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INTENT SERVICE, INC.

712 Main Street, Suite 200, Woodland, CA 95695
(800) 666-1917 • Fax (530) 668-5866 • www.legintent.com

**DECLARATION OF JENNY S. LILLGE**

I, Jenny S. Lillge, declare:

I am an attorney licensed to practice in California, State Bar No. 265046, and am employed by Legislative Intent Service, Inc., a company specializing in researching the history and intent of legislation.

Under my direction and the direction of other attorneys on staff, the research staff of Legislative Intent Service, Inc. undertook to locate and obtain all documents relevant to the enactment of sections 171 through 173 of Title 35 of the United States Code by United States House of Representatives Bill No. 7794 of 1952 [hereinafter referred to as H.R. 7794]. H.R. 7794 was enacted by Congress as Public Law 82-593, on July 19, 1952, at 66 United States Statutes 792.

The following list identifies all documents obtained by the staff of Legislative Intent Service, Inc. on H.R. 7794 of 1952 as it relates to Title 35 United States Code sections 171 through 173. All listed documents have been forwarded with this Declaration except as otherwise noted in this Declaration. All documents gathered by Legislative Intent Service, Inc. and all copies forwarded with this Declaration are true and correct copies of the originals located by Legislative Intent Service, Inc.

**EXHIBIT A - PUBLIC LAW 82-593, H.R. 7794 (BRYSON – 1952):**

1. Public Law 82-593, July 19, 1952, 66 United States Statutes 792;
2. Excerpts regarding HR 7794 and revision of patent laws from *CIS US Serial Set Index* as follows:
   a. Part XIII, Index by Reported Bill Numbers 1817-1969,
   b. Part XI, Subject Index, A-K, 1947-1958,
   c. Part XI, Subject Index, L-Z, 1947-1958;
3. All available versions of H.R. 7794 (Bryson-1952);
4. Excerpt regarding H.R. 7794 from the *Digest of Public General Bills*, 82nd Congress, Second Session, 1952 prepared by the Legislative Reference Service at the Library of Congress;
5. Excerpt regarding H.R. 7794 from the *Congressional Record Index*, 82nd Congress, Second Session, Vol. 98, Part 12;

6. Excerpt regarding H.R. 7794 from the *Congressional Record of Proceedings and Debates*, 82nd Congress, as follows:
    a. House Debate, May 12, 1952, Vol. 98, Part 4;
    b. House Debate, May 19, 1952, Vol. 98, Part 4;
    c. Senate Debate, May 20, 1952, Vol. 98, Part 4;
    d. Senate Debate, June 27, 1952, Vol. 98, Part 6;
    e. Senate Debate, July 3, 1952, Vol. 98, Part 7;
    f. Senate Debate, July 4, 1952, Vol. 98, Part 7;
    g. House Debate, July 5, 1952, Vol. 98, Part 7;
    h. House Debate, July 7, 1952, Vol. 98, Part 7;
7. House Report No.82-1923, entitled "Revision of Title 35, United States Code," prepared by the House Committee on the Judiciary, to accompany H.R. 7794, dated May 12, 1952;
8. Senate Report No. 82-1979, entitled "Revision of Title 35, United States Code," prepared by the Senate Committee on the Judiciary, to accompany H.R. 7794, dated June 27, 1952;
9. Article entitled "Special Commentary on New Title 35, U.S. Code 'Patents'," by Charles J. Zinn, Law Revision Counsel of the Committee on the Judiciary of the House, published in the *United States Code, Congressional and Administrative News,* Vol. 2, 82nd Congress, Second Session, 1952;
10. Excerpt regarding H.R. 7794 from the *Congressional Quarterly*, "Almanac", Vol. VIII, 82nd Congress, Second Session, 1952;
11. Excerpts regarding Representative Joseph R. Bryson from:
    a. The Biographical Directory of the United States Congress, available online at: http://bioguide.congress.gov,
    b. The *Official Congressional Directory*, 82nd Congress, Second Session, for the use of the United States Congress, published by the U.S. Government Printing Office, Washington, 1952.

**EXHIBIT B – 81ST AND 82ND CONGRESSES ,**
**LEGISLATION RELATED TO H.R. 7794 of 1952:**

1. All available versions of H.R. 3760 (Bryson-1951);
2. Excerpt regarding H.R. 3760 from the *Congressional Record Index*, 82nd Congress, First Session, Vol. 97, Part 16;
3. Serial No. 9, entitled "Patent Law Codification and Revision," in Hearings before Subcommittee No. 3 of the House Committee on the Judiciary, on H.R. 3760, dated June 13, 14, and 15, 1951;
4. All available versions of H.R. 9133 (Bryson-1950);
5. Excerpt regarding H.R. 9133 from the *Congressional Record Index,* 81st Congress, Second Session, Vol. 96, Part 19.

**EXHIBIT C – BACKGROUND MATERIALS RELATED TO H.R. 7794 of 1952:**

1. Article entitled "Public Use in Private, or Vice Versa," by D. Journeaux, published in the Journal of the Patent Office Society, July, 1941, Vol. XXIII, No. 7, pages 514, et seq.;
2. "Patent Act of 1952," formal review published in Journal of the Patent Office Society, Vol. XXXIV, No. 8, August, 1952, pages 545, et seq.;
3. Article entitled "The Patent Codification Act," by J.V. Martin, published in the Journal of the Patent Office Society, Vol. XXXIV, No. 9, September, 1954, pages 625, et seq.;
4. Article entitled "The New Patent Statute: Congress Revitalizes the Patent System," by Karl B. Lutz, published in the American Bar Association Journal, Vol. 39, No. 1, January 1953, pages 209, et seq.

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct. Executed this 8th day of June, 2017 at Woodland, California.

Jenny S Lillge

JENNY S. LILLGE

# UNITED STATES STATUTES AT LARGE

CONTAINING THE

LAWS AND CONCURRENT RESOLUTIONS
ENACTED DURING THE SECOND SESSION OF THE
EIGHTY-SECOND CONGRESS
OF THE UNITED STATES OF AMERICA

## 1952

AND

REORGANIZATION PLANS AND PROCLAMATIONS

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## VOLUME 66

IN ONE PART

UNITED STATES
GOVERNMENT PRINTING OFFICE
WASHINGTON : 1953



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Public Law 593 CHAPTER 950

July 19, 1952
[H.R. 7794]

AN ACT

To revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents".

Title 35, U.S. Code.
Codification and enactment into law.

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That title 35 of the United States Code, entitled "Patents", is revised, codified, and enacted into law, and may be cited, "Title 35, United States Code, section—", as follows:

# TITLE 35—PATENTS


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## PART I—PATENT OFFICE


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### CHAPTER 1—ESTABLISHMENT, OFFICERS, FUNCTIONS


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1. Establishment.
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4. Restrictions on officers and employees as to interest in patents.
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9. Classification of patents.
10. Certified copies of records.
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12. Exchange of copies of patents with foreign countries.
13. Copies of patents for public libraries.
14. Annual report to Congress.


#### § 1. Establishment

The Patent Office shall continue as an office in the Department of Commerce, where records, books, drawings, specifications, and other papers and things pertaining to patents and to trade-mark registrations shall be kept and preserved, except as otherwise provided by law.

#### § 2. Seal

The Patent Office shall have a seal with which letters patent, certificates of trade-mark registrations, and papers issued from the Office shall be authenticated.

#### § 3. Officers and employees

A Commissioner of Patents, one first assistant commissioner, two assistant commissioners, and nine examiners-in-chief, shall be appointed by the President, by and with the advice and consent of the Senate. The assistant commissioners shall perform the duties pertaining to the office of commissioner assigned to them by the Commissioner. The first assistant commissioner, or, in the event of a vacancy in that office, the assistant commissioner senior in date of appointment, shall fill the office of Commissioner during a vacancy in that office until a Commissioner is appointed and takes office. The

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Secretary of Commerce, upon the nomination of the Commissioner in accordance with law, shall appoint all other officers and employees.

The Secretary of Commerce may vest in himself the functions of the Patent Office and its officers and employees specified in this title and may from time to time authorize their performance by any other officer or employee.

**§ 4. Restrictions on officers and employees as to interest in patents**

Officers and employees of the Patent Office shall be incapable, during the period of their appointments and for one year thereafter, of applying for a patent and of acquiring, directly or indirectly, except by inheritance or bequest, any patent or any right or interest in any patent, issued or to be issued by the Office. In patents applied for thereafter they shall not be entitled to any priority date earlier than one year after the termination of their appointment.

**§ 5. Bond of Commissioner and other officers**

The Commissioner and such other officers as he designates, before entering upon their duties, shall severally give bond, with sureties, the former in the sum of $10,000, and the latter in sums prescribed by the Commissioner, conditioned for the faithful discharge of their respective duties and that they shall render to the proper officers of the Treasury a true account of all money received by virtue of their offices.

**§ 6. Duties of Commissioner**

The Commissioner, under the direction of the Secretary of Commerce, shall superintend or perform all duties required by law respecting the granting and issuing of patents and the registration of trademarks; and he shall have charge of property belonging to the Patent Office. He may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

**§ 7. Board of Appeals**

The examiners-in-chief shall be persons of competent legal knowledge and scientific ability. The Commissioner, the assistant commissioners, and the examiners-in-chief shall constitute a Board of Appeals, which, on written appeal of the applicant, shall review adverse decisions of examiners upon applications for patents. Each appeal shall be heard by at least three members of the Board of Appeals, the members hearing such appeal to be designated by the Commissioner. The Board of Appeals has sole power to grant rehearings.

Whenever the Commissioner considers it necessary to maintain the work of the Board of Appeals current, he may designate any patent examiner of the primary examiner grade or higher, having the requisite ability, to serve as examiner-in-chief for periods not exceeding six months each. An examiner so designated shall be qualified to act as a member of the Board of Appeals. Not more than one such primary examiner shall be a member of the Board of Appeals hearing an appeal.

**§ 8. Library**

The Commissioner shall maintain a library of scientific and other works and periodicals, both foreign and domestic, in the Patent Office to aid the officers in the discharge of their duties.

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### § 9. Classification of patents

The Commissioner may revise and maintain the classification by subject matter of United States letters patent, and such other patents and printed publications as may be necessary or practicable, for the purpose of determining with readiness and accuracy the novelty of inventions for which applications for patent are filed.

### § 10. Certified copies of records

The Commissioner may furnish certified copies of specifications and drawings of patents issued by the Patent Office, and of other records available either to the public or to the person applying therefor.

### § 11. Publications

(a) The Commissioner may print, or cause to be printed, the following:

1. Patents, including specifications and drawings, together with copies of the same. The Patent Office may print the headings of the drawings for patents for the purpose of photolithography.
2. Certificates of trade-mark registrations, including statements and drawings, together with copies of the same.
3. The Official Gazette of the United States Patent Office.
4. Annual indexes of patents and patentees, and of trade-marks and registrants.
5. Annual volumes of decisions in patent and trade-mark cases.
6. Pamphlet copies of the patent laws and rules of practice, laws and rules relating to trade-marks, and circulars or other publications relating to the business of the Office.

(b) The Commissioner may exchange any of the publications specified in items 3, 4, 5, and 6 of subsection (a) of this section for publications desirable for the use of the Patent Office.

### § 12. Exchange of copies of patents with foreign countries

The Commissioner may exchange copies of specifications and drawings of United States patents for those of foreign countries.

### § 13. Copies of patents for public libraries

The Commissioner may supply printed copies of specifications and drawings of patents to public libraries in the United States which shall maintain such copies for the use of the public, at the rate for each year's issue established for this purpose in section 41 (a) 9 of this title.

### § 14. Annual report to Congress

The Commissioner shall report to Congress annually the moneys received and expended, statistics concerning the work of the Office, and other information relating to the Office as may be useful to the Congress or the public.

## CHAPTER 2—PROCEEDINGS IN THE PATENT OFFICE

Sec.
21. Day for taking action falling on Saturday, Sunday, or holiday.
22. Printing of papers filed.
23. Testimony in Patent Office cases.
24. Subpoenas, witnesses.

### § 21. Day for taking action falling on Saturday, Sunday, or holiday

When the day, or the last day, for taking any action or paying any fee in the United States Patent Office falls on Saturday, Sunday, or a holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding secular or business day.

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### § 22. Printing of papers filed

The Commissioner may require papers filed in the Patent Office to be printed or typewritten.

### § 23. Testimony in Patent Office cases

The Commissioner may establish rules for taking affidavits and depositions required in cases in the Patent Office. Any officer authorized by law to take depositions to be used in the courts of the United States, or of the State where he resides, may take such affidavits and depositions.

### § 24. Subpoenas, witnesses

The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent Office, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent Office.

Every witness subpoenaed and in attendance shall be allowed the fees and traveling expenses allowed to witnesses attending the United States district courts.

A judge of a court whose clerk issued a subpoena may enforce obedience to the process or punish disobedience as in other like cases, on proof that a witness, served with such subpoena, neglected or refused to appear or to testify. No witness shall be deemed guilty of contempt for disobeying such subpoena unless his fees and traveling expenses in going to, and returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret matter except upon appropriate order of the court which issued the subpoena.

## CHAPTER 3—PRACTICE BEFORE PATENT OFFICE

Sec.

31. Regulations for agents and attorneys.
32. Suspension or exclusion from practice.
33. Unauthorized representation as practitioner.

### § 31. Regulations for agents and attorneys

The Commissioner, subject to the approval of the Secretary of Commerce, may prescribe regulations governing the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Patent Office, and may require them, before being recognized as representatives of applicants or other persons, to show that they are of good moral character and reputation and are possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office.

### § 32. Suspension or exclusion from practice

The Commissioner may, after notice and opportunity for a hearing, suspend or exclude, either generally or in any particular case, from further practice before the Patent Office, any person, agent, or attorney shown to be incompetent or disreputable, or guilty of gross misconduct, or who does not comply with the regulations established under section 31 of this title, or who shall, by word, circular, letter, or advertising, with intent to defraud in any manner, deceive, mislead, or threaten

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any applicant or prospective applicant, or other person having immediate or prospective business before the Office. The reasons for any such suspension or exclusion shall be duly recorded. The United States District Court for the District of Columbia, under such conditions and upon such proceedings as it by its rules determines, may review the action of the Commissioner upon the petition of the person so refused recognition or so suspended or excluded.

**§ 33. Unauthorized representation as practitioner**

Whoever, not being recognized to practice before the Patent Office, holds himself out or permits himself to be held out as so recognized, or as being qualified to prepare or prosecute applications for patent, shall be fined not more than $1,000 for each offense.

## CHAPTER 4—PATENT FEES

Sec.
41. Patent fees.
42. Payment of patent fees; return of excess amounts.

**§ 41. Patent fees**

(a) The Commissioner shall charge the following fees:

1. On filing each application for an original patent, except in design cases, $30, and $1 for each claim in excess of twenty.

2. On issuing each original patent, except in design cases, $30, and $1 for each claim in excess of twenty.

3. In design cases: For three years and six months, $10; for seven years, $15; for fourteen years, $30.

4. On every application for the reissue of a patent, $30 and $1 for each claim in excess of twenty over and above the number of claims of the original patent.

5. On filing each disclaimer, $10.

6. On an appeal for the first time from the examiner to the Board of Appeals, $25.

7. On filing each petition for the revival of an abandoned application for a patent or for the delayed payment of the fee for issuing each patent, $10.

8. For certificate of correction of applicant's mistake under section 255 of this title, $10.

9. For uncertified printed copies of specifications and drawings of patents (except design patents), 25 cents per copy; for design patents, 10 cents per copy; special rate for libraries specified in section 13 of this title, $50 for patents issued in one year.

10. For recording every assignment, agreement, or other paper not exceeding six pages, $3; for each additional two pages or less, $1; for each additional patent or application included in one writing, where more than one is so included, 50 cents additional.

11. For each certificate, $1.

(b) The Commissioner may establish charges for copies of records, publications, or services furnished by the Patent Office, not specified above.

**§ 42. Payment of patent fees; return of excess amounts**

All patent fees shall be paid to the Commissioner who shall deposit the same in the Treasury of the United States in such manner as the Secretary of the Treasury directs, and the Commissioner may refund any sum paid by mistake or in excess of the fee required by law.

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# PART II—PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS


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## CHAPTER 10—PATENTABILITY OF INVENTIONS


Sec.
100. Definitions.
101. Inventions patentable.
102. Conditions for patentability; novelty and loss of right to patent.
103. Conditions for patentability; non-obvious subject matter.
104. Invention made abroad.


### § 100. Definitions

When used in this title unless the context otherwise indicates—

(a) The term "invention" means invention or discovery.

(b) The term "process" means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.

(c) The terms "United States" and "this country" mean the United States of America, its territories and possessions.

(d) The word "patentee" includes not only the patentee to whom the patent was issued but also the successors in title to the patentee.

### § 101. Inventions patentable

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

### § 102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be con-

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sidered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

### § 103. Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

### § 104. Invention made abroad

In proceedings in the Patent Office and in the courts, an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country, except as provided in section 119 of this title. Where an invention was made by a person, civil or military, while domiciled in the United States and serving in a foreign country in connection with operations by or on behalf of the United States, he shall be entitled to the same rights of priority with respect to such invention as if the same had been made in the United States.

## CHAPTER 11—APPLICATION FOR PATENT

Sec.
111. Application for patent.
112. Specification.
113. Drawings.
114. Models, specimens.
115. Oath of applicant.
116. Joint inventors.
117. Death or incapacity of inventor.
118. Filing by other than inventor.
119. Benefit of earlier filing date in foreign country; right of priority.
120. Benefit of earlier filing date in the United States.
121. Divisional applications.
122. Confidential status of applications.

### § 111. Application for patent

Application for patent shall be made by the inventor, except as otherwise provided in this title, in writing to the Commissioner. Such application shall include: (1) a specification as prescribed by section 112 of this title; (2) a drawing as prescribed by section 113 of this title; and (3) an oath by the applicant as prescribed by section 115 of this title. The application must be signed by the applicant and accompanied by the fee required by law.

### § 112. Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall

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be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

### § 113. Drawings

When the nature of the case admits, the applicant shall furnish a drawing.

### § 114. Models, specimens

The Commissioner may require the applicant to furnish a model of convenient size to exhibit advantageously the several parts of his invention.

When the invention relates to a composition of matter, the Commissioner may require the applicant to furnish specimens or ingredients for the purpose of inspection or experiment.

### § 115. Oath of applicant

The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by certificate of a diplomatic or consular officer of the United States, and such oath shall be valid if it complies with the laws of the state or country where made. When the application is made as provided in this title by a person other than the inventor, the oath may be so varied in form that it can be made by him.

### § 116. Joint inventors

When an invention is made by two or more persons jointly, they shall apply for patent jointly and each sign the application and make the required oath, except as otherwise provided in this title.

If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Commissioner, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor making the application, subject to the same rights which the omitted inventor would have had if he had been joined. The omitted inventor may subsequently join in the application.

Whenever a person is joined in an application for patent as joint inventor through error, or a joint inventor is not included in an application through error, and such error arose without any deceptive intention on his part, the Commissioner may permit the application to he amended accordingly, under such terms as he prescribes.

### § 117. Death or incapacity of inventor

Legal representatives of deceased inventors and of those under legal incapacity may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor.

### § 118. Filing by other than inventor

Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of

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and as agent for the inventor on proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage; and the Commissioner may grant a patent to such inventor upon such notice to him as the Commissioner deems sufficient, and on compliance with such regulations as he prescribes.

### § 119. Benefit of earlier filing date in foreign country; right of priority

An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed; but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing.

No application for patent shall be entitled to this right of priority unless a claim therefor and a certified copy of the original foreign application, specification and drawings upon which it is based are filed in the Patent Office before the patent is granted, or at such time during the pendency of the application as required by the Commissioner not earlier than six months after the filing of the application in this country. Such certification shall be made by the patent office of the foreign country in which filed and show the date of the application and of the filing of the specification and other papers. The Commissioner may require a translation of the papers filed if not in the English language and such other information as he deems necessary.

### § 120. Benefit of earlier filing date in the United States

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States by the same inventor shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

### § 121. Divisional applications

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional

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application is filed before the issuance of the patent on the other application. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Commissioner may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Commissioner to require the application to be restricted to one invention.

### § 122. Confidential status of applications

Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner.

## CHAPTER 12—EXAMINATION OF APPLICATION

Sec.

131. Examination of application.
132. Notice of rejection; reexamination.
133. Time for prosecuting application.
134. Appeal to the Board of Appeals.
135. Interferences.

### § 131. Examination of application

The Commissioner shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Commissioner shall issue a patent therefor.

### § 132. Notice of rejection; reexamination

Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

### § 133. Time for prosecuting application

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

### § 134. Appeal to the Board of Appeals

An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Appeals, having once paid the fee for such appeal.

### § 135. Interferences

Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute

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the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office.

A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

## CHAPTER 13—REVIEW OF PATENT OFFICE DECISION

Sec.

141. Appeal to Court of Customs and Patent Appeals.
142. Notice of appeal.
143. Proceedings on appeal.
144. Decision on appeal.
145. Civil action to obtain patent.
146. Civil action in case of interference.

### § 141. Appeal to Court of Customs and Patent Appeals

An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Customs and Patent Appeals, thereby waiving his right to proceed under section 145 of this title. A party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority may appeal to the United States Court of Customs and Patent Appeals, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has filed notice of appeal according to section 142 of this title, files notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 146 of this title. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under section 146, in default of which the decision appealed from shall govern the further proceedings in the case.

### § 142. Notice of appeal

When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and shall file in the Patent Office his reasons of appeal, specifically set forth in writing, within such time after the date of the decision appealed from, not less than sixty days, as the Commissioner appoints.

### § 143. Proceedings on appeal

The United States Court of Customs and Patent Appeals shall, before hearing such appeal, give notice of the time and place of the hearing to the Commissioner and the parties thereto. The Commissioner shall transmit to the court certified copies of all the necessary original papers and evidence in the case specified by the appellant and any additional papers and evidence specified by the appellee and in an ex parte case the Commissioner shall furnish the court with the grounds of the decision of the Patent Office, in writing, touching all the points involved by the reasons of appeal.

### § 144. Decision on appeal

The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent Office, and the decision shall be confined to the points set forth in the reasons of appeal. Upon its determination the court

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shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and govern the further proceedings in the case.

### § 145. Civil action to obtain patent

An applicant dissatisfied with the decision of the Board of Appeals may unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

### § 146. Civil action in case of interference

Any party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority, may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints or as provided in section 141 of this title, unless he has appealed to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided. In such suits the record in the Patent Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent Office when admitted shall have the same effect as if originally taken and produced in the suit.

Such suit may be instituted against the party in interest as shown by the records of the Patent Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs. The Commissioner shall not be a necessary party but he shall be notified of the filing of the suit by the clerk of the court in which it is filed and shall have the right to intervene. Judgment of the court in favor of the right of an applicant to a patent shall authorize the Commissioner to issue such patent on the filing in the Patent Office of a certified copy of the judgment and on compliance with the requirements of law.

## CHAPTER 14—ISSUE OF PATENT

Sec.
151. Time of issue of patent.
152. Issue of patent to assignee.
153. How issued.
154. Contents and term of patent.

### § 151. Time of issue of patent

The patent shall issue within three months from the date of the payment of the final fee, which shall be paid not later than six months after written notice to the applicant of allowance of the application,

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but the Commissioner may accept the final fee if paid within one year after the six month period for payment, and the patent shall issue.

### § 152. Issue of patent to assignee

Patents may be granted to the assignee of the inventor of record in the Patent Office, upon the application made and the specification sworn to by the inventor, except as otherwise provided in this title.

### § 153. How issued

Patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Commissioner or have his signature placed thereon and attested by an officer of the Patent Office designated by the Commissioner, and shall be recorded in the Patent Office.

### § 154. Contents and term of patent

Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the right to exclude others from making, using, or selling the invention throughout the United States, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof.

## CHAPTER 15—PLANT PATENTS

Sec.
161. Patents for plants.
162. Description, claim.
163. Grant.
164. Assistance of Department of Agriculture.

### § 161. Patents for plants

Whoever invents or discovers and asexually reproduces any distinct and new variety of plant, other than a tuberpropagated plant, may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for plants, except as otherwise provided.

### § 162. Description, claim

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible.

The claim in the specification shall be in formal terms to the plant shown and described.

### § 163. Grant

In the case of a plant patent the grant shall be of the right to exclude others from asexually reproducing the plant or selling or using the plant so reproduced.

### § 164. Assistance of Department of Agriculture.

The President may by Executive order direct the Secretary of Agriculture, in accordance with the requests of the Commissioner, for the purpose of carrying into effect the provisions of this title with respect to plants (1) to furnish available information of the Department of Agriculture, (2) to conduct through the appropriate bureau or division of the Department research upon special problems, or (3) to detail to the Commissioner officers and employees of the Department.

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## CHAPTER 16—DESIGNS

Sec.
171. Patents for designs.
172. Right of priority.
173. Term of design patent.

### § 171. Patents for designs

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

### § 172. Right of priority

The right of priority provided for by section 119 of this title and the time specified in section 102 (d) shall be six months in the case of designs.

### § 173. Term of design patent

Patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant, in his application, elects.

## CHAPTER 17—SECRECY OF CERTAIN INVENTIONS AND FILING APPLICATIONS IN FOREIGN COUNTRY

Sec.
181. Secrecy of certain inventions and withholding of patent.
182. Abandonment of invention for unauthorized disclosure.
183. Right of compensation.
184. Filing of application in foreign country.
185. Patent barred for filing without license.
186. Penalty.
187. Nonapplicability to certain persons.
188. Rules and regulations, delegation of power.

### § 181. Secrecy of certain inventions and withholding of patent

Whenever publication or disclosure by the grant of a patent on an invention in which the Government has a property interest might, in the opinion of the head of the interested Government agency, be detrimental to the national security, the Commissioner upon being so notified shall order that the invention be kept secret and shall withhold the grant of a patent therefor under the conditions set forth hereinafter.

Whenever the publication or disclosure of an invention by the granting of a patent, in which the Government does not have a property interest, might, in the opinion of the Commissioner, be detrimental to the national security, he shall make the application for patent in which such invention is disclosed available for inspection to the Atomic Energy Commission, the Secretary of Defense, and the chief officer of any other department or agency of the Government designated by the President as a defense agency of the United States.

Each individual to whom the application is disclosed shall sign a dated acknowledgment thereof, which acknowledgment shall be entered in the file of the application. If, in the opinion of the Atomic Energy Commission, the Secretary of a Defense Department, or the chief officer of another department or agency so designated, the publication or disclosure of the invention by the granting of a patent therefor would be detrimental to the national security, the Atomic Energy Commission, the Secretary of a Defense Department, or such other chief officer shall notify the Commissioner and the Commissioner shall order that the invention be kept secret and shall withhold the grant of a patent for such period as the national interest requires, and

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notify the applicant thereof. Upon proper showing by the head of the department or agency who caused the secrecy order to be issued that the examination of the application might jeopardize the national interest, the Commissioner shall thereupon maintain the application in a sealed condition and notify the applicant thereof. The owner of an application which has been placed under a secrecy order shall have a right to appeal from the order to the Secretary of Commerce under rules prescribed by him.

An invention shall not be ordered kept secret and the grant of a patent withheld for a period of more than one year. The Commissioner shall renew the order at the end thereof, or at the end of any renewal period, for additional periods of one year upon notification by the head of the department or the chief officer of the agency who caused the order to be issued that an affirmative determination has been made that the national interest continues so to require. An order in effect, or issued, during a time when the United States is at war, shall remain in effect for the duration of hostilities and one year following cessation of hostilities. An order in effect, or issued, during a national emergency declared by the President shall remain in effect for the duration of the national emergency and six months thereafter. The Commissioner may rescind any order upon notification by the heads of the departments and the chief officers of the agencies who caused the order to be issued that the publication or disclosure of the invention is no longer deemed detrimental to the national security.

**§ 182. Abandonment of invention for unauthorized disclosure**

The invention disclosed in an application for patent subject to an order made pursuant to section 181 of this title may be held abandoned upon its being established by the Commissioner that in violation of said order the invention has been published or disclosed or that an application for a patent therefor has been filed in a foreign country by the inventor, his successors, assigns, or legal representatives, or anyone in privity with him or them, without the consent of the Commissioner. The abandonment shall be held to have occurred as of the time of violation. The consent of the Commissioner shall not be given without the concurrence of the heads of the departments and the chief officers of the agencies who caused the order to be issued. A holding of abandonment shall constitute forfeiture by the applicant, his successors, assigns, or legal representatives, or anyone in privity with him or them, of all claims against the United States based upon such invention.

**§ 183. Right to compensation**

An applicant, his successors, assigns, or legal representatives, whose patent is withheld as herein provided, shall have the right, beginning at the date the applicant is notified that, except for such order, his application is otherwise in condition for allowance, or February 1, 1952, whichever is later, and ending six years after a patent is issued thereon, to apply to the head of any department or agency who caused the order to be issued for compensation for the damage caused by the order of secrecy and/or for the use of the invention by the Government, resulting from his disclosure. The right to compensation for use shall begin on the date of the first use of the invention by the Government. The head of the department or agency is authorized, upon the presentation of a claim, to enter into an agreement with the applicant, his successors, assigns, or legal representatives, in full settlement for the damage and/or use. This settlement agreement shall be conclusive for all purposes not withstanding any other provision of law to the contrary. If full settlement of the claim cannot be effected, the head of the department or agency may award and pay to such applicant, his

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successors, assigns, or legal representatives, a sum not exceeding 75 per centum of the sum which the head of the department or agency considers just compensation for the damage and/or use. A claimant may bring suit against the United States in the Court of Claims or in the District Court of the United States for the district in which such claimant is a resident for an amount which when added to the award shall constitute just compensation for the damage and/or use of the invention by the Government. The owner of any patent issued upon an application that was subject to a secrecy order issued pursuant to section 181 of this title, who did not apply for compensation as above provided, shall have the right, after the date of issuance of such patent, to bring suit in the Court of Claims for just compensation for the damage caused by reason of the order of secrecy and/or use by the Government of the invention resulting from his disclosure. The right to compensation for use shall begin on the date of the first use of the invention by the Government. In a suit under the provisions of this section the United States may avail itself of all defenses it may plead in an action under section 1498 of title 28. This section shall not confer a right of action on anyone or his successors, assigns, or legal representatives who, while in the full-time employment or service of the United States, discovered, invented, or developed the invention on which the claim is based.

62 Stat. 941.

**§ 184. Filing of application in foreign country**

Except when authorized by a license obtained from the Commissioner a person shall not file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States an application for patent or for the registration of a utility model, industrial design, or model in respect of an invention made in this country. A license shall not be granted with respect to an invention subject to an order issued by the Commissioner pursuant to section 181 of this title without the concurrence of the head of the departments and the chief officers of the agencies who caused the order to be issued. The license may be granted retroactively where an application has been inadvertently filed abroad and the application does not disclose an invention within the scope of section 181 of this title.

The term "application" when used in this chapter includes applications and any modifications, amendments, or supplements thereto, or divisions thereof.

**§ 185. Patent barred for filing without license**

Notwithstanding any other provisions of law any person, and his successors, assigns, or legal representatives, shall not receive a United States patent for an invention if that person, or his successors, assigns, or legal representatives shall, without procuring the license prescribed in section 184 of this title, have made, or consented to or assisted another's making, application in a foreign country for a patent or for the registration of a utility model, industrial design, or model in respect of the invention. A United States patent issued to such person, his successors, assigns, or legal representatives shall be invalid.

**§ 186. Penalty**

Whoever, during the period or periods of time an invention has been ordered to be kept secret and the grant of a patent thereon withheld pursuant to section 181 of this title, shall, with knowledge of such order and without due authorization, willfully publish or disclose or authorize or cause to be published or disclosed the invention, or material information with respect thereto, or whoever, in violation of the provisions of section 184 of this title, shall file or cause or authorize to be filed in any foreign country an application for patent or for the registration of a utility model, industrial design, or model in respect of any invention made in the United States, shall,

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upon conviction, be fined not more than $10,000 or imprisoned for not more than two years, or both.

### § 187. Nonapplicability to certain persons

The prohibitions and penalties of this chapter shall not apply to any officer or agent of the United States acting within the scope of his authority, nor to any person acting upon his written instructions or permission.

### § 188. Rules and regulations, delegation of power

The Atomic Energy Commission, the Secretary of a defense department, the chief officer of any other department or agency of the Government designated by the President as a defense agency of the United States, and the Secretary of Commerce, may separately issue rules and regulations to enable the respective department or agency to carry out the provisions of this chapter, and may delegate any power conferred by this chapter.

## PART III—PATENTS AND PROTECTION OF PATENT RIGHTS


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## CHAPTER 25—AMENDMENT AND CORRECTION OF PATENTS


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252. Effect of reissue.
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255. Certificate of correction of applicant's mistake.
256. Misjoinder of inventor.


### § 251. Reissue of defective patents

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Commissioner may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

### § 252. Effect of reissue

The surrender of the original patent shall take effect upon the issue of the reissued patent, and every reissued patent shall have the same effect and operation in law, on the trial of actions for causes thereafter arising, as if the same had been originally granted in such

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amended form, but in so far as the claims of the original and reissued patents are identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent, to the extent that its claims are identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent.

No reissued patent shall abridge or affect the right of any person or his successors in business who made, purchased or used prior to the grant of a reissue anything patented by the reissued patent, to continue the use of, or to sell to others to be used or sold, the specific thing so made, purchased or used, unless the making, using or selling of such thing infringes a valid claim of the reissued patent which was in the original patent. The court before which such matter is in question may provide for the continued manufacture, use or sale of the thing made, purchased or used as specified, or for the manufacture, use or sale of which substantial preparation was made before the grant of the reissue, and it may also provide for the continued practice of any process patented by the reissue, practiced, or for the practice of which substantial preparation was made, prior to the grant of the reissue, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before the grant of the reissue.

**§ 253. Disclaimer**

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, and recorded in the Patent Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

**§ 254. Certificate of correction of Patent Office mistake**

Whenever a mistake in a patent, incurred through the fault of the Patent Office, is clearly disclosed by the records of the Office, the Commissioner may issue a certificate of correction stating the fact and nature of such mistake, under seal, without charge, to be recorded in the records of patents. A printed copy thereof shall be attached to each printed copy of the patent, and such certificate shall be considered as part of the original patent. Every such patent, together with such certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form. The Commissioner may issue a corrected patent without charge in lieu of and with like effect as a certificate of correction.

**§ 255. Certificate of correction of applicant's mistake**

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Commissioner may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require re-examination. Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions

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for causes thereafter arising as if the same had been originally issued in such corrected form.

### § 256. Misjoinder of inventor

Whenever a patent is issued on the application of persons as joint inventors and it appears that one of such persons was not in fact a joint inventor, and that he was included as a joint inventor by error and without any deceptive intention, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate deleting the name of the erroneously joined person from the patent.

Whenever a patent is issued and it appears that a person was a joint inventor, but was omitted by error and without deceptive intention on his part, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate adding his name to the patent as a joint inventor.

The misjoinder or nonjoinder of joint inventors shall not invalidate a patent, if such error can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Commissioner shall issue a certificate accordingly.

## CHAPTER 26—OWNERSHIP AND ASSIGNMENT

Sec.
261. Ownership; assignment.
262. Joint owners.

### § 261. Ownership; assignment

Subject to the provisions of this title, patents shall have the attributes of personal property.

Applications for patent, patents, or any interest therein, shall be assignable in law by an instrument in writing. The applicant, patentee, or his assigns or legal representatives may in like manner grant and convey an exclusive right under his application for patent, or patents, to the whole or any specified part of the United States.

A certificate of acknowledgment under the hand and official seal of a person authorized to administer oaths within the United States, or, in a foreign country, of a diplomatic or consular officer of the United States or an officer authorized to administer oaths whose authority is proved by a certificate of a diplomatic or consular officer of the United States, shall be prima facie evidence of the execution of an assignment, grant or conveyance of a patent or application for patent.

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 its date or prior to the date of such subsequent purchase or mortgage.

### § 262. Joint owners

In the absence of any agreement to the contrary, each of the joint owners of a patent may make, use or sell the patented invention without the consent of and without accounting to the other owners.

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## CHAPTER 27—GOVERNMENT INTERESTS IN PATENTS

Sec.
266. Issue of patents without fees to Government employees.
267. Time for taking action in Government applications.

### § 266. Issue of patents without fees to Government employees

The Commissioner may grant, subject to the provisions of this title, to any officer, enlisted man, or employee of the Government, except officers and employees of the Patent Office, a patent without the payment of fees, when the head of a department or agency certifies the invention is used or likely to be used in the public interest and the applicant in his application states that the invention described therein, if patented, may be manufactured and used by or for the Government for governmental purposes without the payment to him of any royalty thereon, which stipulation shall be included in the patent.

### § 267. Time for taking action in Government applications

Notwithstanding the provisions of sections 133 and 151 of this title, the Commissioner may extend the time for taking any action to three years, when an application has become the property of the United States and the head of the appropriate department or ageucy of the Government has certified to the Commissioner that the invention disclosed therein is important to the armament or defense of the United States.

## CHAPTER 28—INFRINGEMENT OF PATENTS

Sec.
271. Infringement of patent.
272. Temporary presence in the United States.

### § 271. Infringement of patent

(a) Except as otherwise provided in this title, whoever without authority makes, uses or sells any patented invention, within the United States during the term of the patent therefor, infringes the patent.

(b) Whoever actively induces infringement of a patent shall be liable as an infringer.

(c) Whoever sells a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.

(d) No patent owner otherwise entitled to relief for infringement or contributory infringement of a patent shall be denied relief or deemed guilty of misuse or illegal extension of the patent right by reason of his having done one or more of the following: (1) derived revenue from acts which if performed by another without his consent would constitute contributory infringement of the patent; (2) licensed or authorized another to perform acts which if performed without his consent would constitute contributory infringement of the patent; (3) sought to enforce his patent rights against infringement or contributory infringement.

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### § 272. Temporary presence in the United States

The use of any invention in any vessel, aircraft or vehicle of any country which affords similar privileges to vessels, aircraft or vehicles of the United States, entering the United States temporarily or accidentally, shall not constitute infringement of any patent, if the invention is used exclusively for the needs of the vessel, aircraft or vehicle and is not sold in or used for the manufacture of anything to be sold in or exported from the United States.

## CHAPTER 29—REMEDIES FOR INFRINGEMENT OF PATENT, AND OTHER ACTIONS

Sec.

281. Remedy for infringement of patent.
282. Presumption of validity; defenses.
283. Injunction.
284. Damages.
285. Attorney fees.
286. Time limitation on damages.
287. Limitation on damages; marking and notice.
288. Action for infringement of a patent containing an invalid claim.
289. Additional remedy for infringement of design patent.
290. Notice of patent suits.
291. Interfering patents.
292. False marking.
293. Nonresident patentee, service and notice.

### § 281. Remedy for infringement of patent

A patentee shall have remedy by civil action for infringement of his patent.

### § 282. Presumption of validity; defenses

A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it.

The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

(1) Noninfringement, absence of liability for infringement or unenforceability,

(2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability,

(3) Invalidity of the patent or any claim in suit for failure to comply with any requirement of sections 112 or 251 of this title,

(4) Any other fact or act made a defense by this title.

In actions involving the validity or infringement of a patent the party asserting invalidity or noninfringement shall give notice in the pleadings or otherwise in writing to the adverse party at least thirty days before the trial, of the country, number, date, and name of the patentee of any patent, the title, date, and page numbers of any publication to be relied upon as anticipation of the patent in suit or, except in actions in the United States Court of Claims, as showing the state of the art, and the name and address of any person who may be relied upon as the prior inventor or as having prior knowledge of or as having previously used or offered for sale the invention of the patent in suit. In the absence of such notice proof of the said matters may not be made at the trial except on such terms as the court requires.

### § 283. Injunction

The several courts having jurisdiction of cases under this title may grant injunctions in accordance with the principles of equity to prevent the violation of any right secured by patent, on such terms as the court deems reasonable.

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**§ 284. Damages**

Upon finding for the claimant the court shall award the claimant damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court.

When the damages are not found by a jury, the court shall assess them. In either event the court may increase the damages up to three times the amount found or assessed.

The court may receive expert testimony as an aid to the determination of damages or of what royalty would be reasonable under the circumstances.

**§ 285. Attorney fees**

The court in exceptional cases may award reasonable attorney fees to the prevailing party.

**§ 286. Time limitation on damages**

Except as otherwise provided by law, no recovery shall be had for any infringement committed more than six years prior to the filing of the complaint or counterclaim for infringement in the action.

In the case of claims against the United States Government for use of a patented invention, the period before bringing suit, up to six years, between the date of receipt of a written claim for compensation by the department or agency of the Government having authority to settle such claim, and the date of mailing by the Government of a notice to the claimant that his claim has been denied shall not be counted as part of the period referred to in the preceding paragraph.

**§ 287. Limitation on damages; marking and notice**

Patentees, and persons making or selling any patented article for or under them, may give notice to the public that the same is patented, either by fixing thereon the word "patent" or the abbreviation "pat.", together with the number of the patent, or when, from the character of the article, this can not be done, by fixing to it, or to the package wherein one or more of them is contained, a label containing a like notice. In the event of failure so to mark, no damages shall be recovered by the patentee in any action for infringement, except on proof that the infringer was notified of the infringement and continued to infringe thereafter, in which event damages may be recovered only for infringement occurring after such notice. Filing of an action for infringement shall constitute such notice.

**§ 288. Action for infringement of a patent containing an invalid claim**

Whenever, without deceptive intention, a claim of a patent is invalid, an action may be maintained for the infringement of a claim of the patent which may be valid. The patentee shall recover no costs unless a disclaimer of the invalid claim has been entered at the Patent Office before the commencement of the suit.

**§ 289. Additional remedy for infringement of design patent**

Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit, but not less than $250, recoverable in any United States district court having jurisdiction of the parties.

Nothing in this section shall prevent, lessen, or impeach any other remedy which an owner of an infringed patent has under the pro-

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visions of this title, but he shall not twice recover the profit made from the infringement.

**§ 290. Notice of patent suits**

The clerks of the courts of the United States, within one month after the filing of an action under this title shall give notice thereof in writing to the Commissioner, setting forth so far as known the names and addresses of the parties, name of the inventor, and the designating number of the patent upon which the action has been brought. If any other patent is subsequently included in the action he shall give like notice thereof. Within one month after the decision is rendered or a judgment issued the clerk of the court shall give notice thereof to the Commissioner. The Commissioner shall, on receipt of such notices, enter the same in the file of such patent.

**§ 291. Interfering patents**

The owner of an interfering patent may have relief against the owner of another by civil action, and the court may adjudge the question of the validity of any of the interfering patents, in whole or in part. The provisions of the second paragraph of section 146 of this title shall apply to actions brought under this section.

**§ 292. False marking**

(a) Whoever, without the consent of the patentee, marks upon, or affixes to, or uses in advertising in connection with anything made, used, or sold by him, the name or any imitation of the name of the patentee, the patent number, or the words "patent," "patentee," or the like, with the intent of counterfeiting or imitating the mark of the patentee, or of deceiving the public and inducing them to believe that the thing was made or sold by or with the consent of the patentee; or

Whoever marks upon, or affixes to, or uses in advertising in connection with any unpatented article, the word "patent" or any word or number importing that the same is patented, for the purpose of deceiving the public; or

Whoever marks upon, or affixes to, or uses in advertising in connection with any article, the words "patent applied for," "patent pending," or any word importing that an application for patent has been made, when no application for patent has been made, or if made, is not pending, for the purpose of deceiving the public—

Shall be fined not more than $500 for every such offense.

(b) Any person may sue for the penalty, in which event one-half shall go to the person suing and the other to the use of the United States.

**§ 293. Nonresident patentee; service and notice**

Every patentee not residing in the United States may file in the Patent Office a written designation stating the name and address of a person residing within the United States on whom may be served process or notice of proceedings affecting the patent or rights thereunder. If the person designated cannot be found at the address given in the last designation, or if no person has been designated, the United States District Court for the District of Columbia shall have jurisdiction and summons shall be served by publication or otherwise as the court directs. The court shall have the same jurisdiction to take any action respecting the patent or rights thereunder that it would have if the patentee were personally within the jurisdiction of the court.

SEC. 2. Section 21 of the Act approved July 5, 1946, 60 Stat. 435, (United States Code, title 15, sec. 1071, 1946 ed.) is amended by striking out "Revised Statutes 4911" and inserting "35 United States Code, section 141"; by striking out "section 4915, Revised Statutes" and insert-

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ing "35 United States Code, sections 145 and 146"; and by striking out "Revised Statutes 4915" appearing twice in said section and inserting "35 United States Code, section 146".

Separability clause.

SEC. 3. If any provision of Title 35, as enacted by section 1 hereof, is declared unconstitutional or is held invalid, the validity of the remainder of this title shall not be affected.

Effective date.

SEC. 4. (a) This Act shall take effect on January 1, 1953 and shall apply to all applications for patent filed on or after such date and to all patents granted on such applications. It shall apply to further proceedings on applications pending on such date and to patents granted on such applications except as otherwise provided. It shall apply to unexpired patents granted prior to such date except as otherwise provided.

Nonapplicability.

(b) Section 102 (d) of Title 35, as enacted by section 1 hereof, shall not apply to existing patents and pending applications, but the law previously in effect, namely the first paragraph of R. S. 4887 (U. S. Code, title 35, sec. 32, first paragraph, 1946 ed.), shall apply to such patents and applications.

(c) Section 119, second paragraph, of Title 35 as enacted by section 1 hereof shall not apply to existing patents.

(d) The period of one year specified in section 102 (b) of Title 35 as enacted by section 1 hereof shall not apply in the case of applications filed before August 5, 1940, and patents granted on such applications, and with respect to such applications and patents, said period is two years instead of one year.

(e) Nothing contained in Title 35, as enacted by section 1 hereof, shall operate to nullify any judicial finding prior to the effective date of this Act on the validity of any patent by a court of competent jurisdiction.

(f) Nothing in Title 35, as enacted by section 1 hereof, shall affect any provision of the Atomic Energy Act of 1946 (Aug. 1, 1946, ch. 724, 60 Stat. 755).

42 USC 1801 note.

(g) The period of one year specified in section 4 of Title 35 as enacted by section 1 hereof shall not apply in the case of applications filed before the effective date of this Act.

*Post*, p. 817.

Secrecy orders.

(h) The repeal of sections 1–9, 11, 12 of the Act of Congress approved February 1, 1952 (ch. 4, 66 Stat. 3), shall not affect any rights or liabilities existing on the date of approval of this Act. An order of secrecy issued under or in effect under the repealed Act and in effect on the date of approval of this Act, shall be considered as issued under this Act, and any claims arising under the repealed Act or subject to presentation and determination pursuant thereto and unsettled as of the effective date of this Act, may be presented and determined pursuant to the provisions of this Act.

Repeals.

SEC. 5. The sections or parts thereof of the Revised Statutes or Statutes at Large enumerated in the following schedule are hereby repealed. Any rights or liabilities now existing under such sections or parts thereof shall not be affected by this repeal.

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[1] The part relating to the granting of patents to Government employees without fees.
[2] The part relating to certified copies of drawings and specifications.
[3] The part relating to fees for recording assignments.
[4] The part amending R. S. 4894.
[5] The part relating to the price of copies of patents.
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[7] The part relating to the fee for copies of specifications and drawings of patents

Approved July 19, 1952.

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X re HR 7794 and revision of
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**Union Calendar No. 594**

82D CONGRESS
2D SESSION

# H. R. 7794

**[Report No. 1923]**

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IN THE HOUSE OF REPRESENTATIVES

MAY 12, 1952

Mr. BRYSON introduced the following bill; which was referred to the Committee on the Judiciary

MAY 12, 1952

Committed to the Committee of the Whole House on the State of the Union and ordered to be printed

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# A BILL

To revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents".

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That title 35 of the United States Code, entitled "Patents", is revised, codified, and enacted into law, and may be cited, "Title 35, United States Code, section—", as follows:

## TITLE 35—PATENTS


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## PART I—PATENT OFFICE


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## CHAPTER 1—ESTABLISHMENT, OFFICERS, FUNCTIONS

Sec.

1. Establishment.
2. Seal.
3. Officers and employees.
4. Restrictions on officers and employees as to interest in patents.
5. Bond of Commissioner and other officers.
6. Duties of Commissioner.
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8. Library.
9. Classification of patents.
10. Certified copies of records.
11. Publications.
12. Exchange of copies of patents with foreign countries.
13. Copies of patents for public libraries.
14. Annual report to Congress.

### § 1. Establishment

The Patent Office shall continue as an office in the Department of Commerce, where records, books, drawings, specifications, and other papers and things pertaining to patents and to trade-mark registrations shall be kept and preserved, except as otherwise provided by law.

### § 2. Seal

The Patent Office shall have a seal with which letters patent, certificates of trade-mark registrations, and papers issued from the Office shall be authenticated.

### § 3. Officers and employees

A Commissioner of Patents, one first assistant commissioner, two assistant commissioners, and nine examiners-in-chief, shall be appointed by the President, by and with the advice and consent of the Senate. The assistant commissioners shall perform the duties pertaining to the office of commissioner assigned to them by the Commissioner. The first assistant commissioner, or, in the event of a vacancy in that office, the assistant commissioner senior in date of appointment, shall fill the office of Commissioner during a vacancy in that office until a Commissioner is appointed and takes office. The Secretary of Commerce, upon the nomination of the Commissioner in accordance with law, shall appoint all other officers and employees.

The Secretary of Commerce may vest in himself the functions of the Patent Office and its officers and employees specified in this title and may from time to time authorize their performance by any other officer or employee.

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**§ 4. Restrictions on officers and employees as to interest in patents**

Officers and employees of the Patent Office shall be incapable, during the period of their appointments and for one year thereafter, of applying for a patent and of acquiring, directly or indirectly, except by inheritance or bequest, any patent or any right or interest in any patent, issued or to be issued by the Office. In patents applied for thereafter they shall not be entitled to any priority date earlier than one year after the termination of their appointment.

**§ 5. Bond of Commissioner and other officers**

The Commissioner and such other officers as he designates, before entering upon their duties, shall severally give bond, with sureties, the former in the sum of $10,000, and the latter in sums prescribed by the Commissioner, conditioned for the faithful discharge of their respective duties and that they shall render to the proper officers of the Treasury a true account of all money received by virtue of their offices.

**§ 6. Duties of Commissioner**

The Commissioner, under the direction of the Secretary of Commerce, shall superintend or perform all duties required by law respecting the granting and issuing of patents and the registration of trademarks; and he shall have charge of property belonging to the Patent Office. He may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

**§ 7. Board of Appeals**

The examiners-in-chief shall be persons of competent legal knowledge and scientific ability. The Commissioner, the assistant commissioners, and the examiners-in-chief shall constitute a Board of Appeals, which, on written appeal of the applicant, shall review adverse decisions of examiners upon applications for patents. Each appeal shall be heard by at least three members of the Board of Appeals, the members hearing such appeal to be designated by the Commissioner. The Board of Appeals has sole power to grant rehearings.

Whenever the Commissioner considers it necessary to maintain the work of the Board of Appeals current, he may designate any patent

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examiner of the primary examiner grade or higher, having the requisite ability, to serve as examiner-in-chief for periods not exceeding six months each. An examiner so designated shall be qualified to act as a member of the Board of Appeals. Not more than one such primary examiner shall be a member of the Board of Appeals hearing an appeal.

**§ 8. Library**

The Commissioner shall maintain a library of scientific and other works and periodicals, both foreign and domestic, in the Patent Office to aid the officers in the discharge of their duties.

**§ 9. Classification of patents**

The Commissioner may revise and maintain the classification by subject matter of United States letters patent, and such other patents and printed publications as may be necessary or practicable, for the purpose of determining with readiness and accuracy the novelty of inventions for which applications for patent are filed.

**§ 10. Certified copies of records**

The Commissioner may furnish certified copies of specifications and drawings of patents issued by the Patent Office, and of other records available either to the public or to the person applying therefor.

**§ 11. Publications**

(a) The Commissioner may print, or cause to be printed, the following:

1. Patents, including specifications and drawings, together with copies of the same. The Patent Office may print the headings of the drawings for patents for the purpose of photolithography.

2. Certificates of trade-mark registrations, including statements and drawings, together with copies of the same.

3. The Official Gazette of the United States Patent Office.

4. Annual indexes of patents and patentees, and of trade-marks and registrants.

5. Annual volumes of decisions in patent and trade-mark cases.

6. Pamphlet copies of the patent laws and rules of practice, laws and rules relating to trade-marks, and circulars or other publications relating to the business of the Office.

(b) The Commissioner may exchange any of the publications specified in items 3, 4, 5, and 6 of subsection (a) of this section for publications desirable for the use of the Patent Office.

**§ 12. Exchange of copies of patents with foreign countries**

The Commissioner may exchange copies of specifications and drawings of United States patents for those of foreign countries.

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### § 13. Copies of patents for public libraries

The Commissioner may supply printed copies of specifications and drawings of patents to public libraries in the United States which shall maintain such copies for the use of the public, at the rate for each year's issue established for this purpose in section 41 (a) 9 of this title.

### § 14. Annual report to Congress

The Commissioner shall report to Congress annually the moneys received and expended, statistics concerning the work of the Office, and other information relating to the Office as may be useful to the Congress or the public.

## CHAPTER 2—PROCEEDINGS IN THE PATENT OFFICE

Sec.
21. Day for taking action falling on Saturday, Sunday, or holiday.
22. Printing of papers filed.
23. Testimony in Patent Office cases.
24. Subpoenas, witnesses.

### § 21. Day for taking action falling on Saturday, Sunday, or holiday

When the day, or the last day, for taking any action or paying any fee in the United States Patent Office falls on Saturday, Sunday, or a holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding secular or business day.

### § 22. Printing of papers filed

The Commissioner may require papers filed in the Patent Office to be printed or typewritten.

### § 23. Testimony in Patent Office cases

The Commissioner may establish rules for taking affidavits and depositions required in cases in the Patent Office. Any officer authorized by law to take depositions to be used in the courts of the United States, or of the State where he resides, may take such affidavits and depositions.

### § 24. Subpoenas, witnesses

The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent Office, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent Office.

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Every witness subpoenaed and in attendance shall be allowed the fees and traveling expenses allowed to witnesses attending the United States district courts.

A judge of a court whose clerk issued a subpoena may enforce obedience to the process or punish disobedience as in other like cases, on proof that a witness, served with such subpoena, neglected or refused to appear or to testify. No witness shall be deemed guilty of contempt for disobeying such subpoena unless his fees and traveling expenses in going to, and returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret matter except upon appropriate order of the court which issued the subpoena.

## CHAPTER 3—PRACTICE BEFORE PATENT OFFICE

Sec.
31. Regulations for agents and attorneys.
32. Suspension or exclusion from practice.
33. Unauthorized representation as practitioner.

### § 31. Regulations for agents and attorneys

The Commissioner, subject to the approval of the Secretary of Commerce, may prescribe regulations governing the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Patent Office, and may require them, before being recognized as representatives of applicants or other persons, to show that they are of good moral character and reputation and are possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office.

### § 32. Suspension or exclusion from practice

The Commissioner may, after notice and opportunity for a hearing, suspend or exclude, either generally or in any particular case, from further practice before the Patent Office, any person, agent, or attorney shown to be incompetent or disreputable, or guilty of gross misconduct, or who does not comply with the regulations established under section 31 of this title, or who shall, by word, circular, letter, or advertising, with intent to defraud in any manner, deceive, mislead, or threaten any applicant or prospective applicant, or other person having immediate or prospective business before the Office. The reasons for any such suspension or exclusion shall be duly recorded. The United States District Court for the District of Columbia, under

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h conditions and upon such proceedings as it by its rules determines, y review the action of the Commissioner upon the petition of the son so refused recognition or so suspended or excluded.

**3. Unauthorized representation as practitioner**

Whoever, not being recognized to practice before the Patent Office, ds himself out or permits himself to be held out as so recognized, as being qualified to prepare or prosecute applications for patent, ll be fined not more than $1,000 for each offense.

## CHAPTER 4—PATENT FEES

Patent fees.
Payment of patent fees; return of excess amounts.

**1. Patent fees**

a) The Commissioner shall charge the following fees:

. On filing each application for an original patent, except in ign cases, $30, and $1 for each claim in excess of twenty.

. On issuing each original patent, except in design cases, $30, l $1 for each claim in excess of twenty.

. In design cases: For three years and six months, $10; for seven rs, $15; for fourteen years, $30.

. On every application for the reissue of a patent, $30 and $1 for h claim in excess of twenty over and above the number of claims the original patent.

. On filing each disclaimer, $10.

. On an appeal for the first time from the examiner to the Board Appeals, $25.

. On filing each petition for the revival of an abandoned applica- n for a patent or for the delayed payment of the fee for issuing each tent, $10.

. For certificate of correction of applicant's mistake under sec- n 255 of this title, $10.

. For uncertified printed copies of specifications and drawings patents (except design patents), 25 cents per copy: for design tents, 10 cents per copy; special rate for libraries specified in sec- n 13 of this title, $50 for patents issued in one year.

10. For recording every assignment, agreement, or other paper not ceeding six pages, $3; for each additional two pages or less, $1; r each additional patent or application included in one writing, ere more than one is so included, 50 cents additional.

11. For each certificate, $1.

(b) The Commissioner may establish charges for copies of records,

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publications, or services furnished by the Patent Office, not specified above.

### § 42. Payment of patent fees; return of excess amounts

All patent fees shall be paid to the Commissioner who shall deposit the same in the Treasury of the United States in such manner as the Secretary of the Treasury directs, and the Commissioner may refund any sum paid by mistake or in excess of the fee required by law.

## PART II—PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS


| Chapter | | Sec. |
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### CHAPTER 10—PATENTABILITY OF INVENTIONS


Sec.
100. Definitions.
101. Inventions patentable.
102. Conditions for patentability; novelty and loss of right to patent.
103. Conditions for patentability; non-obvious subject matter.
104. Invention made abroad.


### § 100. Definitions

When used in this title unless the context otherwise indicates—

(a) The term "invention" means invention or discovery.

(b) The term "process" means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.

(c) The terms "United States" and "this country" mean the United States of America, its territories and possessions.

(d) The word "patentee" includes not only the patentee to whom the patent was issued but also the successors in title to the patentee.

### § 101. Inventions patentable

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

### § 102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign

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country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country or an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

**§ 103. Conditions for patentability; non-obvious subject matter**

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**§ 104. Invention made abroad**

In proceedings in the Patent Office and in the courts, an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country, except as provided in section 119 of this



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title. Where an invention was made by a person, civil or military, while domiciled in the United States and serving in a foreign country in connection with operations by or on behalf of the United States, he shall be entitled to the same rights of priority with respect to such invention as if the same had been made in the United States.

## CHAPTER 11—APPLICATION FOR PATENT

Sec.
111. Application for patent.
112. Specification.
113. Drawings.
114. Models, specimens.
115. Oath of applicant.
116. Joint inventors.
117. Death or incapacity of inventor.
118. Filing by other than inventor.
119. Benefit of earlier filing date in foreign country; right of priority.
120. Benefit of earlier filing date in the United States.
121. Divisional applications.
122. Confidential status of applications.

### § 111. Application for patent

Application for patent shall be made by the inventor, except as otherwise provided in this title, in writing to the Commissioner. Such application shall include: (1) a specification as prescribed by section 112 of this title; (2) a drawing as prescribed by section 113 of this title; and (3) an oath by the applicant as prescribed by section 115 of this title. The application must be signed by the applicant and accompanied by the fee required by law.

### § 112. Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

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**§ 113. Drawings**

When the nature of the case admits, the applicant shall furnish a drawing.

**§ 114. Models, specimens**

The Commissioner may require the applicant to furnish a model of convenient size to exhibit advantageously the several parts of his invention.

When the invention relates to a composition of matter, the Commissioner may require the applicant to furnish specimens or ingredients for the purpose of inspection or experiment.

**§ 115. Oath of applicant**

The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by certificate of a diplomatic or consular officer of the United States, and such oath shall be valid if it complies with the laws of the state or country where made. When the application is made as provided in this title by a person other than the inventor, the oath may be so varied in form that it can be made by him.

**§ 116. Joint inventors**

When an invention is made by two or more persons jointly, they shall apply for patent jointly and each sign the application and make the required oath, except as otherwise provided in this title.

If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Commissioner, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor making the application, subject to the same rights which the omitted inventor would have had if he had been joined. The omitted inventor may subsequently join in the application.

Whenever a person is joined in an application for patent as joint inventor through error, or a joint inventor is not included in an appli-

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cation through error, and such error arose without any deceptive intention on his part, the Commissioner may permit the application to be amended accordingly, under such terms as he prescribes.

**§ 117. Death or incapacity of inventor**

Legal representatives of deceased inventors and of those under legal incapacity may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor.

**§ 118. Filing by other than inventor**

Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage; and the Commissioner may grant a patent to such inventor upon such notice to him as the Commissioner deems sufficient, and on compliance with such regulations as he prescribes.

**§ 119. Benefit of earlier filing date in foreign country; right of priority**

An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed; but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing.

No application for patent shall be entitled to this right of priority unless a claim therefor and a certified copy of the original foreign application, specification and drawings upon which it is based are filed

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in the Patent Office before the patent is granted, or at such time during the pendency of the application as required by the Commissioner not earlier than six months after the filing of the application in this country. Such certification shall be made by the patent office of the foreign country in which filed and show the date of the application and of the filing of the specification and other papers. The Commissioner may require a translation of the papers filed if not in the English language and such other information as he deems necessary.

**§ 120. Benefit of earlier filing date in the United States**

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States by the same inventor shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

**§ 121. Divisional applications**

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Commissioner may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Commissioner to require the application to be restricted to one invention.

**§ 122. Confidential status of applications**

Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without author-

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ity of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner.

## CHAPTER 12—EXAMINATION OF APPLICATION

Sec.
131. Examination of application.
132. Notice of rejection; reexamination.
133. Time for prosecuting application.
134. Appeal to the Board of Appeals.
135. Interferences.

### § 131. Examination of application

The Commissioner shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Commissioner shall issue a patent therefor.

### § 132. Notice of rejection; reexamination

Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

### § 133. Time for prosecuting application

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

### § 134. Appeal to the Board of Appeals

An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Appeals, having once paid the fee for such appeal.

### § 135. Interferences

Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The

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question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office.

A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

## CHAPTER 13—REVIEW OF PATENT OFFICE DECISION

Sec.
141. Appeal to Court of Customs and Patent Appeals.
142. Notice of appeal.
143. Proceedings on appeal.
144. Decision on appeal.
145. Civil action to obtain patent.
146. Civil action in case of interference.

### § 141. Appeal to Court of Customs and Patent Appeals

An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Customs and Patent Appeals, thereby waiving his right to proceed under section 145 of this title. A party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority may appeal to the United States Court of Customs and Patent Appeals, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has filed notice of appeal according to section 142 of this title, files notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 146 of this title. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under section 146, in default of which the decision appealed from shall govern the further proceedings in the case.

### § 142. Notice of appeal

When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and shall file in the Patent Office his reasons of appeal, specifically set forth in writing, within such time after the date of the

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decision appealed from, not less than sixty days, as the Commissioner appoints.

**§ 143. Proceedings on appeal**

The United States Court of Customs and Patent Appeals shall, before hearing such appeal, give notice of the time and place of the hearing to the Commissioner and the parties thereto. The Commissioner shall transmit to the court certified copies of all the necessary original papers and evidence in the case specified by the appellant and any additional papers and evidence specified by the appellee and in an ex parte case the Commissioner shall furnish the court with the grounds of the decision of the Patent Office, in writing, touching all the points involved by the reasons of appeal.

**§ 144. Decision on appeal**

The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent Office, and the decision shall be confined to the points set forth in the reasons of appeal. Upon its determination the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and govern the further proceedings in the case.

**§ 145. Civil action to obtain patent**

An applicant dissatisfied with the decision of the Board of Appeals may, unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

**§ 146. Civil action in case of interference**

Any party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority, may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints or as provided in section 141 of this title, unless he has appealed to the United States Court of Customs and Patent Appeals, and such appeal

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is pending or has been decided. In such suits the record in the Patent Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent Office when admitted shall have the same effect as if originally taken and produced in the suit.

Such suit may be instituted against the party in interest as shown by the records of the Patent Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs. The Commissioner shall not be a necessary party but he shall be notified of the filing of the suit by the clerk of the court in which it is filed and shall have the right to intervene. Judgment of the court in favor of the right of an applicant to a patent shall authorize the Commissioner to issue such patent on the filing in the Patent Office of a certified copy of the judgment and on compliance with the requirements of law.

## CHAPTER 14—ISSUE OF PATENT

Sec.
151. Time of issue of patent.
152. Issue of patent to assignee.
153. How issued.
154. Contents and term of patent.

### § 151. Time of issue of patent

The patent shall issue within three months from the date of the payment of the final fee, which shall be paid not later than six months after written notice to the applicant of allowance of the application, but the Commissioner may accept the final fee if paid within one year after the six month period for payment, and the patent shall issue.

### § 152. Issue of patent to assignee

Patents may be granted to the assignee of the inventor of record in the Patent Office, upon the application made and the specification sworn to by the inventor, except as otherwise provided in this title.



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### § 153. How issued

Patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Commissioner or have his signature placed thereon and attested by an officer of the Patent Office designated by the Commissioner, and shall be recorded in the Patent Office.

### § 154. Contents and term of patent

Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the right to exclude others from making, using, or selling the invention throughout the United States, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof.

## CHAPTER 15—PLANT PATENTS

Sec.
161. Patents for plants.
162. Description, claim.
163. Grant.
164. Assistance of Department of Agriculture.

### § 161. Patents for plants

Whoever invents or discovers and asexually reproduces any distinct and new variety of plant, other than a tuberpropagated plant, may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for plants, except as otherwise provided.

### § 162. Description, claim

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible.

The claim in the specification shall be in formal terms to the plant shown and described.

### § 163. Grant

In the case of a plant patent the grant shall be of the right to exclude others from asexually reproducing the plant or selling or using the plant so reproduced.

### § 164. Assistance of Department of Agriculture.

The President may by Executive order direct the Secretary of Agriculture, in accordance with the requests of the Commissioner, for the purpose of carrying into effect the provisions of this title with respect to plants (1) to furnish available information of the Department of Agriculture, (2) to conduct through the appropriate bureau

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or division of the Department research upon special problems, or (3) to detail to the Commissioner officers and employees of the Department.

## CHAPTER 16—DESIGNS

Sec.
171. Patents for designs.
172. Right of priority.
173. Term of design patent.

### § 171. Patents for designs

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

### § 172. Right of priority

The right of priority provided for by section 119 of this title and the time specified in section 102 (d) shall be six months in the case of designs.

### § 173. Term of design patent

Patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant, in his application, elects.

## CHAPTER 17—SECRECY OF CERTAIN INVENTIONS AND FILING APPLICATIONS IN FOREIGN COUNTRY

Sec.
181. Secrecy of certain inventions and withholding of patent.
182. Abandonment of invention for unauthorized disclosure.
183. Right of compensation.
184. Filing of application in foreign country.
185. Patent barred for filing without license.
186. Penalty.
187. Nonapplicability to certain persons.
188. Rules and regulations, delegation of power.

### § 181. Secrecy of certain inventions and withholding of patent

Whenever publication or disclosure by the grant of a patent on an invention in which the Government has a property interest might, in the opinion of the head of the interested Government agency, be detrimental to the national security, the Commissioner upon being so notified shall order that the invention be kept secret and shall withhold the grant of a patent therefor under the conditions set forth hereinafter.

Whenever the publication or disclosure of an invention by the granting of a patent, in which the Government does not have a property interest, might, in the opinion of the Commissioner, be detrimental

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to the national security, he shall make the application for patent in which such invention is disclosed available for inspection to the Atomic Energy Commission, the Secretary of Defense, and the chief officer of any other department or agency of the Government designated by the President as a defense agency of the United States.

Each individual to whom the application is disclosed shall sign a dated acknowledgment thereof, which acknowledgment shall be entered in the file of the application. If, in the opinion of the Atomic Energy Commission, the Secretary of a Defense Department, or the chief officer of another department or agency so designated, the publication or disclosure of the invention by the granting of a patent therefor would be detrimental to the national security, the Atomic Energy Commission, the Secretary of a Defense Department, or such other chief officer shall notify the Commissioner and the Commissioner shall order that the invention be kept secret and shall withhold the grant of a patent for such period as the national interest requires, and notify the applicant thereof. Upon proper showing by the head of the department or agency who caused the secrecy order to be issued that the examination of the application might jeopardize the national interest, the Commissioner shall thereupon maintain the application in a sealed condition and notify the applicant thereof. The owner of an application which has been placed under a secrecy order shall have a right to appeal from the order to the Secretary of Commerce under rules prescribed by him.

An invention shall not be ordered kept secret and the grant of a patent withheld for a period of more than one year. The Commissioner shall renew the order at the end thereof, or at the end of any renewal period, for additional periods of one year upon notification by the head of the department or the chief officer of the agency who caused the order to be issued that an affirmative determination has been made that the national interest continues so to require. An order in effect, or issued, during a time when the United States is at war, shall remain in effect for the duration of hostilities and one year following cessation of hostilities. An order in effect, or issued, during a national emergency declared by the President shall remain in effect for the duration of the national emergency and six months thereafter. The Commissioner may rescind any order upon notification by the heads of the departments and the chief officers of the agencies who caused the order to be issued that the publication or disclosure of the invention is no longer deemed detrimental to the national security.

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**§ 182. Abandonment of invention for unauthorized disclosure**

The invention disclosed in an application for patent subject to an order made pursuant to section 181 of this title may be held abandoned upon its being established by the Commissioner that in violation of said order the invention has been published or disclosed or that an application for a patent therefor has been filed in a foreign country by the inventor, his successors, assigns, or legal representatives, or anyone in privity with him or them, without the consent of the Commissioner. The abandonment shall be held to have occurred as of the time of violation. The consent of the Commissioner shall not be given without the concurrence of the heads of the departments and the chief officers of the agencies who caused the order to be issued. A holding of abandonment shall constitute forfeiture by the applicant, his successors, assigns, or legal representatives, or anyone in privity with him or them, of all claims against the United States based upon such invention.

**§ 183. Right to compensation**

An applicant, his successors, assigns, or legal representatives, whose patent is withheld as herein provided, shall have the right, beginning at the date the applicant is notified that, except for such order, his application is otherwise in condition for allowance, or February 1, 1952, whichever is later, and ending six years after a patent is issued thereon, to apply to the head of any department or agency who caused the order to be issued for compensation for the damage caused by the order of secrecy and/or for the use of the invention by the Government, resulting from his disclosure. The right to compensation for use shall begin on the date of the first use of the invention by the Government. The head of the department or agency is authorized, upon the presentation of a claim, to enter into an agreement with the applicant, his successors, assigns, or legal representatives, in full settlement for the damage and/or use. This settlement agreement shall be conclusive for all purposes not withstanding any other provision of law to the contrary. If full settlement of the claim cannot be effected, the head of the department or agency may award and pay to such applicant, his successors, assigns, or legal representatives, a sum not exceeding 75 per centum of the sum which the head of the department or agency considers just compensation for the damage and/or use. A claimant may bring suit against the United States in the Court of Claims or in the District Court of the United States for the district in which such claimant is a resident for an amount which when added to the award

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shall constitute just compensation for the damage and/or use of the invention by the Government. The owner of any patent issued upon an application that was subject to a secrecy order issued pursuant to section 181 of this title, who did not apply for compensation as above provided, shall have the right, after the date of issuance of such patent, to bring suit in the Court of Claims for just compensation for the damage caused by reason of the order of secrecy and/or use by the Government of the invention resulting from his disclosure. The right to compensation for use shall begin on the date of the first use of the invention by the Government. In a suit under the provisions of this section the United States may avail itself of all defenses it may plead in an action under section 1498 of title 28. This section shall not confer a right of action on anyone or his successors, assigns, or legal representatives who, while in the full-time employment or service of the United States, discovered, invented, or developed the invention on which the claim is based.

**§ 184. Filing of application in foreign country**

Except when authorized by a license obtained from the Commissioner a person shall not file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States an application for patent or for the registration of a utility model, industrial design, or model in respect of an invention made in this country. A license shall not be granted with respect to an invention subject to an order issued by the Commissioner pursuant to section 181 of this title without the concurrence of the head of the departments and the chief officers of the agencies who caused the order to be issued. The license may be granted retroactively where an application has been inadvertently filed abroad and the application does not disclose an invention within the scope of section 181 of this title.

The term "application" when used in this chapter includes applications and any modifications, amendments, or supplements thereto, or divisions thereof.

**§ 185. Patent barred for filing without license**

Notwithstanding any other provisions of law any person, and his successors, assigns, or legal representatives, shall not receive a United States patent for an invention if that person, or his successors, assigns, or legal representatives shall, without procuring the license prescribed in section 184 of this title, have made, or consented to or assisted another's making, application in a foreign country for a patent or for the registration of a utility model, industrial design, or model in

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respect of the invention. A United States patent issued to such person, his successors, assigns, or legal representatives shall be invalid.

### § 186. Penalty

Whoever, during the period or periods of time an invention has been ordered to be kept secret and the grant of a patent thereon withheld pursuant to section 181 of this title, shall, with knowledge of such order and without due authorization, willfully publish or disclose or authorize or cause to be published or disclosed the invention, or material information with respect thereto, or whoever, in violation of the provisions of section 184 of this title, shall file or cause or authorize to be filed in any foreign country an application for patent or for the registration of a utility model, industrial design, or model in respect of any invention made in the United States, shall, upon conviction, be fined not more than $10,000 or imprisoned for not more than two years, or both.

### § 187. Nonapplicability to certain persons

The prohibitions and penalties of this chapter shall not apply to any officer or agent of the United States acting within the scope of his authority, nor to any person acting upon his written instructions or permission.

### § 188. Rules and regulations, delegation of power

The Atomic Energy Commission, the Secretary of a defense department, the chief officer of any other department or agency of the Government designated by the President as a defense agency of the United States, and the Secretary of Commerce, may separately issue rules and regulations to enable the respective department or agency to carry out the provisions of this chapter, and may delegate any power conferred by this chapter.

## PART III—PATENTS AND PROTECTION OF PATENT RIGHTS


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## CHAPTER 25—AMENDMENT AND CORRECTION OF PATENTS


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**§ 251. Reissue of defective patents**

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Commissioner may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

**§ 252. Effect of reissue**

The surrender of the original patent shall take effect upon the issue of the reissued patent, and every reissued patent shall have the same effect and operation in law, on the trial of actions for causes thereafter arising, as if the same had been originally granted in such amended form, but in so far as the claims of the original and reissued patents are identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent, to the extent that its claims are identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent.

No reissued patent shall abridge or affect the right of any person or his successors in business who made, purchased or used prior to the grant of a reissue any[illegible] patented by the reissued patent, to continue the use of, or to se[illegible]others to be used or sold, the specific thing so made, purchased or used, unless the making, using or selling of such thing infringes a valid claim of the reissued patent which was in the original patent. The court before which such matter is in question

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may provide for the continued manufacture, use or sale of the thing made, purchased or used as specified, or for the manufacture, use or sale of which substantial preparation was made before the grant of the reissue, and it may also provide for the continued practice of any process patented by the reissue, practiced, or for the practice of which substantial preparation was made, prior to the grant of the reissue, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before the grant of the reissue.

**§ 253. Disclaimer**

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, and recorded in the Patent Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

**§ 254. Certificate of correction of Patent Office mistake**

Whenever a mistake in a patent, incurred through the fault of the Patent Office, is clearly disclosed by the records of the Office the Commissioner may issue a certificate of correction stating the fact and nature of such mistake, under seal, without charge, to be recorded in the records of patents. A printed copy thereof shall be attached to each printed copy of the patent, and such certificate shall be considered as part of the original patent. Every such patent, together with such certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form. The Commissioner may issue a corrected patent without charge in lieu of and with like effect as a certificate of correction.

**§ 255. Certificate of correction of applicant's mistake**

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Commissioner may, upon payment of the required

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fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require re-examination. Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form.

### § 256. Misjoinder of inventor

Whenever a patent is issued on the application of persons as joint inventors and it appears that one of such persons was not in fact a joint inventor, and that he was included as a joint inventor by error and without any deceptive intention, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate deleting the name of the erroneously joined person from the patent.

Whenever a patent is issued and it appears that a person was a joint inventor, but was omitted by error and without deceptive intention on his part, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate adding his name to the patent as a joint inventor.

The misjoinder or nonjoinder of joint inventors shall not invalidate a patent, if such error can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Commissioner shall issue a certificate accordingly.

## CHAPTER 26—OWNERSHIP AND ASSIGNMENT

Sec.
261. Ownership; assignment.
262. Joint owners.

### § 261. Ownership; assignment

Subject to the provisions of this title, patents shall have the attributes of personal property.

Applications for patent, patents, or any interest therein, shall be assignable in law by an instrument in writing. The applicant, patentee, or his assigns or legal representatives may in like manner grant and convey an exclusive right under his application for patent, or patents, to the whole or any specified part of the United States.

A certificate of acknowledgment under the hand and official seal of a person authorized to administer oaths within the United States, or, in a foreign country, of a diplomatic or consular officer of the

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United States or an officer authorized to administer oaths whose authority is proved by a certificate of a diplomatic or consular officer of the United States, shall be prima facie evidence of the execution of an assignment, grant or conveyance of a patent or application for patent.

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 its date or prior to the date of such subsequent purchase or mortgage.

### § 262. Joint owners

In the absence of any agreement to the contrary, each of the joint owners of a patent may make, use or sell the patented invention without the consent of and without accounting to the other owners.

## CHAPTER 27—GOVERNMENT INTERESTS IN PATENTS

Sec.
266. Issue of patents without fees to Government employees.
267. Time for taking action in Government applications.

### § 266. Issue of patents without fees to Government employees

The Commissioner may grant, subject to the provisions of this title, to any officer, enlisted man, or employee of the Government, except officers and employees of the Patent Office, a patent without the payment of fees, when the head of a department or agency certifies the invention is used or likely to be used in the public interest and the applicant in his application states that the invention described therein, if patented, may be manufactured and used by or for the Government for governmental purposes without the payment to him of any royalty thereon, which stipulation shall be included in the patent.

### § 267. Time for taking action in Government applications

Notwithstanding the provisions of sections 133 and 151 of this title, the Commissioner may extend the time for taking any action to three years, when an application has become the property of the United States and the head of the appropriate department or agency of the Government has certified to the Commissioner that the invention disclosed therein is important to the armament or defense of the United States.

## CHAPTER 28—INFRINGEMENT OF PATENTS

Sec.
271. Infringement of patent.
272. Temporary presence in the United States.

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**§ 271. Infringement of patent**

(a) Except as otherwise provided in this title, whoever without authority makes, uses or sells any patented invention, within the United States during the term of the patent therefor, infringes the patent.

(b) Whoever actively induces infringement of a patent shall be liable as an infringer.

(c) Whoever sells a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.

(d) No patent owner otherwise entitled to relief for infringement or contributory infringement of a patent shall be denied relief or deemed guilty of misuse or illegal extension of the patent right by reason of his having done one or more of the following: (1) derived revenue from acts which if performed by another without his consent would constitute contributory infringement of the patent; (2) licensed or authorized another to perform acts which if performed without his consent would constitute contributory infringement of the patent; (3) sought to enforce his patent rights against infringement or contributory infringement.

**§ 272. Temporary presence in the United States**

The use of any invention in any vessel, aircraft or vehicle of any country which affords similar privileges to vessels, aircraft or vehicles of the United States, entering the United States temporarily or accidentally, shall not constitute infringement of any patent, if the invention is used exclusively for the needs of the vessel, aircraft or vehicle and is not sold in or used for the manufacture of anything to be sold in or exported from the United States.

## CHAPTER 29—REMEDIES FOR INFRINGEMENT OF PATENT, AND OTHER ACTIONS

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281. Remedy for infringement of patent.
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284. Damages.
285. Attorney fees.
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Sec.
290. Notice of patent suits.
291. Interfering patents.
292. False marking.
293. Nonresident patentee, service and notice.

**§ 281. Remedy for infringement of patent**

A patentee shall have remedy by civil action for infringement of his patent.

**§ 282. Presumption of validity; defenses**

A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it.

The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

(1) Noninfringement or absence of liability for infringement,

(2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability,

(3) Invalidity of the patent or any claim in suit for failure to comply with any requirement of sections 112 or 251 of this title,

(4) Any other fact or act made a defense by this title.

In actions involving the validity or infringement of a patent the party asserting invalidity or noninfringement shall give notice in the pleadings or otherwise in writing to the adverse party at least thirty days before the trial, of the country, number, date, and name of the patentee of any patent, the title, date, and page numbers of any publication to be relied upon as anticipation of the patent in suit or, except in actions in the United States Court of Claims, as showing the state of the art, and the name and address of any person who may be relied upon as the prior inventor or as having prior knowledge of or as having previously used or offered for sale the invention of the patent in suit. In the absence of such notice proof of the said matters may not be made at the trial except on such terms as the court requires.

**§ 283. Injunction**

The several courts having jurisdiction of cases under this title may grant injunctions in accordance with the principles of equity to prevent the violation of any right secured by patent, on such terms as the court deems reasonable.

**§ 284. Damages**

Upon adjudging a patent valid and infringed, the court shall award the claimant damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court.

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When the damages are not found by a jury, the court shall assess them. In either event the court may increase the damages up to three times the amount found or assessed.

The court may receive expert testimony as an aid to the determination of damages or of what royalty would be reasonable under the circumstances.

**§ 285. Attorney fees**

The court in exceptional cases may award reasonable attorney fees to the prevailing party.

**§ 286. Time limitation on damages**

Except as otherwise provided by law, no recovery shall be had for any infringement committed more than six years prior to the filing of the complaint or counterclaim for infringement in the action.

In the case of claims against the United States Government for use of a patented invention, the period before bringing suit, up to six years, between the date of receipt of a written claim for compensation by the department or agency of the Government having authority to settle such claim, and the date of mailing by the Government of a notice to the claimant that his claim has been denied shall not be counted as part of the period referred to in the preceding paragraph.

**§ 287. Limitation on damages; marking and notice**

Patentees, and persons making or selling any patented article for or under them, may give notice to the public that the same is patented, either by fixing thereon the word "patent" or the abbreviation "pat.", together with the number of the patent, or when, from the character of the article, this can not be done, by fixing to it, or to the package wherein one or more of them is contained, a label containing a like notice. In the event of failure so to mark, no damages shall be recovered by the patentee in any action for infringement, except on proof that the infringer was notified of the infringement and continued to infringe thereafter, in which event damages may be recovered only for infringement occurring after such notice. Filing of an action for infringement shall constitute such notice.

**§ 288. Action for infringement of a patent containing an invalid claim**

Whenever, without deceptive intention, a claim of a patent is invalid, an action may be maintained for the infringement of a claim of the patent which may be valid. The patentee shall recover no costs unless a disclaimer of the invalid claim has been entered at the Patent Office before the commencement of the suit.

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**§ 289. Additional remedy for infringement of design patent**

Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit, but not less than $250, recoverable in any United States district court having jurisdiction of the parties.

Nothing in this section shall prevent, lessen, or impeach any other remedy which an owner of an infringed patent has under the provisions of this title, but he shall not twice recover the profit made from the infringement.

**§ 290. Notice of patent suits**

The clerks of the courts of the United States, within one month after the filing of an action under this title shall give notice thereof in writing to the Commissioner, setting forth so far as known the names and addresses of the parties, name of the inventor, and the designating number of the patent upon which the action has been brought. If any other patent is subsequently included in the action he shall give like notice thereof. Within one month after the decision is rendered or a judgment issued the clerk of the court shall give notice thereof to the Commissioner. The Commissioner shall, on receipt of such notices, enter the same in the file of such patent.

**§ 291. Interfering patents**

The owner of an interfering patent may have relief against the owner of another by civil action, and the court may adjudge the question of the validity of any of the interfering patents, in whole or in part. The provisions of the second paragraph of section 146 of this title shall apply to actions brought under this section.

**§ 292. False marking**

(a) Whoever, without the consent of the patentee, marks upon, or affixes to, or uses in advertising in connection with anything made, used, or sold by him, the name or any imitation of the name of the patentee, the patent number, or the words "patent," "patentee," or the like, with the intent of counterfeiting or imitating the mark of the patentee, or of deceiving the public and inducing them to believe that the thing was made or sold by or with the consent of the patentee; or

Whoever marks upon, or affixes to, or uses in advertising in connection with any unpatented article, the word "patent" or any word or

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number importing that the same is patented, for the purpose of deceiving the public; or

Whoever marks upon, or affixes to, or uses in advertising in connection with any article, the words "patent applied for," "patent pending," or any word importing that an application for patent has been made, when no application for patent has been made, or if made, is not pending, for the purpose of deceiving the public—

Shall be fined not more than $500 for every such offense.

(b) Any person may sue for the penalty, in which event one-half shall go to the person suing and the other to the use of the United States.

**§ 293. Nonresident patentee; service and notice**

Every patentee not residing in the United States may file in the Patent Office a written designation stating the name and address of a person residing within the United States on whom may be served process or notice of proceedings affecting the patent or rights thereunder. If the person designated cannot be found at the address given in the last designation, or if no person has been designated, the United States District Court for the District of Columbia shall have jurisdiction and summons shall be served by publication or otherwise as the court directs. The court shall have the same jurisdiction to take any action respecting the patent or rights thereunder that it would have if the patentee were personally within the jurisdiction of the court.

SEC. 2. Section 21 of the Act approved July 5, 1946, 60 Stat. 435, (United States Code, title 15, sec. 1071, 1946 ed.) is amended by striking out "Revised Statutes 4911" and inserting "35 United States Code, section 141"; by striking out "section 4915, Revised Statutes" and inserting "35 United States Code, sections 145 and 146"; and by striking out "Revised Statutes 4915" appearing twice in said section and inserting "35 United States Code, section 146".

SEC. 3. If any provision of Title 35, as enacted by section 1 hereof, is declared unconstitutional or is held invalid, the validity of the remainder of this title shall not be affected.

SEC. 4. (a) This Act shall take effect on January 1, 1953 and shall apply to all applications for patent filed on or after such date and to all patents granted on such applications. It shall apply to further proceedings on applications pending on such date and to patents granted

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on such applications except as otherwise provided. It shall apply to unexpired patents granted prior to such date except as otherwise provided.

(b) Section 102 (d) of Title 35, as enacted by section 1 hereof, shall not apply to existing patents and pending applications, but the law previously in effect, namely the first paragraph of R. S. 4887 (U. S. Code, title 35, sec. 32, first paragraph, 1946 ed.), shall apply to such patents and applications.

(c) Section 119, second paragraph, of Title 35 as enacted by section 1 hereof shall not apply to existing patents.

(d) The period of one year specified in section 102 (b) of Title 35 as enacted by section 1 hereof shall not apply in the case of applications filed before August 5, 1940, and patents granted on such applications, and with respect to such applications and patents, said period is two years instead of one year.

(e) Nothing contained in Title 35, as enacted by section 1 hereof, shall operate to nullify any judicial finding prior to the effective date of this Act on the validity of any patent by a court of competent jurisdiction.

(f) Nothing in Title 35, as enacted by section 1 hereof, shall affect any provision of the Atomic Energy Act of 1946 (Aug. 1, 1946, ch. 724, 60 Stat. 755).

(g) The period of one year specified in section 4 of Title 35 as enacted by section 1 hereof shall not apply in the case of applications filed before the effective date of this Act.

(h) The repeal of sections 1–9, 11, 12 of the Act of Congress approved February 1, 1952 (ch. 4, 66 Stat. 3), shall not affect any rights or liabilities existing on the date of approval of this Act. An order of secrecy issued under or in effect under the repealed Act and in effect on the date of approval of this Act, shall be considered as issued under this Act, and any claims arising under the repealed Act or subject to presentation and determination pursuant thereto and unsettled as of the effective date of this Act, may be presented and determined pursuant to the provisions of this Act.

SEC. 5. The sections or parts thereof of the Revised Statutes or Statutes at Large enumerated in the following schedule are hereby repealed. Any rights or liabilities now existing under such sections or parts thereof shall not be affected by this repeal.

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| 1921—Mar. 3 | 126 | 1 | 41 | 1313 | 35 | 80. |
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| | | 6 | | 391 | 35 | 47. |
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[1] The part relating to the granting of patents to Government employees without fees.
[2] The part relating to certified copies of drawings and specifications.
[3] The part relating to fees for recording assignments.
[4] The part amending R. S. 4894.
[5] The part relating to the price of copies of patents.
[6] The part relating to payment of fees.
[7] The part relating to the fee for copies of specifications and drawings of patents.

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Union Calendar No. 594

82D CONGRESS
2D SESSION

# H. R. 7794

[Report No. 1923]

# A BILL

To revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents".

By Mr. BRYSON

MAY 12, 1952

Referred to the Committee on the Judiciary

MAY 12, 1952

Committed to the Committee of the Whole House on the State of the Union and ordered to be printed

82D CONGRESS
2D SESSION

# H. R. 7794

IN THE SENATE OF THE UNITED STATES

MAY 20 (legislative day, MAY 12), 1052

Read twice and referred to the Committee on the Judiciary

# AN ACT

To revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents".

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That title 35 of the United States Code, entitled "Patents", is revised, codified, and enacted into law, and may be cited, "Title 35, United States Code, section—", as follows:

## TITLE 35—PATENTS


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## PART I—PATENT OFFICE


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## CHAPTER 1—ESTABLISHMENT, OFFICERS, FUNCTIONS

Sec.

1. Establishment.
2. Seal.
3. Officers and employees.
4. Restrictions on officers and employees as to interest in patents.
5. Bond of Commissioner and other officers.
6. Duties of Commissioner.
7. Board of Appeals.
8. Library.
9. Classification of patents.
10. Certified copies of records.
11. Publications.
12. Exchange of copies of patents with foreign countries.
13. Copies of patents for public libraries.
14. Annual report to Congress.

### § 1. Establishment

The Patent Office shall continue as an office in the Department of Commerce, where records, books, drawings, specifications, and other papers and things pertaining to patents and to trade-mark registrations shall be kept and preserved, except as otherwise provided by law.

### § 2. Seal

The Patent Office shall have a seal with which letters patent, certificates of trade-mark registrations, and papers issued from the Office shall be authenticated.

### § 3. Officers and employees

A Commissioner of Patents, one first assistant commissioner, two assistant commissioners, and nine examiners-in-chief, shall be appointed by the President, by and with the advice and consent of the Senate. The assistant commissioners shall perform the duties pertaining to the office of commissioner assigned to them by the Commissioner. The first assistant commissioner, or, in the event of a vacancy in that office, the assistant commissioner senior in date of appointment, shall fill the office of Commissioner during a vacancy in that office until a Commissioner is appointed and takes office. The Secretary of Commerce, upon the nomination of the Commissioner in accordance with law, shall appoint all other officers and employees.

The Secretary of Commerce may vest in himself the functions of the Patent Office and its officers and employees specified in this title and may from time to time authorize their performance by any other officer or employee.

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**§ 4. Restrictions on officers and employees as to interest in patents**

Officers and employees of the Patent Office shall be incapable, during the period of their appointments and for one year thereafter, of applying for a patent and of acquiring, directly or indirectly, except by inheritance or bequest, any patent or any right or interest in any patent, issued or to be issued by the Office. In patents applied for thereafter they shall not be entitled to any priority date earlier than one year after the termination of their appointment.

**§ 5. Bond of Commissioner and other officers**

The Commissioner and such other officers as he designates, before entering upon their duties, shall severally give bond, with sureties, the former in the sum of $10,000, and the latter in sums prescribed by the Commissioner, conditioned for the faithful discharge of their respective duties and that they shall render to the proper officers of the Treasury a true account of all money received by virtue of their offices.

**§ 6. Duties of Commissioner**

The Commissioner, under the direction of the Secretary of Commerce, shall superintend or perform all duties required by law respecting the granting and issuing of patents and the registration of trademarks; and he shall have charge of property belonging to the Patent Office. He may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

**§ 7. Board of Appeals**

The examiners-in-chief shall be persons of competent legal knowledge and scientific ability. The Commissioner, the assistant commissioners, and the examiners-in-chief shall constitute a Board of Appeals, which, on written appeal of the applicant, shall review adverse decisions of examiners upon applications for patents. Each appeal shall be heard by at least three members of the Board of Appeals, the members hearing such appeal to be designated by the Commissioner. The Board of Appeals has sole power to grant rehearings.

Whenever the Commissioner considers it necessary to maintain the work of the Board of Appeals current, he may designate any patent

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examiner of the primary examiner grade or higher, having the requisite ability, to serve as examiner-in-chief for periods not exceeding six months each. An examiner so designated shall be qualified to act as a member of the Board of Appeals. Not more than one such primary examiner shall be a member of the Board of Appeals hearing an appeal.

**§ 8. Library**

The Commissioner shall maintain a library of scientific and other works and periodicals, both foreign and domestic, in the Patent Office to aid the officers in the discharge of their duties.

**§ 9. Classification of patents**

The Commissioner may revise and maintain the classification by subject matter of United States letters patent, and such other patents and printed publications as may be necessary or practicable, for the purpose of determining with readiness and accuracy the novelty of inventions for which applications for patent are filed.

**§ 10. Certified copies of records**

The Commissioner may furnish certified copies of specifications and drawings of patents issued by the Patent Office, and of other records available either to the public or to the person applying therefor.

**§ 11. Publications**

(a) The Commissioner may print, or cause to be printed, the following:

1. Patents, including specifications and drawings, together with copies of the same. The Patent Office may print the headings of the drawings for patents for the purpose of photolithography.

2. Certificates of trade-mark registrations, including statements and drawings, together with copies of the same.

3. The Official Gazette of the United States Patent Office.

4. Annual indexes of patents and patentees, and of trade-marks and registrants.

5. Annual volumes of decisions in patent and trade-mark cases.

6. Pamphlet copies of the patent laws and rules of practice, laws and rules relating to trade-marks, and circulars or other publications relating to the business of the Office.

(b) The Commissioner may exchange any of the publications specified in items 3, 4, 5, and 6 of subsection (a) of this section for publications desirable for the use of the Patent Office.

**§ 12. Exchange of copies of patents with foreign countries**

The Commissioner may exchange copies of specifications and drawings of United States patents for those of foreign countries.

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### § 13. Copies of patents for public libraries

The Commissioner may supply printed copies of specifications and drawings of patents to public libraries in the United States which shall maintain such copies for the use of the public, at the rate for each year's issue established for this purpose in section 41 (a) 9 of this title.

### § 14. Annual report to Congress

The Commissioner shall report to Congress annually the moneys received and expended, statistics concerning the work of the Office, and other information relating to the Office as may be useful to the Congress or the public.

## CHAPTER 2—PROCEEDINGS IN THE PATENT OFFICE

Sec.
21. Day for taking action falling on Saturday, Sunday, or holiday.
22. Printing of papers filed.
23. Testimony in Patent Office cases.
24. Subpoenas, witnesses.

### § 21. Day for taking action falling on Saturday, Sunday, or holiday

When the day, or the last day, for taking any action or paying any fee in the United States Patent Office falls on Saturday, Sunday, or a holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding secular or business day.

### § 22. Printing of papers filed

The Commissioner may require papers filed in the Patent Office to be printed or typewritten.

### § 23. Testimony in Patent Office cases

The Commissioner may establish rules for taking affidavits and depositions required in cases in the Patent Office. Any officer authorized by law to take depositions to be used in the courts of the United States, or of the State where he resides, may take such affidavits and depositions.

### § 24. Subpoenas, witnesses

The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent Office, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent Office.

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Every witness subpoenaed and in attendance shall be allowed the fees and traveling expenses allowed to witnesses attending the United States district courts.

A judge of a court whose clerk issued a subpoena may enforce obedience to the process or punish disobedience as in other like cases, on proof that a witness, served with such subpoena, neglected or refused to appear or to testify. No witness shall be deemed guilty of contempt for disobeying such subpoena unless his fees and traveling expenses in going to, and returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret matter except upon appropriate order of the court which issued the subpoena.

## CHAPTER 3—PRACTICE BEFORE PATENT OFFICE

Sec.
31. Regulations for agents and attorneys.
32. Suspension or exclusion from practice.
33. Unauthorized representation as practitioner.

### § 31. Regulations for agents and attorneys

The Commissioner, subject to the approval of the Secretary of Commerce, may prescribe regulations governing the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Patent Office, and may require them, before being recognized as representatives of applicants or other persons, to show that they are of good moral character and reputation and are possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office.

### § 32. Suspension or exclusion from practice

The Commissioner may, after notice and opportunity for a hearing, suspend or exclude, either generally or in any particular case, from further practice before the Patent Office, any person, agent, or attorney shown to be incompetent or disreputable, or guilty of gross misconduct, or who does not comply with the regulations established under section 31 of this title, or who shall, by word, circular, letter, or advertising, with intent to defraud in any manner, deceive, mislead, or threaten any applicant or prospective applicant, or other person having immediate or prospective business before the Office. The reasons for any such suspension or exclusion shall be duly recorded. The United States District Court for the District of Columbia, under

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such conditions and upon such proceedings as it by its rules determines, may review the action of the Commissioner upon the petition of the person so refused recognition or so suspended or excluded.

### § 33. Unauthorized representation as practitioner

Whoever, not being recognized to practice before the Patent Office, holds himself out or permits himself to be held out as so recognized, or as being qualified to prepare or prosecute applications for patent, shall be fined not more than $1,000 for each offense.

## CHAPTER 4—PATENT FEES

Sec.
41. Patent fees.
42. Payment of patent fees; return of excess amounts.

### § 41. Patent fees

(a) The Commissioner shall charge the following fees:

1. On filing each application for an original patent, except in design cases, $30, and $1 for each claim in excess of twenty.

2. On issuing each original patent, except in design cases, $30, and $1 for each claim in excess of twenty.

3. In design cases: For three years and six months, $10; for seven years, $15; for fourteen years, $30.

4. On every application for the reissue of a patent, $30 and $1 for each claim in excess of twenty over and above the number of claims of the original patent.

5. On filing each disclaimer, $10.

6. On an appeal for the first time from the examiner to the Board of Appeals, $25.

7. On filing each petition for the revival of an abandoned application for a patent or for the delayed payment of the fee for issuing each patent, $10.

8. For certificate of correction of applicant's mistake under section 255 of this title, $10.

9. For uncertified printed copies of specifications and drawings of patents (except design patents), 25 cents per copy; for design patents, 10 cents per copy; special rate for libraries specified in section 13 of this title, $50 for patents issued in one year.

10. For recording every assignment, agreement, or other paper not exceeding six pages, $3; for each additional two pages or less, $1; for each additional patent or application included in one writing, where more than one is so included, 50 cents additional.

11. For each certificate, $1.

(b) The Commissioner may establish charges for copies of records,

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publications, or services furnished by the Patent Office, not specified above.

### § 42. Payment of patent fees; return of excess amounts

All patent fees shall be paid to the Commissioner who shall deposit the same in the Treasury of the United States in such manner as the Secretary of the Treasury directs, and the Commissioner may refund any sum paid by mistake or in excess of the fee required by law.

## PART II—PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS


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### CHAPTER 10—PATENTABILITY OF INVENTIONS


Sec.
100. Definitions.
101. Inventions patentable.
102. Conditions for patentability; novelty and loss of right to patent.
103. Conditions for patentability; non-obvious subject matter.
104. Invention made abroad.


### § 100. Definitions

When used in this title unless the context otherwise indicates—

(a) The term "invention" means invention or discovery.

(b) The term "process" means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.

(c) The terms "United States" and "this country" mean the United States of America, its territories and possessions.

(d) The word "patentee" includes not only the patentee to whom the patent was issued but also the successors in title to the patentee.

### § 101. Inventions patentable

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

### § 102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign

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country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country or an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

**§ 103. Conditions for patentability; non-obvious subject matter**

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**§ 104. Invention made abroad**

In proceedings in the Patent Office and in the courts, an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country, except as provided in section 119 of this



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title. Where an invention was made by a person, civil or military, while domiciled in the United States and serving in a foreign country in connection with operations by or on behalf of the United States, he shall be entitled to the same rights of priority with respect to such invention as if the same had been made in the United States.

## CHAPTER 11—APPLICATION FOR PATENT

Sec.
111. Application for patent.
112. Specification.
113. Drawings.
114. Models, specimens.
115. Oath of applicant.
116. Joint inventors.
117. Death or incapacity of inventor.
118. Filing by other than inventor.
119. Benefit of earlier filing date in foreign country; right of priority.
120. Benefit of earlier filing date in the United States.
121. Divisional applications.
122. Confidential status of applications.

### § 111. Application for patent

Application for patent shall be made by the inventor, except as otherwise provided in this title, in writing to the Commissioner. Such application shall include: (1) a specification as prescribed by section 112 of this title; (2) a drawing as prescribed by section 113 of this title; and (3) an oath by the applicant as prescribed by section 115 of this title. The application must be signed by the applicant and accompanied by the fee required by law.

### § 112. Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

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§ 113. Drawings

When the nature of the case admits, the applicant shall furnish a drawing.

§ 114. Models, specimens

The Commissioner may require the applicant to furnish a model of convenient size to exhibit advantageously the several parts of his invention.

When the invention relates to a composition of matter, the Commissioner may require the applicant to furnish specimens or ingredients for the purpose of inspection or experiment.

§ 115. Oath of applicant

The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by certificate of a diplomatic or consular officer of the United States, and such oath shall be valid if it complies with the laws of the state or country where made. When the application is made as provided in this title by a person other than the inventor, the oath may be so varied in form that it can be made by him.

§ 116. Joint inventors

When an invention is made by two or more persons jointly, they shall apply for patent jointly and each sign the application and make the required oath, except as otherwise provided in this title.

If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Commissioner, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor making the application, subject to the same rights which the omitted inventor would have had if he had been joined. The omitted inventor may subsequently join in the application.

Whenever a person is joined in an application for patent as joint inventor through error, or a joint inventor is not included in an appli-

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cation through error, and such error arose without any deceptive intention on his part, the Commissioner may permit the application to be amended accordingly, under such terms as he prescribes.

**§ 117. Death or incapacity of inventor**

Legal representatives of deceased inventors and of those under legal incapacity may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor.

**§ 118. Filing by other than inventor**

Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage; and the Commissioner may grant a patent to such inventor upon such notice to him as the Commissioner deems sufficient, and on compliance with such regulations as he prescribes.

**§ 119. Benefit of earlier filing date in foreign country; right of priority**

An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed; but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing.

No application for patent shall be entitled to this right of priority unless a claim therefor and a certified copy of the original foreign application, specification and drawings upon which it is based are filed

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in the Patent Office before the patent is granted, or at such time during the pendency of the application as required by the Commissioner not earlier than six months after the filing of the application in this country. Such certification shall be made by the patent office of the foreign country in which filed and show the date of the application and of the filing of the specification and other papers. The Commissioner may require a translation of the papers filed if not in the English language and such other information as he deems necessary.

**§ 120. Benefit of earlier filing date in the United States**

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States by the same inventor shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

**§ 121. Divisional applications**

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Commissioner may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Commissioner to require the application to be restricted to one invention.

**§ 122. Confidential status of applications**

Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without author-

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ity of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner.

## CHAPTER 12—EXAMINATION OF APPLICATION

Sec.
131. Examination of application.
132. Notice of rejection; reexamination.
133. Time for prosecuting application.
134. Appeal to the Board of Appeals.
135. Interferences.

### § 131. Examination of application

The Commissioner shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Commissioner shall issue a patent therefor.

### § 132. Notice of rejection; reexamination

Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

### § 133. Time for prosecuting application

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

### § 134. Appeal to the Board of Appeals

An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Appeals, having once paid the fee for such appeal.

### § 135. Interferences

Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The

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question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office.

A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

## CHAPTER 13—REVIEW OF PATENT OFFICE DECISION

Sec.
141. Appeal to Court of Customs and Patent Appeals.
142. Notice of appeal.
143. Proceedings on appeal
144. Decision on appeal.
145. Civil action to obtain patent.
146. Civil action in case of interference.

### § 141. Appeal to Court of Customs and Patent Appeals

An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Customs and Patent Appeals, thereby waiving his right to proceed under section 145 of this title. A party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority may appeal to the United States Court of Customs and Patent Appeals, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has filed notice of appeal according to section 142 of this title, files notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 146 of this title. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under section 146, in default of which the decision appealed from shall govern the further proceedings in the case.

### § 142. Notice of appeal

When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and shall file in the Patent Office his reasons of appeal, specifically set forth in writing, within such time after the date of the

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decision appealed from, not less than sixty days, as the Commissioner appoints.

**§ 143. Proceedings on appeal**

The United States Court of Customs and Patent Appeals shall, before hearing such appeal, give notice of the time and place of the hearing to the Commissioner and the parties thereto. The Commissioner shall transmit to the court certified copies of all the necessary original papers and evidence in the case specified by the appellant and any additional papers and evidence specified by the appellee and in an ex parte case the Commissioner shall furnish the court with the grounds of the decision of the Patent Office, in writing, touching all the points involved by the reasons of appeal.

**§ 144. Decision on appeal**

The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent Office, and the decision shall be confined to the points set forth in the reasons of appeal. Upon its determination the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and govern the further proceedings in the case.

**§. 145. Civil action to obtain patent .**

An applicant dissatisfied with the decision of the Board of Appeals may, unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

**§ 146. Civil action in case of interference**

Any party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority, may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints or as provided in section 141 of this title, unless he has appealed to the United States Court of Customs and Patent Appeals, and such appeal

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is pending or has been decided. In such suits the record in the Patent Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent Office when admitted shall have the same effect as if originally taken and produced in the suit.

Such suit may be instituted against the party in interest as shown by the records of the Patent Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs. The Commissioner shall not be a necessary party but he shall be notified of the filing of the suit by the clerk of the court in which it is filed and shall have the right to intervene. Judgment of the court in favor of the right of an applicant to a patent shall authorize the Commissioner to issue such patent on the filing in the Patent Office of a certified copy of the judgment and on compliance with the requirements of law.

## CHAPTER 14—ISSUE OF PATENT

Sec.
151. Time of issue of patent.
152. Issue of patent to assignee.
153. How issued.
154. Contents and term of patent.

### § 151. Time of issue of patent

The patent shall issue within three months from the date of the payment of the final fee, which shall be paid not later than six months after written notice to the applicant of allowance of the application, but the Commissioner may accept the final fee if paid within one year after the six month period for payment, and the patent shall issue.

### § 152. Issue of patent to assignee

Patents may be granted to the assignee of the inventor of record in the Patent Office, upon the application made and the specification sworn to by the inventor, except as otherwise provided in this title.



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§ 153. How issued

Patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Commissioner or have his signature placed thereon and attested by an officer of the Patent Office designated by the Commissioner, and shall be recorded in the Patent Office.

§ 154. Contents and term of patent

Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the right to exclude others from making, using, or selling the invention throughout the United States, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof.

## CHAPTER 15—PLANT PATENTS

Sec.
161. Patents for plants.
162. Description, claim.
163. Grant.
164. Assistance of Department of Agriculture.

§ 161. Patents for plants

Whoever invents or discovers and asexually reproduces any distinct and new variety of plant, other than a tuberpropagated plant, may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for plants, except as otherwise provided.

§ 162. Description, claim

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible.

The claim in the specification shall be in formal terms to the plant shown and described.

§ 163. Grant

In the case of a plant patent the grant shall be of the right to exclude others from asexually reproducing the plant or selling or using the plant so reproduced.

§ 164. Assistance of Department of Agriculture.

The President may by Executive order direct the Secretary of Agriculture, in accordance with the requests of the Commissioner, for the purpose of carrying into effect the provisions of this title with respect to plants (1) to furnish available information of the Department of Agriculture, (2) to conduct through the appropriate bureau

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or division of the Department research upon special problems, or (3) to detail to the Commissioner officers and employees of the Department.

## CHAPTER 16—DESIGNS

Sec.
171. Patents for designs.
172. Right of priority.
173. Term of design patent.

### § 171. Patents for designs

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

### § 172. Right of priority

The right of priority provided for by section 119 of this title and the time specified in section 102 (d) shall be six months in the case of designs.

### § 173. Term of design patent

Patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant, in his application, elects.

## CHAPTER 17—SECRECY OF CERTAIN INVENTIONS AND FILING APPLICATIONS IN FOREIGN COUNTRY

Sec.
181. Secrecy of certain inventions and withholding of patent.
182. Abandonment of invention for unauthorized disclosure.
183. Right of compensation.
184. Filing of application in foreign country.
185. Patent barred for filing without license.
186. Penalty.
187. Nonapplicability to certain persons.
188. Rules and regulations, delegation of power.

### § 181. Secrecy of certain inventions and withholding of patent

Whenever publication or disclosure by the grant of a patent on an invention in which the Government has a property interest might, in the opinion of the head of the interested Government agency, be detrimental to the national security, the Commissioner upon being so notified shall order that the invention be kept secret and shall withhold the grant of a patent therefor under the conditions set forth hereinafter.

Whenever the publication or disclosure of an invention by the granting of a patent, in which the Government does not have a property interest, might, in the opinion of the Commissioner, be detrimental

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to the national security, he shall make the application for patent in which such invention is disclosed available for inspection to the Atomic Energy Commission, the Secretary of Defense, and the chief officer of any other department or agency of the Government designated by the President as a defense agency of the United States.

Each individual to whom the application is disclosed shall sign a dated acknowledgment thereof, which acknowledgment shall be entered in the file of the application. If, in the opinion of the Atomic Energy Commission, the Secretary of a Defense Department, or the chief officer of another department or agency so designated, the publication or disclosure of the invention by the granting of a patent therefor would be detrimental to the national security, the Atomic Energy Commission, the Secretary of a Defense Department, or such other chief officer shall notify the Commissioner and the Commissioner shall order that the invention be kept secret and shall withhold the grant of a patent for such period as the national interest requires, and notify the applicant thereof. Upon proper showing by the head of the department or agency who caused the secrecy order to be issued that the examination of the application might jeopardize the national interest, the Commissioner shall thereupon maintain the application in a sealed condition and notify the applicant thereof. The owner of an application which has been placed under a secrecy order shall have a right to appeal from the order to the Secretary of Commerce under rules prescribed by him.

An invention shall not be ordered kept secret and the grant of a patent withheld for a period of more than one year. The Commissioner shall renew the order at the end thereof, or at the end of any renewal period, for additional periods of one year upon notification by the head of the department or the chief officer of the agency who caused the order to be issued that an affirmative determination has been made that the national interest continues so to require. An order in effect, or issued, during a time when the United States is at war, shall remain in effect for the duration of hostilities and one year following cessation of hostilities. An order in effect, or issued, during a national emergency declared by the President shall remain in effect for the duration of the national emergency and six months thereafter. The Commissioner may rescind any order upon notification by the heads of the departments and the chief officers of the agencies who caused the order to be issued that the publication or disclosure of the invention is no longer deemed detrimental to the national security.

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**§ 182. Abandonment of invention for unauthorized disclosure**

The invention disclosed in an application for patent subject to an order made pursuant to section 181 of this title may be held abandoned upon its being established by the Commissioner that in violation of said order the invention has been published or disclosed or that an application for a patent therefor has been filed in a foreign country by the inventor, his successors, assigns, or legal representatives, or anyone in privity with him or them, without the consent of the Commissioner. The abandonment shall be held to have occurred as of the time of violation. The consent of the Commissioner shall not be given without the concurrence of the heads of the departments and the chief officers of the agencies who caused the order to be issued. A holding of abandonment shall constitute forfeiture by the applicant, his successors, assigns, or legal representatives, or anyone in privity with him or them, of all claims against the United States based upon such invention.

**§ 183. Right to compensation**

An applicant, his successors, assigns, or legal representatives, whose patent is withheld as herein provided, shall have the right, beginning at the date the applicant is notified that, except for such order, his application is otherwise in condition for allowance, or February 1, 1952, whichever is later, and ending six years after a patent is issued thereon, to apply to the head of any department or agency who caused the order to be issued for compensation for the damage caused by the order of secrecy and/or for the use of the invention by the Government, resulting from his disclosure. The right to compensation for use shall begin on the date of the first use of the invention by the Government. The head of the department or agency is authorized, upon the presentation of a claim, to enter into an agreement with the applicant, his successors, assigns, or legal representatives, in full settlement for the damage and/or use. This settlement agreement shall be conclusive for all purposes not withstanding any other provision of law to the contrary. If full settlement of the claim cannot be effected, the head of the department or agency may award and pay to such applicant, his successors, assigns, or legal representatives, a sum not exceeding 75 per centum of the sum which the head of the department or agency considers just compensation for the damage and/or use. A claimant may bring suit against the United States in the Court of Claims or in the District Court of the United States for the district in which such claimant is a resident for an amount which when added to the award

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shall constitute just compensation for the damage and/or use of the invention by the Government. The owner of any patent issued upon an application that was subject to a secrecy order issued pursuant to section 181 of this title, who did not apply for compensation as above provided, shall have the right, after the date of issuance of such patent, to bring suit in the Court of Claims for just compensation for the damage caused by reason of the order of secrecy and/or use by the Government of the invention resulting from his disclosure. The right to compensation for use shall begin on the date of the first use of the invention by the Government. In a suit under the provisions of this section the United States may avail itself of all defenses it may plead in an action under section 1498 of title 28. This section shall not confer a right of action on anyone or his successors, assigns, or legal representatives who, while in the full-time employment or service of the United States, discovered, invented, or developed the invention on which the claim is based.

**§ 184. Filing of application in foreign country**

Except when authorized by a license obtained from the Commissioner a person shall not file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States an application for patent or for the registration of a utility model, industrial design, or model in respect of an invention made in this country. A license shall not be granted with respect to an invention subject to an order issued by the Commissioner pursuant to section 181 of this title without the concurrence of the head of the departments and the chief officers of the agencies who caused the order to be issued. The license may be granted retroactively where an application has been inadvertently filed abroad and the application does not disclose an invention within the scope of section 181 of this title.

The term "application" when used in this chapter includes applications and any modifications, amendments, or supplements thereto, or divisions thereof.

**§ 185. Patent barred for filing without license**

Notwithstanding any other provisions of law any person, and his successors, assigns, or legal representatives, shall not receive a United States patent for an invention if that person, or his successors, assigns, or legal representatives shall, without procuring the license prescribed in section 184 of this title, have made, or consented to or assisted another's making, application in a foreign country for a patent or for the registration of a utility model, industrial design, or model in

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respect of the invention. A United States patent issued to such person, his successors, assigns, or legal representatives shall be invalid.

### § 186. Penalty

Whoever, during the period or periods of time an invention has been ordered to be kept secret and the grant of a patent thereon withheld pursuant to section 181 of this title, shall, with knowledge of such order and without due authorization, willfully publish or disclose or authorize or cause to be published or disclosed the invention, or material information with respect thereto, or whoever, in violation of the provisions of section 184 of this title, shall file or cause or authorize to be filed in any foreign country an application for patent or for the registration of a utility model, industrial design, or model in respect of any invention made in the United States, shall, upon conviction, be fined not more than $10,000 or imprisoned for not more than two years, or both.

### § 187. Nonapplicability to certain persons

The prohibitions and penalties of this chapter shall not apply to any officer or agent of the United States acting within the scope of his authority, nor to any person acting upon his written instructions or permission.

### § 188. Rules and regulations, delegation of power

The Atomic Energy Commission, the Secretary of a defense department, the chief officer of any other department or agency of the Government designated by the President as a defense agency of the United States, and the Secretary of Commerce, may separately issue rules and regulations to enable the respective department or agency to carry out the provisions of this chapter, and may delegate any power conferred by this chapter.

## PART III—PATENTS AND PROTECTION OF PATENT RIGHTS


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## CHAPTER 25—AMENDMENT AND CORRECTION OF PATENTS


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251. Reissue of defective patents.
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255. Certificate of correction of applicant's mistake.
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**§ 251. Reissue of defective patents**

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Commissioner may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

**§ 252. Effect of reissue**

The surrender of the original patent shall take effect upon the issue of the reissued patent, and every reissued patent shall have the same effect and operation in law, on the trial of actions for causes thereafter arising, as if the same had been originally granted in such amended form, but in so far as the claims of the original and reissued patents are identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent, to the extent that its claims are identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent.

No reissued patent shall abridge or affect the right of any person or his successors in business who made, purchased or used prior to the grant of a reissue anything patented by the reissued patent, to continue the use of, or to sell to others to be used or sold, the specific thing so made, purchased or used, unless the making, using or selling of such thing infringes a valid claim of the reissued patent which was in the original patent. The court before which such matter is in question

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may provide for the continued manufacture, use or sale of the thing made, purchased or used as specified, or for the manufacture, use or sale of which substantial preparation was made before the grant of the reissue, and it may also provide for the continued practice of any process patented by the reissue, practiced, or for the practice of which substantial preparation was made, prior to the grant of the reissue, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before the grant of the reissue.

§ 253. Disclaimer

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, and recorded in the Patent Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

§ 254. Certificate of correction of Patent Office mistake

Whenever a mistake in a patent, incurred through the fault of the Patent Office, is clearly disclosed by the records of the Office, the Commissioner may issue a certificate of correction stating the fact and nature of such mistake, under seal, without charge, to be recorded in the records of patents. A printed copy thereof shall be attached to each printed copy of the patent, and such certificate shall be considered as part of the original patent. Every such patent, together with such certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form. The Commissioner may issue a corrected patent without charge in lieu of and with like effect as a certificate of correction.

§ 255. Certificate of correction of applicant's mistake

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Commissioner may, upon payment of the required

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fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require re-examination. Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form.

### § 256. Misjoinder of inventor

Whenever a patent is issued on the application of persons as joint inventors and it appears that one of such persons was not in fact a joint inventor, and that he was included as a joint inventor by error and without any deceptive intention, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate deleting the name of the erroneously joined person from the patent.

Whenever a patent is issued and it appears that a person was a joint inventor, but was omitted by error and without deceptive intention on his part, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate adding his name to the patent as a joint inventor.

The misjoinder or nonjoinder of joint inventors shall not invalidate a patent, if such error can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Commissioner shall issue a certificate accordingly.

## CHAPTER 26—OWNERSHIP AND ASSIGNMENT

Sec.
261. Ownership; assignment.
262. Joint owners.

### § 261. Ownership; assignment

Subject to the provisions of this title, patents shall have the attributes of personal property.

Applications for patent, patents, or any interest therein, shall be assignable in law by an instrument in writing. The applicant, patentee, or his assigns or legal representatives may in like manner grant and convey an exclusive right under his application for patent, or patents, to the whole or any specified part of the United States.

A certificate of acknowledgment under the hand and official seal of a person authorized to administer oaths within the United States, or, in a foreign country, of a diplomatic or consular officer of the

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United States or an officer authorized to administer oaths whose authority is proved by a certificate of a diplomatic or consular officer of the United States, shall be prima facie evidence of the execution of an assignment, grant or conveyance of a patent or application for patent.

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 its date or prior to the date of such subsequent purchase or mortgage.

### § 262. Joint owners

In the absence of any agreement to the contrary, each of the joint owners of a patent may make, use or sell the patented invention without the consent of and without accounting to the other owners.

## CHAPTER 27—GOVERNMENT INTERESTS IN PATENTS

Sec.
266. Issue of patents without fees to Government employees.
267. Time for taking action in Government applications.

### § 266. Issue of patents without fees to Government employees

The Commissioner may grant, subject to the provisions of this title, to any officer, enlisted man, or employee of the Government, except officers and employees of the Patent Office, a patent without the payment of fees, when the head of a department or agency certifies the invention is used or likely to be used in the public interest and the applicant in his application states that the invention described therein, if patented, may be manufactured and used by or for the Government for governmental purposes without the payment to him of any royalty thereon, which stipulation shall be included in the patent.

### § 267. Time for taking action in Government applications

Notwithstanding the provisions of sections 133 and 151 of this title, the Commissioner may extend the time for taking any action to three years, when an application has become the property of the United States and the head of the appropriate department or agency of the Government has certified to the Commissioner that the invention disclosed therein is important to the armament or defense of the United States.

## CHAPTER 28—INFRINGEMENT OF PATENTS

Sec.
271. Infringement of patent.
272. Temporary presence in the United States.

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**§ 271. Infringement of patent**

(a) Except as otherwise provided in this title, whoever without authority makes, uses or sells any patented invention, within the United States during the term of the patent therefor, infringes the patent.

(b) Whoever actively induces infringement of a patent shall be liable as an infringer.

(c) Whoever sells a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.

(d) No patent owner otherwise entitled to relief for infringement or contributory infringement of a patent shall be denied relief or deemed guilty of misuse or illegal extension of the patent right by reason of his having done one or more of the following: (1) derived revenue from acts which if performed by another without his consent would constitute contributory infringement of the patent; (2) licensed or authorized another to perform acts which if performed without his consent would constitute contributory infringement of the patent; (3) sought to enforce his patent rights against infringement or contributory infringement.

**§ 272. Temporary presence in the United States**

The use of any invention in any vessel, aircraft or vehicle of any country which affords similar privileges to vessels, aircraft or vehicles of the United States, entering the United States temporarily or accidentally, shall not constitute infringement of any patent, if the invention is used exclusively for the needs of the vessel, aircraft or vehicle and is not sold in or used for the manufacture of anything to be sold in or exported from the United States.

## CHAPTER 29—REMEDIES FOR INFRINGEMENT OF PATENT, AND OTHER ACTIONS

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281. Remedy for infringement of patent.
282. Presumption of validity; defenses.
283. Injunction.
284. Damages.
285. Attorney fees.
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Sec.
200. Notice of patent suits.
201. Interfering patents.
202. False marking.
203. Nonresident patentee, service and notice.

### § 281. Remedy for infringement of patent

A patentee shall have remedy by civil action for infringement of his patent.

### § 282. Presumption of validity; defenses

A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it.

The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

(1) Noninfringement or absence of liability for infringement,

(2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability,

(3) Invalidity of the patent or any claim in suit for failure to comply with any requirement of sections 112 or 251 of this title,

(4) Any other fact or act made a defense by this title.

In actions involving the validity or infringement of a patent the party asserting invalidity or noninfringement shall give notice in the pleadings or otherwise in writing to the adverse party at least thirty days before the trial, of the country, number, date, and name of the patentee of any patent, the title, date, and page numbers of any publication to be relied upon as anticipation of the patent in suit or, except in actions in the United States Court of Claims, as showing the state of the art, and the name and address of any person who may be relied upon as the prior inventor or as having prior knowledge of or as having previously used or offered for sale the invention of the patent in suit. In the absence of such notice proof of the said matters may not be made at the trial except on such terms as the court requires.

### § 283. Injunction

The several courts having jurisdiction of cases under this title may grant injunctions in accordance with the principles of equity to prevent the violation of any right secured by patent, on such terms as the court deems reasonable.

### § 284. Damages

Upon adjudging a patent valid and infringed, the court shall award the claimant damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court.

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When the damages are not found by a jury, the court shall assess them. In either event the court may increase the damages up to three times the amount found or assessed.

The court may receive expert testimony as an aid to the determination of damages or of what royalty would be reasonable under the circumstances.

**§ 285. Attorney fees**

The court in exceptional cases may award reasonable attorney fees to the prevailing party.

**§ 286. Time limitation on damages**

Except as otherwise provided by law, no recovery shall be had for any infringement committed more than six years prior to the filing of the complaint or counterclaim for infringement in the action.

In the case of claims against the United States Government for use of a patented invention, the period before bringing suit, up to six years, between the date of receipt of a written claim for compensation by the department or agency of the Government having authority to settle such claim, and the date of mailing by the Government of a notice to the claimant that his claim has been denied shall not be counted as part of the period referred to in the preceding paragraph.

**§ 287. Limitation on damages; marking and notice**

Patentees, and persons making or selling any patented article for or under them, may give notice to the public that the same is patented, either by fixing thereon the word "patent" or the abbreviation "pat.", together with the number of the patent, or when, from the character of the article, this can not be done, by fixing to it, or to the package wherein one or more of them is contained, a label containing a like notice. In the event of failure so to mark, no damages shall be recovered by the patentee in any action for infringement, except on proof that the infringer was notified of the infringement and continued to infringe thereafter, in which event damages may be recovered only for infringement occurring after such notice. Filing of an action for infringement shall constitute such notice.

**§ 288. Action for infringement of a patent containing an invalid claim**

Whenever, without deceptive intention, a claim of a patent is invalid, an action may be maintained for the infringement of a claim of the patent which may be valid. The patentee shall recover no costs unless a disclaimer of the invalid claim has been entered at the Patent Office before the commencement of the suit.

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§ 289. Additional remedy for infringement of design patent

Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit, but not less than $250, recoverable in any United States district court having jurisdiction of the parties.

Nothing in this section shall prevent, lessen, or impeach any other remedy which an owner of an infringed patent has under the provisions of this title, but he shall not twice recover the profit made from the infringement.

§ 290. Notice of patent suits

The clerks of the courts of the United States, within one month after the filing of an action under this title shall give notice thereof in writing to the Commissioner, setting forth so far as known the names and addresses of the parties, name of the inventor, and the designating number of the patent upon which the action has been brought. If any other patent is subsequently included in the action he shall give like notice thereof. Within one month after the decision is rendered or a judgment issued the clerk of the court shall give notice thereof to the Commissioner. The Commissioner shall, on receipt of such notices, enter the same in the file of such patent.

§ 291. Interfering patents

The owner of an interfering patent may have relief against the owner of another by civil action, and the court may adjudge the question of the validity of any of the interfering patents, in whole or in part. The provisions of the second paragraph of section 146 of this title shall apply to actions brought under this section.

§ 292. False marking

(a) Whoever, without the consent of the patentee, marks upon, or affixes to, or uses in advertising in connection with anything made, used, or sold by him, the name or any imitation of the name of the patentee, the patent number, or the words "patent," "patentee," or the like, with the intent of counterfeiting or imitating the mark of the patentee, or of deceiving the public and inducing them to believe that the thing was made or sold by or with the consent of the patentee; or

Whoever marks upon, or affixes to, or uses in advertising in connection with any unpatented article, the word "patent" or any word or

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number importing that the same is patented, for the purpose of deceiving the public; or

Whoever marks upon, or affixes to, or uses in advertising in connection with any article, the words "patent applied for," "patent pending," or any word importing that an application for patent has been made, when no application for patent has been made, or if made, is not pending, for the purpose of deceiving the public—

Shall be fined not more than $500 for every such offense.

(b) Any person may sue for the penalty, in which event one-half shall go to the person suing and the other to the use of the United States.

§ 293. **Nonresident patentee; service and notice**

Every patentee not residing in the United States may file in the Patent Office a written designation stating the name and address of a person residing within the United States on whom may be served process or notice of proceedings affecting the patent or rights thereunder. If the person designated cannot be found at the address given in the last designation, or if no person has been designated, the United States District Court for the District of Columbia shall have jurisdiction and summons shall be served by publication or otherwise as the court directs. The court shall have the same jurisdiction to take any action respecting the patent or rights thereunder that it would have if the patentee were personally within the jurisdiction of the court.

SEC. 2. Section 21 of the Act approved July 5, 1946, 60 Stat. 435, (United States Code, title 15, sec. 1071, 1946 ed.) is amended by striking out "Revised Statutes 4911" and inserting "35 United States Code, section 141"; by striking out "section 4915, Revised Statutes" and inserting "35 United States Code, sections 145 and 146"; and by striking out "Revised Statutes 4915" appearing twice in said section and inserting "35 United States Code, section 146".

SEC. 3. If any provision of Title 35, as enacted by section 1 hereof, is declared unconstitutional or is held invalid, the validity of the remainder of this title shall not be affected.

SEC. 4. (a) This Act shall take effect on January 1, 1953 and shall apply to all applications for patent filed on or after such date and to all patents granted on such applications. It shall apply to further proceedings on applications pending on such date and to patents granted

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on such applications except as otherwise provided. It shall apply to unexpired patents granted prior to such date except as otherwise provided.

(b) Section 102 (d) of Title 35, as enacted by section 1 hereof, shall not apply to existing patents and pending applications, but the law previously in effect, namely the first paragraph of R. S. 4887 (U. S. Code, title 35, sec. 32, first paragraph, 1946 ed.), shall apply to such patents and applications.

(c) Section 119, second paragraph, of Title 35 as enacted by section 1 hereof shall not apply to existing patents.

(d) The period of one year specified in section 102 (b) of Title 35 as enacted by section 1 hereof shall not apply in the case of applications filed before August 5, 1940, and patents granted on such applications, and with respect to such applications and patents, said period is two years instead of one year.

(e) Nothing contained in Title 35, as enacted by section 1 hereof, shall operate to nullify any judicial finding prior to the effective date of this Act on the validity of any patent by a court of competent jurisdiction.

(f) Nothing in Title 35, as enacted by section 1 hereof, shall affect any provision of the Atomic Energy Act of 1946 (Aug. 1, 1946, ch. 724, 60 Stat. 755).

(g) The period of one year specified in section 4 of Title 35 as enacted by section 1 hereof shall not apply in the case of applications filed before the effective date of this Act.

(h) The repeal of sections 1–9, 11, 12 of the Act of Congress approved February 1, 1952 (ch. 4, 66 Stat. 3), shall not affect any rights or liabilities existing on the date of approval of this Act. An order of secrecy issued under or in effect under the repealed Act and in effect on the date of approval of this Act, shall be considered as issued under this Act, and any claims arising under the repealed Act or subject to presentation and determination pursuant thereto and unsettled as of the effective date of this Act, may be presented and determined pursuant to the provisions of this Act.

SEC. 5. The sections or parts thereof of the Revised Statutes or Statutes at Large enumerated in the following schedule are hereby repealed. Any rights or liabilities now existing under such sections or parts thereof shall not be affected by this repeal.

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[1] The part relating to the granting of patents to Government employees without fees.
[2] The part relating to certified copies of drawings and specifications.
[3] The part relating to fees for recording assignments.
[4] The part amending R. S. 4894.
[5] The part relating to the price of copies of patents.
[6] The part relating to payment of fees.
[7] The part relating to the fee for copies of specifications and drawings of patents.

Passed the House of Representatives May 19, 1952.

Attest: RALPH R. ROBERTS,

*Clerk.*

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82D CONGRESS
2D SESSION

# H. R. 7794

## AN ACT

To revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents".

MAY 20 (legislative day, MAY 12), 1952
Read twice and referred to the Committee on the Judiciary

LEGISLATIVE INTENT SERVICE (800) 666-1917

Calendar No. 1908

82D CONGRESS
2D SESSION

# H. R. 7794

[Report No. 1979]

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IN THE SENATE OF THE UNITED STATES

MAY 20 (legislative day, MAY 12), 1952

Read twice and referred to the Committee on the Judiciary

JUNE 27, 1952

Reported by Mr. WILEY, with amendments

[Omit the part struck through and insert the part printed in italic]

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# AN ACT

To revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents".

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That title 35 of the United States Code, entitled "Patents", is revised, codified, and enacted into law, and may be cited, "Title 35, United States Code, section—", as follows:

## TITLE 35—PATENTS


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## CHAPTER 1—ESTABLISHMENT, OFFICERS, FUNCTIONS

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1. Establishment.
2. Seal.
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5. Bond of Commissioner and other officers.
6. Duties of Commissioner.
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8. Library.
9. Classification of patents.
10. Certified copies of records.
11. Publications.
12. Exchange of copies of patents with foreign countries.
13. Copies of patents for public libraries.
14. Annual report to Congress.

### § 1. Establishment

The Patent Office shall continue as an office in the Department of Commerce, where records, books, drawings, specifications, and other papers and things pertaining to patents and to trade-mark registrations shall be kept and preserved, except as otherwise provided by law.

### § 2. Seal

The Patent Office shall have a seal with which letters patent, certificates of trade-mark registrations, and papers issued from the Office shall be authenticated.

### § 3. Officers and employees

A Commissioner of Patents, one first assistant commissioner, two assistant commissioners, and nine examiners-in-chief, shall be appointed by the President, by and with the advice and consent of the Senate. The assistant commissioners shall perform the duties pertaining to the office of commissioner assigned to them by the Commissioner. The first assistant commissioner, or, in the event of a vacancy in that office, the assistant commissioner senior in date of appointment, shall fill the office of Commissioner during a vacancy in that office until a Commissioner is appointed and takes office. The Secretary of Commerce, upon the nomination of the Commissioner in accordance with law, shall appoint all other officers and employees.

The Secretary of Commerce may vest in himself the functions of the Patent Office and its officers and employees specified in this title and may from time to time authorize their performance by any other officer or employee.

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**§ 4. Restrictions on officers and employees as to interest in patents**

Officers and employees of the Patent Office shall be incapable, during the period of their appointments and for one year thereafter, of applying for a patent and of acquiring, directly or indirectly, except by inheritance or bequest, any patent or any right or interest in any patent, issued or to be issued by the Office. In patents applied for thereafter they shall not be entitled to any priority date earlier than one year after the termination of their appointment.

**§ 5. Bond of Commissioner and other officers**

The Commissioner and such other officers as he designates, before entering upon their duties, shall severally give bond, with sureties, the former in the sum of $10,000, and the latter in sums prescribed by the Commissioner, conditioned for the faithful discharge of their respective duties and that they shall render to the proper officers of the Treasury a true account of all money received by virtue of their offices.

**§ 6. Duties of Commissioner**

The Commissioner, under the direction of the Secretary of Commerce, shall superintend or perform all duties required by law respecting the granting and issuing of patents and the registration of trademarks; and he shall have charge of property belonging to the Patent Office. He may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

**§ 7. Board of Appeals**

The examiners-in-chief shall be persons of competent legal knowledge and scientific ability. The Commissioner, the assistant commissioners, and the examiners-in-chief shall constitute a Board of Appeals, which, on written appeal of the applicant, shall review adverse decisions of examiners upon applications for patents. Each appeal shall be heard by at least three members of the Board of Appeals, the members hearing such appeal to be designated by the Commissioner. The Board of Appeals has sole power to grant rehearings.

Whenever the Commissioner considers it necessary to maintain the work of the Board of Appeals current, he may designate any patent

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examiner of the primary examiner grade or higher, having the requisite ability, to serve as examiner-in-chief for periods not exceeding six months each. An examiner so designated shall be qualified to act as a member of the Board of Appeals. Not more than one such primary examiner shall be a member of the Board of Appeals hearing an appeal.

**§ 8. Library**

The Commissioner shall maintain a library of scientific and other works and periodicals, both foreign and domestic, in the Patent Office to aid the officers in the discharge of their duties.

**§ 9. Classification of patents**

The Commissioner may revise and maintain the classification by subject matter of United States letters patent, and such other patents and printed publications as may be necessary or practicable, for the purpose of determining with readiness and accuracy the novelty of inventions for which applications for patent are filed.

**§ 10. Certified copies of records**

The Commissioner may furnish certified copies of specifications and drawings of patents issued by the Patent Office, and of other records available either to the public or to the person applying therefor.

**§ 11. Publications**

(a) The Commissioner may print, or cause to be printed, the following:

1. Patents, including specifications and drawings, together with copies of the same. The Patent Office may print the headings of the drawings for patents for the purpose of photolithography.

2. Certificates of trade-mark registrations, including statements and drawings, together with copies of the same.

3. The Official Gazette of the United States Patent Office.

4. Annual indexes of patents and patentees, and of trade-marks and registrants.

5. Annual volumes of decisions in patent and trade-mark cases.

6. Pamphlet copies of the patent laws and rules of practice, laws and rules relating to trade-marks, and circulars or other publications relating to the business of the Office.

(b) The Commissioner may exchange any of the publications specified in items 3, 4, 5, and 6 of subsection (a) of this section for publications desirable for the use of the Patent Office.

**§ 12. Exchange of copies of patents with foreign countries**

The Commissioner may exchange copies of specifications and drawings of United States patents for those of foreign countries.

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### § 13. Copies of patents for public libraries

The Commissioner may supply printed copies of specifications and drawings of patents to public libraries in the United States which shall maintain such copies for the use of the public, at the rate for each year's issue established for this purpose in section 41 (a) 9 of this title.

### § 14. Annual report to Congress

The Commissioner shall report to Congress annually the moneys received and expended, statistics concerning the work of the Office, and other information relating to the Office as may be useful to the Congress or the public.

## CHAPTER 2—PROCEEDINGS IN THE PATENT OFFICE

Sec.

21. Day for taking action falling on Saturday, Sunday, or holiday.
22. Printing of papers filed.
23. Testimony in Patent Office cases.
24. Subpoenas, witnesses.

### § 21. Day for taking action falling on Saturday, Sunday, or holiday

When the day, or the last day, for taking any action or paying any fee in the United States Patent Office falls on Saturday, Sunday, or a holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding secular or business day.

### § 22. Printing of papers filed

The Commissioner may require papers filed in the Patent Office to be printed or typewritten.

### § 23. Testimony in Patent Office cases

The Commissioner may establish rules for taking affidavits and depositions required in cases in the Patent Office. Any officer authorized by law to take depositions to be used in the courts of the United States, or of the State where he resides, may take such affidavits and depositions.

### § 24. Subpoenas, witnesses

The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent Office, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent Office.

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Every witness subpoenaed and in attendance shall be allowed the fees and traveling expenses allowed to witnesses attending the United States district courts.

A judge of a court whose clerk issued a subpoena may enforce obedience to the process or punish disobedience as in other like cases, on proof that a witness, served with such subpoena, neglected or refused to appear or to testify. No witness shall be deemed guilty of contempt for disobeying such subpoena unless his fees and traveling expenses in going to, and returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret matter except upon appropriate order of the court which issued the subpoena.

## CHAPTER 3—PRACTICE BEFORE PATENT OFFICE

Sec.
31. Regulations for agents and attorneys.
32. Suspension or exclusion from practice.
33. Unauthorized representation as practitioner.

### § 31. Regulations for agents and attorneys

The Commissioner, subject to the approval of the Secretary of Commerce, may prescribe regulations governing the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Patent Office, and may require them, before being recognized as representatives of applicants or other persons, to show that they are of good moral character and reputation and are possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office.

### § 32. Suspension or exclusion from practice

The Commissioner may, after notice and opportunity for a hearing, suspend or exclude, either generally or in any particular case, from further practice before the Patent Office, any person, agent, or attorney shown to be incompetent or disreputable, or guilty of gross misconduct, or who does not comply with the regulations established under section 31 of this title, or who shall, by word, circular, letter, or advertising, with intent to defraud in any manner, deceive, mislead, or threaten any applicant or prospective applicant, or other person having immediate or prospective business before the Office. The reasons for any such suspension or exclusion shall be duly recorded. The United States District Court for the District of Columbia, under

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such conditions and upon such proceedings as it by its rules determines, may review the action of the Commissioner upon the petition of the person so refused recognition or so suspended or excluded.

### § 33. Unauthorized representation as practitioner

Whoever, not being recognized to practice before the Patent Office, holds himself out or permits himself to be held out as so recognized, or as being qualified to prepare or prosecute applications for patent, shall be fined not more than $1,000 for each offense.

## CHAPTER 4—PATENT FEES

Sec.
41. Patent fees.
42. Payment of patent fees; return of excess amounts.

### § 41. Patent fees

(a) The Commissioner shall charge the following fees:

1. On filing each application for an original patent, except in design cases, $30, and $1 for each claim in excess of twenty.

2. On issuing each original patent, except in design cases, $30, and $1 for each claim in excess of twenty.

3. In design cases: For three years and six months, $10; for seven years, $15; for fourteen years, $30.

4. On every application for the reissue of a patent, $30 and $1 for each claim in excess of twenty over and above the number of claims of the original patent.

5. On filing each disclaimer, $10.

6. On an appeal for the first time from the examiner to the Board of Appeals, $25.

7. On filing each petition for the revival of an abandoned application for a patent or for the delayed payment of the fee for issuing each patent, $10.

8. For certificate of correction of applicant's mistake under section 255 of this title, $10.

9. For uncertified printed copies of specifications and drawings of patents (except design patents), 25 cents per copy; for design patents, 10 cents per copy; special rate for libraries specified in section 13 of this title, $50 for patents issued in one year.

10. For recording every assignment, agreement, or other paper not exceeding six pages, $3; for each additional two pages or less, $1; for each additional patent or application included in one writing, where more than one is so included, 50 cents additional.

11. For each certificate, $1.

(b) The Commissioner may establish charges for copies of records,

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publications, or services furnished by the Patent Office, not specified above.

### § 42. Payment of patent fees; return of excess amounts

All patent fees shall be paid to the Commissioner who shall deposit the same in the Treasury of the United States in such manner as the Secretary of the Treasury directs, and the Commissioner may refund any sum paid by mistake or in excess of the fee required by law.

## PART II—PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS


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### CHAPTER 10—PATENTABILITY OF INVENTIONS


Sec.
100. Definitions.
101. Inventions patentable.
102. Conditions for patentability; novelty and loss of right to patent.
103. Conditions for patentability; non-obvious subject matter.
104. Invention made abroad.


### § 100. Definitions

When used in this title unless the context otherwise indicates—

(a) The term "invention" means invention or discovery.

(b) The term "process" means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.

(c) The terms "United States" and "this country" mean the United States of America, its territories and possessions.

(d) The word "patentee" includes not only the patentee to whom the patent was issued but also the successors in title to the patentee.

### § 101. Inventions patentable

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

### § 102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign

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country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country ~~or~~ *on* an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

**§ 103. Conditions for patentability; non-obvious subject matter**

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**§ 104. Invention made abroad**

In proceedings in the Patent Office and in the courts, an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country, except as provided in section 119 of this



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title. Where an invention was made by a person, civil or military, while domiciled in the United States and serving in a foreign country in connection with operations by or on behalf of the United States, he shall be entitled to the same rights of priority with respect to such invention as if the same had been made in the United States.

## CHAPTER 11—APPLICATION FOR PATENT

Sec.
111. Application for patent.
112. Specification.
113. Drawings.
114. Models, specimens.
115. Oath of applicant.
116. Joint inventors.
117. Death or incapacity of inventor.
118. Filing by other than inventor.
119. Benefit of earlier filing date in foreign country; right of priority.
120. Benefit of earlier filing date in the United States.
121. Divisional applications.
122. Confidential status of applications.

### § 111. Application for patent

Application for patent shall be made by the inventor, except as otherwise provided in this title, in writing to the Commissioner. Such application shall include: (1) a specification as prescribed by section 112 of this title; (2) a drawing as prescribed by section 113 of this title; and (3) an oath by the applicant as prescribed by section 115 of this title. The application must be signed by the applicant and accompanied by the fee required by law.

### § 112. Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

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§ 113. Drawings

When the nature of the case admits, the applicant shall furnish a drawing.

§ 114. Models, specimens

The Commissioner may require the applicant to furnish a model of convenient size to exhibit advantageously the several parts of his invention.

When the invention relates to a composition of matter, the Commissioner may require the applicant to furnish specimens or ingredients for the purpose of inspection or experiment.

§ 115. Oath of applicant

The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by certificate of a diplomatic or consular officer of the United States, and such oath shall be valid if it complies with the laws of the state or country where made. When the application is made as provided in this title by a person other than the inventor, the oath may be so varied in form that it can be made by him.

§ 116. Joint inventors

When an invention is made by two or more persons jointly, they shall apply for patent jointly and each sign the application and make the required oath, except as otherwise provided in this title.

If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Commissioner, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor making the application, subject to the same rights which the omitted inventor would have had if he had been joined. The omitted inventor may subsequently join in the application.

Whenever a person is joined in an application for patent as joint inventor through error, or a joint inventor is not included in an appli-

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cation through error, and such error arose without any deceptive intention on his part, the Commissioner may permit the application to be amended accordingly, under such terms as he prescribes.

**§ 117. Death or incapacity of inventor**

Legal representatives of deceased inventors and of those under legal incapacity may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor.

**§ 118. Filing by other than inventor**

Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage; and the Commissioner may grant a patent to such inventor upon such notice to him as the Commissioner deems sufficient, and on compliance with such regulations as he prescribes.

**§ 119. Benefit of earlier filing date in foreign country; right of priority**

An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed; but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing.

No application for patent shall be entitled to this right of priority unless a claim therefor and a certified copy of the original foreign application, specification and drawings upon which it is based are filed

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in the Patent Office before the patent is granted, or at such time during the pendency of the application as required by the Commissioner not earlier than six months after the filing of the application in this country. Such certification shall be made by the patent office of the foreign country in which filed and show the date of the application and of the filing of the specification and other papers. The Commissioner may require a translation of the papers filed if not in the English language and such other information as he deems necessary.

**§ 120. Benefit of earlier filing date in the United States**

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States by the same inventor shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

**§ 121. Divisional applications**

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Commissioner may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Commissioner to require the application to be restricted to one invention.

**§ 122. Confidential status of applications**

Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without author-

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ity of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner.

## CHAPTER 12—EXAMINATION OF APPLICATION

Sec.
131. Examination of application.
132. Notice of rejection; reexamination.
133. Time for prosecuting application.
134. Appeal to the Board of Appeals.
135. Interferences.

### § 131. Examination of application

The Commissioner shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Commissioner shall issue a patent therefor.

### § 132. Notice of rejection; reexamination

Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

### § 133. Time for prosecuting application

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

### § 134. Appeal to the Board of Appeals

An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Appeals, having once paid the fee for such appeal.

### § 135. Interferences

Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The

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question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office.

A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

## CHAPTER 13—REVIEW OF PATENT OFFICE DECISION

Sec.
141. Appeal to Court of Customs and Patent Appeals.
142. Notice of appeal.
143. Proceedings on appeal.
144. Decision on appeal.
145. Civil action to obtain patent.
146. Civil action in case of interference.

### § 141. Appeal to Court of Customs and Patent Appeals

An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Customs and Patent Appeals, thereby waiving his right to proceed under section 145 of this title. A party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority may appeal to the United States Court of Customs and Patent Appeals, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has filed notice of appeal according to section 142 of this title, files notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 146 of this title. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under section 146, in default of which the decision appealed from shall govern the further proceedings in the case.

### § 142. Notice of appeal

When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and shall file in the Patent Office his reasons of appeal, specifically set forth in writing, within such time after the date of the

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decision appealed from, not less than sixty days, as the Commissioner appoints.

**§ 143. Proceedings on appeal**

The United States Court of Customs and Patent Appeals shall, before hearing such appeal, give notice of the time and place of the hearing to the Commissioner and the parties thereto. The Commissioner shall transmit to the court certified copies of all the necessary original papers and evidence in the case specified by the appellant and any additional papers and evidence specified by the appellee and in an ex parte case the Commissioner shall furnish the court with the grounds of the decision of the Patent Office, in writing, touching all the points involved by the reasons of appeal.

**§ 144. Decision on appeal**

The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent Office, and the decision shall be confined to the points set forth in the reasons of appeal. Upon its determination the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and govern the further proceedings in the case.

**§ 145. Civil action to obtain patent**

An applicant dissatisfied with the decision of the Board of Appeals may unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

**§ 146. Civil action in case of interference**

Any party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority, may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints or as provided in section 141 of this title, unless he has appealed to the United States Court of Customs and Patent Appeals, and such appeal

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is pending or has been decided. In such suits the record in the Patent Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent Office when admitted shall have the same effect as if originally taken and produced in the suit.

Such suit may be instituted against the party in interest as shown by the records of the Patent Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs. The Commissioner shall not be a necessary party but he shall be notified of the filing of the suit by the clerk of the court in which it is filed and shall have the right to intervene. Judgment of the court in favor of the right of an applicant to a patent shall authorize the Commissioner to issue such patent on the filing in the Patent Office of a certified copy of the judgment and on compliance with the requirements of law.

## CHAPTER 14—ISSUE OF PATENT

Sec.
151. Time of issue of patent.
152. Issue of patent to assignee.
153. How issued.
154. Contents and term of patent.

### § 151. Time of issue of patent

The patent shall issue within three months from the date of the payment of the final fee, which shall be paid not later than six months after written notice to the applicant of allowance of the application, but the Commissioner may accept the final fee if paid within one year after the six month period for payment, and the patent shall issue.

### § 152. Issue of patent to assignee

Patents may be granted to the assignee of the inventor of record in the Patent Office, upon the application made and the specification sworn to by the inventor, except as otherwise provided in this title.



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**§ 153. How issued**

Patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Commissioner or have his signature placed thereon and attested by an officer of the Patent Office designated by the Commissioner, and shall be recorded in the Patent Office.

**§ 154. Contents and term of patent**

Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the right to exclude others from making, using, or selling the invention throughout the United States, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof.

## CHAPTER 15—PLANT PATENTS

Sec.
161. Patents for plants.
162. Description, claim.
163. Grant.
164. Assistance of Department of Agriculture.

**§ 161. Patents for plants**

Whoever invents or discovers and asexually reproduces any distinct and new variety of plant, other than a tuberpropagated plant, may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for plants, except as otherwise provided.

**§ 162. Description, claim**

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible.

The claim in the specification shall be in formal terms to the plant shown and described.

**§ 163. Grant**

In the case of a plant patent the grant shall be of the right to exclude others from asexually reproducing the plant or selling or using the plant so reproduced.

**§ 164. Assistance of Department of Agriculture.**

The President may by Executive order direct the Secretary of Agriculture, in accordance with the requests of the Commissioner, for the purpose of carrying into effect the provisions of this title with respect to plants (1) to furnish available information of the Department of Agriculture, (2) to conduct through the appropriate bureau

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or division of the Department research upon special problems, or (3) to detail to the Commissioner officers and employees of the Department.

## CHAPTER 16—DESIGNS

Sec.
171. Patents for designs.
172. Right of priority.
173. Term of design patent.

### § 171. Patents for designs

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

### § 172. Right of priority

The right of priority provided for by section 119 of this title and the time specified in section 102 (d) shall be six months in the case of designs.

### § 173. Term of design patent

Patents for designs may he granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant, in his application, elects.

## CHAPTER 17—SECRECY OF CERTAIN INVENTIONS AND FILING APPLICATIONS IN FOREIGN COUNTRY

Sec.
181. Secrecy of certain inventions and withholding of patent.
182. Abandonment of invention for unauthorized disclosure.
183. Right of compensation.
184. Filing of application in foreign country.
185. Patent barred for filing without license.
186. Penalty.
187. Nonapplicability to certain persons.
188. Rules and regulations, delegation of power.

### § 181. Secrecy of certain inventions and withholding of patent

Whenever publication or disclosure by the grant of a patent on an invention in which the Government has a property interest might, in the opinion of the head of the interested Government agency, be detrimental to the national security, the Commissioner upon being so notified shall order that the invention be kept secret and shall withhold the grant of a patent therefor under the conditions set forth hereinafter.

Whenever the publication or disclosure of an invention by the granting of a patent, in which the Government does not have a property interest, might, in the opinion of the Commissioner, be detrimental

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to the national security, he shall make the application for patent in which such invention is disclosed available for inspection to the Atomic Energy Commission, the Secretary of Defense, and the chief officer of any other department or agency of the Government designated by the President as a defense agency of the United States.

Each individual to whom the application is disclosed shall sign a dated acknowledgment thereof, which acknowledgment shall be entered in the file of the application. If, in the opinion of the Atomic Energy Commission, the Secretary of a Defense Department, or the chief officer of another department or agency so designated, the publication or disclosure of the invention by the granting of a patent therefor would be detrimental to the national security, the Atomic Energy Commission, the Secretary of a Defense Department, or such other chief officer shall notify the Commissioner and the Commissioner shall order that the invention be kept secret and shall withhold the grant of a patent for such period as the national interest requires, and notify the applicant thereof. Upon proper showing by the head of the department or agency who caused the secrecy order to be issued that the examination of the application might jeopardize the national interest, the Commissioner shall thereupon maintain the application in a sealed condition and notify the applicant thereof. The owner of an application which has been placed under a secrecy order shall have a right to appeal from the order to the Secretary of Commerce under rules prescribed by him.

An invention shall not be ordered kept secret and the grant of a patent withheld for a period of more than one year. The Commissioner shall renew the order at the end thereof, or at the end of any renewal period, for additional periods of one year upon notification by the head of the department or the chief officer of the agency who caused the order to be issued that an affirmative determination has been made that the national interest continues so to require. An order in effect, or issued, during a time when the United States is at war, shall remain in effect for the duration of hostilities and one year following cessation of hostilities. An order in effect, or issued, during a national emergency declared by the President shall remain in effect for the duration of the national emergency and six months thereafter. The Commissioner may rescind any order upon notification by the heads of the departments and the chief officers of the agencies who caused the order to be issued that the publication or disclosure of the invention is no longer deemed detrimental to the national security.

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**§ 182. Abandonment of invention for unauthorized disclosure**

The invention disclosed in an application for patent subject to an order made pursuant to section 181 of this title may be held abandoned upon its being established by the Commissioner that in violation of said order the invention has been published or disclosed or that an application for a patent therefor has been filed in a foreign country by the inventor, his successors, assigns, or legal representatives, or anyone in privity with him or them, without the consent of the Commissioner. The abandonment shall be held to have occurred as of the time of violation. The consent of the Commissioner shall not be given without the concurrence of the heads of the departments and the chief officers of the agencies who caused the order to be issued. A holding of abandonment shall constitute forfeiture by the applicant, his successors, assigns, or legal representatives, or anyone in privity with him or them, of all claims against the United States based upon such invention.

**§ 183. Right to compensation**

An applicant, his successors, assigns, or legal representatives, whose patent is withheld as herein provided, shall have the right, beginning at the date the applicant is notified that, except for such order, his application is otherwise in condition for allowance, or February 1, 1952, whichever is later, and ending six years after a patent is issued thereon, to apply to the head of any department or agency who caused the order to be issued for compensation for the damage caused by the order of secrecy and/or for the use of the invention by the Government, resulting from his disclosure. The right to compensation for use shall begin on the date of the first use of the invention by the Government. The head of the department or agency is authorized, upon the presentation of a claim, to enter into an agreement with the applicant, his successors, assigns, or legal representatives, in full settlement for the damage and/or use. This settlement agreement shall be conclusive for all purposes not withstanding any other provision of law to the contrary. If full settlement of the claim cannot be effected, the head of the department or agency may award and pay to such applicant, his successors, assigns, or legal representatives, a sum not exceeding 75 per centum of the sum which the head of the department or agency considers just compensation for the damage and/or use. A claimant may bring suit against the United States in the Court of Claims or in the District Court of the United States for the district in which such claimant is a resident for an amount which when added to the award

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shall constitute just compensation for the damage and/or use of the invention by the Government. The owner of any patent issued upon an application that was subject to a secrecy order issued pursuant to section 181 of this title, who did not apply for compensation as above provided, shall have the right, after the date of issuance of such patent, to bring suit in the Court of Claims for just compensation for the damage caused by reason of the order of secrecy and/or use by the Government of the invention resulting from his disclosure. The right to compensation for use shall begin on the date of the first use of the invention by the Government. In a suit under the provisions of this section the United States may avail itself of all defenses it may plead in an action under section 1498 of title 28. This section shall not confer a right of action on anyone or his successors, assigns, or legal representatives who, while in the full-time employment or service of the United States, discovered, invented, or developed the invention on which the claim is based.

**§ 184. Filing of application in foreign country**

Except when authorized by a license obtained from the Commissioner a person shall not file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States an application for patent or for the registration of a utility model, industrial design, or model in respect of an invention made in this country. A license shall not be granted with respect to an invention subject to an order issued by the Commissioner pursuant to section 181 of this title without the concurrence of the head of the departments and the chief officers of the agencies who caused the order to be issued. The license may be granted retroactively where an application has been inadvertently filed abroad and the application does not disclose an invention within the scope of section 181 of this title.

The term "application" when used in this chapter includes applications and any modifications, amendments, or supplements thereto, or divisions thereof.

**§ 185. Patent barred for filing without license**

Notwithstanding any other provisions of law any person, and his successors, assigns, or legal representatives, shall not receive a United States patent for an invention if that person, or his successors, assigns, or legal representatives shall, without procuring the license prescribed in section 184 of this title, have made, or consented to or assisted another's making, application in a foreign country for a patent or for the registration of a utility model, industrial design, or model in

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respect of the invention. A United States patent issued to such person, his successors, assigns, or legal representatives shall be invalid.

### § 186. Penalty

Whoever, during the period or periods of time an invention has been ordered to be kept secret and the grant of a patent thereon withheld pursuant to section 181 of this title, shall, with knowledge of such order and without due authorization, willfully publish or disclose or authorize or cause to be published or disclosed the invention, or material information with respect thereto, or whoever, in violation of the provisions of section 184 of this title, shall file or cause or authorize to be filed in any foreign country an application for patent or for the registration of a utility model, industrial design, or model in respect of any invention made in the United States, shall, upon conviction, be fined not more than $10,000 or imprisoned for not more than two years, or both.

### § 187. Nonapplicability to certain persons

The prohibitions and penalties of this chapter shall not apply to any officer or agent of the United States acting within the scope of his authority, nor to any person acting upon his written instructions or permission.

### § 188. Rules and regulations, delegation of power

The Atomic Energy Commission, the Secretary of a defense department, the chief officer of any other department or agency of the Government designated by the President as a defense agency of the United States, and the Secretary of Commerce, may separately issue rules and regulations to enable the respective department or agency to carry out the provisions of this chapter, and may delegate any power conferred by this chapter.

## PART III—PATENTS AND PROTECTION OF PATENT RIGHTS


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## CHAPTER 25—AMENDMENT AND CORRECTION OF PATENTS


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**§ 251. Reissue of defective patents**

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Commissioner may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

**§ 252. Effect of reissue**

The surrender of the original patent shall take effect upon the issue of the reissued patent, and every reissued patent shall have the same effect and operation in law, on the trial of actions for causes thereafter arising, as if the same had been originally granted in such amended form, but in so far as the claims of the original and reissued patents are identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent, to the extent that its claims are identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent.

No reissued patent shall abridge or affect the right of any person or his successors in business who made, purchased or used prior to the grant of a reissue anything patented by the reissued patent, to continue the use of, or to sell to others to be used or sold, the specific thing so made, purchased or used, unless the making, using or selling of such thing infringes a valid claim of the reissued patent which was in the original patent. The court before which such matter is in question

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may provide for the continued manufacture, use or sale of the thing made, purchased or used as specified, or for the manufacture, use or sale of which substantial preparation was made before the grant of the reissue, and it may also provide for the continued practice of any process patented by the reissue, practiced, or for the practice of which substantial preparation was made, prior to the grant of the reissue, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before the grant of the reissue.

**§ 253. Disclaimer**

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, and recorded in the Patent Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

**§ 254. Certificate of correction of Patent Office mistake**

Whenever a mistake in a patent, incurred through the fault of the Patent Office, is clearly disclosed by the records of the Office, the Commissioner may issue a certificate of correction stating the fact and nature of such mistake, under seal, without charge, to be recorded in the records of patents. A printed copy thereof shall be attached to each printed copy of the patent, and such certificate shall be considered as part of the original patent. Every such patent, together with such certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form. The Commissioner may issue a corrected patent without charge in lieu of and with like effect as a certificate of correction.

**§ 255. Certificate of correction of applicant's mistake**

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Commissioner may, upon payment of the required

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fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require re-examination. Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form.

### § 256. Misjoinder of inventor

Whenever a patent is issued on the application of persons as joint inventors and it appears that one of such persons was not in fact a joint inventor, and that he was included as a joint inventor by error and without any deceptive intention, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate deleting the name of the erroneously joined person from the patent.

Whenever a patent is issued and it appears that a person was a joint inventor, but was omitted by error and without deceptive intention on his part, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate adding his name to the patent as a joint inventor.

The misjoinder or nonjoinder of joint inventors shall not invalidate a patent, if such error can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Commissioner shall issue a certificate accordingly.

## CHAPTER 26—OWNERSHIP AND ASSIGNMENT

Sec.
261. Ownership; assignment.
262. Joint owners.

### § 261. Ownership; assignment

Subject to the provisions of this title, patents shall have the attributes of personal property.

Applications for patent, patents, or any interest therein, shall be assignable in law by an instrument in writing. The applicant, patentee, or his assigns or legal representatives may in like manner grant and convey an exclusive right under his application for patent, or patents, to the whole or any specified part of the United States.

A certificate of acknowledgment under the hand and official seal of a person authorized to administer oaths within the United States, or, in a foreign country, of a diplomatic or consular officer of the

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United States or an officer authorized to administer oaths whose authority is proved by a certificate of a diplomatic or consular officer of the United States, shall be prima facie evidence of the execution of an assignment, grant or conveyance of a patent or application for patent.

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 its date or prior to the date of such subsequent purchase or mortgage.

### § 262. Joint owners

In the absence of any agreement to the contrary, each of the joint owners of a patent may make, use or sell the patented invention without the consent of and without accounting to the other owners.

## CHAPTER 27—GOVERNMENT INTERESTS IN PATENTS

Sec.
266. Issue of patents without fees to Government employees.
267. Time for taking action in Government applications.

### § 266. Issue of patents without fees to Government employees

The Commissioner may grant, subject to the provisions of this title, to any officer, enlisted man, or employee of the Government, except officers and employees of the Patent Office, a patent without the payment of fees, when the head of a department or agency certifies the invention is used or likely to be used in the public interest and the applicant in his application states that the invention described therein, if patented, may be manufactured and used by or for the Government for governmental purposes without the payment to him of any royalty thereon, which stipulation shall be included in the patent.

### § 267. Time for taking action in Government applications

Notwithstanding the provisions of sections 133 and 151 of this title, the Commissioner may extend the time for taking any action to three years, when an application has become the property of the United States and the head of the appropriate department or agency of the Government has certified to the Commissioner that the invention disclosed therein is important to the armament or defense of the United States.

## CHAPTER 28—INFRINGEMENT OF PATENTS

Sec.
271. Infringement of patent.
272. Temporary presence in the United States.

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§ 271. Infringement of patent

(a) Except as otherwise provided in this title, whoever without authority makes, uses or sells any patented invention, within the United States during the term of the patent therefor, infringes the patent.

(b) Whoever actively induces infringement of a patent shall be liable as an infringer.

(c) Whoever sells a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.

(d) No patent owner otherwise entitled to relief for infringement or contributory infringement of a patent shall be denied relief or deemed guilty of misuse or illegal extension of the patent right by reason of his having done one or more of the following: (1) derived revenue from acts which if performed by another without his consent would constitute contributory infringement of the patent; (2) licensed or authorized another to perform acts which if performed without his consent would constitute contributory infringement of the patent; (3) sought to enforce his patent rights against infringement or contributory infringement.

§ 272. Temporary presence in the United States

The use of any invention in any vessel, aircraft or vehicle of any country which affords similar privileges to vessels, aircraft or vehicles of the United States, entering the United States temporarily or accidentally, shall not constitute infringement of any patent, if the invention is used exclusively for the needs of the vessel, aircraft or vehicle and is not sold in or used for the manufacture of anything to be sold in or exported from the United States.

## CHAPTER 29—REMEDIES FOR INFRINGEMENT OF PATENT, AND OTHER ACTIONS

Sec.

281. Remedy for infringement of patent.
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284. Damages.
285. Attorney fees.
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Sec,
290. Notice of patent suits.
291. Interfering patents.
292. False marking.
293. Nonresident patentee, service and notice.

### § 281. Remedy for infringement of patent

A patentee shall have remedy by civil action for infringement of his patent.

### § 282. Presumption of validity; defenses

A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it.

The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

(1) Noninfringement, ~~or~~ absence of liability for infringement, *or unenforceability*,

(2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability,

(3) Invalidity of the patent or any claim in suit for failure to comply with any requirement of sections 112 or 251 of this title,

(4) Any other fact or act made a defense by this title.

In actions involving the validity or infringement of a patent the party asserting invalidity or noninfringement shall give notice in the pleadings or otherwise in writing to the adverse party at least thirty days before the trial, of the country, number, date, and name of the patentee of any patent, the title, date, and page numbers of any publication to be relied upon as anticipation of the patent in suit or, except in actions in the United States Court of Claims, as showing the state of the art, and the name and address of any person who may be relied upon as the prior inventor or as having prior knowledge of or as having previously used or offered for sale the invention of the patent in suit. In the absence of such notice proof of the said matters may not be made at the trial except on such terms as the court requires.

### § 283. Injunction

The several courts having jurisdiction of cases under this title may grant injunctions in accordance with the principles of equity to prevent the violation of any right secured by patent, on such terms as the court deems reasonable.

### § 284. Damages

~~Upon adjudging a patent valid and infringed,~~ *Upon finding for the claimant* the court shall award the claimant damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court.

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When the damages are not found by a jury, the court shall assess them. In either event the court may increase the damages up to three times the amount found or assessed.

The court may receive expert testimony as an aid to the determination of damages or of what royalty would be reasonable under the circumstances.

**§ 285. Attorney fees**

The court in exceptional cases may award reasonable attorney fees to the prevailing party.

**§ 286. Time limitation on damages**

Except as otherwise provided by law, no recovery shall be had for any infringement committed more than six years prior to the filing of the complaint or counterclaim for infringement in the action.

In the case of claims against the United States Government for use of a patented invention, the period before bringing suit, up to six years, between the date of receipt of a written claim for compensation by the department or agency of the Government having authority to settle such claim, and the date of mailing by the Government of a notice to the claimant that his claim has been denied shall not be counted as part of the period referred to in the preceding paragraph.

**§ 287. Limitation on damages; marking and notice**

Patentees, and persons making or selling any patented article for or under them, may give notice to the public that the same is patented, either by fixing thereon the word "patent" or the abbreviation "pat.", together with the number of the patent, or when, from the character of the article, this can not be done, by fixing to it, or to the package wherein one or more of them is contained, a label containing a like notice. In the event of failure so to mark, no damages shall be recovered by the patentee in any action for infringement, except on proof that the infringer was notified of the infringement and continued to infringe thereafter, in which event damages may be recovered only for infringement occurring after such notice. Filing of an action for infringement shall constitute such notice.

**§ 288. Action for infringement of a patent containing an invalid claim**

Whenever, without deceptive intention, a claim of a patent is invalid, an action may be maintained for the infringement of a claim of the patent which may be valid. The patentee shall recover no costs unless a disclaimer of the invalid claim has been entered at the Patent Office before the commencement of the suit.

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**§ 289. Additional remedy for infringement of design patent**

Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit, but not less than $250, recoverable in any United States district court having jurisdiction of the parties.

Nothing in this section shall prevent, lessen, or impeach any other remedy which an owner of an infringed patent has under the provisions of this title, but he shall not twice recover the profit made from the infringement.

**§ 290. Notice of patent suits**

The clerks of the courts of the United States, within one month after the filing of an action under this title shall give notice thereof in writing to the Commissioner, setting forth so far as known the names and addresses of the parties, name of the inventor, and the designating number of the patent upon which the action has been brought. If any other patent is subsequently included in the action he shall give like notice thereof. Within one month after the decision is rendered or a judgment issued the clerk of the court shall give notice thereof to the Commissioner. The Commissioner shall, on receipt of such notices, enter the same in the file of such patent.

**§ 291. Interfering patents**

The owner of an interfering patent may have relief against the owner of another by civil action, and the court may adjudge the question of the validity of any of the interfering patents, in whole or in part. The provisions of the second paragraph of section 146 of this title shall apply to actions brought under this section.

**§ 292. False marking**

(a) Whoever, without the consent of the patentee, marks upon, or affixes to, or uses in advertising in connection with anything made, used, or sold by him, the name or any imitation of the name of the patentee, the patent number, or the words "patent," "patentee," or the like, with the intent of counterfeiting or imitating the mark of the patentee, or of deceiving the public and inducing them to believe that the thing was made or sold by or with the consent of the patentee; or

Whoever marks upon, or affixes to, or uses in advertising in connection with any unpatented article, the word "patent" or any word or

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number importing that the same is patented, for the purpose of deceiving the public; or

Whoever marks upon, or affixes to, or uses in advertising in connection with any article, the words "patent applied for," "patent pending," or any word importing that an application for patent has been made, when no application for patent has been made, or if made, is not pending, for the purpose of deceiving the public—

Shall be fined not more than $500 for every such offense.

(b) Any person may sue for the penalty, in which event one-half shall go to the person suing and the other to the use of the United States.

§ 293. **Nonresident patentee; service and notice**

Every patentee not residing in the United States may file in the Patent Office a written designation stating the name and address of a person residing within the United States on whom may be served process or notice of proceedings affecting the patent or rights thereunder. If the person designated cannot be found at the address given in the last designation, or if no person has been designated, the United States District Court for the District of Columbia shall have jurisdiction and summons shall be served by publication or otherwise as the court directs. The court shall have the same jurisdiction to take any action respecting the patent or rights thereunder that it would have if the patentee were personally within the jurisdiction of the court.

SEC. 2. Section 21 of the Act approved July 5, 1946, 60 Stat. 435. (United States Code, title 15, sec. 1071, 1946 ed.) is amended by striking out "Revised Statutes 4911" and inserting "35 United States Code, section 141"; by striking out "section 4915, Revised Statutes" and inserting "35 United States Code, sections 145 and 146"; and by striking out "Revised Statutes 4915" appearing twice in said section and inserting "35 United States Code, section 146".

SEC. 3. If any provision of Title 35, as enacted by section 1 hereof, is declared unconstitutional or is held invalid, the validity of the remainder of this title shall not be affected.

SEC. 4. (a) This Act shall take effect on January 1, 1953 and shall apply to all applications for patent filed on or after such date and to all patents granted on such applications. It shall apply to further proceedings on applications pending on such date and to patents granted

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on such applications except as otherwise provided. It shall apply to unexpired patents granted prior to such date except as otherwise provided.

(b) Section 102 (d) of Title 35, as enacted by section 1 hereof, shall not apply to existing patents and pending applications, but the law previously in effect, namely the first paragraph of R. S. 4887 (U. S. Code, title 35, sec. 32, first paragraph, 1946 ed.), shall apply to such patents and applications.

(c) Section 119, second paragraph, of Title 35 as enacted by section 1 hereof shall not apply to existing patents.

(d) The period of one year specified in section 102 (b) of Title 35 as enacted by section 1 hereof shall not apply in the case of applications filed before August 5, 1940, and patents granted on such applications, and with respect to such applications and patents, said period is two years instead of one year.

(e) Nothing contained in Title 35, as enacted by section 1 hereof, shall operate to nullify any judicial finding prior to the effective date of this Act on the validity of any patent by a court of competent jurisdiction.

(f) Nothing in Title 35, as enacted by section 1 hereof, shall affect any provision of the Atomic Energy Act of 1946 (Aug. 1, 1946, ch. 724, 60 Stat. 755).

(g) The period of one year specified in section 4 of Title 35 as enacted by section 1 hereof shall not apply in the case of applications filed before the effective date of this Act.

(h) The repeal of sections 1–9, 11, 12 of the Act of Congress approved February 1, 1952 (ch. 4, 66 Stat. 3), shall not affect any rights or liabilities existing on the date of approval of this Act. An order of secrecy issued under or in effect under the repealed Act and in effect on the date of approval of this Act, shall be considered as issued under this Act, and any claims arising under the repealed Act or subject to presentation and determination pursuant thereto and unsettled as of the effective date of this Act, may be presented and determined pursuant to the provisions of this Act.

SEC. 5. The sections or parts thereof of the Revised Statutes or Statutes at Large enumerated in the following schedule are hereby repealed. Any rights or liabilities now existing under such sections or parts thereof shall not be affected by this repeal.

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[1] The part relating to the granting of patents to Government employees without fees.
[2] The part relating to certified copies of drawings and specifications.
[3] The part relating to fees for recording assignments.
[4] The part amending R. S. 4894.
[5] The part relating to the price of copies of patents.
[6] The part relating to payment of fees.
[7] The part relating to the fee for copies of specifications and drawings of patents.

Passed the House of Representatives May 19, 1952.

Attest: RALPH R. ROBERTS,

*Clerk.*

LEGISLATIVE INTENT SERVICE (800) 666-1917

Calendar No. 1908

82D CONGRESS
2D SESSION

# H. R. 7794

[Report No. 1979]

# AN ACT

To revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents".

MAY 20 (legislative day, MAY 12), 1952
Read twice and referred to the Committee on the Judiciary

JUNE 27, 1952
Reported with amendments

LEGISLATIVE INTENT SERVICE (800) 666-1917

X re HR 7794

# DIGEST OF
# PUBLIC
# GENERAL BILLS

## WITH INDEX

☆ ☆ ☆

LEGISLATIVE INTENT SERVICE (800) 666-1917

**82d CONGRESS**
**2d SESSION**

**No. 6**

**FINAL ISSUE**
**1952**

THE LIBRARY OF CONGRESS
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WASHINGTON, D.C.

## SENATE BILLS

S. 5. Indefinitely postponed June 21, 1952; H. R. 6578 passed in lieu.

Authorizes $2,000,000 to be used by the Secretary of the Interior to construct and operate a demonstration plant and to conduct research and development work, to produce potable water from sea water, or other saline waters, and to conserve and increase the national water resources. Such research shall be coordinated or conducted jointly with the Department of Defense with the purpose of strengthening the defense and civil economy of the Nation.

S. 18. Passed by Senate June 21, 1952.

Authorizes suits against the United States to adjudicate water rights where the United States is acquiring such rights by appropriation under State law and would be a necessary party to the suit. Prohibits joinder of the United States in any suit or controversy in the Supreme Court of the United States involving the right of States to the use of the water of any interstate stream. Requires the Secretary of the Interior to establish and maintain a catalogue listing claims to and ownership of water rights by every Federal department, agency or corporation.

S. 25. Passed by Senate April 4, 1952.

Amends §75 of the Bankruptcy Act and permanently incorporates such section as chapter XVI of the Act including the following principal provisions: Where not inconsistent, chapters 1 to VII of the Bankruptcy Act (court proceedings, etc.) shall apply to proceedings under the new chapter XVI. Jurisdiction over the property of the debtor including unexpired rights of redemption and like interest is given to the courts substantially as under present law. Without regard to the probability of his rehabilitation at the time a petition is filed a debtor may file a petition either in a pending bankruptcy petition or as an original petition in compliance with provisions of this Chapter whereupon the judge shall enter an order approving the petition if satisfied that it complies with the requirements, or if not so satisfied, dismissing it for want of jurisdiction. The filing of such petition shall operate as a stay of a previous pending bankruptcy, mortgage foreclosure, or other similar proceeding or any act or proceeding for the enforcement of a lien against the debtors' property. Upon approval of a petition the judge may refer the proceeding to a referee. The court shall call a meeting of all the creditors to determine the cause of the debtor's distress, the setting apart of his exemptions, and the fixing of the rental to be paid by the debtor on encumbered property retained by him. Such rental shall be paid into the court and shall be apportioned for expenses of administration, taxes, insurance, upkeep, and repayment of creditors.

If the court shall find that the cause of the distress is beyond the debtor's control, a moratorium shall be granted the debtor for the duration of the emergency causing the distress. During the moratorium, the debtor, subject to the supervision and control by the court, shall have a right to manage and operate the property retained and shall file such reports as the court shall require.

Creditors shall have the right, upon petition to the court and 10 days' notice by mail to the debtor and all creditors, to a rehearing of the order at 2-year intervals. If the resulting moratorium may last for more than 4 years from the granting date, any creditor, within 20 days after the entry of the order, may petition for a review. If the emergency is found still to exist, the moratorium shall continue. However, at yearly intervals, any person aggrieved may present the same question.

Within 60 days after a final determination that the emergency has ceased, the debtor may elect an extension, submitting a proposal to the court for the full repayment of secured and allowable unsecured claims, amortized over a term of years not to exceed 10 years at interest not to exceed 5 percent. Upon approval, the extension shall bind all parties and discharge the debtor of all unsecured debts not a part of the proposal.

Upon failure of the debtor to rehabilitate himself provision is made for dismissal of the proceedings or under certain circumstances for the adjudication of the debtor and an order may be entered directing that bankruptcy be proceeded with. Provides for certain income tax exemptions with respect to profits or income accruing because of adjusted indebtedness.

S. 35. Failed of passage June 24, 1952.

S. 50. Recommitted to the Committee on Interior and Insular Affairs February 27, 1952.

S. 97. Approved June 19, 1952 (Public Law 396).

Authorizes $18,200,000 for the construction, operation, and maintenance of facilities for generating hydroelectric power at the Cheatham Dam on the Cumberland River in Tennessee.

S. 103. Approved July 9, 1952 (Public Law 474).

S. 106. Passed by Senate, May 7, 1952.

S. 107. Passed by Senate July 3, 1952.

S. 194. Passed by Senate February 25, 1952.

Prohibits age requirements with respect to appointments to competitive civil service positions during periods of war or national emergency, except such positions as the Civil Service Commission may from time to time publish. Persons 70 years of age or over shall not be appointed except on a temporary basis.

S. 216. Approved June 24, 1952 (Public Law 407).

S. 241. Approved July 17, 1952 (Public Law 586).

Broadens eligibility for merchant marine construction subsidies by eliminating existing requirements as to essentiality of service, route, or line to be served by the vessel. Permits the balance of purchase payments due on certain larger passenger ships approved by the Secretary of



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the graduated special rates, where several pensions are payable, from $240 to $266, $282 to $313, $318 to $353, and $360 to $400; authorizing a payment of $47 a month to veterans of service subsequent to World War I for loss of a creative organ, and increasing the World War I pension rate for such a loss to $50; granting an award of $67 for veterans of World War II and the Korean War for a completely arrested case of service-connected tuberculosis, and increasing the rate of this award for World War I veterans to the same amount. Increases, as well, "the statutory award" World War I pensions by 11 percent, and sets the maximum extra amount for World War I veterans requiring an attendant at $67 (now $60) [amending Vet. Reg. 1(a) pt. I, par. II (k) through (p), and U. S. C. 38:473, 479].

H. R. 7794. Approved July 19, 1952 (Public Law 593).

H. R. 7800. Approved July 18, 1952 (Public Law 590).

Social Security Act Amendments of 1952 - Increases social security benefits by approximately 12-1/2 percent by (1) raising the minimum primary insurance benefit payable under the conversion table to $25 (now $20) and the maximum to $77.10 (now $68.50); and (2) revising the benefit formula to take 55 percent of the first $100 of wages (now 50 percent thereof) plus 15 percent of the next $200. Increases the maximum individual benefits payable to $168.75 (now $150) or 70 percent of the insured individual's average monthly wage whichever is the lesser, but in no event shall they be reduced below $45. Increases the maximum amount that beneficiary under 75 may earn to $75 (now $50) without incurring any diminution of his benefits.

Provides for a waiver of premium during those quarters of coverage in which an insured individual is permanently or totally disabled, or suffers from a specified degree of blindness. The disability must have continued for at least 6 months and the individual: (1) must be unable to perform any substantially gainful work as the result of physical or mental impairment, or is blind; (2) is under the age of 65; (3) has applied for the benefits; (4) served the 6 months waiting period; (5) had not less than 6 quarters of coverage during the 13 quarter period and 20 quarters of coverage during the 40 quarter period, that end with the quarter in which his disability determination date occurred. Directs the Administrator to enter into agreements with State agencies so that the latter shall make the first determinations as to disability compensation. The Administrator may make redeterminations of eligibility after reasonable notice and hearing.

Establishes wage credits of $160 a month toward Social Security benefits for war veterans (now World War II veterans) for each month of active military or naval service. Extends the time normally permitted for claiming a lump-sum death payment as reimbursement for burial expenses to 2 years of date of reinterment as well as present 2 years from date of death. Applies to deaths of servicemen abroad between June 25, 1947 and January, 1954.

Makes technical amendments to include within quarters of coverage the quarter within which retirement took place, if such inclusion is necessary to obtain maximum benefits for beneficiaries retiring at age 75.

Maintains existing relationship between Social Security and Railroad Retirement systems, and permits beneficiaries of the latter to earn up to $75 a month without jeopardizing retirement benefits.

Effective July 1, 1952, permits the States to disregard the earned income of a recipient of aid to the blind in determining the need of his dependents under any other State public assistance plan approved under the Social Security Act, and makes this requirement compulsory after June 30, 1954.

For a two year period beginning October 1, 1952, establishes the Federal share of State public assistance payments for old age assistance, aid to the blind and aid to the permanently and totally disabled at 4/5 of the first $25, plus 1/2 of the remainder with an individual maximum of $55; and the Federal share of aid to dependent children at 4/5 of the first $15, plus 1/2 of remainder, with individual maximum of $30.

H. R. 7806. Approved July 17, 1952 (Public Law 584).

Extends the permission granted Government employees who are veterans to take 4 hours leave without loss of pay or annual leave to participate in funeral services of all members of the Armed Forces whose remains are returned from abroad for final interment in the United States (now limited to those who lost life in World War II). Designates the chief legal officer of the Department of Commerce as General Counsel (now Solicitor) [amending U. S. C. 5:30].

H. R. 7817. Passed by House July 1, 1952.

H. R. 7855. Approved July 16, 1952 (Public Law 551).

H. R. 7860. Approved June 30, 1952 (Public Law 431).

H. R. 7871. Reported in House June 27, 1952.

Authorizes the Postmaster General to provide for the use in first- and second-class post offices of special canceling stamps or postmarking dies in order to encourage voting in general elections [amending U. S. C. 39:368].

H. R. 7876. Approved July 8, 1952 (Public Law 468).

H. R. 7877. Approved July 3, 1952 (Public Law 444).

H. R. 7888. Reported in House July 20, 1952.

H. R. 7952. Approved July 11, 1952 (Public Law 512).

H. R. 7993. Laid on table July 2, 1952; S. 3337 passed in lieu.

Authorizes the President to loan two submarines to the Government of the Netherlands for use by that Government until the completion of two submarines by the Netherlands, but not to exceed 5 years.

H. R. 8006. Approved July 14, 1952 (Public Law 541).

Adjusts the compensation of employees transferred from the field service of the Post Office Department to the General Services Administration pursuant to Reorganization Plan Numbered 18 of 1950, who had completed sufficient service to entitle them to an annual automatic increase in compensation under Public Law 134, 79th Congress, or to a longevity increase in compensation under Public Law 500, 81st Congress.

H. R. 8086. Reported in House June 11, 1952.

H. R. 8120. Approved July 14, 1952 (Public Law 534).

Authorizes construction program at military and naval installations inside and outside continental Unites States in the following amounts: Army, $328,047,800; Navy, $256,875,000; Air Force, $1,813,360,000.

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H. R. 7762. Mr. Taylor; May 7, 1952 (Interior and Insular Affairs).

Directs the Secretary of the Interior to acquire the building formerly owned by "Uncle Sam" Wilson in Troy, New York. Such building shall be renovated, preserved, etc., as a part of the National Park Service.

H. R. 7778. Mr. Trimble; May 8, 1952 (Public Works).

Authorizes sums for the acquisition of land and erection of certain post offices and Federal court buildings in Bluefield, West Virginia; Lake Charles, Louisiana; and Council Bluffs, Iowa.

H. R. 7779. Mr. August H. Andresen; May 8, 1952 (Ways and Means).

Permits a recipient of Social Security benefits to earn up to $250 in any month (now $50) [amending U. S. C. 42: 403].

H. R. 7780. Mr. Davis of Tennessee; May 8, 1952 (Public Works).

Authorizes an appropriation of $35,000,000 to be expended by the Secretary of the Army for emergency flood-control work made necessary by the recent floods, and provides that pending the appropriation the sum may be allotted from existing flood-control appropriations.

H. R. 7781. Mr. Mansfield; May 8, 1952 (Education and Labor).

Indian Higher Education Act of 1952 - Provides financial assistance to the several States, Hawaii, Alaska, and Puerto Rico to aid in providing scholarships for Indian high-school graduates so that they will be able to pursue their education at higher educational institutions.

H. R. 7782. Mr. O'Hara; May 8, 1952 (Interstate and Foreign Commerce).

Provides equal opportunity for all candidates for office in a public election to use, in person, the facilities of a broadcasting station; prohibits any exercise by the licensee of political or partisan censorship over the material broadcast. Imposes no obligation on the licensee to allow the use of its broadcasting station, or to permit broadcasting of material which would subject it to civil or criminal action by any local, State or Federal court. Provides that the Federal Communications Commission shall issue rules and regulations to carry this into effect within one year after enactment [amending U. S. C. 47:315].

H. R. 7783. Mr. Rankin; May 8, 1952 (Veterans' Affairs).

Increases the "statutory award" veterans' pensions by giving veterans suffering from anatomical injuries an average 19 percent increase; raising the special rates where several pensions are payable from $240-$318 to $266-$353; authorizing a payment of $50 a month to veterans of service subsequent to World War I for loss of a creative organ, and increasing the World War I pension rate for such a loss to $50; granting an award of $70 for veterans of World War II and the Korean War for a completely arrested case of service-connected tuberculosis, and increasing the rate of this award for World War I veterans to the same amount. Increases, as well, "the statutory award" World War I pensions by 11 percent, and sets the maximum extra amount for World War I veterans requiring an attendant at $67 (now $60) [amending Vet. Reg. 1 (a) pt. I, par. II, (k) through (p), and U. S. C. 38:473, 478].

H. R. 7784. Mr. Simpson of Pennsylvania; May 8, 1952 (Ways and Means).

Increases the excess profits credit against current excess profits net income by providing for an adjustment in base period net income with respect to branch losses as follows: (1) the excess profits tax net income for the base period of the taxpayer is increased by (a) the excess of the branch loss for such base year over the loss, if any, incurred by the branch during the current taxable year, and (b) the amount obtained by multiplying such assets of the taxpayer's business as were attributable to the branch during the year of loss by the branch's rate of return for that year under the industry classification schedule; but (2) this allowance is made only when such branch loss exceeded 10 percent of the aggregate excess profits net income of the taxpayer for such taxable year. Defines branch as a business separated from that of the taxpayer and substantially different [amending U. S. C. 26:433 (b)].

H. R. 7785. Mr. Smith of Mississippi; May 8, 1952 (Interstate and Foreign Commerce).

Creates a national committee to be known as the Advisory Committee on Weather Control. Such Committee shall make a complete study and evaluation of public and private experiments in weather control for the purpose of determining the extent to which the United States should experiment with, engage in, or regulate activities designed to control weather conditions.

H. R. 7793. Mr. August H. Andresen; May 12, 1952 (Agriculture).

Provides that whenever there are any standards governing the production, handling, packaging, etc., of domestic plant or animal life intended to be used as food products, the Secretary of Agriculture, either on his own motion, or on petition of producers, packagers, etc., of the same products in this country, may apply such regulations to imported food products.

H. R. 7794. Mr. Bryson; May 12, 1952 (Judiciary).

Revises, codifies, and enacts into positive law title 35 of the United States Code (Patents).

H. R. 7795. Mr. Aandahl; May 12, 1952 (Public Works).

Authorizes $450,000 for the construction and furnishing by the Corps of Engineers of adequate elementary and high-school facilities at Newtown, North Dakota, as part of the comprehensive plans for flood control in the Missouri River Basin.

H. R. 7796. Mr. Abernethy; May 12, 1952 (Agriculture).

Repeals the State grants-in-aid aspect of the soil conservation program; repeals the time limitation on the power granted the Secretary of Agriculture to make direct

LEGISLATIVE INTENT SERVICE (800) 666-1917

X re HR 7794

United States
*of* America

# Congressional Record

PROCEEDINGS AND DEBATES OF THE 82d CONGRESS, SECOND SESSION

# *Index*

VOLUME 98—PART 12

JANUARY 8, 1952, TO JULY 7, 1952



LEGISLATIVE INTENT SERVICE (800) 666-1917

UNITED STATES GOVERNMENT PRINTING OFFICE, WASHINGTON, 1952

# HISTORY OF BILLS AND RESOLUTIONS

## SENATE BILLS

S. 5—To provide for research into and demonstration of practical means for the economical production, from sea or other saline waters, or from the atmosphere (including cloud formations), of water suitable for agricultural, industrial, municipal, and other beneficial consumptive uses, and for other purposes.
Reported with amendment (S. Rept. 1103) 365.—Objected to, 487.—Indefinitely postponed (H. R. 6578 passed in lieu) 7782.

S. 16—To provide for payment of an annuity to widows of judges.
Objected to, 478.

S. 18—To authorize suits against the United States to adjudicate and administer water rights.
Objected to, 473.—Reported with additional amendment (S. Rept. 755, pt. 2) 3334.—Objection withdrawn, 7703.—Amended and passed Senate, 7817.—Referred to House Committee on the Judiciary, 7882.

S. 25—To amend an act entitled "An act to establish a uniform system of bankruptcy throughout the United States", approved July 1, 1898, and acts amendatory thereof and supplementary thereto.
Reported with amendment (S. Rept. 1303) 2220.—Objected to, 2751.—Debated, 3441, 3464.—Amended and passed Senate, 3469.—Referred to House Committee on the Judiciary, 3660.

S. 32—To amend title 28, United States Code, section 456, so as to increase to $15 per day the limit on subsistence expenses allowed to justices and judges traveling while attending court or transacting official business at places other than their official stations, and to authorize reimbursement for such travel by privately owned automobiles at the rate of 7 cents per mile.
Objected to, 475, 9050.

S. 35—To provide for the appointment of deputy United States marshals without regard to the provisions of the civil-service laws and regulations.
Objected to, 475.—Rejected in Senate, 7915.

S. 49—To enable the people of Hawaii to form a constitution and State government and to be admitted into the Union on an equal footing with the original States.
Objected to, 475, 9050.

S. 50—To provide for the admission of Alaska into the Union.
Objected to, 475.—Debated, 719, 751, 953, 988, 1066, 1077, 1114, 1129, 1131, 1183, 1185, 1194, 1237, 1241, 1253, 1324, 1369, 1378, 1409, 1498.—Recommitted to Committee on Interior and Insular Affairs with certain instructions, 1537.—Motion to reconsider vote entered, 1705.

S. 54—For the relief of Stella Jean Stathopoulou.
Reported back (H. Rept. 2228), 7770.—Passed House, 8755.—Examined and signed, 8874, 9039.—Presented to the President, 9047.—Approved [Private Law 848], 9733.

S. 56—For the relief of Francis Kucen San Thu, Mary Luke Thu, Catherine Thu, Victoria Thu, and Anne Bernadette Thu.
Reported back (H. Rept. 1300), 944.—Passed House, 1144.—Examined and signed, 1183, 1223.—Presented to the President, 1183.—Approved [Private Law 455], 1791.

S. 64—For the relief of Helen Dick.
Reported back (H. Rept. 1230), 210.—Passed House, 821.—Examined and signed, 894, 944.—Presented to the President, 898.—Approved [Private Law 64], 1056.

S. 97—To authorize the construction, operation, and maintenance of facilities for generating hydroelectric power at the Cheatham Dam on the Cumberland River in Kentucky.
Made special order (H. Res. 654), 6876.—Debated, amended, and passed House, 6877.—Senate concurs in House amendment, 6904.—Examined and signed, 7005, 7077.—Presented to the President, 7007.—Approved [Public Law 396], 7064.

S. 103—To change the name of Medicine Creek Reservoir in Frontier County of the State of Nebraska to "Harry Strunk Lake."
Reported with amendment (S. Rept. 1729), 7006.—Amended and passed Senate, 7801.—Referred to House Committee on Interior and Insular Affairs, 7882.—Passed House (in lieu of H. R. 51), 8921.—Examined and signed, 9330, 9461.—Presented to the President, 9465.—Approved [Public Law 474], 9732.

S. 106—To amend the act entitled "An act to regulate the practice of optometry in the District of Columbia."
Objected to, 478.—Amended and passed Senate, 4891.—Referred to House Committee on the District of Columbia, 4966.

S. 107—To promote the rehabilitation of the Papago Tribe of Indians and a better utilization of the resources of the Papago Tribe, and for other purposes.
Reported back (S. Rept. 1823), 7952.—Passed Senate, 9069.

S. 142—For the relief of Vito Rizzi.
Reported with amendment (S. Rept. 1904), 8250.—Amended and passed Senate, 9088.

S. 148—For the relief of Gerdina Josephine Van Delft.
Reported with amendment (S. Rept. 1243), 1698.—Amended and passed Senate, 2739.—Referred to House Committee on the Judiciary, 2984.—Reported back (H. Rept. 1875), 5080.—Passed House, 5567.—Examined and signed, 5705, 5753.—Presented to the President, 5753.—Approved [Private Law 638], 6334.

S. 171—For the relief of Mrs. Hildegard Pielecki Kennedy.
Reported back (S. Rept. 1201), 2072.—Passed Senate, 2742.—Referred to House Committee on the Judiciary, 2984.—Reported back (H. Rept. 1686), 3566.—Passed House, 4838.—Examined and signed, 4966, 4968.—Presented to the President, 4972.—Approved [Private Law 630], 5514.

S. 172—To amend section 32 of the Trading With the Enemy Act of 1917, as amended, so as to permit the return under such section of property which an alien acquired, by gift, devise, bequest, or inheritance, from an American citizen.
Objected to, 476, 9051.

S. 183—For the relief of Elfriede Ehrhardt Otto.
Reported back (H. Rept. 1464), 1890.—Passed House, 2474.—Examined and signed, 2544, 2546.—Presented to the President, 2548.—Approved [Private Law 492], 3145.

S. 194—To prohibit age requirements or limitations with respect to the appointment of persons to positions in the competitive civil service during periods of war or national emergency.
Reported with amendments (S. Rept. 1164), 948.—Amended and passed Senate, 1297.—Referred to House Committee on Post Office and Civil Service, 1448.

S. 211—For the relief of Maria Enriquez.
Reported back (H. Rept. 1301), 944.—Passed House, 1145.—Examined and signed, 1183, 1223.—Presented to the President, 1183.—Approved [Private Law 456], 1791.

S. 214—For the relief of Mrs. Juan Antonio Rivera, Mrs. Raul Valle Antelo, Mrs. Jorge Diaz Romero, Mrs. Otto Resse, and Mrs. Hugo Soria.
Reported with amendment (H. Rept. 2097), 6868.—Amended and passed House, 7381.—Senate disagrees to House amendment and asks for a conference, 7682.—Conferees appointed, 7682.

S. 216—To amend section 631b of title 5, United States Code, by adding a new subsection, to be cited as subsection (c).
Reported back (H. Rept. 1873), 5080.—Objected to, 5454.—Passed House, 7277.—Examined and signed, 7330, 7450.—Presented to the President, 7332.—Approved [Public Law 407], 7951.

S. 241—To amend the Merchant Marine Act, 1930, as amended, to further promote the development and maintenance of the American merchant marine, and for other purposes.
Reported with amendment (H. Rept. 2221), 7663.—Amended and passed House, 8314.—Senate disagrees to House amendments and asks for a conference, 8411.—Conferees appointed, 8412.—House insists on its amendments and asks for a conference, 8658.—Conferees appointed, 8659.—Conference report (No. 2450) submitted in House and agreed to, 9215.—Conference report submitted in Senate and agreed to, 9169.—Examined and signed, 9498, 9640.—Presented to the President, 9710.—Approved [Public Law 586], 9733.

S. 302—To amend section 32 (a) (2) of the Trading With the Enemy Act.
Reported with amendment (H. Rept. 1723), 3661.—Amended and passed House, 3773.—Senate disagrees to House amendment and asks for a conference, 5141.—Conferees appointed, 5141.—House insists on its amendment and agrees to a conference, 5578.—Conferees appointed, 5578.—Conference report (No. 2003) submitted in House,



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S. Res. 344—Referring the bill (S. 1609) with accompanying papers to the Court of Claims.
Mr. McCarran, from Committee on the Judiciary (S. Rept. 1873), 8251.—Passed Senate, 9089.

S. Res. 345—To print additional copies of Senate Document 1689, Eighty-first Congress, relative to operations of the Reconstruction Finance Corporation.
Mr. Green; Committee on Rules and Administration, 8545.—Reported back (no written report), 8707.—Passed Senate, 8707.

S. Res. 346—Authorizing the printing of additional copies of the report entitled "Institute of Pacific Relations."
Mr. Hayden; considered and agreed to, 8863.

S. Res. 347—Increasing the limit of expenditures for hearings before the Committee on Armed Services.
Mr. Russell, from Committee on Armed Services, reported back (no written report), and referred to Committee on Rules and Administration, 8811.—Reported, considered, and agreed to, 9173.

S. Res. 348—Providing for a study of problems and matters relating to fair-trade practices.
Mr. Humphrey; Committee on Interstate and Foreign Commerce, 8892.

S. Res. 349—Favoring Federal and State cooperation to provide opportunity for absentee soldier voting in the 1952 elections.
Mr. Bridges, Mr. McFarland, Mr. Saltonstall, Mr. Ferguson, Mr. Hendrickson, Mr. Welker, Mr. Cain, Mr. Johnson of Texas, Mr. Schoeppel, Mr. Capehart, Mr. Martin, Mr. Bricker, Mr. Butler of Nebraska, Mr. Jenner, Mr. Smith of New Jersey, Mr. Watkins, Mr. Ives, Mr. Mundt, Mr. Dworshak, Mr. Malone, Mr. McCarthy, Mr. Butler of Maryland, Mr. Hickenlooper, Mr. Langer, and Mr. Morse; ordered to lie on the table, 9252.—Passed Senate, preamble agreed to, 9486.—Title amended, 9486.

S. Res. 350—To discharge the Committee on Foreign Relations from the further consideration of certain resolutions relating to the imprisonment of William N. Oatis and John Hvasta.

S. Res. 350—Continued
Mr. McCarthy; ordered to lie on the table, 9468.

S. Res. 351—To discharge the Committee on Public Works from the further consideration of H. R. 7778, relative to the erection of certain public buildings.
Mr. Hickenlooper; ordered to lie over under the rule, 9540.—Objected to, 9540.

S. Res. 352—Authorizing the Committee on Rules and Administration to investigate expenditures by and on behalf of presidential candidates.
Mr. Humphrey; Committee on Rules and Administration, 9547.

S. Res. 353—Thanking the President pro tempore for the manner in which he has presided over the Senate.
Mr. Cordon; considered and agreed to, 9728.

S. Res. 354—Thanking the Vice President for the manner in which he has presided over the Senate.
Mr. McFarland; considered and agreed to, 9730.

# HOUSE BILLS 15–648

H. R. 15—To provide for the incorporation, regulation, merger, consolidation, and dissolution of certain business corporations in the District of Columbia.
Reported back (H. Rept. 1522), 2438.—Passed House, 2762.—Referred to Senate Committee on the District of Columbia, 2789.

H. R. 36—To amend title 28, United States Code, section 456, so as to increase to $15 per day the limit on subsistence expenses allowed to justices and judges while attending court or transacting official business at places other than their official station, and to authorize reimbursement for such travel by privately owned automobiles at a rate of not exceeding 7 cents per mile.
Objected to, 475, 9050.

H. R. 51—To change the name of Medicine Creek Reservoir in Frontier County of the State of Nebraska to Harry Strunk Lake.
Reported back (H. Rept. 2296), 3087.—Laid on the table (S. 103 passed in lieu), 8921.

H. R. 156—To repeal the Alaska railroads tax.
Reported with amendment (H. Rept. 1710), 3566.—Amended and passed House, 3615.—Referred to Senate Committee on Finance, 3668.—Reported back (S. Rept. 1577), 5192.—Passed Senate, 6284.—Examined and signed, 6492, 6575.—Presented to the President, 6676.—Approved [Public Law 386], 7712.

H. R. 160—To amend section 5192 of the Revised Statutes, with respect to the reserves of certain national banks.
Reported back (H. Rept. 1616), 2656.—Passed House, 3190.—Referred to Senate Committee on Banking and Currency, 3225.—Reported back (S. Rept. 1624), 6273.—Passed Senate, 7817.—Examined and signed, 7885, 7950.—Presented to the President, 8087.—Approved [Public Law 433], 9185.

H. R. 168—To extend the statute of limitations with respect to certain suits.
Reported back (H. Rept. 2329), 8393.—Passed House, 8027.—Referred to Senate Committee on the Judiciary, 9048.

H. R. 287—Relative to granting and giving instructions in civil and criminal cases in the district courts of continental United States.
Reported with amendment (H. Rept. 1526), 2438.—Recommitted to Committee on the Judiciary, 4805.

H. R. 401—To amend the Nationality Act of 1940, as amended.
Amended and passed House, 776.—Referred to Senate Committee on the Judiciary, 787.—Reported with amendments (S. Rept. 1713), 6811.—Objected to, 7798.—Amended and passed Senate, 9061. (House refused Senate amendments. Omitted in Record.)

H. R. 404—To amend the Military Personnel Claims Act of 1945.
Reported back (S. Rept. 1691), 6811.—Amended and passed Senate, 7797.—House concurs in Senate Amendment, 8079.—Examined and signed, 8089, 8247.—Presented to the President, 8542.—Approved [Public Law 439], 9752.

H. R. 459—To confer jurisdiction on the several States over offenses committed by or against Indians within Indian country.
Reported with amendment (H. Rept. 1640), 2870.—Amended and passed House, 3194.—Referred to Senate Committee on Interior and Insular Affairs, 3225.

H. R. 472—To permit the mining, development, and utilization of the mineral resources of all public lands withdrawn or reserved for power development, and for other purposes.
Reported with amendment (H. Rept. 1296), 839.—Amended and passed House, 3187.—Referred to Senate Committee on Interior and Insular Affairs, 3225.

H. R. 554—To amend section 6 of the act of August 24, 1912, as amended, with respect to the recognition of organizations of postal and Federal employees.
Reported with amendment (H. Rept. 2311), 8088.—Objected to, 8929.

H. R. 575—For the relief of Dr. Alexander Fiala.
Reported with amendment (H. Rept. 1333), 969.—Amended and passed House, 1152.—Referred to Senate Committee on the Judiciary, 1171.

H. R. 586—To authorize the Secretary of the Interior to sell certain land on the Chena River to the Tanana Valley Sportsmen's Association, of Fairbanks, Alaska.
Reported with amendment (S. Rept. 1462), 4053.—Amended and passed Senate, 4657.—House concurs in Senate amendment, 4799.—Examined and signed, 4858, 4861.—Presented to the President, 4968.—Approved [Public Law 596], 5244.

H. R. 598—For the relief of Alaska Juneau Gold Mining Co., of Juneau, Alaska.
Objected to, 481, 9054.

H. R. 607—For the relief of Ronald Yee.
Reported back (H. Rept. 1323), 945.—Passed House, 1147.—Referred to Senate Committee on the Judiciary, 1171.—Reported back (S. Rept. 1366), 3334.—Passed Senate, 3806.—Examined and signed, 3954, 3997.—Presented to the President, 4238.—Approved [Private Law 560], 4218.

H. R. 615—For the relief of Samuel David Fried.
Reported back (H. Rept. 1334), 969.—Passed House, 1152.—Referred to Senate Committee on the Judiciary, 1171.

H. R. 843—For the relief of Mrs. Vivian M. Graham and Herbert H. Graham.
Reported with amendment (S. Rept. 1252), 1698.—Objected to, 2751, 3801.—Amended and passed Senate, 6282.—House concurs in Senate amendment, 6625.—Examined and signed, 6830, 6867.—Presented to the President, 7002.—Approved [Private Law 711], 7712.

H. R. 646—For the relief of Mrs. Inez B. Co[illegible] and George T. Copp.
Reported with amendment (S. Rept. 1253), 1698.—Objected to, 2751, 3801.—Amended and passed Senate, 6282.—Examined and signed, 6830, 6887.—Presented to the President, 7002.—Approved [Private Law 712], 7712.

H. R. 648—To record the lawful admission for permanent residence of aliens Max Mayer Hirsch Winzelberg and Mrs. Jenty Fuss De Winzelberg.
Reported back (S. Rept. 1238), 1698.—Passed Senate, 2741.—Examined and signed, 2869, 2872.—Presented to the President, 3090.—Approved [Private Law 528], 3756.

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H. R. 7751—To extend the period during which vocational rehabilitation training may be provided for certain World War II veterans who were hospitalized for service-connected disability.
Mr. McCarthy; Committee on Veterans' Affairs, 4929.

H. R. 7752—To allow a deduction for income tax purposes of certain expenses incurred by the taxpayer for the education of a dependent.
Mr. Multer; Committee on Ways and Means, 4929.

H. R. 7753—To amend the Interstate Commerce Act in order to prohibit the Interstate Commerce Commission from restricting the right of a motor carrier to add to its equipment, and for other purposes.
Mr. Rogers of Florida; Committee on Interstate and Foreign Commerce, 4929.

H. R. 7754—To amend section 811 (d) of the Internal Revenue Code so as to limit its application in certain disability cases.
Mr. Simpson of Pennsylvania; Committee on Ways and Means, 4929.

H. R. 7755—To amend section 8 of the act to amend certain provisions of the Internal Revenue Code (Public Law 378, 81st Cong.) to permit persons under a disability to take advantage of same.
Mr. Simpson of Pennsylvania; Committee on Ways and Means, 4929.

H. R. 7756—To amend section 315 of the Communications Act of 1934, with respect to the use of broadcasting facilities by candidates for public office.
Mr. Sutton; Committee on Interstate and Foreign Commerce, 4929.

H. R. 7757—To grant preference to disabled veterans of World War II in making homestead entry on public lands.
Mr. Yorty; Committee on Interior and Insular Affairs, 4929.

H. R. 7758—To revise certain laws relating to the mail-messenger service.
Mr. Lantaff; Committee on Post Office and Civil Service, 4929.—Reported back (H. Rept. 1927, 5138.—Passed House, 5464.—Referred to Senate Committee on Post Office and Civil Service, 5516.—Reported back (S. Rept. 1799), 7577.—Passed Senate, 7813.—Examined and signed, 7885, 7950.—Presented to the President, 8087.—Approved [Public Law 443], 9752.

H. R. 7759—To amend section 1699, title 18, United States Code, relating to the unloading of mail from vessels.
Mr. Lantaff; Committee on Post Office and Civil Service, 4929.

H. R. 7760—To amend the act of August 23, 1950 (Public Law 727, 81st Cong.), entitled "An act to direct the Secretary of the Interior to convey abandoned school properties in the Territory of Alaska to local school officials."
Mr. Bartlett; Committee on Interior and Insular Affairs, 4930.

H. R. 7761—To provide for the acquisition and preservation, as a part of the National Park Service, of the building formerly owned by "Uncle Sam" Wilson which is located at 144 Ferry Street, Troy, N. Y.
Mr. O'Brien of New York; Committee on Interior and Insular Affairs, 4930.

H. R. 7762—To provide for the acquisition and preservation, as a part of the National Park Service, of the building formerly owned by "Uncle Sam" Wilson which is located at 144 Ferry Street, Troy, N. Y.
Mr. Taylor; Committee on Interior and Insular Affairs, 4930.

H. R. 7763—For the relief of Vincenza Rallo Pulizzi.
Mr. Anfuso; Committee on the Judiciary, 4930.

H. R. 7764—For the relief of Salvatore Gerlando Faldetta.
Mr. Anfuso; Committee on the Judiciary, 4930.

H. R. 7765—For the relief of Guiseppe Borrometi.
Mr. Anfuso; Committee on the Judiciary, 4930.

H. R. 7766—For the relief of Michele Vitale, also known as Michael Vitale.
Mr. Anfuso; Committee on the Judiciary, 4930.

H. R. 7767—For the relief of Chieko Dohi.
Mr. Dondero; Committee on the Judiciary, 4930.

H. R. 7768—For the relief of Mary Ann Wilkinson.
Mr. Hillings; Committee on the Judiciary, 4930.

H. R. 7769—For the relief of Grigorios Phillipidis (also known as Gregory Phillips).
Mr. Hunter; Committee on the Judiciary, 4930.

H. R. 7770—For the relief of Ng Gin Wei.
Mr. Kilday; Committee on the Judiciary, 4930.

H. R. 7771—For the relief of Pasquale Patricelli.
Mr. Mitchell; Committee on the Judiciary, 4930.

H. R. 7772—For the relief of Mrs. Yacko Ito Aoki.
Mr. Mitchell; Committee on the Judiciary, 4930.

H. R. 7773—For the relief of Anastasios John Kouvaras.
Mr. Rhodes; Committee on the Judiciary, 4930.

H. R. 7774—For the relief of Jerry Pagoulatos.
Mrs. St. George; Committee on the Judiciary, 4930.

H. R. 7775—For the relief of Gertrud Sander and her minor daughter, Irene Sander.
Mr. Walter; Committee on the Judiciary, 4930.

H. R. 7776—For the relief of Nicolas de Rochefort.
Mr. Walter; Committee on the Judiciary, 4930.

H. R. 7777—For the relief of Nettie E. Whitfield.
Mr. Wickersham; Committee on the Judiciary, 4930.

H. R. 7778—To authorize emergency appropriations for the purpose of erecting certain post office and Federal court buildings, and for other purposes.
Mr. Trimble; Committee on Public Works, 4967.—Reported with amendment (H. Rept. 1853), 4967.—Passed House, 7768.—Referred to Senate Committee on Public Works, 7822.

H. R. 7779—To amend the Social Security Act, as amended, to permit individuals entitled to old-age or survivors insurance benefits to earn $250 per month without deductions being made from their benefits.
Mr. August H. Andresen; Committee on Ways and Means, 4967.

H. R. 7780—To provide for emergency flood-control work made necessary by recent floods, and for other purposes.
Mr. Davis of Tennessee; Committee on Public Works, 4967.

H. R. 7781—To assist the several States in providing scholarships to enable high-school graduates of Indian blood to pursue their education at colleges and universities.
Mr. Mansfield; Committee on Education and Labor, 4967.

H. R. 7782—To amend section 315 of the Communications Act of 1934.
Mr. O'Hara; Committee on Interstate and Foreign Commerce, 4967.

H. R. 7783—To increase certain rates of veterans' compensation provided for specific service-incurred disabilities, and for other purposes.
Mr. Rankin; Committee on Veterans' Affairs, 4967.—Reported back (H. Rept. 1931), 5291.—Rules suspended; passed House, 5486.—Referred to Senate Committee on Finance, 5516.—Reported with amendments (S. Rept. 1681), 6679.—Amended and passed Senate, 7790.—House concurs in Senate amendment, 7854.—Examined and signed, 7885, 7950.—Presented to the President, 8087.—Approved [Public Law 427], 9185.

H. R. 7784—To amend section 433 (h) of the Internal Revenue Code.
Mr. Simpson of Pennsylvania; Committee on Ways and Means, 4967.

H. R. 7785—To create a committee to study and evaluate public and private experiments in weather modification.
Mr. Smith of Mississippi; Committee on Interstate and Foreign Commerce, 4967.

H. R. 7786—For the relief of Rosario Balzano.
Mr. Anfuso; Committee on the Judiciary, 4967.

H. R. 7787—For the relief of Fumiko Nakane.
Mr. Burleson; Committee on the Judiciary, 4967.

H. R. 7788—To provide for the issuance of a license to practice chiropractic in the District of Columbia to Anderson Brown.
Mr. Dorn; Committee on the District of Columbia, 4967.

H. R. 7789—For the relief of Golda I. Stegner.
Mr. Judd; Committee on the Judiciary, 4967.

H. R. 7790—For the relief of Tong Su Lien.
Mr. Klein; Committee on the Judiciary, 4967.

H. R. 7791—For the relief of the Sacred Heart Hospital.
Mr. Mansfield; Committee on the Judiciary, 4967.

H. R. 7792—For the relief of Mrs. Maria Verrecchia.
Mr. Rahaut; Committee on the Judiciary, 4967.

H. R. 7793—To provide for standards to be prescribed by the Secretary of Agriculture governing imported agricultural food products.
Mr. August H. Andresen; Committee on Agriculture, 5081.

H. R. 7794—To revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents."
Mr. Bryson; Committee on the Judiciary, 5081.—Reported back (H. Rept. 1923), 5080.—Passed House, 5455.—Referred to Senate Committee on the Judiciary, 5516.—Reported with amendments (S. Rept. 1979), 8251.—Amended and passed Senate, 9096.—Vote reconsidered, 9097.—Objected to, 9116.—Amended and passed Senate, 9323.—House concurs in Senate amendment, 9451.—Examined and signed, 9527, 9702.—Presented to the President, 9750.—Approved [Public Law 593], 9756.

H. R. 7795—To modify the comprehensive plans for flood control in the Missouri River Basin to provide for the inclusion in such plans of adequate elementary and high-school facilities at Newtown, N. Dak., to replace the facilities located in Sanish and Van Hook, N. Dak., which are to be abandoned as a result of the construction of the Garrison Dam and Reservoir.
Mr. Aandahl; Committee on Public Works, 5081.



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X re HR 7794

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# Congressional Record

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Mr. REAMS: Committee on Post Office and Civil Service. H. R. 7030. A bill to amend certain acts and parts of acts which require the submission of documents to the Post Office Department under oath, and for other purposes; without amendment (Rept. No. 1868). Referred to the Committee of the Whole House on the State of the Union.

Mr. COOLEY: Committee on Agriculture. H. R. 7689. A bill to amend the Soil Conservation and Domestic Allotment Act, as amended; without amendment (Rept. No. 1869). Referred to the Committee of the Whole House on the State of the Union.

Mr. JARMAN: Committee on Post Office and Civil Service. H. R. 2390. A bill to rescind certain details required by law to be included in the annual report of the Board of Trustees of the Postal Savings System; without amendment (Rept. No. 1870). Referred to the Committee of the Whole House on the State of the Union.

Mr. JARMAN: Committee on Post Office and Civil Service. H. R. 6754. A bill to provide that salaries of rural carriers serving heavily patronized routes shall not be reduced by reason of increases in the length of such routes; without amendment (Rept. No. 1871). Referred to the Committee of the Whole House on the State of the Union.

Mr. SPENCE: Committee on Banking and Currency. S. 2786. An act to amend section 106 (c) of the Housing Act of 1949; without amendment (Rept. No. 1872). Referred to the Committee of the Whole House on the State of the Union.

Mr. RHODES: Committee on Post Office and Civil Service. S. 216. An act to amend section 631b of title 5, United States Code, by adding a new subsection, to be cited as subsection (c); without amendment (Rept. No. 1873). Referred to the Committee of the Whole House on the State of the Union.

Mr. KARSTEN of Missouri: Committee on Post Office and Civil Service. H. R. 5850. A bill to authorize the Postmaster General to impound mail in certain cases; without amendment (Rept. No. 1874). Referred to the Committee of the Whole House on the State of the Union.

Mr. DAWSON: Committee on Expenditures in the Executive Departments. H. R. 6129. A bill to provide for the transfer of certain lands and interests in lands at Mill Rock Island in the East River, N. Y.; with amendment (Rept. 1919). Referred to the Committee of the Whole House on the State of the Union.

Mr. DAWSON: Committee on Expenditures in the Executive Departments. H. R. 7673. A bill to provide for the conveyance to the State of Indiana of certain surplus real property situated in Marion County, Ind.; without amendment (Rept. No. 1920). Referred to the Committee of the Whole House on the State of the Union.

Mr. DELANEY: Select Committee to Investigate the Use of Chemicals in Foods and Cosmetics. Report pursuant to House Resolution 74 and House Resolution 447, Eighty-second Congress, first session; without amendment (Rept. No. 1921). Referred to the Committee of the Whole House on the State of the Union.

Mr. RICHARDS: Committee on Foreign Affairs. H. R. 7005. A bill to amend the Mutual Security Act of 1951, and for other purposes; with amendment (Rept. No. 1922). Referred to the Committee of the Whole House on the State of the Union.

Mr. BRYSON: Committee on the Judiciary. H. R. 7794. A bill to revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents"; without amendment (Rept. No. 1923). Referred to the Committee of the Whole House on the State of the Union.

Mr. GARMATZ: Joint Committee on the Disposition of Executive Papers, House Report No. 1924. Report on the disposition of certain papers of sundry executive departments. Ordered to be printed.

## REPORTS OF COMMITTEES ON PRIVATE BILLS AND RESOLUTIONS

Under clause 2 of rule XIII, reports of committees were delivered to the Clerk for printing and reference to the proper calendar, as follows:

Mr. LANE: Committee on the Judiciary. H. R. 1097. A bill for the relief of Ethel White, Frankie Ezell, and Ralph James; with amendment (Rept. No. 1854). Referred to the Committee of the Whole House.

Mr. FRAZIER: Committee on the Judiciary. H. R. 1098. A bill for the relief of the estate of C. G. Allen; without amendment (Rept. No. 1855). Referred to the Committee of the Whole House.

Mr. LANE: Committee on the Judiciary. H. R. 1347. A bill for the relief of Margaret Frankell; with amendment (Rept. No. 1856). Referred to the Committee of the Whole House.

Mr. LANE: Committee on the Judiciary. H. R. 2610. A bill for the relief of James Nels Ekberg; with amendment (Rept. No. 1857). Referred to the Committee of the Whole House.

Mr. FRAZIER: Committee on the Judiciary. H. R. 3334. A bill for the relief of Paul Busbey; with amendment (Rept. No. 1858). Referred to the Committee of the Whole House.

Mr. LANE: Committee on the Judiciary. H. R. 3858. A bill for the relief of Mr. and Mrs. Peter Copeyon; without amendment (Rept. No. 1859). Referred to the Committee of the Whole House.

Mr. LANE: Committee on the Judiciary. H. R. 4160. A bill for the relief of Joseph Denekar and Mrs. Mary A. Denekar; with amendment (Rept. No. 1860). Referred to the Committee of the Whole House.

Mr. FRAZIER: Committee on the Judiciary. H. R. 4543. A bill for the relief of Mrs. Priscilla Crowley; without amendment (Rept. No. 1861). Referred to the Committee of the Whole House.

Mr. LANE: Committee on the Judiciary. H. R. 5225. A bill for the relief of S. Irby Adams; without amendment (Rept. No. 1862). Referred to the Committee of the Whole House.

Mr. LANE: Committee on the Judiciary. H. R. 6010. A bill for the relief of Mrs. Lennie G. Clarkson and William E. Clarkson; with amendment (Rept. No. 1863). Referred to the Committee of the Whole House.

Mr. LANE: Committee on the Judiciary. H. R. 6016. A bill for the relief of Louis A. Schafer; with amendment (Rept. No. 1864). Referred to the Committee of the Whole House.

Mr. LANE: Committee on the Judiciary. H. R. 6850. A bill for the relief of Martha Bridges; without amendment (Rept. No. 1865). Referred to the Committee of the Whole House.

Mr. WALTER: Committee on the Judiciary. S. 2672. An act for the relief of Elisabeth Mueller (also known as Elizabeth Philbrick); without amendment (Rept. No. 1866). Referred to the Committee of the Whole House.

Mr. WALTER: Committee on the Judiciary. S. 148. An act for the relief of Gerdina Josephina Van Delft; without amendment (Rept. No. 1875). Referred to the Committee of the Whole House.

Mr. WALTER: Committee on the Judiciary. S. 420. An act for the relief of Gloria Wilson; without amendment (Rept. No. 1876). Referred to the Committee of the Whole House.

Mr. WALTER: Committee on the Judiciary. S. 603. An act for the relief of Wanda Charwat, and her daughter, Wanda Aino Charwat; without amendment (Rept. No. 1877). Referred to the Committee of the Whole House.

Mr. WALTER: Committee on the Judiciary. S. 762. An act for the relief of Alexander Urszu; with amendment (Rept. No. 1878). Referred to the Committee of the Whole House.

Mr. WALTER: Committee on the Judiciary. S. 794. An act for the relief of Mrs. Shu-Ting Liu Hsia and her daughter, Lucia; without amendment (Rept. No. 1879). Referred to the Committee of the Whole House.

Mr. WALTER: Committee on the Judiciary. S. 869. An act for the relief of Marie Cafcalaki; without amendment (Rept. No. 1880). Referred to the Committee of the Whole House.

Mr. WALTER: Committee on the Judiciary. S. 897. An act for the relief of Mr. and Mrs. Thanos Mellos, Michel Mellos, and Hermine Fahni; without amendment (Rept. No. 1881). Referred to the Committee of the Whole House.

Mr. WALTER: Committee on the Judiciary. S. 992. An act for the relief of Daniel Wolkonsky, and his wife, Xenia Wolkonsky; without amendment (Rept. No. 1882). Referred to the Committee of the Whole House.

Mr. WALTER: Committee on the Judiciary. S. 997. An act for the relief of Paula Slucka (Slucki) and Ariel Slucki; with amendment (Rept. No. 1883). Referred to the Committee of the Whole House.

Mr. WALTER: Committee on the Judiciary. S. 1189. An act for the relief of Anthony Lombardo; without amendment (Rept. No. 1884). Referred to the Committee of the Whole House.

Mr. WALTER: Committee on the Judiciary. S. 1192. An act for the relief of Demetrius Alexander Jordan; without amendment (Rept. No. 1885). Referred to the Committee of the Whole House.

Mr. WALTER: Committee on the Judiciary. S. 1372. An act for the relief of Mrs. Madelaine Viale Moore; with amendment (Rept. No. 1886). Referred to the Committee of the Whole House.

Mr. WALTER: Committee on the Judiciary. S. 1420. An act for the relief of Pinfang Hsia; without amendment (Rept. No. 1887). Referred to the Committee of the Whole House.

Mr. WALTER: Committee on the Judiciary. S. 1494. An act for the relief of George Georgacopoulos; without amendment (Rept. No. 1888). Referred to the Committee of the Whole House.

Mr. WALTER: Committee on the Judiciary. S. 1565. An act for the relief of Andy Duzsik; without amendment (Rept. No. 1889). Referred to the Committee of the Whole House.

Mr. WALTER: Committee on the Judiciary. S. 1679. An act for the relief of Stephen Gorove; with amendment (Rept. No. 1890). Referred to the Committee of the Whole House.

Mr. WALTER: Committee on the Judiciary. S. 1765. An act for the relief of Harumi Kamiaka; without amendment (Rept. No. 1891). Referred to the Committee of the Whole House.

Mr. WALTER: Committee on the Judiciary. S. 1766. An act for the relief of Frederic James Mercado; without amendment (Rept. No. 1892). Referred to the Committee of the Whole House.

Mr. WALTER: Committee on the Judiciary. S. 1879. An act for the relief of Ernest Nanpel Ihrig; without amendment (Rept. No. 1893). Referred to the Committee of the Whole House.

Mr. WALTER: Committee on the Judiciary. S. 2033. An act for the relief of Giuseppa S. Boyd; without amendment (Rept. No. 1894). Referred to the Committee of the Whole House.

Mr. WALTER: Committee on the Judiciary. S. 2034. An act for the relief of Charlotte Elizabeth Cason; without amendment (Rept. No. 1895). Referred to the Committee of the Whole House.

Mr. WALTER: Committee on the Judiciary. S. 2051. A act for the relief of Naomi Saito; without amendment (Rept. No. 1896). Referred to the Committee of the Whole House.

Mr. WALTER: Committee on the Judiciary. S. 2145. An act for the relief of certain dis-

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placed persons; without amendment (Rept. No. 1897). Referred to the Committee of the Whole House.

Mr. WALTER: Committee on the Judiciary. S. 2220. An act for the relief of Theresa Hatcher; without amendment (Rept. No. 1898). Referred to the Committee of the Whole House.

Mr. WALTER: Committee on the Judiciary. S. 2588. An act for the relief of Dulcie Ann Steinhardt Sherlock; without amendment (Rept. No. 1899). Referred to the Committee of the Whole House.

Mr. WALTER: Committee on the Judiciary. S. 2770. An act for the relief of Matheos Alafouzos; without amendment (Rept. No. 1900). Referred to the Committee of the Whole House.

Mr. WALTER: Committee on the Judiciary. Senate Concurrent Resolution 66. Concurrent resolution favoring the suspension of deportation of certain aliens; with amendment (Rept. No. 1901). Referred to the Committee of the Whole House.

Mr. WALTER: Committee on the Judiciary. Senate Concurrent Resolution 67. Concurrent resolution favoring the suspension of deportation of certain aliens; without amendment (Rept. No. 1902). Referred to the Committee of the Whole House.

Mr. WALTER: Committee on the Judiciary. Senate Concurrent Resolution 68. Concurrent resolution favoring the suspension of deportation of certain aliens; without amendment (Rept. No. 1903). Referred to the Committee of the Whole House.

Mr. WILSON of Texas: Committee on the Judiciary. H. R. 880. A bill for the relief of Guiseppe Biolzi; with amendment (Rept. No. 1904). Referred to the Committee of the Whole House.

Mr. WILSON of Texas: Committee on the Judiciary. H. R. 2840. A bill for the relief of Mrs. Hee Shee Wong Acbuck; with amendment (Rept. No. 1905). Referred to the Committee of the Whole House.

Mr. GRAHAM: Committee on the Judiciary. H. R. 3275. A bill for the relief of Miyoko Nakagawa; without amendment (Rept. No. 1906). Referred to the Committee of the Whole House.

Mr. GRAHAM: Committee on the Judiciary. H. R. 3564. A bill for the relief of Reuben Krakovsky; without amendment (Rept. No. 1907). Referred to the Committee of the Whole House.

Miss THOMPSON of Michigan: Committee on the Judiciary. H. R. 4126. A bill for the relief of Ernst Shaschnik, Sr.; Hildegard Shaschnik; and Ernst Shaschnick, Jr.; with amendment (Rept. No. 1908). Referred to the Committee of the Whole House.

Mr. WILSON of Texas: Committee on the Judiciary. H. R. 4504. A bill for the relief of Dr. Philip Bloemsma and Mrs. Joy Roelink Bloemsma; with amendment (Rept. No. 1909). Referred to the Committee of the Whole House.

Mr. DONOHUE: Committee on the Judiciary. H. R. 4588. A bill for the relief of Mark Yen Hui; without amendment (Rept. No. 1910). Referred to the Committee of the Whole House.

Mr. DONOHUE: Committee on the Judiciary. H. R. 5107. A bill for the relief of Margarite Mary Fujita; without amendment (Rept. No. 1911). Referred to the Committee of the Whole House.

Miss THOMPSON of Michigan: Committee on the Judiciary. H. R. 5108. A bill for the relief of Nicola, Luela, and Rocco Fierro; with amendment (Rept. No. 1912). Referred to the Committee of the Whole House.

Miss THOMPSON of Michigan: Committee on the Judiciary. H. R. 5301. A bill for the relief of Leonard Jesse Richards (Michio Inoue); without amendment (Rept. No. 1913). Referred to the Commitee of the Whole House.

Mr. WILSON of Texas: Committee on the Judiciary. H. R. 5864. A bill for the relief of Sachiko Kanemochi; without amendment (Rept. No. 1914). Referred to the Committee of the Whole House.

Mr. GRAHAM: Committee on the Judiciary. H. R. 6109. A bill for the relief of Helga Evaline Matz; without amendment (Rept. No. 1915). Referred to the Committee of the Whole House.

Mr. DONOHUE: Committee on the Judiciary. H. R. 6505. A bill for the relief of Karen Ann Crowley; without amendment (Rept. No. 1916). Referred to the Committee of the Whole House.

Miss THOMPSON of Michigan: Committee on the Judiciary. H. R. 6870. A bill for the relief of Louie Bon Kong; without amendment (Rept. No. 1917). Referred to the Committee of the Whole House.

Mr. GRAHAM: Committee on the Judiciary. H. R. 6945. A bill for the relief of Katharina Hoffmann; without amendment (Rept. No. 1918). Referred to the Committee of the Whole House.

## PUBLIC BILLS AND RESOLUTIONS

Under clause 3 of rule XXII, public bills and resolutions were introduced and severally referred as follows:

By Mr. AUGUST H. ANDRESEN:

H. R. 7793. A bill to provide for standards to be prescribed by the Secretary of Agriculture governing imported agricultural food products; to the Committee on Agriculture.

By Mr. BRYSON:

H. R. 7794. A bill to revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code, entitled "Patents"; to the Committee on the Judiciary.

By Mr. AANDAHL:

H. R. 7795. A bill to modify the comprehensive plans for flood control in the Missouri River Basin to provide for the inclusion in such plans of adequate elementary and high-school facilities at Newtown, N. Dak., to replace the facilities located in Sanish and Van Hook, N. Dak., which are to be abandoned as a result of the construction of the Garrison Dam and Reservoir; to the Committee on Public Works.

By Mr. ABERNETHY:

H. R. 7796. A bill to amend the Soil Conservation and Domestic Allotment Act, as amended, and the Agricultural Adjustment Act of 1938, as amended; to the Committee on Agriculture.

By Mr. CURTIS of Nebraska:

H. R. 7797. A bill to disallow the deduction as bad-debt losses loans to political committees or candidates; to the Committee on Ways and Means.

By Mr. D'EWART:

H. R. 7798. A bill to amend the Agricultural Act of 1949, as amended, to strengthen American agriculture and reduce the cost of price-support operations; to the Committee on Agriculture.

By Mr. KEARNS:

H. R. 7799. A bill to authorize the appropriation of funds for the establishment of the Smithsonian Gallery of Art as a part of a national war memorial in the District of Columbia; to the Committee on Public Works.

By Mr. DOUGHTON:

H. R. 7800. A bill to amend title II of the Social Security Act to increase old-age and survivors insurance benefits, to preserve insurance rights of permanently and totally disabled individuals, and to increase the amount of earnings permitted without loss of benefits, and for other purposes; to the Committee on Ways and Means.

By Mr. KLEIN:

H. R. 7801. A bill to provide for the establishments of a Commission on Human Rights in the government of the District of Columbia; to the Committee on the District of Columbia.

By Mr. O'HARA:

H. R. 7802. A bill to amend part I of the Interstate Commerce Act to provide for filing of equipment trust agreements and other documents evidencing or relating to the lease, mortgage, conditional sale, or bailment of railroad equipment; to the Committee on Interstate and Foreign Commerce.

By Mr. O'NEILL:

H. R. 7803. A bill to authorize the payment, in the case of certain officers of the Army of the United States separated with impaired hearing, of sums equal to the pay and allowances they would have received if they had been hospitalized in accordance with administrative requirements prior to separation, and for other purposes; to the Committee on Armed Services.

By Mr. PATTERSON:

H. R. 7804. A bill to authorize additional pay for combat duty performed by members of the uniformed services in Korea, and for other purposes; to the Committee on Armed Services.

By Mr. PHILLIPS:

H. R. 7805. A bill to amend the Civil Service Retirement Act of May 29, 1930, as amended, so as to provide annuities for certain widows who were married at least 50 years to employees to whom such act applied; to the Committee on Post Office and Civil Service.

By Mr. REAMS:

H. R. 7806. A bill to authorize the participation by certain Federal employees, without loss of pay or deduction from annual leave, in funerals for deceased members of the Armed Forces returned to the United States from abroad for burial; to the Committee on Post Office and Civil Service.

By Mr. REES of Kansas:

H. R. 7807. A bill to amend section 402 (f) of the Defense Production Act of 1950; to the Committee on Banking and Currency.

By Mr. ROGERS of Florida:

H. R. 7808. A bill to amend part I of the Interstate Commerce Act to provide for filing of equipment trust agreements and other documents evidencing or relating to the lease, mortgage, conditional sale, or bailment of railroad equipment; to the Committee on Interstate and Foreign Commerce.

By Mr. SADLAK:

H. R. 7809. A bill authorizing the transfer of certain property of the United States Government (in Windsor Locks, Conn.) to the State of Connecticut; to the Committee on Public Works.

By Mr. SAYLOR:

H. R. 7810. A bill to provide that the compensation the United States shall pay the borough of Blairsville, Pa., for certain land and improvements thereon, shall include the replacement costs of such improvements; to the Committee on Public Works.

By Mr. THOMPSON of Texas:

H. R. 7811. A bill to amend the Longshoremen's and Harbor Workers' Compensation Act to increase the maximum benefits provided by such act and to extend its provisions to Puerto Rico, and for other purposes; to the Committee on Education and Labor.

By Mr. VINSON:

H. R. 7812. A bill to provide for the restoration and maintenance of the U. S. S. *Constitution* and to authorize the disposition of the U. S. S. *Constellation*, U. S. S. *Hartford*, U. S. S. *Olympia*, and U. S. S. *Oregon*, and for other purposes; to the Committee on Armed Services.

H. R. 7813. A bill to authorize the Army Medical Service Graduate School to award master-of-science and doctor-of-science degrees in medicine, dentistry, veterinary medicine, and in the biological sciences involved in health services, and for other purposes; to the Committee on Armed Services.

By Mr. WATTS:

H. R. 7814. A bill to authorize the Secretary of the Interior to enter into an agreement with the State of Kentucky to acquire non-Federal cave properties within the authorized boundaries of Mammoth Cave National Park in the State of Kentucky; to the Committee on Interior and Insular Affairs.

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X re HR 7794

UNITED STATES OF AMERICA

# Congressional Record

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SECOND SESSION

## VOLUME 98—PART 4

APRIL 23, 1952, TO MAY 20, 1952
(PAGES 4241 TO 5602)

LEGISLATIVE INTENT SERVICE (800) 666-1917

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Mr. O'CONOR, Mr. O'MAHONEY, Mr. RUSSELL, Mr. SALTONSTALL, Mr. SMATHERS, Mr. SPARKMAN, and Mr. WATKINS entered the Chamber and answered to their names.

The PRESIDING OFFICER. A quorum is present.

Mr. McFARLAND. Mr. President, I ask unanimous consent that the Senate vote upon the substitute which has been offered by the distinguished Senator from New York and other Senators, at 4:30 o'clock p. m. Wednesday, and that the time of debate, beginning at 12 o'clock Wednesday, be divided equally between the proponents and the opponents, of the substitute, the time of the proponents to be controlled by the distinguished Senator from Minnesota, and the time of the opponents, by the distinguished senior Senator from Nevada.

The PRESIDING OFFICER. Is there objection?

Mr. SPARKMAN. Mr. President, reserving the right to object, what time was suggested for the vote?

Mr. McFARLAND. The time for the vote was suggested at 4:30 Wednesday. I understand that those who are interested in the pending legislation expect to try to arrive at an agreement regarding vote on the other amendments and on the bill before that time, probably some time tomorrow. If such an agreement were reached, as I stated before, we would not have a night session on Wednesday.

Mr. SPARKMAN. That is, it is proposed to vote at 4:30 p. m. Wednesday. Is that correct?

Mr. McFARLAND. That is correct.

Mr. WELKER. Mr. President, reserving the right to object, will the majority leader be kind enough to restate the unanimous-consent request?

Mr. McFARLAND. I am happy to do so. I ask unanimous consent that the Senate vote upon the subsitute offered by the distinguished Senator from New York [Mr. LEHMAN] for himself and other Senators at 4:30 p. m., Wednesday, and that the time of debate, beginning at 12 o'clock on Wednesday, be divided equally between the proponents and opponents, the time of the proponents to be controlled by the distinguished Senator from Minnesota; the time of the opponents by the distinguished Senator from Nevada, and that any amendments to the substitute must be germane.

The PRESIDING OFFICER. Is there objection? The Chair hears none, and it is so ordered.

Mr. McFARLAND. Mr. President, consent having been given to this much of the request, I desire to express to Senators my appreciation of their cooperation. I shall express further appreciation when a unanimous-consent agreement is obtained with reference to the other amendments and the bill.

Unless some other Senator desires to speak tonight, I am about to move an executive session.

The PRESIDING OFFICER. The Senator from Arizona has the floor.

## EXECUTIVE SESSION

Mr. McFARLAND. I move that the Senate proceed to the consideration of executive business.

The motion was agreed to; and the Senate proceeded to the consideration of executive business.

The PRESIDING OFFICER. If there be no reports of committees, the clerk will state the nomination on the calendar.

## DEFENSE PRODUCTION ADMINISTRATION

The legislative clerk read the nomination of Henry H. Fowler to be Defense Production Administrator.

The PRESIDING OFFICER. Without objection, the nomination is confirmed; and, without objection, the President will be immediately notified.

That completes the calendar.

Mr. McFARLAND. Mr. President, in accordance with the notice I gave earlier today, tomorrow the Senate will consider the nomination of James P. McGranery to be Attorney General.

Mr. WELKER. Mr. President, will the Senator yield?

Mr. McFARLAND. I yield.

Mr. WELKER. I notice on the Executive Calendar, under the subhead "Favorable reports," the nomination of James F. Hughes to be postmaster at Boise, Idaho. I have noticed that nomination on the calendar for about 2 weeks. Can the distinguished majority leader enlighten me as to why that nomination continues on the calendar, and why it is not withdrawn?

Mr. McFARLAND. A request was made by some Senator that that go over. It has gone over, pursuant to the request, which is customary. I expect to check up on it. Probably we shall be able to dispose of that nomination within the very near future.

Mr. WELKER. Very well.

## RECESS

Mr. McFARLAND. In executive session, I move that the Senate stand in recess until 12 o'clock noon tomorrow.

The motion was agreed to; and (at 6 o'clock and 48 minutes p. m.) the Senate, in executive session, took a recess until tomorrow, Tuesday, May 20, 1952, at 12 o'clock meridian.

## CONFIRMATION

Executive nomination confirmed by the Senate May 19 (legislative day of May 12), 1952:

DEFENSE PRODUCTION ADMINISTRATION

Henry H. Fowler, of Virginia, to be Defense Production Administrator.

# HOUSE OF REPRESENTATIVES

MONDAY, MAY 19, 1952

The House met at 12 o'clock noon.

The Chaplain, Rev. Bernard Braskamp, D. D., offered the following prayer:

O Thou who hast brought us to the beginning of a new week, show us how we may rightly adapt and adjust ourselves to these strenuous and swiftly changing days with their many unforeseen and tangled problems.

Help us to lay hold of the great resources of divine wisdom for Thou art too wise to err and too kind to injure.

We pray that in our high calling of public service we may meet our tasks and responsibilities with confidence and courage, for Thou wilt guide and provide.

Grant that in serving our generation we may earnestly seek to help mankind receive and enjoy its God-ordained human rights and blessings of freedom and peace.

Hear us in the name of the Prince of Peace. Amen.

The Journal of the proceedings of Friday, May 16, 1952, was read and approved.

## MESSAGE FROM THE SENATE

A message from the Senate, by Mr. Landers, its enrolling clerk, announced that the Senate had passed, with amendments in which the concurrence of the House is requested, a bill of the House of the following title:

H. R. 6787. An act to extend the Rubber Act of 1948 (Public Law 469, 80th Cong.), as amended, and for other purposes.

The message also announced that the Senate agrees to the amendments of the House to a bill of the Senate of the following title:

S. 993. An act for the relief of Robert Wendell Tadlock.

## AMENDMENT TO THE FEDERAL EMPLOYEES' COMPENSATION ACT

Mr. MURRAY. Mr. Speaker, I ask unanimous consent that the Committee on Post Office and Civil Service be discharged from further consideration of the bill (H. R. 7621) to amend the Federal Employees' Compensation Act, as amended, with respect to the computation of disability payments in the case of certain seamen and other persons, and that the bill be rereferred to the Committee on Education and Labor.

The SPEAKER. Is there objection to the request of the gentleman from Tennessee?

There was no objection.

## OHIO CORN BREAD

Mr. JENKINS. Mr. Speaker, I ask unanimous consent to address the House for 1 minute and to revise and extend my remarks.

The SPEAKER. Is there objection to the request of the gentleman from Ohio?

There was no objection.

Mr. JENKINS. Mr. Speaker, several days ago my good friend and colleague the gentleman from Iowa [Mr. JENSEN] regaled this House with the glories of corn meal and corn bread from Iowa corn. I felt at that time that he was covering entirely too much territory and I am convinced now because I have heard from the editor of one of the biggest newspapers in Ohio on this very important subject. He states that JENSEN is just as wrong as he can be. So, Mr. Speaker, in my extension of remarks, which will appear in the Appendix of the RECORD, I shall prove this.

There being no objection, the Clerk read the bill, as follows:

*Be it enacted, etc.,* That upon the institution of proceedings before the Postmaster General against any person or concern for the purpose of determining whether any of the orders authorized by the laws codified in sections 255, 259, 259a, and 732 of title 39, United States Code, should be issued, and when it shall appear to the Postmaster General to be reasonably necessary for the protection of the public, or to be in the public interest, he may order that mail addressed to such person or concern be impounded and detained by the postmaster at the office of delivery pending final decision of the issues involved in said proceedings.

The bill was ordered to be engrossed and read the third time, was read the third time and passed, and a motion to reconsider was laid on the table.

## AMENDING SECTION 106 (c) OF THE HOUSING ACT OF 1949 (SLUM CLEARANCE AND REDEVELOPMENT PROJECTS)

The Clerk called the bill (S. 2786) to amend section 106 (c) of the Housing Act of 1949.

The SPEAKER. Is there objection to the present consideration of the bill?

Mr. SHAFER. Mr. Speaker, I object.

## REVISION AND CODIFICATION OF PATENT LAW

The Clerk called the bill (H. R. 7794) to revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents."

There being no objection, the Clerk read the bill, as follows:

*Be it enacted etc.,* United States Code, entitled "Patents," is revised, codified, and enacted into law, and may be cited, "Title 35, United States Code, section —," as follows:

TITLE 35—PATENTS


| Part | Sec. |
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| I. Patent Office | 1 |
| II. Patentability of inventions and grant of patents | 100 |
| III. Patents and protection of patent rights | 251 |


PART I—PATENT OFFICE


| Chapter | Sec. |
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*Chapter 1—Establishment, officers, functions*


Sec.
1. Establishment.
2. Seal.
3. Officers and employees.
4. Restrictions on officers and employees as to interest in patents.
5. Bond of Commissioner and other officers.
6. Duties of Commissioner.
7. Board of Appeals.
8. Library.
9. Classification of patents.
10. Certified copies of records.
11. Publications.
12. Exchange of copies of patents with foreign countries.
13. Copies of patents for public libraries.
14. Annual report to Congress.


§ 1. Establishment

The Patent Office shall continue as an office in the Department of Commerce, where records, books, drawings, specifications, and other papers and things pertaining to patents and to trade-mark registrations shall be kept and preserved, except as otherwise provided by law.

§ 2. Seal

The Patent Office shall have a seal with which letters patent, certificates of trade-mark registrations, and papers issued from the Office shall be authenticated.

§ 3. Officers and employees

A Commissioner of Patents, one first assistant commissioner, two assistant commissioners, and nine examiners-in-chief shall be appointed by the President, by and with the advice and consent of the Senate. The assistant commissioners shall perform the duties pertaining to the office of commissioner assigned to them by the Commissioner. The first assistant commissioner, or, in the event of a vacancy in that office, the assistant commissioner senior in date of appointment, shall fill the office of Commissioner during a vacancy in that office until a Commissioner is appointed and takes office. The Secretary of Commerce, upon the nomination of the Commissioner in accordance with law, shall appoint all other officers and employees.

The Secretary of Commerce may vest in himself the functions of the Patent Office and its officers and employees specified in this title and may from time to time authorize their performance by any other officer or employee.

§ 4. Restrictions on officers and employees as to interest in patents

Officers and employees of the Patent Office shall be incapable, during the period of their appointments and for 1 year thereafter, of applying for a patent and of acquiring, directly or indirectly, except by inheritance or bequest, any patent or any right or interest in any patent, issued or to be issued by the Office. In patents applied for thereafter they shall not be entitled to any priority date earlier than 1 year after the termination of their appointment.

§ 5. Bond of Commissioner and other officers

The Commissioner and such other officers as he designates, before entering upon their duties, shall severally give bond, with sureties, the former in the sum of $10,000, and the latter in sums prescribed by the Commissioner, conditioned for the faithful discharge of their respective duties and that they shall render to the proper officers of the Treasury a true account of all money received by virtue of their offices.

§ 6. Duties of Commissioner

The Commissioner, under the direction of the Secretary of Commerce, shall superintend or perform all duties required by law respecting the granting and issuing of patents and the registration of trade marks; and he shall have charge of property belonging to the Patent Office. He may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

§ 7. Board of Appeals

The examiners-in-chief shall be persons of competent legal knowledge and scientific ability. The Commissioner, the assistant commissioners, and the examiners in chief shall constitute a Board of Appeals, which, on written appeal of the applicant, shall review adverse decisions of examiners upon applications for patents. Each appeal shall be heard by at least three members of the Board of Appeals, the members hearing such appeal to be designated by the Commissioner. The Board of Appeals has sole power to grant rehearings.

Whenever the Commissioner considers it necessary to maintain the work of the Board of Appeals current, he may designate any patent examiner of the primary examiner grade or higher, having the requisite ability, to serve as examiner in chief for periods not exceeding 6 months each. An examiner so designated shall be qualified to act as a member of the Board of Appeals. Not more than one such primary examiner shall be a member of the Board of Appeals hearing an appeal.

§ 8. Library

The Commissioner shall maintain a library of scientific and other works and periodicals, both foreign and domestic, in the Patent Office to aid the officers in the discharge of their duties.

§ 9. Classification of patents

The Commissioner may revise and maintain the classification by subject matter of United States letters patent, and such other patents and printed publications as may be necessary or practicable, for the purpose of determining with readiness and accuracy the novelty of inventions for which applications for patent are filed.

§ 10. Certified copies of records

The Commissioner may furnish certified copies of specifications and drawings of patents issued by the Patent Office, and of other records available either to the public or to the person applying therefor.

§ 11. Publications

(a) The Commissioner may print, or cause to be printed, the following:

1. Patents, including specifications and drawings, together with copies of the same. The Patent Office may print the headings of the drawings for patents for the purpose of photolithography.

2. Certificates of trade-mark registrations, including statements and drawings, together with copies of the same.

3. The Official Gazette of the United States Patent Office.

4. Annual indexes of patents and patentees, and of trade-marks and registrants.

5. Annual volumes of decisions in patent and trade-mark cases.

6. Pamphlet copies of the patent laws and rules of practice, laws and rules relating to trade-marks, and circulars or other publications relating to the business of the Office.

(b) The Commissioner may exchange any of the publications specified in items 3, 4, 5, and 6 of subsection (a) of this section for publications desirable for the use of the Patent Office.

§ 12. Exchange of copies of patents with foreign countries

The Commissioner may exchange copies of specifications and drawings of United States patents for those of foreign countries.

§ 13. Copies of patents for public libraries

The Commissioner may supply printed copies of specifications and drawings of patents to public libraries in the United States which shall maintain such copies for the use of the public, at the rate for each year's issue established for this purpose in section 41 (a) 9 of this title.

§ 14. Annual report to Congress

The Commissioner shall report to Congress annually the moneys received and expended, statistics concerning the work of the Office, and other information relating to the Office as may be useful to the Congress or the public.

*Chapter 2—Proceedings in the Patent Office*


Sec.
21. Day for taking action falling on Saturday, Sunday, or holiday.
22. Printing of papers filed.
23. Testimony in Patent Office cases.
24. Subpenas, witnesses.




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§ 21. Day for taking action falling on Saturday, Sunday, or holiday

When the day, or the last day, for taking any action or paying any fee in the United States Patent Office falls on Saturday, Sunday, or a holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding secular or business day.

§ 22. Printing of papers filed

The Commissioner may require papers filed in the Patent Office to be printed or typewritten.

§ 23. Testimony in Patent Office cases

The Commissioner may establish rules for taking affidavits and depositions required in cases in the Patent Office. Any officer authorized by law to take depositions to be used in the courts of the United States, or of the State where he resides, may take such affidavits and depositions.

§ 24. Subpenas, witnesses

The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent Office, shall, upon the application of any party thereto, issue a subpena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent Office.

Every witness subpenaed and in attendance shall be allowed the fees and traveling expenses allowed to witnesses attending the United States district courts.

A judge of a court whose clerk issued a subpena may enforce obedience to the process or punish disobedience as in other like cases, on proof that a witness, served with such subpena, neglected or refused to appear or to testify. No witness shall be deemed guilty of contempt for disobeying such subpena unless his fees and traveling expenses in going to and returning from, and 1 day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpena; nor for refusing to disclose any secret matter except upon appropriate order of the court which issued the subpena.

*Chapter 3—Practice before Patent Office*

Sec.
31. Regulation for agents and attorneys.
32. Suspension or exclusion from practice.
33. Unauthorized representation as practitioner.

§ 31. Regulations for agents and attorneys

The Commissioner, subject to the approval of the Secretary of Commerce, may prescribe regulations governing the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Patent Office, and may require them, before being recognized as representatives of applicants or other persons, to show that they are of good moral character and reputation and are possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office.

§ 32. Suspension or exclusion from practice

The Commissioner may, after notice and opportunity for a hearing, suspend or exclude, either generally or in any particular case, from further practice before the Patent Office, any person, agent, or attorney shown to be incompetent or disreputable, or guilty of gross misconduct, or who does not comply with the regulations established under section 31 of this title, or who shall, by word, circular, letter, or advertising, with intent to defraud in any manner, deceive, mislead, or threaten any applicant or prospective applicant, or other person having immediate or prospective business before the Office. The reasons for any such suspension or exclusion shall be duly recorded. The United States District Court for the District of Columbia, under such conditions and upon such proceedings as it by its rules determines, may review the action of the Commissioner upon the petition of the person so refused recognition or so suspended or excluded.

§ 33. Unauthorized representation as practitioner

Whoever, not being recognized to practice before the Patent Office, holds himself out or permits himself to be held out as so recognized, or as being qualified to prepare or prosecute applications for patent, shall be fined not more than $1,000 for each offense.

*Chapter 4—Patent fees*

Sec.
41. Patent fees.
42. Payment of patent fees; return of excess amounts.

§ 41. Patent fees

(a) The Commissioner shall charge the following fees:

1. On filing each application for an original patent, except in design cases, $30, and $1 for each claim in excess of twenty.

2. On issuing each original patent, except in design cases, $30, and $1 for each claim in excess of twenty.

3. In design cases: For 3 years and 6 months, $10; for 7 years, $15; for 14 years, $30.

4. On every application for the reissue of a patent, $30 and $1 for each claim in excess of twenty over and above the number of claims of the original patent.

5. On filing each disclaimer, $10.

6. On an appeal for the first time from the examiner to the Board of Appeals, $25.

7. On filing each petition for the revival of an abandoned application for a patent or for the delayed payment of the fee for issuing each patent, $10.

8. For certificate of correction of applicant's mistake under section 255 of this title, $10.

9. For uncertified printed copies of specifications and drawings of patents (except design patents), 25 cents per copy; for design patents, 10 cents per copy; special rate for libraries specified in section 13 of this title, $50 for patents issued in 1 year.

10. For recording every assignment, agreement, or other paper not exceeding six pages, $3; for each additional two pages or less, $1; for each additional patent or application included in one writing, where more than one is so included, 50 cents additional.

11. For each certificate, $1.

(b) The Commissioner may establish charges for copies of records, publications, or services furnished by the Patent Office, not specified above.

§ 42. Payment of patent fees; return of excess amounts

All patent fees shall be paid to the Commissioner who shall deposit the same in the Treasury of the United States in such manner as the Secretary of the Treasury directs, and the Commissioner may refund any sum paid by mistake or in excess of the fee required by law.

PART II—PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS


| Chapter | Sec. |
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| 10. Patentability of inventions | 100 |
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*Chapter 10—Patentability of Inventions*

Sec.
100. Definitions.
101. Inventions patentable.
102. Conditions for patentability; novelty and loss of right to patent.
103. Conditions for patentability; non-obvious subject matter.
104. Invention made abroad.

§ 100. Definitions

When used in this title unless the context otherwise indicates—

(a) The term "invention" means invention or discovery.

(b) The term "process" means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.

(c) The terms "United States" and "this country" mean the United States of America, its territories and possessions.

(d) The word "patentee" includes not only the patentee to whom the patent was issued but also the successors in title to the patentee.

§ 101. Inventions patentable

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

§ 102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country or an application filed more than 12 months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

§ 103. Conditions for patentability; nonobvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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§ 104. Invention made abroad

In proceedings in the Patent Office and in the courts, an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country, except as provided in section 119 of this title. Where an invention was made by a person, civil or military, while domiciled in the United States and serving in a foreign country in connection with operations by or on behalf of the United States, he shall be entitled to the same rights of priority with respect to such invention as if the same had been made in the United States.

*Chapter 11—Application for patent*

Sec.
111. Application for patent.
112. Specification.
113. Drawings.
114. Models, specimens.
115. Oath of applicant.
116. Joint inventors.
117. Death or incapacity of inventor.
118. Filing by other than inventor.
119. Benefit of earlier filing date in foreign country; right of priority.
120. Benefit of earlier filing date in the United States.
121. Divisional applications.
122. Confidential status of applications.

§ 111. Application for patent

Application for patent shall be made by the inventor, except as otherwise provided in this title, in writing to the Commissioner. Such application shall include: (1) a specification as prescribed by section 112 of this title; (2) a drawing as prescribed by section 113 of this title, and (3) an oath by the applicant as prescribed by section 115 of this title. The application must be signed by the applicant and accompanied by the fee required by law.

§ 112. Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalent thereof.

§ 113. Drawings

When the nature of the case admits, the applicant shall furnish a drawing.

§ 114. Models, specimens

The Commissioner may require the applicant to furnish a model of convenient size to exhibit advantageously the several parts of his invention.

When the invention relates to a composition of matter, the Commissioner may require the applicant to furnish specimens or ingredients for the purpose of inspection or experiment.

§ 115. Oath of applicant

The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by certificate of a diplomatic or consular officer of the United States, and such oath shall be valid if it complies with the laws of the state or country where made. When the application is made as provided in this title by a person other than the inventor, the oath may be so varied in form that it can be made by him.

§ 116. Joint inventors

When an invention is made by two or more persons jointly, they shall apply for patent jointly and each sign the application and make the required oath, except as otherwise provided in this title.

If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Commissioner, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor making the application, subject to the same rights which the omitted inventor would have had if he had been joined. The omitted inventor may subsequently join in the application.

Whenever a person is joined in an application for patent as joint inventor through error, or a joint inventor is not included in an application through error, and such error arose without any deceptive intention on his part, the Commissioner may permit the application to be amended accordingly, under such terms as he prescribes.

§ 117. Death or incapacity of inventor

Legal representatives of deceased inventors and of those under legal incapacity may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor.

§ 118. Filing by other than inventor

Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage; and the Commissioner may grant a patent to such inventor upon such notice to him as the Commissioner deems sufficient, and on compliance with such regulations as he prescribes.

§ 119. Benefit of earlier filing date in foreign country; right of priority

An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within 12 months from the earliest date on which such foreign application was filed; but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than 1 year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than 1 year prior to such filing.

No application for patent shall be entitled to this right of priority unless a claim therefor and a certified copy of the original foreign application, specification, and drawings upon which it is based are filed in the Patent Office before the patent is granted, or at such time during the pendency of the application as required by the Commissioner not earlier than 6 months after the filing of the application in this country. Such certification shall be made by the patent office of the foreign country in which filed and show the date of the application and of the filing of the specification and other papers. The Commissioner may require a translation of the papers filed if not in the English language and such other information as he deems necessary.

§ 120. Benefit of earlier filing date in the United States

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States by the same inventor shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

§ 121. Divisional applications

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Commissioner may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Commissioner to require the application to be restricted to one invention.

§ 122. Confidential status of applications

Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any act of Congress or in such special circumstances as may be determined by the Commissioner.

*Chapter 12—Examination of application*

Sec.
131. Examination of application.
132. Notice of rejection; reexamination.
133. Time for prosecuting application.
134. Appeal to the Board of Appeals.
135. Interferences.

§ 131. Examination of application

The Commissioner shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Commissioner shall issue a patent therefor.

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§ 132. Notice of rejection; reexamination

Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

§ 133. Time for prosecuting application

Upon failure of the applicant to prosecute the application within 6 months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than 30 days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

§ 134. Appeal to the Board of Appeals

An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Appeals, having once paid the fee for such appeal.

§ 135. Interferences

Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office.

A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to 1 year from the date on which the patent was granted.

*Chapter 13—Review of Patent Office decision*

Sec.
141. Appeal to Court of Customs and Patent Appeals.
142. Notice of appeal.
143. Proceedings on appeal.
144. Decision on appeal.
145. Civil action to obtain patent.
146. Civil action in case of interference.

§ 141. Appeal to Court of Customs and Patent Appeals

An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Customs and Patent Appeals, thereby waiving his right to proceed under section 145 of this title. A party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority may appeal to the United States Court of Customs and Patent Appeals, but such appeal shall be dismissed if any adverse party to such interference, within 20 days after the appellant has filed notice of appeal according to section 142 of this title, files notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 146 of this title. Thereupon the appellant shall have 30 days thereafter within which to file a civil action under section 146, in default of which the decision appealed from shall govern the further proceedings in the case.

§ 142. Notice of appeal

When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and shall file in the Patent Office his reasons of appeal, specifically set forth in writing, within such time after the date of the decision appealed from, not less than 60 days, as the Commissioner appoints.

§ 143. Proceedings on appeal

The United States Court of Customs and Patent Appeals shall, before hearing such appeal, give notice of the time and place of the hearing to the Commissioner and the parties thereto. The Commissioner shall transmit to the court certified copies of all the necessary original papers and evidence in the case specified by the appellant and any additional papers and evidence specified by the appellee and in an ex parte case the Commissioner shall furnish the court with the grounds of the decision of the Patent Office, in writing, touching all the points involved by the reasons of appeal.

§ 144. Decision on appeal

The United States Court of customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent Office, and the decision shall be confined to the points set forth in the reasons of appeal. Upon its determination the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and govern the further proceedings in the case.

§ 145. Civil action to obtain patent

An applicant dissatisfied with the decision of the Board of Appeals may, unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than 60 days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

§ 146. Civil action in case of interference

Any party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority, may have remedy by civil action, if commenced within such time after such decision, not less than 60 days, as the Commissioner appoints or as provided in section 141 of this title, unless he has appealed to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided. In such suits the record in the Patent Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent Office when admitted shall have the same effect as if originally taken and produced in the suit.

Such suit may be instituted against the party in interest as shown by the records of the Patent Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same State, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs. The Commissioner shall not be a necessary party but he shall be notified of the filing of the suit by the clerk of the court in which it is filed and shall have the right to intervene. Judgment of the court in favor of the right of an applicant to a patent shall authorize the Commissioner to issue such patent on the filing in the Patent Office of a certified copy of the judgment and on compliance with the requirements of law.

*Chapter 14—Issue of patent*

Sec.
151. Time of issue of patent.
152. Issue of patent to assignee.
153. How issued.
154. Contents and term of patent.

§ 151. Time of issue of patent

The patent shall issue within 3 months from the date of the payment of the final fee, which shall be paid not later than 6 months after written notice to the applicant of allowance of the application, but the Commissioner may accept the final fee if paid within 1 year after the 6-month period for payment, and the patent shall issue.

§ 152. Issue of patent to assignee

Patents may be granted to the assignee of the inventor of record in the Patent Office, upon the application made and the specification sworn to by the inventor, except as otherwise provided in this title.

§ 153. How issued

Patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Commissioner or have his signature placed thereon and attested by an officer of the Patent Office designated by the Commissioner, and shall be recorded in the Patent Office.

§ 154. Contents and term of patent

Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, for the term of 17 years, of the right to exclude others from making, using, or selling the invention throughout the United States, referring to the specification for the particulars thereof. A copy of the specification and drawing shall be annexed to the patent and be a part thereof.

*Chapter 15—Plant patents*

Sec.
161. Patents for plants.
162. Description, claim.
163. Grant.
164. Assistance of Department of Agriculture.

§ 161. Patents for plants

Whoever invents or discovers and asexually reproduces any distinct and new variety of plant, other than a tuberpropagated plant, may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for plants, except as otherwise provided.

§ 162. Description, claim

No plant patent shall be declared invalid for noncompliance with section 112 of this

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title if the description is as complete as is reasonably possible.

The claim in the specification shall be in formal terms to the plant shown and described.

§ 163. Grant

In the case of a plant patent the grant shall be of the right to exclude others from asexually reproducing the plant or selling or using the plant so reproduced.

§ 164. Assistance of Department of Agriculture

The President may by Executive order direct the Secretary of Agriculture, in accordance with the requests of the Commissioner, for the purpose of carrying into effect the provisions of this title with respect to plants (1) to furnish available information of the Department of Agriculture, (2) to conduct through the appropriate bureau or division of the Department research upon special problems, or (3) to detail to the Commissioner officers and employees of the Department.

*Chapter 16—Designs*

Sec.
171. Patents for designs.
172. Right of priority.
173. Term of design patent.

§ 171. Patents for designs

Whoever invents any new, original, and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

§ 172. Right of priority

The right of priority provided for by section 119 of this title and the time specified in section 102 (d) shall be 6 months in the case of designs.

§ 173. Term of design patent

Patents for designs may be granted for the term of 3 years and 6 months, or for 7 years, or for 14 years, as the applicant, in his application, elects.

*Chapter 17—Secrecy of certain inventions and filing applications in foreign country*

Sec.
181. Secrecy of certain inventions and withholding of patent.
Sec.
182. Abandonment of invention for unauthorized disclosure.
183. Right of compensation.
184. Filing of application in foreign country.
185. Patent barred for filing without license.
186. Penalty.
187. Nonapplicability to certain persons.
188. Rules and regulations, delegation of power.

§ 181. Secrecy of certain inventions and withholding of patent

Whenever publication or disclosure by the grant of a patent on an invention in which the Government has a property interest might, in the opinion of the head of the interested Government agency, be detrimental to the national security, the Commissioner upon being so notified shall order that the invention be kept secret and shall withhold the grant of a patent therefor under the conditions set forth hereinafter.

Whenever the publication or disclosure of an invention by the granting of a patent, in which the Government does not have a property interest, might, in the opinion of the Commissioner, be detrimental to the national security, he shall make the application for patent in which such invention is disclosed available for inspection to the Atomic Energy Commission, the Secretary of Defense, and the chief officer of any other department or agency of the Government designated by the President as a defense agency of the United States.

Each individual to whom the application is disclosed shall sign a dated acknowledgment thereof, which acknowledgment shall be entered in the file of the application. If, in the opinion of the Atomic Energy Commission, the Secretary of a Defense Department, or the chief officer of another department or agency so designated, the publication or disclosure of the invention by the granting of a patent therefor would be detrimental to the national security, the Atomic Energy Commission, the Secretary of a Defense Department, or such other chief officer shall notify the Commissioner and the Commissioner shall order that the invention be kept secret and shall withhold the grant of a patent for such period as the national interest requires, and notify the applicant thereof. Upon proper showing by the head of the department or agency who caused the secrecy order to be issued that the examination of the application might jeopardize the national interest, the Commissioner shall thereupon maintain the application in a sealed condition and notify the applicant thereof. The owner of an application which has been placed under a secrecy order shall have a right to appeal from the order to the Secretary of Commerce under rules prescribed by him.

An invention shall not be ordered kept secret and the grant of a patent withheld for a period of more than 1 year. The Commissioner shall renew the order at the end thereof, or at the end of any renewal period, for additional periods of 1 year upon notification by the head of the department or the chief officer of the agency who caused the order to be issued that an affirmative determination has been made that the national interest continues so to require. An order in effect, or issued, during a time when the United States is at war, shall remain in effect for the duration of hostilities and 1 year following cessation of hostilities. An order in effect, or issued, during a national emergency declared by the President shall remain in effect for the duration of the national emergency and 6 months thereafter. The Commissioner may rescind any order upon notification by the heads of the departments and the chief officers of the agencies who caused the order to be issued that the publication or disclosure of the invention is no longer deemed detrimental to the national security.

§ 182. Abandonment of invention for unauthorized disclosure

The invention disclosed in an application for patent subject to an order made pursuant to section 181 of this title may be held abandoned upon its being established by the Commissioner that in violation of said order the invention has been published or disclosed or that an application for a patent therefor has been filed in a foreign country by the inventor, his successors, assigns, or legal representatives, or anyone in privity with him or them, without the consent of the Commissioner. The abandonment shall be held to have occurred as of the time of violation. The consent of the Commissioner shall not be given without the concurrence of the heads of the departments and the chief officers of the agencies who caused the order to be issued. A holding of abandonment shall constitute forfeiture by the applicant, his successors, assigns, or legal representatives, or anyone in privity with him or them, of all claims against the United States based upon such invention.

§ 183. Right to compensation

An applicant, his successors, assigns, or legal representatives, whose patent is withheld as herein provided, shall have the right, beginning at the date the applicant is notified that, except for such order, his application is otherwise in condition for allowance, or February 1, 1952, whichever is later, and ending 6 years after a patent is issued thereon, to apply to the head of any department or agency who caused the order to be issued for compensation for the damage caused by the order of secrecy and/or for the use of the invention by the Government, resulting from his disclosure. The right to compensation for use shall begin on the date of the first use of the invention by the Government. The head of the department or agency is authorized, upon the presentation of a claim, to enter into an agreement with the applicant, his successors, assigns, or legal representatives, in full settlement for the damage and/or use. This settlement agreement shall be conclusive for all purposes not withstanding any other provision of law to the contrary. If full settlement of the claim cannot be effected, the head of the department or agency may award and pay to such applicant, his successors, assigns, or legal representatives, a sum not exceeding 75 percent of the sum which the head of the department or agency considers just compensation for the damage and/or use. A claimant may bring suit against the United States in the Court of Claims or in the district court of the United States for the district in which such claimant is a resident for an amount which when added to the award shall constitute just compensation for the damage and/or use of the invention by the Government. The owner of any patent issued upon an application that was subject to a secrecy order issued pursuant to section 181 of this title, who did not apply for compensation as above provided, shall have the right, after the date of issuance of such patent, to bring suit in the Court of Claims for just compensation for the damage caused by reason of the order of secrecy and/or use by the Government of the invention resulting from his disclosure. The right to compensation for use shall begin on the date of the first use of the invention by the Government. In a suit under the provisions of this section the United States may avail itself of all defenses it may plead in an action under section 1498 of title 28. This section shall not confer a right of action on anyone or his successors, assigns, or legal representatives, who while in the full-time employment or service of the United States, discovered, invented, or developed the invention on which the claim is based.

§ 184. Filing of application in foreign country

Except when authorized by a license obtained from the Commissioner a person shall not file or cause or authorize to be filed in any foreign country prior to 6 months after filing in the United States an application for patent or for the registration of a utility model, industrial design, or model in respect of an invention made in this country. A license shall not be granted with respect to an invention subject to an order issued by the Commissioner pursuant to section 181 of this title without the concurrence of the head of the departments and the chief officers of the agencies who caused the order to be issued. The license may be granted retroactively where an application has been inadvertently filed abroad and the application does not disclose an invention within the scope of section 181 of this title.

The term "application" when used in this chapter includes applications and any modifications, amendments, or supplements thereto, or divisions thereof.

§ 185. Patent barred for filing without license

Notwithstanding any other provisions of law any person, and his successors, assigns, or legal representatives, shall not receive a United States patent for an invention if that person, or his successors, assigns, or legal representatives shall, without procuring the

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license prescribed in section 184 of this title, have made, or consented to or assisted another's making, application in a foreign country for a patent or for the registration of a utility model, industrial design, or model in respect of the invention. A United States patent issued to such person, his successors, assigns, or legal representatives shall be invalid.

§ 186. Penalty

Whoever, during the period or periods of time an invention has been ordered to be kept secret and the grant of a patent thereon withheld pursuant to section 181 of this title, shall, with knowledge of such order and without due authorization; willfully publish or disclose or authorize or cause to be published or disclosed the invention, or material information with respect thereto, or whoever, in violation of the provisions of section 184 of this title, shall file or cause or authorize to be filed in any foreign country an application for patent or for the registration of a utility model, industrial design, or model in respect of any invention made in the United States, shall, upon conviction, be fined not more than $10,000 or imprisoned for not more than 2 years, or both.

§ 187. Nonapplicability to certain persons

The prohibitions and penalties of this chapter shall not apply to any officer or agent of the United States acting within the scope of his authority, nor to any person acting upon his written instructions or permission.

§ 188. Rules and regulations, delegation of power

The Atomic Energy Commission, the Secretary of a defense department, the chief officer of any other department or agency of the Government designated by the President as a defense agency of the United States, and the Secretary of Commerce, may separately issue rules and regulations to enable the respective department or agency to carry out the provisions of this chapter, and may delegate any power conferred by this chapter.

PART III—PATENTS AND PROTECTION OF PATENT RIGHTS


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*Chapter 25—Amendment and correction of patents*


Sec.
251. Reissue of defective patents.
252. Effect of reissue.
253. Disclaimer.
254. Certificate of correction of Patent Office mistake.
255. Certificate of correction of applicant's mistake.
256. Misjoiner of inventor.


§ 251. Reissues of defective patents

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Commissioner may issue several reissued patents for distinct and separate parts the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within 2 years from the grant of the original patent.

§ 252. Effective of reissue

The surrender of the original patent shall take effect upon the issue of the reissued patent, and every reissued patent shall have the same effect and operation in law, on the trial of actions for causes thereafter arising, as if the same had been originally granted in such amended form, but insofar as the claims of the original and reissued patents are identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent, to the extent that its claims are identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent.

No reissued patent shall abridge or affect the right of any person or his successors in business who made, purchased or used prior to the grant of a reissue anything patented by the reissued patent, to continue the use of, or to sell to others to be used or sold, the specific thing so made, purchased or used, unless the making, using or selling of such thing infringes a valid claim of the reissued patent which was in the original patent. The court before which such matter is in question may provide for the continued manufacture, use or sale of the thing made, purchased or used as specified, or for the manufacture, use or sale of which substantial preparation was made before the grant of the reissue, and it may also provide for the continued practice of any process patented by the reissue, practiced, or for the practice of which substantial preparation was made, prior to the grant of the reissue, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before the grant of the reissue.

§ 253. Disclaimer

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, and recorded in the Patent Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

§ 254. Certificate of correction of Patent Office mistake

Whenever a mistake in a patent, incurred through the fault of the Patent Office, is clearly disclosed by the records of the Office, the Commissioner may issue a certificate of correction stating the fact and nature of such mistake, under seal, without charge, to be recorded in the records of patents. A printed copy thereof shall be attached to each printed copy of the patent, and such certificate shall be considered as part of the original patent. Every such patent, together with such certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form. The Commissioner may issue a corrected patent without charge in lieu of and with like effect as a certificate of correction.

§ 255. Certificate of correction of applicant's mistake

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent Office, appears in a patent and a showing has been made that such mistake occurred in good faith the Commissioner may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination. Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form.

§ 256. Misjoinder of inventor

Whenever a patent is issued on the application of persons as joint inventors and it appears that one of such persons was not in fact a joint inventor, and that he was included as a joint inventor by error and without any deceptive intention, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate deleting the name of the erroneously joined person from the patent.

Whenever a patent is issued and it appears that a person was a joint inventor, but was omitted by error and without deceptive intention on his part, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate adding his name to the patent as a joint inventor.

The misjoinder or nonjoinder of joint inventors shall not invalidate a patent, if such error can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Commissioner shall issue a certificate accordingly.

*Chapter 26—Ownership and assignment*


Sec.
261. Ownership; assignment.
262. Joint owners.


§ 261. Ownership; assignment

Subject to the provisions of this title, patents shall have the attributes of personal property.

Applications for patent, patents, or any interest therein, shall be assignable in law by an instrument in writing. The applicant, patentee, or his assigns or legal representatives may in like manner grant and convey an exclusive right under his application for patent, or patents, to the whole or any specified part of the United States.

A certificate of acknowledgment under the hand and official seal of a person authorized to administer oaths within the United States, or, in a foreign country, of a diplomatic or consular officer of the United States or an officer authorized to administer oaths whose authority is proved by a certificate of a diplomatic or consular officer of the United States, shall be prima facie evidence of the execution of an assignment, grant or conveyance of a patent or application for patent.

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 3 months from its date or prior to the date of such subsequent purchase or mortgage.

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§ 262. Joint owners

In the absence of any agreement to the contrary, each of the joint owners of a patent may make, use or sell the patented invention without the consent of and without accounting to the other owners.

*Chapter 27—Government interests in patents*

Sec.
266. Issue of patents without fees to Government employees.
267. Time for taking action in Government applications.

§ 266. Issue of patents without fees to Government employees

The Commissioner may grant, subject to the provisions of this title, to any officer, enlisted man, or employee of the Government, except officers and employees of the Patent Office, a patent without the payment of fees, when the head of a department or agency certifies the invention is used or likely to be used in the public interest and the applicant in his application states that the invention described therein, if patented, may be manufactured and used by or for the Government for governmental purposes without the payment to him of any royalty thereon, which stipulation shall be included in the patent.

§ 267. Time for taking action in Government applications

Notwithstanding the provisions of sections 133 and 151 of this title, the Commissioner may extend the time for taking any action to 3 years, when an application has become the property of the United States and the head of the appropriate department or agency of the Government has certified to the Commissioner that the invention disclosed therein is important to the armament or defense of the United States.

*Chapter 28—Infringement of patents*

Sec.
271. Infringement of patent.
272. Temporary presence in the United States.

§ 271. Infringement of patent

(a) Except as otherwise provided in this title, whoever without authority makes, uses or sells any patented invention, within the United States during the term of the patent therefor, infringes the patent.

(b) Whoever actively induces infringement of a patent shall be liable as an infringer.

(c) Whoever sells a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.

(d) No patent owner otherwise entitled to relief for infringement or contributory infringement of a patent shall be denied relief or deemed guilty of misuse or illegal extension of the patent right by reason of his having done one or more of the following: (1) derived revenue from acts which if performed by another without his consent would constitute contributory infringement of the patent; (2) licensed or authorized another to perform acts which if performed without his consent would constitute contributory infringement of the patent; (3) sought to enforce his patent rights against infringement or contributory infringement.

§ 272. Temporary presence in the United States

The use of any invention in any vessel, aircraft or vehicle of any country which affords similar privileges to vessels, aircraft or vehicles of the United States, entering the United States temporarily or accidentally, shall not constitute infringement of any patent, if the invention is used exclusively for the needs of the vessel, aircraft or vehicle and is not sold in or used for the manufacture of anything to be sold in or exported from the United States.

*Chapter 29—Remedies for infringement of patent, and other actions*

Sec.
281. Remedy for infringement of patent.
282. Presumption of validity; defenses.
283. Injunction.
284. Damages.
285. Attorney fees.
286. Time limitation on damages.
287. Limitation on damages; marking and notice.
288. Action for infringement of a patent containing an invalid claim.
289. Additional remedy for infringement of design patent.
290. Notice of patent suits.
291. Interfering patents.
292. False marking.
293. Nonresident patentee, service and notice.

§ 281. Remedy for infringement of patent

A patentee shall have remedy by civil action for infringement of his patent.

§ 282. Presumption of validity; defenses

A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it.

The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

(1) Noninfringement or absence of liability for infringement,

(2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability,

(3) Invalidity of the patent or any claim in suit for failure to comply with any requirement of sections 112 or 251 of this title,

(4) Any other fact or act made a defense by this title.

In actions involving the validity or infringement of a patent the party asserting invalidity or noninfringement shall give notice in the pleadings or otherwise in writing to the adverse party at least 30 days before the trial, of the country, number, date, and name of the patentee of any patent, the title, date, and page numbers of any publication to be relied upon as anticipation of the patent in suit or, except in actions in the United States Court of Claims, as showing the state of the art, and the name and address of any person who may be relied upon as the prior inventor or as having prior knowledge of or as having previously used or offered for sale the invention of the patent in suit. In the absence of such notice proof of the said matters may not be made at the trial except on such terms as the court requires.

§ 283. Injunction

The several courts having jurisdiction of cases under this title may grant injunctions in accordance with the principles of equity to prevent the violation of any right secured by patent, on such terms as the court deems reasonable.

§ 284. Damages

Upon adjudging a patent valid and infringed, the court shall award the claimant damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court.

When the damages are not found by a jury, the court shall assess them. In either event the court may increase the damages up to three times the amount found or assessed.

The court may receive expert testimony as an aid to the determination of damages or of what royalty would be reasonable under the circumstances.

§ 285. Attorney fees

The court in exceptional cases may award reasonable attorney fees to the prevailing party.

§ 286. Time limitation on damages.

Except as otherwise provided by law, no recovery shall be had for any infringement committed more than 6 years prior to the filing of the complaint or counterclaim for infringement in the action.

In the case of claims against the United States Government for use of a patented invention, the period before bringing suit, up to 6 years, between the date of receipt of a written claim for compensation by the department or agency of the Government having authority to settle such claim, and the date of mailing by the Government of a notice to the claimant that his claim has been denied shall not be counted as part of the period referred to in the preceding paragraph.

§ 287. Limitation on damages; marking and notice

Patentees, and persons making or selling any patented article for or under them, may give notice to the public that the same is patented, either by fixing thereon the word "patent" or the abbreviation "pat.", together with the number of the patent, or when, from the character of the article, this cannot be done, by fixing to it, or to the package wherein one or more of them is contained, a label containing a like notice. In the event of failure so to mark, no damages shall be be recovered by the patentee in any action for infringement, except on proof that the infringer was notified of the infringement and continued to infringe thereafter, in which event damages may be recovered only for infringement occurring after such notice. Filing of an action for infringement shall constitute such notice.

§ 288. Action for infringement of a patent containing an invalid claim

Whenever, without deceptive intention, a claim of a patent is invalid, an action may be maintained for the infringement of a claim of the patent which may be valid. The patentee shall recover no costs unless a disclaimer of the invalid claim has been entered at the Patent Office before the commencement of the suit.

§ 289. Additional remedy for infringement of design patent

Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit, but not less than $250, recoverable in any United States district court having jurisdiction of the parties.

Nothing in this section shall prevent, lessen, or impeach any other remedy which an owner of an infringed patent has under the provisions of this title, but he shall not twice recover the profit made from the infringement.

§ 290. Notice of patent suit

The clerks of the courts of the United States, within 1 month after the filing of an action under this title shall give notice thereof in writing to the Commisisoner, setting forth so far as known the names and addresses of the parties, name of the inventor, and the designating number of the patent upon which the action has been brought. If any other patent is subsequently included in the action he shall give like notice thereof. Within 1 month after the decision is

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rendered or a judgment issued the clerk of the court shall give notice thereof to the Commissioner. The Commissioner shall, on receipt of such notices, enter the same in the file of such patent.

§ 291. Interfering patents

The owner of an interfering patent may have relief against the owner of another by civil action, and the court may adjudge the question of the validity of any of the interfering patents, in whole or in part. The provisions of the second paragraph of section 146 of this title shall apply to actions brought under this section.

§ 292. False marking

(a) Whoever, without the consent of the patentee, marks upon, or affixes to, or uses in advertising in connection with anything made, used, or sold by him, the name of any imitation of the name of the patentee, the patent number, or the words "patent," "patentee," or the like, with the intent of counterfeiting or imitating the mark of the patentee, or of deceiving the public and inducing them to believe that the thing was made or sold by or with the consent of the patentee; or

Whoever marks upon, or affixes to, or uses in advertising in connection with any unpatented article, the word "patent" or any word or number importing that the same is patented, for the purpose of deceiving the public; or

Whoever marks upon, or affixes to, or uses in advertising in connection with any article, the words "patent applied for," "patent pending," or any word importing that an application for patent has been made, when no application for patent has been made, or, if made, is not pending, for the purpose of deceiving the public—

Shall be fined not more than $500 for every such offense.

(b) Any person may sue for the penalty, in which event one-half shall go to the person suing and the other to the use of the United States.

§ 293. Nonresident patentee; service and notice

Every patentee not residing in the United States may file in the Patent Office a written designation stating the name and address of a person residing within the United States on whom may be served process or notice of proceedings affecting the patent or rights thereunder. If the person designated cannot be found at the address given in the last designation, or if no person has been designated, the United States District Court for the District of Columbia shall have jurisdiction and summons shall be served by publication or otherwise as the court directs. The court shall have the same jurisdiction to take any action respecting the patent or rights thereunder that it would have if the patentee were personally within the jurisdiction of the court.

SEC. 2. Section 21 of the act approved July 5, 1946 (60 Stat. 435) (U. S. C., title 15, sec. 1071, 1946 ed.), is amended by striking out "Revised Statutes 4911" and inserting "35 United States Code, section 141"; by striking out "section 4915, Revised Statutes" and inserting "35 United States Code, sections 145 and 146"; and by striking out "Revised Statutes 4915", appearing twice in said section, and inserting "35 United States Code, section 144."

SEC. 3. If any provision of title 35, as enacted by section 1 hereof, is declared unconstitutional or is held invalid, the validity of the remainder of this title shall not be affected.

SEC. 4. (a) This act shall take effect on January 1, 1953, and shall apply to all applications for patent filed on or after such date and to all patents granted on such applications. It shall apply to further proceedings on applications pending on such date and to patents granted on such applications except as otherwise provided. It shall apply to unexpired patents granted prior to such date except as otherwise provided.

(b) Section 102 (d) of title 35, as enacted by section 1 hereof, shall not apply to existing patents and pending applications, but the law previously in effect, namely, the first paragraph of Revised Statutes 4887 (U. S. C., title 35, sec. 32, first paragraph, 1946 ed.), shall apply to such patents and applications.

(c) Section 119, second paragraph, of title 35 as enacted by section 1 hereof shall not apply to existing patents.

(d) The period of 1 year specified in section 102 (b) of title 35 as enacted by section 1 hereof shall not apply in the case of applications filed before August 5, 1940, and patents granted on such applications, and with respect to such applications and patents, said period is 2 years instead of 1 year.

(e) Nothing contained in title 35, as enacted by section 1 hereof, shall operate to nullify any judicial finding prior to the effective date of this act on the validity of any patent by a court of competent jurisdiction.

(f) Nothing in title 35, as enacted by section 1 hereof, shall affect any provision of the Atomic Energy Act of 1946 (Aug. 1, 1946, ch. 724, 60 Stat. 755).

(g) The period of 1 year specified in section 4 of title 35 as enacted by section 1 hereof shall not apply in the case of applications filed before the effective date of this act.

(h) The repeal of sections 1–9, 11, 12 of the act of Congress approved February 1, 1952 (ch. 4, 66 Stat. 3), shall not affect any rights or liabilities existing on the date of approval of this act. An order of secrecy issued under or in effect under the repealed act and in effect on the date of approval of this act, shall be considered as issued under this act, and any claims arising under the repealed act or subject to presentation and determination pursuant thereto and unsettled as of the effective date of this act, may be presented and determined pursuant to the provisions of this act.

SEC. 5. The sections or parts thereof of the Revised Statutes or Statues at Large enumerated in the following schedule are hereby repealed. Any rights or liabilities now existing under such sections or parts thereof shall not be affected by this repeal.

| Revised Statutes | U. S. Code, 1946 edition | |
|---|---|---|
| | Title | Section |
| Section: | | |
| 475 | 35 | 1 |
| 476 | 35 | 2 |
| 478 | 35 | 3 |
| 479 | 35 | 5 |
| 480 | 35 | 4 |
| 481 | 35 | 6 |
| 482 | 35 | 7 |
| 483 | 35 | 8 |
| 486 | 35 | 10 |
| 487 | 35 | 11 |
| 488 | 35 | 12 |
| 489 | 35 | 13 |
| 493 | 35 | 78 |
| 494 | 35 | 20 |
| 496 | 35 | 19 |
| 4883 | 35 | 39 |
| 4884 | 35 | 40 |
| 4885 | 35 | 41 |
| 4886 | 35 | 31 |
| 4887 | 35 | 32 |
| 4888 | 35 | 33 |
| 4889 | 35 | 34 |
| 4890 | 35 | 34 |
| 4891 | 35 | 34 |
| 4892 | 35 | 35 |
| 4893 | 35 | 36 |
| 4894 | 35 | 37 |
| 4895 | 35 | 44 |
| 4896 | 35 | 46 |
| 4898 | 35 | 47 |
| 4899 | 35 | 48 |
| 4900 | 35 | 49 |
| 4901 | 35 | 50 |
| 4903 | 35 | 51 |
| 4904 | 35 | 52 |
| 4905 | 35 | 53 |
| 4906 | 35 | 54 |
| 4907 | 35 | 55 |
| 4908 | 35 | 56 |
| 4909 | 35 | 57 |
| 4911 | 35 | 59a |
| 4912 | 35 | 60 |
| 4913 | 35 | 61 |
| 4914 | 35 | 62 |
| 4915 | 35 | 63 |
| 4916 | 35 | 64 |
| 4917 | 35 | 65 |
| 4918 | 35 | 66 |
| 4919 | 35 | 67 |
| 4920 | 35 | 69 |
| 4921 | 35 | 70 |
| 4922 | 35 | 71 |
| 4923 | 35 | 72 |
| 4929 | 35 | 73 |
| 4930 | 35 | 76 |
| 4931 | 35 | 77 |
| 4933 | 35 | 73 |
| 4934 | 35 | 78 |
| 4935 | 35 | 79 |
| 4936 | 35 | 79 |

| Statutes at Large | | | | | U. S. Code, 1946 edition | |
|---|---|---|---|---|---|---|
| Date | Chapter | Section | Volume | Page | Title | Section |
| 1883—Mar. 3 | 143 | Part [1] | 22 | 623 | 35 | 45. |
| 1887—Feb. 4 | 105 | 1 | 24 | 387 | 35 | 74. |
| | | 2 | 24 | 388 | 35 | 75. |
| 1888—Feb. 18 | 15 | | 25 | 40 | 35 | 39. |
| 1891—Mar. 3 | 541 | 1 part [2] | 26 | 839 | 35 | 11. |
| 1896—May 19 | 201 | | 29 | 124 | 35 | 78. |
| 1897—Mar. 3 | 3.1 | 1 | 29 | 692 | 35 | 31. |
| | | 2 | | 692 | 35 | 60. |
| | | 3 | | 693 | 35 | 32. |
| | | 4 | | 693 | 35 | 37. |
| | | 5 | | 693 | 35 | 47. |
| | | 6 | | 694 | 35 | 70. |
| | | 7 | | 694 | 35 | 43. |
| 1903—June 10 | 423 | 1 | 30 | 440 | 35 | 6 note. |
| 1899—Feb. 28 | 227 | | 30 | 915 | 35 | 46. |
| 1902—Apr. 11 | 417 | | 32 | 95 | 35 | 30. |
| May 9 | 783 | | 32 | 193 | 35 | 73. |
| 1903—Mar. 3 | 1019 | 1 | 32 | 1225 | 35 | 32. |
| | | 2 | | 1226 | 35 | 35. |
| | | 3 | | 1226 | 35 | 46. |
| 1903—May 23 | 188 | | 35 | 245 | 35 | 46. |
| May 23 | 189 | | 35 | 246 | 35 | 41. |
| May 27 | 200 | 1 part [3] | 35 | 343 | 35 | 78. |
| 1915—Jan. 14 | Pub. Res. 61. | | 38 | 1221 | 35 | 15. |
| Mar. 3 | 94 | 1 | 38 | 958 | 35 | 33. |
| | | 2 | | 959 | 35 | 34. |
| 1916—Feb. 15 | 22 | 1 | 39 | 8 | 35 | 2. |
| 1916—July 6 | 225 | 1 part [4] | 39 | 348 | 35 | 37. |
| 1919—Nov. 4 | 93 | 1 part [5] | 41 | 335 | 35 | 78. |
| 1920—Mar. 6 | 94 | 1 part [6] | 41 | 512 | 35 | 79. |
| 1921—Mar. 3 | 126 | 1 | 41 | 1313 | 35 | 80. |
| | | 2 | | 1314 | 35 | 81. |
| | | 3 | | 1314 | 35 | 82. |
| | | 4 | | 1314 | 35 | 83. |
| | | 5 | | 1314 | 35 | 84. |
| | | 6 | | 1314 | 35 | 85. |
| | | 7 | | 1314 | 35 | 86. |
| | | 8 | | 1315 | 35 | 87. |
| 1922—Feb. 18 | 58 | | | | | |
| | | 3 | 42 | 390 | 35 | 11. |
| | | 5 | | 391 | 35 | 39. |
| | | 6 | | 391 | 35 | 47. |
| | | 7 | | 391 | 35 | 54. |
| | | 8 | | 392 | 35 | 70. |
| | | 9 | | 393 | 35 | 78. |
| 1925—Mar. 4 | 535 | 1 | 43 | 1268 | 35 | 88. |

[1] The part relating to the granting of patents to Government employees without fees.
[2] The part relating to certified copies of drawings and specifications.
[3] The part relating to fees for recording assignments.
[4] The part amending R. S. 4894.
[5] The part relating to the price of copies of patents.
[6] The part relating to payment of fees.

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| Statutes at Large | | | | | U. S. Code, 1946 edition | |
|---|---|---|---|---|---|---|
| Date | Chapter | Section | Volume | Page | Title | Section |
| 1927—Feb. 7 | 67 | | 44 | 1058 | 35 | 49. |
| Feb. 14 | 139 | 1 | 44 | 1068 | 35 | 2. |
| | | 2 | | 1069 | 35 | 78. |
| Mar. 2 | 273 | 1 | 44 | 1335 | 35 | 37. |
| | | 3 | | 1335 | 35 | 7. |
| | | 4 | | 1336 | 35 | 52. |
| | | 5 | | 1336 | 35 | 57. |
| | | 8 | | 1336 | 35 | 59a. |
| | | 9 | | 1336 | 35 | 60. |
| | | 10 | | 1336 | 35 | 61. |
| | | 11 | | 1336 | 35 | 63. |
| | | 12 | | 1337 | 35 | 66. |
| | | 13 | | 1337 | 35 | 78. |
| | | 14 | | 1337 | 35 | 21. |
| 1927—Mar. 3 | 364 | | 44 | 1364 | 35 | 72a. |
| 1928—Apr. 30 | 460 | | 45 | 467 | 35 | 45. |
| May 24 | 730 | | 45 | 732 | 35 | 64. |
| May 31 | 992 | 1 | 45 | 1012 | 35 | 40a. |
| | | 2 | | 1013 | 35 | 40b. |
| | | 3 | | 1013 | 35 | 40c. |
| | | 4 | | 1014 | 35 | 40d. |
| 1929—Mar. 2 | 488 | 2b | 45 | 1476 | 35 | 59a, 60, 63. |
| 1930—Apr. 11 | 152 | 1 | 46 | 155 | 35 | 2. |
| | | 2 | | 155 | 35 | 7. |
| | | 3 | | 155 | 35 | 78. |
| | | 5 | | 156 | 35 | 22. |
| May 23 | 312 | 1 | 46 | 376 | 35 | 31, 40. |
| | | 2 | | 376 | 35 | 33. |
| | | 3 | | 376 | 35 | 35. |
| | | 4 | | 376 | 35 | 52a. |
| | | 5 | | 376 | 35 | 32a. |
| | | 6 | | 376 | 35 | 32b. |
| 1932—June 30 | 314 | 308 | 47 | 410 | 35 | 78. |
| | | 309 | | 410 | 35 | 78. |
| 1936—June 19 | 594 | | 49 | 1629 | 35 | 32. |
| 1938—May 9 | 188 | | 52 | 342 | 35 | 110. |
| 1939—Aug. 5 | 450 | 1 | 53 | 1212 | 35 | 31, 32, 69, 73. |
| | | 2 | | 1212 | 35 | 31 note. |
| Aug. 5 | 461 | 1 | 53 | 1212 | 35 | 52. |
| | | 2 | | 1212 | 35 | 57. |
| | | 3 | | 1212 | 35 | 59a. |
| | | 4 | | 1212 | 35 | 63. |
| Aug. 5 | 452 | 1 | 53 | 1213 | 35 | 51. |
| Aug. 7 | 568 | | 53 | 1264 | 35 | 37. |
| Aug. 9 | 619 | 2 | 53 | 1293 | 35 | 41. |
| | | 3 | | 1293 | 35 | 78. |
| 1941—Aug. 18 | 370 | | 55 | 634 | 35 | 47. |
| 1946—July 5 | 541 | 301 part [1] | 60 | 471 | 35 | 78. |
| Aug. 1 | 726 | | 60 | 778 | 35 | 70. |
| Aug. 3 | 910 | 9 | 60 | 943 | 35 | 109. |
| 1950—Mar. 4 | 50 | | 64 | 11 | 35 | 7. |
| June 15 | 249 | | 64 | 215 | 35 | 78. |
| 1951—Oct. 31 | 655 | 53a | 65 | 728 | 35 | 72a. |
| 1952—Feb. 1 | 4 | 1 | 66 | 3 | 35 | 151. |
| | | 2 | | 4 | 35 | 152. |
| | | 3 | | 4 | 35 | 153. |
| | | 4 | | 5 | 35 | 154. |
| | | 5 | | 5 | 35 | 155. |
| | | 6 | | 5 | 35 | 156. |
| | | 7 | | 6 | 35 | 157. |
| | | 8 | | 6 | 35 | 158. |
| | | 9 | | 6 | | |
| | | 11 | | 6 | 35 | 159. |
| | | 12 | | 6 | | |

[1] The part relating to the fee for copies of specifications and drawings of patents.

The bill was ordered to be engrossed and read a third time, was read the third time, and passed, and a motion to reconsider was laid on the table.

## TRANSFER BY SECRETARY OF AGRICULTURE TO DEPARTMENT OF THE NAVY OF CERTAIN PROPERTY AT SHUMAKER, ARK.

The Clerk called the bill (S. 1403) to authorize and direct the Secretary of Agriculture to transfer to the Department of the Navy certain property at Shumaker, Ark.

There being no objection, the Clerk read the bill, as follows:

*Be it enacted, etc.*, That the Secretary of Agriculture is authorized and directed to transfer, without exchange of funds, to the custody and control of the Navy Department a parcel of land, with any improvements thereon, at the United States Naval Ammunition Depot, Shumaker, in Calhoun County, Ark., containing 118 acres, more or less, being the same parcel of land described in a revocable permit from the War Food Administration to the Navy Department dated June 23, 1945, and which is now occupied and used as an integral part of the said ammunition depot.

The bill was ordered to be read a third time, was read the third time, and passed, and a motion to reconsider was laid on the table.

## EASEMENTS FOR RIGHTS-OF-WAY FOR THE TRANSMISSION LINES ACROSS NATIONAL FOREST LANDS

The Clerk called the bill (S. 1630) to amend the provision in the act of March 4, 1911—Thirty-sixth Statutes, pages 1235, 1253—authorizing the granting of easements for rights-of-way for electrical transmission, telephone, and telegraph lines and poles.

There being no objection, the Clerk read the bill, as follows:

*Be it enacted, etc.*, That the fourth paragraph under the subheading "Improvement of the National Forests" under the heading "Forest Service" of the act entitled "An act making appropriations for the Department of Agriculture for the fiscal year ending June 30, 1912" (36 Stat. 1253, 43 U. S. C. 961) is amended to read as follows:

"That the head of the department having jurisdiction over the lands he, and he hereby is, authorized and empowered, under general regulations to be fixed by him, to grant an easement for rights-of-way, for a period not exceeding 50 years from the date of the issuance of such grant, over, across, and upon the public lands, national forests, and reservations of the United States for electrical poles and lines for the transmission and distribution of electrical power, and for poles and lines for communication purposes, and for radio, television, and other forms of communication transmitting, relay, and receiving structures and facilities, to the extent of 200 feet on each side of the center line of such lines and poles and not to exceed 400 feet by 400 feet for radio, television, and other forms of communication transmitting, relay, and receiving structures and facilities, to any citizen, association, or corporation of the United States, where it is intended by such to exercise the right-of-way herein granted for any one or more of the purposes herein named: *Provided*, That such right-of-way shall be allowed within or through any national park, national forest, military, Indian, or any other reservation only upon the approval of the chief officer of the department under whose supervision or control such reservation falls, and upon a finding by him that the same is not incompatible with the public interest: *Provided further*, That all or any part of such right-of-way may be forfeited and annulled by declaration of the head of the department having jurisdiction over the lands for nonuse for a period of 2 years or for abandonment."

The bill was ordered to be read a third time, was read the third time, and passed, and a motion to reconsider was laid on the table.

## EMERGENCY ASSIGNMENTS OF POSTAL EMPLOYEES TO RURAL ROUTES

The Clerk called the bill (H. R. 7204) to amend section 5 of the act entitled "An act to credit certain service performed by employees of the postal service who are transferred from one position to another within the service for purposes of determining eligibility for promotion," approved June 19, 1948.

There being no objection, the Clerk read the bill, as follows:

*Be it enacted, etc.*, That section 5 of the act entitled "An act to credit certain service performed by employees of the postal service who are transferred from one position to another within the service for purposes of determining eligibility for promotion," approved June 19, 1948 (sec. 883, title 39, U. S. C.), is hereby amended to read as follows:

"SEC. 5. The rate of compensation of any employee in the postal service, except regular, temporary, or substitute rural carriers, whose services are utilized in a dual capacity shall not be reduced as a result of employment in such capacity: *Provided*, That any employee in the postal service who is assigned to serve any rural route, and who shall furnish the vehicle used in the performance of such service, shall receive the equipment maintenance allowance provided for the route so served, in addition to the compensation paid such employee."

The bill was ordered to be engrossed and read a third time, was read the third time, and passed, and a motion to reconsider was laid on the table.

## REVISION OF REPORTING REQUIREMENTS FOR MAIL SCHEDULES

The Clerk called the bill (H. R. 7205) to amend section 3841 of the Revised Statutes relating to the schedules of the arrival and departure of the mail, to repeal certain obsolete laws relating to the postal service, and for other purposes.

There being no objection, the Clerk read the bill, as follows:

*Be it enacted, etc.*, That section 3841 of the Revised Statutes (sec. 7, title 39, U. S. C.) is hereby amended by striking out the clause reading "and he shall cause to be kept and returned to the Department, at short and regular intervals, registers, showing the exact times of the arrivals and departures of the mail.", and by inserting in lieu thereof, a clause to read as follows: "and he shall cause to be kept and forwarded to the Department, or designated field offices, such reports as he may consider necessary."

SEC. 2. The act entitled "An act to reclassify postmasters and employees of the Postal Service and readjust their salaries and compensation on an equitable basis," approved June 5, 1920 (41 Stat. 1045), as amended, is hereby further amended by striking out the paragraph reading:

"A clerk in charge is defined as a clerk in charge of a railway post office, terminal railway post office, or transfer office whether he performs service alone or has a crew of clerks under his supervision, or of a tour or a crew within a tour of a terminal railway post office or transfer office."

SEC. 3. Section 3975 of the Revised Statutes (sec. 493, title 39, U. S. C.) is hereby amended to read as follows:

"SEC. 3975. The Postmaster General may, when he deems it advisable, contract for the transportation of the mails to and from any post office."

With the following committee amendment.

The amendment is as follows: On page 2, beginning with line 13, strike out down through and including line 17, and insert:

"SEC. 3. Section 3975 of the Revised Statutes (sec. 493, title 39, U. S. C.) is hereby amended by striking out the semicolon and

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UNITED STATES OF AMERICA

# Congressional Record

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## VOLUME 98—PART 4

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## REPORT OF COMMITTEE ON INTERSTATE AND FOREIGN COMMERCE

Mr. JOHNSON of Colorado, from the Committee on Interstate and Foreign Commerce, to which was referred the bill (S. 2592) to amend section 403 (b) of the Civil Aeronautics Act of 1938 so as to permit the granting of free or reduced-rate transportation to ministers of religion, reported it without amendment, and submitted a report (No. 1585) thereon.

## BILLS INTRODUCED

Bills were introduced, read the first time, and, by unanimous consent, the second time, and referred as follows:

By Mr. JOHNSTON of South Carolina:

S. 3200. A bill to extend the benefits of the Veterans' Preference Act of 1944 to persons serving in the Armed Forces of the United States after the termination of the state of war between the United States and the Government of Japan and prior to July 2, 1955; to the Committee on Post Office and Civil Service.

By Mr. THYE:

S. 3201. A bill for the relief of Ruth Ann Holecek; to the Committee on the Judiciary.

By Mr. BRIDGES (for Mr. ECTON):

S. 3202. A bill for the relief of Beryl Ardythe Arnold; to the Committee on the Judiciary.

By Mr. SEATON (for himself and Mr. WILLIAMS):

S. 3203. A bill to amend section 284 of title 18 of the United States Code so as to require registration by former officers and employees of the Government who act as counsel, attorney, or agent before Government agencies; to the Committee on the Judiciary.

By Mr. SEATON:

S. 3204. A bill for the relief of Don B. Whelan; and

S. 3205. A bill for the relief of Hiroko Tokunaga and her son; to the Committee on the Judiciary.

By Mr. O'CONOR:

S. 3206. A bill to amend and clarify certain provisions of law relating to maritime functions of the Secretary of Commerce, and for other purposes; to the Committee on Interstate and Foreign Commerce.

## HOUSE BILLS AND JOINT RESOLUTION REFERRED

The following bills and joint resolution were severally read twice by their titles, and referred as indicated:

H. R. 2390. An act to rescind certain details required by law to be included in the annual report of the Board of Trustees of the Postal Savings System;

H. R. 5850. An act to authorize the Postmaster General to impound mail in certain cases;

H. R. 6764. An act to provide that salaries of rural carriers serving heavily patronized routes shall not be reduced by reason of increases in the length of such routes;

H. R. 7030. An act to amend certain acts and parts of acts which require the submission of documents to the Post Office Department under oath, and for other purposes;

H. R. 7204. An act to amend section 5 of the act entitled "An act to credit certain service performed by employees of the postal service who are transferred from one position to another within the service for purposes of determining eligibility for promotion," approved June 19, 1948;

H. R. 7205. An act to amend section 3841 of the Revised Statutes relating to the schedules of the arrival and departure of the mail, to repeal certain obsolete laws relating to the postal service, and for other purposes; and

H. R. 7758. An act to revise certain laws relating to the mail-messenger service; to the Committee on Post Office and Civil Service.

H. R. 2813. An act to authorize the Secretary of the Interior to construct, operate, and maintain the Collbran reclamation project, Colorado, and to provide for disposition of the project upon completion of repayment;

H. R. 3438. An act to amend the act entitled "An act relating to the compensation of commissioners for the Territory of Alaska," approved March 16, 1948 (62 Stat. 80);

H. R. 4752. An act to amend the mineral leasing laws in order to eliminate the waiver of rentals for oil and gas leases; and

H. R. 6531. An act to amend the American River Development Act, and for other purposes; to the Committee on Interior and Insular Affairs.

H. R. 3098. An act to amend sections 1331 and 1332 of title 28, United States Code, relating to amount in controversy;

H. R. 7794. An act to revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents"; and

H. J. Res. 411. Joint resolution to authorize completion and termination of the issuance of immigration visas authorized under the Act of June 25, 1948, as amended; to the Committee on the Judiciary.

H. R. 5314. An act to authorize the transfer to the regents of the University of California, for agricultural purposes, of certain real property in Napa County, Calif.; to the Committee on Agriculture and Forestry.

H. R. 5350. An act to amend further the Federal Property and Administrative Services Act of 1949, as amended, and for other purposes; to the Committee on Government Operations.

H. R. 7783. An act to increase certain rates of veterans' compensation provided for specific service-incurred disabilities, and for other purposes; to the Committee on Finance.

## CHANGE OF REFERENCE

On motion by Mr. JOHNSTON of South Carolina, the Committee on Post Office and Civil Service was discharged from the further consideration of the bill (S. 3165) for the relief of John N. Wilson and Hamilton M. Webb, and it was referred to the Committee on Armed Services.

## ADDRESSES, EDITORIALS, ARTICLES, ETC., PRINTED IN THE APPENDIX

On request, and by unanimous consent, addresses, editorials, articles, etc., were ordered to be printed in the Appendix, as follows:

By Mr. MARTIN:

Address delivered by him on May 17, 1952, at Harrisburg, Pa., to Pennsylvania Federation of Young Republican Clubs.

Menu of Delmonico's Restaurant in 1834, published in the Washington Reporter, Washington, Pa.

By Mr. CAPEHART:

Speech entitled "Demonstrating the Right to Public Confidence," delivered by Mr. Victor H. Nyborg, president, Association of Better Business Bureaus, Inc., before the annual meeting of the Better Business Bureau of Washington, D. C., Inc., May 19, 1952.

By Mr. JOHNSON of Texas:

Editorial entitled "The President and Offshore Wealth," published in the Washington Evening Star of May 20, 1952.

By Mrs. SMITH of Maine:

Resolution adopted by the North York, Maine, United Baptist Association on proposed appointment of Ambassador to the Vatican.

By Mr. WELKER:

Article entitled "New Senior Senator," praising Senator BUTLER of Maryland, published in the Annapolis Evening Capital of May 15, 1952.

By Mr. DWORSHAK:

Article entitled "The Riddle of Charles Lindbergh," published in the American Weekly of May 18, 1952.

By Mr. KEM:

Editorial entitled "Hokum in Agriculture," published in a recent issue of the Washington Daily News.

## SALE OF NATIONAL FOREST TIMBER WITHOUT ADVERTISEMENT

The VICE PRESIDENT laid before the Senate the amendment of the House of Representatives to the bill (S. 1517) to amend the act of June 4, 1897, entitled "An act making appropriations for sundry civil expenses of the Government for the fiscal year ending June 30, 1898, and for other purposes," as amended, to enable the Secretary of Agriculture to sell without advertisement national forest timber in amounts not exceeding $2,000 in appraised value, which was, on page 1, line 5, to strike out all after the word "amended" down to and including "value" line 2, on page 2, and insert "by striking out the words 'in value five hundred dollars' and substituting in lieu thereof '$2,000 in appraised value'."

Mr. ELLENDER. I move that the Senate concur in the amendment of the House.

The motion was agreed to.

## THE ANTICIPATED DEFICIT—HOARDING OF UNITED STATES CURRENCY ABROAD

Mr. ROBERTSON. Mr. President, I ask unanimous consent to proceed for 4 minutes, so that I may comment on a report made by the Joint Committee on Internal Revenue Taxation with reference to the anticipated deficit.

The VICE PRESIDENT. Is there objection? The Chair hears none, and the Senator from Virginia is recognized for 4 minutes.

Mr. ROBERTSON. Mr. President, some days ago the senior Senator from New Jersey [Mr. SMITH] brought to my attention the fact that while some of our European allies were claiming a large dollar shortage, their nationals had hoarded a substantial amount of our currency, and the Senator from New Jersey asked me what I thought should be done about it.

The first thing I did was to ask the Legislative Reference Service of the Library of Congress to give me what information it had on the subject. On yesterday I received from the Economic Section of the Reference Service a quotation from Pick's World Currency Report which said:

> United States bank-note hoards abroad grew from about a billion dollars in 1938 to between six billion and seven billion presently. Forty percent of this amount is hidden in France, 15 percent in Italy, 8 percent in Benelux, 8 percent in Central and South America, and 7 percent in Asia.

I still do not know what we should do about that situation, but on yesterday another communication came over my

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UNITED STATES OF AMERICA

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S. 2662. A bill for the relief of Sadako Ishiguro (Rept. No. 1968);

S. 2907. A bill to prescribe policy and procedure in connection with construction contracts made by executive agencies, and for other purposes; without recommendation (Rept. No. 1969);

H. R. 1095. A bill for the relief of Shelby Shoe Co., of Salem, Mass. (Rept. No. 1970);

H. R. 1098. A bill for the relief of the estate of C. G. Allen (Rept. No. 1971);

H. R. 3527. A bill for the relief of Morris Tutnauer (Rept. No. 1972);

H. R. 4180. A bill for the relief of Joseph Denekar and Mrs. Mary A. Denekar (Rept. No. 1973); and

H. R. 5238. A bill for the relief of Albert O. Holland and Bergtor Haaland (Rept. No. 1974).

By Mr. McCARRAN, from the Committee on the Judiciary, with amendments:

S. 1613. A bill for the relief of Lian-Tong Wen (Rept. No. 1975);

S. 2372. A bill for the relief of Sizuko Kato (Rept. No. 1976);

S. 2439. A bill to provide funds for the acquisition and maintenance of a German Embassy by the Federal Republic of Germany (Rept. No. 1977); and

H. R. 746. A bill for the relief of Harris A. Bakken (Rept. No. 1978).

By Mr. WILEY, from the Committee on the Judiciary:

H. R. 7794. A bill to revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents"; with amendments (Rept. No. 1979).

By Mr. O'MAHONEY, from the Committee on Interior and Insular Affairs:

S. 3333. A bill to vest title in the United States to certain lands and interests in lands of the Shoshone and Arapaho Indian Tribes of the Wind River Reservation and to provide compensation therefor, and for other purposes; with amendments (Rept. No. 1980).

By Mr. McCARRAN, from the Committee on the Judiciary:

S. 3281. A bill for the relief of Chiu But Yue (Rept. No. 1981).

## PROVISION FOR SUNDRY ADMINISTRATIVE MATTERS AFFECTING THE FEDERAL GOVERNMENT—REPORT OF A COMMITTEE

Mr. HUNT. Mr. President, from the Committee on Armed Services, I report favorably an original bill to provide for sundry administrative matters affecting the Federal Government, particularly the Army, Navy, Air Force, and State Department, and for other purposes, and I submit a report (No. 1865) thereon.

The PRESIDENT pro tempore. The report will be received, and the bill will be placed on the calendar.

The bill (S. 3409) to provide for sundry administrative matters affecting the Federal Government, particularly the Army, Navy, Air Force, and State Department, and for other purposes, reported by Mr. HUNT, from the Committee on Armed Services, was read twice by its title, and ordered to be placed on the calendar.

## INCREASED LIMIT OF EXPENDITURES BY COMMITTEE ON FOREIGN RELATIONS—REPORT OF A COMMITTEE

Mr. CONNALLY. Mr. President, from the Committee on Foreign Relations, I report an original resolution to increase the limit of expenditures by the Committee on Foreign Relations.

The PRESIDENT pro tempore. The resolution will be received, and, under the rule, referred to the Committee on Rules and Administration.

The resolution (S. Res. 342) was referred to the Committee on Rules and Administration, as follows:

*Resolved*, That the Committee on Foreign Relations hereby is authorized to expend from the contingent fund of the Senate, during the Eighty-second Congress, $10,000 in addition to the amount and for the same purposes specified in section 134 (a) of the Legislative Reorganization Act, approved August 2, 1946, and Senate Resolution 171, agreed to August 6, 1951, and Senate Resolution 219, agreed to October 11, 1951.

## RELIEF OF CERTAIN CONSTRUCTION FIRMS—REFERENCE OF BILL TO COURT OF CLAIMS—REPORT OF A COMMITTEE

Mr. McCARRAN. Mr. President, from the Committee on the Judiciary, I report an original resolution to refer the bill (S. 3326) for the relief of certain construction firms, to the Court of Claims, and I submit a report (No. 1872) thereon.

The PRESIDENT pro tempore. The report will be received, and the resolution will be placed on the Calendar.

The resolution (S. Res. 343) was placed on the calendar, as follows:

*Resolved*, That the bill (S. 3326) for the relief of certain construction firms, now pending in the Senate, together with all the accompanying papers, is hereby referred to the United States Court of Claims; and the court shall proceed with the same in accordance with the provisions of sections 1492 and 2509 of title 28 of the United States Code and report to the Senate, at the earliest practicable date, giving such findings of fact and conclusions thereon as shall be sufficient to inform the Congress of the nature and character of the demand as a claim, legal or equitable, against the United States and the amount, if any, legally or equitably due from the United States to the claimants: *Provided, however*, That the passage of this resolution shall not be construed as an inference of liability on the part of the Government of the United States.

## V. A. VERHEI—REFERENCE OF BILL TO COURT OF CLAIMS

Mr. McCARRAN. Mr. President, from the Committee on the Judiciary, I report an original resolution to refer the bill (S. 1609) for the relief of V. A. Verhei, to the Court of Claims, and I submit a report (No. 1873) thereon.

The PRESIDENT pro tempore. The report will be received, and the resolution will be placed on the calendar.

The resolution (S. Res. 344) was placed on the calendar, as follows:

*Resolved*, That the bill (S. 1609) for the relief of V. A. Verhei, now pending in the Senate, together with all the accompanying papers, is hereby referred to the United States Court of Claims; and the court shall proceed with the same in accordance with the provisions of sections 1492 and 2509 of title 28 of the United States Code and report to the Senate, at the earliest practicable date, giving such findings of fact and conclusions thereon as shall be sufficient to inform the Congress of the nature and character of the demand as a claim, legal or equitable, against the United States and the amount, if any, legally or equitably due from the United States to the claimant: *Provided, however*, That the passage of this resolution shall not be construed as an inference of liability on the part of the Government of the United States.

## UNAUTHORIZED USE OF ALUMINUM IN STORM-WINDOW INDUSTRY—REPORT OF A COMMITTEE (REPT. NO. 1869)

Mr. SPARKMAN, from the Select Committee on Small Business, submitted a report relating to the unauthorized use of aluminum in the storm-window industry, which was ordered to be printed.

## BILLS INTRODUCED

Bills were introduced, read the first time, and, by unanimous consent, the second time, and referred as follows:

By Mr. CORDON:

S. 3408. A bill to permit exploration, location, entry, and disposition under the mineral-land laws of the United States of certain lands acquired by the United States; to the Committee on Interior and Insular Affairs.

By Mr. HUNT:

S. 3409. A bill to provide for sundry administrative matters affecting the Federal Government, particularly the Army, Navy, Air Force, and State Department, and for other purposes; ordered to be placed on the calendar.

(See the remarks of Mr. HUNT when he reported the above bill from the Committee on Armed Services, which appear under a separate heading.)

By Mr. DIRKSEN:

S. 3410. A bill to provide for more local control and support and to regulate and limit public housing and to provide for slum clearance; to the Committee on Banking and Currency.

By Mr. MORSE:

S. 3411. A bill for the relief of Marie T. Gonsalves; to the Committee on the Judiciary.

## AMENDMENT OF SECTION 457 OF INTERNAL REVENUE CODE—AMENDMENTS

Mr. McKELLAR submitted an amendment intended to be proposed by him to the bill (H. R. 8271) to amend section 457 of the Internal Revenue Code, which was ordered to lie on the table and to be printed.

Mr. MARTIN. Mr. President, I submit an amendment intended to be proposed by me to the bill (H. R. 8271) to amend section 457 of the Internal Revenue Code. I ask unanimous consent that a statement by me in support of the amendment be printed in the RECORD.

The PRESIDENT pro tempore. The amendment will be received and printed, and will lie on the table; and, without objection, the statement presented by the Senator from Pennsylvania will be printed in the RECORD.

The statement is as follows:

STATEMENT BY SENATOR MARTIN IN SUPPORT OF AMENDMENT

The purpose of the excess profits tax law is to tax as excess profits all corporate earning in excess of normal earnings of the base period years 1946–49, inclusive.



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UNITED STATES OF AMERICA

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The amendment was ordered to be engrossed and the bill to be read a third time.

The bill was read the third time and passed.

RUBEN GEORGE VARGA AND MRS. ILONA VARGA

The bill (H. R. 4250) for the relief of Ruben George Varga and Mrs. Ilona Varga was considered, ordered to a third reading, read the third time, and passed.

TOSHIKO NAKAMUTA TAKIMOTO AND HER MINOR SON

The bill (H. R. 4326) for the relief of Toshiko Nakamuta Takimoto and her minor son was considered, ordered to a third reading, read the third time, and passed.

RAHEL ZAKAR PETERS

The bill (H. R. 4466) for the relief of Rahel Zakar Peters was considered, ordered to a third reading, read the third time, and passed.

SUZANNE MARIE SCHARTZ

The bill (H. R. 4503) for the relief of Suzanne Marie Schartz was considered, ordered to a third reading, read the third time, and passed.

MARK YEN HUI

The bill (H. R. 4588) for the relief of Mark Len Hui was considered, ordered to a third reading, read the third time, and passed.

LINDA LEE CONVERSE

The bill (H. R. 4632) for the relief of Linda Lee Converse was considered, ordered to a third reading, read the third time, and passed.

BARON FRED ALEXANDER D'OSTEN-SACKEN

The bill (H. R. 4709) for the relief of Baron Fred Alexander D'Osten-Sacken was considered, ordered to a third reading, read the third time, and passed.

DEBORAH ANITA HUDSON

The bill (H. R. 4762) for the relief of Deborah Anita Hudson was considered, ordered to a third reading, read the third time, and passed.

EMMA GAZZANIGA AND OTHERS

The bill (H. R. 4866) for the relief of Emma Gazzaniga, Cecelia Trezzi, Clelia Mainetti, Bonosa Colombo, Emma Baldisserotto, Lina DalDosso, Lucia Paganoni, and Regina Pagani was considered, ordered to a third reading, read the third time, and passed.

ESTATE OF EMIL A. PESHEK

The bill (H. R. 4891) for the relief of the estate of Emil A. Peshek was considered, ordered to a third reading, read the third time, and passed.

HOONG MOY LAM

The bill (H. R. 5087) for the relief of Hoong Moy Lam was considered, ordered to a third reading, read the third time, and passed.

MARGARITE MARY FUJITA

The bill (H. R. 5107) for the relief of Margarite Mary Fujita was considered, ordered to a third reading, read the third time, and passed.

ALBERT O. HOLLAND AND BERGTOR HAALAND

The Senate proceeded to consider the bill (H. R. 5238) for the relief of Albert O. Holland and Bergtor Haaland which had been reported from the Committee on the Judiciary with an amendment in line 8, after the word "state", to insert "while employed in Venezuela under contract with the Venezuelan Government."

The amendment was agreed to.

The amendment was ordered to be engrossed and the bill to be read a third time.

The bill was read the third time and passed.

F. ARCHIE MEATYARD

The bill (H. R. 5496) for the relief of F. Archie Meatyard was considered, ordered to a third reading, read the third time, and passed.

JOHN H. VOGEL

The bill (H. R. 5515) for the relief of John H. Vogel was considered, ordered to a third reading, read the third time, and passed.

MRS. KATHARINA LUISE TRENYE

The bill (H. R. 5517) for the relief of Mrs. Katharina Luise Trenye was considered, ordered to a third reading, read the third time, and passed.

SISTER ANGELANTONIA DIANA

The bill (H. R. 5591) for the relief of Sister Angelantonia Diana was considered, ordered to a third reading, read the third time, and passed.

SACHIKO KANEMOCHI

The bill (H. R. 5864) for the relief of Sachiko Kanemochi was considered, ordered to a third reading, read the third time, and passed.

DELMA L. MAUZEY

The bill (H. R. 5955) for the relief of Delma L. Mauzey was considered, ordered to a third reading, read the third time, and passed.

DAVID DARYL DALKO

The bill (H. R. 6025) for the relief of David, Daryl Dalko was considered, ordered to a third reading, read the third time, and passed.

AYAKO SUKIURA

The bill (H. R. 6381) for the relief of Ayako Sukiura was considered, ordered to a third reading, read the third time, and passed.

JEANNE MARIE MIURA

The bill (H. R. 6446) for the relief of Jeanne Marie Miura was considered, ordered to a third reading, read the third time, and passed.

KAREN ANN CROWLEY

The bill (H. R. 6505) for the relief of Karen Ann Crowley was considered, ordered to a third reading, read the third time, and passed.

MARTHA BRIDGES

The bill (H. R. 6850) for the relief of Martha Bridges was considered, ordered to a third reading, read the third time, and passed.

LOUIE BON KONG

The bill (H. R. 6870) for the relief of Louie Bon Kong was considered, ordered to a third reading, read the third time, and passed.

KATHARINA HOFFMANN

The bill (H. R. 6945) for the relief of Katharina Hoffmann was considered, ordered to a third reading, read the third time, and passed.

RUTH ANN HOLECEK

The bill (H. R. 7095) for the relief of Ruth Ann Holecek was considered, ordered to a third reading, read the third time, and passed.

AI-LING TUNG TSOU AND HER SON, MOODY TSOU

The bill (H. R. 8052) for the relief of Ai-Ling Tung Tsou and her son, Moody Tsou, was considered, ordered to a third reading, read the third time, and passed.

CODIFICATION OF PATENT LAWS—BILL PLACED AT FOOT OF CALENDAR

The Senate proceeded to consider the bill (H. R. 7794) to revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents", which had been reported from the Committee on the Judiciary with amendments in chapter 10, section 102, on page 9, line 9, after the word "country", strike out "or" and insert "on"; in chapter 28, section 282, in the 5th line of the section, after the word "Noninfringement" to strike out "or"; in the same line, after the word "infringement", to strike out the comma and insert "or unenforceability,", and in the

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same chapter, section 284, beginning in line 1 of the section, to strike out "Upon adjudging a patent valid and infringed," and insert "Upon finding for the claimant."

The amendments were agreed to.

The amendments were ordered to be engrossed and the bill to be read a third time.

The bill was read the third time and passed.

Mr. HENDRICKSON subsequently said: Mr. President, let me ask what action was taken in the case of House bill 7794, Calendar 1908?

The PRESIDING OFFICER. That bill was passed.

Mr. HENDRICKSON. Mr. President, I ask unanimous consent that the vote by which the bill was passed be reconsidered.

The PRESIDING OFFICER. Is there objection to the request of the Senator from New Jersey? Without objection, the vote by which the bill was passed is reconsidered, and the bill as amended is before the Senate.

Mr. HENDRICKSON. Mr. President, by request, I ask that the bill be passed over.

The PRESIDING OFFICER. Objection being made, the bill is passed over.

Mr. WILEY. Mr. President, I wonder whether the Senator from New Jersey will withhold his objection?

Mr. HENDRICKSON. I have objected on behalf of the Senator from North Dakota [Mr. LANGER].

Mr. WILEY. I wonder whether the Senator will withhold objection, for I think probably we can agree to have the bill placed at the foot of the calendar. The bill provides for a codification of the patent laws, and the House of Representatives has worked on this subject for 3 or 4 years. The bill simply constitutes a restatement of the patent laws of the United States.

Mr. HENDRICKSON. I am quite familiar with the bill; it is a very meritorious measure, and I am in favor of it.

On the other hand, I have been requested to object. If the Senator from Wisconsin wishes to have the bill placed at the foot of the calendar, so that in the meantime he can discuss the matter with the Senator from North Dakota, I shall be very happy to have that done.

Mr. WILEY. I so request, Mr. President.

The PRESIDING OFFICER. Without objection, the bill will be placed at the foot of the calendar.

## TITLE TO CERTAIN LANDS OF SHOSHONE AND ARAPAHO INDIAN TRIBES OF WIND RIVER RESERVATION

The Senate proceeded to consider the bill (S. 3333) to vest title in the United States to certain lands and interests in lands of the Shoshone and Arapaho Indian Tribes of the Wind River Reservation and to provide compensation therefor, and for other purposes, which had been reported from the Committee on Interior and Insular Affairs with amendments on page 1, line 3, after the word "a" to insert "reasonable;" in line 4, after the word "consideration," to strike out "of" and insert "not to exceed," so as to make the bill read:

*Be it enacted, etc.*, That the Secretary of the Interior is authorized, for a reasonable consideration not to exceed $458,000, to be paid from funds appropriated for the Missouri River Basin project, to convey and relinquish to the United States of America the property and rights of the Shoshone and of the Arapaho Indian Tribes needed by the United States for the construction and operation and maintenance of the Boysen Unit of the Missouri River Basin project. Action heretofore taken by the Secretary of the Interior in granting rights-of-way over Indian lands for the establishment or the relocation of roads, highways, and railroads, and telegraph, telephone, power transmission, and pipelines in connection with the construction of the Boysen Unit of the Missouri River Basin project is hereby confirmed.

SEC. 2. The conveyances and relinquishments shall be, in all things, in accord with the memorandum of understanding between the Bureau of Reclamation and the Bureau of Indian Affairs as approved by the Secretary of the Interior on December 29, 1951, and as amended with his approval on May 1, 1952.

SEC. 3. The moneys to be paid to the Shoshone and Arapaho Tribes hereunder shall be deposited in the Treasury of the United States of America to the credit and for the use of the respective tribes in accordance with the provisions of the act of May 19, 1947 (61 Stat. 102), as amended by the act of August 30, 1951 (65 Stat. 208).

The amendments were agreed to.

The bill was ordered to be engrossed for a third reading, read the third time, and passed.

## SELECT COMMITTEE ON CONSUMER INTERESTS—RESOLUTION PASSED OVER

The Senate proceeded to consider the resolution (S. Res. 169) creating a Select Committee on Consumer Interests, which had been reported from the Committee on Rules and Administration with amendments on page 1, line 4, after the word "Senate" to insert "of whom not more than seven shall be of the same political party"; on page 2, line 8, after the word "the" to insert "ultimate"; in line 13, after "Eighty-second", to strike out "Congress" and insert "and succeeding Congresses", and on page 3, line 7, after the word "exceed" to insert "$158,800", so as to make the resolution read:

*Resolved*, That there is hereby created a select committee to be known as the Committee on Consumer Interests and to consist of 13 Senators to be appointed by the President of the Senate of whom not more than seven shall be of the same political party as soon as practicable after the date of adoption of this resolution.

It shall be the duty of such committee to study and survey by means of research and investigation all problems affecting consumer interests in the present national emergency and to obtain all facts possible in relation thereto which would not only be of public interest but which would aid the Congress in enacting remedial legislation, and to report to the Senate from time to time the results of such studies and surveys, together with its recommendations. No proposed legislation shall be referred to such committee and such committee shall not have power to report by bill or otherwise have legislative jurisdiction.

In carrying out its duties the committee shall give special attention to prices charged the ultimate consumer for food, fuel, and clothing and the costs and methods of producing, processing, and distributing these and other consumer goods.

For the purpose of this resolution, the committee, or any subcommittee thereof, is authorized to sit and act during the Eighty-second and succeeding Congresses at such times and places, whether or not the Senate is sitting, has recessed, or has adjourned; to employ upon a temporary basis such technical, clerical, and other assistants as it deems advisable; and, with the consent of the head of the department or agency concerned, to borrow from Government departments and agencies and special assistants, and to utilize the services, information, facilities, and personnel of all agencies in the executive branch of the Government; to hold such hearings; to require the attendance of such witnesses and the production of such books, papers, and documents; and to take such testimony, as it deems necessary. Subpenas may be issued under the signature of the chairman of the committee or any properly designated chairman of a subcommittee thereof, or any member designated by him, and may be served by any person designated by such chairman or member. The chairman of the committee or any member thereof may administer oaths to witnesses. The expenses of the committee under this resolution, which shall not exceed $158,800 shall be paid from the contingent fund of the Senate upon vouchers approved by the chairman of the committee.

The amendments were agreed to.

The resolution, as amended, was agreed to.

Mr. SCHOEPPEL subsequently said: Mr. President, was Senate Resolution 169, Calendar 1912, agreed to?

The PRESIDING OFFICER. Yes; it was agreed to, as amended.

Mr. SCHOEPPEL. I ask unanimous consent that the vote by which the resolution, as amended, was agreed to, be reconsidered, for I wish to object to the resolution.

The PRESIDING OFFICER. Without objection, the vote by which the resolution, as amended, was agreed to, is reconsidered.

The resolution, as amended, is now before the Senate.

Mr. SCHOEPPEL. Mr. President, I ask that the resolution be passed over.

The PRESIDING OFFICER. The resolution will be passed over.

## BILL PASSED OVER

The bill (S. 3413) authorizing the Secretary of State to make grants or loans to needy widows of Foreign Service officers who died prior to the effective date of the Foreign Service Act of 1946 was announced as next in order.

Mr. SCHOEPPEL. Mr. President, I ask that the bill be passed over.

The PRESIDING OFFICER. The bill will be passed over.

## NOGALES SANITATION PROJECT, ARIZONA

The bill (S. 960) to authorize an agreement between the United States and Mexico for the joint operation and maintenance by the International Boundary and Water Commission,



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continue to be so treated. They are subject to discipline; they can and are ordered to undesirable posts of duty on a moment's notice; are key men in the defense against bacteriological warfare; and they could, almost without exception, earn far more in private life than they are now getting. They have been successfully recruited largely because as commissioned officers of the Public Health Service they would be treated on the same basis as their opposite numbers in the Army and Navy.

The principal individual benefits which are derived from military status are widow's benefits, Government life insurance, the death gratuity, and the uniform allowance for junior officers. Loss of military status for the commissioned corps of the Public Health Service would mean the loss of all these benefits for its 2,500 officers. In effect, the Public Health Service would then be only one of the uniformed services without some type of death benefit.

Inasmuch as these authorities are currently in effect, there would be no additional appropriations required to support the comparatively minor expenditures authorized by the provisions of this amendment.

The PRESIDING OFFICER. Is there objection to the present consideration of the joint resolution?

Mr. CASE. Reserving the right to object, do I understand the Senator from Montana to say that the only statutory provisions which are extended are related to the Public Health Service?

Mr. MURRAY. That is correct.

Mr. CASE. There is no general extension of authority for the President to make whole losses or claims for losses sustained by Government contractors.

Mr. MURRAY. Absolutely none.

Mr. McKELLAR. Mr. President, I object.

The PRESIDING OFFICER. Objection is heard. The bill goes over.

## AMENDMENT OF NATIONAL HOUSING ACT

The PRESIDING OFFICER. The clerk will state the next bill passed to the foot of the calendar.

The LEGISLATIVE CLERK. A bill (H. R. 3177 (to amend title IV of the National Housing Act as amended.

Mr. HENDRICKSON. Mr. President, I asked that the bill go over, by request.

Mr. SPARKMAN. Mr. President, will the Senator withhold his objection?

Mr. HENDRICKSON. I gladly withhold my objection.

Mr. SPARKMAN. Mr. President, this morning we asked that the bill be placed at the foot of the calendar, because the distinguished Senator from California [Mr. KNOWLAND] was not on the floor. He is present now. I know that an effort has been made to draft language to do what the Senator from California wants to have done. I wonder whether the Senator from California has studied the proposed language which is sought to be added to the bill, and whether it is satisfactory to him.

Mr. KNOWLAND. Mr. President, I regret very much that the language which the Senator has in mind is not satisfactory. At least I have not had a chance to get an answer from the Pacific coast with reference to it. We are trying to reach them.

I do not believe the provision, in the form in which the Senator from Alabama now has it, will be satisfactory unless some change has occurred within the last half hour.

If the Senator could see his way clear to have the Senate adopt the amendment which my colleague, the junior Senator from California [Mr. NIXON] and I offered on the floor of the Senate the other day, but which was ruled out because of the parliamentary situation, we might then be able to work out such a provision in conference.

But under the circumstances I feel that the language of the alternative provision, as the Senator has prepared it, would not be satisfactory, and I would have to object to consideration of the bill at the present time.

Mr. SPARKMAN. I wonder whether the Senator from California will answer a further question: It is my understanding that a provision on this subject has been added in the House to the supplemental appropriation bill, which soon will be before the Senate, and it is my understanding that the Senate committee has worked out a provision somewhat similar to it, and that it is proposed to be offered in the Senate to that appropriation bill, when that bill is under consideration here. Is the Senator from California satisfied with that provision?

Mr. KNOWLAND. No, because I understand it will apply only to the funds covered by that particular bill.

The PRESIDING OFFICER. Under the rule, the time has expired.

Mr. KNOWLAND. Mr. President, I have reserved the right to object, and I do not think I have used all the time available to me.

Let me say that under the terms of the provision contained in the appropriation bill which the Senate has passed, certain limitations are imposed; but they apply only to the funds carried in that bill. Therefore, that provision in itself will not meet the problem.

If the Senator from Alabama could accept the so-called Knowland-Nixon amendment, it might be that within the next day the matter could be worked out to the satisfaction of the Senator from Alabama and to our satisfaction, because I think all of us are trying to find a solution to that very real problem.

Mr. SPARKMAN. Mr. President, if the Senator from California will yield to me——

Mr. KNOWLAND. I yield.

Mr. SPARKMAN. Let me say that of course I tried to make clear the other day that the only difference between our viewpoint and that of the Senator from California is that the provision he offered was not sufficient to protect the Federal Government in the breaking of a contract between an agency of the State of California and the city of Los Angeles. We have tried to draft a provision which will protect the Federal Government in connection with a contract which has been made between two State agencies. The Federal Government has a $12,000,000 investment in the development at Los Angeles.

Mr. McFARLAND. Mr. President, will the Senator from California yield to me, with the understanding that the time I shall use at this point will not be charged to the time available to him?

Mr. KNOWLAND. I yield, with that understanding.

The PRESIDING OFFICER. Without objection, it is so ordered.

Mr. McFARLAND. Mr. President, let me suggest that I realize that it may be possible to work out the objections which have been made in the case of some of the bills on the calendar. On the other hand, such objections are not worked out by means of debate on the floor.

Provided such an objection is worked out, I shall be inclined to move to have the bill brought up, and to try to have it passed before adjournment.

I wish to give that notice, because if some Senator has an objection to a bill, even though he did not make the objection on the floor, if he will register his objection to the bill with either the minority leader or with myself, in order that the objection may be worked out, and if it is worked out, we shall try to have the bill brought up. Of course, such a bill could not be brought up except by unanimous consent.

On the other hand, I do not see that we shall gain anything by debating these bills any longer, after objections have been lodged.

Mr. KNOWLAND. Mr. President, I am inclined to agree with the distinguished Senator from Arizona.

Therefore, temporarily I object to this bill. If we can work out the objection, I hope the majority leader will provide an opportunity for the Senator from Alabama to have the bill brought up.

Mr. McKELLAR. Mr. President, are there further bills to be called in connection with the call of the calendar?

The PRESIDING OFFICER. There are several others.

Mr. McKELLAR. We have yet to act on a $8,000,000,000 appropriation bill. Unless action is taken on it today, I am in doubt as to whether it will be possible to have final action taken on the bill by Saturday night. We should give ample attention to these important measures.

I shall request the floor immediately after the last bill on the calendar is called.

The PRESIDING OFFICER. The Senator from Tennessee will be recognized at that point.

Mr. McKELLAR. I thank the Chair.

## CODIFICATION OF PATENT LAWS—BILL PASSED OVER

The PRESIDING OFFICER. The next bill placed at the foot of the calendar will be called.

The LEGISLATIVE CLERK. A bill (H. R. 7794) to revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents."

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The PRESIDING OFFICER. Is there objection to the present consideration of the bill?

Mr. LANGER. Mr. President, I have objected to the present consideration of that bill. Perhaps the objection can be worked out, but at the present time I object.

The PRESIDING OFFICER. Objection is heard, and the bill will be passed over.

## STATE COMPACT RELATING TO WATERS OF COLUMBIA RIVER AND TRIBUTARIES

The PRESIDING OFFICER. The next bill previously placed at the foot of the calendar will be called.

The LEGISLATIVE CLERK. A bill (H. R. 2470) granting the consent of Congress the States of Idaho, Montana, Nevada, Oregon, Utah, Washington, and Wyoming, to negotiate and enter into a compact for the disposition, allocation, diversion, and apportionment of the waters of the Columbia River and its tributaries, and for other purposes.

The PRESIDING OFFICER. Is there objection to the present consideration of the bill?

There being no objection, the Senate proceeded to consider the bill, which had been reported from the Committee on Interior and Insular Affairs with amendments on page 1, line 4, after the name "Montana", to strike out "Nevada"; in the same line, after the name "Oregon", to strike out "Utah"; and on page 2, line 7, after the word "States", to strike out the comma and "including the four States having major interest, namely: Idaho, Montana, Oregon, and Washington,".

The amendments were agreed to.

The amendments were ordered to be engrossed and the bill to be read a third time.

The bill was read the third time and passed.

The title was amended so as to read: "An act granting the consent of Congress to the States of Idaho, Montana, Oregon, Washington, and Wyoming to negotiate and enter into a compact for the disposition allocation, diversion, and apportionment of the waters of the Columbia River and its tributaries, and for other purposes."

## CHIEF JOSEPH DAM IRRIGATION WORKS

The PRESIDING OFFICER. The next bill previously placed at the foot of the calendar will be stated.

The LEGISLATIVE CLERK. A bill (S. 2320) to provide the basis for authorization of irrigation works in connection with Chief Joseph Dam, to provide for financial assistance thereto from power revenues, and for other purposes.

The PRESIDING OFFICER. Is there objection to the present consideration of the bill?

There being no objection, the Senate proceeded to consider the bill, which had been reported from the Committee on Interior and Insular Affairs, with an amendment, to strike out all after the enacting clause and insert:

That the Secretary of the Interior is authorized to proceed in relation to the Chief Joseph Dam project on the Columbia River, Wash., initially authorized by section 1 of the act of July 24, 1946 (60 Stat. 637), in accordance with the provisions of this act to make a study and report to Congress on means of providing financial and other assistance in the reclamation of arid lands in the general vicinity of the project. In making such study and report the Secretary shall be guided by the provisions of applicable laws.

SEC. 2. The report of the Secretary of the Interior shall state among other things, the construction cost of the proposed works, including said authorized project and proposed reclamation units; the portions of said cost allocable to various functions; the operation and maintenance costs of all functions (of the project); the amount of the construction cost allocable to irrigation which the irrigators may reasonably be expected to repay, together with the proposed charges for water service and proposed repayment period upon the irrigation allocation; the amount of the cost allocable to irrigation in excess of that which the irrigators can repay, which the Secretary proposes shall be recovered from power revenues; the proposed charges for power, and proposed repayment period on the amount allocable to power; the proposed interest rate on the power investment, and the disposition which the Secretary proposes to make of the interest component and other components of the power revenues; the unrecovered cost to the Federal Treasury of the works proposed, in connection with the means of financing recommended by the Secretary; the ratio of net costs to net benefits; the ratio of net benefits per acre to irrigators' repayment per acre; and a complete financial analysis of repayment program together with all other data reasonably required to enable the Congress to pass upon the economic feasibility of the proposed works.

SEC. 3. Any such reclamation works proposed to be constructed under the study authorized by this act may be undertaken only after the Secretary of the Interior has submitted a report and findings thereon under section 2 of this act and section 9 of the Reclamation Project Act of 1939 (53 Stat. 1187), and only if the works so reported on are thereafter specifically authorized by act of Congress.

SEC. 4. Nothing in this act shall modify in any way the requirements and provisions of existing laws with respect to the availability of funds for construction and operation and maintenance of the Chief Joseph Dam and power plant.

The amendment was agreed to.

The bill was ordered to be engrossed for a third reading, read the third time, and passed.

The title was amended so as to read: "A bill to provide for authorization of a study and report of irrigation works in connection with Chief Joseph Dam."

## AMENDMENT OF THE NATURAL GAS ACT

Mr. DOUGLAS. Mr. President, I understand that Senate bill 1084, Calendar 1387, was previously ordered placed at the foot of the calendar.

The PRESIDING OFFICER. That is correct, and that bill will be called at this time. The bill will be stated by title.

The LEGISLATIVE CLERK. A bill (S. 1084) to amend section 2 of the Natural Gas Act.

The PRESIDING OFFICER. Is there objection to the present consideration of the bill?

Mr. DOUGLAS. Mr. President, reserving the right to object, let me say that since this bill has been placed on the agenda of bills which will be called up by the majority leader, and notice served by him, I feel that the bill is of sufficient importance not to be passed during the call of the Consent Calendar.

So I request that the bill be passed over at this time.

I shall not oppose having the bill called up in order, upon request of the majority leader.

The PRESIDING OFFICER. Objection being heard, the bill is passed over.

## PRESS CONFERENCE TO BE HELD BY DEFENSE PRODUCTION ADMINISTRATOR IN REGARD TO ALLOCATIONS OF STEEL, COPPER, AND ALUMINUM

Mr. MAYBANK. Mr. President, I ask unanimous consent to have printed in the RECORD a letter I have received from Mr. Henry H. Fowler, Defense Production Administrator. His letter is addressed to me, as chairman of the Banking and Currency Committee, and is in regard to a press conference which he will hold at 3 o'clock, in connection with the allocations of steel, copper, and aluminum.

There being no objection, the letter was ordered to be printed in the RECORD, as follows:

DEFENSE PRODUCTION ADMINISTRATION,
*Washington, July 2, 1952.*

The Honorable BURNET R. MAYBANK,
*Chairman, Joint Committee on Defense Production, Washington, D. C.*

DEAR CHAIRMAN MAYBANK: The Defense Production Administration is announcing tomorrow, Thursday, July 3, the fourth quarter 1952 allocations for copper and aluminum under the Controlled Materials Plan to permit industrial users to comply with lead-time requirements on material orders for copper and aluminum. Final levels of steel allocation for the fourth quarter cannot be established or announced by the DPA until after the work stoppage ends, and it is possible to measure the production loss and develop the best means of coping with the situation.

Already the steel strike has caused the loss as of June 30 of approximately 11,400,000 ingot tons of steel. Even if the strike ended tomorrow, the additional production losses involved in starting up operations are estimated to be approximately 2,000,000 tons. Even if the strike ended tomorrow, the nation will have lost a total of 13,400,000 ingot tons of steel, about one-half of a quarter's production, and the defense program, together with the civilian economy, must operate in the year 1952 on approximately 98,830,000 tons of steel which is over 6,000,000 tons less than were produced in the year 1951.

In other words, the work stoppage has canceled out for the year 1952 the benefits to the economy of the vast steel expansion program which, barring the stoppage, would have made available approximately 113,000,000 tons this year. The dire consequences of this fact cannot be washed away by a resumption of full-scale production this year. Despite all of the advantages of allocation and the devices the Controlled Materials Plan permits for distributing the impact in an equitable and orderly manner, CMP will

X re HR 7794

UNITED STATES OF AMERICA

# Congressional Record

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(Rept. No. 2458). Referred to the Committee of the Whole House.

Mr. MURDOCK: Committee on Interior and Insular Affairs. S. 1876. An act to provide for the transfer of certain lands in the State of Idaho to the Idaho Ranch for Youth, Inc.; without amendment (Rept. No. 2458). Referred to the Committee of the Whole House.

## PUBLIC BILLS AND RESOLUTIONS

Under clause 3 of rule XXII, public bills and resolutions were introduced and severally referred as follows:

By Mr. CLEMENTE:

H. R. 8494. A bill to provide for a new Federal building in South Ozone Park, Long Island, N. Y.; to the Committee on Public Works.

H. R. 8495. A bill to provide for a new Federal building in Ozone Park, Long Island, N. Y.; to the Committee on Public Worke.

By Mr. ROGERS of Texas:

H. R. 8496. A bill to amend part II of Veterans Regulation No. 1 (a); to the Committee on Veterans' Affairs.

H. R. 8497. A bill to provide benefits for members of the Reserve components of the Armed Forces who suffer disability or death while performing travel to and from specified types of active duty, and for other purposes; to the Committee on Armed Services.

By Mr. SHEPPARD:

H. R. 8498. A bill to provide that a woman taxpayer who must work to support her dependents may deduct moneys paid for the care of her dependents while she works; to the Committee on Ways and Means.

By Mr. STANLEY:

H. R. 8499. A bill to amend the act of June 23, 1949, as amended, with respect to the accumulated balances on telephone and telegraph accounts of Members of the House of Representatives; to the Committee on House Administration.

By Mr. BERRY:

H. R. 8500. A bill to credit the Oglala Sioux Tribe with the proceeds of Oglala Sioux tribal lands; to the Committee on Interior and Insular Affairs.

By Mr. DEMPSEY:

H. R. 8501. A bill to amend the Federal Aid Highway Act of 1952; to the Committee on Public Worke.

By Mr. FLOOD:

H. R. 8502. A bill to amend section 34 of the Trading With the Enemy Act, so as to prevent allowance or payment of certain debt claims based upon bonds of Germany, Japan, Bulgaria, Hungary, Rumania, or Italy, and for other purposes; to the Committee on Interstate and Foreign Commerce.

H. R. 8503. A bill to amend section 39 of the Trading with the Enemy Act, so as to permit the return of property to nationals of Germany or Japan, or their successors in interest; to the Committee on Interstate and Foreign Commerce.

H. R. 8504. A bill to amend section 32 of the Trading with the Enemy Act, so as to permit the return under such section of certain property owned by an alien individual; to the Committee on Interstate and Foreign Commerce.

H. R. 8505. A bill authorizing the construction and operation of a demonstration plant at Hazleton, Pa., to produce synthetic liquid fuel from anthracite; to the Committee on Interior and Insular Affairs.

By Mrs. BOSONE:

H. J. Res. 494. Joint resolution authorizing the erection of a sculptural piece known as The Pony Express in Washington, D. C.; to the Committee on House Administration.

By Mr. GRANGER:

H. J. Res. 495. Joint resolution authorizing the erection of a sculptural piece known as The Pony Express in Washington, D. C.; to the Committee on House Administration.

By Mr. FLOOD:

H. Con. Res. 238. Concurrent resolution reaffirming our historic friendship with the Slovak peoples, and expressing our hopes for the early liberation of the Slovak peoples from their present enslavement and for the early restoration of their basic human rights and freedoms; to the Committee on Foreign Affairs.

## MEMORIALS

Under clause 3 of rule XXII, memorials were presented and referred as follows:

By the SPEAKER: Memorial of the Legislature of the State of Massachusetts memorializing the President and the Congress of the United States, to make adequate appropriation for a complete and effective national civil defense organization; to the Committee on Appropriations.

By Mr. GOODWIN: Memorial of the Massachusetts Legislature urging Congress to make adequate appropriation for a complete and effective national civil defense organization; to the Committee on Appropriations.

By Mr. HESELTON: Memorial of the Commonwealth of Massachusetts urging the Congress of the United States to make adequate appropriation for a complete and effective national civil defense organization; to the Committee on Appropriations.

By Mrs. ROGERS of Massachusetts: Memorial of the Senate of Massachusetts urging the Congress of the United States to make adequate appropriation for a complete and effective national civil defense organization; to the Committee on Appropriations.

## PRIVATE BILLS AND RESOLUTIONS

Under clause 1 of rule XXII, private bills and resolutions were introduced and severally referred as follows:

By Mr. ANFUSO:

H. R. 8506. A bill for the relief of Felice Marotta; to the Committee on the Judiciary.

By Mr. BEALL:

H. R. 8507. A bill for the relief of Catherine V. Sindy; to the Committee on the Judiciary.

By Mr. BUCKLEY:

H. R. 8508. A bill for the relief of Mrs. Rachel Soloff Vertman; to the Committee on the Judiciary.

H. R. 8509. A bill for the relief of Arthur Weingarten; to the Committee on the Judiciary.

By Mr. BUDGE:

H. R. 8510. A bill for the relief of Miss Elizabeth Herrmann; to the Committee on the Judiciary.

By Mr. FORD:

H. R. 8511. A bill for the relief of John Jacob Wagner; to the Committee on the Judiciary.

By Mr. HAVENNER:

H. R. 8512. A bill for the relief of Joseph Arena; to the Committee on the Judiciary.

By Mr. JACKSON of California:

H. R. 8513. A bill for the relief of Mrs. Ellen Krogsoe Carver; to the Committee on the Judiciary.

By Mr. JUDD:

H. R. 8514. A bill for the relief of Arthur Neustadt and Mrs. Emma Neustadt; to the Committee on the Judiciary.

By Mr. KEOGH:

H. R. 8515. A bill for the relief of Francesco Mule; to the Committee on the Judiciary.

By Mr. MACHROWICZ:

H. R. 8516. A bill for the relief of Carlo Giovanni Recchia; to the Committee on the Judiciary.

H. R. 8517. A bill for the relief of Saliba Douaihy; to the Committee on the Judiciary.

By Mr. MARTIN of Massachusetts:

H. R. 8518. A bill for the relief of Jose Gomes Pereira; to the Committee on the Judiciary.

By Mr. MULTER:

H. R. 8519. A bill for the relief of Juanita Kloeden; to the Committee on the Judiciary.

By Mr. ROOSEVELT:

H. R. 8520. A bill for the relief of Ehstathios A. Spathis; to the Committee on the Judiciary.

By Mr. SMITH of Mississippi:

H. R. 8521. A bill for the relief of Kim Ki Hang; to the Committee on the Judiciary.

By Mr. TOLLEFSON:

H. R. 8522. A bill for the relief of Marlene D. Knight; to the Committee on the Judiciary.

## PETITIONS, ETC.

Under clause 1 of rule XXII, petitions and papers were laid on the Clerk's desk and referred as follows:

787. By Mr. BRYSON: Petition of 969 citizens of Port Arthur, Tex., in support of the Bryson bill (H. R. 2188), a bill to prohibit the transportation of alcoholic beverage advertising in interstate commerce and ban its broadcasting over the air; to the Committee on Interstate and Foreign Commerce.

788. By Mr. PHILLIPS: Petition of Mrs. Joseph J. Pausner, president of the California Chapter of Pro-America, containing 17,108 signatures, from all congressional districts of California, petitioning for tax reduction, the elimination of unnecessary spending, and a limitation on the Federal debt; to the Committee on Ways and Means.

# SENATE

## FRIDAY, JULY 4, 1952

*(Legislative day of Friday, June 27, 1952)*

The Senate met at 12 o'clock meridian, on the expiration of the recess.

Rev. Dr. Edward L. R. Elson, minister, the National Presbyterian Church, Washington, D. C., offered the following prayer:

Eternal God, the strength of our years and the light of all our days, we turn again from the clash and clamor of our times, from the confusion of voices and the pressure of daily duties to hear again the "still, small voice." We lay before Thee our little lives—our weary bodies, our tired minds, our taut spirits—beseeching the refreshment which alone comes from Thee, the fountain of life and health.

We thank Thee for this new day of duty and service. Grant to Thy servants here clean hands, pure hearts, wisdom in every decision, and fidelity in every dedication. Make known Thy ways to them and grant this body courage to follow therein.

On this day of sacred memory we thank Thee for this good land which Thou hast given us for an heritage and for the freedom vouchsafed to us as sons of Thy creation. We remember before Thee those whom Thou hast raised up for our Nation, to defend our liberty, preserve our union, maintain law and order within our borders, and

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the granting of free or reduced-rate transportation to ministers of religion.

The PRESIDING OFFICER. The question is on agreeing to the motion of the Senator from Arizona.

The motion was agreed to; and the Senate proceeded to consider the bill.

Mr. HUMPHREY. Mr. President, may I inquire as to the nature of the bill?

Mr. McFARLAND. The bill would permit—and I will say that its provisions are not mandatory—granting by airlines of reduced rates to ministers. The same privilege is granted to ministers by the railroads. The bill was unanimously reported by the Committee on Interstate and Foreign Commerce.

Mr. HUMPHREY. I thank the majority leader for bringing up the bill. I think it is a very fine bill.

Mr. FERGUSON. Mr. President, am I to understand that the bill would do no more than to allow airlines, if they desired, to grant a reduced rate to ministers of religion?

Mr. McFARLAND. That is correct.

Mr. FERGUSON. What rate could airlines give? Could they carry ministers of religion free?

Mr. CAPEHART. Mr. President, if I may explain the bill, it would give airlines the same right which railroads have had for a hundred years. It would permit airlines to sell tickets to ministers of religion at half fare.

Mr. FERGUSON. That is what I want to know. It provides that ministers of religion could be carried for half fare?

Mr. CAPEHART. That is correct.

Mr. FERGUSON. There are no compulsory features about it?

Mr. CAPEHART. No. If the airlines wanted to do it today they could not do it. Legislation is required to give them the right to sell half-fare tickets to ministers of religion.

Mr. FERGUSON. If one airline, flying to New York City, for example, allowed the half-fare privilege, would all the other airlines be forced to allow the same privilege?

Mr. CAPEHART. No.

Mr. FERGUSON. It would not be considered unfair competition?

Mr. CAPEHART. No.

Mr. FERGUSON. It is purely a permissive provision?

Mr. CAPEHART. That is correct. It grants no other right than the one which railroads have been enjoying for a hundred years.

The PRESIDING OFFICER. The question is on the engrossment and third reading of the bill.

The bill was ordered to be engrossed for a third reading, read the third time, and passed.

## REVISION AND CODIFICATION OF LAWS RELATING TO PATENTS

Mr. McFARLAND. Mr. President, I move that the Senate proceed to the consideration of Calendar No. 1908, H. R. 7794.

The PRESIDING OFFICER. The clerk will state the bill by title.

The LEGISLATIVE CLERK. A bill (H. R. 7794) to revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents."

The PRESIDING OFFICER. The question is on agreeing to the motion of the Senator from Arizona.

The motion was agreed to; and the Senate proceeded to consider the bill, which had been reported from the Committee on the Judiciary with amendments on page 9, line 9, to strike out the word "or" and insert the word "on"; on page 29, in subsection 282 (1), to strike out the word "or" between the words "infringement" and "absence"; to strike out the comma at the end of the line after the word "infringement" and add the words "or unenforceability"; and on the same page, in the first line of section 284, to strike out the words "Upon adjudging a patent valid and infringed," and insert in lieu thereof the words "Upon finding for the claimant".

The PRESIDING OFFICER. The question is on agreeing to the amendments.

The amendments were agreed to.

Mr. SALTONSTALL. Mr. President, will the Senator from Nevada tell us the purpose of the bill?

Mr. McCARRAN. The bill would codify the patent laws of the United States. It is under the able guidance of the Senator from Wisconsin [Mr. WILEY].

Mr. SALTONSTALL. I am not a patent lawyer, but I know patents are a very technical subject. Does the bill change the law in any way or only codify the present patent laws.

Mr. McCARRAN. It codifies the present patent laws. It passed the House, and it was approved by the Judiciary Committee of the Senate.

Mr. HENDRICKSON. Mr. President, as I recall, it was approved by the Judiciary Committee unanimously.

Mr. McCARRAN. I think the Senator from New Jersey is correct.

Mr. President, I ask unanimous consent that a statement prepared by me may be inserted in the RECORD at this point.

There being no objection, the statement was ordered to be printed in the RECORD, as follows:

STATEMENT BY SENATOR MCCARRAN

This legislation is another step in codification of the United States Code and will enact into law title 35 of the United States Code entitled "Patents." This legislation has been in the process of study and consideration for a number of years. It has passed the House and has reached the Senate after lengthy hearings on the House side. The bill has the general approval of all parties concerned and represents a step forward in the codification of our laws, for it brings together in one package all of the laws relating to patents that were contained in the revised statutes of 1874 down to the present time. The bill is divided into three categories, the first being entitled the "Patent Office" and deals with its functions; part 2 is titled the "Patentability of Inventions and Grant of Powers," and part 3 is titled "Patents and Protection of Patent Rights." Into these three categories the existing laws relating to patents have been codified. In view of decisions of the Supreme Court and others as well as trial by practice and error there have been some changes in the law of patents as it now exists and some new terminology used. All these matters, as stated before, have been carefully gone over in hearings and the bill as it is now presented to the Senate represents, in the opinion of the committee, legislation of merit. The committee therefore recommends that this legislation be speedily passed.

The Senate amendments are primarily technical. The addition of the words "or unenforceability"—this is the subject matter of the committee amendment No. 3—will place in the code this word which has been used in numerous court decisions under the section in question.

The change in language proposed in committee amendment No. 4 is for the purpose of avoiding a possible construction that judgment must be entered by a court even in a case where a patent is found unenforceable. This will preserve the present rule of law in this regard.

The question as to whether part I of H. R. 7794 should have been properly codified in title 35 rather than title 5 dealing with executive agencies was discussed in the House Codification Committee and brought up in the study of the bill in the subcommittee of the Judiciary Committee of the Senate.

Inasmuch as title 5 has not been codified and the Patent Office is the proper agency for handling both patents and trade-marks, it is considered that part I is properly in H. R. 7794 at this time.

If it is desired to transfer the Patent Office to title 5 which deals with executive agencies, that matter could be properly taken care of when title 5 is offered for codification. It would seem that to leave the setting up of the Patent Office out of title 35 at this time would be to leave a portion of the patent law uncodified.

The PRESIDING OFFICER. The question is on the engrossment of the amendments and the third reading of the bill.

The amendments were ordered to be engrossed and the bill to be read the third time.

The bill was read the third time and passed.

## FRED P. HINES—VETO MESSAGE

Mr. LANGER. Mr. President, I move that the Senate proceed to reconsider the bill (S. 827) for the relief of Fred P. Hines, the objections of the President of the United States to the contrary notwithstanding.

The PRESIDING OFFICER (Mr. HILL in the chair) laid before the Senate the bill (S. 827) for the relief of Fred P. Hines, and the message from the President vetoing the bill.

(For the veto message see the CONGRESSIONAL RECORD of August 30, 1951.)

The PRESIDING OFFICER. The question is on agreeing to the motion of the Senator from North Dakota.

The motion was agreed to; and the Senate proceeded to reconsider the bill (S. 827) for the relief of Fred P. Hines.

The PRESIDING OFFICER. The question is, Shall the bill pass, the objections of the President of the United States to the contrary notwithstanding?

Mr. HENDRICKSON. Mr. President, may we have an explanation of the bill?

Mr. McFARLAND. Mr. President, I hope the Senator from North Dakota will withdraw his motion. A great many conference committees are meeting at this time. A record vote will be required on the question before the Senate, and in view of the fact that many Senators

X re HR 7794

UNITED STATES OF AMERICA

# Congressional Record

PROCEEDINGS AND DEBATES OF THE 82d CONGRESS
SECOND SESSION

## VOLUME 98—PART 7

JUNE 28, 1952, TO JULY 7, 1952
(PAGES 8395 TO 9806)

LEGISLATIVE INTENT SERVICE (800) 666-1917

UNITED STATES GOVERNMENT PRINTING OFFICE, WASHINGTON, 1952

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or deduction from annual leave, in funerals for deceased members of the Armed Forces returned to the United States from abroad for burial, with Senate amendments thereto, and concur in the Senate amendments.

The Clerk read the title of the bill.

The Clerk read the Senate amendments, as follows:

Page 2, after line 11, insert:

"SEC. 2. The Solicitor of the Department of Commerce shall hereafter be designated as the General Counsel of the Department of Commerce, and all laws and orders relating or referring to the Solicitor of the Department of Commerce shall be deemed to relate or refer to the General Counsel of the Department of Commerce."

Amend the title so as to read: "An act to authorize the participation by certain Federal employees, without loss of pay or deduction from annual leave, in funerals for deceased members of the Armed Forces returned to the United States from abroad for burial and relating to the General Counsel of the Department of Commerce."

The SPEAKER. Is there objection to the request of the gentleman from Tennessee?

There was no objection.

The Senate amendments were concurred in.

A motion to reconsider was laid on the table.

## EXTRA COMPENSATION FOR CERTAIN POSTAL EMPLOYEES

Mr. MURRAY. Mr. Speaker, I ask unanimous consent to take from the Speaker's table the bill (H. R. 7204) to amend section 5 of the act entitled "An act to credit certain service performed by employees of the postal service who are transferred from one position to another within the service for purposes of determining eligibility for promotion" approved June 19, 1948, with Senate amendments thereto, and concur in the Senate amendments.

The Clerk read the title of the bill.

The Clerk read the Senate amendments as follows:

Page 2, line 3, after "services" insert "due to any emergency."

Page 2, line 3, after "capacity" insert ", not in excess of 30 days."

The SPEAKER. Is there objection to the request of the gentleman from Tennessee?

There was no objection.

The Senate amendments were concurred in.

A motion to reconsider was laid on the table.

## CONTINUATION OF SUSPENSION OF DUTIES AND IMPORT TAXES ON METAL SCRAP

Mr. EBERHARTER. Mr. Speaker, I ask unanimous consent to take from the Speaker's table the bill, H. R. 6845, to continue until the close of June 30, 1953, the suspension of duties and import taxes on metal scrap, and for other purposes, with a Senate amendment thereto, and concur in the Senate amendment.

The Clerk read the title of the bill.

The Clerk read the Senate amendment, as follows:

Line 6, after "1953", insert ": *Provided*, That this act shall not apply to lead scrap."

The SPEAKER. Is there objection to the request of the gentleman from Pennsylvania?

There was no objection.

The Senate amendment was concurred in.

A motion to reconsider was laid on the table.

## REVISE AND CODIFY LAWS RELATING TO PATENTS

Mr. BRYSON. Mr. Speaker, I ask unanimous consent to take from the Speaker's desk the bill (H. R. 7794) to revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents," with a Senate amendment thereto, and concur in the Senate amendment.

The Clerk read the title of the bill.

The Clerk read the Senate amendments, as follows:

Page 9, line 3 of paragraph (d), strike out "or" and insert "on."

Page 29, in paragraph (1), strike out "Noninfringement or" and insert "Noninfringement."

Page 29, in paragraph (1), strike out "infringement," and insert "infringement or unenforceability."

Page 29, at beginning of last paragraph, strike out "Upon adjudging a patent valid and infringed," and insert "Upon finding for the claimant."

The SPEAKER. Is there objection to the request of the gentleman from South Carolina?

There was no objection.

The Senate amendment was concurred in.

A motion to reconsider was laid on the table.

## MESSAGE FROM THE SENATE

A further message from the Senate, by Mr. Landers, its enrolling clerk, announced that the Senate had passed without amendment bills and a concurrent resolution of the House of the following titles:

H. R. 948. An act to provide for terms of court to be held at West Palm Beach, and at Fort Myers, in the southern district of Florida;

H. R. 3209. An act amending section 25 of the Tennessee Valley Authority Act of 1933, as amended;

H. R. 5567. An act to provide for the conveyance to Potter County, Tex., of certain surplus lands located at the Veterans' Administration hospital near Amarillo;

H. R. 6856. An act to extend the duration of the Water Pollution Control Act;

H. R. 7241. An act to authorize payment to the Empire District Electric Co. for reasonable costs of protecting its Ozark Beach power plant from the backwater of Bull Shoals Dam;

H. R. 7855. An act for improvement of Gowanus Creek Channel, N. Y.;

H. R. 8127. An act to amend the act of June 21, 1940, relating to the alteration of certain bridges over navigable waters, so as to include highway bridges, and for other purposes;

H. R. 8170. An act relating to burley tobacco farm acreage allotments under the Agricultural Adjustment Act of 1938, as amended;

H. R. 8190. An act to amend the act of February 7, 1905, as amended, authorizing the Kensington & Eastern Railroad Co. to construct a bridge across the Calumet River;

H. R. 8194. An act to amend an act approved May 26, 1928, relating to a bridge across the Mississippi River at Bettendorf, Iowa;

H. R. 8234. An act to amend section 5 of the act of June 29, 1888, relating to the office of Supervisor of New York Harbor; and

H. Con. Res. 231. Concurrent resolution to favor the economic development and improvement of the south Asian subcontinent.

The message also announced that the Senate agrees to the report of the committee of conference on the disagreeing votes of the two Houses on the amendments of the Senate to the bill (H. R. 7656) entitled "An act to provide vocational readjustment and to restore lost educational opportunities to certain persons who served in the Armed Forces on or after June 27, 1950, and prior to such date as shall be fixed by the President or the Congress, and for other purposes."

The message also announced that the Senate had passed a bill of the following title, in which the concurrence of the House is requested:

H. R. 7794. An act to revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents."

The message also announced that the Senate agrees to the amendments of the House to concurrent resolution of the Senate of the following title:

S. Con. Res. 76. Concurrent resolution favoring the suspension of deportation of certain aliens.

## AMERICAN FOREIGN POLICY IN KOREA

Mr. BRAY. Mr. Speaker, I ask unanimous consent to address the House for 1 minute.

The SPEAKER. Is there objection to the request of the gentleman from Indiana?

There was no objection.

Mr. BRAY. Mr. Speaker, today America is tremendously concerned and involved in Korea. Thousands of our boys are living in the towns, and in the fox holes of that Asiatic peninsula. How we became involved, why we are there, or what is involved is not the immediate question. The die has been cast and no regrets or tears can alter the situation in which we find ourselves today.

However, what we do and how we conduct ourselves on that foreign land does make all the difference in practice, and in principle, for free God-fearing men.

A few weeks ago the newspapers told us that the Korean Government and its President Rhee had refused to permit our Voice of America programs to be broadcast over their radios. Our State Department, which plans and operates these Voice of America programs, became indignant over the fact.

Now the facts show that these programs were planned and composed to criticize and discredit the present Korean Government and its administration

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The SPEAKER. The Clerk will report the amendment in disagreement.

The Clerk read as follows:

Page 25, line 7, strike out:

"Plant and equipment: For an additional amount for 'Plant and equipment,' including the purchase (not to exceed an additional 100) and hire of passenger motor vehicles, $1,450,000,000: *Provided,* That in connection with the expansion of facilities provided in this appropriation, the Commission is authorized without regard to section 3679 of the Revised Statutes to enter into new contracts or modify existing contracts to provide for electric utility services for periods not exceeding 25 years, and such contracts shall be subject to termination by the Commission upon payment of cancellation costs of not to exceed $57,000,000, and any appropriation presently or hereafter made available to the Commission shall be available for the payment of such cancellation costs: *Provided further,* That no part of the foregoing appropriation shall be available for the construction of any building, utility, or other specific portion of a project, unless funds are available for the completion of such building, utility, or other specific portion of such project."

And insert the following:

"Plant and equipment: For an additional amount for 'plant and equipment,' $1,450,000,000, of which $1,355,398,000 is for (1) expenditures during the fiscal year ending June 30, 1953, or thereafter under contracts and against other obligations in an aggregate amount of $3,518,800,000 for the foregoing purposes which the Atomic Energy Commission is authorized to enter into pursuant to the authority of this act as necessary or appropriate to carry out the program as recommended by the National Security Council, approved by the President of the United States, and submitted to the Congress by the Atomic Energy Commission and (ii) settlement and payment of termination claims under such contracts if additional appropriations to permit continuation of performance under such contracts are not hereafter made: *Provided,* That the Commission is authorized without regard to section 3679 of the Revised Statutes to enter into new contracts or modify existing contracts to provide for electric utility services for periods not exceeding 25 years and such contracts shall be subject to termination by the Commission upon payment of cancellation costs as provided in the contracts, and any appropriation presently or hereafter made available to the Commission shall be available for the payment of such cancellation costs: *Provided further,* That appropriations for the fiscal year ending June 30, 1953, may be used, any other law to the contrary notwithstanding, to start new construction projects directly and primarily related to thermonuclear matters."

Mr. THOMAS. Mr. Speaker, I move that the House recede and concur in the Senate amendment with an amendment.

The Clerk read as follows:

Mr. THOMAS moves that the House recede from its disagreement to the amendment of the Senate numbered 41, and concur therein with an amendment, as follows: In lieu of the matter stricken out and inserted by said amendment insert the following: "Plant and equipment: For an additional amount for 'Plant and equipment,' including the purchase (not to exceed an additional 100) and hire of passenger motor vehicles, $2,000,000,000: *Provided,* That in connection with the expansion of facilities provided in this appropriation, the Commission is authorized without regard to section 3879 of the Revised Statutes to enter into new contracts or modify existing contracts to provide for electric utility services for periods not exceeding 25 years, and such contracts shall be subject to termination by the Commission upon payment of cancellation costs of not to exceed $57,000,000, and any appropriation presently or hereafter made available to the Commission shall be available for the payment of such cancellation costs: *Provided further,* That no part of the foregoing appropriation shall be available for the construction of any office building, residence, warehouse or similar structure, utility, or other specific portion or unit of a project, unless funds are available for the completion of such building, utility, or other specific portion or unit of such project. The foregoing proviso shall not be construed to prevent the purchase of land for any project, the construction of any new building or procurement of any machinery, equipment, or materials therefor, nor any utility nor any portion or unit of a specific project if the funds are available to pay the cost of such land, the cost of such building, machinery, equipment, or materials, or the cost of such utility or the cost of any such specific portion or unit of such project."

Mr. THOMAS. Mr. Speaker, briefly, what this does is to add about $550,000,000 and explain the language in great detail. It is crystal clear.

Mr. Speaker, I move the previous question on the motion.

The previous question was ordered.

The motion was agreed to.

A motion to reconsider the votes by which action was taken on the several motions was laid on the table.

## CIVIL FUNCTIONS APPROPRIATION BILL, 1953

Mr. CANNON. Mr. Speaker, I ask unanimous consent to take from the Speaker's desk the bill (H. R. 7268) making appropriations for civil functions administered by the Department of the Army for the fiscal year ending June 30, 1953, and for other purposes, with Senate amendments thereto, disagree to the Senate amendments, and agree to the conference asked by the Senate.

The SPEAKER. Is there objection to the request of the gentleman from Missouri? [After a pause.] The Chair hears none and appoints the following conferees: Messrs. CANNON, RABAUT, MCGRATH, GARY, TABER, DAVIS of Wisconsin, and FORD.

## RECESS

The SPEAKER. The House will stand in recess subject to call.

Accordingly (at 3 o'clock and 12 minutes a. m.) the House stood in recess subject to the call of the Chair.

## AFTER RECESS

The recess having expired, the House was called to order by the Speaker at 5 o'clock and 35 minutes a. m.

## FURTHER MESSAGE FROM THE SENATE

A message from the Senate by Mr. LANDERS, its clerk, announced that the Senate agrees to the report of the committee of conference on the disagreeing votes of the two Houses on the amendments of the Senate to the bill (H. R. 8370) entitled "An act making supplemental appropriations for the fiscal year ending June 30, 1953, and for other purposes"; be it further

*Resolved,* That the Senate disagree to the amendment of the House of Representatives to Senate amendment numbered 41 and request a further conference in the House on the disagreeing votes of the two Houses thereon.

*Ordered,* That Mr. MCKELLAR, Mr. HAYDEN, Mr. MCCARRAN, Mr. O'MAHONEY, Mr. MAYBANK, Mr. BRIDGES, Mr. FERGUSON, Mr. CORDON, and Mr. SALTONSTALL be the conferees on the part of the Senate.

## SUPPLEMENTAL APPROPRIATION BILL, 1953

Mr. THOMAS. Mr. Speaker, I ask unanimous consent to take from the Speaker's desk the bill (H. R. 8370) making supplemental appropriations for the fiscal year ending June 30, 1953, and for other purposes, with Senate amendment thereto, disagree to the Senate amendment, and agree to the conference asked by the Senate.

The SPEAKER. Is there objection to the request of the gentleman from Texas? [After a pause.] The Chair hears none, and appoints the following conferees: Messrs. CANNON, MAHON, THOMAS, WHITTEN, GARY, TABER, WIGGLESWORTH, and DAVIS of Wisconsin.

## SESSIONS OF THE HOUSE NEXT WEEK

Mr. MCCORMACK. Mr. Speaker, I ask unanimous consent that when the House adjourns on Monday next it adjourn to meet on the following Thursday and that when the House adjourns on Thursday next it adjourn to meet on the following Monday.

The SPEAKER. Is there objection to the request of the gentleman from Massachusetts?

There was no objection.

## ENROLLED BILLS SIGNED

Mr. STANLEY, from the Committee on House Administration, reported that that committee had examined and found truly enrolled bills of the House of the following titles, which were thereupon signed by the Speaker:

H. R. 7289. An act making appropriations for the Departments of State, Justice, Commerce, and the Judiciary, for the fiscal year ending June 30, 1953, and for other purposes;

H. R. 7656. An act to provide vocational readjustment and to restore lost educational opportunities to certain persons who served in the Armed Forces on or after June 27, 1950, and prior to such date as shall be fixed by the President or the Congress, and for other purposes;

H. R. 7794. An act to revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents"; and

H. R. 1180. An act to facilitate the performance of research and development work by and on behalf of the Departments of the Army, the Navy, and the Air Force, and for other purposes.

LEGISLATIVE REFERENCE SERVICE

X re HR 7794

UNITED STATES OF AMERICA

# Congressional Record

PROCEEDINGS AND DEBATES OF THE 82d CONGRESS
SECOND SESSION

## VOLUME 98—PART 7

JUNE 28, 1952, TO JULY 7, 1952
(PAGES 8395 TO 9806)

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UNITED STATES GOVERNMENT PRINTING OFFICE, WASHINGTON, 1952

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or deduction from annual leave, in funerals for deceased members of the Armed Forces returned to the United States from abroad for burial, with Senate amendments thereto, and concur in the Senate amendments.

The Clerk read the title of the bill.

The Clerk read the Senate amendments, as follows:

Page 2, after line 11, insert:

"SEC. 2. The Solicitor of the Department of Commerce shall hereafter be designated as the General Counsel of the Department of Commerce, and all laws and orders relating or referring to the Solicitor of the Department of Commerce shall be deemed to relate or refer to the General Counsel of the Department of Commerce."

Amend the title so as to read: "An act to authorize the participation by certain Federal employees, without loss of pay or deduction from annual leave, in funerals for deceased members of the Armed Forces returned to the United States from abroad for burial and relating to the General Counsel of the Department of Commerce."

The SPEAKER. Is there objection to the request of the gentleman from Tennessee?

There was no objection.

The Senate amendments were concurred in.

A motion to reconsider was laid on the table.

## EXTRA COMPENSATION FOR CERTAIN POSTAL EMPLOYEES

Mr. MURRAY. Mr. Speaker, I ask unanimous consent to take from the Speaker's table the bill (H. R. 7204) to amend section 5 of the act entitled "An act to credit certain service performed by employees of the postal service who are transferred from one position to another within the service for purposes of determining eligibility for promotion" approved June 19, 1948, with Senate amendments thereto, and concur in the Senate amendments.

The Clerk read the title of the bill.

The Clerk read the Senate amendments as follows:

Page 2, line 3, after "services" insert "due to any emergency."

Page 2, line 3, after "capacity" insert ", not in excess of 30 days."

The SPEAKER. Is there objection to the request of the gentleman from Tennessee?

There was no objection.

The Senate amendments were concurred in.

A motion to reconsider was laid on the table.

## CONTINUATION OF SUSPENSION OF DUTIES AND IMPORT TAXES ON METAL SCRAP

Mr. EBERHARTER. Mr. Speaker, I ask unanimous consent to take from the Speaker's table the bill, H. R. 6845, to continue until the close of June 30, 1953, the suspension of duties and import taxes on metal scrap, and for other purposes, with a Senate amendment thereto, and concur in the Senate amendment.

The Clerk read the title of the bill.

The Clerk read the Senate amendment, as follows:

Line 6, after "1953", insert ": *Provided*, That this act shall not apply to lead scrap."

The SPEAKER. Is there objection to the request of the gentleman from Pennsylvania?

There was no objection.

The Senate amendment was concurred in.

A motion to reconsider was laid on the table.

## REVISE AND CODIFY LAWS RELATING TO PATENTS

Mr. BRYSON. Mr. Speaker, I ask unanimous consent to take from the Speaker's desk the bill (H. R. 7794) to revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents," with a Senate amendment thereto, and concur in the Senate amendment.

The Clerk read the title of the bill.

The Clerk read the Senate amendments, as follows:

Page 9, line 3 of paragraph (d), strike out "or" and insert "on."

Page 29, in paragraph (1), strike out "Noninfringement or" and insert "Noninfringement."

Page 29, in paragraph (1), strike out "infringement," and insert "infringement or unenforceability."

Page 29, at beginning of last paragraph, strike out "Upon adjudging a patent valid and infringed," and insert "Upon finding for the claimant."

The SPEAKER. Is there objection to the request of the gentleman from South Carolina?

There was no objection.

The Senate amendment was concurred in.

A motion to reconsider was laid on the table.

## MESSAGE FROM THE SENATE

A further message from the Senate, by Mr. Landers, its enrolling clerk, announced that the Senate had passed without amendment bills and a concurrent resolution of the House of the following titles:

H. R. 948. An act to provide for terms of court to be held at West Palm Beach, and at Fort Myers, in the southern district of Florida;

H. R. 3209. An act amending section 26 of the Tennessee Valley Authority Act of 1933, as amended;

H. R. 5567. An act to provide for the conveyance to Potter County, Tex., of certain surplus lands located at the Veterans' Administration hospital near Amarillo;

H. R. 6856. An act to extend the duration of the Water Pollution Control Act;

H. R. 7241. An act to authorize payment to the Empire District Electric Co. for reasonable costs of protecting its Ozark Beach power plant from the backwater of Bull Shoals Dam;

H. R. 7855. An act for improvement of Gowanus Creek Channel, N. Y.;

H. R. 8127. An act to amend the act of June 21, 1940, relating to the alteration of certain bridges over navigable waters, so as to include highway bridges, and for other purposes;

H. R. 8170. An act relating to burley tobacco farm acreage allotments under the Agricultural Adjustment Act of 1938, as amended;

H. R. 8190. An act to amend the act of February 7, 1905, as amended, authorizing the Kensington & Eastern Railroad Co. to construct a bridge across the Calumet River;

H. R. 8194. An act to amend an act approved May 26, 1928, relating to a bridge across the Mississippi River at Bettendorf, Iowa;

H. R. 8234. An act to amend section 5 of the act of June 29, 1888, relating to the office of Supervisor of New York Harbor; and

H. Con. Res. 231. Concurrent resolution to favor the economic development and improvement of the south Asian subcontinent.

The message also announced that the Senate agrees to the report of the committee of conference on the disagreeing votes of the two Houses on the amendments of the Senate to the bill (H. R. 7656) entitled "An act to provide vocational readjustment and to restore lost educational opportunities to certain persons who served in the Armed Forces on or after June 27, 1950, and prior to such date as shall be fixed by the President or the Congress, and for other purposes."

The message also announced that the Senate had passed a bill of the following title, in which the concurrence of the House is requested:

H. R. 7794. An act to revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents."

The message also announced that the Senate agrees to the amendments of the House to concurrent resolution of the Senate of the following title:

S. Con. Res. 76. Concurrent resolution favoring the suspension of deportation of certain aliens.

## AMERICAN FOREIGN POLICY IN KOREA

Mr. BRAY. Mr. Speaker, I ask unanimous consent to address the House for 1 minute.

The SPEAKER. Is there objection to the request of the gentleman from Indiana?

There was no objection.

Mr. BRAY. Mr. Speaker, today America is tremendously concerned and involved in Korea. Thousands of our boys are living in the towns, and in the fox holes of that Asiatic peninsula. How we became involved, why we are there, or what is involved is not the immediate question. The die has been cast and no regrets or tears can alter the situation in which we find ourselves today.

However, what we do and how we conduct ourselves on that foreign land does make all the difference in practice, and in principle, for free God-fearing men.

A few weeks ago the newspapers told us that the Korean Government and its President Rhee had refused to permit our Voice of America programs to be broadcast over their radios. Our State Department, which plans and operates these Voice of America programs, became indignant over the fact.

Now the facts show that these programs were planned and composed to criticize and discredit the present Korean Government and its administration

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Mr. STENNIS. I had not made any agreement. I understood that the Senator from New Hampshire had been notified and had approved this particular appointment. It is not a promotion in rank.

Mr. BRIDGES. I have nothing against the nominee. I have great admiration for the Senator from Mississippi, but the request is not in accordance with our agreement.

Mr. McFARLAND. Mr. President, will the Senator from New Hampshire yield?

Mr. BRIDGES. Certainly.

Mr. McFARLAND. Mr. President, I thought the nominations had been cleared, or I would not have suggested that they be brought up. I thought they had been cleared with the other side. I am trying to do the best I can to see that everything has been cleared. If I had known that the nominations had not been cleared, I would have objected, myself.

Mr. BRIDGES. Mr. President, I do not want to stymie the works here. As a matter of fact, I have no objection to this man, and I know the Senator from Mississippi is very sincere in whatever he does.

Mr. JOHNSON of Texas. Mr. President, will the Senator from New Hampshire yield?

Mr. BRIDGES. I yield.

Mr. JOHNSON of Texas. With reference to the five colonels whose nominations were just confirmed, we talked to Senators on the other side of the aisle, and understood that there was no objection.

The Senator from Mississippi [Mr. STENNIS] conferred with other members of the committee, and a staff member told us that he had talked to other members of the committee.

Mr. STENNIS. The Senator is correct. I consulted with the Senator from Massachusetts [Mr. SALTONSTALL] the Senator from Washington [Mr. CAIN], and the Senator from Kansas [Mr. SCHOEPPEL]. I specifically inquired about the Senator from New Hampshire, and was told by a staff member that the matter had been cleared with him.

Mr. BRIDGES. Mr. President, in view of the explanations by the Senator from Mississippi, whom I respect, and the Senator from Texas, whom I respect, well knowing that they would not attempt to do anything like this unless they had an agreement or understood they had one, I withdraw my objection.

The VICE PRESIDENT. Without objection, the nomination of Rear Adm. Joseph W. Fowler, United States Navy—retired—is confirmed; and, without objection, the President will be notified of the confirmation made this day.

## MESSAGE FROM THE HOUSE—ENROLLED BILLS SIGNED

A message from the House of Representatives, by Mr. Maurer, one of its reading clerks, announced that the Speaker had affixed his signature to the following enrolled bills, and they were signed by the Vice President:

H. R. 1180. An act to facilitate the performance of research and development work by and on behalf of the Departments of the Army, the Navy, and the Air Force, and for other purposes;

H. R. 7289. An act making appropriations for the Departments of State, Justice, Commerce, and the Judiciary, for the fiscal year ending June 30, 1953, and for other purposes;

H. R. 7656. An act to provide vocational readjustment and to restore lost educational opportunities to certain persons who served in the Armed Forces on or after June 27, 1950, and prior to such date as shall be fixed by the President or the Congress, and for other purposes; and

H. R. 7794. An act to revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents."

## COMMENTS ON THE SENATE OF THE UNITED STATES

Mr. BENTON. Mr. President, yesterday evening I laughed, as many of my colleagues must have laughed, at Jim Berryman's cartoon on the front page of the Evening Star. Berryman showed Chairman Gabrielson before a microphone with his gavel raised, with a flag giving the backdrop of the Republican National Committee, and with this caption "Before we adjourn, are there any further suggestions as to how we can lose the election?"

I speak of this cartoon because I do not wish to suggest that my own anticipation of my own victory next November is necessarily due to any particular confidence I may have in my own ability. Many before me have commented on the fact that the Republican Party seems to have a genius for snatching defeat out of the jaws of victory. And no one in this body can ever know for sure whether he has won his elections due to his own skill and ability, or due to the fumblings and blunders of his opponents.

Perhaps this knowledge, or lack of sure knowledge, which we in the Senate acquire from the realities of politics, is what makes this body humble. Humility is the first of the Christian virtues and, as I leave tonight for Connecticut on this the last day of our session, I attest to the fact that I do not know a Member of this body to whom the adjective "humble" or the noun "humility" might not be applied. I do not suggest that the adjective or noun could be applied in all circumstances and at all times to all Members. I merely attest to the fact that this group, more than any other group with which I have ever been associated, can boast this particular Christian virtue. Perhaps this is because all of us lead highly competitive lives, and through the pressures and tensions of competition—the virtue of humility is born and nurtured.

Some months after I resigned as Assistant Secretary of State in 1947, I spoke to the Sales Executives Society of New York. This is a group that knows me well because a large part of my life, and all of my young manhood has been devoted to the development of the techniques of selling, promoting, and advertising. In 1947, based on 2 years of intimate work with many committees of the Congress, I told this audience that the United States Congress was the most remarkable group of men I had ever met. I told them there could not be another such group anywhere. I told them that I did not know another process of natural selection which uncovered and developed such extraordinary men.

Thirty of our own body, the last time I checked, had been governors of their States. And as many more had served in the House of Representatives.

Only a few first termers can be called accidents, due to unknown or unpredictable factors in their States which accounted for their election or appointment. The real test is, of course, the second try, when a man must answer for his record.

As we prepare to adjourn today, I want the Senate to know that it would never have occurred to me to introduce my resolution calling for the expulsion of one of our Members if I had not read the report of the Subcommittee on Privileges and Elections dealing with the Maryland election campaign. The report referred to the back-alley aspects of the campaign. This report, unanimously signed by five Senators, including two most distinguished Republican Senators, recommended that legislation be passed under which the Senate could in the future expel any Senator who engaged in such practices. The reasons why such legislation has not been passed are, of course, known to well-informed Senators.

My resolution, which was based on the report of this subcommittee, in effect merely stated that the immediate issue was a moral one and not political or legislative. As a moral issue, it transcended the question of the present lack of sufficiently stringent corrupt practices acts.

In my testimony before the Gillette subcommittee last September I stated:

> Is it not a part of our duty as Senators to encourage within and for the Senate the standards of morality and justice which we wish proudly to proclaim to the world as representative of the best qualities of our country?
>
> I submit that the failure of any Senator to set a high standard of morality is not the failure of a man alone. In the eyes of the world, it is the failure of a nation. Thus the question of standards of character for a Senator cannot be deemed a matter of merely local concern, for a single State, or merely a matter of personal concern, for the Senator or his family. The question we are to discuss today is not only a matter of national but of world concern.

Mr. President, I have been asked about the speech on Wednesday afternoon of the junior Senator from Washington [Mr. CAIN]. As he indicated in the speech, we have had pleasant and cordial personal relationships. Only recently I heard Mrs. Anna Rosenberg, Assistant Secretary of Defense, pay him high tribute.

I must say that his speech made me think that my own speech in Wisconsin last Saturday must have been a far more successful political speech than I had realized. Last Saturday I was the featured speaker at the Democratic State convention in Wisconsin. I am sure he understands the purpose of such speeches, because he himself must have been called on to make them many times himself. The purpose is to arouse the enthusiasm of the political organization.

The SPEAKER. The Clerk will report the amendment in disagreement.

The Clerk read as follows:

Page 25, line 7, strike out:

"Plant and equipment: For an additional amount for 'Plant and equipment,' including the purchase (not to exceed an additional 100) and hire of passenger motor vehicles, $1,450,000,000: *Provided*, That in connection with the expansion of facilities provided in this appropriation, the Commission is authorized without regard to section 3679 of the Revised Statutes to enter into new contracts or modify existing contracts to provide for electric utility services for periods not exceeding 25 years, and such contracts shall be subject to termination by the Commission upon payment of cancellation costs of not to exceed $57,000,000, and any appropriation presently or hereafter made available to the Commission shall be available for the payment of such cancellation costs: *Provided further*, That no part of the foregoing appropriation shall be available for the construction of any building, utility, or other specific portion of a project, unless funds are available for the completion of such building, utility, or other specific portion of such project."

And insert the following:

"Plant and equipment: For an additional amount for 'plant and equipment,' $1,450,000,000, of which $1,355,398,000 is for (i) expenditures during the fiscal year ending June 30, 1953, or thereafter under contracts and against other obligations in an aggregate amount of $3,518,800,000 for the foregoing purposes which the Atomic Energy Commission is authorized to enter into pursuant to the authority of this act as necessary or appropriate to carry out the program as recommended by the National Security Council, approved by the President of the United States, and submitted to the Congress by the Atomic Energy Commission and (ii) settlement and payment of termination claims under such contracts if additional appropriations to permit continuation of performance under such contracts are not hereafter made: *Provided*, That the Commission is authorized without regard to section 3679 of the Revised Statutes to enter into new contracts or modify existing contracts to provide for electric utility services for periods not exceeding 25 years and such contracts shall be subject to termination by the Commission upon payment of cancellation costs as provided in the contracts, and any appropriation presently or hereafter made available to the Commission shall be available for the payment of such cancellation costs: *Provided further*, That appropriations for the fiscal year ending June 30, 1953, may be used, any other law to the contrary notwithstanding, to start new construction projects directly and primarily related to thermonuclear matters."

Mr. THOMAS. Mr. Speaker, I move that the House recede and concur in the Senate amendment with an amendment.

The Clerk read as follows:

Mr. THOMAS moves that the House recede from its disagreement to the amendment of the Senate numbered 41, and concur therein with an amendment, as follows: In lieu of the matter stricken out and inserted by said amendment insert the following: "Plant and equipment: For an additional amount for 'Plant and equipment,' including the purchase (not to exceed an additional 100) and hire of passenger motor vehicles, $2,000,000,000: *Provided*, That in connection with the expansion of facilities provided in this appropriation, the Commission is authorized without regard to section 3679 of the Revised Statutes to enter into new contracts or modify existing contracts to provide for electric utility services for periods not exceeding 25 years, and such contracts shall be subject to termination by the Commission upon payment of cancellation costs of not to exceed $57,000,000, and any appropriation presently or hereafter made available to the Commission shall be available for the payment of such cancellation costs: *Provided further*, That no part of the foregoing appropriation shall be available for the construction of any office building, residence, warehouse or similar structure, utility, or other specific portion or unit of a project, unless funds are available for the completion of such building, utility, or other specific portion or unit of such project. The foregoing proviso shall not be construed to prevent the purchase of land for any project, the construction of any new building or procurement of any machinery, equipment, or materials therefor, nor any utility nor any portion or unit of a specific project if the funds are available to pay the cost of such land, the cost of such building, machinery, equipment, or materials, or the cost of such utility or the cost of any such specific portion or unit of such project."

Mr. THOMAS. Mr. Speaker, briefly, what this does is to add about $550,000,000 and explain the language in great detail. It is crystal clear.

Mr. Speaker, I move the previous question on the motion.

The previous question was ordered.

The motion was agreed to.

A motion to reconsider the votes by which action was taken on the several motions was laid on the table.

## CIVIL FUNCTIONS APPROPRIATION BILL, 1953

Mr. CANNON. Mr. Speaker, I ask unanimous consent to take from the Speaker's desk the bill (H. R. 7268) making appropriations for civil functions administered by the Department of the Army for the fiscal year ending June 30, 1953, and for other purposes, with Senate amendments thereto, disagree to the Senate amendments, and agree to the conference asked by the Senate.

The SPEAKER. Is there objection to the request of the gentleman from Missouri? [After a pause.] The Chair hears none and appoints the following conferees: Messrs. CANNON, RABAUT, MCGRATH, GARY, TABER, DAVIS of Wisconsin, and FORD.

## RECESS

The SPEAKER. The House will stand in recess subject to call.

Accordingly (at 3 o'clock and 12 minutes a. m.) the House stood in recess subject to the call of the Chair.

## AFTER RECESS

The recess having expired, the House was called to order by the Speaker at 5 o'clock and 35 minutes a. m.

## FURTHER MESSAGE FROM THE SENATE

A message from the Senate by Mr. LANDERS, its clerk, announced that the Senate agrees to the report of the committee of conference on the disagreeing votes of the two Houses on the amendments of the Senate to the bill (H. R. 8370) entitled "An act making supplemental appropriations for the fiscal year ending June 30, 1953, and for other purposes"; be it further

*Resolved*, That the Senate disagree to the amendment of the House of Representatives to Senate amendment numbered 41 and request a further conference in the House on the disagreeing votes of the two Houses thereon.

*Ordered*, That Mr. MCKELLAR, Mr. HAYDEN, Mr. MCCARRAN, Mr. O'MAHONEY, Mr. MAYBANK, Mr. BRIDGES, Mr. FERGUSON, Mr. CORDON, and Mr. SALTONSTALL be the conferees on the part of the Senate.

## SUPPLEMENTAL APPROPRIATION BILL, 1953

Mr. THOMAS. Mr. Speaker, I ask unanimous consent to take from the Speaker's desk the bill (H. R. 8370) making supplemental appropriations for the fiscal year ending June 30, 1953, and for other purposes, with Senate amendment thereto, disagree to the Senate amendment, and agree to the conference asked by the Senate.

The SPEAKER. Is there objection to the request of the gentleman from Texas? [After a pause.] The Chair hears none, and appoints the following conferees: Messrs. CANNON, MAHON, THOMAS, WHITTEN, GARY, TABER, WIGGLESWORTH, and DAVIS of Wisconsin.

## SESSIONS OF THE HOUSE NEXT WEEK

Mr. MCCORMACK. Mr. Speaker, I ask unanimous consent that when the House adjourns on Monday next it adjourn to meet on the following Thursday and that when the House adjourns on Thursday next it adjourn to meet on the following Monday.

The SPEAKER. Is there objection to the request of the gentleman from Massachusetts?

There was no objection.

## ENROLLED BILLS SIGNED

Mr. STANLEY, from the Committee on House Administration, reported that that committee had examined and found truly enrolled bills of the House of the following titles, which were thereupon signed by the Speaker:

H. R. 7289. An act making appropriations for the Departments of State, Justice, Commerce, and the Judiciary, for the fiscal year ending June 30, 1953, and for other purposes;

H. R. 7656. An act to provide vocational readjustment and to restore lost educational opportunities to certain persons who served in the Armed Forces on or after June 27, 1950, and prior to such date as shall be fixed by the President or the Congress, and for other purposes;

H. R. 7794. An act to revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents"; and

H. R. 1180. An act to facilitate the performance of research and development work by and on behalf of the Departments of the Army, the Navy, and the Air Force, and for other purposes.

H. R. 6356. An act for the relief of William J. Martin;

H. R. 6831. An act for the relief of Ayako Sukiura;

H. R. 6446. An act for the relief of Jeanne Marie Miura; and

H. R. 6505. An act for the relief of Karen Ann Crowley.

## EXTENSION OF REMARKS

By unanimous consent, permission to extend remarks in the Appendix of the RECORD, or to revise and extend remarks, was granted as follows:

Mr. WOLVERTON with reference to the election of the President of the Republic of Mexico.

Mr. ANGELL in two instances and to include extraneous matter.

Mr. MURDOCK in two instances and to include extraneous matter.

Mr. MANSFIELD in two instances and to include extraneous matter.

Mr. IRVING in four instances and to include extraneous matter in each.

Mr. SHEEHAN (at the request of Mr. CURTIS of Nebraska) and to include extraneous matter.

Mr. CHATHAM and to include an editorial from the Winston-Salem Journal.

Mr. HOWELL in three instances and to include extraneous matter.

Mr. BYRNES of Wisconsin and to include extraneous matter.

Mr. JARMAN (at the request of Mr. STEED) and to include a speech.

Mr. MADDEN and to include an editorial.

Mr. DOYLE in two instances and to include appropriate material.

Mr. MILLER of California and to include certain newspaper articles.

Mr. ANFUSO (at the request of Mr. PRIEST) and to include an address by Chairman Meade of the Federal Trade Commission.

Mr. RAINS and to include extraneous matter.

Mrs. ROGERS of Massachusetts and to include the address that General MacArthur will deliver in Chicago tonight.

Mr. CANNON (at the request of Mr. THOMAS) and to include certain tables and other extraneous matter.

## ADJOURNMENT

Mr. PRIEST. Mr. Speaker, I move that the House do now adjourn.

The motion was agreed to; accordingly (at 6 o'clock and 29 minutes p. m.), pursuant to House Concurrent Resolution 240, the second session of the Eighty-second Congress adjourned sine die.

## BILLS ENROLLED AFTER SINE DIE ADJOURNMENT

Mr. STANLEY, from the Committee on House Administration, after sine die adjournment, reported that that committee had examined and found truly enrolled bills of the House of the following titles:

H. R. 7268. An act making appropriations for civil functions administered by the Department of the Army for the fiscal year ending June 30, 1953, and for other purposes;

H. R. 7800. An act to amend title II of the Social Security Act to increase old-age and survivors insurance benefits, to preserve insurance rights of permanently and totally disabled individuals, and to increase the amount of earnings permitted without loss of benefits, and for other purposes; and

H. R. 8370. An act making supplemental appropriations for the fiscal year ending June 30, 1953, and for other purposes.

## BILLS SIGNED AFTER SINE DIE ADJOURNMENT

The SPEAKER announced that pursuant to House Concurrent Resolution 241, Eighty-second Congress, that he did on Wednesday, July 9, 1952, sign enrolled bills of the House of the following titles:

H. R. 7268. An act making appropriations for civil functions administered by the Department of the Army for the fiscal year ending June 30, 1953, and for other purposes;

H. R. 7800. An act to amend title II of the Social Security Act to increase old-age and survivors insurance benefits, to preserve insurance rights of permanently and totally disabled individuals, and to increase the amount of earnings permitted without loss of benefits, and for other purposes; and

H. R. 8370. An act making supplemental appropriations for the fiscal year ending June 30, 1953, and for other purposes.

## BILLS AND JOINT RESOLUTIONS PRESENTED TO THE PRESIDENT SUBSEQUENT TO SINE DIE ADJOURNMENT

Mr. STANLEY, from the Committee on House Administration, subsequent to sine die adjournment, reported that that committee did, on the following dates present to the President for his approval bills and joint resolutions of the House of the following titles:

On July 7, 1952:

H. R. 707. An act for the relief of John Michael Ancker Rasmussen;

H. R. 1843. An act for the relief of Nahan Ahdo Haj Moussa; and

H. R. 2166. An act for the relief of Sister Anita (Vincenzina Di Franco).

On July 8, 1952:

H. R. 6521. An act to amend section 4472 of the Revised Statutes, as amended, to further provide for the safe loading and discharging of explosives in connection with transportation by vessel;

H. R. 6544. An act to amend the act of June 28, 1948 (62 Stat. 1061), relating to the establishment of the Independence National Historical Park;

H. R. 6556. An act authorizing the issuance of a patent in fee to Erle E. Howe;

H. R. 6601. An act to amend the act of July 16, 1892 (27 Stat. 174, ch. 195), so as to extend to the Secretary of the Navy, and to the Secretary of the Treasury with respect to the Coast Guard, the authority now vested in the Secretaries of the Army and Air Force with respect to the withholding of officer's pay;

H. R. 6637. An act for the relief of Gaetana Giambruno Tomasino;

H. R. 6640. An act for the relief of Hitomi Matsushita;

H. R. 6641. An act for the relief of Leu Wai Ung (Wong Wai Ung) and Leu Wai Chiu (Wong Wai Chiu);

H. R. 6681. An act authorizing the issuance of a patent in fee to John B. Cummins;

H. R. 6723. An act to approve contracts negotiated with the Gering and Fort Laramie irrigation district, the Goshen irrigation district, and the Pathfinder irrigation district, and to authorize their execution; and to authorize the execution of contracts with individual water right contractors on the North Platte Federal reclamation project, and for other purposes;

H. R. 6732. An act for the relief of the alien Ilona Lindelof;

H. R. 6850. An act for the relief of Martha Bridges;

H. R. 6869. An act for the relief of Wong Yang Yee and Wong Sue Chee;

H. R. 6870. An act for the relief of Louie Bon Kong;

H. R. 6978. An act for the relief of Gerald A. Lynn W. Roehm;

H. R. 6983. An act for the relief of Gevork Zohrab Bandarian;

H. R. 7009. An act authorizing the issuance of a patent in fee to Franklin Yarlott;

H. R. 7176. An act making appropriations for the Department of the Interior for the fiscal year ending June 30, 1953, and for other purposes;

H. R. 7255. An act to amend section 165 (b) of the Internal Revenue Code (relating to employee stock purchase plans);

H. R. 7289. An act making appropriations for the Department of State, Justice, Commerce, and the Judiciary, for the fiscal year ending June 30, 1953, and for other purposes;

H. R. 7301. An act authorizing the Secretary of the Interior to issue a patent in fee to Viola Delaney;

H. R. 7302. An act authorizing the Secretary of the Interior to issue patents in fee to certain allottees on the Blackfeet Indian Reservation;

H. R. 7303. An act authorizing the Secretary of the Interior to issue patents in fee to certain allottees on the Crow Indian Reservations;

H. R. 7313. An act making appropriations for the legislative branch for the fiscal year ending June 30, 1953, and for other purposes;

H. R. 7366. An act for the relief of Erika O. Eder, and her son, James Robert Eder;

H. R. 7477. An act for the relief of Carol R. Gray;

H. R. 7502. An act to amend the act of June 6, 1924, as amended, relating to the National Capital Park and Planning Commission, and for other purposes;

H. R. 7641. An act to provide benefits for certain Federal employees of Japanese ancestry who lost certain rights with respect to grade, time in grade, and rate of compensation by reason of any policy or program of the Federal Government with respect to persons of Japanese ancestry during World War II;

H. R. 7654. An act to amend section 508 of title 14, United States Code;

H. R. 7667. An act for the relief of Marie Luise Elfriede Steiniger;

H. R. 7794. An act to revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents";

H. R. 7833. An act for the relief of Prof. Werner Richter and Prof. Max Horkheimer;

H. R. 7850. An act for the relief of Leopold Laufer and Elfriede Laufer;

H. R. 7952. An act to authorize the combination of the Truck Corp Insect Laboratory and the Citrus Insect Laboratory of the Bureau of Entomology and Plant Quarantine, located at Alhambra and Whittier, Calif., respectively, and to provide for new quarters;

H. R. 8006. An act to provide for an adjustment in the compensation of certain employees transferred from the field services of the Post Office Department to the General Services Administration pursuant to Reorgaulzation Plan No. 18 of 1950, and for other purposes;

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the Delaware River and defining certain functions, powers, and duties of said commission, and for other purposes.

On July 18, 1952:

H. R. 1095. An act for the relief of Shelby Shoe Co., of Salem, Mass.;

H. R. 7800. An act to amend title II of the Social Security Act to increase old-age and survivors insurance benefits, to preserve insurance rights of permanently and totally disabled individuals, and to increase the amount of earnings permitted without loss of benefits, and for other purposes; and

H. R. 7833. An act for the relief of Prof. Werner Richter and Prof. Max Horkheimer.

On July 19, 1952:

H. R. 7502. An act to amend the act of June 6, 1924, as amended, relating to the National Capital Park and Planning Commission, and for other purposes; and

H. R. 7794. An act to revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents."

On July 21, 1952:

H. R. 8271. An act to amend sections 433 (h), 457, and 459 of the Internal Revenue Code, and for other purposes.

## DISAPPROVAL OF HOUSE BILL AFTER SINE DIE ADJOURNMENT

The President of the United States, after sine die adjournment, transmitted to the Clerk of the House a bill disapproved, together with his reasons for such action, as follows:

On July 19, 1952:

POSTAL DEPARTMENT LEASE-PURCHASE AGREEMENTS

H. R. 6839. I am withholding my approval of H. R. 6839, "To modify and extend the authority of the Postmaster General to lease quarters for post-office purposes."

Although H. R. 6839 would grant desirable authority to the Postmaster General to enter into lease-purchase agreements for acquiring space to be used for postal purposes, it contains a provision which would infringe upon the functions of the executive branch to such an extent that I feel I cannot give my approval.

Section 8 of H. R. 6839 requires that every lease-purchase agreement negotiated under authority of this bill receive the approval of the House and Senate Committees on Post Office and Civil Service and the House and Senate Committees on Public Works.

I do not dispute the right of the Congress and its committees to take an interest in real-estate transactions made by the executive branch of the Government, but I do question the propriety and wisdom of giving committees veto power over executive functions authorized by the Congress to be carried out by executive agencies. Full information regarding any property transaction has in the past, and will in the future, be made available to the committees of Congress.

I hope that the Congress will, at its next session, give further consideration to legislation to accomplish the purposes of H. R. 6839, and that it will frame legislation free from the difficulties which impel me to withhold my approval from this measure.

HARRY S. TRUMAN.

THE WHITE HOUSE, *July 19, 1952.*

## COMMITTEE EMPLOYEES

COMMITTEE ON AGRICULTURE

JULY 14, 1952.

To the CLERK OF THE HOUSE:

The above-mentioned committee or subcommittee, pursuant to section 134 (b) of the Legislative Reorganization Act of 1946, Public Law 601, Seventy-ninth Congress, approved August 2, 1946, as amended, submits the following report showing the name, profession, and total salary of each person employed by it during the 6-month period from January 1, 1952, to June 30, 1952, inclusive, together with total funds authorized or appropriated and expended by it:

| Name of employee | Profession | Total gross salary during 6-month period |
|---|---|---|
| John J. Heimburger | Counsel (P) | $5,823.00 |
| Altavene Clark | Executive officer (P) | 5,823.00 |
| Mabel C. Downey | Clerk (C) | 5,823.00 |
| Lydia Vacin | Staff assistant (C) | 3,224.94 |
| Alice Baker | do | 2,890.32 |
| Lorraine Greenbaum | do | 2,428.32 |
| Betty Prezioso | do | 2,252.37 |

| | |
|---|---|
| Funds authorized or appropriated for committee expenditures | $50,000.00 |
| Amount of expenditures previously reported | 10,902.98 |
| Amount expended from Jan. 1 to June 30, 1952 | 7,898.75 |
| Total amount expended from Jan. 1, 1951, to June 30, 1952 | 18,801.73 |
| Balance unexpended as of June 30, 1952 | 31,198.27 |

HAROLD D. COOLEY,
*Chairman.*

COMMITTEE ON APPROPRIATIONS

JULY 15, 1952.

To the CLERK OF THE HOUSE:

The above-mentioned committee or subcommittee, pursuant to section 134 (b) of the Legislative Reorganization Act of 1946, Public Law 601, Seventy-ninth Congress, approved August 2, 1946, as amended, submits the following report showing the name, profession, and total salary of each person employed by it during the 6-month period from January 1, 1952, to June 30, 1952, inclusive, together with total funds authorized or appropriated and expended by it:

| Name of employee | Profession | Total gross salary during 6-month period |
|---|---|---|
| George Y. Harvey | The clerk | $5,823.00 |
| Kenneth Sprankle | The assistant clerk | 5,823.00 |
| William A. Duvall | Second assistant clerk | 5,823.00 |
| Corbal D. Orescan | Assistant clerk | 5,823.00 |
| Robert E. Lambert | do | 5,823.00 |
| Paul M. Wilson | do | 5,642.52 |
| Ross P. Pope | do | 5,642.52 |
| Jay B. Howe | do | 5,642.52 |
| John J. Donnelly, Jr. | do | 5,366.04 |
| Arthur Orr | do | 5,290.92 |
| Robert P. Williams | do | 5,158.68 |
| Adelbert W. Heinmiller | do | 4,639.00 |
| Frank Sanders | do | 4,605.66 |
| Carson W. Culp | do | 4,005.66 |
| Robert W. Moyer | Assistant clerk | $4,398.00 |
| Robert L. Michaels | do | 3,663.00 |
| Lawrence C. Miller | Junior assistant clerk | 3,145.20 |
| G. Homer Skarin | do | 2,826.60 |
| Earl C. Silsby | do | 2,826.60 |
| Francis G. Merrill | Clerk-stenographer | 2,189.34 |
| Samuel R. Preston | do | 1,911.36 |
| Robert M. Lewis | Messenger | 1,854.72 |
| Willie Tarrant | Janitor-messenger | 1,443.60 |
| John C. Pugh | Consultant | 1,216.14 |
| E. L. Eckloff | Clerk to the majority | 4,951.20 |
| Robert E. Lee | Clerk to the minority | 5,823.00 |
| Lawrence A. DiCenzo | Clerk-stenographer to ranking minority member | 2,189.34 |
| Julia M. Elliott | Clerk-stenographer to subcommittee chairman | 2,189.34 |
| William J. Neary | do | 2,189.34 |
| Nora Jean Ray | do | 2,189.34 |
| Michael J. McGrath | do | 2,189.34 |
| Marie Silvers | do | 1,824.45 |
| Theodora M. Grant | do | 2,189.34 |
| Jean W. Adams | do | 2,189.34 |
| Dorothy D. Vitale | do | 1,094.67 |
| Claudia Robinson | do | 182.44 |
| Ann M. Woodward | do | 924.38 |
| Ernestine Green | do | 912.26 |
| Ethel M. Scholl | do | 729.78 |
| Mona E. Keating | do | 595.97 |
| Katie Prince Esker | do | 170.22 |
| Elizabeth H. Pascual | do | 364.89 |
| Mary Nell Lea | do | 364.89 |
| Geneva Nichols | do | 729.78 |
| Joseph V. Gartlan, Jr. | do | 364.89 |

| | |
|---|---|
| Funds authorized or appropriated for committee expenditures | $275,000.00 |
| Amount of expenditures previously reported | 128,597.13 |
| Amount expended from Jan. 1 to June 30, 1952 | 135,547.56 |
| Total amount expended from July 1, 1951, to June 30, 1952 | 264,144.73 |
| Balance unexpended as of June 30, 1952 | 10,855.27 |

CLARENCE CANNON,
*Chairman.*

COMMITTEE ON APPROPRIATIONS, INVESTIGATIVE STAFF

JULY 15, 1952.

To the CLERK OF THE HOUSE:

The above-mentioned committee or subcommittee, pursuant to section 134 (b) of the Legislative Reorganization Act of 1946, Public Law 601, Seventy-ninth Congress, approved August 2, 1946, as amended, submits the following report showing the name, profession, and total salary of each person employed by it during the 6-month period from January 1, 1952, to June 30, 1952, inclusive, together with total funds authorized or appropriated and expended by it:

| Name of employee | Profession | Total gross salary during 6-month period |
|---|---|---|
| James E. Nugent | Chief investigator | $4,712.70 |
| Frederic D. Vechery | Chief investigator (from Jan. 1, 1931) | 768.74 |
| Robert E. Rightmyer | Investigator | 3,751.68 |
| Charles G. Haynes | do | 3,001.32 |
| M. Phyllis Monaghan | Clerk-stenographer | 1,748.78 |
| Helen G. Terry | do | 1,379.88 |
| Lois A. Eggars | do | 717.84 |
| Florence M. Leonard | do | 336.34 |

Approved For Release 2000/05/23 : CIA-RDP80-00666-R000100010001-6

REVISION OF TITLE 35, UNITED STATES CODE

# "PATENTS"

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## REPORT

FROM THE

## COMMITTEE ON THE JUDICIARY
## HOUSE OF REPRESENTATIVES

TO ACCOMPANY

## H. R. 7794

A BILL TO REVISE AND CODIFY THE LAWS RELATING TO PATENTS AND THE PATENT OFFICE, AND TO ENACT INTO LAW TITLE 35 OF THE UNITED STATES CODE ENTITLED "PATENTS"



MAY 12, 1952.—Committed to the Committee of the Whole House on the State of the Union and ordered to be printed

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UNITED STATES
GOVERNMENT PRINTING OFFICE
94006 WASHINGTON : 1952

H. Repts., 82-2, vol. 3——9



LEGISLATIVE INTENT SERVICE (800) 666-1917

# COMMITTEE ON THE JUDICIARY

## HOUSE OF REPRESENTATIVES

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WALTER R. LEE, *Legislative Assistant*
CHARLES J. ZINN, *Law Revision Counsel*



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82D CONGRESS } HOUSE OF REPRESENTATIVES { REPORT
2d Session } { No. 1923

# REVISION OF TITLE 35, UNITED STATES CODE

MAY 12, 1952.—Committed to the Committee of the Whole House on the State of the Union and ordered to be printed

Mr. BRYSON, from the Committee on the Judiciary, submitted the following

## REPORT

[To accompany H. R. 7794]

The Committee on the Judiciary submits the following report in explanation of the bill (H. R. 7794) to revise, codify, and enact into law title 35 of the United States Code entitled "Patents," and recommends that the bill do pass. The present bill has been substituted for an earlier bill (H. R. 3760), on which hearings were held, and contains changes recommended by the subcommittee.

### INTRODUCTION

As its title indicates, the purpose of the bill is to revise and codify the laws relating to patents and enact into law title 35 of the United States Code entitled "Patents."

This bill is part of the comprehensive program of revising and enacting into law all the titles of the United States Code. Up to the present time nine out of the 50 titles of the code have been revised and enacted into law and consideration or preparation of bills relating to a number of additional titles is in process.

For many years there had been considerable agitation for a complete restatement and codification of all the laws of the United States, inasmuch as the only such codification—the Revised Statutes of 1874—had become generally outmoded on all subjects.

In 1926, in response to widespread recognition of the need therefor, and after nearly 7 years' effort on the part of the Committee on the Revision of the Laws, the Congress adopted the United States Code, which was a codification of the existing general and permanent laws of the United States arranged in 50 titles according to subject matter, and which was declared to be prima facie evidence of the law.

Because of the size of that code Congress decided that it should undergo a testing period before it was enacted into positive law.



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The code has now been subjected to such a testing period lasting more than 25 years, and the committee's program of enacting the titles into law has been in progress for several years.

### PRIOR REVISION OF PATENT LAWS

The present patent laws consist of about 60 sections of the Revised Statutes of 1874, together with a large number of acts of Congress passed since that date revising various sections of the Revised Statutes or making new enactments not related to any section of the Revised Statutes.

Since the sections of the Revised Statutes relating to patents were merely a compilation of the act of July 8, 1870, 16 Stat. 198, our present patent law is essentially the act of 1870 with subsequent amendatory and supplemental enactments.

The last general revision of the patent laws was the act of July 8, 1870, which was enacted as part of a program to revise and consolidate all the laws of the United States then under way. In 1866 Congress passed a law providing for a commission to revise and consolidate the statutes of the United States. The Commission which was appointed to perform this work prepared a preliminary draft of the part relating to patents and copyrights in 1868, and a second preliminary draft in 1869. The following year a draft of the statutes relating to patents and copyrights as revised, simplified, arranged, and consolidated by the Commission was reported to Congress, and at the same time referred to the Committee on Patents; a bill was introduced by the chairman a few days later.

The object of the Commission on revision of the laws was only to revise, arrange, and consolidate the statutes in force and the draft reported from the Commission presumably was for this purpose only.

The probable reason for referring the matter to the Committee on Patents was that during this same period there had been suggestions for amending the patent laws in substance and it appears that the Committee on Patents studied the draft of the Commission and changed it by various amendments affecting matters of substance. The bill thus introduced was enacted on July 8, 1870, 16 Stat. 198, and included the subjects of copyrights and trade-marks as well as patents.

When the Revised Statutes, as in force on December 1, 1873, were enacted on June 22, 1874, the sections of the act of 1870 were distributed in various parts of the Revised Statutes.

### HISTORY OF PRESENT BILL

By a fortunate distribution of committee functions, the Committee on the Judiciary, and the same subcommittee of this committee, is charged both with the revision of the laws and with the consideration of bills relating to patents.

About three years ago it was suggested that, since the same subcommittee of the Committee on the Judiciary has jurisdiction over both the revision of the laws and the subject of patents, we should undertake the preparation of a bill to revise these laws.

The work was initiated by the preparation of a preliminary draft of a "Proposed Revision and Amendment of the Patent Laws," which was printed and distributed in February 1950.

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The preliminary draft, in addition to simple codification, included a collection of a large number of proposed changes in the law which had come to the attention of the Congress during the past quarter-century, in the form of bills or otherwise. The preliminary draft was widely distributed with a request for criticisms and suggestions. As a result of the comments received, it was decided not to include most of the proposed changes in a bill but to defer them for later consideration, and to limit the bill to the main purpose of codification and enactment of title 35 into law, with only some minor procedural and other changes deemed substantially noncontroversial and desirable.

Numerous suggestions had been received from the Patent Bar and the public. After consideration of the suggestions and criticisms and other comments which had been received, a bill (H. R. 9133) was prepared and introduced in the Eighty-first Congress on July 17, 1950. This bill was also widely distributed and again comments were received from the Patent Bar and others. As a result, the bill was reintroduced in revised form in the Eighty-second Congress as H. R. 3760.

Hearings were held on H. R. 3760 and as a result of the hearings and material received by the committee the bill was revised and introduced as the present bill.

In the preparation of the various drafts leading to the present bill, all acts of Congress relating to or mentioning patents which have been enacted since 1874 were collected and studied, and those acts which had not been specifically repealed were used in preparing the drafts.

The changes introduced in the bill were obtained mainly from a study of all the bills relating to patents which had been introduced in Congress since 1925, the reports of various committees making studies of the patent laws, reports and recommendations of private groups and individuals, and other miscellaneous sources.

The actual work of preparing the preliminary drafts and the bill was directed and supervised by the committee's law revision counsel, Charles J. Zinn, and its counsel having jurisdiction over patent matters, L. James Harris.

For a number of years the committee has pursued a policy of calling on official and unofficial experts in the subject-matter of the proposed revision to assist it, and it has been most fortunate in receiving the able and helpful assistance of various persons such as Mr. P. J. Federico of the Patent Office, Capt. George N. Robillard, United States Navy, patent counsel of the Department of Defense, Mr. T. Hayward Brown of the Department of Justice, and many others. The Coordinating Committee on the Patent Bar, which was organized under the auspices of the National Council of Patent Law Associations and included representatives of industry as well, has rendered invaluable service to the committee in the preparation and refinement of the bill. Messrs. Henry R. Ashton, Giles S. Rich and Paul A. Rose, particularly, devoted themselves to this work.

## EARLY PATENT LAWS

As has already been stated, the present patent laws consist of the Patent Act of 1870 with subsequent enactments adding to or changing various sections of that original act. The first patent law was enacted

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in the second session of the First Congress in 1790. When the first Congress met, one of its very first items of business was the consideration of patents and copyrights, and the first patent bill was H. R. No. 10 of the First Congress.

The patent laws are enacted by Congress in accordance with the power granted by article I, section 8, of the Constitution which provides that:

> The Congress shall have the power . . . to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

This provision was unanimously adopted by the Constitutional Convention following suggestions for Federal jurisdiction over both patents and copyrights which had been made in the Convention by James Madison of Virginia and Charles Pinckney of South Carolina. Each proposed separate provisions relating to patents and to copyrights which were merged by the Drafting Committee of the Convention into the general statement we now have, which was adopted without any dissenting voice.

The background, the balanced construction, and the usage current then and later, indicate that the constitutional provision is really two provisions merged into one. The purpose of the first provision is to promote the progress of science by securing for limited times to authors the exclusive right to their writings, the word "science" in this connection having the meaning of knowledge in general, which is one of its meanings today. The other provision is that Congress has the power to promote the progress of useful arts by securing for limited times to inventors the exclusive right to their discoveries. The first patent law and all patent laws up to a much later period were entitled "Acts to promote the progress of useful arts."

The first patent law, which was enacted on April 10, 1790, vested the jurisdiction to issue patents in a Board consisting of the Secretary of State, the Attorney General, and the Secretary of War. The person principally interested and the leader of the group was the Secretary of State, Thomas Jefferson, who was personally deeply interested in the subject matter of patent law. Jefferson was not a patentee himself, but he was the inventor of a number of devices, most of them being "gadgets."

This first law made the power of the Board to issue patents absolute, and also provided for various things that would be necessary in a general patent law.

While the Board, and particularly Thomas Jefferson, was quite favorable to the granting of patents, and granted them with great consideration, the other duties of members of this Board, in view of their high offices, made it impossible for them to devote much time to this work, and as a result the law was changed in 1793 to make the granting of patents a clerical function. Under the act of 1793 patents were granted to anyone who applied on fulfilling the formal requirements and filing the necessary papers and fees.

This law continued in force until 1836 when the dissatisfaction with the granting of patents without any examination as to novelty or other matters led to the appointment of a select committee by the Senate which introduced a bill that became the new law which was enacted on July 4, 1836. This new law contains the fundamental

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principles of our present patent law. It created a Patent Office with a Commissioner of Patents at the head, and examiners with the function of examining applications for patents and with the power to refuse patents, which was not present in the previous law. The law had many other provisions in it relating to details of procedure, enforcement of patents, and matters of that sort.

Amendments were made to this act of 1836 at various times until 1870 when the law was completely revised in the manner above referred to.

The present bill in a sense, then, is the second revision and codification of the patent laws by a committee on the Revision of the Laws and a committee in charge of patents.

## GENERAL DESCRIPTION OF BILL

Although the principal purpose of the bill is the codification of title 35, United States Code and involves simplification and clarification of language and arrangement, and elimination of obsolete and redundant provisions there are a number of changes in substantive statutory law. These will be explained in some detail in the revision notes keyed to each section which appear in the appendix of this report. The major changes or innovations in the title consist of incorporating a requirement for invention in § 103 and the judicial doctrine of contributory infringement in § 271.

The bill divides the statutes into three parts. The first part contains the sections of the law relating to the Patent Office generally, its powers and duties and some ancillary matters of that kind. The second part consists of the sections relating to the conditions under which a patent may be obtained and the procedure in obtaining patents. The third part contains the sections relating to the patents themselves and the protection of rights under patents, and matters relating to that phase of the subject.

Stated generally, these three parts relate to, first, the Patent Office, second, obtaining a patent, and third, the patent itself. Of course it has not been possible to maintain this three-part division strictly and there may be some overlapping of the three phases of the subject. In each part the sections are arranged in several chapters of more or less homogeneous subject matter, with chapter headings.

The organization of the bill and the arrangement of the sections are such that new future amendments can readily find their place in the organization. Catchlines of parts, chapters and sections are provided for convenience of reference.

The first chapter in part I relates to the Patent Office and covers the establishment of the Patent Office, its seal, officers and employees, restrictions on officers and employees as to interest in patents, bond of the Commissioner, duties of the Commissioner, the Board of Appeals, the Patent Office library, etc. Very little change is introduced in these sections. There is one change in section 3, relating to a temporary successor to the Commissioner when the office is vacant, filling a gap in the present law. There is a change in section 4 relating to the disability of Patent Office employees to obtain patents.

The next chapter collects some of the details relating to procedure in the Patent Office of general application with no important changes.

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The next group, sections 31, 32, and 33 relate to practice before the Patent Office. In them the language of the prior statutes has been rearranged and divided into several sections. There has been no change in substance in these sections, except in the third of this group which is a criminal provision for unauthorized practice. The language has been considerably simplified, and the maximum fine has been raised from $100 to $1,000.

In the next group of sections, relating to Patent Office fees, there have been a few readjustments in some minor fees, and an upward change in the fee for an appeal to the Board of Appeals.

The sections of the first part apply to the Patent Office as such, and, except for provisions specific to patents, include trade-marks as well as patents, where they relate to organizational and procedural matters, since the registration of trade-marks is handled by the Patent Office.

Part II relates to patentability of inventions and the grant of patents.

Referring first to section 101, this section specifies the type of material which can be the subject matter of a patent. The present law states that any person who has invented or discovered any "new and useful art, machine, manufacture, or composition of matter, or any new or useful improvement thereof" may obtain a patent. That language has been preserved except that the word "art" which appears in the present statute has been changed to the word "process." "Art" in this place in the present statute has a different meaning than the words "useful art" in the Constitution, and a different meaning than the use of the word "art" in other places in the statutes, and it is interpreted by the courts to be practically synonymous with process or method. The word "process" has been used to avoid the necessity of explanation that the word "art" as used in this place means "process or method," and that it does not mean the same thing as the word "art" in other places.

The definition of "process" has been added in section 100 to make it clear that "process or method" is meant, and also to clarify the present law as to the patentability of certain types of processes or methods as to which some insubstantial doubts have been expressed.

Section 101 sets forth the subject matter that can be patented, "subject to the conditions and requirements of this title." The conditions under which a patent may be obtained follow, and section 102 covers the conditions relating to novelty.

A person may have "invented" a machine or a manufacture, which may include anything under the sun that is made by man, but it is not necessarily patentable under section 101 unless the conditions of the title are fulfilled.

Section 102 in paragraphs (a), (b), and (c) repeats the conditions in the existing law relating to novelty.

Subsection (a) is the language of the existing law, recognizing that the interpretation by the courts excludes various kinds of private knowledge not known to the public.

Paragraph (d) relating to a bar to patentability when the inventor has previously obtained a patent in a foreign country, represents a liberalizing change in the existing law.

Subsection (e) is another well-recognized condition imposed by a decision of the Supreme Court which was not expressed in the existing law; for the purpose of anticipating subsequent inventors, a

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patent disclosing the subject matter speaks from the filing date of the application disclosing the subject matter.

Subsection (f) merely emphasizes that it is the inventor that applies for the patent.

Subsection (g) relates to the question of priority of invention between rival inventors.

Section 102, in general, may be said to describe the statutory novelty required for patentability, and includes, in effect, an amplification and definition of "new" in section 101.

Section 103, for the first time in our statute, provides a condition which exists in the law and has existed for more than 100 years, but only by reason of decisions of the courts. An invention which has been made, and which is new in the sense that the same thing has not been made before, may still not be patentable if the difference between the new thing and what was known before is not considered sufficiently great to warrant a patent. That has been expressed in a large variety of ways in decisions of the courts and in writings. Section 103 states this requirement in the title. It refers to the difference between the subject matter sought to be patented and the prior art, meaning what was known before as described in section 102. If this difference is such that the subject matter as a whole would have been obvious at the time to a person skilled in the art, then the subject matter cannot be patented.

That provision paraphrases language which has often been used in decisions of the courts, and the section is added to the statute for uniformity and definiteness. This section should have a stabilizing effect and minimize great departures which have appeared in some cases.

The next group of sections relates to the application for a patent.

Sections 116 and 118 introduce a new element in our statutes. The existing statute is very strict in requiring that only the inventor may apply for a patent. These two sections provide for certain types of situations where it may be impossible for the inventor himself to apply, or where, in the case of a joint invention, one of the joint applicants has been inadvertently erroneously included or a joint inventor inadvertently excluded; the sections provide all the safeguards necessary for the inventor.

Section 119 introduces a minor change.

Sections 120 and 121 express in the statute certain matters which exist in the law today but which had not before been written into the statute, and in so doing make some minor changes in the concepts involved.

Section 122 incorporates into the title the rule of secrecy of patent applications which has existed in the Patent Office for generations.

The next chapter relates to the examination of the application in the Patent Office; rejection by the examiner, the right to reconsideration, the time within which an applicant must reply to actions, time for prosecuting application, appeal to the Board, and interferences between rival claimants for a patent. Very little has been changed in this group of sections except a minor revision in the interference section.

The next chapter relates to the review of Patent Office decisions.

The act of 1836 provided, for the first time, for the refusal of patents by officials known as examiners. The legislature was jealous of the

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rights of the public and provided adequate means of reviewing the action of the Patent Office. In fact, there are now two types of review. The applicant may appeal to a court of appeals especially provided, or he may file suit in the district court against the Commissioner to have his rights adjudicated by the court.

This group of sections makes no fundamental change in the various appeals and other review of Patent Office action, but has made a few changes in the procedure in various instances to correct some of the problems which have arisen, particularly in section 146. These details are mainly procedural.

The next chapter collects the provisions relating to plant patents, the next those relating to designs, and chapter 17 restates the recently enacted statute relating to secrecy of certain inventions.

Part III deals with the patent itself after it has been granted.

The first chapter of this part relates to correcting and amending a patent.

Sections 251 and 252 are a development of the present statute relating to what are called reissues. Under certain circumstances the patentee may obtain a new patent to replace the old one to correct certain kinds of defects that he may have discovered in the patent. These two sections together replace the present one, make a number of clarifications and a few additions in further development of the subject.

Section 253 relates to another form of correction of a patent known as the disclaimer. The patentee files a paper in the Office which is recorded. He disclaims certain things from the scope of his patent or disclaims certain claims. This subject of disclaimers, in the present law, has resulted in a great deal of confusion and uncertainty in certain situations in the law which at times are almost ridiculous. Consequently, the bill in two sections, 253 and 288, has introduced certain changes relating to disclaimers. One of these changes is that only a whole claim can be disclaimed; a patent can not be rewritten by filing a paper in the Patent Office.

The second change relates to the situation when a patent has two or more claims and one of them may be discovered to be invalid. There is now a provision in the statute under which an invalid claim must be disclaimed without unreasonable delay in order to save the rest of the patent. What delay is unreasonable is presently quite confusing, and the present law does not, as a matter of fact, prevent the patentee from suing again on the invalid claim if he so wishes.

The bill has eliminated that requirement. It has left the situation so that if one claim of a patent is invalid, the patentee may take it out. He may sue on the remaining claims which have whatever validity they may have on their own merits. That is, one bad claim does not affect the other claims, unless they are also bad for similar reasons.

Other provisions of the bill take care at least as well as is done in the present law of the possibility of a patentee suing again after his patent has been held invalid. That can be done today and no change is made in that situation, except that certain provisions tend to deter doing such a thing.

Section 255, which permits the Patent Office to correct by a certificate a merely clerical error made by the patentee, is new.

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Section 256 is a new section in the law that is correlated with section 116 and relates to a mistake in joining a person as a joint inventor. Very often two or three people make an invention together. They must apply as joint inventors. If they make a mistake in determining who are the true inventors, they do so at their peril. This provision permits a bona fide mistake in joining a person as inventor or in failing to join a person as an inventor to be corrected.

The next chapter of two sections relates to assignments and ownership.

Section 262 merely states in the statute a peculiarity relating to joint ownership.

The next two sections collect provisions now in the law referring to the Government ownership of patents, making little change except in language.

The next chapter relates to infringements of patents.

Section 271, paragraph (a), is a declaration of what constitutes infringement. There is no declaration of what constitutes infringement in the present statute. It is not actually necessary because the granting clause creates certain exclusive rights and infringement would be any violation of those rights.

Paragraphs (b), (c), and (d) relate to the subject referred to as contributory infringement. The doctrine of contributory infringement has been part of our law for about 80 years. It has been applied to enjoin those who sought to cause infringement by supplying someone else with the means and directions for infringing a patent. One who makes a special device constituting the heart of a patented machine and supplies it to others with directions (specific or implied) to complete the machine is obviously appropriating the benefit of the patented invention. It is for this reason that the doctrine of contributory infringement, which prevents appropriating another man's patented invention, has been characterized as "an expression both of law and morals." Considerable doubt and confusion as to the scope of contributory infringement has resulted from a number of decisions of the courts in recent years. The purpose of this section is to codify in statutory form principles of contributory infringement and at the same time eliminate this doubt and confusion. Paragraph (b) recites in broad terms that one who aids and abets an infringement is likewise an infringer. The principle of contributory infringement is set forth in the provisions of the next paragraph which is concerned with the usual situation in which contributory infringement arises. This latter paragraph is much more restricted than many proponents of contributory infringement believe should be the case. The sale of a component of a patented machine, etc., must constitute a material part of the invention and must be known to be especially made or especially adapted for use in the infringement before there can be contributory infringement, and likewise the sale of staple articles of commerce suitable for noninfringement use does not constitute contributory infringement. The last paragraph of this section provides that one who merely does what he is authorized to do by statute is not guilty of misuse of the patent. These paragraphs have as their main purpose clarification and stabilization.

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Section 272 is a new section in the law relating to infringement, but it is of relatively little importance and it follows a paragraph in a treaty to which the United States is a party.

Beginning with 281 is a group of sections relating to remedy for infringement of a patent, the suit in the courts. The present statutes on this matter are in confusion because they were written quite some time ago and court procedure and the names of actions and so on have changed since then. So the present sections were substantially reorganized into a group of sections fitting in at this place, with some changes.

Section 281 is a declaration which serves as a preamble to the others.

Section 282 introduces a declaration of the presumption of validity of a patent, which is now a statement made by courts in decisions, but has had no expression in the statute. The defenses to a suit for infringement are stated in general terms, changing the language in the present statute, but not materially changing the substance.

The next few sections relate to injunctions, damages, attorney fees, the statute of limitations, and to marking and notice; all of which together replace present statutes on suits, with a good deal of reorganization in language to clarify the statement of the statutes.

Section 288 is the companion section to the disclaimer section, 253.

Section 292 is a criminal statute relating to falsely marking an article as being patented when it was not patented, which is now the present law. But this section revises it and makes a few changes, and also makes it an ordinary criminal action as well as an informer action as in the present statute.

Section 293 is a new section that is needed on some occasions to obtain jurisdiction over foreign patent owners that do not reside in the United States.

The revision notes, which follow and constitute a part of this report, point out in more detail the revisions made by the bill.

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# APPENDIX

## REVISION NOTES

Notes explaining in detail the revision of the laws relating to patents are set forth in numerical order according to the section numbers of the revised title.

### Title 35—Patents


| Part | | Sec. |
|---|---|---|
| I. | PATENT OFFICE | 1 |
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| III. | PATENTS AND PROTECTION OF PATENT RIGHTS | 251 |


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## CHAPTER 1. ESTABLISHMENT, OFFICERS, FUNCTIONS


Sec.

1. Establishment.
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3. Officers and employees.
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5. Bond of Commissioner and other officers.
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14. Annual report to Congress.




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### SECTION 1—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 1 (R. S. 475 and Executive Order 4175, Mar. 17, 1925).

The word "all" is omitted from the corresponding section of the existing statute and "except as otherwise provided by law" added, since some old records are kept in the National Archives, see 44 U. S. C., 1946 ed., ch. 8A.

The word "models" has been omitted to remove emphasis on models since they are no longer generally required. They are included by the word "things."

The phrase "and to trade-mark registrations" is added. There is no enactment corresponding to this section in the trade-mark law. The original chapter of the Revised Statutes containing this section deals with the Patent Office as such in its administration of trade-marks as well as patents. This is explicitly brought out in some of the corresponding sections of the present chapter.

Changes in language are made.

### SECTION 2—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 3 (R. S. 478).

"Certificates of trade-mark registrations" is added, see note under section 1. Changes in language are made and the specific date eliminated.

### SECTION 3—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 2 (R. S. 476, amended (1) Feb. 15, 1916, ch. 22, § 1, 39 Stat. 8, (2) Feb. 14, 1927, ch. 139, § 1, 44 Stat. 1098, (3) April 11, 1930, ch. 132, § 1, 46 Stat. 155).

The temporary designation of the assistant commissioner as Commissioner in case of a vacancy in office is added. This will eliminate complications since present applicable general statutes (5 U. S. C., 1946 ed., § 7) permit a vacancy to be temporarily filled only for not more than 30 days.

Changes in language are made. "Assistant commissioners" is used in the second sentence (and elsewhere in the bill) as referring to all three assistants.

This entire title is subject to Reorganization Plan No. 5 of 1950 (64 Stat. 1263) which vests all functions of the Patent Office in the Secretary of Commerce and authorizes delegation by him. It has been found impractical to so word the various sections of the title, and a general provision has been inserted as the second paragraph of this section of the bill, leaving the wording of various sections of the title in terms of officers previously specified and to whom the functions presently stand delegated.

### SECTION 4—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 4 (R. S. 480).

The language is revised and inability to apply for a patent, included in the original language, is made explicit.

The period of disability is increased to include one year after leaving the Office.

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The further restriction, that no priority date earlier than one year after leaving the Office can be claimed, is added.

The one year period is made inapplicable to applications which may be pending when the revised title goes into effect by section 4 (g) of the bill.

SECTION 5—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 5 (R. S. 479).

Specific mention of the office of chief clerk is omitted from the corresponding section of the existing statute, the officers requiring bonds, and the amounts of the bonds are to be designated by the Commissioner.

SECTION 6—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 6 (R. S. 481 and 483).

The two sections are combined into one with some changes in language.

"And the registration of trade-marks" is added, see note under section 1.

SECTION 7—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 7 (R. S. 482, amended (1) Mar. 2, 1927, ch. 273, § 3, 44 Stat. 1335, (2) April 11, 1930, ch. 132, § 2, 46 Stat. 155, (3) Mar. 4, 1950, ch. 50, 64 Stat. 11).

Some changes in language have been made and the reference to interferences, which are no longer considered by the Board of Appeals, has been deleted. Reference to reissues is omitted in view of the general provision in section 201.

SECTION 8—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 10 (R. S. 486).

Some change in language has been made. "Purchased" is changed to "maintained" to include the existing library and keeping it up by additions. The phrase "and other" is added to include legal works. The last phrase of the corresponding section of the existing statute is omitted as unnecessary.

SECTION 9—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 6 note (June 10, 1898, ch. 430, § 1, 30 Stat. 440).

Changes in language are made.

SECTION 10—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 14 (Mar. 3, 1891, ch. 541, § 1 (part), 26 Stat. 908, 940).

Reference to other records is added. The fee for certification is omitted as it appears in the table of fees.

SECTION 11—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., §§ 13 and 16 (R. S. 489; July 9, 1947, ch. 211, § 301 (part), 61 Stat. 299, repeated in prior and subsequent appropriation acts).



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Section is amplified to list the publications of the Patent Office, based on 44 U. S. C., 1946 ed., § 283, 283a.

The second sentence of item 1 of the revised section is a provision appearing annually in appropriation acts to enable the Patent Office to maintain a small printing press to place headings on drawings before the drawings are reproduced.

Language is changed.

### Section 12—Section Revised

Based on title 35, U. S. C., 1946 ed., §§ 15 and 78, part (Jan. 14, 1915, 38 Stat. 1221; Feb. 18, 1922, ch. 58, § 9, proviso in, 42 Stat. 393).

The first act mentioned applies to Canada only, the second to any country; these are consolidated in one section, specific reference to one country not being necessary.

Language is changed.

### Section 13—Section Revised

Based on title 35, U. S. C., 1946 ed., § 78, part (R. S. 4934, Feb. 18, 1922, ch. 58, § 9, 42 Stat. 389, 393, amended June 15, 1950, ch. 249, 64 Stat. 215).

The proviso in the schedule of fees of the existing statute is made a separate section and some changes in language are made.

### Section 14—Section Revised

Based on title 35, U. S. C., 1946 ed., § 20 (R. S. 494).

Language is changed. The lists referred to in the corresponding section of existing statute, and which are omitted from the revised section, are the indexes provided for in section 11 (a) 4. The month of reporting is omitted. The report contemplated by R. S. 494 has been discontinued since 1925 under authority of 44 U. S. C., 1946 ed., § 212.

## CHAPTER 2. PROCEEDINGS IN THE PATENT OFFICE

Sec.

21. Day for taking action falling on Saturday, Sunday or holiday.
22. Printing of papers filed.
23. Testimony in Patent Office cases.
24. Subpoenas, witnesses.

### Section 21—Section Revised

Based on title 35, U. S. C., 1946 ed., § 21 (Mar. 2, 1927, ch. 273, § 14, 44 Stat. 1337).

"Fixed by statute" is omitted from the corresponding section of the existing statute as unnecessary. Saturday is added as a day on which action need not be taken.

### Section 22—Section Revised

Based on title 35, U. S. C., 1946 ed., § 12 (R. S. 488).

Language is changed and "or typewritten" is added after "printed."

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### Section 23—Section Revised

Based on title 35, U. S. C., 1946 ed., § 53 (R. S. 4905).

This section is placed in part 1 since it relates to trade-mark cases in the Patent Office as well as to patent cases.

Language is changed.

### Section 24—Section Revised

Based on title 35, U. S. C., 1946 ed., §§ 54, 55 and 56 (R. S. 4906, amended Feb. 18, 1922, ch. 58, § 7, 42 Stat. 389, 391–2; R. S. 4907; R. S. 4908).

Three sections of the existing statute are combined with some changes in language and placed in part 1 since they apply to trade-mark cases in the Patent Office as well as to patent cases. Reference to a repealed statute in the first paragraph is replaced by reference to the Federal Rules of Civil Procedure and certain rules are made applicable.

## CHAPTER 3, PRACTICE BEFORE PATENT OFFICE

Sec.

31. Regulations for agents and attorneys.
32. Suspension or exclusion from practice.
33. Unauthorized representation as practitioner.

### Section 31—Section Revised

Based on title 35, U. S. C., 1946 ed., § 11 (R. S. 487, amended Feb. 18, 1922, ch. 58, § 3, 42 Stat. 390).

The present statute is divided into two sections, 31 and 32.

Changes in language are made.

### Section 32—Section Revised

Based on title 35, U. S. C., 1946 ed., § 11 (R. S. 487 amended Feb 18, 1922, ch. 58, § 3, 42 Stat. 390).

See note under section 31.

### Section 33—Section Revised

Based on title 35, U. S. C., 1946 ed., § 11a (May 9, 1938, ch. 188, 52 Stat. 342).

This is a criminal statute. The language has been considerably simplified and the upper limit of the penalty is increased.

## CHAPTER 4. PATENT FEES

Sec.

41. Patent fees.
42. Payment of patent fees; return of excess amounts.

### Section 41—Section Revised

Based on title 35, U. S. C., 1946 ed., § 78 (R. S. 4934, amended (1) May 27, 1908, ch. 200, § 1 (part) 35 Stat. 317, 343; (2) June 25, 1910, ch. 414, § 2, 35 Stat. 843; (3) Feb. 18, 1922, ch. 58, § 9, 42 Stat. 389, 393; (4) Feb. 14, 1927, ch. 139, § 2, 44 Stat. 1098, 1099; (5) Mar.

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2, 1927, ch. 273, § 13, 44 Stat. 1335, 1337; (6) April 11, 1930, ch. 132, § 3, 46 Stat. 155; (7) June 30, 1932, ch. 314, §§ 308, 309, 47 Stat. 382, 410; (8) Aug. 9, 1939, ch. 619, § 3, 53 Stat. 1293; July 5, 1946, ch. 541, § 301 (part), 60 Stat. 446, 471.

The items in the schedule of fees are rearranged in a few instances and are numbered for convenient reference.

The obsolete fee for appeal from the examiners of interferences to the Board of Appeals is omitted.

The fee for appeal to the Board of Appeals is changes from $15 to $25.

Two provisos in the corresponding section of the existing statute have been made separate sections, see sections 12 and 13.

The fee for a certificate is changed from 50 cents to $1 to correspond to the same fee in the trade-mark statute.

A new item (8) is added to go with section 205.

An omnibus item to take care of miscellaneous minor fees is added; in view of this, two items in the present schedule are omitted.

The fee for reissue applications is changed slightly.

### SECTION 42—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 79 (Mar. 6, 1920, ch. 94, § 1 (part), 41 Stat. 503, 512).

Language has been changed.

## PART II. PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS


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## CHAPTER 10. PATENTABILITY OF INVENTIONS


Sec.
100. Definitions.
101. Inventions patentable.
102. Conditions for patentability; novelty and loss of right to patent.
103. Conditions for patentability; nonobvious subject matter.
104. Invention made abroad.


### SECTION 100—NEW SECTION

Paragraph (a) is added only to avoid repetition of the phrase "invention or discovery" and its derivatives throughout the revised title. The present statutes use the phrase "invention or discovery" and derivatives.

Paragraph (b) is noted under section 101.

Paragraphs (c) and (d) are added to avoid the use of long expressions in various parts of the revised title.

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### SECTION 101—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 31 (R. S. 4886, amended (1) Mar. 3, 1897, ch. 391, § 1, 29 Stat. 692, (2) May 23, 1930, ch. 312, § 1, 46 Stat. 376, (3) Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212).

The corresponding section of existing statute is split into two sections, section 101 relating to the subject matter for which patents may be obtained, and section 102 defining statutory novelty and stating other conditions for patentability.

Section 101 follows the wording of the existing statute as to the subject matter for patents, except that reference to plant patents has been omitted for incorporation in section 301 and the word "art" has been replaced by "process", which is defined in section 100. The word "art" in the corresponding section of the existing statute has a different meaning than the same word as used in other places in the statute; it has been interpreted by the courts as being practically synonymous with process or method. "Process" has been used as its meaning is more readily grasped than "art" as interpreted, and the definition in section 100 (b) makes it clear that "process or method" is meant. The remainder of the definition clarifies the status of processes or methods which involve merely the new use of a known process, machine, manufacture, composition of matter, or material; they are processes or methods under the statute and may be patented provided the conditions for patentability are satisfied.

### SECTION 102—SECTION REVISED

Paragraphs (a), (b), and (c) are based on 35 U. S. C., 1946 ed., § 31 (R. S. 4886, amended (1) Mar. 3, 1897, ch. 391, § 1, 29 Stat. 692, (2) May 23, 1930, ch. 312, § 1, 46 Stat. 376, (3) Aug. 5, 1939, ch. 450, §1, 53 Stat. 1212).

No change is made in these paragraphs other than that due to division into lettered paragraphs. The interpretation by the courts of paragraph (a) as being more restricted than the actual language would suggest (for example, "known" has been held to mean "publicly known") is recognized but no change in the language is made at this time. Paragraph (a) together with section 104 contains the substance of title 35 U. S. C., 1946 ed., § 72 (R. S. 4923).

Paragraph (d) is based on 35 U. S. C., 1946 ed., § 32, first paragraph (R. S. 4887 (first paragraph), amended (1) Mar. 3, 1897, ch. 391, § 3, 29 Stat. 692, 693, (2) Mar. 3, 1903, ch. 1019, § 1, 32 Stat. 1225, 1226, (3) June 19, 1936, ch. 594, 49 Stat. 1529).

The section has been changed so that the prior foreign patent is not a bar unless it was granted before the filing of the application in the United States.

Paragraph (e) is new and enacts the rule of *Milburn* v. *Davis-Bournonville*, 270 U. S. 390, by reason of which a United States patent disclosing an invention dates from the date of filing the application for the purpose of anticipating a subsequent inventor.

Paragraph (f) indicates the necessity for the inventor as the party applying for patent. Subsequent sections permit certain persons to apply in place of the inventor under special circumstances.

Paragraph (g) is derived from title 35, U. S. C., 1946 ed., § 69 (R. S. 4920, amended (1) Mar. 3, 1897, ch. 391, § 2, 29 Stat. 692,

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(2) Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212), the second defense recited in this section. This paragraph retains the present rules of law governing the determination of priority of invention.

Language relating specifically to designs is omitted for inclusion in subsequent sections.

### SECTION 103—NEW SECTION

There is no provision corresponding to the first sentence explicitly stated in the present statutes, but the refusal of patents by the Patent Office, and the holding of patents invalid by the courts, on the ground of lack of invention or lack of patentable novelty has been followed since at least as early as 1850. This paragraph is added with the view that an explicit statement in the statute may have some stabilizing effect, and also to serve as a basis for the addition at a later time of some criteria which may be worked out.

The second sentence states that patentability as to this requirement is not to be negatived by the manner in which the invention was made, that is, it is immaterial whether it resulted from long toil and experimentation or from a flash of genius.

### SECTION 104—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 109 (Aug. 8, 1946, ch. 910, 60 Stat. 943).

Language has been changed and the last sentence has been broadened to refer to persons serving in connection with operations by or on behalf of the United States, instead of solely in connection with the prosecution of the war.

## CHAPTER 11. APPLICATION FOR PATENT

Sec.

111. Application for patent.
112. Specification.
113. Drawings.
114. Models, specimens.
115. Oath of applicant.
116. Joint inventors.
117. Death or incapacity of inventor.
118. Filing by other than inventor.
119. Benefit of earlier filing date in foreign country; right of priority.
120. Benefit of earlier filing date in the United States.
121. Divisional applications.
122. Confidential status of applications.

### SECTION 111—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 33 (R. S. 4888, amended (1) Mar. 3, 1915, ch. 94, § 1, 38 Stat. 958; (2) May 23, 1930, ch. 312, § 2, 46 Stat. 376).

The corresponding section of existing statute is divided into an introductory section relating to the application generally (this section) and a section on the specification (sec. 112).

The parts of the application are specified and the requirement for signature is placed in this general section so as to insure that only one signature will suffice.

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### Section 112—Section Revised

Based on title 35, U. S. C., 1946 ed., § 33 (R. S. 4888, amended (1) Mar. 3, 1915, ch. 94, § 1, 38 Stat. 958; (2) May 23, 1930, ch. 312, § 2, 46 Stat. 376).

The sentence relating to signature of the specification is omitted in view of the general requirement for a signature in section 111.

The last sentence is omitted for inclusion in the chapter relating to plant patents.

The clause relating to machines is omitted as unnecessary and the requirement for disclosing the best mode of carrying out the invention is stated as generally applicable to all types of invention (derived from title 35, U. S. C., 1946 ed., § 69, first defense).

The clause relating to the claim is made a separate paragraph to emphasize the distinction between the description and the claim or definition, and the language is modified.

A new paragraph relating to functional claims is added.

### Section 113—Section Revised

Based on title 35, U. S. C., 1946 ed., § 34, part (R. S. 4889, amended Mar. 3, 1915, ch. 94, § 2, 38 Stat. 958).

The requirement for signature in the corresponding section of existing statute is omitted; regulations of the Patent Office can take care of any substitute. A redundant clause is omitted.

### Section 114—Section Revised

Based on title 35, U. S. C., 1946 ed., § 34, part (R. S. 4890 and 4891).

The change in language in the second paragraph broadens the requirement for specimens.

### Section 115—Section Revised

Based on title 35, U. S. C., 1946 ed., § 35 (R. S. 4892, amended (1) Mar. 3, 1903, ch. 1019, § 2, 32 Stat. 1225, 1226, (2) May 23, 1930, ch. 312, § 3, 46 Stat. 376).

The expression at the end of the second sentence is added to avoid application of the District of Columbia law to oaths taken outside the District.

Changes in language are made.

### Section 116—New Section

The first paragraph is implied in the present statutes, and the part of the last paragraph relating to omission of an erroneously joined inventor is in the Patent Office rules. The remainder is new and provides for the correction of a mistake in erroneously joining a person as inventor, and for filing an application when one of several joint inventors cannot be found. This section is ancillary to section 256.

### Section 117—Section Revised

Based on title 35, U. S. C., 1946 ed., § 46 (R. S. 4896, amended (1) Feb. 28, 1899, ch. 227, 30 Stat. 915, (2) Mar. 3, 1903, ch. 1019, § 3, 32 Stat. 1225, 1226, (3) May 23, 1908, ch. 188, 35 Stat. 245).

The language has been considerably simplified.

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### Section 118—New Section

This section is new and provides for the filing of an application by another on behalf of the inventor in certain special hardship situations.

### Section 119—Section Revised

Based on title 35, U. S. C., 1946 ed., § 32, second paragraph (R. S. 4887, second paragraph, amended (1) Mar. 3, 1903, ch. 1019, § 1, 32 Stat. 1225, 1226, (2) June 19, 1936, ch. 594, 49 Stat. 1529, (3) Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212).

The first paragraph is the same as the present law with changes in language. The references to designs have been removed for inclusion in another section and the opening clause has been modified to accord with actual practice and the requirements of the International Convention for the Protection of Industrial Property.

The second paragraph is new, making an additional procedural requirement for obtaining the right of priority. Copies of the foreign papers on which the right of priority is based are required so that the record of the United States patent will be complete in this country.

### Section 120—New Section

This section represents present law not expressed in the statute, except for the added requirement that the first application must be specifically mentioned in the second.

### Section 121—New Section

This section enacts as law existing practice with respect to division, at the same time introducing a number of changes. Division is made discretionary with the Commissioner. The requirements of section 120 are made applicable and neither of the resulting patents can be held invalid over the other merely because of their being divided in several patents. In some cases a divisional application may be filed by the assignee.

### Section 122—New Section

This section enacts the Patent Office rule of secrecy of applications.

## CHAPTER 12. EXAMINATION OF APPLICATION

Sec.

131. Examination of application.
132. Notice of rejection; reexamination.
133. Time for prosecuting application.
134. Appeal to the Board of Appeals.
135. Interferences.

### Section 131—Section Revised

Based on title 35, U. S. C., 1946 ed., § 36 (R. S. 4893).

The first part is revised in language and amplified. The phrase "and that the invention is sufficiently useful and important" is omitted as unnecessary, the requirements for patentability being stated in sections 101, 102 and 103.

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### SECTION 132—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 51 (R. S. 4903, amended Aug. 5, 1939, ch. 452, § 1, 53 Stat. 1213).

The first paragraph of the corresponding section of existing statute is revised in language and amplified to incorporate present practice; the second paragraph of the existing statute is placed in section 135.

The last sentence relating to new matter is added but represents no departure from present practice.

### SECTION 133—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 37 (R. S. 4894, amended (1) Mar. 3, 1897, ch. 391, § 4, 29 Stat. 692, 693, (2) July 6, 1916, ch. 225, § 1, 39 Stat. 345, 347–8, (3) Mar. 2, 1927, ch. 273, § 1, 44 Stat. 1335, (4) Aug. 7, 1939, ch. 568, 53 Stat. 1264).

The opening clause of the corresponding section of existing statute is omitted as having no present day meaning or value and the last two sentences are omitted for inclusion in section 267. The notice is stated as given or mailed. Language is revised.

### SECTION 134—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 57 (R. S. 4909 amended (1) Mar. 2, 1927, ch. 273, § 5, 44 Stat. 1335, 1336, (2) Aug. 5, 1939, ch. 451, § 2, 53 Stat. 1212).

Reference to reissues is omitted in view of the general provision in section 251. Minor changes in language are made.

### SECTION 135—SECTION REVISED

The first paragraph is based on title 35, U. S. C., 1946 ed., § 52 (R. S. 4904 amended (1) Mar. 2, 1927, ch. 273, § 4, 44 Stat. 1335, 1336, (2) Aug. 5, 1939, ch. 451, § 1, 53 Stat. 1212).

The first paragraph states the existing corresponding statute with a few changes in language. An explicit statement that the Office decision on priority constitutes a final refusal by the Office of the claims involved, is added. The last sentence is new and provides that judgment adverse to a patentee constitutes cancellation of the claims of the patent involved after the judgment has become final, the patentee has a right of appeal (sec. 141) and is given a right of review by civil action (sec. 146).

The second paragraph is based on title 35, U. S. C., 1946 ed., § 51, (R. S. 4903, amended Aug. 5, 1939, ch. 452, § 1, 53 Stat. 1213). Changes in language are made.

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## CHAPTER 13. REVIEW OF PATENT OFFICE DECISIONS

Sec.

141. Appeal to Court of Customs and Patent Appeals.
142. Notice of appeal.
143. Proceedings on appeal.
144. Decision on appeal.
145. Civil action to obtain patent.
146. Civil action in case of interference.

### Section 141—Section Revised

Based on title 35, U. S. C., 1946 ed., § 59a (R. S. 4911, amended (1) Mar. 2, 1927, ch. 273, § 8, 44 Stat. 1336, (2) Mar. 2, 1929, ch. 4888, § 2a, 45 Stat. 1476, (3) Aug. 5, 1939, ch. 451, § 3, 53 Stat. 1212).

Changes in language are made.

### Section 142—Section Revised

Based on title 35, U. S. C., 1946 ed., § 60 (R. S. 4912 amended (1) Mar. 2, 1927, ch. 273, § 9, 44 Stat. 1336 (2) Mar. 2, 1929, ch. 4888, § 2 (b), 45 Stat. 1476).

Changes in language are made.

### Section 143—Section Revised

Based on title 35, U. S. C., 1946 ed., § 61 (R. S. 4913, amended Mar. 2, 1927, ch. 273, § 10, 44 Stat. 1336).

Language is changed. The requirement that the Commissioner notify the parties is omitted and a requirement that the court notify the parties is added. The statement relating to filing the papers and testimony is made more explicit.

### Section 144—Section Revised

Based on title 35, U. S. C., 1946 ed., § 62 (R. S. 4914).

Language is changed and the last sentence of the corresponding section of existing statute omitted as superfluous; such a sentence does not appear in the present civil action section, 35 U. S. C. 63 and in either case the validity of the patent may be questioned.

### Section 145—Section Revised

Based on title 35, U. S. C., 1946 ed., § 63 (R. S. 4915, amended (1) Mar. 2, 1927, ch. 273, § 11, 44 Stat. 1336, (2) Mar. 2, 1929, ch. 488, § 2 (b), 45 Stat. 1476, (3) Aug. 5, 1939, ch. 451, § 4, 53 Stat. 1212).

Bill in equity is changed to civil action and the section is restricted to exclude interferences which are covered by the next section. The time for filing the action is changed to the same as the time for appeal. The requirement for the applicant to file a copy of the decision in the Patent Office is omitted. Language is changed.

### Section 146—Section Revised

The first paragraph and parts of the second paragraph are based on title 35, U. S. C., 1946 ed., § 63 (R. S. 4915, amended (1) Mar. 2, 1927, ch. 273, § 11, 44 Stat. 1336, (2) Mar. 2, 1929, ch. 488, § 2 (b),

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45 Stat. 1476, (3) Aug. 5, 1939, ch. 451, § 4, 53 Stat. 1212), limited to interferences and making some changes. The action is not restricted to applicants, but a patentee may also bring the action. The time for bringing the action is made the same as for appeals.

In the second paragraph the first sentence is new and eliminates difficulties arising from unrecorded interests.

The second sentence is based on 35 U. S. C., 1946 ed., § 72a (Mar. 3, 1927, ch. 364, 44 Stat. 1394, reenacted Oct. 31, 1951, ch. 655, § 53a, 65 Stat. 728) with changes in language.

The fourth sentence is new and prevents such suits from being filed against the Commissioner as a defendant; however, the Commissioner has the right to intervene.

Language is changed.

## CHAPTER 14. ISSUE OF PATENT

Sec.
151. Time of issue of patent.
152. Issue of patent to assignee.
153. How issued.
154. Contents and term of patent.

### Section 151—Section Revised

Based on title 35, U. S. C., 1946 ed., § 41 (R. S. 4885, amended (1) May 23, 1908, ch. 189, 35 Stat. 246, (2) Aug. 9, 1939, § 2, ch. 619, 53 Stat. 1293).

Language is changed.

### Section 152—Section Revised

Based on title 35, U. S. C., 1946 ed., § 44 (R. S. 4895).

Language is changed and the reference to reissues is omitted in view of the general provision in section 201.

### Section 153—Section Revised

Based on title 35, U. S. C., 1946 ed., § 39 (R. S. 4883, amended (1) Feb. 18, 1888, ch. 15, 25 Stat. 40, (2) April 11, 1903, ch. 417, 32 Stat. 95, (3) Feb. 18, 1922, ch. 58, § 5, 42 Stat. 391).

The phrases referring to the attesting officers and to the recording of the patents are broadened.

### Section 154—Section Revised

Based on title 35, U. S. C., 1946 ed., § 40 (R. S. 4884, amended May 23, 1930, ch. 312, § 1, 46 Stat. 376).

The reference to plants is omitted for inclusion in another section and the reference to the title is shortened since the title is of no legal significance.

The wording of the granting clause is changed to "the right to exclude others from making, using, or selling", following language used by the Supreme Court, to render the meaning clearer.

"United States" is defined in section 100.

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## CHAPTER 15. PLANT PATENTS

Sec.
161. Patents for plants.
162. Description, claim.
163. Grant.
164. Assistance of Department of Agriculture.

### SECTION 161—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 31, part (R. S. 4886, amended (1) Mar. 3, 1897, ch. 391, § 1, 29 Stat. 692, (2) May 23, 1930, ch. 312, § 1, 46 Stat. 376, (3) Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212).

The provision relating to plants in the corresponding section of existing statute is made a separate section.

### SECTION 162—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 33, part (R. S. 4888, amended (1) Mar. 3, 1915, ch. 94, § 1, 38 Stat. 958, (2) May 23, 1930, ch. 312, § 2, 46 Stat. 376).

The first paragraph is the provision in R. S. 4888 (see section 112). The second paragraph is not in the statute but represents the actual practice.

### SECTION 163—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 40, part (R. S. 4884, amended May 23, 1930, ch. 312, § 1, 46 Stat. 376).

This provision is from R. S. 4884 (see section 154) amended in language.

### SECTION 164—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 56a (May 23, 1930, ch. 312, § 4, 46 Stat. 376).

Language is changed.

## CHAPTER 16. DESIGNS

Sec.
171. Patents for designs.
172. Right of priority.
173. Term of design patent.

### SECTION 171—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 73 (R. S. 4929, amended (1) May 9, 1902, ch. 783, 32 Stat. 193, (2) Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212; R. S. 4933).

The list of conditions specified in the corresponding section of existing statute is omitted as unnecessary in view of the general inclusion of all conditions applying to other patents. Language is changed.

### SECTION 172—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 32, part (R. S. 4887, amended (1) Mar. 3, 1903, ch. 1019, § 1, 32 Stat. 1225, 1226, (2) June 19, 1936, ch. 594, 49 Stat. 1529, (3) Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212).

This provision is taken from R. S. 4887 (see section 119) and made a separate section.

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SECTION 173—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 77 (R. S. 4931).
Language is changed slightly.

## CHAPTER 17. SECRECY OF CERTAIN INVENTIONS AND FILING APPLICATIONS IN FOREIGN COUNTRY

Sec.
181. Secrecy of certain inventions and withholding of patent.
182. Abandonment of invention for unauthorized disclosure.
183. Right of compensation.
184. Filing of application in foreign country.
185. Patent barred for filing without license.
186. Penalty.
187. Nonapplicability to certain persons.
188. Rules and regulations, delegation of power.

SECTION 181—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 151 (Feb. 1, 1952, ch. 4, § 1, 66 Stat. 3, 4).
Language is changed.

SECTION 182—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 152 (Feb. 1, 1952, ch. 4, § 2, 66 Stat. 4).
Language is changed.

SECTION 183—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 153 (Feb. 1, 1952, ch. 4, § 3, 66 Stat. 4, 5).
Language is changed.

SECTION 184—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 154 (Feb. 1, 1952, ch. 4, § 4, 66 Stat. 5).
Language is changed.

SECTION 185—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 155 (Feb. 1, 1952, ch. 4, § 5, 66 Stat. 5).
Language is changed.

SECTION 186—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 156 (Feb. 1, 1952, ch. 4, § 6, 66 Stat. 5, 6).
Language is changed.

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### SECTION 187—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 157 (Feb. 1, 1952, ch. 4, § 7, 66 Stat. 6).

Language is changed.

### SECTION 188—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 158 (Feb. 1, 1952, ch. 4, § 8, 66 Stat. 6).

Language is changed.

## PART III. PATENTS AND PROTECTION OF PATENT RIGHTS


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## CHAPTER 25. AMENDMENT AND CORRECTION OF PATENTS


Sec.
251. Reissue of defective patents.
252. Effect of reissue.
253. Disclaimer.
254. Certificate of correction of Patent Office mistake.
255. Certificate of correction of applicant's mistake.
256. Misjoinder of inventor.


### SECTION 251—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 64 (R. S. 4916, amended May 24, 1928, ch. 730, 45 Stat. 732.)

The sentences of the corresponding section of existing statute are rearranged and divided into two sections with some changes in language. The clause at the end of the present statute is omitted as obsolete.

The third paragraph incorporates by reference the requirements of other applications, and adds a new provision relating to application for reissue being made in certain cases by the assignee.

A two year period of limitation on applying for broadened reissues is added, codifying the present rule of decision with a fixed period.

### SECTION 252—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 64 (R. S. 4916, amended May 24, 1928, ch. 730, 45 Stat. 732.)

The first paragraph follows the present section with some rearrangement in language. The second paragraph adds new provisions for the protection of intervening rights, the court is given discretion to protect legitimate activities which would be adversely affected by the grant of a reissue and things made before the grant of the reissue are not subject to the reissue unless a claim of the original patent which is repeated in the reissue is infringed.

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### Section 253—Section Revised

Based on title 35, U. S. C., 1946 ed., § 65 (R. S. 4917).

Language is changed and substantive changes are introduced; (1) only a claim as a whole may be disclaimed, and (2) the provision regarding delay is omitted. See preliminary general description of bill.

See section 288.

The second paragraph is new and provides for the disclaiming or dedication of an entire patent, or any terminal part of the term, for example, a patentee may disclaim the last three years of the term of his patent.

### Section 254—Section Revised

Based on title 35, U. S. C., 1946 ed., § 88 (Mar. 4, 1925, ch. 535, § 1, 43 Stat. 1268).

The last sentence of the present section is omitted as obsolete. A sentence is added similar to a provision in the corresponding section in the trade-mark law, 15 U. S. C., 1946 ed., § 1057 (f), and provides that the Commissioner may issue a corrected patent instead of a certificate of correction.

### Section 255—New Section

This section providing for the correction of minor clerical errors made by the applicant, is new and follows a similar provision in the trade-mark law, 15 U. S. C., 1946 ed., § 1057 (g).

### Section 256—New Section

This section is new and is companion to section 116.

The first two paragraphs provide for the correction of the inadvertent joining or nonjoining of a person as a joint inventor. The third paragraph provides that a patent shall not be invalid for such cause, and also provides that a court may order correction of a patent; the two sentences of this paragraph are independent.

## CHAPTER 26. OWNERSHIP AND ASSIGNMENT

Sec.

261. Ownership; assignment.
262. Joint owners.

### Section 261—Section Revised

Based on title 35, U. S. C., 1946 ed., § 47 (R. S. 4898, amended (1) Mar. 3, 1897, ch. 391, § 5, 29 Stat. 93, (2) Feb. 18, 1922, ch. 58, § 6, 42 Stat. 391, (3) Aug. 18, 1941, ch. 370, 55 Stat. 634).

The first paragraph is new but is declaratory only. The second paragraph is the same as in the corresponding section of existing statute. The third paragraph is from the existing statute, a specific reference to another statute is omitted. The fourth paragraph is the same as the existing statute but language has been changed.

### Section 262—New Section

This section states a condition in existing law not expressed in the existing statutes.

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## CHAPTER 27. GOVERNMENT INTERESTS IN PATENTS

Sec.
266. Issue of patents without fees to Government employees.
267. Time for taking action in Government applications.

### Section 266—Section Revised

Based on title 35, U. S. C., 1946 ed., § 45 (Mar. 3, 1883, ch. 143, 22 Stat. 625, amended April 30, 1928, ch. 460, 45 Stat. 467).

Changes in language are made. The omission of the specific reference to 35 U. S. C., 1946 ed., § 31, (R. S. 4886) broadens the section so as to include design patents.

### Section 267—Section Revised

Based on title 35, U. S. C. 1946 ed., § 37 (R. S. 4894, amended (1) Mar. 3, 1897, ch. 391, § 4, 29 Stat. 692, 693, (2) July 6, 1916, ch. 225, § 1, 39 Stat. 345, 347–8, (3) Mar. 2, 1927, ch. 273, § 1, 44 Stat. 1335, (4) Aug. 7, 1939, ch. 568, 53 Stat. 1264).

This provision, which appears as the last two sentences of the corresponding section of the present statute (see note to section 133) is made a separate section and rewritten in simpler form.

## CHAPTER 28. INFRINGEMENT OF PATENTS

Sec.
271. Infringement of patent.
272. Temporary presence in the United States.

### Section 271—New Section

The first paragraph of this section is declaratory only, defining infringement.

Paragraphs (b) and (c) define and limit contributory infringement of a patent and paragraph (d) is ancillary to these paragraphs, see preliminary general description of bill. One who actively induces infringement as by aiding and abetting the same is liable as an infringer, and so is one who sells a component part of a patented invention or material or apparatus for use therein knowing the same to be especially made or especially adapted for use in the infringement of the patent except in the case of a staple article or commodity of commerce having other uses. A patentee is not deemed to have misused his patent solely by reason of doing anything authorized by the section.

### Section 272—New Section

This section follows the requirement of the International Convention for the Protection of Industrial Property, to which the United States is a party, and also codifies the holding of the Supreme Court that use of a patented invention on board a foreign ship does not infringe a patent.

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# CHAPTER 29. REMEDIES FOR INFRINGEMENT OF PATENT, AND OTHER ACTIONS

Sec.
281. Remedy for infringement of patent.
282. Prosecution of validity; defenses.
283. Injunction.
284. Damages.
285. Attorney fees.
286. Time limitation on damages.
287. Limitation on damages; marking and notice.
288. Action for infringement of a patent containing an invalid claim.
289. Additional remedy for infringement of design patent.
290. Notice of patent suits.
291. Interfering patents.
292. False marking.
293. Nonresident patentee, service and notice.

## SECTION 281—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., §§ 67 and 70, part (R. S. 4919; R. S. 4921, amended (1) Mar. 3, 1897, ch. 391, § 6, 29 Stat. 694, (2) Feb. 18, 1922, ch. 58, § 8, 42 Stat. 392, (3) Aug. 1, 1946, ch. 726, § 1, 60 Stat. 778).

The corresponding two sections of existing law are divided among sections 281, 283, 284, 285, 286 and 289 with some changes in language. Section 241 serves as an introduction or preamble to the following sections, the modern term civil action is used, there would be, of course, a right to a jury trial when no injunction is sought.

## SECTION 282—SECTION REVISED

Derived from title 35, U. S. C., 1946 ed., § 69, (R. S. 4920, amended (1) Mar. 3, 1897, ch. 391, § 2, 29 Stat. 692, (2) Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212).

The first paragraph declares the existing presumption of validity of patents.

The five defenses named in R. S. 4920 are omitted and replaced by a broader paragraph specifying defenses in general terms.

The third paragraph, relating to notice of prior patents, publications and uses, is based on part of the last paragraph of R. S. 4920 which was superseded by the Federal Rules of Civil Procedure but which is reinstated with modifications.

## SECTION 283—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 70, part (R. S. 4921, amended (1) Mar. 3, 1897, ch. 391, § 6, 29 Stat. 694, (2) Feb. 18, 1922, ch. 58, § 8, 42 Stat. 392, (3) Aug. 1, 1946, ch. 726, § 1, 60 Stat. 778).

This section is the same as the provision which opens R. S. 4921 with minor changes in language.

## SECTION 284—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., §§ 67 and 70, part (R. S. 4919; R. S. 4921, amended (1) Mar. 3, 1897, ch. 391, § 6, 29 Stat. 694, (2) Feb. 18, 1922, ch. 58, § 8, 42 Stat. 392, (3) Aug. 1, 1946, ch. 726, § 1, 60 Stat. 778).

This section consolidates the provisions relating to damages in R. S. 4919 and 4921, with some changes in language.



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### SECTION 285—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 70, part (R. S. 4921, amended (1) Mar. 3, 1897, ch. 391, § 6, 29 Stat. 694, (2) Feb. 18, 1922, ch. 58, § 8, 42 Stat. 392, (3) Aug. 1, 1946, ch. 726, § 1, 60 Stat. 778).

This section is substantially the same as the corresponding provision in R. S. 4921; "in exceptional cases" has been added as expressing the intention of the present statute as shown by its legislative history and as interpreted by the courts.

### SECTION 286—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 70, part (R. S. 4921, amended (1) Mar. 3, 1897, ch. 391, § 6, 29 Stat. 694, (2) Feb. 18, 1922, ch. 58, § 8, 42 Stat. 392, (3) Aug. 1, 1946, ch. 726, § 1, 60 Stat. 778).

The first paragraph is the same as the provision in R. S. 4921 with minor changes in language, with the added provision relating to the date for counterclaims for infringement.

The second paragraph is new and relates to extending the period of limitations with respect to suits in the Court of Claims in certain instances when administrative consideration is pending.

### SECTION 287—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 49 (R. S. 4900, amended Feb. 7, 1927, ch. 67, 44 Stat. 1058).

Language is changed. The proviso in the corresponding section of existing statute is omitted as being temporary in character and now obsolete.

### SECTION 288—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 71 (R. S. 4922).

The necessity for a disclaimer to recover on valid claims is eliminated. See section 253.

Language is changed.

### SECTION 289—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., §§ 74, 75 (Feb. 4, 1887, ch. 105, §§ 1, 2, 24 Stat. 387, 388).

Language is changed.

### SECTION 290—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 70, part (R. S. 4921, amended (1) Mar. 3, 1897, ch. 391, § 6, 29 Stat. 694, (2) Feb. 18, 1922, ch. 58, § 8, 42 Stat. 392, (3) Aug. 1, 1946, ch. 726, § 1, 60 Stat. 778).

This is the last sentence of R. S. 4921, third paragraph, with minor changes in language.

### SECTION 291—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 66 (R. S. 4918, amended Mar. 2, 1927, ch. 273, § 12, 44 Stat. 1337).

Language is changed.

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### SECTION 292—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 50 (R. S. 4901).

This is a criminal provision. The first two paragraphs of the corresponding section of existing statute are consolidated, a new paragraph relating to false marking of "patent applied for" is added, and false advertising is included in all the offenses. The minimum fine, which has been interpreted by the courts as a maximum, is replaced by a higher maximum. The informer action is included as additional to an ordinary criminal action.

### SECTION 293—NEW SECTION

This section provides for service on non-resident patentees.

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## COMPLIANCE WITH RAMSEYER RULE

### 1. Text of Statutes for Repeal

In compliance with paragraph 2a (1) of rule XIII of the Rules of the House of Representatives, the text of the statutes or parts thereof which are proposed to be repealed by the bill are set out below.

The Revised Statutes, set out first, are in numerical order according to section number. The Statutes at Large which specifically amend a section of the Revised Statutes follow the particular Revised Statute section. The Statutes at Large which do not specifically amend any particular section of the Revised Statutes follow the Revised Statutes in chronological order.

The citation in the left-hand column of the headings identifies the text of the Revised Statutes or Statutes at Large which immediately follows that reference; that in the right-hand column refers to the section of proposed title 35, "Patents", of the United States Code, where similar subject matter will be found. The word "omitted" in the right-hand column of a heading indicates that the particular text of such statute was not incorporated in proposed title 35 because it was obsolete, executed, covered by other law, or superseded by later law. The specific reasons for omitting and repealing such statutes are given in the table of omitted laws elsewhere in this report.

### REVISED STATUTES

R. S. 475 ..... T. 35, § 1

There shall be in the Department of the Interior an office known as the Patent-Office, where all records, books, models, drawings, specifications, and other papers and things pertaining to patents shall be safely kept and preserved.

R. S. 476 ..... T. 35, § 3

There shall be in the Patent-Office a Commissioner of Patents, one Assistant Commissioner, and three examiners-in-chief, who shall be appointed by the President, by and with the advice and consent of the Senate. All other officers, clerks, and employees authorized by law for the Office shall be appointed by the Secretary of the Interior upon the nomination of the Commissioner of Patents.

As amended Feb. 15, 1916, ch. 22, § 1, 39 Stat. 8.

That section four hundred and seventy-six of the Revised Statutes be, and the same is hereby, amended to read as follows:

"Sec. 476. There shall be in the Patent Office a Commissioner of Patents, one first assistant commissioner, one assistant commissioner, and five examiners in chief, who shall be appointed by the President, by and with the advice and consent of the Senate. The first assistant commissioner and the assistant commissioner shall perform such duties pertaining to the office of commissioner as may be assigned to them, respectively, from time to time by the Commissioner of Patents. All other officers, clerks, and employees authorized by law for the office shall be appointed by the Secretary of the Interior upon the nomination of the Commissioner of Patents, in accordance with existing law."

As amended Feb. 14, 1927, ch. 139, § 1, 44 Stat. 1098.

That section 476 of the Revised Statutes be amended to read as follows:

"Sec. 476. There shall be in the Patent Office a Commissioner of Patents, one first assistant commissioner, one assistant commissioner, and six examiners in



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chief, who shall be appointed by the President, by and with the advice and consent of the Senate. The first assistant commissioner and the assistant commissioner shall perform such duties pertaining to the office of commissioner as may be assigned to them, respectively, from time to time by the Commissioner of Patents. All other officers, clerks, and employees authorized by law for the office shall be appointed by the Secretary of Commerce upon the nomination of the Commissioner of Patents, in accordance with existing law."

As amended April 11, 1930, ch. 132, § 1, 46 Stat. 155.

That section 476 of the Revised Statutes, as amended (United States Code, title 35, section 2), is amended to read as follows:

"SEC. 476. There shall be in the Patent-Office a Commissioner of Patents, one first assistant commissioner, two assistant commissioners, and nine examiners-in-chief, who shall be appointed by the President, by and with the advice and consent of the Senate. The first assistant commissioner and the assistant commissioners shall perform such duties pertaining to the office of commissioner as may be assigned to them, respectively, from time to time by the Commissioner of Patents. All other officers, clerks, and employees authorized by law for the office shall be appointed by the Secretary of Commerce upon the nomination of the Commissioner of Patents, in accordance with existing law."

R. S. 478 ..... T. 35, § 2

The seal heretofore provided for the Patent-Office shall be the seal of the Office, with which letters-patent and papers issued from the Office shall be authenticated.

R. S. 479 ..... T. 35, § 5

The Commissioner of Patents and the chief clerk, before entering upon their duties, shall severally give bond, with sureties, to the Treasurer of the United States, the former in the sum of ten thousand dollars, and the latter in the sum of five thousand dollars, conditioned for the faithful discharge of their respective duties, and that they shall render to the proper officers of the Treasury a true account of all money received by virtue of their offices.

R. S. 480 ..... T. 35, § 4

All officers and employes of the Patent-Office shall be incapable, during the period for which they hold their appointments, to acquire or take, directly or indirectly, except by inheritance or bequest, any right or interest in any patent issued by the Office.

R. S. 481 ..... T. 35, § 6

The Commissioner of Patents, under the direction of the Secretary of the Interior, shall superintend or perform all duties respecting the granting and issuing of patents directed by law; and he shall have charge of all books, records, papers, models, machines, and other things belonging to the Patent-Office.

R. S. 482 ..... T. 35, § 7

The examiners-in-chief shall be persons of competent legal knowledge and scientific ability, whose duty it shall be, on written petition of the appellant, to revise and determine upon the validity of the adverse decisions of examiners upon applications for patents, and for re-issues of patents, and in interference cases; and, when required by the Commissioner, they shall hear and report upon claims for extensions, and perform such other like duties as he may assign them.

As amended Mar. 2, 1927, ch. 273, § 3, 44 Stat. 1335.

SEC. 3. That section 482 of the Revised Statutes of the United States be amended to read as follows:

"SEC. 482. The examiners-in-chief shall be persons of competent legal knowledge and scientific ability. The Commissioner of Patents, the first assistant commissioner, the assistant commissioner, and the examiners in chief shall constitute a board of appeals, whose duty it shall be, on written petition of the appellant, to review and determine upon the validity of the adverse decisions of examiners upon applications for patents and for reissues of patents and in interference cases. Each appeal shall be heard by at least three members of the board of appeals, the members hearing such appeal to be designated by the commissioner. The board of appeals shall have sole power to grant rehearings."

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As amended Apr. 11, 1930, ch. 132, § 2, 46 Stat. 155.

SEC. 2. Section 482 of the Revised Statutes as amended (United States Code, title 35, section 7) is hereby amended by substituting the words "assistant commissioners" for the words "assistant commissioner," in conformity with the provisions of section 1 of this bill.

As amended Mar. 4, 1950, ch. 50, 64 Stat. 11.

That section 482 of the Revised Statutes (35 U. S. C. 7) is amended by adding the following paragraph:

"The Commissioner, when in his discretion considered necessary to maintain the work of the board of appeals current, may designate any examiner of the primary examiner grade or higher, having the requisite ability, to serve as examiner in chief for periods not exceeding six months each, and any examiner so designated shall be qualified to act as a member of the board of appeals. Not more than one primary examiner shall be among the members of the board of appeals hearing an appeal."

R. S. 483 ---------- T. 35, § 6

The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent-Office.

R. S. 486 ---------- T. 35, § 8

There shall be purchased for the use of the Patent-Office a library of such scientific works and periodicals, both foreign and American, as may aid the officers in the discharge of their duties, not exceeding the amount annually appropriated for that purpose.

R. S. 487 ---------- T. 35, §§ 31, 32

For gross misconduct the Commissioner of Patents may refuse to recognize any person as a patent-agent, either generally or in any particular case; but the reasons for such refusal shall be duly recorded, and be subject to the approval of the Secretary of the Interior.

As amended Feb. 18, 1922, ch. 58, § 3, 42 Stat. 390.

SEC. 3. That section 487 of the Revised Statutes be, and the same is hereby, amended to read as follows:

"SEC. 487. The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may prescribe rules and regulations governing the recognition of agents, attorneys, or other persons representing applicants or other parties before his office, and he may require of such persons, agents, or attorneys, before being recognized as representatives of applicants or other persons, that they shall show that they are of good moral character and in good repute, are possessed of the necessary qualifications to enable them to render to applicants or other persons valuable service, and are likewise competent to advise and assist applicants or other persons in the presentation or prosecution of their applications or other business before the office. And the Commissioner of Patents may, after notice and opportunity for a hearing, suspend or exclude, either generally or in any particular case, from further practice before his office any person, agent, or attorney shown to be incompetent or disreputable, or guilty of gross misconduct, or who refuses to comply with the said rules and regulations, or who shall, with intent to defraud in any manner, deceive, mislead, or threaten any applicant or prospective applicant, or other person having immediate or prospective business before the office, by word, circular, letter, or by advertising. The reasons for any such suspension or exclusion shall be duly recorded. And the action of the commissioner may be reviewed upon the petition of the person so refused recognition or so suspended or excluded by the Supreme Court of the District of Columbia under such conditions and upon such proceedings as the said court may by its rules determine."

R. S. 488 ---------- T. 35, § 22

The Commissioner of Patents may require all papers filed in the Patent-Office, if not correctly, legibly, and clearly written, to be printed at the cost of the party filing them.

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R. S. 489 ---------- T. 35, § 11

The Commissioner of Patents may print, or cause to be printed, copies of the claims of current issues, and copies of such laws, decisions, regulations, and circulars as may be necessary for the information of the public.

R. S. 493 ---------- T. 35, § 41

The price to be paid for uncertified printed copies of specifications and drawings of patents shall be determined by the Commissioner of Patents, within the limits of ten cents as the minimum and fifty cents as the maximum price.

As amended May 19, 1896, ch. 204, 29 Stat. 124.

That section four hundred and ninety-three of the Revised Statutes be, and the same hereby is, amended by striking out the words" within the limits of ten cents as the minimum and fifty cents as the maximum price," in lines three and four, and substituting in lieu thereof, "*Provided*, That the maximum cost of a copy shall be ten cents," so that the section so amended shall read as follows:

"SEC. 493. The price to be paid for uncertified printed copies of specifications and drawings of patents shall be determined by the Commissioner of Patents: *Provided*, That the maximum cost of a copy shall be ten cents."

R. S. 494 ---------- T. 35, § 14

The Commissioner of Patents shall lay before Congress, in the month of January, annually, a report, giving a detailed statement of all moneys received for patents, for copies of records or drawings, or from any other source whatever; a detailed statement of all expenditures for contingent and miscellaneous expenses; a list of all patents which were granted during the preceding year, designating under proper heads the subjects of such patents; an alphabetical list of all the patentees, with their places of residence; a list of all patents which have been extended during the year; and such other information of the condition of the Patent-Office as may be useful to Congress or the public.

R. S. 496 ---------- Omitted

All disbursements for the Patent-Office shall be made by the disbursing clerk of the Interior Department.

R. S. 4883 ---------- T. 35, § 153

All patents shall be issued in the name of the United States of America, under the seal of the Patent-Office, and shall be signed by the Secretary of the Interior and countersigned by the Commissioner of Patents, and they shall be recorded, together with the specifications, in the Patent-Office, in books to be kept for that purpose.

As amended Feb. 18, 1888, ch. 15, 25 Stat. 40.

That section four thousand eight hundred and eighty-three of the Revised Statutes is hereby amended by inserting after the words "Secretary of the Interior," where they occur therein, the following words: "or under his direction by one of the Assistant Secretaries of the Interior," so that the said section as amended will read as follows:

"*SECTION 4883*. All patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Secretary of the Interior or under his direction by one of the Assistant Secretaries of the Interior, and counter-signed by the Commissioner of Patents, and they shall be recorded, together with the specifications, in the Patent Office, in books to be kept for that purpose."

As amended Apr. 11, 1902, ch. 417, 32 Stat. 95.

That section forty-eight hundred and eighty-three of the Revised Statutes be, and is hereby, amended so as to read as follows:

"SEC. 4883. All patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Commissioner of Patents, and they shall be recorded, together with the specifications, in the Patent Office in books to be kept for that purpose."

As amended Feb. 18, 1922, ch. 58, sec. 5, 42 Stat. 391.

SEC. 5. That section 4883 of the Revised Statutes be, and the same is hereby, amended to read as follows:

SEC. 4883. All patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall either be signed, by the

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Commissioner of Patents or have his name printed thereon and attested by an Assistant Commissioner of Patents or by one of the law examiners duly designated by the commissioner, and shall be recorded, together with the specifications, in the Patent Office in books to be kept for that purpose."

R. S. 4884 ..... T. 35, §§ 154, 163

Every patent shall contain a short title or description of the invention or discovery, correctly indicating its nature and design, and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the exclusive right to make, use and vend the invention or discovery throughout the United States and the Territories thereof, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof.

As amended May 23, 1930, ch. 312, sec. 1, 46 Stat. 376.

That sections 4884 [and 4886] of the Revised Statutes, as amended (U. S. C., title 35, secs. 40 [and 31]), are amended to read as follows:

"SEC. 4884. Every patent shall contain a short title or description of the invention or discovery, correctly indicating its nature and design, and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the exclusive right to make, use, and vend the invention or discovery (including in the case of a plant patent the exclusive right to asexually reproduce the plant) throughout the United States and the Territories thereof, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof."

R. S. 4885 ..... T. 35, § 151

Every patent shall bear date as of a day not later than six months from the time at which it was passed and allowed and notice thereof was sent to the applicant or his agent; and if the final fee is not paid within that period the patent shall be withheld.

As amended May 23, 1908, ch. 189, 35 Stat. 246.

That section forty-eight hundred and eighty-five of the Revised Statutes be, and the same hereby is, amended to read as follows:

"SEC. 4885. Every patent shall issue within a period of three months from the date of the payment of the final fee, which fee shall be paid not later than six months from the time at which the application was passed and allowed and notice thereof was sent to the applicant or his agent; and if the final fee is not paid within that period the patent shall be withheld."

As amended Aug. 9, 1939, ch. 619, § 2, 53 Stat. 1293.

SEC. 2. That section 4885 of the Revised Statutes (U. S. C., title 35, sec. 41) be amended by adding at the end thereof the following: "*Provided, however*, That the Commissioner of Patents may in his discretion receive the final fee if paid within one year after the six months' period for payment has passed and the patent shall issue."

R. S. 4886 ..... T. 35, §§ 101, 102, 161

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 proceeding had, obtain a patent therefor.

As amended Mar. 3, 1897, ch. 391, § 1 29 Stat. 692.

That section forty-eight hundred and eighty-six of the Revised Statutes be, and the same hereby is, amended by inserting on line four, after the word "country," the words "before his invention or discovery thereof" and on line five after the word "thereof" the words "or more than two years prior to his application," so that the clause so amended will read as follows:

"SEC. 4886. Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, not known or used by others in this country, before his

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invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had obtain a patent therefor."

As amended May 23, 1930, ch. 312, sec. 1, 46 Stat. 376.

That sections [4884 and] 4886 of the Revised Statutes, as amended (U S. C., title 35, secs. [40 and] 31), are amended to read as follows:

"SEC. 4886. 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 or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant not known or used by others in this country, before his invention or discovery thereof and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."

As amended Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212.

That sections 4886, 4887, 4920, and 4929 of the Revised Statutes (U. S. C., title 35, secs. 31, 32, 69, and 73) be amended by striking out the words "two years" wherever they appear in said sections and substituting therefor the words "one year".

R. S. 4887 ..... T. 35, §§ 102 (d), 119

No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented in a foreign country, unless the same has been introduced into public use in the United States for more than two years prior to the application. But every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years.

As amended Mar. 3, 1897, ch. 391, § 3, 29 Stat. 693.

SEC. 3. That section forty-eight hundred and eighty-seven of the Revised Statutes be, and the same hereby is, amended by inserting on line one, after the words "no person," the words "otherwise entitled thereto," and on line three, after the words "caused to be patented," the words "by the inventor or his legal representatives or assigns," and by erasing therein all that portion of the section which follows the words "in a foreign country," on lines three and four, and substituting in lieu thereof the following: "unless the application for said foreign patent was filed more than seven months prior to the filing of the application in this country, in which case no patent shall be granted in this country" so that the section so amended will read as follows:

"SEC. 4887. No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than seven months prior to the filing of the application in this country, in which case no patent shall be granted in this country."

As amended Mar. 3, 1903, ch. 1019, § 1, 32 Stat. 1225.

That section forty-eight hundred and eighty-seven of the Revised Statutes is amended by changing the word "seven" to "twelve", and by inserting after the word "months" the words "in cases within the provisions of section forty-eight hundred and eighty-six of the Revised Statutes, and four months, in cases of designs," and by adding the following words: "An application for patent for an invention or discovery or for a design filed in this country by any person who has previously regularly filed an application for a patent for the same invention, discovery, or design in a foreign country which, by treaty, convention, or law, affords

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similar privileges to citizens of the United States shall have the same force and effect as the same application would have if filed in this country on the date on which the application for patent for the same invention, discovery, or design was first filed in such foreign country, provided the application in this country is filed within twelve months in cases within the provisions of section forty-eight hundred and eighty-six of the Revised Statutes, and within four months in cases of designs, from the earliest date on which any such foreign application was filed. But no patent shall be granted on an application for patent for an invention or discovery or a design which had been patented or described in a printed publication in this or any foreign country more than two years before the date of the actual filing of the application in this country, or which had been in public use, or on sale in this country for more than two years prior to such filing;" so that the section so amended shall read:

"SEC. 4887. No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than twelve months, in cases within the provisions of section forty-eight hundred and eighty-six of the Revised Statutes, and four months in cases of designs, prior to the filing of the application in this country, in which case no patent shall be granted in this country.

"An application for patent for an invention or discovery or for a design filed in this country by any person who has previously regularly filed an application for a patent for the same invention, discovery or design in a foreign country which, by treaty, convention, or law, affords similar privileges to citizens of the United States shall have the same force and effect as the same application would have if filed in this country on the date on which the application for patent for the same invention, discovery, or design was first filed in such foreign country, provided the application in this country is filed within twelve months in cases within the provisions of section forty-eight hundred and eighty-six of the Revised Statutes, and within four months in cases of designs, from the earliest date on which any such foreign application was filed. But no patent shall be granted on an application for patent for an invention or discovery or a design which had been patented or described in a printed publication in this or any foreign country more than two years before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country for more than two years prior to such filing."

As amended June 19, 1936, ch. 594, 49 Stat. 1529.

That section 4887 of the Revised Statutes (U. S. C., title 35, sec. 32) be amended to read as follows:

"No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than twelve months, in cases within the provisions of section 4886 of the Revised Statutes, and six months in cases of designs, prior to the filing of the application in this country, in which case no patent shall be granted in this country.

"An application for patent for an invention or discovery or for a design filed in this country by any person who has previously regularly filed an application for a patent for the same invention, discovery, or design in a foreign country which, by treaty, convention, or law, affords similar privileges to citizens of the United States shall have the same force and effect as the same application would have if filed in this country on the date on which the application for patent for the same invention, discovery, or design was first filed in such foreign country: *Provided*, That the application in this country is filed within twelve months in cases within the provisions of section 4886 of the Revised Statutes, and within six months in cases of designs, from the earliest date on which any such foreign application was filed. But no patent shall be granted on any application for patent for an invention or discovery or a design which had been patented or described in a printed publication in this or any foreign country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country for more than one year prior to such filing."

As amended Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212.

That sections 4886, 4887, 4920, and 4929 of the Revised Statutes (U. S. C., title 35, secs. 31, 32, 69, and 73) be amended by striking out the words "two

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years" wherever they appear in said sections and substituting therefor the words "one year".

R. S. 4888 ..... T. 35, §§ 111, 112, 162

Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent-Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor and attested by two witnesses.

As amended Mar. 3, 1915, ch. 94, § 1, 38 Stat. 958.

That section forty-eight hundred and eighty-eight of the Revised Statutes of the United States be, and the same is hereby, amended by striking out from the last clause thereof the words "and attested by two witnesses," so that the section so amended will read as follows:

"SEC. 4888 Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent-Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor."

As amended May 23, 1930, ch. 312, § 2, 46 Stat. 376.

SEC. 2. Section 4888 of the Revised Statutes, as amended (U. S. C., title 35, sec. 33), is amended by adding at the end thereof the following sentence: "No plant patent shall be declared invalid on the ground of noncompliance with this section if the description is made as complete as is reasonably possible."

R. S. 4889 ..... T. 35, § 113

When the nature of the case admits of drawings, the applicant shall furnish one copy signed by the inventor or his attorney in fact, and attested by two witnesses, which shall be filed in the Patent Office; and a copy of the drawing to be furnished by the Patent Office, shall be attached to the patent as a part of the specification.

As amended Mar. 3, 1915, ch. 94, § 2, 38 Stat. 959.

SEC. 2. That section forty-eight hundred and eighty-nine of the Revised Statutes of the United States be, and the same is hereby, amended by striking out the words "and attested by two witnesses," so that the section so amended will read as follows:

"SEC. 4889. When the nature of the case admits of drawings, the applicant shall furnish one copy signed by the inventor or his attorney in fact, which shall be filed in the Patent Office; and a copy of the drawing to be furnished by the Patent Office, shall be attached to the patent as a part of the specification."

R. S. 4890 ..... T. 35, § 114

When the invention or discovery is of a composition of matter, the applicant, if required by the commissioner, shall furnish specimens of ingredients and of the composition, sufficient in quantity for the purpose of experiment.

R. S. 4891 ..... T. 35, § 114

In all cases which admit of representation by model, the applicant, if required by the commissioner, shall furnish a model of convenient size to exhibit advantageously the several parts of his invention or discovery.

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R. S. 4892 ..... T. 35, § 115

The applicant shall make oath that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement for which he solicits a patent; that he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, charge d'affaires, consul, or commercial agent, holding commission under the Government of the United States, or before any notary public of the foreign country in which the applicant may be.

As amended Mar. 3, 1903, ch. 1019, § 2, 32 Stat. 1226.

SEC. 2. That section forty-eight hundred and ninety-two of the Revised Statutes is amended by inserting after the words "notary public" the words "judge or magistrate having an official seal and authorized to administer oaths," and by adding at the end thereof the words "whose authority shall be proved by certificate of a diplomatic or consular officer of the United States;" so that the section so amended shall read:

"SEC. 4892. The applicant shall make oath that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition. or improvement for which he solicits a patent; that he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, charge d'affaires, or consul holding commission under the Government of the United States, or before any notary public, judge, or magistrate having any official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by certificate of a diplomatic or consular officer of the United States."

As amended May 23, 1930, ch. 312, § 3, 46 Stat. 376.

SEC. 3. The first sentence of section 4892 of the Revised Statutes, as amended (U. S. C., title 35, sec. 35), is amended to read as follows:

"SEC. 4892. The applicant shall make oath that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement, or of the variety of plant, for whic he solicits a patent; that he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen."

R. S. 4893 ..... T. 35, § 131

On the filing of any such application and the payment of the fees required by law, the Commissioner of Patents shall cause an examination to be made of the alleged new invention or discovery; and, if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the commissioner shall issue a patent therefor.

R. S. 4894 ..... T. 35, §§ 133, 267

All applications for patents shall be completed and prepared for examination within two years after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same within two years after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable.

As amended Mar. 3, 1897, ch. 391, § 4, 29 Stat. 693.

SEC. 4. That section forty-eight hundred and ninety-four of the Revised Statutes be, and the same hereby is, amended by striking out the words "two years" in every place where they occur and substituting in lieu thereof the words "one year," so that the section so amended will read as follows:

"Sec. 4894. All applications for patents shall be completed and prepared for examination within one year after the filing of the application and in default thereof, or upon failure of the applicant to prosecute the same within one year after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable.

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As amended July 6, 1916, ch. 225, § 1 (part), 39 Stat. 348.

Section forty-eight hundred and ninety-four of the Revised Statutes is amended so as to read as follows:

"SEC. 4894. All applications for patents shall be completed and prepared for examination within one year after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same within one year after any action therein of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable: *Provided, however* That no application shall be regarded as abandoned which has become the property of the Government of the United States and with respect to which the head of any department of the Government shall have certified to the Commissioner of Patents, within a period of three years, that the invention disclosed therein is important to the armament or defense of the United States: *Provided further*, That within ninety days, and not less than thirty days, before the expiration of any such three-year period the Commissioner of Patents shall, in writing, notify the head of the department interested in any pending application for patent, of the approaching expiration of the three-year period within which any application for patent shall have been pending."

As amended Mar. 2, 1927, ch. 273, 1, 44 Stat. 1335

That section 4894 of the Revised Statutes of the United States be amended by striking out the words "one year" wherever they appear and substituting therefor the words "six months."

As amended Aug. 7, 1939, ch. 568, 53 Stat. 1264

That section 4894 of the Revised Statutes (U. S. C., title 35, sec. 37) be amended by inserting after "six months", second occurrence, the words "or such shorter time, not less than thirty days or any extensions thereof, as shall be fixed by the Commissioner of Patents in writing to the applicant."

R. S. 4895 ..... T. 35, § 152

Patents may be granted and issued or reissued to the assignee of the inventor or discoverer; but the assignment must first be entered of record in the Patent Office. And in all cases of an application by an assignee for the issue of a patent, the application shall be made and the specification sworn to by the inventor or discoverer; and in all cases of an application for a reissue of any patent, the application must be made and the corrected specification signed by the inventor or discoverer, if he is living, unless the patent was issued and assignment made before the eighth day of July, eighteen hundred and seventy.

R. S. 4896 ..... T. 35, § 117

When any person, having made any new invention or discovery for which a patent might have been granted, dies before a patent is granted, the right of applying for and obtaining the patent shall devolve on his executor or administrator, in trust for the heirs at law of the deceased, in case he shall have died intestate; or if he shall have left a will, disposing of the same, then in trust for his devisees, in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him in his life time; and when the application is made by such legal representatives, the oath or affirmation required to be made shall be so varied in form that it can be made by them.

As amended Feb. 28, 1899, ch. 227, 30 Stat. 915

That section forty-eight hundred and ninety-six of the Revised Statutes is hereby amended by inserting after the words "in his lifetime" the following words: "and when any person having made any new invention or discovery for which a patent might have been granted becomes insane before a patent is granted, the right of applying for and obtaining the patent shall devolve upon his legally appointed guardian, conservator, or representative in trust for his estate, in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him while sane;" and by inserting at the end of said section the following words: "The foregoing section, as to insane persons, is to cover all applications now on file in the Patent Office or which may be hereafter made," so that the said section as amended will read as follows:

"SEC. 4896. When any person, having made any new invention or discovery for which a patent might have been granted, dies before a patent is granted, the right of applying for and obtaining the patent shall devolve upon his executor or administrator, in trust for the heirs at law of the deceased, in case he shall have died

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intestate; or if he shall have left a will, disposing of the same, then in trust for his devisees in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him in his lifetime; and when any person having made any new invention or discovery for which a patent might have been granted becomes insane before a patent is granted, the right of applying for and obtaining the patent shall devolve on his legally appointed guardian, conservator, or representative in trust for his estate, in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him while sane; and when the application is made by such legal representatives, the oath or affirmation required to be made shall be so varied in form that it can be made by them.

"The foregoing section, as to insane persons, is to cover all applications now on file in the Patent Office or which may be hereafter made."

As amended Mar. 3. 1903, ch. 1019, § 3, 32 Stat. 1226–7

SEC. 3. That section forty-eight hundred and ninety-six of the Revised Statutes is amended by adding thereto the following sentence: "The executor or administrator duly authorized under the law of any foreign country to administer upon the estate of the deceased inventor shall, in case the said inventor was not domiciled in the United States at the time of his death, have the right to apply for and obtain the patent. The authority of such foreign executor or administrator shall be proved by certificate of a diplomatic or consular officer of the United States;" so that the section so amended shall read as follows:

"SEC. 4896. When any person, having made any new invention or discovery for which a patent might have been granted, dies before a patent is granted, the right of applying for and obtaining the patent shall devolve on his executor or administrator, in trust for the heirs at law of the decreased, in case he shall have died intestate; or if he shall have left a will disposing of the same, then in trust for his devisees, in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him in his lifetime; and when the application is made by such legal representatives, the oath or affirmation required to be made shall be so varied in form that it can be made by them. The executor or administrator duly authorized under the law of any foreign country to administer upon the estate of the deceased inventor shall, in case the said inventor was not domiciled in the United States at the time of his death, have the right to apply for and obtain the patent. The authority of such foreign executor or administrator shall be proved by certificate of a diplomatic or consular officer of the United States."

As amended May 23, 1908, ch. 188, 35 Stat. 245

That section forty-eight hundred and ninety-six of the Revised Statutes be, and the same is hereby, amended so that the section shall read as follows:

"SEC. 4896. When any person, having made any new invention or discovery for which a patent might have been granted, dies before a patent is granted the right of applying for and obtaining the patent shall devolve on his executor or administrator, in trust for the heirs at law of the deceased, in case he shall have died intestate; or if he shall have left a will disposing of the same, then in trust for his devisees in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him in his lifetime; and when any person having made any new invention or discovery for which a patent might have been granted becomes insane before a patent is granted the right of applying for and obtaining the patent shall devolve on his legally appointed guardian, conservator, or representative in trust for his estate in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him while sane; and when the application is made by such legal representatives the oath or affirmation required to be made shall be so varied in form that it can be made by them. The executor or administrator duly authorized under the law of any foreign country to administer upon the estate of the deceased inventor shall, in case the said inventor was not domiciled in the United States at the time of his death, have the right to apply for and obtain the patent. The authority of such foreign executor or administrator shall be proved by certificate of a diplomatic or consular officer of the United States.

"The foregoing section, as to insane persons, is to cover all applications now on file in the Patent Office or which may be hereafter made."

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R. S. 4898 ---------- T. 35, § 261

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 mortgage for a valuable consideration, without notice, unless it is recorded in the Patent-Office within three months from the date thereof.

As amended Mar. 3, 1897, ch. 391, § 5, 29 Stat. 693

SEC. 5. That section forty-eight hundred and ninety-eight of the Revised Statutes be, and the same hereby is, amended by adding thereto the following sentence:

"If any such assignment, grant, or conveyance of any patent shall be acknowledged before any notary public of the several States or Territories or the District of Columbia, or any commissioner of the United States circuit court, or before any secretary of legation or consular officer authorized to administer oaths or perform notarial acts under section seventeen hundred and fifty of the Revised Statutes, the certificate of such acknowledgment, under the hand and official seal of such notary or other officer, shall be prima facie evidence of the execution of such assignment, grant, or conveyance," so that the section so amended will read as follows:

"SEC. 4898. 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 hereof.

"If any such assignment, grant, or conveyance of any patent shall be acknowledged before any notary public of the several States or Territories or the District of Columbia, or any commissioner of the United States circuit court, or before any secretary of legation or consular officer authorized to administer oaths or perform notarial acts under section seventeen hundred and fifty of the Revised Statutes, the certificate of such acknowledgment, under the hand and official seal of such notary or other officer, shall be prima facie evidence of the execution of such assignment, grant or conveyance."

As amended Feb. 18, 1922, ch. 58, § 6, 42 Stat. 391

SEC. 6. That section 4898 of the Revised Statutes be, and the same is hereby, amended to read as follows:

"SEC. 4898. 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 or prior to such subsequent purchase or mortgage.

"If any such assignment, grant, or conveyance of any patent shall be acknowledged before any notary public of the several States or Territories or the District of Columbia, or any commissioner of any court of the United States for any District or Territory, or before any secretary of legation or consular officer authorized to administer oaths or perform notarial acts under section 1750 of the Revised Statutes, the certificate of such acknowledgment, under the hand and official seal of such notary or other officer, shall be prima facie evidence of the execution of such assignment, grant, or conveyance."

As amended Aug. 18, 1941, ch. 370, 55 Stat. 634

That section 4898 of the Revised Statutes (35 U. S. C. 47) be, and the same is hereby, amended to read as follows:

"SEC. 4898. Every application for patent or patent or any interest therein shall be assignable in law by an instrument in writing, and the applicant or patentee or his assigns or legal representatives may, in like manner, grant and convey an exclusive right under his application for patent or 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 or prior to such subsequent purchase or mortgage.

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"If any such assignment, grant, or conveyance of any application for patent or patent shall be acknowledged before any notary public of the several States or Territories or the District of Columbia, or any commissioner of any court of the United States for any district or Territory, or before any secretary of legation or consular officer authorized to administer oaths or perform notarial acts under section 1750 of the Revised Statutes (U. S. C., title 22, sec. 131) the certificate of such acknowledgment, under the hand and official seal of such notary or other officer, shall be prima facie evidence of the execution of such assignment, grant or conveyance."

R. S. 4899 ..... Omitted

Every person who purchases of the inventor, or discoverer, or with his knowledge and consent constructs any newly invented or discovered machine, or other patentable article, prior to the application by the inventor or discoverer for a patent, or who sells or uses one so constructed, shall have the right to use, and vend to others to be used, the specific thing so made or purchased, without liability therefor.

R. S. 4900 ..... T. 35, § 287

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

As amended Feb. 7, 1927, ch. 67, 44 Stat. 1058

That section 4900 of the Revised Statutes of the United States shall be amended to read as follows:

"It shall be the duty of all patentees and their assigns and legal representatives, and of all persons making or vending any patented article for or under them, to give sufficient notice to the public that the same is patented; either by fixing thereon the word 'patent', together with the number of the patent, or when, from the character of the article, this can not be done, by fixing to it, or to the package wherein one or more of them is inclosed, a label containing the like notice: *Provided, however*, That with respect to any patent issued prior to April 1, 1927, it shall be sufficient to give such notice in the form following, viz: '*Patented*', together with the day and year the patent was granted; and in any suit for infringement by the party failing so to mark, no damages shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement and continued, after such notice, to make, use, or vend the article so patented."

R. S. 4901 ..... T. 35, § 292

Every person who, in any manner, marks upon anything made, used, or sold by him for which he has not obtained a patent, the name or any imitation of the name of any person who has obtained a patent therefor without the consent of such patentee, or his assigns or legal representatives; or

Who, in any manner, marks upon or affixes to any such patented article the word "patent" or "patentee", or the words "letters patent" or any word of like import, with intent to imitate or counterfeit the mark or device of the patentee, without having the license or consent of such patentee or his assigns or legal representatives; or

Who, in any manner, marks upon or affixes to any unpatented article the word "patent," or any word importing that the same is patented, for the purpose of deceiving the public, shall be liable, for every such offense, to a penalty of not less than $100, with costs; one-half of said penalty to the person who shall sue for the same, and the other to the use of the United States, to be recovered by suit in any district court of the United States within whose jurisdiction such offense may have been committed.

R. S. 4903 ..... T. 35, § 132, 135

Whenever, on examination, any claim for a patent is rejected, the Commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejection,



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together with such information and references as may be useful in judging of the propriety of renewing his application or of altering his specification; and if after receiving such notice, the applicant persists in his claim for a patent, with or without altering his specification, the Commissioner shall order a reexamination of the case.

As amended Aug. 5, 1939, ch. 452, § 1, 53 Stat. 1213.

That section 4903 of the Revised Statutes (U. S. C., title 35, sec. 51) be amended by adding at the end thereof the following:

"No amendment for the first time presenting or asserting a claim which is the same as, or for substantially the same subject matter as, a claim of an issued patent may be made in any application unless such amendment is filed within one year from the date on which said patent was granted."

R. S. 4904 ---------- T. 35, § 135

Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than twenty days, as the Commissioner shall prescribe.

As amended Mar. 2, 1927, ch. 273, § 4, 44 Stat. 1336.

SEC. 4. That section 4904 of the Revised Statutes of the United States be amended by striking out from the last sentence thereof the words "or of the board of examiners in chief, as the case may be."

As amended Aug. 5, 1939, ch. 451, § 1, 53 Stat. 1212.

That section 4904 of the Revised Statutes (U. S. C., title 35, sec. 52) be amended to read as follows:

"Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct a board of three examiners of interferences to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor."

R. S. 4905 ---------- T. 35, § 23

The Commissioner of Patents may establish rules for taking affidavits and depositions required in cases pending in the Patent Office, and such affidavits and depositions may be taken before any officer authorized by law to take depositions to be used in the courts of the United States, or of the State where the officer resides.

R S. 4906 ---------- T. 35 § 24

The clerk in any court of the United States, for any district or Territory wherein testimony is to be taken for use in any contested case pending in the Patent-Office, his agent or attorney, issue a subpoena for any witness residing or being within such district or Territory, commanding him to appear and testify before any officer in such district or Territory authorized to take depositions and affidavits, at any time and place in the subpoena stated. But no witness shall be required to attend at any place more than forty miles from the place where the subpoena is served upon him.

As amended Feb. 18, 1922, ch. 58, § 7, 49 Stat. 391, 392.

SEC. 7. That section 4906 of the Revised Statutes be, and the same is hereby amended to read as follows:

"SEC. 4906. The clerk of any court of the United States, for any District or Territory wherein testimony is to be taken for use in any contested case pending in the Patent Office, shall, upon the application of any party thereto, or of his agent or attorney, issue a subpoena for any witness residing or being within such District or Territory, commanding him to appear and testify before any officer in such District or Territory authorized to take depositions and affidavits at any time and place in the subpoena stated. But no witness shall be required to attend at any place more than forty miles from the place where the subpoena is served

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upon him; and the provisions of section 869 of the Revised Statutes relating to the issuance of subpoenas duces tecum shall apply to contested cases in the Patent Office."

R. S. 4907 ..... T. 35, § 24

Every witness duly subpoenaed and in attendance shall be allowed the same fees as are allowed to witnesses attending the courts of the United States.

R. S. 4908 ..... T. 35, § 24

Whenever any witness, after being duly served with such subpoena, neglects or refuses to appear, or after appearing refuses to testify, the judge of the court whose clerk issued the subpoena may, on proof of such neglect or refusal, enforce obedience to the process, or punish the disobedience, as in other like cases. But no witness shall be deemed guilty of contempt for disobeying such subpoena, unless his fees and traveling expenses in going to, returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret invention or discovery made or owned by himself.

R. S. 4909 ..... T. 35, § 134

Every applicant for a patent or for the re-issue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners-in-chief; having once paid the fee for such appeal.

As amended Mar. 2, 1927, ch. 273, § 5, 44 Stat. 1336.

SEC. 5. That section 4909 of the Revised Statutes of the United States be amended by striking out the words "board of examiners in chief" and substituting therefor the words "board of appeals."

As amended Aug. 5, 1939, ch. 451, § 2, 53 Stat. 1212.

SEC. 2. That section 4909 of the Revised Statutes (U. S. C., title 35, sec. 57) be amended to read as follows:

"Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, may appeal from the decision of the primary examiner to the Board of Appeals, having once paid the fee for such appeal."

R. S. 4911 ..... T. 35, § 141

If such party, except a party to an interference, is dissatisfied with the decision of the Commissioner, he may appeal to the supreme court of the District of Columbia, sitting in banc.

As amended Mar. 2, 1927, ch. 273, § 8, 44 Stat. 1336.

SEC. 8. That section 4911 of the Revised Statutes of the United States be amended to read as follows:

"SEC. 4911. If any applicant is dissatisfied with the decision of the board of appeals, he may appeal to the United States Court of Appeals of the District of Columbia, in which case he waives his right to proceed under section 4915 of the Revised Statutes. If any party to an interference is dissatisfied with the decision of the board of appeals, he may appeal to the United States Court of Appeals of the District of Columbia, provided that such appeal shall be dismissed if any adverse party to such interference shall, within twenty days after the appellant shall have filed notice of appeal according to section 4912 of the Revised Statutes, file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes. Thereupon the appellant shall have thirty days thereafter within which to file a bill of equity under said section 4915, in default of which the decisions appealed from shall govern the further proceedings in the case. If the appellant shall file such bill within said thirty days and shall file due proof thereof with the Commissioner of Patents, the issue of a patent to the party awarded priority by said board of appeals shall be withheld pending the final determination of said proceeding under said section 4915."

As amended Mar. 2, 1929, ch. 488, § 2 (b), 45 Stat. 1475.

SEC. 2. (b) Sections 4911 (Forty-fourth Statutes, page 1336), 4912 (section 60, title 35, United States Code), and 4915 (section 63, title 35, United States Code)

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of the Revised Statutes, as amended, and section 9 of the Act entitled "An Act to authorize the registration of trade-marks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same,' approved February 20, 1905 (United States Code, title 15, section 89), are amended by striking out the words "Court of Appeals of the District of Columbia" wherever they occur therein and inserting in lieu thereof the words "United States Court of Customs and Patent Appeals" in each instance.

As amended Aug. 5, 1939, ch. 451, § 3, 53 Stat. 1212.

SEC. 3. That section 4911 of the Revised Statutes (U. S. C., title 35, sec. 59a) be amended by changing the words "Board of Appeals" in the second sentence to read "board of interference examiners", and by canceling the last sentence of said section.

R. S. 4912 ..... T. 35, § 142

When an appeal is taken to the supreme court of the District of Columbia, the appellant shall give notice thereof to the Commissioner, and file in the Patent-Office, within such time as the Commissioner shall appoint, his reasons of appeal, specifically set forth in writing.

As amended Mar. 2, 1927, ch. 273, § 9, 44 Stat. 1336.

SEC. 9. That section 4912 of the Revised Statutes of the United States be amended by striking out the words "Supreme Court of the District of Columbia" and substituting therefor the words "Court of Appeals of the District of Columbia".

R. S. 4913 ..... T. 35, § 143

The court shall, before hearing such appeal, give notice to the Commissioner of the time and place of the hearing, and on receiving such notice the Commissioner shall give notice of such time and place in such manner as the court may prescribe, to all parties who appear to be interested therein. The party appealing shall lay before the court certified copies of all the original papers and evidence in the case, and the Commissioner shall furnish the court with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal. And at the request of any party interested, or of the court, the Commissioner and the examiners may be examined under oath, in explanation of the principles of the thing for which a patent is demanded.

As amended Mar. 2, 1927, ch. 273, § 10, 44 Stat. 1336.

SEC 10. That section 4913 of the Revised Statutes of the United States be amended by striking out the words "And at the request of any party interested, or of the court, the commissioner and the examiners may be examined under oath in explanation of the principles of the thing for which a patent is demanded."

R. S. 4914 ..... T. 35, § 144

The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the commissioner, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

R. S. 4915 ..... T. 35, §§ 145, 146

Whenever a patent on application is refused, either by the Commissioner of Patents or by the supreme court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent-Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where

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there is no opposing party, a copy of the bill shall be served on the Commissioner; and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not.

As amended Mar. 2, 1927, ch. 273, § 11, 44 Stat. 1336.

SEC. 11. That section 4915 of the Revised Statutes of the United States be amended to read as follows:

"SEC. 4915. Whenever a patent on application is refused by the Commissioner of Patents, the applicant, unless appeal has been taken from the decision of the board of appeals to the Court of Appeals of the District of Columbia, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioners; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit."

As amended Mar. 2, 1929, ch. 488, § 2 (b), 45 Stat. 1475.

SEC. 2. (b) Sections 4911 (Forty-fourth Statutes, page 1336), 4912 (section 60, title 35, United States Code), and 4915 (section 63, title 35, United States Code) of the Revised Statutes, as amended, and section 9 of the Act entitled "An Act to authorize the registration of trade-marks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same," approved February 20, 1905 (United States Code, title 15, section 89), are amended by striking out the words "Court of Appeals of the District of Columbia" wherever they occur therein and inserting in lieu thereof the words "United States Court of Customs and Patent Appeals" in each instance.

As amended Aug. 5, 1939, ch. 451, § 4, 53 Stat. 1212.

SEC. 4. That section 4915 of the Revised Statutes (U. S. C., title 35, sec. 63) he amended by changing the first sentence thereof to read:

"Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear."

R. S. 4916 ---------- T. 35, §§ 251, 252

Whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the Commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be reissued to the patentee, or in the case of his death or of an assignment of the whole or any undivided part of the original patent, then to his executors, administrators, or assigns, for the unexpired part of the term of the original patent. Such surrender shall take

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effect upon the issue of the amended patent. The Commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters-patent. The specifications and claims in every such case shall be subject to revision and restriction in the same manner as original applications are. Every patent so reissued, together with the corrected specification, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; but no new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the Commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid.

May 24, 1928, ch. 730, 45 Stat. 732 as amended.

That section 4916 of the Revised Statutes of the United States be, and the same is hereby, amended to read as follows:

"SEC. 4916. Whenever any patent is wholly or partly inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a patent for the same invention, and in accordance with the corrected specification, to be reissued to the patentee or to his assigns or legal representatives, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the reissued patent, but in so far as the claims of the original and reissued patents are identical, such surrender shall not affect any action then pending nor abate any casue of actioo then existing, and the reissued patent to the extent that its claims are identical with the original patent shall constitute a continuation thereof and have effect continuously from the date of the original patent. The commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters-patent. The specifications and claims in every such case shall be subject to revision and restriction in the same manner as original applications are. Every patent so reissued, together with the corrected specifications, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; but no new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid."

R. S. 4917 ..... T. 35, § 253

Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it.

R. S. 4918 ..... T. 35, § 291

Whenever there are interfering patents, any person interested in any one of them, or in the working of the invention claimed under either of them, may have

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relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either of the patents void in whole or in part, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the right of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment.

Mar. 2, 1927, ch. 273, § 12, 44 Stat. 1337 as amended.

SEC. 12. That section 4918 of the Revised Statutes of the United States be amended to change the phrase "may adjudge and declare eight of the patents void in whole or in part" to read as follows: "may adjudge and declare either or both of the patents void in whole or in part, upon any ground."

R. S. 4919 ..... T. 35, §§ 281, 284

Damages for the infringement of any patent may be recovered by action on the case, in the name of the party interested, either as patentee, assignee, or grantee. And whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment thereon for any sum above the amount found by the verdict as the actual damages sustained, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs.

R. S. 4920 ..... T. 35, § 282

In any action for infringement the defendant may plead the general issue, and, having given notice in writing to the plaintiff or his attorney thirty days before, may prove on trial any one or more of the following special matters:

First. That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect; or,

Second. That he had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; or,

Third. That it has been patented or described in some printed publication prior to his supposed invention or discovery thereof; or,

Fourth. That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; or,

Fifth. That it had been in public use or on sale in this country for more than two years before his application for a patent, or had been abandoned to the public.

And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of the patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented or to have had the prior knowledge of the thing patented, and where and by whom it had been used; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defenses may be pleaded in any suit in equity for relief against an alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect.

Mar. 3, 1897, ch. 391, § 2, 29 Stat. 692 as amended.

SEC. 2. That section forty-nine hundred and twenty of the Revised Statutes be, and the same hereby is, amended by adding to the third clause of said section after "thereof" and before "or" the following words: "or more than two years prior to his application for a patent therefor," so that the section so amended will read as follows:

"SEC. 4920. In any action for infringement the defendant may plead the general issue, and, having given notice in writing to the plaintiff or his attorney thirty days before, may prove on trial any one or more of the following special matters:

"First. That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect; or,

"Second. That he had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; or,

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"Third. That it has been patented or described in some printed publication prior to his supposed invention or discovery thereof, or more than two years prior to his application for a patent therefor; or,

"Fourth. That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; or,

"Fifth. That it had been in public use or on sale in this country for more than one year before his application for a patent, or had been abandoned to the public.

"And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of the patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented or to have had the prior knowledge of the thing patented, and where and by whom it had been used; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defenses may be pleaded in any suit in equity for relief against an alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect."

Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212 as amended.

That sections 4886, 4887, 4920, and 4929 of the Revised Statutes (U. S. C., title 35, secs. 31, 32, 69, and 73) be amended by striking out the words "two years" wherever they appear in said sections and substituting therefor the words "one year."

R. S. 4921 ..... T. 35, §§ 283, 284, 285, 286, 290

The several courts vested with jurisdiction of cases arising under the patent laws shall have power to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for an infringement, the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby; and the court shall assess the same or cause the same to be assessed under its direction. And the court shall have the same power to increase such damages, in its discretion, as is given to increase the damages found by verdicts in actions in the nature of actions of trespass upon the case.

Mar. 3, 1897, ch. 391, § 6, 29 Stat. 694 as amended.

SEC. 6. That section forty-nine hundred and twenty-one of the Revised Statutes be, and the same hereby is, amended by adding thereto the following sentence:

"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, and this provision shall apply to existing causes of action." so that the section so amended will read as follows:

"SEC. 4921. The several courts vested with jurisdiction of cases arising under the patent laws shall have power to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for an infringement the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complaint has sustained thereby; and the court shall assess the same or cause the same to be assessed under its direction. And the court shall have the same power to increase such damages, in its discretion, as is given to increase the damages found by verdicts in actions in the nature of actions of trespass upon the case.

"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, and this provision shall apply to existing causes of action."

Feb. 18, 1922, ch. 58, § 8, 42 Stat. 392 as amended.

SEC. 8. That section 4921 of the Revised Statutes be, and the same is hereby, amended to read as follows:

"SEC. 4921. The several courts vested with jurisdiction of cases arising under the patent laws shall have power to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for an infringement the complainant shall be

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entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby, and the court shall assess the same or cause the same to be assessed under its direction. If on the proofs it shall appear that the complainant has suffered damage from the infringement or that the defendant has realized profits therefrom to which the complainant is justly entitled, but that such damages or profits are not susceptible of calculation and determination with reasonable certainty, the court may, on evidence tending to establish the same, in its discretion, receive opinion or expert testimony, which is hereby declared to be competent and admissible, subject to the general rules of evidence applicable to this character of testimony; and upon such evidence and all other evidence in the record the court may adjudge and decree the payment by the defendant to the complainant of a reasonable sum as profits or general damages for the infringement: *Provided*, That this provision shall not affect pending litigation. And the court shall have the same power to increase such damages, in its discretion, as is given to increase the damages found by verdicts in actions in the nature of actions of trespass upon the case; 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, and this provision shall apply to existing causes of action. And it shall be the duty of the clerks of such courts within one month after the filing of any action, suit, or proceeding arising under the patent laws to give notice thereof in writing to the Commissioner of Patents, setting forth in order so far as known the names and addresses of the litigants, names of the inventors, and the designating number or numbers of the patent or patents upon which the action, suit, or proceeding has been brought, and in the event any other patent or patents be subsequently included in the action, suit, or proceeding by amendment, answer, cross bill, or other pleading, the clerk shall give like notice thereof to the Commissioner of Patents, and within one month after the decision is rendered or a decree issued the clerk of the court shall give notice thereof to the Commissioner of Patents, and it shall be the duty of the Commissioner of Patents on receipt of such notice forthwith to indorse the same upon the file wrapper of the said patent or patents and to incorporate the same as a part of the contents of said file or file wrapper; and for each notice required to be furnished to the Commissioner of Patents in compliance herewith a fee of 50 cents shall be taxed by the clerk as costs of suit."

Aug. 1, 1946, ch. 726, 60 Stat. 778 as amended.

That section 4921 of the Revised Statutes of the United States (35 U. S. C. A. 70) is hereby amended to read as follows:

"The several courts vested with jurisdiction of cases arising under the patent laws shall have power to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable; and upon a judgment being rendered in any case for an infringement the complainant shall be entitled to recover general damages which shall be due compensation for making, using, or selling the invention, not less than a reasonable royalty therefor, together with such costs, and interest, as may be fixed by the court. The court may in its discretion award reasonable attorney's fees to the prevailing party upon the entry of judgment on any patent case.

"The court is authorized to receive expert or opinion evidence upon which to determine in conjunction with any other evidence in the record, due compensation for making, using, or selling the invention, and such expert or opinion evidence is declared to be competent and admissible subject to the general rules of evidence applicable thereto.

"The court shall assess said damages, or cause the same to be assessed, under its direction and shall have the same power to increase the assessed damages, in its discretion, as is given to increase the damages found by verdicts in actions in the nature of actions of trespass upon the case; but recovery shall not be had for any infringement committed more than six years prior to the filing of the complaint in the action. And it shall be the duty of the clerks of such courts within one month after the filing of any action, suit, or proceeding arising under the patent laws to give notice thereof in writing to the Commissioner of Patents, setting forth in order so far as known the names and addresses of the litigants, names of the inventors, and the designating number or numbers of the patent or patents upon which the action, suit, or proceeding has been brought, and in the event any other patent or patents be subsequently included in the action, suit, or proceeding by amendment, answer, cross bill, or other pleading, the

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clerk shall give like notice thereof to the Commissioner of Patents, and within one month after the decision is rendered or a judgment issued the clerk of the court shall give notice thereof to the Commissioner of Patents, and it shall be the duty of the Commissioner of Patents on receipt of such notice forthwith to endorse the same upon the file wrapper of the said patent or patents, and to incorporate the same as a part of the contents of said file or file wrapper."

This Act shall take effect upon approval and shall apply to pending causes of action in which the taking of the testimony has not been concluded: *Provided, however,* That pending causes of action in which the taking of the testimony has been concluded are to be governed by the statute in force at the time of approval of this Act as if such statute had not been amended.

R. S. 4922 ---------- T. 35, § 288

Whenever, through inadvertence, accident, or mistake and without any willful default or intent to defraud or mislead the public, a patentee has, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof, which was bona fide his own, if it is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right, notwithstanding the specifications may embrace more than that of which the patentee was the first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff no costs shall be recovered unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit. But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer.

R. S. 4923 ---------- T. 35, § 102, 104

Whenever it appears that a patentee, at the time of making his application for the patent, believed himself to be the original and first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country, before his invention or discovery thereof, if it had not been patented or described in a printed publication.

R. S. 4929 ---------- T. 35, § 171

Any person who, by his own industry, genius, efforts, and expense, has invented and produced any new and original design for a manufacture, bust, statute, alto-relievo, or bas-relief; any new and original design for the printing of woolen, silk, cotton, or other fabrics; any new and original impression, ornament, patent, print, or picture to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication, may, upon payment of the fee prescribed, and other due proceedings had the same as in cases of inventions or discoveries, obtain a patent therefor.

As amended May 9, 1902, ch. 783, 32 Stat. 193.

That section forty-nine hundred and twenty-nine of the Revised Statutes be, and the same is hereby, amended so as to read as follows:

"SEC. 4949. Any person who has invented any new, original, and ornamental design for an article of manufacture, not known or used by others in this country before his invention thereof, and not patented or described in any printed publication in this or any foreign country before his invention thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law and other due proceedings had, the same as in cases of inventions or discoveries covered by section 4886, obtain a patent therefor."

As amended Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212.

That sections 4886, 4887, 4920, and 4929 of the Revised Statutes (U. S. C., title 35, secs. 31, 32, 69, and 73) be amended by striking out the words "two years"

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wherever they appear in said sections and substituting therefor the words "one year".

R. S. 4930 ..... T. 35, § 114

The commissioner may dispense with models of designs when the design can be sufficiently represented by drawings or photographs.

R. S. 4931 ..... T. 35, § 173

Patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant may, in his application, elect.

R. S 4933 ..... T. 35, § 171

All the regulations and provisions which apply to obtaining or protecting patents for inventions or discoveries not inconsistent with the provisions of this title, shall apply to patents for designs.

R. S. 4934 ..... T. 35, §§ 12, 13, 41

The following shall be the rates for patent-fees:

On filing each original application for a patent, except in design cases, fifteen dollars.

On issuing each original patent, except in design cases, twenty dollars.

In design cases: For three years and six months, ten dollars; for seven years, fifteen dollars; for fourteen years, thirty dollars.

On filing each caveat, ten dollars.

On every application for the re-issue of a patent, thirty dollars.

On filing each disclaimer, ten dollars.

On every application for the extension of a patent, fifty dollars.

On the granting of every extension of a patent, fifty dollars.

On an appeal for the first time from the primary examiners to the examiners-in-chief, ten dollars.

On every appeal from the examiners-in-chief to the Commissioner, twenty dollars.

For certified copies of patents and other papers, including certified printed copies, ten cents per hundred words.

For recording every assignment, agreement, power of attorney, or other paper, of three hundred words or under, one dollar; of over three hundred and under one thousand words, two dollars; of over one thousand words, three dollars.

For copies of drawings, the reasonable cost of making them.

As amended Feb. 18, 1922, ch. 58, § 9, 42 Stat. 393.

SEC. 9. That section 4934 of the Revised Statutes be, and the same is hereby, amended to read as follows:

"SEC. 4934. The following shall be the rates for patent fees:

"On filing each original application for a patent, except in design cases, $20.

"On issuing each original patent, except in design cases, $20.

"In design cases: For three years and six months, $10; for seven years, $15; for fourteen years, $30.

"On every application for the reissue of a patent, $30.

"On filing each disclaimer, $10.

"On an appeal for the first time from the primary examiners to the examiners in chief, $10.

"On every appeal from the examiners in chief to the commissioner, $20.

"For uncertified printed copies of specifications and drawings of patents, 10 cents per copy: *Provided*, That the Commissioner of Patents may supply public libraries of the United States with such copies as published, for $50 per annum: *Provided further*, That the Commissioner of Patents may exchange copies of United States patents for those of foreign countries.

"For copies of records made by the Patent Office, excluding printed copies, 10 cents per hundred words.

"For each certificate, 25 cents.

"For recording every assignment, agreement, power of attorney, or other paper of three hundred words or under, $1; of over three hundred and under one thousand words, $2; and for each additional thousand words or fraction thereof, $1; for each additional patent or application included or involved in one writing, where more than one is so included or involved, 25 cents additional.

"For copies of drawings, the reasonable cost of making them."

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As amended Feb. 14, 1927, ch. 139, § 2, 44 Stat. 1098.

SEC. 2. That section 4934 of the Revised Statutes be amended to read as follows:

"SEC. 4934. The following shall be the rates for patent fees:

"On filing each original application for a patent, except in design cases, $20, and $1 for each claim in excess of twenty.

"On issuing each original patent. except in design cases, $20, and $1 for each claim in excess of twenty.

"In design cases: For three years and six months, $10; for seven years, $15; for fourteen years, $30.

"On every application for the reissue of a patent, $30.

"On filing each disclaimer, $10.

"On an appeal for the first time from the primary examiners to the examiners in chief, $10

"On every appeal from the examiners in chief to the commissioner, $20.

"For uncertified printed copies of specifications and drawings of patents, 10 cents per copy: *Provided*, That the Commissioner of Patents may supply public libraries of the United States with such copies as published for $50 per annum: *Provided further*, That the Commissioner of Patents may exchange copies of United States patents for those of foreign countries.

"For copies of records made by the Patent Office, excluding printed copies, 10 cents per hundred words

"For each certificate 25 cents.

"For recording every assignment, agreement, power of attorney, or other paper of three hundred words or under, $1; of over three hundred and under one thousand words, $2; and for each additional thousand words or fraction thereof, $1· for each additional patent or application included or involved in one writing, where more than one is so included or involved, 25 cents additional.

"For copies of drawings, the reasonable cost of making them."

As amended Mar. 2, 1927, ch. 273, § 13, 44 Stat. 1337.

SEC. 13. That section 4934 of the Revised Statutes of the United States be amended by striking out the following words: "On an appeal for the first time from the primary examiners to the examiners in chief, $10. On every appeal from the examiners in chief to the commissioner, $20," and substituting therefor the words "on an appeal for the first time from the primary examiners to the board of appeals, $15. On every appeal from the examiner of interferences to the board of appeals, $25."

As amended Apr. 11, 1930, ch. 132, § 3, 46 Stat. 155.

SEC. 3. Section 4934 of the Revised Statutes, as amended (United States Code, title 35, section 78), is amended to read as follows:

"SEC. 4934. The following shall be the rates for patent fees:

"On filing each original application for a patent, except in design cases, $25, and $1 for each claim in excess of twenty.

"On issuing each original patent, except in design cases, $25, and $1 for each claim in excess of twenty.

"In design cases: For three years and six months, $10; for seven years, $15; for fourteen years, $30.

"On every application for the reissue of a patent, $30.

"On filing each disclaimer, $10.

"On an appeal for the first time from the primary examiners to the Board of Appeals, $15.

"On every appeal from the examiner of interferences to the Board of Appeals, $25.

"For uncertified printed copies of specifications and drawings of patents, 10 cents per copy: *Provided*, That the Commissioner of Patents may supply public libraries of the United States with such copies as published, for $50 per annum: *Provided further*, That the Commissioner of Patents may exchange copies of United States patents for those of foreign countries.

"For copies of records made by the Patent Office, excluding printed copies, 10 cents per hundred words.

"For each certificate, 50 cents.

"For recording every assignment, agreement, power of attorney, or other paper not exceeding six pages, $3; for each additional two pages or less, $1; for each additional patent or application included or involved in one writing, where more than one is so included or involved, 50 cents additional.

"For copies of drawings, the reasonable cost of making them."

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As amended June 30, 1932, ch. 314, §§ 308, 309, 47 Stat. 410.

SEC. 308. After the expiration of thirty days after the enactment of this Act (but in no event prior to July 1, 1932), the base fee of $25 provided by section 4934 of the Revised Statutes, as amended (U. S. C., Sup. V, title 35, sec. 78), to be paid upon the filing of each original application and upon each renewal application for patent, except in design cases, and on issuing each original patent, except in design cases, is hereby increased to $30.

SEC. 309. Section 4934 of the Revised Statutes, as amended (U. S. C., Sup. V, title 35, sec. 78), is amended by adding at the end thereof the following:

"On filing each petition for the revival of an abandoned application for a patent, $10."

As amended Aug. 9, 1939, ch. 619, § 3, 53 Stat. 1293.

SEC. 3. That section 4934 of the Revised Statutes (U. S. C., title 35, sec. 78) be amended by changing the last sentence to read: "On filing each petition for the revival of an abandoned application for a patent or for the delayed payment of the fee for issuing each patent, $10."

As amended June 15, 1950, ch. 249, 64 Stat. 215.

That section 4934 of the Revised Statutes, as amended (U. S. C., title 35, sec. 78), is amended by inserting after "*Provided*, That the Commissioner of Patents may supply public libraries of the United States with such copies as published, for $50 per annum" a colon and the following: "*Provided further*, That the Commissioner of Patents may supply to any public library approved by the Commissioner, which on January 1, 1949, was receiving such copies under the preceding proviso, such copies for any year in which such library did not receive copies under the preceding proviso upon the payment of $50 per year for any such year."

R. S. 4935 ..... T. 35, § 42

Patent fees may be paid to the Commissioner of Patents, or to the Treasurer or any of the assistant treasurers of the United States, or to any of the designated depositaries, national banks, or receivers of public money, designated by the Secretary of the Treasury for that purpose; and such officer shall give the depositor a receipt or certificate of deposit therefor. All money received at the Patent Office, for any purpose, or from any source whatever, shall be paid into the Treasury as received, without any deduction whatever.

R. S. 4936 ..... T. 35, § 42

The Treasurer of the United States is authorized to pay back any sum or sums of money to any person who has through mistake paid the same into the Treasury, or to any receiver or depositary, to the credit of the Treasury, as for fees accruing at the Patent Office, upon a certificate thereof being made to the Treasurer by the Commissioner of Patents.

## STATUTES AT LARGE

Mar. 3, 1883, ch. 143 (part), 22 Stat. 625 ..... T. 35, § 266

The Secretary of the Interior and the Commissioner of Patents are authorized to grant any officer of the government, except officers and employees of the Patent Office, a patent for any invention of the classes mentioned in section forty-eight hundred and eighty-six of the Revised Statutes, when such invention is used or to be used in the public service, without the payment of any fee: *Provided*, That the applicant in his application shall state that the invention described therein, if patented, may be used by the government or any of its officers or employees in the prosecution of work for the government, or by any other person in the United States, without the payment to him of any royalty thereon, which stipulation shall be included in the patent.

As amended Apr. 30, 1928, ch. 460, 45 Stat. 467.

That so much of chapter 143 of the Act of Congress approved March 3, 1883 (Twenty-second Statutes at Large, page 625), as relates to issue of patents without payment of any fee be, and the same is hereby, amended to read as follows:

"The Commissioner of Patents is authorized to grant, subject to existing law, to any officer, enlisted man, or employee of the Government, except officers and employees of the Patent Office, a patent for any invention of the classes mentioned in section 4886 of the Revised Statutes, without the payment of any fee when the head of the department or independent bureau certifies such invention is used or

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liable to be used in the public interest: *Provided*, That the applicant in his application shall state that the invention described therein, if patented, may be manufactured and used by or for the Government for governmental purposes without the payment to him of any royalty thereon, which stipulation shall be included in the patent."

Feb. 4, 1887, ch. 105, §§ 1 and 2, 24 Stat. 387 ..... T. 35, § 289

Hereafter, during the term of letters patent for a design, it shall be unlawful for any person other than the owner of said letters patent, without the license of such owner, to apply the design secured by such letters patent, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or to sell or expose for sale any article of manufacture to which such design or colorable imitation shall, without the license of the owner, have been applied, knowing that the same has been so applied. Any person violating the provisions, or either of them, of this section, shall be liable in the amount of two hundred and fifty dollars; and in case the total profit made by him from the manufacture or sale, as aforesaid, of the article or articles to which the design, or colorable imitation thereof, has been applied, exceeds the sum of two hundred and fifty dollars, he shall be further liable for the excess of such profit over and above the sum of two hundred and fifty dollars; and the full amount of such liability may be recovered by the owner of the letters patent, to his own use, in any circuit court of the United States having jurisdiction of the parties, either by action at law or upon a bill in equity for an injunction to restrain such infringement.

SEC. 2. That nothing in this Act contained shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any owner of letters patent for a design, aggrieved by the infringement of the same might have had if this act had not been passed; but such owner shall not twice recover the profit made from the infringement.

Feb. 18, 1888, ch. 15, 25 Stat. 40 ..... T. 35, § 153

See under R. S. 4883.

Mar. 3, 1891, ch. 541, § 1 (part) 26 Stat. 940 ..... T. 35, § 10

And certified copies of such drawings and specifications may be furnished by the Commissioner of Patents to persons applying therefor upon payment of the present rates for uncertified copies, and twenty-five cents additional for each certification.

May 19, 1896, ch. 204, 29 Stat. 124 ..... T. 35, § 41

See under R. S. 493.

Mar. 3, 1897, ch. 391, §§ 1, 2, 3, 4, 5, 6, 29 Stat. 694. — T. 35, §§ 101, 102, 119, 133, 211, 267, 282–6, 250, 171, 172.

See under R. S. 4886, 4920, 4887, 4894, 4898, 4921.

Mar. 3, 1897, ch. 391, § 7, 29 Stat. 694 ..... Omitted

SEC. 7. That in every case where the head of any Department of the Government shall request the Commissioner of Patents to expedite the consideration of an application for a patent it shall be the duty of such head of a Department to be represented before the Commissioner in order to prevent the improper issue of a patent.

June 10 1898, ch 423, § 1, 30 Stat. 440 ..... T. 35 § 9

SEC. 1. That for the purpose of determining with more readiness and accuracy the novelty of inventions for which applications for letters patent are or may be filed in the United States Patent Office, and to prevent the issuance of letters patent of the United States for inventions which are not new the Commissioner of Patents is hereby authorized and directed to revise and perfect the classification, by subjects-matter, of all letters patent and printed publications in the United States Patent Office which constitute the field of search in the examination as to the novelty of invention for which applications for patents are or may be filed.

Feb. 28, 1899, ch 227, 30 Stat. 915 ..... T. 35, § 117

See under R. S. 4896.

Apr. 11, 1902, ch. 417, 32 Stat. 95 ..... T. 35, § 153

See under R. S. 4883.

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May 9, 1902, ch. 783, 32 Stat. 193 ..... T. 35, § 171

See under R. S. 4929.

Mar. 3, 1903, ch. 1019 §§ 1, 2, 3, 32 Stat. 1225–7 T. 35, §§ 102, 115, 117, 119, 172

See under R. S. 4887, 4892, 4896.

May 23, 1908, ch. 188 35 Stat. 245 ..... T. 35, § 117

See under R. S. 4896.

May 23, 1908, ch. 189, 35 Stat. 246 ..... T. 35, § 151

See under R. S. 4885.

May 27, 1908, ch. 200, § 1 (part), 35 Stat. 343 ..... T. 35, § 41

In lieu of the fees fixed by section forty-nine hundred and thirty-four of the Revised Statutes for recording assignments, agreements, powers of attorney, or other papers in the Patent Office the following shall hereafter be the rates:

For recording every assignment, agreement, power of attorney, or other paper, of three hundred words or under, one dollar; of over three hundred and under one thousand words, two dollars; and for each additional thousand words or fraction thereof, one dollar.

Jan. 14, 1915, Pub. Res. 61, 38 Stat. 1221 ..... T. 35, § 12

That the Commissioner of Patents of the United States be, and he is hereby, authorized to exchange with the Dominion of Canada, under such terms of contract as may by him be deemed practicable, printed copies of patents now in the United States Patent Office and hereafter issued by the United States.

Mar. 3, 1915, ch. 94, §§ 1, 2, 38 Stat. 958 ..... T. 35, §§ 111–113,162

See under R. S. 4888, 4889.

Feb. 15, 1916, ch. 22, § 1, 39 Stat. 9 ..... T. 35, § 3

See under R. S. 476.

July 6, 1916, ch. 225, § 1 (part), 39 Stat. 348 ..... T. 35, §§ 133, 267

See under R. S. 4894.

Nov. 4, 1919, ch. 93, § 1 (part), 41 Stat. 335 ..... T. 35, § 41

*Provided*, That hereafter 10 cents per copy shall be charged for uncertified printed copies of specifications and drawings of patents.

Mar. 6, 1920, ch. 94, § 1 (part), 41 Stat. 512 ..... T. 35, § 42

Hereafter all patent fees shall be paid to the Commissioner of Patents, who shall deposit the same in the Treasury of the United States in such manner as the Secretary of the Treasury shall direct, and said commissioner is authorized to pay back any sum or sums of money paid to him by any person by mistake or in excess of the fee required by law.

Mar. 3, 1921, ch. 126, §§ 1–8, 41 Stat. 1313–1315 ..... Omitted

That the rights of priority provided by section 4887 of the Revised Statutes, for the filing of applications for patent for inventions and designs, which rights had not expired on the 1st day of August, 1914, or which rights have arisen since the 1st day of August, 1914, shall be, and the same are hereby extended until the expiration of a period of six months from the passage of this Act in favor of the citizens of the United States or citizens or subjects of all countries which have extended, or which now extend, or which within said period of six months shall extend substantially reciprocal privileges to citizens of the United States, and such extension shall apply to applications upon which patents have been granted, as well as to applications now pending or filed within the period herein: *Provided* That such extension shall in no way furnish a basis of claim against the Government of the United States: *Provided further* That such extension shall in no way affect the right of any citizen of the United States, who, before the passage of this Act, was bona fide in possession of any rights in patents or applications for patent

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conflicting with rights in patents granted or validated by reason of such extension, to exercise such rights by itself or himself personally, or by such agents, or licensees, as derived their rights from it, or him, before the passage of this Act, and such persons shall not be amenable to any action for infringement of any patent granted or validated by reason of such extension.

A patent shall not be refused on an application coming within the provisions of this Act, nor shall a patent granted on such application be held invalid by reason of the invention having been patented or described in any printed publication or in public use or on sale in the United States prior to the filing of the application, unless such patent or publication or such public use or sale was prior to the filing of the foreign application upon which the right of priority is based.

SEC. 2. That the time now fixed by law for the payment of any fee or for the taking of any action with respect to an application for patent, which time had not expired on August 1, 1914, or which commenced after August 1, 1914, is hereby extended until the expiration of one year from the passage of this Act, without the payment of extension fees or other penalty in favor of the citizens or subjects of countries which have extended, now extend, or shall extend during a period of one year from the passage of this Act substantially reciprocal privileges to citizens of the United States, provided that no extension herein shall confer such privileges on the citizens or subjects of a foreign country for a longer term than the term during which such privileges are conferred by such foreign country on the citizens of the United States, but nothing in this Act shall give any right to reopen interference proceedings where final hearing before the examiner of interferences has taken place.

SEC. 3. That no patent granted or validated by reason of the extensions provided for in sections 1 and 2 of this Act shall abridge or otherwise affect the right of any citizen of the United States, or his agent or agents, or his successor in business, to continue any manufacture, use, or sale commenced before the passage of this Act by such citizen, nor shall the continued manufacture, use, or sale by such citizen, or the use or sale of the devices resulting from such manufacture or use constitute an infringement.

SEC. 4. That all applications for patent filed since August 1, 1914, and prior to June 15, 1920, which were executed by an agent of the applicant, and in which a petition, specification, and oath, signed by the inventor, or his executor or administrator, had been filed or shall have been filed within a period of one year from the passage of this Act, and the patents granted on such applications, shall have the same force and effect as if the papers signed by the inventor, or his executor or administrator, had been filed on the date on which the papers signed by the agent were filed.

SEC. 5. That all applications for patent filed since August 1, 1914, in which the oath was executed before or authenticated by a consular officer, or other representative qualified to administer oaths, of a Government acting in the interest of the Government of the United States, shall have the same force and effect as if said oath had been executed by the applicant before a consular officer of the United States.

SEC. 6. That where an invention was made by a person while serving abroad, during the war, with the forces of the United States, civil or military, the inventor thereof shall be entitled, in interference and other proceedings arising in connection with such invention, to the same rights of priority with respect of such invention as if the same had been made in the United States, and where an application became abandoned or forfeited, during the time the applicant was serving with the forces of the United States, by reason of his failure to take action or pay a fee within the time now required by law, such action may be taken, or the fee paid, within six months from the passage of this Act.

SEC. 7. That no claim shall be made or action brought in respect of the use since August 1, 1914, up to the passage of this Act, by the Government of the United States, or by any persons acting on behalf of, or under contract with, or with the assent of the Government of the United States or of Governments or their representatives associated with the United States, under any patent rights owned in whole or in part since August 1, 1914, by an alien enemy, nor in respect of the use of any process during such period, or the sale, offering for sale, or use, at any time, of any products, articles, or apparatus whatsoever manufactured during such period to which such patent rights applied.

SEC. 8. That nothing in this Act shall affect any act done by virtue of the special measures taken during the war under legislative, executive, or administrative authority of the United States in regard to the rights of an enemy, or ally

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of an enemy, as defined by the Trading with the Enemy Act of October 6, 1917, in patents for inventions and designs.

Feb. 18, 1922, ch. 58, §§ 3, 5, 6, 7, 8, 9, 42 Stat. 390–393. T. 35, §§ 12, 13, 24, 31, 32, 41, 153, 211, 283–286, 250.

See under R. S. 487, 4883, 4898, 4906, 4921, 4934.

Mar. 4, 1925, ch. 535, § 1, 43 Stat. 1268 ..... T. 35, § 254

That whenever a mistake in a patent or a trade-mark registration, incurred through the fault of the Patent Office, is clearly disclosed by the records or files of the office, a certificate, stating the fact and nature of such mistake, signed by the Commissioner of Patents and sealed with the seal of the Patent Office, may be issued, without charge, and recorded in the records of patents or trade-marks, and a printed copy thereof attached to each printed copy of the patent or trade-mark registration, and such certificate shall thereafter be considered as part of the original, and every patent or trade-mark registration, together with such certificate, shall have the same effect and operation in law on the trial of all actions for causes thereafter arising as if the same had been originally issued in such corrected form. All such certificates heretofore issued in accordance with the rules of the Patent Office and the patents or trade-mark registrations to which they are attached shall have the same force and effect as if such certificates had been specifically authorized by statute.

Feb. 7, 1927, ch. 67, 44 Stat. 1058 ..... T. 35, § 287

See under R. S. 4900.

Feb. 14, 1927, ch. 139, §§ 1, 2, 44 Stat. 1098–9 ..... T. 35, §§ 3, 12, 13, 41

See under R. S. 476, 4934.

Mar. 2, 1927, ch. 273, §§ 1, 3, 4, 5, 8, 9, 10, 11, 12, 13, 44 Stat. 1335–37. T. 35, §§ 7, 12, 13, 41, 133–5, 141–3, 146, 267, 291

See under R. S. 4894, 482, 4904, 4909, 4911, 4912, 4913, 4915, 4918, 4934.

Mar. 2, 1927, ch. 273, § 14, 44 Stat. 1337 ..... T. 35, § 21

SEC. 14. That where the day, or the last day, fixed by statute for taking any action or paying any fee in the United States Patent Office falls on Sunday, or on a holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding secular or business day.

Mar. 3, 1927, ch. 364, 44 Stat. 1394 ..... T. 35, §§ 146, 291

That section 52 of the Judicial Code be, and the same is hereby, amended by adding thereto the following:

And upon the filing of a bill in the Supreme Court of the District of Columbia wherein remedy is sought under section 4915 or section 4918 of the Revised Statutes, without seeking other remedy, if it shall appear that there is an adverse party residing in a foreign country, or adverse parties residing in a plurality of districts not embraced within the same State, the court shall have jurisdiction thereof and writs shall, unless the adverse party or parties voluntarily make appearance, be issued against all of the adverse parties with the force and effect and in the manner set forth in this section; provided that writs issued against parties residing in foreign countries pursuant to this section may be served by publication or otherwise as the court shall direct."

Apr. 30, 1928, ch. 460, 45 Stat. 467 ..... T. 35, § 266

See under Mar. 3, 1883, ch. 143, 22 Stat. 625.

May 24, 1928, ch. 730, 45 Stat. 732 ..... T. 35, §§ 251, 252

See under R. S. 4916.

May 31, 1928, ch. 992, §§ 1–4, 45 Stat. 1012–1014 ..... Omitted

That any person who served honorably in the military or naval forces of the United States at any time between April 6, 1917, and November 11, 1918, both dates inclusive, and was subsequently honorably discharged, may within six months after the enactment of this Act, upon payment of a fee of $20, make application to the Commissioner of Patents, comprising a verified statement, accompanied by supporting evidence of the following facts:



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(A) That he is the inventor or discoverer of an invention or discovery for which a specified patent was granted prior to the 11th day of November, 1918, the original term of which remains unexpired at the time of the filing of the application.

(B) That between April 6, 1917, and November 11, 1918, and also at the time of the passage of this Act, he held, by ownership or contract, a right in said invention or under said patent or to income by way of royalty or otherwise therefrom, whereby an extension of the term of said patent would benefit him.

(C) That between April 6, 1917, and July 2, 1921, he was not receiving from said patent an income, or that his income therefrom was reduced by his said service.

(D) That at the time of his induction into the service he was making diligent effort to exploit the invention covered by his patent.

(E) The names of all persons, firms, or corporations, if any, holding at the time of the passage of this Act, by grant, transfer, license, or contract from him, any right or interest in the invention or discovery or under the patent, and their consent to the extension for which application is made, which shall be supported by an instrument, or instruments, executed by all such persons, firms, and corporations, evidencing their consent to such extension.

(F) The period of extension of the patent from the expiration of the original term thereof, for which he applies, which shall in no case exceed a further term of three times the length of his said service in the military or naval forces of the United States between the dates of April 6, 1917, and July 2, 1921, but exclusive of any reenlistment subsequent to November 11, 1918.

(G) That the licensee of a patent affected by this Act shall automatically be granted an extension of said license for the period of the extension on the same terms and conditions as contained in said existing license, thereby creating an equitable adjustment of the benefits of this Act.

(H) That such extension shall in no way impair the right of anyone who before the passage of this Act was bona fide in possession of any rights in patents or applications for patents conflicting with the rights in any patents extended under this Act, nor shall any extension granted under this Act impair the right of anyone who was lawfully manufacturing before the passage of this Act the invention covered by the extended patent.

SEC. 2. In the case of a veteran, as described in paragraph 1 of this Act, who dies, or has died, or who becomes insane or unable to act, which veteran owned an interest as described in this Act in said patent at the time of his death or at the time he was declared mentally incompetent or became unable to act before said extension is granted, such application may be filed or proceeded with by his legal representatives substantially as provided in section 4896 of the Revised Statutes of the United States (United States Code, title 35, section 46), as amended, with respect to proceedings in such cases for obtaining a patent.

SEC. 3. On the filing of such application the Commissioner of Patents shall cause an examination thereof to be made, and if, on such examination, it shall appear that such application conforms, or by amendment or supplement is made to conform, to the requirements of section 1 of this Act, the commissioner shall cause notice of such application to be published at least once in the Official Gazette. Any person who believes that he would be injured by such extension may within forty-five days from such publication oppose the same on the ground that any of the statements of the application for extension required by section 1 of this Act is not true in fact, which said notice of opposition shall be verified before an officer authorized by the laws of any State or Territory or the District of Columbia to administer oaths. In all cases where notice of opposition is filed the Commissioner of Patents shall notify the applicant for extension thereof and set a day of hearing. If after such hearing the Commissioner of Patents is of the opinion that such extension should not be granted, he may deny the application therefor, stating in writing his reasons for such denial. Where an extension is refused the applicant therefor shall have the same remedy by appeal from the decision of the commissioner as is now provided by law where an application for patent is refused. If no opposition to the grant of the extension is filed, or if, after opposition is filed, it shall be decided that the applicant is entitled to the extension asked for, the Commissioner of Patents shall issue a certificate that the term of said patent is extended for the additional period for which application has been made as aforesaid, and shall cause notice of such extension to be published in the Official Gazette and marked upon copies of the patent for sale by the Patent Office, in such manner as the commissioner may determine.

SEC. 4. Thereupon said patent shall have the same force and effect in law as though it had been originally granted for seventeen years plus the term of such

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extension: *Provided, however,* That in any action, at law or in equity, for infringement after the expiration of seventeen years from the grant of the patent and during the period of such extension, the defendant may plead the general issue, and having given notice in writing to the plaintiff or his attorney thirty days before, may prove on trial that any of the statements of the application for extension required by section 1 of this Act is not true in fact; and if any one or more of such statements shall be found untrue in fact, judgment shall be rendered for the defendant, with costs: *Provided further,* That no person whose patent shall be extended under the provisions of this Act shall be permitted to make any claim for damages against the United States for the period of the extension, and the rights of the United States shall remain in all respects as if these patents had not been extended.

Mar. 2, 1929, ch. 488, § 2 (b), 45 Stat. 1475 ..... T. 35, §§ 141, 145, 146

See under R. S. 4911, 4915.

Apr. 11, 1930, ch. 132, §§ 1, 2, 3, 46 Stat. 155 ..... T. 35, §§ 3, 7, 12, 13, 41

See under R. S. 476, 482, 4934.

Apr. 11, 1930, ch. 132, § 5, 46 Stat. 156 ..... Omitted

SEC. 5. The money required for the Patent Office each year, commencing with the fiscal year 1932, shall be appropriated by law out of the revenues of that office, except as otherwise provided by law.

May 23, 1930, ch. 312, §§ 1, 2, 3, 46 Stat. 376 — T. 35, §§ 101, 102, 111, 112, 115, 154, 162, 171

See under R. S. 4884, 4886, 4888, 4892.

May 23, 1930, ch. 312, § 4, 46 Stat. 376 ..... T. 35, § 163

SEC. 4. The President may by Executive order direct the Secretary of Agriculture (1) to furnish the Commissioner of Patents such available information of the Department of Agriculture, or (2) to conduct through the appropriate bureau or division of the department such research upon special problems, or (3) to detail to the Commissioner of Patents such officers and employees of the department, as the commissioner may request for the purposes of carrying this Act into effect.

May 23, 1930, ch. 312, § 5, 46 Stat. 376 ..... Omitted

SEC. 5. Notwithstanding the foregoing provisions of this Act, no variety of plant which has been introduced to the public prior to the approval of this Act shall be subject to patent.

May 23, 1930, ch. 312, § 6, 46 Stat 376 ..... § 3 of bill

SEC. 6. If any provision of this Act is declared unconstitutional or the application thereof to any person or circumstance is held invalid, the validity of the remainder of the Act and the application thereof to other persons or circumstances shall not be affected thereby.

June 30, 1932, ch. 314, §§ 308, 309, 47 Stat. 410 ..... T. 35, § 12, 13, 41

See under R. S. 4934.

June 19, 1936, ch. 594, 49 Stat. 1529 ..... T. 35, § 102, 119, 172

See under R. S. 4887.

May 9, 1938, ch. 188, § 477, 52 Stat. 342 ..... T. 35, § 33

That it shall be unlawful for any person who has not been duly recognized to practice before the United States Patent Office in accordance with the provisions of Section 487 of the Revised Statutes (U. S. C., title 35, sec. 11) and the rules of the Patent Office to hold himself out or knowingly permit himself to be held out as a patent solicitor, patent agent, or patent attorney, or otherwise in any manner hold himself out, either directly or indirectly, as authorized to represent applicants for patent in their business before the Patent Office, and it shall be unlawful for any person who has, under the authority of section 487 of the Revised Statutes (U. S. C., title 35, sec. 11) been disbarred or excluded from practice before the Patent Office, and has not been reinstated, to hold himself out in any manner whatever as entitled to represent or assist persons in the

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transaction of business before the Patent Office or any division thereof; and any offense against the foregoing provision shall be a misdemeanor and be punished by a fine of not less than $50 and not exceeding $500.

Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212..... T. 35, §§ 101, 102, 119, 171, 172

See under R. S. 4886, 4887, 4920, 4929.

Aug. 5, 1939, ch. 450, § 2, 53 Stat. 1212..... Sec. 4 (d) of bill

SEC. 2. This Act shall take effect one year after its approval and shall apply to all applications for patent filed after it takes effect and to all patents granted on such applications: *Provided, however,* That all applications for patents filed prior to the time this Act takes effect and all patents granted on such applications are to be governed by the statutes in force at the time of approval of this Act as if such statutes had not been amended.

Aug. 5, 1939, ch. 451, §§ 1, 2, 3, 4, 53 Stat. 1212 T. 35, §§ 134, 135, 141, 145, 146

See under R. S. 4904, 4909, 4911, 4915.

Aug. 5, 1939, ch. 452, § 1, 53 Stat. 1213..... T. 35, §§ 132, 135

See under R. S. 4903.

Aug. 7, 1939, ch. 568, 53 Stat. 1264..... T. 35, §§ 133, 267

See under R. S. 4894.

Aug. 9, 1939, ch. 619, §§ 2, 3, 53 Stat. 1293..... T. 35, §§ 12, 13, 41, 151

See under R. S. 4885, 4934.

Aug. 18, 1941, ch. 370, 55 Stat. 634..... T. 35, § 261

See under R. S. 4898.

Aug. 1, 1946, ch. 726, 60 Stat. 778..... T. 35, §§ 283–6, 250

See under R. S. 4921.

July 5, 1946, ch. 541, § 301 (part), 60 Stat. 471..... T. 35, § 41

*Provided,* That hereafter on July 1, 1946, and thereafter 25 cents per copy shall be charged for uncertified copies of specifications and drawings of patents, and 10 cents per copy for design patents and certificates of trade-mark registration.

Aug. 8, 1946, ch. 910, § 9, 60 Stat. 943..... T. 35, § 104

SEC. 9. That in proceedings in the Patent Office and in the courts of the United States an applicant for a patent for an invention, discovery, or a design, or a patentee, shall not be permitted to establish the date of invention or discovery by reference to knowledge or use thereof, or other activity with respect thereto, in a country foreign to the United States, other than the filing in a foreign country of an application for a patent for the same invention, discovery, or design which, in accordance with and subject to the provisions of section 4887 of the Revised Statutes, as amended, or in accordance with and subject to the provisions of this Act, is entitled to have the same force and effect as it would have had if filed in the United States on the date on which it was filed in such foreign country: *Provided,* That where an invention was made by a person, civil or military, during the time such person was domiciled in the United States or its possessions and was serving in a foreign country in connection with the prosecution of the war on behalf of the United States or its allies, the inventor thereof shall be entitled, in interference and other proceedings arising in connection with such invention, to the same rights of priority with respect to such invention as if the same had been made in the United States.

Mar. 4, 1950, ch. 50, 64 Stat. 11..... T. 35, § 7

See under R. S. 482.

June 15, 1950, ch. 249, 64 Stat. 215..... T. 35, §§ 12, 13, 41

See under R. S. 4934.

Oct. 31, 1951, ch. 655, § 53a, 65 Stat. 728..... T. 35, §§ 146, 291

SEC. 53a. (a) Upon the filing of a complaint in the United States District Court for the District of Columbia wherein remedy is sought under section 4915 or

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section 4918 of the Revised Statutes, as amended (35 U. S. C., secs. 63 and 66), without seeking other remedy, if it shall appear that there is an adverse party residing in a foreign country, or adverse parties residing in a plurality of districts not embraced within the same State, the court shall have jurisdiction thereof and process shall, unless the adverse party or parties voluntarily make appearance, be issued against all of the adverse parties and served anywhere within the United States, except that process issued against parties residing in foreign countries pursuant to this section may be served by publication or otherwise as the court may direct.

(b) The provision of subsection (a) of this section shall be deemed to be in effect as of September 1, 1948.

Feb. 1, 1952, ch. 4, §§, 1–9, 11, 12, 66 Stat. 3–6 — T. 35, §§ 181–188

That whenever publication or disclosure by the grant of a patent or an invention in which the Government has a property interest might, in the opinion of the head of the interested Government agency, be detrimental to the national security, the Secretary of Commerce upon being so notified shall order that the invention be kept secret and shall withhold the grant of a patent therefor under the conditions set forth hereinafter.

Whenever the publication or disclosure of an invention by the granting of a patent, in which the Government does not have a property interest, might, in the opinion of the Secretary of Commerce, be detrimental to the national security, he shall make the application for patent in which such invention is disclosed available for inspection to the Atomic Energy Commission, the Secretary of Defense, and the chief officer of any other department or agency of the Government designated by the President as a defense agency of the United States.

Each individual to whom the application is disclosed shall sign a dated acknowledgment thereof, which acknowledgment shall be entered in the file of the application. If, in the opinion of the Atomic Energy Commission, the Secretary of a Defense Department, or the chief officer of another department or agency so designated, the publication or disclosure of the invention by the granting of a patent therefor would be detrimental to the national security, the Atomic Energy Commission, the Secretary of a Defense Department, or such other chief officer shall notify the Secretary of Commerce and the Secretary of Commerce shall order that the invention be kept secret and shall withhold the grant of a patent for such period as the national interest requires, and notify the applicant thereof. Upon proper showing by the head of the department or agency who caused the secrecy order to be issued that the examination of the application might jeopardize the national interest, the Secretary of Commerce shall thereupon maintain the application in a sealed condition and notify the applicant thereof. The owner of an application which has been placed under a secrecy order shall have a right to appeal from the order to the Secretary of Commerce under rules prescribed by him.

An invention shall not be ordered kept secret and the grant of a patent withheld for a period of not more than one year. The Secretary of Commerce shall renew the order at the end thereof, or at the end of any renewal period, for additional periods of one year upon notification by the head of the department or the chief officer of the agency who caused the order to be issued that an affirmative determination has been made that the national interest continues so to require. An order in effect, or issued, during a time when the United States is at war, shall remain in effect for the duration of hostilities and one year following cessation of hostilities. An order in effect, or issued, during a national emergency declared by the President shall remain in effect for the duration of the national emergency and six months thereafter. The Secretary of Commerce may rescind any order upon notification by the heads of the departments and the chief officers of the agencies who caused the order to be issued that the publication or disclosure of the invention is no longer deemed detrimental to the national security.

SEC. 2. The invention disclosed in an application for patent subject to an order made pursuant to section 1 hereof may be held abandoned upon its being established by the Secretary of Commerce that in violation of said order the invention has been published or disclosed or that an application for a patent therefor has been filed in a foreign country by the inventor, his successors, assigns, or legal representatives, or anyone in privity with him or them, without the consent of the Secretary of Commerce. The abandonment shall be held to have occurred as of the time of violation. The consent of the Secretary of Commerce shall not be given without the concurrence of the heads of the departments and the chief officers of the agencies who caused the order to be issued. A holding of abandon-

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ment shall constitute forfeiture by the applicant, his successors, assigns, or legal representatives, or anyone in privity with him or them, of all claims against the United States based upon such invention.

SEC. 3. An applicant, his successors, assigns, or legal representatives, whose patent is withheld as herein provided, shall have the right, beginning at the date the applicant is notified that, except for such order, his application is otherwise in condition for allowance, or the effective date of this Act, whichever is later, and ending six years after a patent is issued thereon, to apply to the head of any department or agency who caused the order to be issued for compensation for the damage caused by the order of secrecy and/or for the use of the invention by the Government, resulting from his disclosure. The right to compensation for use shall begin on the date of the first use of the invention by the Government. The head of the department or agency is authorized, upon the presentation of claim, to enter into an agreement with the applicant, his successors, assigns, or legal representatives, in full settlement for the damage and/or use. This settlement agreement shall be conclusive for all purposes notwithstanding any other provision of law to the contrary. If full settlement of the claim cannot be effected, the head of the department or agency may award and pay to such applicant, his successors, assigns, or legal representatives, a sum not exceeding 75 per centum of the sum which the head of the department or agency considers just compensation for the damage and/or use. A claimant may bring suit against the United States in the Court of Claims or in the District Court of the United States for the district in which such claimant is a resident for an amount which when added to the award shall constitute just compensation for the damage and/or use of the invention by the Government. The owner of any patent issued upon an application that was subject to a secrecy order issued pursuant to section 1 hereof, who did not apply for compensation as above provided, shall have the right, after the date of issuance of such patent, to bring suit in the Court of Claims for just compensation for the damage caused by reason of the order of secrecy and/or use by the Government of the invention resulting from his disclosure. The right to compensation for use shall begin on the date of the first use of the invention by the Government. In a suit under the provisions of this section, and in negotiations concerning settlement of a claim, the United States may avail itself of all defenses it may plead in an action under title 28, United States Code, section 1498, as amended. This section shall not confer a right of action on anyone or his successors, assigns, or legal representatives who, while in the full-time employment or service of the United States, discovered, invented, or developed the invention on which the claim is based.

SEC. 4. Except when authorized by a license obtained from the Secretary of Commerce a person shall not file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States an application for patent or for the registration of a utility model, industrial design, or model in respect of an invention made in this country. A license shall not be granted with respect to an invention subject to an order issued by the Secretary of Commerce pursuant to section 1 hereof without the concurrence of the head of the departments and the chief officers of the agencies who caused the order to be issued. The license may be granted retroactively where an application has been inadvertently filed abroad and the application does not disclose an invention within the categories prescribed under section 1 hereof.

The term "application" when used in this Act includes applications and any modifications, amendments, or supplements thereto, or divisions thereof.

SEC. 5. Notwithstanding any other provisions of law any person, and his successors, assigns, or legal representatives, shall not receive a United States patent for an invention if that person, or his successors, assigns, or legal representatives shall, without procuring the license prescribed in section 4 hereof, have made, or consented to or assisted another's making, application in a foreign country for a patent or for the registration of a utility model, industrial design, or model in respect of the invention. A United States patent issued to such person, his successors, assigns, or legal representatives shall be invalid.

SEC. 6. Whoever, during the period or periods of time an invention has been ordered to be kept secret and the grant of a patent thereon withheld pursuant to section 1 hereof, shall, with knowledge of such order and without due authorization, willfully publish or disclose or authorize or cause to be published or disclosed the invention, or material information with respect thereto, or whoever, in violation of the provisions of section 4 hereof, shall file or cause or authorize to be filed in any foreign country an application for patent or for the registration of a utility

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model, industrial design, or model in respect of any invention made in the United States, shall, upon conviction, be fined nor more than $10,000 or imprisoned for not more than two years, or both.

SEC. 7. The prohibitions and penalties of this Act shall not apply to any officer or agent of the United States acting within the scope of his authority, nor to any person acting upon his written instructions or permission.

SEC. 8. The Atomic Energy Commission, the Secretary of a defense department, the chief officer of any other department or agency of the Government designated by the President as a defense agency of the United States, and the Secretary of Commerce, may separately issue rules and regulations to enable the respective department or agency to carry out the provisions of this Act, and may delegate any power conferred by this Act.

SEC. 9. If any provision of this Act or of any section hereof shall be held invalid, the remainder of the Act shall not be affected thereby.

SEC. 11. Nothing in this Act shall be construed to alter, amend, revoke, repeal, or otherwise affect the provisions of the Atomic Energy Act of 1946 (60 Stat. 755), as amended.

SEC. 12. This Act may be cited as the "Invention Secrecy Act of 1951".

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## 2. Comparative Text of Statutes Amended

In compliance with paragraph 2a (2) of rule XIII of the Rules of the House of Representatives, a comparative print of the part of an act to be amended by section 2 of the bill follows. This amendment merely changes references to the old statutes to appropriate references to proposed title 35.

The comparative text of the proposed amendment is set forth below with omissions indicated by brackets and additions by italics.

### Section 2 of the Bill

Amends Act July 5, 1946, ch. 540, § 21, 60 Stat. 435, (15 U. S. C., 1946 ed., § 1071).

**Comparative text.—**

Any applicant for registration of a mark, party to an interference proceeding, party to an opposition proceeding, party to an application to register as a lawful concurrent user, party to a cancelation proceeding, or any registrant who has filed an affidavit as provided in section 8, who is dissatisfied with the decision of the Commissioner may appeal to the United States Court of Customs and Patent Appeals or may proceed under [section 4915, Revised Statutes] *35 United States Code, sections 145 and 146*, as in the case of applicants for patents, under the same conditions, rules, and procedure as are prescribed in the case of patent appeals or proceedings so far as they are applicable: *Provided*, That any party who is satisfied with the decision of the Commissioner shall, upon the filing of an appeal to the Court of Customs and Patent Appeals by any dissatisfied party, have the right to elect to have all further proceedings under [Revised Statutes 4915] *35 United States Code, section 146*, by election as provided in [Revised Statutes 4911] *35 United States Code, section 141*. The Commissioner of Patents shall not be a necessary party to an inter partes proceeding under [Revised Statutes 4915] *35 United States Code, section 146*, but he shall be notified of the filing of the bill by the clerk of the court in which it is filed and the Commissioner shall have the right to intervene in the action.



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# TABLES

## TABLE 1.—REVISED STATUTES AND STATUTES AT LARGE

*Showing where the subject matter of the Revised Statutes and Statutes at Large will be found in revised title 35*

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| 4914 | 144 |
| 4915 | 145, 146 |
| 4916 | 251, 252 |
| 4917 | 253 |
| 4918 | 291 |
| 4919 | 281, 284 |
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| 4921 | 283–6, 290 |
| 4922 | 288 |
| 4923 | 102, 104 |
| 4929 | 171 |
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| 4934 | 12, 13, 41 |
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### STATUTES AT LARGE

| Date | Chapter | Section | Volume | Page | Revised title 35—section |
|---|---|---|---|---|---|
| 1883—Mar. 3 | 143 | (Part) | 22 | 625 | 266 |
| 1887—Feb. 4 | 105 | 1 | 24 | 387 | 289 |
| | | 2 | 24 | 388 | 289 |
| 1888—Feb. 18 | 15 | | 25 | 40 | 153 |
| 1891—Mar. 3 | 541 | 1 (part) | 26 | 939 | 10 |
| 1896—May 19 | 204 | | 29 | 124 | 21 |
| 1897—Mar. 3 | 391 | 1 | 29 | 692 | 101, 102 |
| | | 2 | 29 | 692 | 282 |
| | | 3 | 29 | 693 | 102 (d), 119 |
| | | 4 | 29 | 693 | 133 |
| | | 5 | 29 | 693 | 261 |
| | | 6 | 29 | 694 | 286 |
| | | 7 | 29 | 694 | Omitted |
| 1898—June 10 | 423 | 1 | 30 | 440 | 9 |
| 1899—Feb. 28 | 227 | | 30 | 915 | 117 |
| 1902—Apr. 11 | 417 | | 32 | 95 | 153 |
| May 9 | 783 | | 32 | 193 | 171 |
| 1903—Mar. 3 | 1019 | 1 | 32 | 1225 | 102 (d), 119 |
| | | 2 | 32 | 1226 | 115 |
| | | 3 | 32 | 1226 | 117 |
| 1908—May 23 | 188 | | 35 | 245 | 117 |
| May 23 | 189 | | 35 | 246 | 151 |
| May 27 | 200 | 1 (part) | 35 | 343 | 41 |
| 1915—Jan. 14 | Pub. Res. 61 | | 38 | 1221 | 12 |
| Mar. 3 | 94 | 1 | 38 | 958 | 111, 112 |
| | | 2 | 38 | 959 | 115 |
| 1916—Feb. 15 | 22 | 1 | 39 | 8 | 3 |
| July 6 | 225 | 1 (part) | 39 | 348 | 133, 267 |
| 1919—Nov. 4 | 93 | 1 (part) | 41 | 335 | 41 |
| 1920—Mar. 6 | 94 | 1 (part) | 41 | 512 | 42 |
| 1921—Mar. 3 | 126 | 1 | 41 | 1313 | Omitted |
| | | 2 | 41 | 1314 | Omitted |
| | | 3 | 41 | 1314 | Omitted |



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| Date | Chapter | Section | Volume | Page | Revised title 35—section |
|---|---|---|---|---|---|
| 1921—Mar. 3 | | 4 | 41 | 1314 | Omitted |
| | | 5 | 41 | 1314 | Omitted |
| | | 6 | 41 | 1314 | Omitted |
| | | 7 | 41 | 1314 | Omitted |
| | | 8 | 41 | 1314 | Omitted |
| 1922—Feb. 18 | 58 | 3 | 42 | 390 | 31, 32 |
| | | 5 | 42 | 391 | 153 |
| | | 6 | 42 | 391 | 261 |
| | | 7 | 42 | 391 | 24 |
| | | 8 | 42 | 392 | 283–6, 250 |
| | | 9 | 42 | 393 | 12, 13, 41 |
| 1925—Mar. 4 | 535 | 1 | 43 | 1268 | 254 |
| 1927—Feb. 7 | 67 | | 44 | 1058 | 287 |
| Feb. 14 | 139 | 1 | 44 | 1098 | 3 |
| | | 2 | 44 | 1099 | 12, 13, 41 |
| Mar. 2 | 273 | 1 | 44 | 1335 | 133 |
| | | 3 | 44 | 1335 | 7 |
| | | 4 | 44 | 1336 | 135 |
| | | 5 | 44 | 1336 | 134 |
| | | 8 | 44 | 1336 | 141 |
| | | 9 | 44 | 1336 | 142 |
| | | 10 | 44 | 1336 | 143 |
| | | 11 | 44 | 1336 | 145, 146 |
| | | 12 | 44 | 1337 | 291 |
| | | 13 | 44 | 1337 | 41 |
| | | 14 | 44 | 1337 | 21 |
| 1927—Mar. 3 | 364 | | 44 | 1394 | 146, 291 |
| 1928—Apr. 30 | 460 | | 45 | 467 | 266 |
| May 24 | 730 | | 45 | 732 | 251, 252 |
| May 31 | 992 | 1 | 45 | 1012 | Omitted |
| | | 2 | 45 | 1013 | Omitted |
| | | 3 | 45 | 1013 | Omitted |
| | | 4 | 45 | 1014 | Omitted |
| 1929—Mar. 2 | 488 | 2b | 45 | 1476 | 141, 145, 146 |
| 1930—Apr. 11 | 132 | 1 | 46 | 155 | 3 |
| | | 2 | 46 | 155 | 7 |
| | | 3 | 46 | 155 | 12, 13, 41 |
| | | 5 | 46 | 156 | Omitted |
| May 23 | 312 | 1 | 46 | 376 | 101, 102, 154, 161, 163 |
| | | 2 | 46 | 376 | 162 |
| | | 3 | 46 | 376 | 115 |
| | | 4 | 46 | 376 | 164 |
| | | 5 | 46 | 376 | Omitted |
| | | 6 | 46 | 376 | Sec. 3 of Bill |
| 1932—June 30 | 314 | 308 | 47 | 410 | 41 |
| | | 309 | 47 | 410 | 41 |
| 1936—June 19 | 594 | | 49 | 1529 | 102 (d), 119, 172 |
| 1938—May 9 | 188 | | 52 | 342 | 33 |
| 1939—Aug. 5 | 450 | 1 | 53 | 1212 | 102, 119 |
| | | 2 | 53 | 1212 | Sec. 4 (d) of Bill |
| Aug. 5 | 451 | 1 | 53 | 1212 | 135 |
| | | 2 | 53 | 1212 | 134 |
| | | 3 | 53 | 1212 | 141 |
| | | 4 | 53 | 1212 | 145, 146 |
| Aug. 5 | 452 | 1 | 53 | 1213 | 135 |
| 1939—Aug. 7 | 568 | | 53 | 1264 | 133 |
| Aug. 9 | 619 | 2 | 53 | 1293 | 151 |
| | | 3 | 53 | 1293 | 41 |
| 1941—Aug. 18 | 370 | | 55 | 634 | 261 |
| 1946—July 5 | 541 | 301 (part) | 60 | 471 | 41 |
| Aug. 1 | 726 | | 60 | 778 | 283–6, 290 |
| Aug. 8 | 910 | 9 | 60 | 943 | 104 |
| 1950—Mar. 4 | 50 | | 64 | 11 | 7 |
| June 15 | 249 | | 64 | 215 | 13 |
| 1951—Oct. 31 | 655 | 53a | 65 | 728 | 146, 291 |
| 1952—Feb. 1 | 4 | 1 | 66 | 3 | 181 |
| | | 2 | | 4 | 182 |
| | | 3 | | 4 | 183 |
| | | 4 | | 5 | 184 |
| | | 5 | | 5 | 185 |
| | | 6 | | 5 | 186 |
| | | 7 | | 6 | 187 |
| | | 8 | | 6 | 188 |
| | | 9 | | 6 | Sec. 3 of Bill |
| | | 11 | | 6 | Sec. 4 (f) of Bill |
| | | 12 | | 6 | Omitted |

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## TABLE 2.—UNITED STATES CODE

*Showing where sections of the United States Code, 1946 edition, will be found in revised title 35*

| 35 U. S. C. 1946 ed., section | Revised, title 35, section | 35 U. S. C. 1946 ed., section | Revised, title 35, section | 35 U. S. C. 1946 ed., section | Revised title 35, section |
|---|---|---|---|---|---|
| 1 | 1 | 37 | 133, 267 | 66 | 291 |
| 2 | 3 | 39 | 153 | 67 | 281, 284 |
| 3 | 2 | 40 | 154 | 69 | 282 |
| 4 | 4 | 40a to 40d | Omitted | 70 | 283-6, 290 |
| 5 | 5 | 41 | 151 | 71 | 288 |
| 6 | 6 | 43 | Omitted | 72 | 102, 104 |
| 7 | 7 | 44 | 152 | 72a | 146, 291 |
| 10 | 8 | 45 | 256 | 73 | 171 |
| 11 | 31, 32 | 46 | 117 | 74 | 289 |
| 11a | 33 | 47 | 201 | 75 | 289 |
| 12 | 22 | 48 | Omitted | 76 | 114 |
| 13 | 11 | 49 | 287 | 77 | 173 |
| 14 | 10 | 50 | 292 | 78 | 12, 13, 41 |
| 15 | 12 | 51 | 132, 135 | 79 | 42 |
| 16 | 11 (a) 1 | 52 | 135 | 80-87 | Omitted |
| 19 | Omitted | 53 | 23 | 88 | 251 |
| 20 | 14 | 54 | 21 | 109 | 104 |
| 21 | 21 | 55 | 24 | 151 | 181 |
| 22 | Omitted | 56 | 21 | 152 | 182 |
| 31 | 101, 102, 161 | 56a | 161 | 153 | 183 |
| 32 | 102 (d), 119, 172 | 57 | 131 | 154 | 184 |
| | | 59a | 141 | 155 | 185 |
| 32a | Omitted | 60 | 142 | 156 | 186 |
| 32b | Sec. 3 of bill | 61 | 143 | 157 | 187 |
| 33 | 111, 112, 162 | 62 | 144 | 158 | 188 |
| 34 | 113, 114 | 63 | 145, 146 | 159 | Sec. 4 (f) of bill |
| 35 | 115 | 64 | 251, 252 | | |
| 36 | 131 | 65 | 253 | | |

## TABLE 3.—LAWS OMITTED AND REPEALED

| Revised Statutes or Statutes at Large | Reason for omission and repeal |
|---|---|
| R. S. 496 (35 U. S. C., 1946 ed. § 19) | Superseded, the function of disbursement was transferred to Treasury in 1933 by Executive Order 6166, see notes under 35 U. S. C., 1946 ed., § 19. |
| R. S. 4899 (35 U. S. C., 1946 ed. § 48) | Redundant and unnecessary. |
| Mar. 3, 1897, ch. 391, § 7, 29 Stat. 694 (35 U. S. C., 1946 ed. § 43). | Has no apparent meaning. |
| Mar. 3, 1921, ch. 126, §§ 1–8, 41 Stat. 1313, 1314 (35 U. S. C., 1946 ed. § 80–87). | Obsolete. |
| May 31, 1928, ch. 992, §§ 1–4, 45 Stat. 1012–1014 (35 U. S. C., 1946 ed. § 40a–40d). | Executed and obsolete. |
| Apr. 11, 1930, ch. 132, § 5, 46 Stat. 156 (35 U. S. C., 1946 ed. § 22). | Superseded by act of June 26, 1934, ch. 756, § 6, 48 Stat. 1228 (31 U. S. C., 1946 ed., § 725e). |
| May 23, 1930, ch. 312, § 5, 46 Stat. 376 (35 U. S. C., 1946 ed. § 32a). | Obsolete. |
| Feb. 1, 1952, ch. 4, § 12, 66 Stat. 6 | Obsolete short title. |

## TABLE 4.—LAWS OMITTED BUT NOT REPEALED

*Showing laws omitted from this revision but not included in the schedule of repeals*

The following statutes are not included in the revision, since they are mainly of a temporary nature and will be appropriately codified as may be necessary.

Oct. 31, 1942, ch. 634, 56 Stat. 1013 (35 U. S. C., 1946 ed. §§ 89–97. Royalty Adjustment Act, expires by its terms.

Aug. 8, 1946, ch. 910, 60 Stat. 990 (35 U. S. C., 1946 ed., §§ 101–114). Boykin Act; except section 9 (35 U. S. C., 1946 ed. sec. 109) which is in section 104. The time for taking action under this act has expired.

July 23, 1947, ch. 302, 61 Stat. 413. Extension of Boykin Act.

Aug. 6, 1947, ch. 511, 61 Stat. 794. relating to peace treaties and patents to citizens of Germany and Japan

June 30, 1950, ch. 444, 64 Stat. 316 (35 U. S. C., 1946 ed., §§ 115–118). Relates to extensions of patents to veterans of World War II, the time for taking action under this act has expired.

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Calendar No. 1908

82D CONGRESS
2d Session

SENATE

REPORT
No. 1979

# REVISION OF TITLE 35, UNITED STATES CODE

JUNE 27, 1952.—Ordered to be printed

Mr. WILEY, from the Committee on the Judiciary, submitted the following

## REPORT

[To accompany H. R. 7794]

The Committee on the Judiciary, to which was referred the bill (H. R. 7794) to revise, codify, and enact into law title 35 of the United States Code entitled "Patents," having considered the same, reports favorably thereon, with amendments, and recommends that the bill, as amended, do pass.

### AMENDMENTS

Amendment No. 1: On page 9, line 3 of subdivision (d), section 102, strike the word "or" and insert in lieu thereof the word "on".

Amendment No. 2: On page 29, subdivision (1) of section 282, strike out the word "or" and insert in lieu thereof a comma.

Amendment No. 3: On page 29, subdivision (1) of section 282, strike out the comma after the word "infringement" and insert in lieu thereof "or unenforceability,".

Amendment No. 4: On page 29, first line of section 284, strike out "Upon adjudging a patent valid and infringed" and insert in lieu thereof the following: "Upon finding for the claimant".

### PURPOSE

The purpose of the proposed legislation is to revise and codify the laws relating to patents and enact into law title 35 of the United States Code entitled "Patents".

### STATEMENT

Hearings were held in the House on H. R. 3760, which dealt with the matter of the codification of title 35, and as a result of those hearings the bill was revised and introduced as H. R. 7794.

This bill is part of the comprehensive program of revising and enacting into law all the titles of the United States Code. Up to the present time 9 out of the 50 titles of the code have been revised and enacted into law and consideration or preparation of bills relating to a number of additional titles is in process.



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For many years there had been considerable agitation for a complete restatement and codification of all the laws of the United States, inasmuch as the only such codification—the Revised Statutes of 1874—had become generally outmoded on all subjects.

In 1926, in response to widespread recognition of the need therefor, and after nearly 7 years' effort, the Congress adopted the United States Code, which was a codification of the existing general and permanent laws of the United States arranged in 50 titles according to subject matter, and which was declared to be prima facie evidence of the law.

Because of the size of that code Congress decided that it should undergo a testing period before it was enacted into positive law.

The code has now been subjected to such a testing period lasting more than 25 years.

The present patent laws consist of about 60 sections of the Revised Statutes of 1874, together with a large number of acts of Congress passed since that date revising various sections of the Revised Statutes or making new enactments not related to any section of the Revised Statutes.

Since the sections of the Revised Statutes relating to patents were merely a compilation of the act of July 8, 1870, 16 Stat. 198, our present patent law is essentially the act of 1870 with subsequent amendatory and supplemental enactments.

The last general revision of the patent laws was the act of July 8, 1870, which was enacted as part of a program to revise and consolidate all the laws of the United States then under way. In 1866 Congress passed a law providing for a commission to revise and consolidate the statutes of the United States. The Commission which was appointed to perform this work prepared a preliminary draft of the part relating to patents and copyrights in 1868, and a second preliminary draft in 1869. The following year a draft of the statutes relating to patents and copyrights as revised, simplified, arranged, and consolidated by the Commission was reported to Congress, and at the same time referred to the Committee on Patents; a bill was introduced by the chairman a few days later.

The object of the Commission on revision of the laws was only to revise, arrange, and consolidate the statutes in force and the draft reported from the Commission presumably was for this purpose only.

The probable reason for referring the matter to the Committee on Patents was that during this same period there had been suggestions for amending the patent laws in substance and it appears that the Committee on Patents studied the draft of the Commission and changed it by various amendments affecting matters of substance. The bill thus introduced was enacted on July 8, 1870, 16 Stat. 198, and included the subjects of copyrights and trade-marks as well as patents.

When the Revised Statutes, as in force on December 1, 1873, were enacted on June 22, 1874, the sections of the act of 1870 were distributed in various parts of the Revised Statutes.

As has already been stated, the present patent laws consist of the Patent Act of 1870 with subseqnent enactments adding to or changing various sections of that original act. The first patent law was enacted in the second session of the First Congress in 1790. When the first Congress met, one of its very first items of business was the considera-

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tion of patents and copyrights, and the first patent bill was H. R. 10 of the First Congress.

The patent laws are enacted by Congress in accordance with the power granted by article I, section 8, of the Constitution which provides that:

> The Congress shall have the power * * * to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

This provision was unanimously adopted by the Constitutional Convention following suggestions for Federal jurisdiction over both patents and copyrights which had been made in the Convention by James Madison of Virginia and Charles Pinckney of South Carolina. Each proposed separate provisions relating to patents and to copyrights which were merged by the Drafting Committee of the Convention into the general statement we now have, which was adopted without any dissenting voice.

The background, the balanced construction, and the usage current then and later, indicate that the constitutional provision is really two provisions merged into one. The purpose of the first provision is to promote the progress of science by securing for limited times to authors the exclusive right to their writings, the word "science" in this connection having the meaning of knowledge in general, which is one of its meanings today. The other provision is that Congress has the power to promote the progress of useful arts by securing for limited times to inventors the exclusive right to their discovereis. The first patent law and all patent laws up to a much later period were entitled "Acts to promote the progress of useful arts."

The first patent law, which was enacted on April 10, 1790, vested the jurisdiction to issue patents in a Board consisting of the Secretary of State, the Attorney General, and the Secretary of War. The person principally interested and the leader of the group was the Secretary of State, Thomas Jefferson, who was personally deeply interested in the subject matter of patent law. Jefferson was not a patentee himself, but he was the inventor of a number of devices, most of them being "gadgets."

This first law made the power of the Board to issue patents absolute, and also provided for various things that would be necessary in a general patent law.

While the Board, and particularly Thomas Jefferson, was quite favorable to the granting of patents, and granted them with great consideration, the other duties of members of this Board, in view of their high offices, made it impossible for them to devote much time to this work, and as a result the law was changed in 1793 to make the granting of patents a clerical function. Under the act of 1793 patents were granted to anyone who applied on fulfilling the formal requirements and filing the necessary papers and fees.

This law continued in force until 1836 when the dissatisfaction with the granting of patents without any examination as to novelty or other matters led to the appointment of a select committee by the Senate which introduced a bill that became the new law which was enacted on July 4, 1836. This new law contains the fundamental principles of our present patent law. It created a Patent Office with a Commissioner of Patents at the head, and examiners with the func-

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tion of examining applications for patents and with the power to refuse patents, which was not present in the previous law. The law had many other provisions in it relating to details of procedure, enforcement of patents, and matters of that sort.

Amendments were made to this act of 1836 at various times until 1870 when the law was completely revised in the manner above referred to.

The present bill in a sense, then, is the second revision and codification of the patent laws.

A detailed description of the provisions of H. R. 7794 as set forth in House Report No. 1923, Eighty-second Congress, is as follows:

Although the principal purpose of the bill is the codification of title 35, United States Code, and involves simplification and clarification of language and arrangement, and elimination of obsolete and redundant provisions there are a number of changes in substantive statutory law. These will be explained in some detail in the revision notes keyed to each section which appear in the appendix of this report. The major changes or innovations in the title consist of incorporating a requirement for invention in § 103 and the judicial doctrine of contributory infringement in § 271.

The bill divides the statutes into three parts. The first part contains the sections of the law relating to the Patent Office generally, its powers and duties and some ancillary matters of that kind. The second part consists of the sections relating to the conditions under which a patent may be obtained and the procedure in obtaining patents. The third part contains the sections relating to the patents themselves and the protection of rights under patents, and matters relating to that phase of the subject.

Stated generally, these three parts relate to, first, the Patent Office, second, obtaining a patent, and third, the patent itself. Of course it has not been possible to maintain this three-part division strictly and there may be some overlapping of the three phases of the subject. In each part the sections are arranged in several chapters of more or less homogeneous subject matter, with chapter headings.

The organization of the bill and the arrangement of the sections are such that new future amendments can readily find their place in the organization. Catch lines of parts, chapters, and sections are provided for convenience of reference.

The first chapter in part I relates to the Patent Office and covers the establishment of the Patent Office, its seal, officers and employees, restrictions on officers and employees as to interest in patents, bond of the Commissioner, duties of the Commissioner, the Board of Appeals, the Patent Office library, etc. Very little change is introduced in these sections. There is one change in section 3, relating to a temporary successor to the Commissioner when the office is vacant, filling a gap in the present law. There is a change in section 4 relating to the disability of Patent Office employees to obtain patents.

The next chapter collects some of the details relating to procedure in the Patent Office of general application with no important changes.

The next group, sections 31, 32, and 33 relate to practice before the Patent Office. In them the language of the prior statutes has been rearranged and divided into several sections. There has been no change in substance in these sections, except in the third of this group which is a criminal provision for unauthorized practice. The

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language has been considerably simplified, and the maximum fine has been raised from $100 to $1,000.

In the next group of sections, relating to Patent Office fees, there have been a few readjustments in some minor fees, and an upward change in the fee for an appeal to the Board of Appeals.

The sections of the first part apply to the Patent Office as such, and, except for provisions specific to patents, include trade-marks as well as patents, where they relate to organizational and procedural matters, since the registration of trade-marks is handled by the Patent Office.

Part II relates to patentability of inventions and the grant of patents.

Referring first to section 101, this section specifies the type of material which can be the subject matter of a patent. The present law states that any person who has invented or discovered any "new and useful art, machine, manufacture, or composition of matter, or any new or useful improvement thereof" may obtain a patent. That language has been preserved except that the word "art" which appears in the present statute has been changed to the word "process." "Art" in this place in the present statute has a different meaning than the words "useful art" in the Constitution, and a different meaning than the use of the word "art" in other places in the statutes, and it is interpreted by the courts to be practically synonymous with process or method. The word "process" has been used to avoid the necessity of explanation that the word "art" as used in this place means "process or method," and that it does not mean the same thing as the word "art" in other places.

The definition of "process" has been added in section 100 to make it clear that "process or method" is meant, and also to clarify the present law as to the patentability of certain types of processes or methods as to which some insubstantial doubts have been expressed.

Section 101 sets forth the subject matter that can be patented, "subject to the conditions and requirements of this title." The conditions under which a patent may be obtained follow, and section 102 covers the conditions relating to novelty.

A person may have "invented" a machine or a mannfacture, which may include anything under the sun that is made by man, but it is not necessarily patentable under section 101 unless the conditions of the title are fulfilled.

Section 102 in paragraphs (a), (b), and (c) repeats the conditions in the existing law relating to novelty.

Subsection (a) is the language of the existing law, recognizing that the interpretation by the courts excludes various kinds of private knowledge not known to the public.

Paragraph (d) relating to a bar to patentability when the inventor has previously obtained a patent in a foreign country, represents a liberalizing change in the existing law.

Subsection (e) is another well-recognized condition imposed by a decision of the Supreme Court which was not expressed in the existing law; for the purpose of anticipating subsequent inventors, a patent disclosing the subject matter speaks from the filing date of the application disclosing the subject matter.

Subsection (f) merely emphasizes that it is the inventor that applies for the patent.

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Subsection (g) relates to the question of priority of invention between rival inventors.

Section 102, in general, may be said to describe the statutory novelty required for patentability, and includes, in effect, an amplification and definition of "new" in section 101.

Section 103, for the first time in our statute, provides a condition which exists in the law and has existed for more than 100 years, but only by reason of decisions of the courts. An invention which has been made, and which is new in the sense that the same thing has not been made before, may still not be patentable if the difference between the new thing and what was known before is not considered sufficiently great to warrant a patent. That has been expressed in a large variety of ways in decisions of the courts and in writings. Section 103 states this requirement in the title. It refers to the difference between the subject matter sought to be patented and the prior art, meaning what was known before as described in section 102. If this difference is such that the subject matter as a whole would have been obvious at the time to a person skilled in the art, then the subject matter cannot be patented.

That provision paraphrases language which has often been used in decisions of the courts, and the section is added to the statute for uniformity and definiteness. This section should have a stabilizing effect and minimize great departures which have appeared in some cases.

The next group of sections relates to the application for a patent.

Sections 116 and 118 introduce a new element in our statutes. The existing statute is very strict in requiring that only the inventor may apply for a patent. These two sections provide for certain types of situations where it may be impossible for the inventor himself to apply, or where, in the case of a joint invention, one of the joint applicants has been inadvertently erroneously included, or a joint inventor inadvertently excluded; the sections provide all the safeguards necessary for the inventor.

Section 119 introduces a minor change.

Sections 120 and 121 express in the statute certain matters which exist in the law today but which had not before been written into the statute, and in so doing make some minor changes in the concepts involved.

Section 122 incorporates into the title the rule of secrecy of patent applications which has existed in the Patent Office for generations.

The next chapter relates to the examination of the application in the Patent Office; rejection by the examiner, the right to reconsideration, the time within which an applicant must reply to actions, time for prosecuting application, appeal to the Board, and interferences between rival claimants for a patent. Very little has been changed in this group of sections except a minor revision in the interference section.

The next chapter relates to the review of Patent Office decisions.

The act of 1836 provided, for the first time, for the refusal of patents by officials known as examiners. The legislature was jealous of the rights of the public and provided adequate means of reviewing the action of the Patent Office. In fact, there are now two types of review. The applicant may appeal to a court of appeals especially

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provided, or he may file suit in the district court against the Commissioner to have his rights adjudicated by the court.

This group of sections makes no fundamental change in the various appeals and other review of Patent Office action, but has made a few changes in the procedure in various instances to correct some of the problems which have arisen, particularly in section 146. These details are mainly procedural.

Chapter 15 collects the provisions relating to plant patents, the next those relating to designs, and chapter 17 restates the recently enacted statute relating to secrecy of certain inventions.

Part III deals with the patent itself after it has been granted.

The first chapter of this part relates to correcting and amending a patent.

Sections 251 and 252 are a development of the present statute relating to what are called reissues. Under certain circumstances the patentee may obtain a new patent to replace the old one to correct certain kinds of defects that he may have discovered in the patent. These two sections together replace the present one, make a number of clarifications and a few additions in further development of the subject.

Section 253 relates to another form of correction of a patent known as the disclaimer. The patentee files a paper in the Office which is recorded. He disclaims certain things from the scope of his patent or disclaims certain claims. This subject of disclaimers, in the present law, has resulted in a great deal of confusion and uncertainty in certain situations in the law which at times are almost ridiculous. Consequently, the bill in two sections, 253 and 288, has introduced certain changes relating to disclaimers. One of these changes is that only a whole claim can be disclaimed; a patent cannot be rewritten by filing a paper in the Patent Office.

The second change relates to the situation when a patent has two or more claims and one of them may be discovered to be invalid. There is now a provision in the statute under which an invalid claim must be disclaimed without unreasonable delay in order to save the rest of the patent. What delay is unreasonable is presently quite confusing, and the present law does not, as a matter of fact, prevent the patentee from suing again on the invalid claim if he so wishes.

The bill has eliminated that requirement. It has left the situation so that if one claim of a patent is invalid, the patentee may take it out. He may sue on the remaining claims which have whatever validity they may have on their own merits. That is, one bad claim does not affect the other claims, unless they are also bad for similar reasons.

Other provisions of the bill take care at least as well as is done in the present law of the possibility of a patentee suing again after his patent has been held invalid. That can be done today and no change is made in that situation, except that certain provisions tend to deter doing such a thing.

Section 255, which permits the Patent Office to correct by a certificate a merely clerical error made by the patentee, is new.

Section 256 is a new section in the law that is correlated with section 116 and relates to a mistake in joining a person as a joint inventor. Very often two or three people make an invention together. They

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must apply as joint inventors. If they make a mistake in determining who are the true inventors, they do so at their peril. This provision permits a bona fide mistake in joining a person as inventor or in failing to join a person as an inventor to be corrected.

The next chapter of two sections relates to assignments and ownership.

Section 262 merely states in the statute a peculiarity relating to joint ownership.

The next two sections collect provisions now in the law referring to the Government ownership of patents, making little change except in language.

The next chapter relates to infringements of patents.

Section 271, paragraph (a), is a declaration of what constitutes infringement. There is no declaration of what constitutes infringement in the present statute. It is not actually necessary because the granting clause creates certain exclusive rights and infringement would be any violation of those rights.

Paragraphs (b), (c), and (d) relate to the subject referred to as contributory infringement. The doctrine of contributory infringement has been part of our law for about 80 years. It has been applied to enjoin those who sought to cause infringement by supplying someone else with the means and directions for infringing a patent. One who makes a special device constituting the heart of a patented machine and supplies it to others with directions (specific or implied) to complete the machine is obviously appropriating the benefit of the patented invention. It is for this reason that the doctrine of contributory infringement, which prevents appropriating another man's patented invention, has been characterized as "an expression both of law and morals." Considerable doubt and confusion as to the scope of contributory infringement has resulted from a number of decisions of the courts in recent years. The purpose of this section is to codify in statutory form principles of contributory infringement and at the same time eliminate this doubt and confusion. Paragraph (b) recites in broad terms that one who aids and abets an infringement is likewise an infringer. The principle of contributory infringement is set forth in the provisions of the next paragraph which is concerned with the usual situation in which contributory infringement arises. This latter paragraph is much more restricted than many proponents of contributory infringement believe should be the case. The sale of a component of a patented machine, etc., must constitute a material part of the invention and must be known to be especially made or especially adapted for use in the infringement before there can be contributory infringement. and likewise the sale of staple articles of commerce suitable for noninfringement use does not constitute contributory infringement. The last paragraph of this section provides that one who merely does what he is authorized to do by staute is not guilty of misuse of the patent. These paragraphs have as their main purpose clarification and stabilization.

Section 272 is a new section in the law relating to infringement, but it is of relatively little importance and it follows a paragraph in a treaty to which the United States is a party.

Beginning with 281 is a group of sections relating to remedy for infringement of a patent, the suit in the courts. The present statutes

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on this matter are in confusion because they were written quite some time ago and court procedure and the names of actions and so on have changed since then. So the present sections were substantially reorganized into a group of sections fitting in at this place, with some changes.

Section 281 is a declaration which serves as a preamble to the others.

Section 282 introduces a declaration of the presumption of validity of a patent, which is now a statement made by courts in decisions, but has had no expression in the statute. The defenses to a suit for infringement are stated in general terms, changing the language in the present statute, but not materially changing the substance.

The next few sections relate to injunctions, damages, attorney fees, the statute of limitations, and to marking and notice; all of which together replace present statutes on suits, with a good deal of reorganization in language to clarify the statement of the statutes.

Section 288 is the companion section to the disclaimer section, 253.

Section 292 is a criminal statute relating to falsely marking an article as being patented when it was not patented, which is now the present law. But this section revises it and makes a few changes, and also makes it an ordinary criminal action as well as an informer action as in the present statute.

Section 293 is a new section that is needed on some occasions to obtain jurisdiction over foreign patent owners that do not reside in the United States.

The revision notes, which follow and constitute a part of this report, point out in more detail the revisions made by the bill.

The committee is of the opinion that the codification of title 35 is most desirable in order that the laws relating to patents can be readily accessible and understandable. Previous codifications, such as those of titles 18 and 28, have proved their worth, and after a study of the bill H. R. 7794 the committee believes that it should be given favorable consideration.

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# APPENDIX

## REVISION NOTES

Notes explaining in detail the revision of the laws relating to patents are set forth in numerical order according to the section numbers of the revised title.

### Title 35—Patents


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#### PART II. PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS


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## CHAPTER 1. ESTABLISHMENT, OFFICERS, FUNCTIONS

Sec.


1. Establishment.
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3. Officers and employees.
4. Restrictions on officers and employees as to interest in patents.
5. Bond of Commissioner and other officers.
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7. Board of Appeals.
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12 Exchange of copies of patents with foreign countries.
13. Copies of patents for public libraries.
14. Annual report to Congress.




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### SECTION 1—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 1 (R. S. 475 and Executive Order 4175, Mar. 17, 1925).

The word "all" is omitted from the corresponding section of the existing statute and "except as otherwise provided by law" added, since some old records are kept in the National Archives, see 44 U. S. C., 1946 ed., ch. 8A.

The word "models" has been omitted to remove emphasis on models since they are no longer generally required. They are included by the word "things."

The phrase "and to trade-mark registrations" is added. There is no enactment corresponding to this section in the trade-mark law. The original chapter of the Revised Statutes containing this section deals with the Patent Office as such in its administration of trade-marks as well as patents. This is explicitly brought out in some of the corresponding sections of the present chapter.

Changes in language are made.

### SECTION 2—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 3 (R. S. 478).

"Certificates of trade-mark registrations" is added, see note under section 1. Changes in language are made and the specific date eliminated.

### SECTION 3—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 2 (R. S. 476, amended (1) Feb. 15, 1916, ch. 22, § 1, 39 Stat. 8, (2) Feb. 14, 1927, ch. 139, § 1, 44 Stat. 1098, (3) April 11, 1930, ch. 132, § 1, 46 Stat. 155).

The temporary designation of the assistant commissioner as Commissioner in case of a vacancy in office is added. This will eliminate complications since present applicable general statutes (5 U. S. C., 1946 ed., § 7) permit a vacancy to be temporarily filled only for not more than 30 days.

Changes in language are made. "Assistant commissioners" is used in the second sentence (and elsewhere in the bill) as referring to all three assistants.

This entire title is subject to Reorganization Plan No. 5 of 1950 (64 Stat. 1263) which vests all functions of the Patent Office in the Secretary of Commerce and authorizes delegation by him. It has been found impractical to so word the various sections of the title, and a general provision has been inserted as the second paragraph of this section of the bill, leaving the wording of various sections of the title in terms of officers previously specified and to whom the functions presently stand delegated.

### SECTION 4—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 4 (R. S. 480).

The language is revised and inability to apply for a patent, included in the original language, is made explicit.

The period of disability is increased to include one year after leaving the Office.

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The further restriction, that no priority date earlier than one year after leaving the Office can be claimed, is added.

The one year period is made inapplicable to applications which may be pending when the revised title goes into effect by section 4 (g) of the bill.

SECTION 5—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 5 (R. S. 479).

Specific mention of the office of chief clerk is omitted from the corresponding section of the existing statute, the officers requiring bonds, and the amounts of the bonds are to be designated by the Commissioner.

SECTION 6—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 6 (R. S. 481 and 483).

The two sections are combined into one with some changes in language.

"And the registration of trade-marks" is added, see note under section 1.

SECTION 7—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 7 (R. S. 482, amended (1) Mar. 2, 1927, ch. 273, § 3, 44 Stat. 1335, (2) April 11, 1930, ch. 132, § 2, 46 Stat. 155, (3) Mar. 4, 1950, ch. 50, 64 Stat. 11).

Some changes in language have been made and the reference to interferences, which are no longer considered by the Board of Appeals, has been deleted. Reference to reissues is omitted in view of the general provision in section 201.

SECTION 8—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 10 (R. S. 486).

Some change in language has been made. "Purchased" is changed to "maintained" to include the existing library and keeping it up by additions. The phrase "and other" is added to include legal works. The last phrase of the corresponding section of the existing statute is omitted as unnecessary.

SECTION 9—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 6 note (June 10, 1898, ch. 430, § 1, 30 Stat. 440).

Changes in language are made.

SECTION 10—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 14 (Mar. 3, 1891, ch. 541, § 1 (part), 26 Stat. 908, 940).

Reference to other records is added. The fee for certification is omitted as it appears in the table of fees.

SECTION 11—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., §§ 13 and 16 (R. S. 489; July 9, 1947, ch. 211, § 301 (part), 61 Stat. 299, repeated in prior and subsequent appropriation acts).

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Section is amplified to list the publications of the Patent Office, based on 44 U. S. C., 1946 ed., § 283, 283a.

The second sentence of item 1 of the revised section is a provision appearing annually in appropriation acts to enable the Patent Office to maintain a small printing press to place headings on drawings before the drawings are reproduced.

Language is changed.

### SECTION 12—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., §§ 15 and 78, part (Jan. 14, 1915, 38 Stat. 1221; Feb. 18, 1922, ch. 58, § 9, proviso in, 42 Stat. 393).

The first act mentioned applies to Canada only, the second to any country; these are consolidated in one section, specific reference to one country not being necessary.

Language is changed.

### SECTION 13—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 78, part (R. S. 4934, Feb. 18, 1922, ch. 58, § 9, 42 Stat. 389, 393, amended June 15, 1950, ch. 249, 64 Stat. 215).

The proviso in the schedule of fees of the existing statute is made a separate section and some changes in language are made.

### SECTION 14—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 20 (R. S. 494).

Language is changed. The lists referred to in the corresponding section of existing statute, and which are omitted from the revised section, are the indexes provided for in section 11 (a) 4. The month of reporting is omitted. The report contemplated by R. S. 494 has been discontinued since 1925 under authority of 44 U. S. C., 1946 ed., § 212.

## CHAPTER 2. PROCEEDINGS IN THE PATENT OFFICE

Sec.

21. Day for taking action falling on Saturday, Sunday or holiday.
22. Printing of papers filed.
23. Testimony in Patent Office cases.
24. Subpoenas, witnesses.

### SECTION 21—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 21 (Mar. 2, 1927, ch. 273, § 14, 44 Stat. 1337).

"Fixed by statute" is omitted from the corresponding section of the existing statute as unnecessary. Saturday is added as a day on which action need not be taken.

### SECTION 22—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 12 (R. S. 488).

Language is changed and "or typewritten" is added after "printed."

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SECTION 23—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 53 (R. S. 4905).

This section is placed in part 1 since it relates to trade-mark cases in the Patent Office as well as to patent cases.

Language is changed.

SECTION 24—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., §§ 54, 55 and 56 (R. S. 4906, amended Feb. 18, 1922, ch. 58, § 7, 42 Stat. 389, 391–2; R. S. 4907; R. S. 4908).

Three sections of the existing statute are combined with some changes in language and placed in part 1 since they apply to trade-mark cases in the Patent Office as well as to patent cases. Reference to a repealed statute in the first paragraph is replaced by reference to the Federal Rules of Civil Procedure and certain rules are made applicable.

## CHAPTER 3, PRACTICE BEFORE PATENT OFFICE

Sec.

31. Regulations for agents and attorneys.
32. Suspension or exclusion from practice.
33. Unauthorized representation as practitioner.

SECTION 31—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 11 (R. S. 487, amended Feb. 18, 1922, ch. 58, § 3, 42 Stat. 390).

The present statute is divided into two sections, 31 and 32.

Changes in language are made.

SECTION 32—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 11 (R. S. 487 amended Feb 18, 1922, ch. 58, § 3, 42 Stat. 390).

See note under section 31.

SECTION 33—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 11a (May 9, 1938, ch. 188, 52 Stat. 342).

This is a criminal statute. The language has been considerably simplified and the upper limit of the penalty is increased.

## CHAPTER 4. PATENT FEES

Sec.

41. Patent fees.
42. Payment of patent fees; return of excess amounts.

SECTION 41—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 78 (R. S. 4934, amended (1) May 27, 1908, ch. 200, § 1 (part) 35 Stat. 317, 343; (2) June 25, 1910, ch. 414, § 2, 35 Stat. 843; (3) Feb. 18, 1922, ch. 58, § 9, 42 Stat. 389, 393; (4) Feb. 14, 1927, ch. 139, § 2, 44 Stat. 1098, 1099; (5) Mar

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2, 1927, ch. 273, § 13, 44 Stat. 1335, 1337; (6) April 11, 1930, ch. 132, § 3, 46 Stat. 155; (7) June 30, 1932, ch. 314, §§ 308, 309, 47 Stat. 382, 410; (8) Aug. 9, 1939, ch. 619, § 3, 53 Stat. 1293; July 5, 1946, ch. 541, § 301 (part), 60 Stat. 446, 471.

The items in the schedule of fees are rearranged in a few instances and are numbered for convenient reference.

The obsolete fee for appeal from the examiners of interferences to the Board of Appeals is omitted.

The fee for appeal to the Board of Appeals is changes from $15 to $25.

Two provisos in the corresponding section of the existing statute have been made separate sections, see sections 12 and 13.

The fee for a certificate is changed from 50 cents to $1 to correspond to the same fee in the trade-mark statute.

A new item (8) is added to go with section 205.

An omnibus item to take care of miscellaneous minor fees is added; in view of this, two items in the present schedule are omitted.

The fee for reissue applications is changed slightly.

### SECTION 42—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 79 (Mar. 6, 1920, ch. 94, § 1 (part), 41 Stat. 503, 512).

Language has been changed.

## PART II. PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS


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## CHAPTER 10. PATENTABILITY OF INVENTIONS


Sec.
100. Definitions.
101. Inventions patentable.
102. Conditions for patentability; novelty and loss of right to patent.
103. Conditions for patentability; nonobvious subject matter.
104. Invention made abroad.


### SECTION 100—NEW SECTION

Paragraph (a) is added only to avoid repetition of the phrase "invention or discovery" and its derivatives throughout the revised title. The present statutes use the phrase "invention or discovery" and derivatives.

Paragraph (b) is noted under section 101.

Paragraphs (c) and (d) are added to avoid the use of long expressions in various parts of the revised title.

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### SECTION 101—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 31 (R. S. 4886, amended (1) Mar. 3, 1897, ch. 391, § 1, 29 Stat. 692, (2) May 23, 1930, ch. 312, § 1, 46 Stat. 376, (3) Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212).

The corresponding section of existing statute is split into two sections, section 101 relating to the subject matter for which patents may be obtained, and section 102 defining statutory novelty and stating other conditions for patentability.

Section 101 follows the wording of the existing statute as to the subject matter for patents, except that reference to plant patents has been omitted for incorporation in section 301 and the word "art" has been replaced by "process", which is defined in section 100. The word "art" in the corresponding section of the existing statute has a different meaning than the same word as used in other places in the statute; it has been interpreted by the courts as being practically synonymous with process or method. "Process" has been used as its meaning is more readily grasped than "art" as interpreted, and the definition in section 100 (b) makes it clear that "process or method" is meant. The remainder of the definition clarifies the status of processes or methods which involve merely the new use of a known process, machine, manufacture, composition of matter, or material; they are processes or methods under the statute and may be patented provided the conditions for patentability are satisfied.

### SECTION 102—SECTION REVISED

Paragraphs (a), (b), and (c) are based on 35 U. S. C., 1946 ed., § 31 (R. S. 4886, amended (1) Mar. 3, 1897, ch. 391, § 1, 29 Stat. 692, (2) May 23, 1930, ch. 312, § 1, 46 Stat. 376, (3) Aug. 5, 1939, ch. 450, §1, 53 Stat. 1212).

No change is made in these paragraphs other than that due to division into lettered paragraphs. The interpretation by the courts of paragraph (a) as being more restricted than the actual language would suggest (for example, "known" has been held to mean "publicly known") is recognized but no change in the language is made at this time. Paragraph (a) together with section 104 contains the substance of title 35 U. S. C., 1946 ed., § 72 (R. S. 4923).

Paragraph (d) is based on 35 U. S. C., 1946 ed., § 32, first paragraph (R. S. 4887 (first paragraph), amended (1) Mar. 3, 1897, ch. 391, § 3, 29 Stat. 692, 693, (2) Mar. 3, 1903, ch. 1019, § 1, 32 Stat. 1225, 1226, (3) June 19, 1936, ch. 594, 49 Stat. 1529).

The section has been changed so that the prior foreign patent is not a bar unless it was granted before the filing of the application in the United States.

Paragraph (e) is new and enacts the rule of *Milburn* v. *Davis-Bournonville*, 270 U. S. 390, by reason of which a United States patent disclosing an invention dates from the date of filing the application for the purpose of anticipating a subsequent inventor.

Paragraph (f) indicates the necessity for the inventor as the party applying for patent. Subsequent sections permit certain persons to apply in place of the inventor under special circumstances.

Paragraph (g) is derived from title 35, U. S. C., 1946 ed., § 69 (R. S. 4920, amended (1) Mar. 3, 1897, ch. 391, § 2, 29 Stat. 692,



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(2) Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212), the second defense recited in this section. This paragraph retains the present rules of law governing the determination of priority of invention.

Language relating specifically to designs is omitted for inclusion in subsequent sections.

### SECTION 103—NEW SECTION

There is no provision corresponding to the first sentence explicitly stated in the present statutes, but the refusal of patents by the Patent Office, and the holding of patents invalid by the courts, on the ground of lack of invention or lack of patentable novelty has been followed since at least as early as 1850. This paragraph is added with the view that an explicit statement in the statute may have some stabilizing effect, and also to serve as a basis for the addition at a later time of some criteria which may be worked out.

The second sentence states that patentability as to this requirement is not to be negatived by the manner in which the invention was made, that is, it is immaterial whether it resulted from long toil and experimentation or from a flash of genius.

### SECTION 104—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 109 (Aug. 8, 1946, ch. 910, 60 Stat. 943).

Language has been changed and the last sentence has been broadened to refer to persons serving in connection with operations by or on behalf of the United States, instead of solely in connection with the prosecution of the war.

## CHAPTER 11. APPLICATION FOR PATENT

Sec.

111. Application for patent.
112. Specification.
113. Drawings.
114. Models, specimens.
115. Oath of applicant.
116. Joint inventors.
117. Death or incapacity of inventor.
118. Filing by other than inventor.
119. Benefit of earlier filing date in foreign country; right of priority.
120. Benefit of earlier filing date in the United States.
121. Divisional applications.
122. Confidential status of applications.

### SECTION 111—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 33 (R. S. 4888, amended (1) Mar. 3, 1915, ch. 94, § 1, 38 Stat. 958; (2) May 23, 1930, ch. 312, § 2, 46 Stat. 376).

The corresponding section of existing statute is divided into an introductory section relating to the application generally (this section) and a section on the specification (sec. 112).

The parts of the application are specified and the requirement for signature is placed in this general section so as to insure that only one signature will suffice.

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### SECTION 112—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 33 (R. S. 4888, amended (1) Mar. 3, 1915, ch. 94, § 1, 38 Stat. 958; (2) May 23, 1930, ch. 312, § 2, 46 Stat. 376).

The sentence relating to signature of the specification is omitted in view of the general requirement for a signature in section 111.

The last sentence is omitted for inclusion in the chapter relating to plant patents.

The clause relating to machines is omitted as unnecessary and the requirement for disclosing the best mode of carrying out the invention is stated as generally applicable to all types of invention (derived from title 35, U. S. C., 1946 ed., § 69, first defense).

The clause relating to the claim is made a separate paragraph to emphasize the distinction between the description and the claim or definition, and the language is modified.

A new paragraph relating to functional claims is added.

### SECTION 113—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 34, part (R. S. 4889, amended Mar. 3, 1915, ch. 94, § 2, 38 Stat. 958).

The requirement for signature in the corresponding section of existing statute is omitted; regulations of the Patent Office can take care of any substitute. A redundant clause is omitted.

### SECTION 114—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 34, part (R. S. 4890 and 4891).

The change in language in the second paragraph broadens the requirement for specimens.

### SECTION 115—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 35 (R. S. 4892, amended (1) Mar. 3, 1903, ch. 1019, § 2, 32 Stat. 1225, 1226, (2) May 23, 1930, ch. 312, § 3, 46 Stat. 376).

The expression at the end of the second sentence is added to avoid application of the District of Columbia law to oaths taken outside the District.

Changes in language are made.

### SECTION 116—NEW SECTION

The first paragraph is implied in the present statutes, and the part of the last paragraph relating to omission of an erroneously joined inventor is in the Patent Office rules. The remainder is new and provides for the correction of a mistake in erroneously joining a person as inventor, and for filing an application when one of several joint inventors cannot be found. This section is ancillary to section 256.

### SECTION 117—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 46 (R. S. 4896, amended (1) Feb. 28, 1899, ch. 227, 30 Stat. 915, (2) Mar. 3, 1903, ch. 1019, § 3, 32 Stat. 1225, 1226, (3) May 23, 1908, ch. 188, 35 Stat. 245).

The language has been considerably simplified.

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### Section 118—New Section

This section is new and provides for the filing of an application by another on behalf of the inventor in certain special hardship situations.

### Section 119—Section Revised

Based on title 35, U. S. C., 1946 ed., § 32, second paragraph (R. S. 4887, second paragraph, amended (1) Mar. 3, 1903, ch. 1019, § 1, 32 Stat. 1225, 1226, (2) June 19, 1936, ch. 594, 49 Stat. 1529, (3) Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212).

The first paragraph is the same as the present law with changes in language. The references to designs have been removed for inclusion in another section and the opening clause has been modified to accord with actual practice and the requirements of the International Convention for the Protection of Industrial Property.

The second paragraph is new, making an additional procedural requirement for obtaining the right of priority. Copies of the foreign papers on which the right of priority is based are required so that the record of the United States patent will be complete in this country.

### Section 120—New Section

This section represents present law not expressed in the statute, except for the added requirement that the first application must be specifically mentioned in the second.

### Section 121—New Section

This section enacts as law existing practice with respect to division, at the same time introducing a number of changes. Division is made discretionary with the Commissioner. The requirements of section 120 are made applicable and neither of the resulting patents can be held invalid over the other merely because of their being divided in several patents. In some cases a divisional application may be filed by the assignee.

### Section 122—New Section

This section enacts the Patent Office rule of secrecy of applications.

## CHAPTER 12. EXAMINATION OF APPLICATION

Sec.

131. Examination of application.
132. Notice of rejection; reexamination.
133. Time for prosecuting application.
134. Appeal to the Board of Appeals.
135. Interferences.

### Section 131—Section Revised

Based on title 35, U. S. C., 1946 ed., § 36 (R. S. 4893).

The first part is revised in language and amplified. The phrase "and that the invention is sufficiently useful and important" is omitted as unnecessary, the requirements for patentability being stated in sections 101, 102 and 103.

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### SECTION 132—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 51 (R. S. 4903, amended Aug. 5, 1939, ch. 452, § 1, 53 Stat. 1213).

The first paragraph of the corresponding section of existing statute is revised in language and amplified to incorporate present practice; the second paragraph of the existing statute is placed in section 135.

The last sentence relating to new matter is added but represents no departure from present practice.

### SECTION 133—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 37 (R. S. 4894, amended (1) Mar. 3, 1897, ch. 391, § 4, 29 Stat. 692, 693, (2) July 6, 1916, ch. 225, § 1, 39 Stat. 345, 347–8, (3) Mar. 2, 1927, ch. 273, § 1, 44 Stat. 1335, (4) Aug. 7, 1939, ch. 568, 53 Stat. 1264).

The opening clause of the corresponding section of existing statute is omitted as having no present day meaning or value and the last two sentences are omitted for inclusion in section 267. The notice is stated as given or mailed. Language is revised.

### SECTION 134—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 57 (R. S. 4909 amended (1) Mar. 2, 1927, ch. 273, § 5, 44 Stat. 1335, 1336, (2) Aug. 5, 1939, ch. 451, § 2, 53 Stat. 1212).

Reference to reissues is omitted in view of the general provision in section 251. Minor changes in language are made.

### SECTION 135—SECTION REVISED

The first paragraph is based on title 35, U. S. C., 1946 ed., § 52 (R. S. 4904 amended (1) Mar. 2, 1927, ch. 273, § 4, 44 Stat. 1335, 1336, (2) Aug. 5, 1939, ch. 451, § 1, 53 Stat. 1212).

The first paragraph states the existing corresponding statute with a few changes in language. An explicit statement that the Office decision on priority constitutes a final refusal by the Office of the claims involved, is added. The last sentence is new and provides that judgment adverse to a patentee constitutes cancellation of the claims of the patent involved after the judgment has become final, the patentee has a right of appeal (sec. 141) and is given a right of review by civil action (sec. 146).

The second paragraph is based on title 35, U. S. C., 1946 ed., § 51, (R. S. 4903, amended Aug. 5, 1939, ch. 452, § 1, 53 Stat. 1213). Changes in language are made.

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## CHAPTER 13. REVIEW OF PATENT OFFICE DECISIONS

Sec.

141. Appeal to Court of Customs and Patent Appeals.
142. Notice of appeal.
143. Proceedings on appeal.
144. Decision on appeal.
145. Civil action to obtain patent.
146. Civil action in case of interference.

### Section 141—Section Revised

Based on title 35, U. S. C., 1946 ed., § 59a (R. S. 4911, amended (1) Mar. 2, 1927, ch. 273, § 8, 44 Stat. 1336, (2) Mar. 2, 1929, ch. 4888, § 2a, 45 Stat. 1476, (3) Aug. 5, 1939, ch. 451, § 3, 53 Stat. 1212).

Changes in language are made.

### Section 142—Section Revised

Based on title 35, U. S. C., 1946 ed., § 60 (R. S. 4912 amended (1) Mar. 2, 1927, ch. 273, § 9, 44 Stat. 1336 (2) Mar. 2, 1929, ch. 4888, § 2 (b), 45 Stat. 1476).

Changes in language are made.

### Section 143—Section Revised

Based on title 35, U. S. C., 1946 ed., § 61 (R. S. 4913, amended Mar. 2, 1927, ch. 273, § 10, 44 Stat. 1336).

Language is changed. The requirement that the Commissioner notify the parties is omitted and a requirement that the court notify the parties is added. The statement relating to filing the papers and testimony is made more explicit.

### Section 144—Section Revised

Based on title 35, U. S. C., 1946 ed., § 62 (R. S. 4914).

Language is changed and the last sentence of the corresponding section of existing statute omitted as superfluous; such a sentence does not appear in the present civil action section, 35 U. S. C. 63 and in either case the validity of the patent may be questioned.

### Section 145—Section Revised

Based on title 35, U. S. C., 1946 ed., § 63 (R. S. 4915, amended (1) Mar. 2, 1927, ch. 273, § 11, 44 Stat. 1336, (2) Mar. 2, 1929, ch. 488, § 2 (b), 45 Stat. 1476, (3) Aug. 5, 1939, ch. 451, § 4, 53 Stat. 1212).

Bill in equity is changed to civil action and the section is restricted to exclude interferences which are covered by the next section. The time for filing the action is changed to the same as the time for appeal. The requirement for the applicant to file a copy of the decision in the Patent Office is omitted. Language is changed.

### Section 146—Section Revised

The first paragraph and parts of the second paragraph are based on title 35, U. S. C., 1946 ed., § 63 (R. S. 4915, amended (1) Mar. 2, 1927, ch. 273, § 11, 44 Stat. 1336, (2) Mar. 2, 1929, ch. 488, § 2 (b),

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45 Stat. 1476, (3) Aug. 5, 1939, ch. 451, § 4, 53 Stat. 1212), limited to interferences and making some changes. The action is not restricted to applicants, but a patentee may also bring the action. The time for bringing the action is made the same as for appeals.

In the second paragraph the first sentence is new and eliminates difficulties arising from unrecorded interests.

The second sentence is based on 35 U. S. C., 1946 ed., § 72a (Mar. 3, 1927, ch. 364, 44 Stat. 1394, reenacted Oct. 31, 1951, ch. 655, § 53a, 65 Stat. 728) with changes in language.

The fourth sentence is new and prevents such suits from being filed against the Commissioner as a defendant; however, the Commissioner has the right to intervene.

Language is changed.

## CHAPTER 14. ISSUE OF PATENT

Sec.

151. Time of issue of patent.
152. Issue of patent to assignee.
153. How issued.
154. Contents and term of patent.

### Section 151—Section Revised

Based on title 35, U. S. C., 1946 ed., § 41 (R. S. 4885, amended (1) May 23, 1908, ch. 189, 35 Stat. 246, (2) Aug. 9, 1939, § 2, ch. 619, 53 Stat. 1293).

Language is changed.

### Section 152—Section Revised

Based on title 35, U. S. C., 1946 ed., § 44 (R. S. 4895).

Language is changed and the reference to reissues is omitted in view of the general provision in section 251.

### Section 153—Section Revised

Based on title 35, U. S. C., 1946 ed., § 39 (R. S. 4883, amended (1) Feb. 18, 1888, ch. 15, 25 Stat. 40, (2) April 11, 1903, ch. 417, 32 Stat. 95, (3) Feb. 18, 1922, ch. 58, § 5, 42 Stat. 391).

The phrases referring to the attesting officers and to the recording of the patents are broadened.

### Section 154—Section Revised

Based on title 35, U. S. C., 1946 ed., § 40 (R. S. 4884, amended May 23, 1930, ch. 312, § 1, 46 Stat. 376).

The reference to plants is omitted for inclusion in another section and the reference to the title is shortened since the title is of no legal significance.

The wording of the granting clause is changed to "the right to exclude others from making, using, or selling", following language used by the Supreme Court, to render the meaning clearer.

"United States" is defined in section 100.

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## CHAPTER 15. PLANT PATENTS

Sec.
161. Patents for plants.
162. Description, claim.
163. Grant.
164. Assistance of Department of Agriculture.

### SECTION 161—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 31, part (R. S. 4886, amended (1) Mar. 3, 1897, ch. 391, § 1, 29 Stat. 692, (2) May 23, 1930, ch. 312, § 1, 46 Stat. 376, (3) Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212).

The provision relating to plants in the corresponding section of existing statute is made a separate section.

### SECTION 162—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 33, part (R. S. 4888, amended (1) Mar. 3, 1915, ch. 94, § 1, 38 Stat. 958, (2) May 23, 1930, ch. 312, § 2, 46 Stat. 376).

The first paragraph is the provision in R. S. 4888 (see section 112). The second paragraph is not in the statute but represents the actual practice.

### SECTION 163—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 40, part (R. S. 4884, amended May 23, 1930, ch. 312, § 1, 46 Stat. 376).

This provision is from R. S. 4884 (see section 154) amended in language.

### SECTION 164—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 56a (May 23, 1930, ch. 312, § 4, 46 Stat. 376).

Language is changed.

## CHAPTER 16. DESIGNS

Sec.
171. Patents for designs.
172. Right of priority.
173. Term of design patent.

### SECTION 171—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 73 (R. S. 4929, amended (1) May 9, 1902, ch. 783, 32 Stat. 193, (2) Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212; R. S. 4933).

The list of conditions specified in the corresponding section of existing statute is omitted as unnecessary in view of the general inclusion of all conditions applying to other patents. Language is changed.

### SECTION 172—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 32, part (R. S. 4887, amended (1) Mar. 3, 1903, ch. 1019, § 1, 32 Stat. 1225, 1226, (2) June 19, 1936, ch. 594, 49 Stat. 1529, (3) Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212).

This provision is taken from R. S. 4887 (see section 119) and made a separate section.

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SECTION 173—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 77 (R. S. 4931).
Language is changed slightly.

## CHAPTER 17. SECRECY OF CERTAIN INVENTIONS AND FILING APPLICATIONS IN FOREIGN COUNTRY

Sec.
181. Secrecy of certain inventions and withholding of patent.
182. Abandonment of invention for unauthorized disclosure.
183. Right of compensation.
184. Filing of application in foreign country.
185. Patent barred for filing without license.
186. Penalty.
187. Nonapplicability to certain persons.
188. Rules and regulations, delegation of power.

SECTION 181—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 151 (Feb. 1, 1952, ch. 4, § 1, 66 Stat. 3, 4).
Language is changed.

SECTION 182—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 152 (Feb. 1, 1952, ch. 4, § 2, 66 Stat. 4).
Language is changed.

SECTION 183—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 153 (Feb. 1, 1952, ch. 4, § 3, 66 Stat. 4, 5).
Language is changed.

SECTION 184—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 154 (Feb. 1, 1952, ch. 4, § 4, 66 Stat. 5).
Language is changed.

SECTION 185—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 155 (Feb. 1, 1952, ch. 4, § 5, 66 Stat. 5).
Language is changed.

SECTION 186—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 156 (Feb. 1, 1952, ch. 4, § 6, 66 Stat. 5, 6).
Language is changed.

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### SECTION 187—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 157 (Feb. 1, 1952, ch. 4, § 7, 66 Stat. 6).

Language is changed.

### SECTION 188—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 158 (Feb. 1, 1952, ch. 4, § 8, 66 Stat. 6).

Language is changed.

## PART III. PATENTS AND PROTECTION OF PATENT RIGHTS


| Chapter | | Sec. |
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| 25. | AMENDMENT AND CORRECTION OF PATENTS | 251 |
| 26. | OWNERSHIP AND ASSIGNMENT | 261 |
| 27. | GOVERNMENT INTERESTS IN PATENTS | 266 |
| 28. | INFRINGEMENT OF PATENTS | 271 |
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## CHAPTER 25. AMENDMENT AND CORRECTION OF PATENTS


Sec.

251. Reissue of defective patents.
252. Effect of reissue.
253. Disclaimer.
254. Certificate of correction of Patent Office mistake.
255. Certificate of correction of applicant's mistake.
256. Misjoinder of inventor.


### SECTION 251—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 64 (R. S. 4916, amended May 24, 1928, ch. 730, 45 Stat. 732.)

The sentences of the corresponding section of existing statute are rearranged and divided into two sections with some changes in language. The clause at the end of the present statute is omitted as obsolete.

The third paragraph incorporates by reference the requirements of other applications, and adds a new provision relating to application for reissue being made in certain cases by the assignee.

A two year period of limitation on applying for broadened reissues is added, codifying the present rule of decision with a fixed period.

### SECTION 252—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 64 (R. S. 4916, amended May 24, 1928, ch. 730, 45 Stat. 732.)

The first paragraph follows the present section with some rearrangement in language. The second paragraph adds new provisions for the protection of intervening rights, the court is given discretion to protect legitimate activities which would be adversely affected by the grant of a reissue and things made before the grant of the reissue are not subject to the reissue unless a claim of the original patent which is repeated in the reissue is infringed.

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### SECTION 253—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 65 (R. S. 4917).

Language is changed and substantive changes are introduced; (1) only a claim as a whole may be disclaimed, and (2) the provision regarding delay is omitted. See preliminary general description of bill.

See section 288.

The second paragraph is new and provides for the disclaiming or dedication of an entire patent, or any terminal part of the term, for example, a patentee may disclaim the last three years of the term of his patent.

### SECTION 254—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 88 (Mar. 4, 1925, ch. 535, § 1, 43 Stat. 1268).

The last sentence of the present section is omitted as obsolete. A sentence is added similar to a provision in the corresponding section in the trade-mark law, 15 U. S. C., 1946 ed., § 1057 (f), and provides that the Commissioner may issue a corrected patent instead of a certificate of correction.

### SECTION 255—NEW SECTION

This section providing for the correction of minor clerical errors made by the applicant, is new and follows a similar provision in the trade-mark law, 15 U. S. C., 1946 ed., § 1057 (g).

### SECTION 256—NEW SECTION

This section is new and is companion to section 116.

The first two paragraphs provide for the correction of the inadvertent joining or nonjoining of a person as a joint inventor. The third paragraph provides that a patent shall not be invalid for such cause, and also provides that a court may order correction of a patent; the two sentenees of this paragraph are independent.

## CHAPTER 26. OWNERSHIP AND ASSIGNMENT

Sec.

261. Ownership; assignment.
262. Joint owners.

### SECTION 261—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 47 (R. S. 4898, amended (1) Mar. 3, 1897, ch. 391, § 5, 29 Stat. 93, (2) Feb. 18, 1922, ch. 58, § 6, 42 Stat. 391, (3) Aug. 18, 1941, ch. 370, 55 Stat. 634).

The first paragraph is new but is declaratory only. The second paragraph is the same as in the corresponding section of existing statute. The third paragraph is from the existing statute, a specific reference to another statute is omitted. The fourth paragraph is the same as the existing statute but language has been changed.

### SECTION 262—NEW SECTION

This section states a condition in existing law not expressed in the existing statutes.

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## CHAPTER 27. GOVERNMENT INTERESTS IN PATENTS

Sec.
266. Issue of patents without fees to Government employees.
267. Time for taking action in Government applications.

### Section 266—Section Revised

Based on title 35, U. S. C., 1946 ed., § 45 (Mar. 3, 1883, ch. 143, 22 Stat. 625, amended April 30, 1928, ch. 460, 45 Stat. 467).

Changes in language are made. The omission of the specific reference to 35 U. S. C., 1946 ed., § 31, (R. S. 4886) broadens the section so as to include design patents.

### Section 267—Section Revised

Based on title 35, U. S. C. 1946 ed., § 37 (R. S. 4894, amended (1) Mar. 3, 1897, ch. 391, § 4, 29 Stat. 692, 693, (2) July 6, 1916, ch. 225, § 1, 39 Stat. 345, 347–8, (3) Mar. 2, 1927, ch. 273, § 1, 44 Stat. 1335, (4) Aug. 7, 1939, ch. 568, 53 Stat. 1264).

This provision, which appears as the last two sentences of the corresponding section of the present statute (see note to section 133) is made a separate section and rewritten in simpler form.

## CHAPTER 28. INFRINGEMENT OF PATENTS

Sec.
271. Infringement of patent.
272. Temporary presence in the United States.

### Section 271—New Section

The first paragraph of this section is declaratory only, defining infringement.

Paragraphs (b) and (c) define and limit contributory infringement of a patent and paragraph (d) is ancillary to these paragraphs, see preliminary general description of bill. One who actively induces infringement as by aiding and abetting the same is liable as an infringer, and so is one who sells a component part of a patented invention or material or apparatus for use therein knowing the same to be especially made or especially adapted for use in the infringement of the patent except in the case of a staple article or commodity of commerce having other uses. A patentee is not deemed to have misused his patent solely by reason of doing anything authorized by the section.

### Section 272—New Section

This section follows the requirement of the International Convention for the Protection of Industrial Property, to which the United States is a party, and also codifies the holding of the Supreme Court that use of a patented invention on board a foreign ship does not infringe a patent.

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# CHAPTER 29. REMEDIES FOR INFRINGEMENT OF PATENT, AND OTHER ACTIONS

Sec.
281. Remedy for infringement of patent.
282. Prosecution of validity; defenses.
283. Injunction.
284. Damages.
285. Attorney fees.
286. Time limitation on damages.
287. Limitation on damages; marking and notice.
288. Action for infringement of a patent containing an invalid claim.
289. Additional remedy for infringement of design patent.
290. Notice of patent suits.
291. Interfering patents.
292. False marking.
293. Nonresident patentee, service and notice.

## SECTION 281—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., §§ 67 and 70, part (R. S. 4919; R. S. 4921, amended (1) Mar. 3, 1897, ch. 391, § 6, 29 Stat. 694, (2) Feb. 18, 1922, ch. 58, § 8, 42 Stat. 392, (3) Aug. 1, 1946, ch. 726, § 1, 60 Stat. 778).

The corresponding two sections of existing law are divided among sections 281, 283, 284, 285, 286 and 289 with some changes in language. Section 281 serves as an introduction or preamble to the following sections, the modern term civil action is used, there would be, of course, a right to a jury trial when no injunction is sought.

## SECTION 282—SECTION REVISED

Derived from title 35, U. S. C., 1946 ed., § 69, (R. S. 4920, amended (1) Mar. 3, 1897, ch. 391, § 2, 29 Stat. 692, (2) Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212).

The first paragraph declares the existing presumption of validity of patents.

The five defenses named in R. S. 4920 are omitted and replaced by a broader paragraph specifying defenses in general terms.

The third paragraph, relating to notice of prior patents, publications and uses, is based on part of the last paragraph of R. S. 4920 which was superseded by the Federal Rules of Civil Procedure but which is reinstated with modifications.

## SECTION 283—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 70, part (R. S. 4921, amended (1) Mar. 3, 1897, ch. 391, § 6, 29 Stat. 694, (2) Feb. 18, 1922, ch. 58, § 8, 42 Stat. 392, (3) Aug. 1, 1946, ch. 726, § 1, 60 Stat. 778).

This section is the same as the provision which opens R. S. 4921 with minor changes in language.

## SECTION 284—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., §§ 67 and 70, part (R. S. 4919; R. S. 4921, amended (1) Mar. 3, 1897, ch. 391, § 6, 29 Stat. 694, (2) Feb. 18, 1922, ch. 58, § 8, 42 Stat. 392, (3) Aug. 1, 1946, ch. 726, § 1, 60 Stat. 778).

This section consolidates the provisions relating to damages in R. S. 4919 and 4921, with some changes in language.

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### SECTION 285—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 70, part (R. S. 4921, amended (1) Mar. 3, 1897, ch. 391, § 6, 29 Stat. 694, (2) Feb. 18, 1922, ch. 58, § 8, 42 Stat. 392, (3) Aug. 1, 1946, ch. 726, § 1, 60 Stat. 778).

This section is substantially the same as the corresponding provision in R. S. 4921; "in exceptional cases" has been added as expressing the intention of the present statute as shown by its legislative history and as interpreted by the courts.

### SECTION 286—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 70, part (R. S. 4921, amended (1) Mar. 3, 1897, ch. 391, § 6, 29 Stat. 694, (2) Feb. 18, 1922, ch. 58, § 8, 42 Stat. 392, (3) Aug. 1, 1946, ch. 726, § 1, 60 Stat. 778).

The first paragraph is the same as the provision in R. S. 4921 with minor changes in language, with the added provision relating to the date for counterclaims for infringement.

The second paragraph is new and relates to extending the period of limitations with respect to suits in the Court of Claims in certain instances when administrative consideration is pending.

### SECTION 287—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 49 (R. S. 4900, amended Feb. 7, 1927, ch. 67, 44 Stat. 1058).

Language is changed. The proviso in the corresponding section of existing statute is omitted as being temporary in character and now obsolete.

### SECTION 288—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 71 (R. S. 4922).

The necessity for a disclaimer to recover on valid claims is eliminated. See section 253.

Language is changed.

### SECTION 289—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., §§ 74, 75 (Feb. 4, 1887, ch. 105, §§ 1, 2, 24 Stat. 387, 388).

Language is changed.

### SECTION 290—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 70, part (R. S. 4921, amended (1) Mar. 3, 1897, ch. 391, § 6, 29 Stat. 694, (2) Feb. 18, 1922, ch. 58, § 8, 42 Stat. 392, (3) Aug. 1, 1946, ch. 726, § 1, 60 Stat. 778).

This is the last sentence of R. S. 4921, third paragraph, with minor changes in language.

### SECTION 291—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 66 (R. S. 4918, amended Mar. 2, 1927, ch. 273, § 12, 44 Stat. 1337).

Language is changed.

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### SECTION 292—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 50 (R. S. 4901).

This is a criminal provision. The first two paragraphs of the corresponding section of existing statute are consolidated, a new paragraph relating to false marking of "patent applied for" is added, and false advertising is included in all the offenses. The minimum fine, which has been interpreted by the courts as a maximum, is replaced by a higher maximum. The informer action is included as additional to an ordinary criminal action.

### SECTION 293—NEW SECTION

This section provides for service on non-resident patentees.

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# CHANGES IN EXISTING LAW

## 1. Text of Statutes for Repeal

In compliance with subsection (4) of rule XXIX of the Standing Rules of the Senate, the text of the statutes or parts thereof which are proposed to be repealed by the bill are set out below.

The Revised Statutes, set out first, are in numerical order according to section number. The Statutes at Large which specifically amend a section of the Revised Statutes follow the particular Revised Statute section. The Statutes at Large which do not specifically amend any particular section of the Revised Statutes follow the Revised Statutes in chronological order.

The citation in the left-hand column of the headings identifies the text of the Revised Statutes or Statutes at Large which immediately follows that reference; that in the right-hand column refers to the section of proposed title 35, "Patents", of the United States Code, where similar subject matter will be found. The word "omitted" in the right-hand column of a heading indicates that the particular text of such statute was not incorporated in proposed title 35 because it was obsolete, executed, covered by other law, or superseded by later law. The specific reasons for omitting and repealing such statutes are given in the table of omitted laws elsewhere in this report.

## REVISED STATUTES

R. S. 475 ..... T. 35, § 1

There shall be in the Department of the Interior an office known as the Patent-Office, where all records, books, models, drawings, specifications, and other papers and things pertaining to patents shall be safely kept and preserved.

R. S. 476 ..... T. 35, § 3

There shall be in the Patent-Office a Commissioner of Patents, one Assistant Commissioner, and three examiners-in-chief, who shall be appointed by the President, by and with the advice and consent of the Senate. All other officers, clerks, and employees authorized by law for the Office shall be appointed by the Secretary of the Interior upon the nomination of the Commissioner of Patents.

As amended Feb. 15, 1916, ch. 22, § 1, 39 Stat. 8.

That section four hundred and seventy-six of the Revised Statutes be, and the same is hereby, amended to read as follows:

"Sec. 476. There shall be in the Patent Office a Commissioner of Patents, one first assistant commissioner, one assistant commissioner, and five examiners in chief, who shall be appointed by the President, by and with the advice and consent of the Senate. The first assistant commissioner and the assistant commissioner shall perform such duties pertaining to the office of commissioner as may be assigned to them, respectively, from time to time by the Commissioner of Patents. All other officers, clerks, and employees authorized by law for the office shall be appointed by the Secretary of the Interior upon the nomination of the Commissioner of Patents, in accordance with existing law."

As amended Feb. 14, 1927, ch. 139, § 1, 44 Stat. 1098.

That section 476 of the Revised Statutes be amended to read as follows:

"Sec. 476. There shall be in the Patent Office a Commissioner of Patents, one first assistant commissioner, one assistant commissioner, and six examiners in



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chief, who shall be appointed by the President, by and with the advice and consent of the Senate. The first assistant commissioner and the assistant commissioner shall perform such duties pertaining to the office of commissioner as may be assigned to them, respectively, from time to time by the Commissioner of Patents. All other officers, clerks, and employees authorized by law for the office shall be appointed by the Secretary of Commerce upon the nomination of the Commissioner of Patents, in accordance with existing law."

As amended April 11, 1930, ch. 132, § 1, 46 Stat. 155.

That section 476 of the Revised Statutes, as amended (United States Code, title 35, section 2), is amended to read as follows:

"SEC. 476. There shall be in the Patent-Office a Commissioner of Patents, one first assistant commissioner, two assistant commissioners, and nine examiners-in-chief, who shall be appointed by the President, by and with the advice and consent of the Senate. The first assistant commissioner and the assistant commissioners shall perform such duties pertaining to the office of commissioner as may be assigned to them, respectively, from time to time by the Commissioner of Patents. All other officers, clerks, and employees authorized by law for the office shall be appointed by the Secretary of Commerce upon the nomination of the Commissioner of Patents, in accordance with existing law."

R. S. 478 ..... T. 35, § 2

The seal heretofore provided for the Patent-Office shall be the seal of the Office, with which letters-patent and papers issued from the Office shall be authenticated.

R. S. 479 ..... T. 35, § 5

The Commissioner of Patents and the chief clerk, before entering upon their duties, shall severally give bond, with sureties, to the Treasurer of the United States, the former in the sum of ten thousand dollars, and the latter in the sum of five thousand dollars, conditioned for the faithful discharge of their respective duties, and that they shall render to the proper officers of the Treasury a true account of all money received by virtue of their offices.

R. S. 480 ..... T. 35, § 4

All officers and employes of the Patent-Office shall be incapable, during the period for which they hold their appointments, to acquire or take, directly or indirectly, except by inheritance or bequest, any right or interest in any patent issued by the Office.

R. S. 481 ..... T. 35, § 6

The Commissioner of Patents, under the direction of the Secretary of the Interior, shall superintend or perform all duties respecting the granting and issuing of patents directed by law; and he shall have charge of all books, records, papers, models, machines, and other things belonging to the Patent-Office.

R. S. 482 ..... T. 35, § 7

The examiners-in-chief shall be persons of competent legal knowledge and scientific ability, whose duty it shall be, on written petition of the appellant, to revise and determine upon the validity of the adverse decisions of examiners upon applications for patents, and for re-issues of patents, and in interference cases; and, when required by the Commissioner, they shall hear and report upon claims for extensions, and perform such other like duties as he may assign them.

As amended Mar. 2, 1927, ch. 273, § 3, 44 Stat. 1335.

SEC. 3. That section 482 of the Revised Statutes of the United States be amended to read as follows:

"SEC. 482. The examiners-in-chief shall be persons of competent legal knowledge and scientific ability. The Commissioner of Patents, the first assistant commissioner, the assistant commissioner, and the examiners in chief shall constitute a board of appeals, whose duty it shall be, on written petition of the appellant, to review and determine upon the validity of the adverse decisions of examiners upon applications for patents and for reissues of patents and in interference cases. Each appeal shall be heard by at least three members of the board of appeals, the members hearing such appeal to be designated by the commissioner. The board of appeals shall have sole power to grant rehearings."

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As amended Apr. 11, 1930, ch. 132, § 2, 46 Stat. 155.

SEC. 2. Section 482 of the Revised Statutes as amended (United States Code, title 35, section 7) is hereby amended by substituting the words "assistant commissioners" for the words "assistant commissioner," in conformity with the provisions of section 1 of this bill.

As amended Mar. 4, 1950, ch. 50, 64 Stat. 11.

That section 482 of the Revised Statutes (35 U. S. C. 7) is amended by adding the following paragraph:

"The Commissioner, when in his discretion considered necessary to maintain the work of the board of appeals current, may designate any examiner of the primary examiner grade or higher, having the requisite ability, to serve as examiner in chief for periods not exceeding six months each, and any examiner so designated shall be qualified to act as a member of the board of appeals. Not more than one primary examiner shall be among the members of the board of appeals hearing an appeal."

R. S. 483 ..... T. 35, § 6

The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent-Office.

R. S. 486 ..... T. 35, § 8

There shall he purchased for the use of the Patent-Office a library of such scientific works and periodicals, both foreign and American, as may aid the officers in the discharge of their duties, not exceeding the amount annually appropriated for that purpose.

R. S. 487 ..... T. 35, §§ 31, 32

For gross misconduct the Commissioner of Patents may refuse to recognize any person as a patent-agent, either generally or in any particular case; but the reasons for such refusal shall be duly recorded, and he subject to the approval of the Secretary of the Interior.

As amended Feb. 18, 1922, ch. 58, § 3, 42 Stat. 390.

SEC. 3. That section 487 of the Revised Statutes be, and the same is hereby, amended to read as follows:

"SEC. 487. The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may prescribe rules and regulations governing the recognition of agents, attorneys, or other persons representing applicants or other parties before his office, and he may require of such persons, agents, or attorneys, before being recognized as representatives of applicants or other persons, that they shall show that they are of good moral character and in good repute, are possessed of the necessary qualifications to enable them to render to applicants or other persons valuable service, and are likewise competent to advise and assist applicants or other persons in the presentation or prosecution of their applications or other business before the office. And the Commissioner of Patents may, after notice and opportunity for a hearing, suspend or exclude, either generally or in any particular case, from further practice before his office any person, agent, or attorney shown to be incompetent or disreputable, or guilty of gross misconduct, or who refuses to comply with the said rules and regulations, or who shall, with intent to defraud in any manner, deceive, mislead, or threaten any applicant or prospective applicant, or other person having immediate or prospective business before the office, by word, circular, letter, or by advertising. The reasons for any such suspension or exclusion shall be duly recorded. And the action of the commissioner may be reviewed upon the petition of the person so refused recognition or so suspended or excluded by the Supreme Court of the District of Columbia under such conditions and upon such proceedings as the said court may by its rules determine."

R. S. 488 ..... T. 35, § 22

The Commissioner of Patents may require all papers filed in the Patent-Office, if not correctly, legibly, and clearly written, to be printed at the cost of the party filing them.

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R. S. 489 ..... T. 35, § 11

The Commissioner of Patents may print, or cause to be printed, copies of the claims of current issues, and copies of such laws, decisions, regulations, and circulars as may be necessary for the information of the public.

R. S. 493 ..... T. 35, § 41

The price to be paid for uncertified printed copies of specifications and drawings of patents shall be determined by the Commissioner of Patents, within the limits of ten cents as the minimum and fifty cents as the maximum price.

As amended May 19, 1896, ch. 204, 29 Stat. 124.

That section four hundred and ninety-three of the Revised Statutes be, and the same hereby is, amended by striking out the words" within the limits of ten cents as the minimum and fifty cents as the maximum price," in lines three and four, and substituting in lieu thereof, "*Provided*, That the maximum cost of a copy shall be ten cents," so that the section so amended shall read as follows:

"SEC. 493. The price to be paid for uncertified printed copies of specifications and drawings of patents shall be determined by the Commissioner of Patents: *Provided*, That the maximum cost of a copy shall be ten cents."

R. S. 494 ..... T. 35, § 14

The Commissioner of Patents shall lay before Congress, in the month of January, annually, a report, giving a detailed statement of all moneys received for patents, for copies of records or drawings, or from any other source whatever; a detailed statement of all expenditures for contingent and miscellaneous expenses; a list of all patents which were granted during the preceding year, designating under proper heads the subjects of such patents; an alphabetical list of all the patentees, with their places of residence; a list of all patents which have been extended during the year; and such other information of the condition of the Patent-Office as may be useful to Congress or the public.

R. S. 496 ..... Omitted

All disbursements for the Patent-Office shall be made by the disbursing clerk of the Interior Department.

R. S. 4883 ..... T. 35, § 153

All patents shall be issued in the name of the United States of America, under the seal of the Patent-Office, and shall be signed by the Secretary of the Interior and countersigned by the Commissioner of Patents, and they shall be recorded, together with the specifications, in the Patent-Office, in books to be kept for that purpose.

As amended Feb. 18, 1888, ch. 15, 25 Stat. 40.

That section four thousand eight hundred and eighty-three of the Revised Statutes is hereby amended by inserting after the words "Secretary of the Interior," where they occur therein, the following words: "or under his direction by one of the Assistant Secretaries of the Interior," so that the said section as amended will read as follows:

"*SECTION 4883.* All patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Secretary of the Interior or under his direction by one of the Assistant Secretaries of the Interior, and counter-signed by the Commissioner of Patents, and they shall be recorded, together with the specifications, in the Patent Office, in books to be kept for that purpose."

As amended Apr. 11, 1902, ch. 417, 32 Stat. 95.

That section forty-eight hundred and eighty-three of the Revised Statutes be, and is hereby, amended so as to read as follows:

"SEC. 4883. All patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Commissioner of Patents, and they shall be recorded, together with the specifications, in the Patent Office in books to be kept for that purpose."

As amended Feb. 18, 1922, ch. 58, sec. 5, 42 Stat. 391.

SEC. 5. That section 4883 of the Revised Statutes be, and the same is hereby, amended to read as follows:

SEC. 4883. All patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall either be signed, by the

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Commissioner of Patents or have his name printed thereon and attested by an Assistant Commissioner of Patents or by one of the law examiners duly designated by the commissioner, and shall be recorded, together with the specifications, in the Patent Office in books to be kept for that purpose."

R. S. 4884 ..... T. 35, §§ 154, 163

Every patent shall contain a short title or description of the invention or discovery, correctly indicating its nature and design, and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the exclusive right to make, use and vend the invention or discovery throughout the United States and the Territories thereof, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof.

As amended May 23, 1930, ch. 312, sec. 1, 46 Stat. 376.

That sections 4884 [and 4886] of the Revised Statutes, as amended (U. S. C., title 35, secs. 40 [and 31]), are amended to read as follows:

"SEC. 4884. Every patent shall contain a short title or description of the invention or discovery, correctly indicating its nature and design, and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the exclusive right to make, use, and vend the invention or discovery (including in the case of a plant patent the exclusive right to asexually reproduce the plant) throughout the United States and the Territories thereof, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof."

R. S. 4885 ..... T. 35, § 151

Every patent shall bear date as of a day not later than six months from the time at which it was passed and allowed and notice thereof was sent to the applicant or his agent; and if the final fee is not paid within that period the patent shall be withheld.

As amended May 23, 1908, ch. 189, 35 Stat. 246.

That section forty-eight hundred and eighty-five of the Revised Statutes be, and the same hereby is, amended to read as follows:

"SEC. 4885. Every patent shall issue within a period of three months from the date of the payment of the final fee, which fee shall be paid not later than six months from the time at which the application was passed and allowed and notice thereof was sent to the applicant or his agent; and if the final fee is not paid within that period the patent shall be withheld."

As amended Aug. 9, 1939, ch. 619, § 2, 53 Stat. 1293.

SEC. 2. That section 4885 of the Revised Statutes (U. S. C., title 35, sec. 41) be amended by adding at the end thereof the following: "*Provided, however*, That the Commissioner of Patents may in his discretion receive the final fee if paid within one year after the six months' period for payment has passed and the patent shall issue."

R. S. 4886 ..... T. 35, §§ 101, 102, 161

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 proceeding had, obtain a patent therefor.

As amended Mar. 3, 1897, ch. 391, § 1, 29 Stat. 692.

That section forty-eight hundred and eighty-six of the Revised Statutes be, and the same hereby is, amended by inserting on line four, after the word "country," the words "before his invention or discovery thereof," and on line five after the word "thereof", the words "or more than two years prior to his application," so that the clause so amended will read as follows:

"SEC. 4886. Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, not known or used by others in this country, before his

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invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."

As amended May 23, 1930, ch. 312, sec. 1, 46 Stat. 376.

That sections [4884 and] 4886 of the Revised Statutes, as amended (U S. C., title 35, secs. [40 and] 31), are amended to read as follows:

"SEC. 4886. 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, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant not known or used by others in this country, before his invention or discovery thereof and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."

As amended Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212.

That sections 4886, 4887, 4920, and 4929 of the Revised Statutes (U. S. C., title 35, secs. 31, 32, 69, and 73) be amended by striking out the words "two years" wherever they appear in said sections and substituting therefor the words "one year".

R. S. 4887 ..... T. 35, §§ 102 (d), 119

No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented in a foreign country, unless the same has been introduced into public use in the United States for more than two years prior to the application. But every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years.

As amended Mar. 3, 1897, ch. 391, § 3, 29 Stat. 693.

SEC. 3. That section forty-eight hundred and eighty-seven of the Revised Statutes be, and the same hereby is, amended by inserting on line one, after the words "no person," the words "otherwise entitled thereto," and on line three, after the words "caused to be patented," the words "by the inventor or his legal representatives or assigns," and by erasing therein all that portion of the section which follows the words "in a foreign country," on lines three and four, and substituting in lieu thereof the following: "unless the application for said foreign patent was filed more than seven months prior to the filing of the application in this country, in which case no patent shall be granted in this country" so that the section so amended will read as follows:

"SEC. 4887. No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than seven months prior to the filing of the application in this country, in which case no patent shall be granted in this country."

As amended Mar. 3, 1903, ch. 1019, § 1, 32 Stat. 1225.

That section forty-eight hundred and eighty-seven of the Revised Statutes is amended by changing the word "seven" to "twelve", and by inserting after the word "months" the words "in cases within the provisions of section forty-eight hundred and eighty-six of the Revised Statutes, and four months, in cases of designs," and by adding the following words: "An application for patent for an invention or discovery or for a design filed in this country by any person who has previously regularly filed an application for a patent for the same invention, discovery, or design in a foreign country which, by treaty, convention, or law, affords

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similar privileges to citizens of the United States shall have the same force and effect as the same application would have if filed in this country on the date on which the application for patent for the same invention, discovery, or design was first filed in such foreign country, provided the application in this country is filed within twelve months in cases within the provisions of section forty-eight hundred and eighty-six of the Revised Statutes, and within four months in cases of designs, from the earliest date on which any such foreign application was filed. But no patent shall be granted on an application for patent for an invention or discovery or a design which had been patented or described in a printed publication in this or any foreign country more than two years before the date of the actual filing of the application in this country, or which had been in public use, or on sale in this country for more than two years prior to such filing;" so that the section so amended shall read:

"SEC. 4887. No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than twelve months, in cases within the provisions of section forty-eight hundred and eighty-six of the Revised Statutes, and four months in cases of designs, prior to the filing of the application in this country, in which case no patent shall be granted in this country.

"An application for patent for an invention or discovery or for a design filed in this country by any person who has previously regularly filed an application for a patent for the same invention, discovery or design in a foreign country which, by treaty, convention, or law, affords similar privileges to citizens of the United States shall have the same force and effect as the same application would have if filed in this country on the date on which the application for patent for the same invention, discovery, or design was first filed in such foreign country, provided the application in this country is filed within twelve months in cases within the provisions of section forty-eight hundred and eighty-six of the Revised Statutes, and within four months in cases of designs, from the earliest date on which any such foreign application was filed. But no patent shall be granted on an application for patent for an invention or discovery or a design which had been patented or described in a printed publication in this or any foreign country more than two years before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country for more than two years prior to such filing."

As amended June 19, 1936, ch. 594, 49 Stat. 1529.

That section 4887 of the Revised Statutes (U. S. C., title 35, sec. 32) be amended to read as follows:

"No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than twelve months, in cases within the provisions of section 4886 of the Revised Statutes, and six months in cases of designs, prior to the filing of the application in this country, in which case no patent shall be granted in this country.

"An application for patent for an invention or discovery or for a design filed in this country by any person who has previously regularly filed an application for a patent for the same invention, discovery, or design in a foreign country which, by treaty, convention, or law, affords similar privileges to citizens of the United States shall have the same force and effect as the same application would have if filed in this country on the date on which the application for patent for the same invention, discovery, or design was first filed in such foreign country: *Provided*, That the application in this country is filed within twelve months in cases within the provisions of section 4886 of the Revised Statutes, and within six months in cases of designs, from the earliest date on which any such foreign application was filed. But no patent shall be granted on any application for patent for an invention or discovery or a design which had been patented or described in a printed publication in this or any foreign country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country for more than one year prior to such filing."

As amended Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212.

That sections 4886, 4887, 4920, and 4929 of the Revised Statutes (U. S. C., title 35. secs. 31, 32, 69, and 73) be amended by striking out the words "two

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years" wherever they appear in said sections and substituting therefor the words "one year".

R. S. 4888 ..... T. 35, §§ 111, 112, 162

Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent-Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor and attested by two witnesses.

As amended Mar. 3, 1915, ch. 94, § 1, 38 Stat. 958.

That section forty-eight hundred and eighty-eight of the Revised Statutes of the United States be, and the same is hereby, amended by striking out from the last clause thereof the words "and attested by two witnesses," so that the section so amended will read as follows:

"SEC. 4888. Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent-Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor."

As amended May 23, 1930, ch. 312, § 2, 46 Stat. 376.

SEC. 2. Section 4888 of the Revised Statutes, as amended (U. S. C., title 35, sec. 33), is amended by adding at the end thereof the following sentence: "No plant patent shall be declared invalid on the ground of noncompliance with this section if the description is made as complete as is reasonably possible."

R. S. 4889 ..... T. 35, § 113

When the nature of the case admits of drawings, the applicant shall furnish one copy signed by the inventor or his attorney in fact, and attested by two witnesses, which shall be filed in the Patent Office; and a copy of the drawing to be furnished by the Patent Office, shall be attached to the patent as a part of the specification.

As amended Mar. 3, 1915, ch. 94, § 2, 38 Stat. 959.

SEC. 2. That section forty-eight hundred and eighty-nine of the Revised Statutes of the United States be, and the same is hereby, amended by striking out the words "and attested by two witnesses," so that the section so amended will read as follows:

"SEC. 4889. When the nature of the case admits of drawings, the applicant shall furnish one copy signed by the inventor or his attorney in fact, which shall be filed in the Patent Office; and a copy of the drawing to be furnished by the Patent Office, shall be attached to the patent as a part of the specification."

R. S. 4890 ..... T. 35, § 114

When the invention or discovery is of a composition of matter, the applicant, if required by the commissioner, shall furnish specimens of ingredients and of the composition, sufficient in quantity for the purpose of experiment.

R. S. 4891 ..... T. 35, § 114

In all cases which admit of representation by model, the applicant, if required by the commissioner, shall furnish a model of convenient size to exhibit advantageously the several parts of his invention or discovery.

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R. S. 4892 ..... T. 35, § 115

The applicant shall make oath that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement for which he solicits a patent; that he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, charge d'affaires, consul, or commercial agent, holding commission under the Government of the United States, or before any notary public of the foreign country in which the applicant may be.

As amended Mar. 3, 1903, ch. 1019, § 2, 32 Stat. 1226.

SEC. 2. That section forty-eight hundred and ninety-two of the Revised Statutes is amended by inserting after the words "notary public" the words "judge or magistrate having an official seal and authorized to administer oaths," and by adding at the end thereof the words "whose authority shall be proved by certificate of a diplomatic or consular officer of the United States;" so that the section so amended shall read:

"SEC. 4892. The applicant shall make oath that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition. or improvement for which he solicits a patent; that he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, charge d'affaires, or consul holding commission under the Government of the United States, or before any notary public, judge, or magistrate having any official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by certificate of a diplomatic or consular officer of the United States."

As amended May 23, 1930, ch. 312, § 3, 46 Stat. 376.

SEC. 3. The first sentence of section 4892 of the Revised Statutes, as amended (U. S. C., title 35, sec. 35), is amended to read as follows:

"SEC. 4892. The applicant shall make oath that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement, or of the variety of plant, for whic he solicits a patent; that he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen."

R. S. 4893 ..... T. 35, § 131

On the filing of any such application and the payment of the fees required by law, the Commissioner of Patents shall cause an examination to be made of the alleged new invention or discovery; and, if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the commissioner shall issue a patent therefor.

R. S. 4894 ..... T. 35, §§ 133, 267

All applications for patents shall be completed and prepared for examination within two years after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same within two years after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable.

As amended Mar. 3, 1897, ch. 391, § 4, 29 Stat. 693.

SEC. 4. That section forty-eight hundred and ninety-four of the Revised Statutes be, and the same hereby is, amended by striking out the words "two years" in every place where they occur and substituting in lieu thereof the words "one year," so that the section so amended will read as follows:

"Sec. 4894. All applications for patents shall be completed and prepared for examination within one year after the filing of the application and in default thereof, or upon failure of the applicant to prosecute the same within one year after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable.

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As amended July 6, 1916, ch. 225, § 1 (part), 39 Stat. 348.

Section forty-eight hundred and ninety-four of the Revised Statutes is amended so as to read as follows:

"SEC. 4894. All applications for patents shall be completed and prepared for examination within one year after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same within one year after any action therein of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable: *Provided, however* That no application shall be regarded as abandoned which has become the property of the Government of the United States and with respect to which the head of any department of the Government shall have certified to the Commissioner of Patents, within a period of three years, that the invention disclosed therein is important to the armament or defense of the United States: *Provided further*, That within ninety days, and not less than thirty days, before the expiration of any such three-year period the Commissioner of Patents shall, in writing, notify the head of the department interested in any pending application for patent, of the approaching expiration of the three-year period within which any application for patent shall have been pending."

As amended Mar. 2, 1927, ch. 273, 1, 44 Stat. 1335

That section 4894 of the Revised Statutes of the United States be amended by striking out the words "one year" wherever they appear and substituting therefor the words "six months."

As amended Aug. 7, 1939, ch. 568, 53 Stat. 1264

That section 4894 of the Revised Statutes (U. S. C., title 35, sec. 37) be amended by inserting after "six months", second occurrence, the words "or such shorter time, not less than thirty days or any extensions thereof, as shall be fixed by the Commissioner of Patents in writing to the applicant."

R. S. 4895 ..... T. 35, § 152

Patents may be granted and issued or reissued to the assignee of the inventor or discoverer; but the assignment must first be entered of record in the Patent Office. And in all cases of an application by an assignee for the issue of a patent, the application shall be made and the specification sworn to by the inventor or discoverer; and in all cases of an application for a reissue of any patent, the application must be made and the corrected specification signed by the inventor or discoverer, if he is living, unless the patent was issued and assignment made before the eighth day of July, eighteen hundred and seventy.

R. S. 4896 ..... T. 35, § 117

When any person, having made any new invention or discovery for which a patent might have been granted, dies before a patent is granted, the right of applying for and obtaining the patent shall devolve on his executor or administrator, in trust for the heirs at law of the deceased, in case he shall have died intestate; or if he shall have left a will, disposing of the same, then in trust for his devisees, in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him in his life time; and when the application is made by such legal representatives, the oath or affirmation required to be made shall be so varied in form that it can be made by them.

As amended Feb. 28, 1899, ch. 227, 30 Stat. 915

That section forty-eight hundred and ninety-six of the Revised Statutes is hereby amended by inserting after the words "in his lifetime" the following words: "and when any person having made any new invention or discovery for which a patent might have been granted becomes insane before a patent is granted, the right of applying for and obtaining the patent shall devolve upon his legally appointed guardian, conservator, or representative in trust for his estate, in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him while sane;" and by inserting at the end of said section the following words: "The foregoing section, as to insane persons, is to cover all applications now on file in the Patent Office or which may be hereafter made," so that the said section as amended will read as follows:

"SEC. 4896. When any person, having made any new invention or discovery for which a patent might have been granted, dies before a patent is granted, the right of applying for and obtaining the patent shall devolve upon his executor or administrator, in trust for the heirs at law of the deceased, in case he shall have died

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intestate; or if he shall have left a will, disposing of the same, then in trust for his devisees in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him in his lifetime; and when any person having made any new invention or discovery for which a patent might have been granted becomes insane before a patent is granted, the right of applying for and obtaining the patent shall devolve on his legally appointed guardian, conservator, or representative in trust for his estate, in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him while sane; and when the application is made by such legal representatives, the oath or affirmation required to be made shall be so varied in form that it can be made by them.

"The foregoing section, as to insane persons, is to cover all applications now on file in the Patent Office or which may be hereafter made."

As amended Mar. 3. 1903, ch. 1019, § 3, 32 Stat. 1226–7

SEC. 3. That section forty-eight hundred and ninety-six of the Revised Statutes is amended by adding thereto the following sentence: "The executor or administrator duly authorized under the law of any foreign country to administer upon the estate of the deceased inventor shall, in case the said inventor was not domiciled in the United States at the time of his death, have the right to apply for and obtain the patent. The authority of such foreign executor or administrator shall be proved by certificate of a diplomatic or consular officer of the United States;" so that the section so amended shall read as follows:

"SEC. 4896. When any person, having made any new invention or discovery for which a patent might have been granted, dies before a patent is granted, the right of applying for and obtaining the patent shall devolve on his executor or administrator, in trust for the heirs at law of the decreased, in case he shall have died intestate; or if he shall have left a will disposing of the same, then in trust for his devisees, in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him in his lifetime; and when the application is made by such legal representatives, the oath or affirmation required to be made shall be so varied in form that it can be made by them. The executor or administrator duly authorized under the law of any foreign country to administer upon the estate of the deceased inventor shall, in case the said inventor was not domiciled in the United States at the time of his death, have the right to apply for and obtain the patent. The authority of such foreign executor or administrator shall be proved by certificate of a diplomatic or consular officer of the United States."

As amended May 23, 1908, ch. 188, 35 Stat. 245

That section forty-eight hundred and ninety-six of the Revised Statutes be, and the same is hereby, amended so that the section shall read as follows:

"SEC. 4896. When any person, having made any new invention or discovery for which a patent might have been granted, dies before a patent is granted the right of applying for and obtaining the patent shall devolve on his executor or administrator, in trust for the heirs at law of the deceased, in case he shall have died intestate; or if he shall have left a will disposing of the same, then in trust for his devisees in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him in his lifetime; and when any person having made any new invention or discovery for which a patent might have been granted becomes insane before a patent is granted the right of applying for and obtaining the patent shall devolve on his legally appointed guardian, conservator, or representative in trust for his estate in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him while sane; and when the application is made by such legal representatives the oath or affirmation required to be made shall be so varied in form that it can be made by them. The executor or administrator duly authorized under the law of any foreign country to administer upon the estate of the deceased inventor shall, in case the said inventor was not domiciled in the United States at the time of his death, have the right to apply for and obtain the patent. The authority of such foreign executor or administrator shall be proved by certificate of a diplomatic or consular officer of the United States.

"The foregoing section, as to insane persons, is to cover all applications now on file in the Patent Office or which may be hereafter made."

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R. S. 4898 ..... T. 35, § 261

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 mortgage for a valuable consideration, without notice, unless it is recorded in the Patent-Office within three months from the date thereof.

As amended Mar. 3, 1897, ch. 391, § 5, 29 Stat. 693

SEC. 5. That section forty-eight hundred and ninety-eight of the Revised Statutes be, and the same hereby is, amended by adding thereto the following sentence:

"If any such assignment, grant, or conveyance of any patent shall be acknowledged before any notary public of the several States or Territories or the District of Columbia, or any commissioner of the United States circuit court, or before any secretary of legation or consular officer authorized to administer oaths or perform notarial acts under section seventeen hundred and fifty of the Revised Statutes, the certificate of such acknowledgment, under the hand and official seal of such notary or other officer, shall be prima facie evidence of the execution of such assignment, grant, or conveyance," so that the section so amended will read as follows:

"SEC. 4898. 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 hereof.

"If any such assignment, grant, or conveyance of any patent shall be acknowledged before any notary public of the several States or Territories or the District of Columbia, or any commissioner of the United States circuit court, or before any secretary of legation or consular officer authorized to administer oaths or perform notarial acts under section seventeen hundred and fifty of the Revised Statutes, the certificate of such acknowledgment, under the hand and official seal of such notary or other officer, shall be prima facie evidence of the execution of such assignment, grant or conveyance."

As amended Feb. 18, 1922, ch. 58, § 6, 42 Stat. 391

SEC. 6. That section 4898 of the Revised Statutes be, and the same is hereby, amended to read as follows:

"SEC. 4898. 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 or prior to such subsequent purchase or mortgage.

"If any such assignment, grant, or conveyance of any patent shall be acknowledged before any notary public of the several States or Territories or the District of Columbia, or any commissioner of any court of the United States for any District or Territory, or before any secretary of legation or consular officer authorized to administer oaths or perform notarial acts under section 1750 of the Revised Statutes, the certificate of such acknowledgment, under the hand and official seal of such notary or other officer, shall be prima facie evidence of the execution of such assignment, grant, or conveyance."

As amended Aug. 18, 1941, ch. 370, 55 Stat. 634

That section 4898 of the Revised Statutes (35 U. S. C. 47) be, and the same is hereby, amended to read as follows:

"SEC. 4898. Every application for patent or patent or any interest therein shall be assignable in law by an instrument in writing, and the applicant or patentee or his assigns or legal representatives may, in like manner, grant and convey an exclusive right under his application for patent or 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 or prior to such subsequent purchase or mortgage.

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"If any such assignment, grant, or conveyance of any application for patent or patent shall be acknowledged before any notary public of the several States or Territories or the District of Columbia, or any commissioner of any court of the United States for any district or Territory, or before any secretary of legation or consular officer authorized to administer oaths or perform notarial acts under section 1750 of the Revised Statutes (U. S. C., title 22, sec. 131) the certificate of such acknowledgment, under the hand and official seal of such notary or other officer, shall be prima facie evidence of the execution of such assignment, grant or conveyance."

R. S. 4899 ---------- Omitted

Every person who purchases of the inventor, or discoverer, or with his knowledge and consent constructs any newly invented or discovered machine, or other patentable article, prior to the application by the inventor or discoverer for a patent, or who sells or uses one so constructed, shall have the right to use, and vend to others to be used, the specific thing so made or purchased, without liability therefor.

R. S. 4900 ---------- T. 35, § 287

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

As amended Feb. 7, 1927, ch. 67, 44 Stat. 1058

That section 4900 of the Revised Statutes of the United States shall be amended to read as follows:

"It shall be the duty of all patentees and their assigns and legal representatives, and of all persons making or vending any patented article for or under them, to give sufficient notice to the public that the same is patented; either by fixing thereon the word 'patent', together with the number of the patent, or when, from the character of the article, this can not be done, by fixing to it, or to the package wherein one or more of them is inclosed, a label containing the like notice: *Provided, however*, That with respect to any patent issued prior to April 1, 1927, it shall be sufficient to give such notice in the form following, viz: '*Patented*', together with the day and year the patent was granted; and in any suit for infringement by the party failing so to mark, no damages shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement and continued, after such notice, to make, use, or vend the article so patented."

R. S. 4901 ---------- T. 35, § 292

Every person who, in any manner, marks upon anything made, used, or sold by him for which he has not obtained a patent, the name or any imitation of the name of any person who has obtained a patent therefor without the consent of such patentee, or his assigns or legal representatives; or

Who, in any manner, marks upon or affixes to any such patented article the word "patent" or "patentee", or the words "letters patent" or any word of like import, with intent to imitate or counterfeit the mark or device of the patentee, without having the license or consent of such patentee or his assigns or legal representatives; or

Who, in any manner, marks upon or affixes to any unpatented article the word "patent," or any word importing that the same is patented, for the purpose of deceiving the public, shall be liable, for every such offense, to a penalty of not less than $100, with costs; one-half of said penalty to the person who shall sue for the same, and the other to the use of the United States, to be recovered by suit in any district court of the United States within whose jurisdiction such offense may have been committed.

R. S. 4903 ---------- T. 35, § 132, 135

Whenever, on examination, any claim for a patent is rejected, the Commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejection,

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together with such information and references as may be useful in judging of the propriety of renewing his application or of altering his specification; and if after receiving such notice, the applicant persists in his claim for a patent, with or without altering his specification, the Commissioner shall order a reexamination of the case.

As amended Aug. 5, 1939, ch. 452, § 1, 53 Stat. 1213.

That section 4903 of the Revised Statutes (U. S. C., title 35, sec. 51) be amended by adding at the end thereof the following:

"No amendment for the first time presenting or asserting a claim which is the same as, or for substantially the same subject matter as, a claim of an issued patent may be made in any application unless such amendment is filed within one year from the date on which said patent was granted."

R. S. 4904 ..... T. 35, § 135

Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than twenty days, as the Commissioner shall prescribe.

As amended Mar. 2, 1927, ch. 273, § 4, 44 Stat. 1336.

SEC. 4. That section 4904 of the Revised Statutes of the United States be amended by striking out from the last sentence thereof the words "or of the board of examiners in chief, as the case may be."

As amended Aug. 5, 1939, ch. 451, § 1, 53 Stat. 1212.

That section 4904 of the Revised Statutes (U. S. C., title 35, sec. 52) be amended to read as follows:

"Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct a board of three examiners of interferences to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor."

R. S. 4905 ..... T. 35, § 23

The Commissioner of Patents may establish rules for taking affidavits and depositions required in cases pending in the Patent Office, and such affidavits and depositions may be taken before any officer authorized by law to take depositions to be used in the courts of the United States, or of the State where the officer resides.

R S. 4906 ..... T. 35 § 24

The clerk in any court of the United States, for any district or Territory wherein testimony is to be taken for use in any contested case pending in the Patent-Office, his agent or attorney, issue a subpoena for any witness residing or being within such district or Territory, commanding him to appear and testify before any officer in such district or Territory authorized to take depositions and affidavits, at any time and place in the subpoena stated. But no witness shall be required to attend at any place more than forty miles from the place where the subpoena is served upon him.

As amended Feb. 18, 1922, ch. 58, § 7, 49 Stat. 391, 392.

SEC. 7. That section 4906 of the Revised Statutes be, and the same is hereby amended to read as follows:

"SEC. 4906. The clerk of any court of the United States, for any District or Territory wherein testimony is to be taken for use in any contested case pending in the Patent Office, shall, upon the application of any party thereto, or of his agent or attorney, issue a subpoena for any witness residing or being within such District or Territory, commanding him to appear and testify before any officer in such District or Territory authorized to take depositions and affidavits at any time and place in the subpoena stated. But no witness shall be required to attend at any place more than forty miles from the place where the subpoena is served

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upon him; and the provisions of section 869 of the Revised Statutes relating to the issuance of subpoenas duces tecum shall apply to contested cases in the Patent Office."

R. S. 4907 ..... T. 35, § 24

Every witness duly subpoenaed and in attendance shall be allowed the same fees as are allowed to witnesses attending the courts of the United States.

R. S. 4908 ..... T. 35, § 24

Whenever any witness, after being duly served with such subpoena, neglects or refuses to appear, or after appearing refuses to testify, the judge of the court whose clerk issued the subpoena may, on proof of such neglect or refusal, enforce obedience to the process, or punish the disobedience, as in other like cases. But no witness shall be deemed guilty of contempt for disobeying such subpoena, unless his fees and traveling expenses in going to, returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret invention or discovery made or owned by himself.

R. S. 4909 ..... T. 35, § 134

Every applicant for a patent or for the re-issue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners-in-chief; having once paid the fee for such appeal.

As amended Mar. 2, 1927, ch. 273, § 5, 44 Stat. 1336.

SEC. 5. That section 4909 of the Revised Statutes of the United States be amended by striking out the words "board of examiners in chief" and substituting therefor the words "board of appeals."

As amended Aug. 5, 1939, ch. 451, § 2, 53 Stat. 1212.

SEC. 2. That section 4909 of the Revised Statutes (U. S. C., title 35, sec. 57) be amended to read as follows:

"Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, may appeal from the decision of the primary examiner to the Board of Appeals, having once paid the fee for such appeal."

R. S. 4911 ..... T. 35, § 141

If such party, except a party to an interference, is dissatisfied with the decision of the Commissioner, he may appeal to the supreme court of the District of Columbia, sitting in banc.

As amended Mar. 2, 1927, ch. 273, § 8, 44 Stat. 1336.

SEC. 8. That section 4911 of the Revised Statutes of the United States be amended to read as follows:

"SEC. 4911. If any applicant is dissatisfied with the decision of the board of appeals, he may appeal to the United States Court of Appeals of the District of Columbia, in which case he waives his right to proceed under section 4915 of the Revised Statutes. If any party to an interference is dissatisfied with the decision of the board of appeals, he may appeal to the United States Court of Appeals of the District of Columbia, provided that such appeal shall be dismissed if any adverse party to such interference shall, within twenty days after the appellant shall have filed notice of appeal according to section 4912 of the Revised Statutes, file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes. Thereupon the appellant shall have thirty days thereafter within which to file a bill of equity under said section 4915, in default of which the decisions appealed from shall govern the further proceedings in the case. If the appellant shall file such bill within said thirty days and shall file due proof thereof with the Commissioner of Patents, the issue of a patent to the party awarded priority by said board of appeals shall be withheld pending the final determination of said proceeding under said section 4915."

As amended Mar. 2, 1929, ch. 488, § 2 (b), 45 Stat. 1475.

SEC. 2. (b) Sections 4911 (Forty-fourth Statutes, page 1336), 4912 (section 60, title 35, United States Code), and 4915 (section 63, title 35, United States Code)

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of the Revised Statutes, as amended, and section 9 of the Act entitled "An Act to authorize the registration of trade-marks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same,' approved February 20, 1905 (United States Code, title 15, section 89), are amended by striking out the words "Court of Appeals of the District of Columbia" wherever they occur therein and inserting in lieu thereof the words "United States Court of Customs and Patent Appeals" in each instance.

As amended Aug. 5, 1939, ch. 451, § 3, 53 Stat. 1212.

SEC. 3. That section 4911 of the Revised Statutes (U. S. C., title 35, sec. 59a) be amended by changing the words "Board of Appeals" in the second sentence to read "board of interference examiners", and by canceling the last sentence of said section.

R. S. 4912 ..... T. 35, § 142

When an appeal is taken to the supreme court of the District of Columbia, the appellant shall give notice thereof to the Commissioner, and file in the Patent-Office, within such time as the Commissioner shall appoint, his reasons of appeal, specifically set forth in writing.

As amended Mar. 2, 1927, ch. 273, § 9, 44 Stat. 1336.

SEC. 9. That section 4912 of the Revised Statutes of the United States be amended by striking out the words "Supreme Court of the District of Columbia" and substituting therefor the words "Court of Appeals of the District of Columbia".

R. S. 4913 ..... T. 35, § 143

The court shall, before hearing such appeal, give notice to the Commissioner of the time and place of the hearing, and on receiving such notice the Commissioner shall give notice of such time and place in such manner as the court may prescribe, to all parties who appear to be interested therein. The party appealing shall lay before the court certified copies of all the original papers and evidence in the case, and the Commissioner shall furnish the court with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal. And at the request of any party interested, or of the court, the Commissioner and the examiners may be examined under oath, in explanation of the principles of the thing for which a patent is demanded.

As amended Mar. 2, 1927, ch. 273, § 10, 44 Stat. 1336.

SEC 10. That section 4913 of the Revised Statutes of the United States be amended by striking out the words "And at the request of any party interested, or of the court, the commissioner and the examiners may be examined under oath in explanation of the principles of the thing for which a patent is demanded."

R. S. 4914 ..... T. 35, § 144

The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the commissioner, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

R. S. 4915 ..... T. 35, §§ 145, 146

Whenever a patent on application is refused, either by the Commissioner of Patents or by the supreme court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent-Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where

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there is no opposing party, a copy of the bill shall be served on the Commissioner; and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not.

As amended Mar. 2, 1927, ch. 273, § 11, 44 Stat. 1336.

SEC. 11. That section 4915 of the Revised Statutes of the United States be amended to read as follows:

"SEC. 4915. Whenever a patent on application is refused by the Commissioner of Patents, the applicant, unless appeal has been taken from the decision of the board of appeals to the Court of Appeals of the District of Columbia, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioners; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit."

As amended Mar. 2, 1929, ch. 488, § 2 (b), 45 Stat. 1475.

SEC. 2. (b) Sections 4911 (Forty-fourth Statutes, page 1336), 4912 (section 60, title 35, United States Code), and 4915 (section 63, title 35, United States Code) of the Revised Statutes, as amended, and section 9 of the Act entitled "An Act to authorize the registration of trade-marks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same," approved February 20, 1905 (United States Code, title 15, section 89), are amended by striking out the words "Court of Appeals of the District of Columbia" wherever they occur therein and inserting in lieu thereof the words "United States Court of Customs and Patent Appeals" in each instance.

As amended Aug. 5, 1939, ch. 451, § 4, 53 Stat. 1212.

SEC. 4. That section 4915 of the Revised Statutes (U. S. C., title 35, sec. 63) be amended by changing the first sentence thereof to read:

"Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear."

R. S. 4916 ---------- T. 35, §§ 251, 252

Whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the Commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be reissued to the patentee, or in the case of his death or of an assignment of the whole or any undivided part of the original patent, then to his executors, administrators, or assigns, for the unexpired part of the term of the original patent. Such surrender shall take



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effect upon the issue of the amended patent. The Commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters-patent. The specifications and claims in every such case shall be subject to revision and restriction in the same manner as original applications are. Every patent so reissued, together with the corrected specification, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; but no new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the Commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid.

May 24, 1928, ch. 730, 45 Stat. 732 as amended.

That section 4916 of the Revised Statutes of the United States be, and the same is hereby, amended to read as follows:

"SEC. 4916. Whenever any patent is wholly or partly inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a patent for the same invention, and in accordance with the corrected specification, to be reissued to the patentee or to his assigns or legal representatives, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the reissued patent, but in so far as the claims of the original and reissued patents are identical, such surrender shall not affect any action then pending nor abate any casue of action then existing, and the reissued patent to the extent that its claims are identical with the original patent shall constitute a continuation thereof and have effect continuously from the date of the original patent. The commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters-patent. The specifications and claims in every such case shall be subject to revision and restriction in the same manner as original applications are. Every patent so reissued, together with the corrected specifications, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; but no new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid."

R. S. 4917 ..... T. 35, § 253

Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it.

R. S. 4918 ..... T. 35, § 291

Whenever there are interfering patents, any person interested in any one of them, or in the working of the invention claimed under either of them, may have

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relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either of the patents void in whole or in part, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the right of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment.

Mar. 2, 1927, ch. 273, § 12, 44 Stat. 1337 as amended.

SEC. 12. That section 4918 of the Revised Statutes of the United States be amended to change the phrase "may adjudge and declare eight of the patents void in whole or in part" to read as follows: "may adjudge and declare either or both of the patents void in whole or in part, upon any ground."

R. S. 4919 ..... T. 35, §§ 281, 284

Damages for the infringement of any patent may be recovered by action on the case, in the name of the party interested, either as patentee, assignee, or grantee. And whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment thereon for any sum above the amount found by the verdict as the actual damages sustained, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs.

R. S. 4920 ..... T. 35, § 282

In any action for infringement the defendant may plead the general issue, and, having given notice in writing to the plaintiff or his attorney thirty days before, may prove on trial any one or more of the following special matters:

First. That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect; or,

Second. That he had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; or,

Third. That it has been patented or described in some printed publication prior to his supposed invention or discovery thereof; or,

Fourth. That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; or,

Fifth. That it had been in public use or on sale in this country for more than two years before his application for a patent, or had been abandoned to the public.

And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of the patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented or to have had the prior knowledge of the thing patented, and where and by whom it had been used; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defenses may be pleaded in any suit in equity for relief against an alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect.

Mar. 3, 1897, ch. 391, § 2, 29 Stat. 692 as amended.

SEC. 2. That section forty-nine hundred and twenty of the Revised Statutes be, and the same hereby is, amended by adding to the third clause of said section after "thereof" and before "or" the following words: "or more than two years prior to his application for a patent therefor," so that the section so amended will read as follows:

"SEC. 4920. In any action for infringement the defendant may plead the general issue, and, having given notice in writing to the plaintiff or his attorney thirty days before, may prove on trial any one or more of the following special matters:

"First. That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect; or,

"Second. That he had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; or,

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"Third. That it has been patented or described in some printed publication prior to his supposed invention or discovery thereof, or more than two years prior to his application for a patent therefor; or,

"Fourth. That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; or,

"Fifth. That it had been in public use or on sale in this country for more than one year before his application for a patent, or had been abandoned to the public.

"And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of the patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented or to have had the prior knowledge of the thing patented, and where and by whom it had been used; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defenses may be pleaded in any suit in equity for relief against an alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect."

Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212 as amended.

That sections 4886, 4887, 4920, and 4929 of the Revised Statutes (U. S. C., title 35, secs. 31, 32, 69, and 73) be amended by striking out the words "two years" wherever they appear in said sections and substituting therefor the words "one year."

R. S. 4921 ..... T. 35, §§ 283, 284, 285, 286, 290

The several courts vested with jurisdiction of cases arising under the patent laws shall have power to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for an infringement, the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby; and the court shall assess the same or cause the same to be assessed under its direction. And the court shall have the same power to increase such damages, in its discretion, as is given to increase the damages found by verdicts in actions in the nature of actions of trespass upon the case.

Mar. 3, 1897, ch. 391, § 6, 29 Stat. 694 as amended.

SEC. 6. That section forty-nine hundred and twenty-one of the Revised Statutes be, and the same hereby is, amended by adding thereto the following sentence:

"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, and this provision shall apply to existing causes of action." so that the section so amended will read as follows:

"SEC. 4921. The several courts vested with jurisdiction of cases arising under the patent laws shall have power to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for an infringement the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complaint has sustained thereby; and the court shall assess the same or cause the same to be assessed under its direction. And the court shall have the same power to increase such damages, in its discretion, as is given to increase the damages found by verdicts in actions in the nature of actions of trespass upon the case.

"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, and this provision shall apply to existing causes of action."

Feb. 18, 1922, ch. 58, § 8, 42 Stat. 392 as amended.

SEC. 8. That section 4921 of the Revised Statutes be, and the same is hereby, amended to read as follows:

"SEC. 4921. The several courts vested with jurisdiction of cases arising under the patent laws shall have power to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for an infringement the complainant shall be

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entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby, and the court shall assess the same or cause the same to be assessed under its direction. If on the proofs it shall appear that the complainant has suffered damage from the infringement or that the defendant has realized profits therefrom to which the complainant is justly entitled, but that such damages or profits are not susceptible of calculation and determination with reasonable certainty, the court may, on evidence tending to establish the same, in its discretion, receive opinion or expert testimony, which is hereby declared to be competent and admissible, subject to the general rules of evidence applicable to this character of testimony; and upon such evidence and all other evidence in the record the court may adjudge and decree the payment by the defendant to the complainant of a reasonable sum as profits or general damages for the infringement: *Provided*, That this provision shall not affect pending litigation. And the court shall have the same power to increase such damages, in its discretion, as is given to increase the damages found by verdicts in actions in the nature of actions of trespass upon the case; 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, and this provision shall apply to existing causes of action. And it shall be the duty of the clerks of such courts within one month after the filing of any action, suit, or proceeding arising under the patent laws to give notice thereof in writing to the Commissioner of Patents, setting forth in order so far as known the names and addresses of the litigants, names of the inventors, and the designating number or numbers of the patent or patents upon which the action, suit, or proceeding has been brought, and in the event any other patent or patents be subsequently included in the action, suit, or proceeding by amendment, answer, cross bill, or other pleading, the clerk shall give like notice thereof to the Commissioner of Patents, and within one month after the decision is rendered or a decree issued the clerk of the court shall give notice thereof to the Commissioner of Patents, and it shall be the duty of the Commissioner of Patents on receipt of such notice forthwith to indorse the same upon the file wrapper of the said patent or patents and to incorporate the same as a part of the contents of said file or file wrapper; and for each notice required to be furnished to the Commissioner of Patents in compliance herewith a fee of 50 cents shall be taxed by the clerk as costs of suit."

Aug. 1, 1946, ch. 726, 60 Stat. 778 as amended.

That section 4921 of the Revised Statutes of the United States (35 U. S. C. A. 70) is hereby amended to read as follows:

"The several courts vested with jurisdiction of cases arising under the patent laws shall have power to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable; and upon a judgment being rendered in any case for an infringement the complainant shall be entitled to recover general damages which shall be due compensation for making, using, or selling the invention, not less than a reasonable royalty therefor, together with such costs, and interest, as may be fixed by the court. The court may in its discretion award reasonable attorney's fees to the prevailing party upon the entry of judgment on any patent case.

"The court is authorized to receive expert or opinion evidence upon which to determine in conjunction with any other evidence in the record, due compensation for making, using, or selling the invention, and such expert or opinion evidence is declared to be competent and admissible subject to the general rules of evidence applicable thereto.

"The court shall assess said damages, or cause the same to be assessed, under its direction and shall have the same power to increase the assessed damages, in its discretion, as is given to increase the damages found by verdicts in actions in the nature of actions of trespass upon the case; but recovery shall not be had for any infringement committed more than six years prior to the filing of the complaint in the action. And it shall be the duty of the clerks of such courts within one month after the filing of any action, suit, or proceeding arising under the patent laws to give notice thereof in writing to the Commissioner of Patents, setting forth in order so far as known the names and addresses of the litigants, names of the inventors, and the designating number or numbers of the patent or patents upon which the action, suit, or proceeding has been brought, and in the event any other patent or patents be subsequently included in the action, suit, or proceeding by amendment, answer, cross bill, or other pleading, the

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clerk shall give like notice thereof to the Commissioner of Patents, and within one month after the decision is rendered or a judgment issued the clerk of the court shall give notice thereof to the Commissioner of Patents, and it shall be the duty of the Commissioner of Patents on receipt of such notice forthwith to endorse the same upon the file wrapper of the said patent or patents, and to incorporate the same as a part of the contents of said file or file wrapper."

This Act shall take effect upon approval and shall apply to pending causes of action in which the taking of the testimony has not been concluded: *Provided, however,* That pending causes of action in which the taking of the testimony has been concluded are to be governed by the statute in force at the time of approval of this Act as if such statute had not been amended.

R. S. 4922 ..... T. 35, § 288

Whenever, through inadvertence, accident, or mistake and without any willful default or intent to defraud or mislead the public, a patentee has, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof, which was bona fide his own, if it is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right, notwithstanding the specifications may embrace more than that of which the patentee was the first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff no costs shall be recovered unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit. But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer.

R. S. 4923 ..... T. 35, § 102, 104

Whenever it appears that a patentee, at the time of making his application for the patent, believed himself to be the original and first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country, before his invention or discovery thereof, if it had not been patented or described in a printed publication.

R. S. 4929 ..... T. 35, § 171

Any person who, by his own industry, genius, efforts, and expense, has invented and produced any new and original design for a manufacture, bust, statute, alto-relievo, or bas-relief; any new and original design for the printing of woolen, silk, cotton, or other fabrics; any new and original impression, ornament, patent, print, or picture to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication, may, upon payment of the fee prescribed, and other due proceedings had the same as in cases of inventions or discoveries, obtain a patent therefor.

As amended May 9, 1902, ch. 783, 32 Stat. 193.

That section forty-nine hundred and twenty-nine of the Revised Statutes be, and the same is hereby, amended so as to read as follows:

"SEC. 4949. Any person who has invented any new, original, and ornamental design for an article of manufacture, not known or used by others in this country before his invention thereof, and not patented or described in any printed publication in this or any foreign country before his invention thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law and other due proceedings had, the same as in cases of inventions or discoveries covered by section 4886, obtain a patent therefor."

As amended Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212.

That sections 4886, 4887, 4920, and 4929 of the Revised Statutes (U. S. C., title 35, secs. 31, 32, 69, and 73) be amended by striking out the words "two years"

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wherever they appear in said sections and substituting therefor the words "one year".

R. S. 4930 ..... T. 35, § 114

The commissioner may dispense with models of designs when the design can be sufficiently represented by drawings or photographs.

R. S. 4931 ..... T. 35, § 173

Patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant may, in his application, elect.

R. S. 4933 ..... T. 35, § 171

All the regulations and provisions which apply to obtaining or protecting patents for inventions or discoveries not inconsistent with the provisions of this title, shall apply to patents for designs.

R. S. 4934 ..... T. 35, §§ 12, 13, 41

The following shall he the rates for patent-fees:

On filing each original application for a patent, except in design cases, fifteen dollars.

On issuing each original patent, except in design cases, twenty dollars.

In design cases: For three years and six months, ten dollars; for seven years, fifteen dollars; for fourteen years, thirty dollars.

On filing each caveat, ten dollars.

On every application for the re-issue of a patent, thirty dollars.

On filing each disclaimer, ten dollars.

On every application for the extension of a patent, fifty dollars.

On the granting of every extension of a patent, fifty dollars.

On an appeal for the first time from the primary examiners to the examiners-in-chief, ten dollars.

On every appeal from the examiners-in-chief to the Commissioner, twenty dollars.

For certified copies of patents and other papers, including certified printed copies, ten cents per hundred words.

For recording every assignment, agreement, power of attorney, or other paper, of three hundred words or under, one dollar; of over three hundred and under one thousand words, two dollars; of over one thousand words, three dollars.

For copies of drawings, the reasonable cost of making them.

As amended Feb. 18, 1922, ch. 58, § 9, 42 Stat. 393.

SEC. 9. That section 4934 of the Revised Statutes be, and the same is hereby, amended to read as follows:

"SEC. 4934. The following shall be the rates for patent fees:

"On filing each original application for a patent, except in design cases, $20.

"On issuing each original patent, except in design cases, $20.

"In design cases: For three years and six months, $10; for seven years, $15; for fourteen years, $30.

"On every application for the reissue of a patent, $30.

"On filing each disclaimer, $10.

"On an appeal for the first time from the primary examiners to the examiners in chief, $10.

"On every appeal from the examiners in chief to the commissioner, $20.

"For uncertified printed copies of specifications and drawings of patents, 10 cents per copy: *Provided*, That the Commissioner of Patents may supply public libraries of the United States with such copies as published, for $50 per annum: *Provided further*, That the Commissioner of Patents may exchange copies of United States patents for those of foreign countries.

"For copies of records made by the Patent Office, excluding printed copies, 10 cents per hundred words.

"For each certificate, 25 cents.

"For recording every assignment, agreement, power of attorney, or other paper of three hundred words or under, $1; of over three hundred and under one thousand words, $2; and for each additional thousand words or fraction thereof, $1; for each additional patent or application included or involved in one writing, where more than one is so included or involved, 25 cents additional.

"For copies of drawings, the reasonable cost of making them."

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As amended Feb. 14, 1927, ch. 139, § 2, 44 Stat. 1098.

SEC. 2. That section 4934 of the Revised Statutes be amended to read as follows:

"SEC. 4934. The following shall be the rates for patent fees:

"On filing each original application for a patent, except in design cases, $20, and $1 for each claim in excess of twenty.

"On issuing each original patent, except in design cases, $20, and $1 for each claim in excess of twenty.

"In design cases: For three years and six months, $10; for seven years, $15; for fourteen years, $30.

"On every application for the reissue of a patent, $30.

"On filing each disclaimer, $10.

"On an appeal for the first time from the primary examiners to the examiners in chief, $10.

"On every appeal from the examiners in chief to the commissioner, $20.

"For uncertified printed copies of specifications and drawings of patents, 10 cents per copy: *Provided*, That the Commissioner of Patents may supply public libraries of the United States with such copies as published, for $50 per annum: *Provided further*, That the Commissioner of Patents may exchange copies of United States patents for those of foreign countries.

"For copies of records made by the Patent Office, excluding printed copies, 10 cents per hundred words.

"For each certificate, 25 cents.

"For recording every assignment, agreement, power of attorney, or other paper of three hundred words or under, $1; of over three hundred and under one thousand words, $2; and for each additional thousand words or fraction thereof, $1; for each additional patent or application included or involved in one writing, where more than one is so included or involved, 25 cents additional.

"For copies of drawings, the reasonable cost of making them."

As amended Mar. 2, 1927, ch. 273, § 13, 44 Stat. 1337.

SEC. 13. That section 4934 of the Revised Statutes of the United States be amended by striking out the following words: "On an appeal for the first time from the primary examiners to the examiners in chief, $10. On every appeal from the examiners in chief to the commissioner, $20," and substituting therefor the words "on an appeal for the first time from the primary examiners to the board of appeals, $15. On every appeal from the examiner of interferences to the board of appeals, $25."

As amended Apr. 11, 1930, ch. 132, § 3, 46 Stat. 155.

SEC. 3. Section 4934 of the Revised Statutes, as amended (United States Code, title 35, section 78), is amended to read as follows:

"SEC. 4934. The following shall be the rates for patent fees:

"On filing each original application for a patent, except in design cases, $25, and $1 for each claim in excess of twenty.

"On issuing each original patent, except in design cases, $25, and $1 for each claim in excess of twenty.

"In design cases: For three years and six months, $10; for seven years, $15; for fourteen years, $30.

"On every application for the reissue of a patent, $30.

"On filing each disclaimer, $10.

"On an appeal for the first time from the primary examiners to the Board of Appeals, $15.

"On every appeal from the examiner of interferences to the Board of Appeals, $25.

"For uncertified printed copies of specifications and drawings of patents, 10 cents per copy: *Provided*, That the Commissioner of Patents may supply public libraries of the United States with such copies as published, for $50 per annum: *Provided further*, That the Commissioner of Patents may exchange copies of United States patents for those of foreign countries.

"For copies of records made by the Patent Office, excluding printed copies, 10 cents per hundred words.

"For each certificate, 50 cents.

"For recording every assignment, agreement, power of attorney, or other paper not exceeding six pages, $3; for each additional two pages or less, $1; for each additional patent or application included or involved in one writing, where more than one is so included or involved, 50 cents additional.

"For copies of drawings, the reasonable cost of making them."

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As amended June 30, 1932, ch. 314, §§ 308, 309, 47 Stat. 410.

SEC. 308. After the expiration of thirty days after the enactment of this Act (but in no event prior to July 1, 1932), the base fee of $25 provided by section 4934 of the Revised Statutes, as amended (U. S. C., Sup. V, title 35, sec. 78), to be paid upon the filing of each original application and upon each renewal application for patent, except in design cases, and on issuing each original patent, except in design cases, is hereby increased to $30.

SEC. 309. Section 4934 of the Revised Statutes, as amended (U. S. C., Sup. V, title 35, sec. 78), is amended by adding at the end thereof the following:

"On filing each petition for the revival of an abandoned application for a patent, $10."

As amended Aug. 9, 1939, ch. 619, § 3, 53 Stat. 1293.

SEC. 3. That section 4934 of the Revised Statutes (U. S. C., title 35, sec. 78) be amended by changing the last sentence to read: "On filing each petition for the revival of an abandoned application for a patent or for the delayed payment of the fee for issuing each patent, $10."

As amended June 15, 1950, ch. 249, 64 Stat. 215.

That section 4934 of the Revised Statutes, as amended (U. S. C., title 35, sec. 78), is amended by inserting after "*Provided*, That the Commissioner of Patents may supply public libraries of the United States with such copies as published, for $50 per annum" a colon and the following: "*Provided further*, That the Commissioner of Patents may supply to any public library approved by the Commissioner, which on January 1, 1949, was receiving such copies under the preceding proviso, such copies for any year in which such library did not receive copies under the preceding proviso upon the payment of $50 per year for any such year."

R. S. 4935 ..... T. 35, § 42

Patent fees may be paid to the Commissioner of Patents, or to the Treasurer or any of the assistant treasurers of the United States, or to any of the designated depositaries, national banks, or receivers of public money, designated by the Secretary of the Treasury for that purpose; and such officer shall give the depositor a receipt or certificate of deposit therefor. All money received at the Patent Office, for any purpose, or from any source whatever, shall be paid into the Treasury as received, without any deduction whatever.

R. S. 4936 ..... T. 35, § 42

The Treasurer of the United States is authorized to pay back any sum or sums of money to any person who has through mistake paid the same into the Treasury, or to any receiver or depositary, to the credit of the Treasury, as for fees accruing at the Patent Office, upon a certificate thereof being made to the Treasurer by the Commissioner of Patents.

## STATUTES AT LARGE

Mar. 3, 1883, ch. 143 (part), 22 Stat. 625 ..... T. 35, § 266

The Secretary of the Interior and the Commissioner of Patents are authorized to grant any officer of the government, except officers and employees of the Patent Office, a patent for any invention of the classes mentioned in section forty-eight hundred and eighty-six of the Revised Statutes, when such invention is used or to be used in the public service, without the payment of any fee: *Provided*, That the applicant in his application shall state that the invention described therein, if patented, may be used by the government or any of its officers or employees in the prosecution of work for the government, or by any other person in the United States, without the payment to him of any royalty thereon, which stipulation shall be included in the patent.

As amended Apr. 30, 1928, ch. 460, 45 Stat. 467.

That so much of chapter 143 of the Act of Congress approved March 3, 1883 (Twenty-second Statutes at Large, page 625), as relates to issue of patents without payment of any fee be, and the same is hereby, amended to read as follows:

"The Commissioner of Patents is authorized to grant, subject to existing law, to any officer, enlisted man, or employee of the Government, except officers and employees of the Patent Office, a patent for any invention of the classes mentioned in section 4886 of the Revised Statutes, without the payment of any fee when the head of the department or independent bureau certifies such invention is used or

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liable to be used in the public interest: *Provided*, That the applicant in his application shall state that the invention described therein, if patented, may be manufactured and used by or for the Government for governmental purposes without the payment to him of any royalty thereon, which stipulation shall be included in the patent."

Feb. 4, 1887, ch. 105, §§ 1 and 2, 24 Stat. 387 ..... T. 35, § 289

Hereafter, during the term of letters patent for a design, it shall be unlawful for any person other than the owner of said letters patent, without the license of such owner, to apply the design secured by such letters patent, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or to sell or expose for sale any article of manufacture to which such design or colorable imitation shall, without the license of the owner, have been applied, knowing that the same has been so applied. Any person violating the provisions, or either of them, of this section, shall be liable in the amount of two hundred and fifty dollars; and in case the total profit made by him from the manufacture or sale, as aforesaid, of the article or articles to which the design, or colorable imitation thereof, has been applied, exceeds the sum of two hundred and fifty dollars, he shall be further liable for the excess of such profit over and above the sum of two hundred and fifty dollars; and the full amount of such liability may be recovered by the owner of the letters patent, to his own use, in any circuit court of the United States having jurisdiction of the parties, either by action at law or upon a bill in equity for an injunction to restrain such infringement.

SEC. 2. That nothing in this Act contained shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any owner of letters patent for a design, aggrieved by the infringement of the same might have had if this act had not been passed; but such owner shall not twice recover the profit made from the infringement.

Feb. 18, 1888, ch. 15, 25 Stat. 40 ..... T. 35, § 153

See under R. S. 4883.

Mar. 3, 1891, ch. 541, § 1 (part) 26 Stat. 940 ..... T. 35, § 10

And certified copies of such drawings and specifications may be furnished by the Commissioner of Patents to persons applying therefor upon payment of the present rates for uncertified copies, and twenty-five cents additional for each certification.

May 19, 1896, ch. 204, 29 Stat. 124 ..... T. 35, § 41

See under R. S. 493.

Mar. 3, 1897, ch. 391, §§ 1, 2, 3, 4, 5, 6, 29 Stat. 694. — T. 35, §§ 101, 102, 119, 133, 211, 267, 282-6, 250, 171, 172.

See under R. S. 4886, 4920, 4887, 4894, 4898, 4921.

Mar. 3, 1897, ch. 391, § 7, 29 Stat. 694 ..... Omitted

SEC. 7. That in every case where the head of any Department of the Government shall request the Commissioner of Patents to expedite the consideration of an application for a patent it shall be the duty of such head of a Department to be represented before the Commissioner in order to prevent the improper issue of a patent.

June 10 1898, ch 423, § 1, 30 Stat. 440 ..... T. 35 § 9

SEC. 1. That for the purpose of determining with more readiness and accuracy the novelty of inventions for which applications for letters patent are or may be filed in the United States Patent Office, and to prevent the issuance of letters patent of the United States for inventions which are not new, the Commissioner of Patents is hereby authorized and directed to revise and perfect the classification, by subjects-matter, of all letters patent and printed publications in the United States Patent Office which constitute the field of search in the examination as to the novelty of invention for which applications for patents are or may be filed.

Feb. 28, 1899, ch 227, 30 Stat. 915 ..... T. 35, § 117

See under R. S. 4896.

Apr. 11, 1902, ch. 417, 32 Stat. 95 ..... T. 35, § 153

See under R. S. 4883.

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May 9, 1902, ch. 783, 32 Stat. 193 ..... T. 35, § 171

See under R. S. 4929.

Mar. 3, 1903, ch. 1019, §§ 1, 2, 3, 32 Stat. 1225–7 ..... T. 35, §§ 102, 115, 117, 119, 172

See under R. S. 4887, 4892, 4896.

May 23, 1908, ch. 188, 35 Stat. 245 ..... T. 35, § 117

See under R. S. 4896.

May 23, 1908, ch. 189, 35 Stat. 246 ..... T. 35, § 151

See under R. S. 4885.

May 27, 1908, ch. 200, § 1 (part), 35 Stat. 343 ..... T. 35, § 41

In lieu of the fees fixed by section forty-nine hundred and thirty-four of the Revised Statutes for recording assignments, agreements, powers of attorney, or other papers in the Patent Office the following shall hereafter be the rates:

For recording every assignment, agreement, power of attorney, or other paper, of three hundred words or under, one dollar; of over three hundred and under one thousand words, two dollars; and for each additional thousand words or fraction thereof, one dollar.

Jan. 14, 1915, Pub. Res. 61, 38 Stat. 1221 ..... T. 35, § 12

That the Commissioner of Patents of the United States be, and he is hereby, authorized to exchange with the Dominion of Canada, under such terms of contract as may by him be deemed practicable, printed copies of patents now in the United States Patent Office and hereafter issued by the United States.

Mar. 3, 1915, ch. 94, §§ 1, 2, 38 Stat. 958 ..... T. 35, §§ 111–113,162

See under R. S. 4888, 4889.

Feb. 15, 1916, ch. 22, § 1, 39 Stat. 9 ..... T. 35, § 3

See under R. S. 476.

July 6, 1916, ch. 225, § 1 (part), 39 Stat. 348 ..... T. 35, §§ 133, 267

See under R. S. 4894.

Nov. 4, 1919, ch. 93, § 1 (part), 41 Stat. 335 ..... T. 35, § 41

*Provided*, That hereafter 10 cents per copy shall be charged for uncertified printed copies of specifications and drawings of patents.

Mar. 6, 1920, ch. 94, § 1 (part), 41 Stat. 512 ..... T. 35, § 42

Hereafter all patent fees shall be paid to the Commissioner of Patents, who shall deposit the same in the Treasury of the United States in such manner as the Secretary of the Treasury shall direct, and said commissioner is authorized to pay back any sum or sums of money paid to him by any person by mistake or in excess of the fee required by law.

Mar. 3, 1921, ch. 126, §§ 1–8, 41 Stat. 1313–1315 ..... Omitted

That the rights of priority provided by section 4887 of the Revised Statutes, for the filing of applications for patent for inventions and designs, which rights had not expired on the 1st day of August, 1914, or which rights have arisen since the 1st day of August, 1914, shall be, and the same are hereby, extended until the expiration of a period of six months from the passage of this Act in favor of the citizens of the United States or citizens or subjects of all countries which have extended, or which now extend, or which within said period of six months shall extend substantially reciprocal privileges to citizens of the United States, and such extension shall apply to applications upon which patents have been granted, as well as to applications now pending or filed within the period herein: *Provided* That such extension shall in no way furnish a basis of claim against the Government of the United States *Provided further* That such extension shall in no way affect the right of any citizen of the United States, who, before the passage of this Act, was bona fide in possession of any rights in patents or applications for patent

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conflicting with rights in patents granted or validated by reason of such extension, to exercise such rights by itself or himself personally, or by such agents, or licensees, as derived their rights from it, or him, before the passage of this Act, and such persons shall not be amenable to any action for infringement of any patent granted or validated by reason of such extension.

A patent shall not be refused on an application coming within the provisions of this Act, nor shall a patent granted on such application be held invalid by reason of the invention having been patented or described in any printed publication or in public use or on sale in the United States prior to the filing of the application, unless such patent or publication or such public use or sale was prior to the filing of the foreign application upon which the right of priority is based.

SEC. 2. That the time now fixed by law for the payment of any fee or for the taking of any action with respect to an application for patent, which time had not expired on August 1, 1914, or which commenced after August 1, 1914, is hereby extended until the expiration of one year from the passage of this Act, without the payment of extension fees or other penalty in favor of the citizens or subjects of countries which have extended, now extend, or shall extend during a period of one year from the passage of this Act substantially reciprocal privileges to citizens of the United States, provided that no extension herein shall confer such privileges on the citizens or subjects of a foreign country for a longer term than the term during which such privileges are conferred by such foreign country on the citizens of the United States, but nothing in this Act shall give any right to reopen interference proceedings where final hearing before the examiner of interferences has taken place.

SEC. 3. That no patent granted or validated by reason of the extensions provided for in sections 1 and 2 of this Act shall abridge or otherwise affect the right of any citizen of the United States, or his agent or agents, or his successor in business, to continue any manufacture, use, or sale commenced before the passage of this Act by such citizen, nor shall the continued manufacture, use, or sale by such citizen, or the use or sale of the devices resulting from such manufacture or use constitute an infringement.

SEC. 4. That all applications for patent filed since August 1, 1914, and prior to June 15, 1920, which were executed by an agent of the applicant, and in which a petition, specification, and oath, signed by the inventor, or his executor or administrator, had been filed or shall have been filed within a period of one year from the passage of this Act, and the patents granted on such applications, shall have the same force and effect as if the papers signed by the inventor, or his executor or administrator, had been filed on the date on which the papers signed by the agent were filed.

SEC. 5. That all applications for patent filed since August 1, 1914, in which the oath was executed before or authenticated by a consular officer, or other representative qualified to administer oaths, of a Government acting in the interest of the Government of the United States, shall have the same force and effect as if said oath had been executed by the applicant before a consular officer of the United States.

SEC. 6. That where an invention was made by a person while serving abroad, during the war, with the forces of the United States, civil or military, the inventor thereof shall be entitled, in interference and other proceedings arising in connection with such invention, to the same rights of priority with respect of such invention as if the same had been made in the United States, and where an application became abandoned or forfeited, during the time the applicant was serving with the forces of the United States, by reason of his failure to take action or pay a fee within the time now required by law, such action may be taken, or the fee paid, within six months from the passage of this Act.

SEC. 7. That no claim shall be made or action brought in respect of the use since August 1, 1914, up to the passage of this Act, by the Government of the United States, or by any persons acting on behalf of, or under contract with, or with the assent of the Government of the United States or of Governments or their representatives associated with the United States, under any patent rights owned in whole or in part since August 1, 1914, by an alien enemy, nor in respect of the use of any process during such period, or the sale, offering for sale, or use, at any time, of any products, articles, or apparatus whatsoever manufactured during such period to which such patent rights applied.

SEC. 8. That nothing in this Act shall affect any act done by virtue of the special measures taken during the war under legislative, executive, or administrative authority of the United States in regard to the rights of an enemy, or ally

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of an enemy, as defined by the Trading with the Enemy Act of October 6, 1917, in patents for inventions and designs.

Feb. 18, 1922, ch. 58, §§ 3, 5, 6, 7, 8, 9, 42 Stat. 390–393. **T. 35, §§ 12, 13, 24, 31, 32, 41, 153, 261, 283–286, 291.**

See under R. S. 487, 4883, 4898, 4906, 4921, 4934.

Mar. 4, 1925, ch. 535, § 1, 43 Stat. 1268 ..... T. 35, § 254

That whenever a mistake in a patent or a trade-mark registration, incurred through the fault of the Patent Office, is clearly disclosed by the records or files of the office, a certificate, stating the fact and nature of such mistake, signed by the Commissioner of Patents and sealed with the seal of the Patent Office, may be issued, without charge, and recorded in the records of patents or trade-marks, and a printed copy thereof attached to each printed copy of the patent or trade-mark registration, and such certificate shall thereafter be considered as part of the original, and every patent or trade-mark registration, together with such certificate, shall have the same effect and operation in law on the trial of all actions for causes thereafter arising as if the same had been originally issued in such corrected form. All such certificates heretofore issued in accordance with the rules of the Patent Office and the patents or trade-mark registrations to which they are attached shall have the same force and effect as if such certificates had been specifically authorized by statute.

Feb. 7, 1927, ch. 67, 44 Stat. 1058 ..... T. 35, § 287

See under R. S. 4900.

Feb. 14, 1927, ch. 139, §§ 1, 2, 44 Stat. 1098–9 ..... T. 35, §§ 3, 12, 13, 41

See under R. S. 476, 4934.

Mar. 2, 1927, ch. 273, §§ 1, 3, 4, 5, 8, 9, 10, 11, 12, 13, 44 Stat. 1335–37. T. 35, §§ 7, 12, 13, 41, 133–5, 141–3, 146, 267, 291

See under R. S. 4894, 482, 4904, 4909, 4911, 4912, 4913, 4915, 4918, 4934.

Mar. 2, 1927, ch. 273, § 14, 44 Stat. 1337 ..... T. 35, § 21

SEC. 14. That where the day, or the last day, fixed by statute for taking any action or paying any fee in the United States Patent Office falls on Sunday, or on a holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding secular or business day.

Mar. 3, 1927, ch. 364, 44 Stat. 1394 ..... T. 35, §§ 146, 291

That section 52 of the Judicial Code be, and the same is hereby, amended by adding thereto the following:

And upon the filing of a bill in the Supreme Court of the District of Columbia wherein remedy is sought under section 4915 or section 4918 of the Revised Statutes, without seeking other remedy, if it shall appear that there is an adverse party residing in a foreign country, or adverse parties residing in a plurality of districts not embraced within the same State, the court shall have jurisdiction thereof and writs shall, unless the adverse party or parties voluntarily make appearance, be issued against all of the adverse parties with the force and effect and in the manner set forth in this section; provided that writs issued against parties residing in foreign countries pursuant to this section may be served by publication or otherwise as the court shall direct."

Apr. 30, 1928, ch. 460, 45 Stat. 467 ..... T. 35, § 266

See under Mar. 3, 1883, ch. 143, 22 Stat. 625.

May 24, 1928, ch. 730, 45 Stat. 732 ..... T. 35, §§ 251, 252

See under R. S. 4916.

May 31, 1928, ch. 992, §§ 1–4, 45 Stat. 1012–1014 ..... Omitted

That any person who served honorably in the military or naval forces of the United States at any time between April 6, 1917, and November 11, 1918, both dates inclusive, and was subsequently honorably discharged, may within six months after the enactment of this Act, upon payment of a fee of $20, make application to the Commissioner of Patents, comprising a verified statement, accompanied by supporting evidence of the following facts:

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(A) That he is the inventor or discoverer of an invention or discovery for which a specified patent was granted prior to the 11th day of November, 1918, the original term of which remains unexpired at the time of the filing of the application.

(B) That between April 6, 1917, and November 11, 1918, and also at the time of the passage of this Act, he held, by ownership or contract, a right in said invention or under said patent or to income by way of royalty or otherwise therefrom, whereby an extension of the term of said patent would benefit him.

(C) That between April 6, 1917, and July 2, 1921, he was not receiving from said patent an income, or that his income therefrom was reduced by his said service.

(D) That at the time of his induction into the service he was making diligent effort to exploit the invention covered by his patent.

(E) The names of all persons, firms, or corporations, if any, holding at the time of the passage of this Act, by grant, transfer, license, or contract from him, any right or interest in the invention or discovery or under the patent, and their consent to the extension for which application is made, which shall be supported by an instrument, or instruments, executed by all such persons, firms, and corporations, evidencing their consent to such extension.

(F) The period of extension of the patent from the expiration of the original term thereof, for which he applies, which shall in no case exceed a further term of three times the length of his said service in the military or naval forces of the United States between the dates of April 6, 1917, and July 2, 1921, but exclusive of any reenlistment subsequent to November 11, 1918.

(G) That the licensee of a patent affected by this Act shall automatically be granted an extension of said license for the period of the extension on the same terms and conditions as contained in said existing license, thereby creating an equitable adjustment of the benefits of this Act.

(H) That such extension shall in no way impair the right of anyone who before the passage of this Act was bona fide in possession of any rights in patents or applications for patents conflicting with the rights in any patents extended under this Act, nor shall any extension granted under this Act impair the right of anyone who was lawfully manufacturing before the passage of this Act the invention covered by the extended patent.

SEC. 2. In the case of a veteran, as described in paragraph 1 of this Act, who dies, or has died, or who becomes insane or unable to act, which veteran owned an interest as described in this Act in said patent at the time of his death or at the time he was declared mentally incompetent or became unable to act before said extension is granted, such application may be filed or proceeded with by his legal representatives substantially as provided in section 4896 of the Revised Statutes of the United States (United States Code, title 35, section 46), as amended, with respect to proceedings in such cases for obtaining a patent.

SEC. 3. On the filing of such application the Commissioner of Patents shall cause an examination thereof to be made, and if, on such examination, it shall appear that such application conforms, or by amendment or supplement is made to conform, to the requirements of section 1 of this Act, the commissioner shall cause notice of such application to be published at least once in the Official Gazette. Any person who believes that he would be injured by such extension may within forty-five days from such publication oppose the same on the ground that any of the statements of the application for extension required by section 1 of this Act is not true in fact, which said notice of opposition shall be verified before an officer authorized by the laws of any State or Territory or the District of Columbia to administer oaths. In all cases where notice of opposition is filed the Commissioner of Patents shall notify the applicant for extension thereof and set a day of hearing. If after such hearing the Commissioner of Patents is of the opinion that such extension should not be granted, he may deny the application therefor, stating in writing his reasons for such denial. Where an extension is refused the applicant therefor shall have the same remedy by appeal from the decision of the commissioner as is now provided by law where an application for patent is refused. If no opposition to the grant of the extension is filed, or if, after opposition is filed, it shall be decided that the applicant is entitled to the extension asked for, the Commissioner of Patents shall issue a certificate that the term of said patent is extended for the additional period for which application has been made as aforesaid, and shall cause notice of such extension to be published in the Official Gazette and marked upon copies of the patent for sale by the Patent Office, in such manner as the commissioner may determine.

SEC. 4. Thereupon said patent shall have the same force and effect in law as though it had been originally granted for seventeen years plus the term of such

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extension: *Provided, however,* That in any action, at law or in equity, for infringement after the expiration of seventeen years from the grant of the patent and during the period of such extension, the defendant may plead the general issue, and having given notice in writing to the plaintiff or his attorney thirty days before, may prove on trial that any of the statements of the application for extension required by section 1 of this Act is not true in fact; and if any one or more of such statements shall be found untrue in fact, judgment shall be rendered for the defendant, with costs: *Provided further,* That no person whose patent shall be extended under the provisions of this Act shall be permitted to make any claim for damages against the United States for the period of the extension, and the rights of the United States shall remain in all respects as if these patents had not been extended.

Mar. 2, 1929, ch. 488, § 2 (b), 45 Stat. 1475..... T. 35, §§ 141, 145, 146

See under R. S. 4911, 4915.

Apr. 11, 1930, ch. 132, §§ 1, 2, 3, 46 Stat. 155..... T. 35, §§ 3, 7, 12, 13, 41

See under R. S. 476, 482, 4934.

Apr. 11, 1930, ch. 132, § 5, 46 Stat. 156..... Omitted

SEC. 5. The money required for the Patent Office each year, commencing with the fiscal year 1932, shall be appropriated by law out of the revenues of that office, except as otherwise provided by law.

May 23, 1930, ch. 312, §§ 1, 2, 3, 46 Stat. 376 — T. 35, §§ 101, 102, 111, 112, 115, 154, 162, 171

See under R. S. 4884, 4886, 4888, 4892.

May 23, 1930, ch. 312, § 4, 46 Stat. 376..... T. 35, § 163

SEC. 4. The President may by Executive order direct the Secretary of Agriculture (1) to furnish the Commissioner of Patents such available information of the Department of Agrieulture, or (2) to conduct through the appropriate bureau or division of the department such research upon special problems, or (3) to detail to the Commissioner of Patents such officers and employees of the department, as the commissioner may request for the purposes of carrying this Act into effect.

May 23, 1930, ch. 312, § 5, 46 Stat. 376..... Omitted

SEC. 5. Notwithstanding the foregoing provisions of this Act, no variety of plant which has been introduced to the public prior to the approval of this Act shall be subject to patent.

May 23, 1930, ch. 312, § 6, 46 Stat 376..... § 3 of bill

SEC. 6. If any provision of this Act is declared unconstitutional or the application thereof to any person or circumstance is held invalid, the validity of the remainder of the Act and the application thereof to other persons or circumstances shall not be affected thereby.

June 30, 1932, ch. 314, §§ 308, 309, 47 Stat. 410..... T. 35, § 12, 13, 41

See under R. S. 4934.

June 19, 1936, ch. 594, 49 Stat. 1529..... T. 35, § 102, 119, 172

See under R. S. 4887.

May 9, 1938, ch. 188, § 477, 52 Stat. 342..... T. 35, § 33

That it shall be unlawful for any person who has not been duly recognized to practice before the United States Patent Office in accordance with the provisions of Section 487 of the Revised Statutes (U. S. C., title 35, sec. 11) and the rules of the Patent Office to hold himself out or knowingly permit himself to be held out as a patent solicitor, patent agent, or patent attorney, or otherwise in any manner hold himself out, either directly or indirectly, as authorized to represent applicants for patent in their business before the Patent Office, and it shall be unlawful for any person who has, under the authority of section 487 of the Revised Statutes (U. S. C., title 35, sec. 11) been disbarred or excluded from practice before the Patent Office, and has not been reinstated, to hold himself out in any manner whatever as entitled to represent or assist persons in the

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transaction of business before the Patent Office or any division thereof; and any offense against the foregoing provision shall be a misdemeanor and be punished by a fine of not less than $50 and not exceeding $500.

Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212..... T. 35, §§ 101, 102, 119, 171, 172

See under R. S. 4886, 4887, 4920, 4929.

Aug. 5, 1939, ch. 450, § 2, 53 Stat. 1212..... Sec. 4 (d) of bill

SEC. 2. This Act shall take effect one year after its approval and shall apply to all applications for patent filed after it takes effect and to all patents granted on such applications: *Provided, however*, That all applications for patents filed prior to the time this Act takes effect and all patents granted on such applications are to be governed by the statutes in force at the time of approval of this Act as if such statutes had not been amended.

Aug. 5, 1939, ch. 451, §§ 1, 2, 3, 4, 53 Stat. 1212 ..... T. 35, §§ 134, 135, 141, 145, 146

See under R. S. 4904, 4909, 4911, 4915.

Aug. 5, 1939, ch. 452, § 1, 53 Stat. 1213..... T. 35, §§ 132, 135

See under R. S. 4903.

Aug. 7, 1939, ch. 568, 53 Stat. 1264..... T. 35, §§ 133, 267

See under R. S. 4894.

Aug. 9, 1939, ch. 619, §§ 2, 3, 53 Stat. 1293..... T. 35, §§ 12, 13, 41, 151

See under R. S. 4885, 4934.

Aug. 18, 1941, ch. 370, 55 Stat. 634..... T. 35, § 261

See under R. S. 4898.

Aug. 1, 1946, ch. 726, 60 Stat. 778..... T. 35, §§ 283–6, 291

See under R. S. 4921.

July 5, 1946, ch. 541, § 301 (part), 60 Stat. 471..... T. 35, § 41

*Provided*, That hereafter on July 1, 1946, and thereafter 25 cents per copy shall be charged for uncertified copies of specifications and drawings of patents, and 10 cents per copy for design patents and certificates of trade-mark registration.

Aug. 8, 1946, ch. 910, § 9, 60 Stat. 943..... T. 35, § 104

SEC. 9. That in proceedings in the Patent Office and in the courts of the United States an applicant for a patent for an invention, discovery, or a design, or a patentee, shall not be permitted to establish the date of invention or discovery by reference to knowledge or use thereof, or other activity with respect thereto, in a country foreign to the United States, other than the filing in a foreign country of an application for a patent for the same invention, discovery, or design which, in accordance with and subject to the provisions of section 4887 of the Revised Statutes, as amended, or in accordance with and subject to the provisions of this Act, is entitled to have the same force and effect as it would have had if filed in the United States on the date on which it was filed in such foreign country: *Provided*, That where an invention was made by a person, civil or military, during the time such person was domiciled in the United States or its possessions and was serving in a foreign country in connection with the prosecution of the war on behalf of the United States or its allies, the inventor thereof shall be entitled, in interference and other proceedings arising in connection with such invention, to the same rights of priority with respect to such invention as if the same had been made in the United States.

Mar. 4, 1950, ch. 50, 64 Stat. 11..... T. 35, § 7

See under R. S. 482.

June 15, 1950, ch. 249, 64 Stat. 215..... T. 35, §§ 12, 13, 41

See under R. S. 4934.

Oct. 31, 1951, ch. 655, § 53a, 65 Stat. 728..... T. 35, §§ 146, 291

SEC. 53a. (a) Upon the filing of a complaint in the United States District Court for the District of Columbia wherein remedy is sought under section 4915 or

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section 4918 of the Revised Statutes, as amended (35 U. S. C., secs. 63 and 66), without seeking other remedy, if it shall appear that there is an adverse party residing in a foreign country, or adverse parties residing in a plurality of districts not embraced within the same State, the court shall have jurisdiction thereof and process shall, unless the adverse party or parties voluntarily make appearance, be issued against all of the adverse parties and served anywhere within the United States, except that process issued against parties residing in foreign countries pursuant to this section may be served by publication or otherwise as the court may direct.

(b) The provision of subsection (a) of this section shall be deemed to be in effect as of September 1, 1948.

Feb. 1, 1952, ch. 4, §§, 1–9, 11, 12, 66 Stat. 3–6 — T. 35, §§ 181–188

That whenever publication or disclosure by the grant of a patent or an invention in which the Government has a property interest might, in the opinion of the head of the interested Government agency, be detrimental to the national security, the Secretary of Commerce upon being so notified shall order that the invention be kept secret and shall withhold the grant of a patent therefor under the conditions set forth hereinafter.

Whenever the publication or discolsure of an invention by the granting of a patent, in which the Government does not have a property interest, might, in the opinion of the Secretary of Commerce, be detrimental to the national security, he shall make the application for patent in which such invention is disclosed available for inspection to the Atomic Energy Commission, the Secretary of Defense, and the chief officer of any other department or agency of the Government designated by the President as a defense agency of the United States.

Each individual to whom the application is disclosed shall sign a dated acknowledgment thereof, which acknowledgment shall be entered in the file of the application. If, in the opinion of the Atomic Energy Commission, the Secretary of a Defense Department, or the chief officer of another department or agency so designated, the publication or disclosure of the invention by the granting of a patent therefor would be detrimental to the national security, the Atomic Energy Commission, the Secretary of a Defense Department, or such other chief officer shall notify the Secretary of Commerce and the Secretary of Commerce shall order that the invention be kept secret and shall withhold the grant of a patent for such period as the national interest requires, and notify the applicant thereof. Upon proper showing by the head of the department or agency who caused the secrecy order to be issued that the examination of the application might jeopardize the national interest, the Secretary of Commerce shall thereupon maintain the application in a sealed condition and notify the applicant thereof. The owner of an application which has been placed under a secrecy order shall have a right to appeal from the order to the Secretary of Commerce under rules prescribed by him.

An invention shall not be ordered kept secret and the grant of a patent withheld for a period of not more than one year. The Secretary of Commerce shall renew the order at the end thereof, or at the end of any renewal period, for additional periods of one year upon notification by the head of the department or the chief officer of the agency who caused the order to be issued that an affirmative determination has been made that the national interest continues so to require. An order in effect, or issued, during a time when the United States is at war, shall remain in effect for the duration of hostilities and one year following cessation of hostilities. An order in effect, or issued, during a national emergency declared by the President shall remain in effect for the duration of the national emergency and six months thereafter. The Secretary of Commerce may rescind any order upon notification by the heads of the departments and the chief officers of the agencies who caused the order to be issued that the publication or disclosure of the invention is no longer deemed detrimental to the national security.

SEC. 2. The invention disclosed in an application for patent subject to an order made pursuant to section 1 hereof may be held abandoned upon its being established by the Secretary of Commerce that in violation of said order the invention has been published or disclosed or that an application for a patent therefor has been filed in a foreign country by the inventor, his successors, assigns, or legal representatives, or anyone in privity with him or them, without the consent of the Secretary of Commerce. The abandonment shall be held to have occurred as of the time of violation. The consent of the Secretary of Commerce shall not be given without the concurrence of the heads of the departments and the chief officers of the agencies who caused the order to be issued. A holding of abandon-



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ment shall constitute forfeiture by the applicant, his successors, assigns, or legal representatives, or anyone in privity with him or them, of all claims against the United States based upon such invention.

SEC. 3. An applicant, his successors, assigns, or legal representatives, whose patent is withheld as herein provided, shall have the right, beginning at the date the applicant is notified that, except for such order, his application is otherwise in condition for allowance, or the effective date of this Act, whichever is later, and ending six years after a patent is issued thereon, to apply to the head of any department or agency who caused the order to be issued for compensation for the damage caused by the order of secrecy and/or for the use of the invention by the Government, resulting from his disclosure. The right to compensation for use shall begin on the date of the first use of the invention by the Government. The head of the department or agency is authorized, upon the presentation of claim, to enter into an agreement with the applicant, his successors, assigns, or legal representatives, in full settlement for the damage and/or use. This settlement agreement shall be conclusive for all purposes notwithstanding any other provision of law to the contrary. If full settlement of the claim cannot be effected, the head of the department or agency may award and pay to such applicant, his successors, assigns, or legal representatives, a sum not exceeding 75 per centum of the sum which the head of the department or agency considers just compensation for the damage and/or use. A claimant may bring suit against the United States in the Court of Claims or in the District Court of the United States for the district in which such claimant is a resident for an amount which when added to the award shall constitute just compensation for the damage and/or use of the invention by the Government. The owner of any patent issued upon an application that was subject to a secrecy order issued pursuant to section 1 hereof, who did not apply for compensation as above provided, shall have the right, after the date of issuance of such patent, to bring suit in the Court of Claims for just compensation for the damage caused by reason of the order of secrecy and/or use by the Government of the invention resulting from his disclosure. The right to compensation for use shall begin on the date of the first use of the invention by the Government. In a suit under the provisions of this section, and in negotiations concerning settlement of a claim, the United States may avail itself of all defenses it may plead in an action under title 28, United States Code, section 1498, as amended. This section shall not confer a right of action on anyone or his successors, assigns, or legal representatives who, while in the full-time employment or service of the United States, discovered, invented, or developed the invention on which the claim is based.

SEC. 4. Except when authorized by a license obtained from the Secretary of Commerce a person shall not file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States an application for patent or for the registration of a utility model, industrial design, or model in respect of an invention made in this country. A license shall not be granted with respect to an invention subject to an order issued by the Secretary of Commerce pursuant to section 1 hereof without the concurrence of the head of the departments and the chief officers of the agencies who caused the order to be issued. The license may be granted retroactively where an application has been inadvertently filed abroad and the application does not disclose an invention within the categories prescribed under section 1 hereof.

The term "application" when used in this Act includes applications and any modifications, amendments, or supplements thereto, or divisions thereof.

SEC. 5. Notwithstanding any other provisions of law any person, and his successors, assigns, or legal representatives, shall not receive a United States patent for an invention if that person, or his successors, assigns, or legal representatives shall, without procuring the license prescribed in section 4 hereof, have made, or consented to or assisted another's making, application in a foreign country for a patent or for the registration of a utility model, industrial design, or model in respect of the invention. A United States patent issued to such person, his successors, assigns, or legal representatives shall be invalid.

SEC. 6. Whoever, during the period or periods of time an invention has been ordered to be kept secret and the grant of a patent thereon withheld pursuant to section 1 hereof, shall, with knowledge of such order and without due authorization, willfully publish or disclose or authorize or cause to be published or disclosed the invention, or material information with respect thereto, or whoever, in violation of the provisions of section 4 hereof, shall file or cause or authorize to be filed in any foreign country an application for patent or for the registration of a utility

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model, industrial design, or model in respect of any invention made in the United States, shall, upon conviction, be fined nor more than $10,000 or imprisoned for not more than two years, or both.

SEC. 7. The prohibitions and penalties of this Act shall not apply to any officer or agent of the United States acting within the scope of his authority, nor to any person acting upon his written instructions or permission.

SEC. 8. The Atomic Energy Commission, the Secretary of a defense department, the chief officer of any other department or agency of the Government designated by the President as a defense agency of the United States, and the Secretary of Commerce, may separately issue rules and regulations to enable the respective department or agency to carry out the provisions of this Act, and may delegate any power conferred by this Act.

SEC. 9. If any provision of this Act or of any section hereof shall be held invalid, the remainder of the Act shall not be affected thereby.

SEC. 11. Nothing in this Act shall be construed to alter, amend, revoke, repeal, or otherwise affect the provisions of the Atomic Energy Act of 1946 (60 Stat. 755), as amended.

**SEC. 12. This Act may be cited as the "Invention Secrecy Act of 1951".**

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## 2. Comparative Text of Statutes Amended

In compliance with paragraph 2a (2) of rule XIII of the Rules of the House of Representatives, a comparative print of the part of an act to be amended by section 2 of the bill follows. This amendment merely changes references to the old statutes to appropriate references to proposed title 35.

The comparative text of the proposed amendment is set forth below with omissions indicated by brackets and additions by italics.

### Section 2 of the Bill

Amends Act July 5, 1946, ch. 540, § 21, 60 Stat. 435, (15 U. S. C., 1946 ed., § 1071).

**Comparative text.—**

Any applicant for registration of a mark, party to an interference proceeding, party to an opposition proceeding, party to an application to register as a lawful concurrent user, party to a cancelation proceeding, or any registrant who has filed an affidavit as provided in section 8, who is dissatisfied with the decision of the Commissioner may appeal to the United States Court of Customs and Patent Appeals or may proceed under [section 4915, Revised Statutes] *35 United States Code, sections 145 and 146*, as in the case of applicants for patents, under the same conditions, rules, and procedure as are prescribed in the case of patent appeals or proceedings so far as they are applicable: *Provided*, That any party who is satisfied with the decision of the Commissioner shall, upon the filing of an appeal to the Court of Customs and Patent Appeals by any dissatisfied party, have the right to elect to have all further proceedings under [Revised Statutes 4915] *35 United States Code, section 146*, by election as provided in [Revised Statutes 4911] *35 United States Code, section 141*. The Commissioner of Patents shall not be a necessary party to an inter partes proceeding under [Revised Statutes 4915] *35 United States Code, section 146*, but he shall be notified of the filing of the bill by the clerk of the court in which it is filed and the Commissioner shall have the right to intervene in the action.



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# TABLES

## TABLE 1.—REVISED STATUTES AND STATUTES AT LARGE

*Showing where the subject matter of the Revised Statutes and Statutes at Large will be found in revised title 35*

REVISED STATUTES

| R. S. | Revised title 35—section |
|---|---|
| 475 | 1 |
| 476 | 3 |
| 478 | 2 |
| 479 | 5 |
| 480 | 4 |
| 481 | 6 |
| 482 | 7 |
| 483 | 6 |
| 486 | 8 |
| 487 | 31, 32 |
| 488 | 22 |
| 489 | 11 |
| 493 | 41 |
| 494 | 14 |
| 496 | Omitted |
| 4883 | 153 |
| 4884 | 154 |
| 4885 | 151 |
| 4886 | 101, 102, 171 |
| 4887 | 102 (d), 119, 172 |
| 4888 | 111, 112, 162 |
| 4889 | 113 |
| 4890 | 114 |
| 4891 | 114 |
| 4892 | 115 |
| 4893 | 131 |
| 4894 | 133, 267 |
| 4895 | 152 |
| 4896 | 117 |
| 4898 | 261 |
| 4899 | Omitted |
| 4900 | 287 |
| 4901 | 292 |
| 4903 | 132, 135 |
| 4904 | 135 |
| 4905 | 23 |
| 4906 | 24 |
| 4907 | 24 |
| 4908 | 24 |
| 4909 | 134 |
| 4911 | 141 |
| 4912 | 142 |
| 4913 | 143 |
| 4914 | 144 |
| 4915 | 145, 146 |
| 4916 | 251, 252 |
| 4917 | 253 |
| 4918 | 291 |
| 4919 | 281, 284 |
| 4920 | 282 |
| 4921 | 283–6, 290 |
| 4922 | 288 |
| 4923 | 102, 104 |
| 4929 | 171 |
| 4930 | 114 |
| 4931 | 173 |
| 4933 | 171 |
| 4934 | 12, 13, 41 |
| 4935 | 42 |
| 4936 | 42 |

STATUTES AT LARGE

| Date | Chapter | Section | Volume | Page | Revised title 35—section |
|---|---|---|---|---|---|
| 1883—Mar. 3 | 143 | (Part) | 22 | 625 | 260 |
| 1887—Feb. 4 | 105 | 1 | 24 | 387 | 289 |
| | | 2 | 24 | 388 | 289 |
| 1888—Feb. 18 | 15 | | 25 | 40 | 153 |
| 1891—Mar. 3 | 541 | 1 (part) | 26 | 939 | 10 |
| 1896—May 19 | 204 | | 29 | 124 | 21 |
| 1897—Mar. 3 | 391 | 1 | 29 | 692 | 101, 102 |
| | | 2 | 29 | 692 | 282 |
| | | 3 | 29 | 693 | 102 (d), 119 |
| | | 4 | 29 | 693 | 133 |
| | | 5 | 29 | 693 | 261 |
| | | 6 | 29 | 694 | 286 |
| | | 7 | 29 | 694 | Omitted |
| 1898—June 10 | 423 | 1 | 30 | 440 | 9 |
| 1899—Feb. 28 | 227 | | 30 | 915 | 117 |
| 1902—Apr. 11 | 417 | | 32 | 95 | 153 |
| May 9 | 783 | | 32 | 193 | 171 |
| 1903—Mar. 3 | 1019 | 1 | 32 | 1225 | 102 (d), 119 |
| | | 2 | 32 | 1226 | 115 |
| | | 3 | 32 | 1226 | 117 |
| 1908—May 23 | 188 | | 35 | 245 | 117 |
| May 23 | 189 | | 35 | 246 | 151 |
| May 27 | 200 | 1 (part) | 35 | 343 | 41 |
| 1915—Jan. 14 | Pub. Res. 61 | | 38 | 1221 | 12 |
| Mar. 3 | 94 | 1 | 38 | 958 | 111, 112 |
| | | 2 | 38 | 959 | 115 |
| 1916—Feb. 15 | 22 | 1 | 39 | 8 | 3 |
| July 6 | 225 | 1 (part) | 39 | 348 | 133, 267 |
| 1919—Nov. 4 | 93 | 1 (part) | 41 | 335 | 41 |
| 1920—Mar. 6 | 94 | 1 (part) | 41 | 512 | 42 |
| 1921—Mar. 3 | 126 | 1 | 41 | 1313 | Omitted |
| | | 2 | 41 | 1314 | Omitted |
| | | 3 | 41 | 1314 | Omitted |



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STATUTES AT LARGE—Continued

| Date | Chapter | Section | Volume | Page | Revised title 35—section |
|---|---|---|---|---|---|
| 1921—Mar. 3 | | 4 | 41 | 1314 | Omitted |
| | | 5 | 41 | 1314 | Omitted |
| | | 6 | 41 | 1314 | Omitted |
| | | 7 | 41 | 1314 | Omitted |
| | | 8 | 41 | 1314 | Omitted |
| 1922—Feb. 18 | 58 | 3 | 42 | 390 | 31, 32 |
| | | 5 | 42 | 391 | 153 |
| | | 6 | 42 | 391 | 261 |
| | | 7 | 42 | 391 | 24 |
| | | 8 | 42 | 392 | 283–6, 250 |
| | | 9 | 42 | 393 | 12, 13, 41 |
| 1925—Mar. 4 | 535 | 1 | 43 | 1268 | 254 |
| 1927—Feb. 7 | 67 | | 44 | 1058 | 287 |
| Feb. 14 | 139 | 1 | 44 | 1098 | 3 |
| | | 2 | 44 | 1099 | 12, 13, 41 |
| Mar. 2 | 273 | 1 | 44 | 1335 | 133 |
| | | 3 | 44 | 1335 | 7 |
| | | 4 | 44 | 1336 | 135 |
| | | 5 | 44 | 1336 | 134 |
| | | 8 | 44 | 1336 | 141 |
| | | 9 | 44 | 1336 | 142 |
| | | 10 | 44 | 1336 | 143 |
| | | 11 | 44 | 1336 | 145, 146 |
| | | 12 | 44 | 1337 | 291 |
| | | 13 | 44 | 1337 | 41 |
| | | 14 | 44 | 1337 | 21 |
| 1927—Mar. 3 | 364 | | 44 | 1394 | 146, 291 |
| 1928—Apr. 30 | 460 | | 45 | 467 | 266 |
| May 24 | 730 | | 45 | 732 | 251, 252 |
| May 31 | 992 | 1 | 45 | 1012 | Omitted |
| | | 2 | 45 | 1013 | Omitted |
| | | 3 | 45 | 1013 | Omitted |
| | | 4 | 45 | 1014 | Omitted |
| 1929—Mar. 2 | 488 | 2b | 45 | 1476 | 141, 145, 146 |
| 1930—Apr. 11 | 132 | 1 | 46 | 155 | 3 |
| | | 2 | 46 | 155 | 7 |
| | | 3 | 46 | 155 | 12, 13, 41 |
| | | 5 | 46 | 156 | Omitted |
| May 23 | 312 | 1 | 46 | 376 | 101, 102, 154, 161, 163 |
| | | 2 | 46 | 376 | 162 |
| | | 3 | 46 | 376 | 115 |
| | | 4 | 46 | 376 | 164 |
| | | 5 | 46 | 376 | Omitted |
| | | 6 | 46 | 376 | Sec. 3 of Bill |
| 1932—June 30 | 314 | 308 | 47 | 410 | 41 |
| | | 309 | 47 | 410 | 41 |
| 1936—June 19 | 594 | | 49 | 1529 | 102 (d), 119, 172 |
| 1938—May 9 | 188 | | 52 | 342 | 33 |
| 1939—Aug. 5 | 450 | 1 | 53 | 1212 | 102, 119 |
| | | 2 | 53 | 1212 | Sec. 4 (d) of Bill |
| Aug. 5 | 451 | 1 | 53 | 1212 | 135 |
| | | 2 | 53 | 1212 | 134 |
| | | 3 | 53 | 1212 | 141 |
| | | 4 | 53 | 1212 | 145, 146 |
| Aug. 5 | 452 | 1 | 53 | 1213 | 135 |
| 1939—Aug. 7 | 568 | | 53 | 1264 | 133 |
| Aug. 9 | 619 | 2 | 53 | 1293 | 151 |
| | | 3 | 53 | 1293 | 41 |
| 1941—Aug. 18 | 370 | | 55 | 634 | 261 |
| 1946—July 5 | 541 | 301 (part) | 60 | 471 | 41 |
| Aug. 1 | 726 | | 60 | 778 | 283–6, 290 |
| Aug. 8 | 910 | 9 | 60 | 943 | 104 |
| 1950—Mar. 4 | 50 | | 64 | 11 | 7 |
| June 15 | 249 | | 64 | 215 | 13 |
| 1951—Oct. 31 | 655 | 53a | 65 | 728 | 146, 291 |
| 1952—Feb. 1 | 4 | 1 | 66 | 3 | 181 |
| | | 2 | | 4 | 182 |
| | | 3 | | 4 | 183 |
| | | 4 | | 5 | 184 |
| | | 5 | | 5 | 185 |
| | | 6 | | 5 | 186 |
| | | 7 | | 6 | 187 |
| | | 8 | | 6 | 188 |
| | | 9 | | 6 | Sec. 3 of Bill |
| | | 11 | | 6 | Sec. 4 (f) of Bill |
| | | 12 | | 6 | Omitted |

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## TABLE 2.—UNITED STATES CODE

*Showing where sections of the United States Code, 1946 edition, will be found in revised title 35*

| 35 U. S. C. 1946 ed., section | Revised, title 35, section | 35 U. S. C. 1946 ed.. section | Revised, title 35, section | 35 U. S. C. 1946 ed., section | Revised title 35, section |
|---|---|---|---|---|---|
| 1 | 1 | 37 | 133, 267 | 66 | 291 |
| 2 | 3 | 39 | 153 | 67 | 281, 284 |
| 3 | 2 | 40 | 154 | 69 | 282 |
| 4 | 4 | 40a to 40d | Omitted | 70 | 283–6, 290 |
| 5 | 5 | 41 | 151 | 71 | 288 |
| 6 | 6 | 43 | Omitted | 72 | 102, 104 |
| 7 | 7 | 44 | 152 | 72a | 146, 291 |
| 10 | 8 | 45 | 266 | 73 | 171 |
| 11 | 31, 32 | 46 | 117 | 74 | 239 |
| 11a | 33 | 47 | 261 | 75 | 289 |
| 12 | 22 | 48 | Omitted | 76 | 114 |
| 13 | 11 | 49 | 287 | 77 | 173 |
| 14 | 10 | 50 | 292 | 78 | 12, 13, 41 |
| 15 | 12 | 51 | 132, 135 | 79 | 42 |
| 16 | 11 (a) 1 | 52 | 135 | 80–87 | Omitted |
| 19 | Omitted | 53 | 23 | 88 | 251 |
| 20 | 14 | 54 | 24 | 109 | 104 |
| 21 | 21 | 55 | 24 | 151 | 181 |
| 22 | Omitted | 56 | 21 | 152 | 182 |
| 31 | 101, 102, 161 | 56a | 161 | 153 | 183 |
| 32 | 102 (d), 119, 172 | 57 | 134 | 154 | 184 |
| | | 59a | 141 | 155 | 185 |
| 32a | Omitted | 60 | 142 | 156 | 186 |
| 32b | Sec. 3 of bill | 61 | 143 | 157 | 187 |
| 33 | 111, 112, 162 | 62 | 144 | 158 | 188 |
| 34 | 113, 114 | 63 | 145, 146 | 159 | Sec. 4 (f) of bill |
| 35 | 115 | 64 | 251, 252 | | |
| 36 | 131 | 65 | 253 | | |

## TABLE 3.—LAWS OMITTED AND REPEALED

| Revised Statutes or Statutes at Large | Reason for omission and repeal |
|---|---|
| R. S. 496 (35 U. S. C., 1946 ed. § 19) | Superseded, the function of disbursement was transferred to Treasury in 1933 by Executive Order 6166, see notes under 35 U. S. C., 1946 ed., § 19. |
| R. S. 4899 (35 U. S. C., 1946 ed. § 48) | Redundant and unnecessary. |
| Mar. 3, 1897, ch. 391, § 7, 29 Stat. 694 (35 U. S. C., 1946 ed. § 43). | Has no apparent meaning. |
| Mar. 3, 1921, ch. 126, §§ 1–8, 41 Stat. 1313, 1314 (35 U. S. C., 1946 ed. § 80–87). | Obsolete. |
| May 31, 1928, ch. 992, §§ 1–4, 45 Stat. 1012–1014 (35 U. S. C., 1946 ed. § 40a–40d). | Executed and obsolete. |
| Apr. 11, 1930, ch. 132, § 5, 46 Stat. 156 (35 U. S. C., 1946 ed. § 22). | Superseded by act of June 26, 1934, ch. 756, § 6, 48 Stat. 1228 (31 U. S. C., 1946 ed., § 725e). |
| May 23, 1930, ch. 312, § 5, 46 Stat. 376 (35 U. S. C., 1946 ed. § 32a). | Obsolete. |
| Feb. 1, 1952, ch. 4, § 12, 66 Stat. 6 | Obsolete short title. |

## TABLE 4.—LAWS OMITTED BUT NOT REPEALED

*Showing laws omitted from this revision but not included in the schedule of repeals*

The following statutes are not included in the revision, since they are mainly of a temporary nature and will be appropriately codified as may be necessary.

Oct. 31, 1942, ch. 634, 56 Stat. 1013 (35 U. S. C., 1946 ed. §§ 89–97. Royalty Adjustment Act, expires by its terms.

Aug. 8, 1946, ch. 910, 60 Stat. 990 (35 U. S. C., 1946 ed., §§ 101–114). Boykin Act; except section 9 (35 U. S. C., 1946 ed. sec. 109) which is in section 104. The time for taking action under this act has expired.

July 23, 1947, ch. 302, 61 Stat. 413. Extension of Boykin Act.

Aug. 6, 1947, ch. 511, 61 Stat. 794. relating to peace treaties and patents to citizens of Germany and Japan.

June 30, 1950, ch. 444, 64 Stat. 316 (35 U. S. C., 1946 ed., §§ 115–118). Relates to extensions of patents to veterans of World War II, the time for taking action under this act has expired.

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X re Commentary by
Charles J. Zinn

# UNITED STATES CODE
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# COMMENTARY ON NEW TITLE 35, U. S. CODE "PATENTS"

By

CHARLES J. ZINN

On January 1, 1953, new Title 35 of the United States Code, "Patents" will become effective. For the first time in more than eighty years we shall have a complete revision and codification of the laws on that subject.

## HISTORY OF PATENT LAW

In 1870 the Congress enacted a revision of the patent laws that had been prepared for it by a commission to revise all the federal laws appointed by the President pursuant to an act of 1866. The commission had submitted a preliminary draft in 1868, and a second preliminary draft in 1869, relating to both patents and copyrights. The functions of the commission were restricted to a restatement of the then existing laws and its draft was accordingly so limited. However, the proposed restatement was referred to the House of Representatives Committee on Patents, and that committee made a thorough study of it in the light of the many current suggestions for substantive revisions in the law. As a result, the act which was finally approved on July 8, 1870, contained a number of committee amendments constituting substantive changes in the law and embraced the subject of patents, copyrights and trade-marks. Four years later the various sections of the 1870 act were distributed throughout the complete revised statutes enacted on June 22, 1874.

From that time on—a period of phenomenal progress in technological matters—the patent law grew rather haphazardly. Although the statutory law never was, and under the new title will not be, voluminous, the judicial constructions and interpretations of the statutes have been numerous and far-reaching. In some instances the courts have supplied concepts which were not actually spelled out in the statute.

In 1926, at the time of the adoption of the first edition of the United States Code, the then existing patent laws were codified



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and brought up to date as Title 35. Since then all statutory amendments and changes have been carefully reflected in supplements and new editions of the United States Code, which have kept the law current.

A few years ago the House of Representatives former Committee on Revision of the Laws obtained Congressional approval of its proposed program to revise each title of the United States Code. The results to date of their program which has been carried on by the House Committee on the Judiciary since 1947 are well known to most lawyers engaged in federal practice. The revisions of Title 18, Criminal Code and Title 28, Judicial Code, drafted with the active assistance and cooperation of the West Publishing Company and the Edward Thompson Company have been particularly favorably received by the bench and bar. In all, nine of the fifty titles of the United States Code were revised and reenacted through the 81st Congress. During that Congress it was suggested that the patent laws be revised and Title 35 reenacted with such revisions especially in view of the fact that the House Committee on the Judiciary—which had succeeded to the functions of the Committee on Revision of the Laws under the Legislative Reorganization Act of 1946—had jurisdiction of revision of statutes and of legislation relating to patents.

Accordingly, a preliminary draft was prepared and distributed widely during the year 1950. Since this draft was intended principally to elicit suggestions and criticisms from the patent bar and others interested in the subject it contained many proposed changes in substantive law which had been suggested during the past quarter-century.

Numerous comments were received from persons and groups who had studied the preliminary draft, as a result of which the committee decided to eliminate many of the proposed changes in substantive law and defer them for later consideration.

Thereafter, in the 81st Congress, a bill H.R. 9133 was introduced on July 17, 1950 giving effect to the suggestions and criticisms solicited by the distribution of the preliminary draft. This bill was again widely distributed and comments solicited from members of the Patent Bar and others. A coordinating committee which had been formed by the several patent bar associations throughout the United States gave intensive consideration to the bill and thereafter was extremely helpful to the House Committee in coordinating the comments from the Patent Bar and offering valuable suggestions of their own.

Early in the 82nd Congress a bill, H.R. 3760, was introduced. It contained a number of changes in form and substance based



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upon the comments received after the distribution of H.R. 9133. Hearings were held by the House Committee on the Judiciary for three successive days on the new bill. Representatives of numerous governmental and private groups as well as individuals appeared and testified before the committee. Following the hearings the committee gave consideration to this testimony and continued to make improvements in the bill. Finally in May of 1952 the committee reported out a "clean" bill, H.R. 7794, which ultimately became Public Law 593 of the 82nd Congress, approved on July 19, 1952.

## ARRANGEMENT OF THE TITLE

Title 35, Patents, is divided into three basic parts, each consisting of several chapters arranged in logical order. These parts are: I. Patent Office; II. Patentability of Inventions and Grant of Patents; and III. Patents and Protection of Patent Rights. Such an arrangement keeps the overlapping of subject-matter to a minimum.

For the purpose of flexibility and to facilitate the fitting in of later amendments when necessary there is a gap in chapter numbering between the end of each part and the beginning of the next. Similarly, there is a gap in section numbering between the end of each chapter and the beginning of the next.

The statutory patent law is one of the most concise and brief of all branches of federal legislation. In all there are only 17 chapters consisting of a total of 94 sections. By merely scanning the chapter headings within the several parts it is feasible to locate the portion of the title covering the subject matter and containing the section sought with a minimum of research.

## PART I—THE PATENT OFFICE

Part I relates to the organization and operation of the Patent Office. It is divided into four chapters, namely: 1. Establishment, Officers, Functions; 2. Proceedings in the Patent Office; 3. Practice Before the Patent Office; and 4. Patent Fees. These chapters deal with the Patent Office from the aspect of internal operation while Part II deals with it from the aspect of applications for patents.

### Chapter 1. Establishment, etc.

The first chapter, comprising 14 sections, restates the existing law relating to the Patent Office, its officers, and functions, with a number of changes in language for the purpose of simplification, and a few substantive revisions of the existing law.



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The section relating to the establishment of the Patent Office (§ 1), by the inclusion of the last clause takes cognizance of the fact that certain records formerly kept by the office are now preserved in the National Archives. The section does not contain the reference to "models" which was in the former law. Models are no longer generally required although under § 114 the Commissioner may, in a proper case, require the applicant to furnish one. The section and section 6 include for convenience and completeness a reference to the functions of the Patent Office and the Commissioner with respect to trade-mark registration which was not specified in the former law.

There is a new provision in the section relating to officers and employees (§ 3) which authorizes the assistant commissioner to perform the duties of the commissioner during a vacancy in the latter office. The last paragraph of the section is intended to take into account the provisions of Reorganization Plan No. 5 of 1950 (64 Stat. 1263) which vested all functions of the Patent Office in the Secretary of Commerce with the authority to delegate them to others, which he has done. The entire title is subject to that Plan, but for the purpose of clarity and convenience effect has been given in the provisions of the title to that delegation of functions by the commissioner.

The restrictions on officers and employees of the Patent Office with respect to interests in patents during the period for which they hold their appointments is extended for one year thereafter by section 4. It also restricts priority dates in subsequent applications made by them so that no priority date earlier than one year after the period of their appointment can be claimed by them.

The provision relating to the bond of the commissioner and other officers (§ 6) has been changed by the revised title to eliminate specific reference to the bond of the chief clerk and granting the commission the authority to designate the officers required to furnish bonds.

The balance of the chapter contains no important changes in the former law although all sections contain rephrasing and there is some consolidation of former sections.

### Chapter 2. Proceedings in the Patent Office

This chapter, consisting of four sections, contains several consolidations of sections of the former law which are placed in this chapter rather than in a chapter in Part II because they apply also to trade-mark cases in the Patent Office.

In conformity with the growing custom of considering Saturday as a holiday, the provision relating to postponing until the



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next day any action which would normally have been required on a non-business day (§ 21) has been extended to include Saturday as a non-business day.

The old provision dating back to the middle of the 19th century authorizing the Commissioner to require all papers filed in the Patent Office, if not correctly, legibly, and clearly written, to be printed, has been brought up to date by including a provision for their being typewritten (§ 22).

The provision relating to subpoenas and witnesses formerly set out in section 54, 55 and 56 of the old title, have been consolidated and brought up to date in accord with the Federal Rules of Civil Procedure in section 24.

### Chapter 3. Practice Before Patent Office

The three sections comprising chapter 3 contain only one important change in substantive law. The criminal fine for unauthorized representation as a practitioner before the Patent Office (§ 33) has been increased to a maximum of $1000 from the former limit of $100.

The other two sections (§§ 31, 32) are derived from former section 11 with minor changes of phraseology. The breaking up of the former section into two parts relating, first, to promulgation of regulations for agents and attorneys (§ 31) and, secondly, to suspension or exclusion from practice, conforms with better drafting practice favoring shorter sections.

### Chapter 4. Patent Fees

The itemization of patent fees (§ 41) is a slight rearrangement of the schedule contained in the former law. The fee for appeal to the Board of Appeals is set at $25, an increase of $10 over the former fee, and that for a certificate is increased to $10 to correspond with the similar fee in trade-mark cases. Provision of a $10 fee for a certificate of correction of applicant's own mistake is new and is based upon the new provision in section 255 permitting such correction, which corresponds to a similar provision in the trade-mark law.

The provisions of the former law for a fee of 10 cents per hundred words for copies of records made by the Patent Office, and "for copies of drawings, the reasonable cost of making them" are omitted as covered by new subsection (b) which authorizes the Commissioner to establish charges for copies of records, publications, or services furnished by the Patent Office, not specified in subsection (a).

The other section in this chapter (§ 42) contains no substantive change in the former law.



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## PART II. PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS

Part II consists of 8 chapters dealing with patentability (chapter 10), the complete procedure on applications for patents (chapters 11–14), plant patents (chapter 15) and designs (chapter 16), and secrecy of certain inventions (chapter 17). This part contains the substantive and procedural provisions which are so basic in determining the question of patentability and the issue of patents. There are several important changes of substance made in this part with which the practitioner should become familiar.

### Chapter 10. Patentability of Inventions

Of the five sections comprising this chapter, two (§§ 100, 103) are new. The others contain some new matter and several changes in substance.

A section containing definitions (§ 100) is new. In order to avoid repetitious use of the term "invention or discovery" which occurred frequently in the former law the term "invention" is defined in subsection (a) of section 100 as meaning "invention or discovery". Also, the term "process" is defined in subsection (b) as meaning process, art or method, and including a new use of a known process, machine, manufacture, composition of matter, or material. This definition is inserted to take care of the omission of the word "art" from the provision relating to inventions patentable as set out in section 101. It also recognizes that a new use is patentable thereby clarifying the law and practice of the Patent Office on this point.

Section 101 contains that portion of the former patentability section which relates to the subject matter of patents, substituting, however, the word "process" for the word "art" which had been used there in a somewhat different sense from its use, in the term "useful arts", in the Constitution, and in other parts of the patent statute. It should be read in the light of its definition in section 100 (b). The provisions of the former section relating to plants have been transferred to chapter 15.

The former provisions regarding conditions for patentability are set forth without substantial change in section 102. The first three sub-paragraphs are based upon the provisions contained in former section 31. Subparagraph (d) contains a new provision, not contained in former section 32. Under the new provision a person is not barred from obtaining a patent even though he has filed an application for the same patent in a foreign country more than twelve months prior to his application here unless the foreign patent has been granted prior to his application here.



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Sub-paragraph (e) spells out for the first time in the statute the rule announced by the United States Supreme Court in the case of *Alexander Milburn Co.* v. *Davis-Bournonville Co.*, 270 U.S. 390, 46 S.Ct. 324, 70 L.Ed. 651, to the effect that an invention described in a patent dates from the time of the filing of the application for the purpose of anticipating a subsequent inventor.

Subsection (f) requiring that the applicant himself be the inventor of the subject matter sought to be invented conforms to the provisions of section 111 relating to application for patent, as modified by section 117 permitting the application to be made by the legal representatives of deceased or incapacitated inventors, and the new provision contained in section 118 authorizing the filing of an application by another on behalf of the inventor in certain cases.

The provisions relating to the determination of priority of invention contained in subparagraph (g) are unchanged in substance.

Section 103 is a restatement of the rule invalidating patents for lack of invention or lack of patentable novelty which has long been recognized by the courts and other authorities but has not before been spelled out in the statute.

The second sentence of this section providing that patentability shall not be negatived by the manner in which the invention was made eliminates the "flash of genius" concept that has been considered as an essential element of patentability since the *Cuno* case. In that case (Cuno Engineering Corp. v. Automatic Devices Corp., 314 U.S. 84, 62 S.Ct. 37, 86 L.Ed. 58) the Supreme Court held that "the new device, however useful it may be, must reveal the flash of creative genius, not merely the skill of the calling". The patentability of an invention resulting from arduous experimentation will not be negatived solely because it does not meet that concept.

The provisions in section 104 relating to inventions made abroad by persons domiciled in the United States have been broadened to include any such person serving in a foreign country in connection with any operations by or on behalf of the United States and is not limited to such persons engaged solely in connection with the prosecution of the war.

### Chapter 11. Application for Patent

The twelve sections comprising this chapter generally restate the existing law with minor changes but there are two new provisions (§§ 116, 118) relating to filing of applications by persons other than the inventor. In addition, several rules not now spelled out in the statute are made specific.



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The provisions of section 111 relating to the application for a patent are taken from the corresponding portion of former section 33 with the balance of that section relating to specifications being set out in section 112. Section 111 lists the parts of the application clarifying and simplifying the former law.

The provisions of former section 33 relating to specifications are set out in section 112, except that the last sentence relating to plant patents is transferred to section 162. The requirement for disclosing the best mode of carrying out the invention is not limited to machines as it was in the former law. The final paragraph of section 112 relating to functional claims is new. It recognizes the validity of combination claims wherein the novelty is expressed in functional terms. It offsets the theory of the *Halliburton* case but does not go so far as to permit the use of single means claims.

The requirement for furnishing a drawing when the nature of the case admits is unchanged in section 113, subject to Patent Office regulations.

Section 114 restates the former law relating to furnishing models. The provision regarding specimens is broadened to authorize them being required for purpose of inspection as well as experiment.

The requirement regarding the oath of the applicant contained in section 115 is generally unchanged in substance. The provision that an oath made outside the District of Columbia is valid if it complies with the laws of the state or country where made, is new. Also there is a final sentence added in view of the provisions in sections 116 and 118 authorizing an application by a person other than the inventor, which permits variation in the form of the oath in such cases.

The first paragraph of section 116 expresses for the first time the general requirement, which was implicit in the former law, that joint inventors must all sign the application and make the required oath. The second paragraph is entirely new. It authorizes the making of an application by one inventor where his co-inventor refuses to join in the application or can not be found. The facts must be proved by the applicant and the grant of the patent will protect the rights of the omitted inventor. Provision is also made, in the final paragraph, for amending an application for the purpose of deleting the name of a person joined through error, or adding the name of a joint inventor who had been omitted through error.

The procedure for accomplishing the amendment provided for in section 116 is set out in section 256 under chapter 25—Amendment and Correction of Patents. The section is a realistic treat-



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ment of the many problems arising in the cases of joint inventions.

Section 117, relating to making of applications in the case of death or incapacity of an inventor is a good example of the simplification of language and the elimination of superfluous verbiage accomplished by the revision. It states in 32 words, without substantive change, what the former law required more than 200 words to state.

Under the new provisions contained in section 118, when the inventor can not be found or refuses to execute the application for a patent, a person having the required proprietary interest may make the application on behalf of the inventor under conditions fully safeguarding the rights of the inventor. There is no comparable provision in the former law.

The first paragraph of section 119 restates the former law with regard to obtaining the benefit of an earlier filing date in a foreign country. The existing practice and requirements of the International Convention for the Protection of Industrial Property relating to foreign applications by the legal representatives or assigns of the applicant here are recognized by the opening clause. The references to designs in the former law are omitted as covered by section 172 in chapter 16—Designs. Minor changes in phraseology have also been made.

The second paragraph of section 119 is new and requires the filing in the Patent Office of a certified copy of the foreign application. Such a provision is consistent with the provisions of the patent laws of many foreign countries and will result in the establishment of a complete and useful record in the Patent Office.

The provisions set out in section 120 giving the applicant the benefit of the date of an earlier application by him for the same invention constitute a restatement of the former practice which was not, however, spelled out in the former law. The requirement in the last clause that the earlier application be specifically referred to in the later application is new but it is logical and reasonable.

Another codification of existing practice not spelled out in the former law is the provision for divisional applications set out in section 121. The Commissioner is given the discretion of requiring a division. The use of either the original or the division as a reference against the other is specifically forbidden and Section 120 is extended to cover such applications.

The ancient Patent Office practice relating to secrecy of applications receives legislative acknowledgment for the first time in section 122.



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## Chapter 12. Examination of Application

Chapter 12, consists of five sections (§§ 131–135) relating to examinations of applications by the Patent Office and makes little change in the former law. It covers examination, rejection and reexamination, abandonment of application, appeals to the Board of Appeals, and interferences. Only in the last section, relating to interferences, is there any substantial change or innovation.

Section 131, providing for the examination is a simplification of the language of the former law plus a specific reference to the examination of the application as well as the invention. The clause in the former law "that the same [invention] is sufficiently useful and important" is omitted as covered by the requirements for patentability set out in sections 101–103.

The provisions for notice of rejection or reexamination contained in section 132 restate the former law with slight amplification to give statutory recognition of the present practice. The final sentence which provides that no amendment shall introduce new matter into the disclosure of the invention is new to the statute but also represents existing practice.

Section 133, providing for the time for prosecuting the application for the patent contains minor changes in phraseology of the existing law but no change of substance, except that the opening clause of the former law which provided that all applications for patents shall be completed and prepared for examination within one year has been omitted as having no meaning at the present time.

The authorization for appeal to the Board of Appeals contained in section 134 is largely a restatement of the existing law with minor changes in phraseology. The reference in the former law relating to reissues has been eliminated because of the overall provisions of section 251 in Chapter 25 relating to reissue of defective patents.

Section 135 relating to interferences, restates the former law with minor changes in phraseology and adds several new provisions. The provision in the second sentence that the adverse decision of the board on the question of priority constitutes a final refusal by the Patent Office of the claims involved is new. Also, the last sentence in the first paragraph which provides for the automatic cancellation of the claims involved is new in the statute. This section must be read in connection with section 141 which authorizes an appeal to the Court of Customs and Patent Appeals and section 146 which provides for a right of review by civil action in case of interference.



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## Chapter 13. Review of Patent Office Decision

This chapter dealing with the review of Patent Office decisions by the Court of Customs and Patent Appeals and by civil actions in the federal courts consists of six sections (141–146) which restate the existing law with few changes in substance. The authorization for appeal to the Court of Customs and Patent Appeals set out in section 141 is a restatement of the former law with only changes in phraseology.

Likewise section 142 containing the provision with respect to notice of appeals are substantially the same as the former law with only minor changes in language.

Section 143 dealing with proceedings on appeal in addition to changes in phraseology makes a change in the former law by transferring from the Commissioner to the Court the obligation of giving notice to the parties of the time and place of the hearing. The section also contains a new requirement that any additional papers and evidence specified by the appellee must be filed with the Court.

Section 144 relating to decisions on appeal is substantially the same as the former law except that it omits a provision of the former law that no opinion or the decision of the Court in any such case would preclude any person interested from the right to contest the validity of such proceeding in any court wherein the same may be called in question. That provision is considered unnecessary.

In section 145 relating to civil actions to obtain a patent, the law is brought up to date by specifically changing the references to bills in equity which are obsolete. The time for filing the action is made to conform to the time for taking an appeal to the Court of Customs and Patent Appeals. In addition to changes in phraseology, the requirement of the former law for filing a copy of the decision in the Patent Office is deleted.

The provisions relating to civil actions in case of interference set out in section 146 contain several changes in the existing law. For example, a patentee—as well as an applicant—may now bring the action. Also, the time for bringing the action is changed to conform to the time for taking an appeal to the Court of Customs and Patent Appeals as in section 145. Similarly, the provisions that suits may be instituted against the party in interest as shown by the records of the Patent Office at the time of the decision complained of, and that any party in interest may become a party to the action, are new. These provisions will overcome the difficulties stemming from assignees that are



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unrecorded. There is also a new provision that the Commissioner is not a necessary party but shall have the right to intervene.

### Chapter 14. Issue of Patent

The chapter relating to the issue of the patent and the time and manner of issue consists of four sections (§§ 151–154) with comparatively minor changes.

In section 151 the provisions of the former law regarding the time of issue of the patent are restated with only minor changes in phraseology.

The provisions relating to the issue of the patent to the assignee of the inventor, contained in section 152, are substantially the same as the former law on the subject except that the reference to reissue is omitted in view of the general provisions covering reissue contained in section 251 in chapter 25.

Section 153 sets out the provisions of the former law covering the manner of issue except that the clause regarding attesting officers is no longer limited to an assistant commissioner or law examiner but extends to any officer of the Patent Office designated by the Commissioner.

In section 154 several changes have been made in the section regarding the contents and term of the patent. The former law provided for "a grant * * * of the exclusive right to make, use, and vend" the patent. This section, in keeping with the language of the Supreme Court, specifically grants the right "to exclude others from making, using, or selling the invention". A reference to plants in the former law has been transferred to section 163 in chapter 15. Also the provisions for details of the short title have been eliminated as unnecessary. Other changes have been made in phraseology.

### Chapter 15. Plant Patents

A new chapter relating specifically to plant patents, consisting of four sections (§§ 161–164) gathers together and separates these provisions from the general provisions for convenience and clarity.

Section 161 contains the plant portions of the former law which otherwise is now set out in sections 101 and 102 in chapter 10.

The first paragraph of section 162 is a restatement of the former law incorporated by reference to section 112 in chapter 10. The second paragraph is a statutory restatement of the actual practice which was not specifically provided for in the former law.



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The provision regarding the grant of patents for plants set out in section 163 conforms to the inclusion of the right to exclude others as provided in section 154 in chapter 14.

Section 164, providing for the assistance of the Department of Agriculture respecting patents for plants is a restatement of the former law with change in phraseology.

### Chapter 16. Designs

As in the case of patents for plants the new title contains this separate chapter consisting of three sections (§§ 171–173), correlating the provisions relating to patents for designs.

Section 171 which provides for the obtaining of a patent for a design omits the detailed conditions set out in the former law and incorporated by reference the conditions applicable to all patents, as provided in chapter 10.

The provisions relating to right of priority contained in section 172 incorporate by reference the general provisions contained in chapter 11 with the exception that the time limitation of six months contained in the former law, in the case of design patents, is unchanged.

Only minor changes in phraseology have been made in section 173 relating to the term of patents for designs.

### Chapter 17. Secrecy of Certain Inventions and Filing Applications in Foreign Country

The Secrecy of Invention Act of 1951 is set out in chapter 17 consisting of eight sections (§§ 181–188) with no changes in substantive law but merely changes in phraseology.

Section 181 contains the conditions permitting the Commissioner to keep secret certain inventions in which the Government has an interest and where publication might be detrimental to the natural interest.

Section 182 provides for the penalty of holding an invention to have been abandoned if published or disclosed or filed in a foreign country in violation of a secrecy order provided for in section 181.

Section 183 authorizes the payment of compensation to the owner of an application under a secrecy order.

Section 184 prohibits the filing in a foreign country of an application for patent prior to six months after filing an application in the United States except under a license obtained from the Commissioner of Patents.

Section 185 provides that a person who files a foreign application without license shall not receive a patent.



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Section 186 imposes a penalty of a fine of $10,000 or imprisonment for not more than two years, or both, for violation of the provisions of the chapter.

Section 187 provides that the prohibitions and penalties shall not apply to officers or agents of the United States acting within the scope of their authority.

Section 188 authorizes the Atomic Energy Commission and officers separately to issue rules and regulations to administer the chapter.

## PART III—PATENTS AND PROTECTION OF PATENT RIGHTS

Part III of the new title consisting of five chapters (chapters 25–29) deals with a number of matters relating to the patent itself after it has been granted, such as amendments and reissues, ownership and assignment, government interests, and infringement and remedies for infringement. It sets out most of the most important features of the patent law and contains some changes in the former law.

### Chapter 25. Amendment and Correction of Patents

The chapter dealing with amendment, reissue, and correction of patents consists of six sections (§§ 251–256) in which a number of substantive changes in the former law are made, and two of which (§§ 255, 256) are entirely new.

Section 251, providing for the reissue of defective patents, and section 252, dealing with the effect of reissue, are derived from one section of the former law, with several changes and additions. The reissue practice is liberalized by section 251 providing specifically for broadened reissues and a consequent two year period of limitation during which applications may be made for a broadened reissue, codifying the present rule of decision with a fixed period. A provision in the former law relating to models and drawings has been omitted as obsolete. Authorization for applications by an assignee for reissue in certain cases is new. The first paragraph of section 252 is a restatement of that portion of the former law with changes in phraseology. The second paragraph is new and contains provisions for the protection of intervening rights arising before the grant of reissue. Further, the court is authorized to protect legitimate activities which would not infringe any claim of the original patent which is included in the reissue. Thus the question of intervening rights may be determined by reference to the reissue alone.

Section 253 relating to disclaimers contains several substantive changes and new provisions. Under this section only disclaimer



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of a claim as a whole may be made—eliminating disclaimers of part of a claim. The provision of the former law that "no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer" is omitted. This changes the former law whereby the courts have held that the entire patent may be void if a prompt disclaimer has not been entered. This change is the basis of the provision in section 288 in chapter 29 which provides that an action for infringement for valid claims may be maintained even though there are invalid claims, the only penalty being that the patentee may recover no costs. The second paragraph of section 253 is new and authorizes the disclaiming of the entire or any terminal part of the term of a patent.

The provisions relating to the issuing of a certificate of correction of a mistake of the Patent Office, contained in section 254, and is largely a restatement of the former law with the omission of an obsolete provision covering certificates issued prior to March 4, 1925, and the addition of a provision comparable to the trade-mark law (15 U.S.C.A. 1057) authorizing the issue of a corrected patent in lieu of a certificate of correction.

Section 255 authorizing the issuing of a certificate of correction of the applicant's own mistakes is new and conforms to a similar provision in the trade-mark law (15 U.S.C.A. 1057).

Section 256 is also new and provides for the deletion or addition of a misjoined or nonjoined inventor in the case of an issued patent. It also provides that misjoinder or nonjoinder shall not invalidate the patent. This is an extension of the principle permitting correction of the application in this regard.

### Chapter 26. Ownership and Assignment

This chapter, consisting of only two sections (§§ 261, 262) restates the former statutory law relating to ownership and contains some new provisions which are declaratory of the existing law, and a new provision regarding joint owners.

Section 261 contains in the first paragraph a new statutory declaration that patents have the attributes of personal property. The second paragraph contains only minor changes in phrascology. The third paragraph omits a reference to section 131 of Title 22, but otherwise does not alter the former law with only minor changes in phraseology.

Section 262 is new and authorizes a joint owner, in the absence of an agreement to the contrary, to make, use, and sell the patented invention without the consent of and without accounting to the other owners.



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### Chapter 27. Government Interests in Patents

The provisions of the former law regarding government interests in patents is restated with minor changes in this chapter consisting of two sections (§§ 266, 267).

Section 266 authorizing the issue of patents without fees to Government employees, in certain cases, is extended to include design patents.

Section 267 contains, with changes in phraseology only, the provisions of the former law relating to the time for taking action on Government applications.

### Chapter 28. Infringement of Patents

This chapter consisting of two sections (§§ 271, 272) is altogether new to the patent statute. The former law contained no provisions declaratory of what constitutes infringement.

Section 271 is divided into four lettered paragraphs. Paragraph (a) contains the elements of direct infringement. Paragraph (b) provides that whoever induces infringement is liable as an infringer. Paragraph (c) takes up for the first time in a statute the knotty problem of contributory infringement. This subject, as covered by judicial decisions and opinions has been a highly controversial one and was discussed in detail at the hearings on the codification. This subsection which defines contributory infringement and specifically excludes therefrom staple articles or commodities of commerce suitable for substantial noninfringing use, should do much to stabilize the law. Paragraph (d) gives statutory recognition to certain lawful exercises of the patent right that have been curtailed or condemned in judicial decisions.

Section 272 is also new to the statute but merely restates the provision of article 5 of the International Convention for the Protection of Industrial Property, of which the United States is a party, and incorporates the judicial doctrine that use of a patented invention aboard a foreign vessel does not constitute infringement of the patent.

### Chapter 29. Remedies for Infringement of Patent, and Other Actions

This chapter dealing with judicial remedies, consisting of thirteen sections (§§ 281–293), is based largely upon nine sections of the former law with changes in phraseology and several new provisions.



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Section 281 is a brief declaration that a patentee shall have remedy by civil action for infringement of his patent, and substitutes the term "civil action" for the obsolete expression "action on the case".

The existing judicial presumption of validity of patents is expressed in the statute for the first time in section 282, which also sets out the defenses in an action involving the validity or infringement of a patent. The former law stated five specific defenses which are here rephrased in general terms without material change. The final paragraph of the section restates the provision requiring notice of the references to be relied upon and includes a reference to the state of the art. This is intended to avoid surprise at the trial.

The provisions regarding injunctions are restated in section 283 with only minor changes in phraseology.

Section 284, relating to damages, is a consolidation of the provisions of two sections in the former law with changes in phraseology.

Section 285 deals with attorneys fees and substitutes the expression "in exceptional cases" for the phrase "in its discretion" of the former law.

The first paragraph of section 286 relating to the statute of limitations on damages is substantially the same as the former law but adds a provision relating to counterclaims which was not expressed in the former statute. The second paragraph is new to the statute. It extends the period of limitations with respect to suits against the Government in the Court of Claims in certain instances when administrative consideration is pending.

Section 287, containing the provisions for marking patented articles for the purposes of notice to the public. A new provision is added regarding the recovery of damages in the case of unmarked patented articles after notice to the infringer. The filing of an action for infringement constitutes such notice.

Section 288, dealing with actions for infringement of a patent containing an invalid claim is a corallary of section 253 in chapter 25. Under this section recovery on valid claims is authorized even though there has been no disclaimer of invalid claims.

Section 289 consolidates with changes in phraseology the provisions of two sections of the former law regarding remedies for infringement of design patents.

The provision regarding giving notice to the Commissioner of suits pending under this title, contained in section 290, is a continuation of the former law with changes in phraseology.



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Similarly, section 291 containing the provisions for relief against interfering patents, is the same as the former law with simplification of language.

The penalties for false marking, set out in section 292, are changed by substituting a fine of "not more than $500" in lieu of the former fine of "not less than $100". Also a new provision is added relating to the marking of "patent applied for", with false advertising being included in all the offenses. Subsection (b) sets out separately the right to sue for the penalty in an "informer" action.

Section 293 is a new provision in the statute authorizing a patentee residing outside the United States to designate a domestic representative to accept service of process in proceedings affecting the patent, similar to the procedure in trade-mark cases. It also provides for service by publication in the absence of such a designation or if the person designated can not be found.

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X re HR 7794

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# Public Laws Of The 82nd Congress

## (Second Session)

The 339 public laws enacted by the second session of the 82nd Congress are listed below in numerical order and described briefly. Second session laws are numbered 256 through 594. (For numerical list and description of the 255 first session laws, see CQ Almanac, Vol. VII, p. 8.)

For a complete listing of all public business transacted during the second session, see the breakdown of Bills Acted On at the end of each category — Agriculture, Appropriations, etc. These category listings carry public laws, public business transacted through simple or concurrent resolutions, which by their nature do not become law, and public bills which received partial action but were not completed to law.

A complete listing, by category, of public bills introduced will be found beginning on page 380.

**Public Law 256 (HR 4687)** — Provide for withholding of a patent when the publication or disclosure of an invention by the granting of a patent might be detrimental to the national security.

**Public Law 257 (HR 4948)** — Suspend import duties on lead until March 31, 1953 or end of national emergency, unless the N.Y. delivered price of lead falls below 18 cents a pound for any one calendar month during that period.

**Public Law 258 (HR 5448)** — Suspend import duties on zinc until March 31, 1953 or end of national emergency, unless the E. St. Louis delivered price of Prime Western zinc falls below 18 cents a pound for any one calendar month during that period.

**Public Law 259 (S 2169)** — Authorize Secretary of the Interior to acquire the Gila Pueblo, near Globe, Arizona, for archeological labratory and storage purposes.

**Public Law 260 (S 493)** — Amend District of Columbia dangerous weapons law to provide for seizure and destruction of such articles.

**Public Law 261 (H J Res 314)** — Designate September 17 of each year as "Citizenship Day".

**Public Law 262 (S 759)** — Provide that postal screen vehicle contractors shall have the same benefits as star-route contractors with respect to contract renewal and adjustment of contract pay.

**Public Law 263 (HR 6273)** — Amend the act incorporating Trinity College of Washington, D.C., pursuant to incorporation laws of the District of Columbia.

**Public Law 264 (HR 3981)** — Amend the act authorizing the Secretary of Agriculture to adjust titles to lands acquired by the U.S. and subject to his jurisdiction, to permit a 20-year period for correction of errors in titles.

**Public Law 265 (HR 4419)** — Amend District of Columbia Teachers' Salary Act to permit employment of not more than 15 retired members of the U.S. armed services as teachers of military science at regular compensation in addition to retired pay and allowances.

**Public Law 266 (HR 5235)** — Authorize District of Columbia Commissioners to make studies and investigations concerning the location and construction of a bridge over the Potomac River between Virginia and the District of Columbia.

**Public Law 267 (HR 4749)** — Authorize Secretary of Agriculture to return to the Police Jury of Caddo Parish, La., certain lands formerly used in pecan production research.

**Public Law 268 (S 1244)** — Amend the Federal Civil Defense Act to exempt Alaska from certain limitations on federal contributions, and to provide for administering of oaths by certain civil defense officers.

**Public Law 269 (HR 2398)** — Amend the Vermejo reclamation project act to delete references to taxation of personal property for repayment of reimbursable costs and limit such taxation to real property in accordance with New Mexico law.

**Public Law 270 (HR 3100)** — Amend the law providing for reservation of lands for educational purposes in Alaska, to prevent location of mining claims on such lands.

**Public Law 271 (HR 4703)** — Provide that the Board of Education of the District of Columbia shall have sole authority to regulate vacations and annual leave periods of school officers and employees.

**Public Law 272 (HR 5256)** — Provide for reciprocity between the District of Columbia and the several states having reciprocal laws to secure attendance of witnesses in criminal proceedings.

**Public Law 273 (HR 5097)** — Extend to Dec. 31, 1954, the time during which the Secretary of the Interior may enter into amendatory repayment contracts under federal reclamation laws.

**Public Law 274 (HR 3860)** — Amend the District of Columbia public school teachers retirement act.

**Public Law 275 (S 1710)** — Authorize the Secretary of the Army to convey certain road rights - of - way in De Kalb and Putnam Counties, Tenn., to the State of Tennessee.

**Public Law 276 (S 1411)** Authorize the Postmaster General to issue duplicate checks without bond when checks of the Post Office Department are lost while in custody of the U. S.

**Public Law 277 (S 2078)** — Authorize establishment of postal stations and branch post offices at military and defense installations.

**Public Law 278 (S 2458)** — Correct an error in P.L. 204, 82nd Congress, relating to assistant superintendents in motor vehicle service of the Post Office Department.

**Public Law 279 (S 2394)** — Repeal the 10 per cent surcharge on postal cards sold in quantities of 50 or more.

**Public Law 280 (S 664)** — Amend the District of Columbia Corporation Act to permit charitable, educational, and religious corporations to purchase stocks in other corporations.

**Public Law 281 (S1345)** — Amend the District of Columbia Code to abolish the one per cent fee to the clerk of the U.S. District Court for handling money or securities required by the court to be deposited.

**Public Law 282 (H J Res 396)** — Provide additional appropriations of $52,000 for the Motor Carrier Claims Commission, and $815,000 for Congress for the fiscal year 1952.

**Public Law 283 (S 1851)** Strengthen laws preventing aliens from entering or remaining in the U. S. illegally.

**Public Law 284 (HR 4515)** — Authorize the acquisition by exchange of certain properties within Death Valley National Monument, California.

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**Public Law 586 (S 241)** — Amend the Merchant Marine Act of 1936 to allow operators the advantage of construction - differential subsidy as well as operating subsidy, to reduce the obsolescence age of vessels, provide special guarantees for purchasers of passenger - type vessels, provide special tax benefits, and otherwise encourage the development of an American merchant fleet.

**Public Law 587 (S 1999)** — Provide for withholding of tax, for state income tax purposes, on compensation of federal employees.

**Public Law 588 (HR 1758)** — Extend the District of Columbia unlawful entry statute to public as well as private buildings, and otherwise broaden its terms.

**Public Law 589 (HR 7255)** — Amend the Internal Revenue Code relating to employee stock purchase plans.

**Public Law 590 (HR 7800)** — Amend the Social Seucirty Act to increase old-age and survivors benefits, permit earning of $75 a month without loss of retirement benefits, authorize wage credits for military service, and remedy defects in benefit computation provisions.

**Public Law 591 (S 3333)** — Authorize purchase, for the Missouri River Basin project, of certain lands and interests in lands of the Shoshone and Arapaho Indian Tribes of the Wind River Reservation.

**Public Law 592 (HR 7502)** — Amend law providing for the National Capital Park and Planning Commission.

**Public Law 593 (HR 7794)** — Revise and codify the laws relating to patents, and enact into law title 35 of the United States Code entitled "Patents."

**Public Law 594 (HR 8271)** — Amend the Excess Profits Tax Act of 1950 to provide an adjustment in base period earnings credit of companies making earnings - deposits under the Merchant Marine Act.

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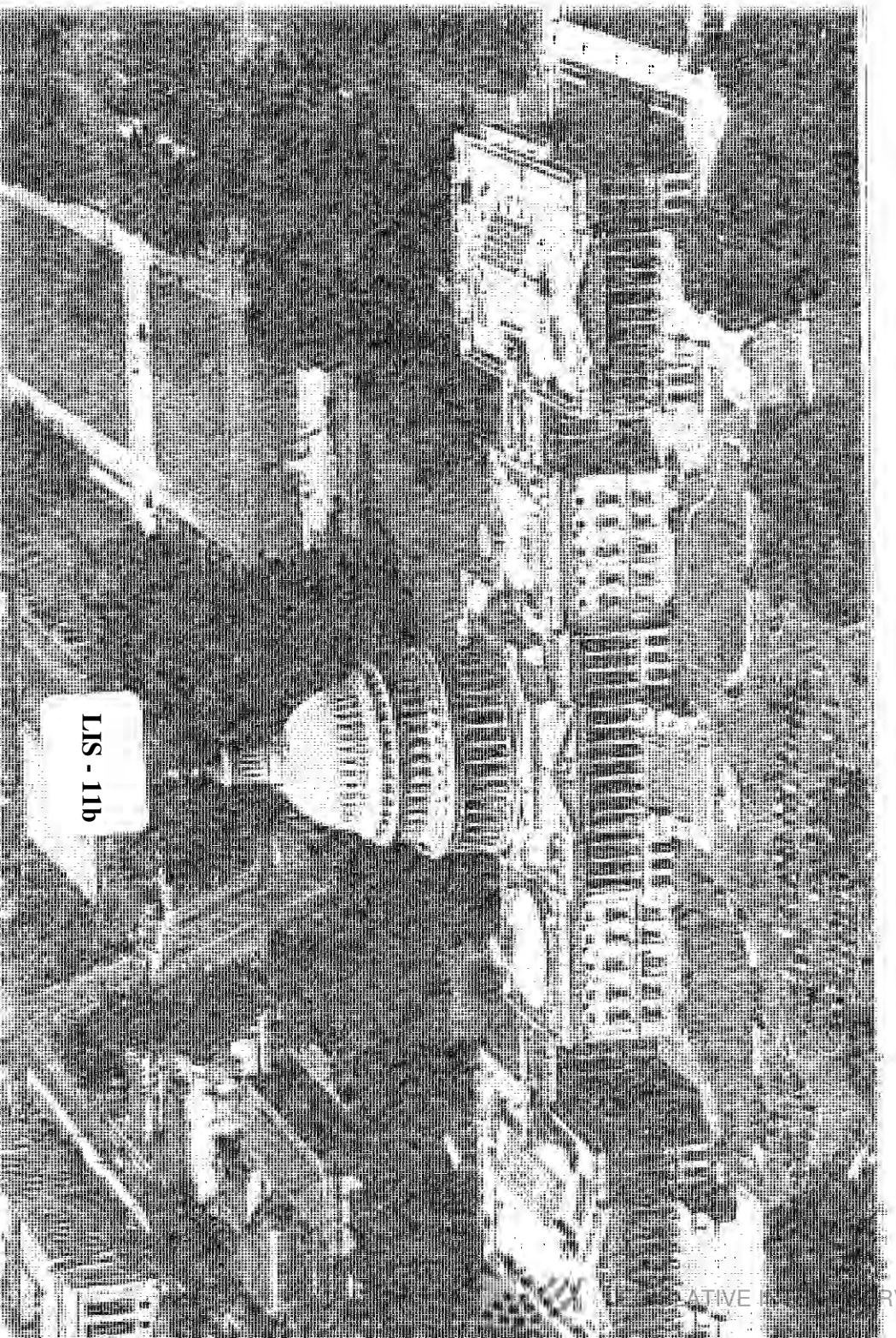
# BRYSON, Joseph Raleigh, (1893 - 1953)



*Collection of the U.S. House of Representatives*

**BRYSON, Joseph Raleigh,** a Representative from South Carolina; born in Brevard, Transylvania County, N.C., January 18, 1893; moved, with his parents, to Greenville, Greenville County, S.C., in 1900; attended the public schools; was graduated from Furman University, Greenville, S.C., in 1917 and from the law department of the University of South Carolina at Columbia in 1920; enlisted on September 28, 1915, as a private in Company A, First Infantry, South Carolina National Guard, and served until discharged on August 9, 1916; reenlisted on August 3, 1917, in the Medical Reserve Corps, being discharged as a second lieutenant of Infantry on December 12, 1918; was admitted to the bar in 1920 and commenced practice in Greenville, S.C.; member of the State house of representatives 1921-1924; served in the State senate 1929–1932; elected as a Democrat to the Seventy-sixth and to the seven succeeding Congresses, and served from January 3, 1939, until his death in the naval hospital at Bethesda, Md., March 10, 1953; interment in Woodlawn Memorial Park, Greenville, S.C.

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LIS - 11b

82D CONGRESS, 2D SESSION

BEGINNING JANUARY 8, 1952

OFFICIAL

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X re Representative Bryson

SECOND DISTRICT.—COUNTIES: Kent and Washington. PROVIDENCE COUNTY: City of Providence, representative districts, 8 to 25; city of Cranston; towns of Burrillville, Foster, Gloucester, Johnson, North Providence, North Smithfield, Scituate, and Smithfield. Population (1950), 413,663.

JOHN EDWARD FOGARTY, Democrat, of Harmony, R. I.; born in Providence, R. I., March 23, 1913; attended La Salle Academy, Providence College; June 1946, awarded honorary degree (Doctor of Political Science) by Providence College; married; member, Knights of Columbus, Elks, Eagles, president of the Bricklayers Union No. 1 of Rhode Island; member, Smithfield Sportsmen's Club; elected to the Seventy-seventh Congress on November 5, 1940; reelected to Seventy-eighth, Seventy-ninth, Eightieth, Eighty-first, and Eighty-second Congresses.

## SOUTH CAROLINA

(Population (1950), 2,117,027)

### SENATORS

BURNET RHETT MAYBANK, Democrat, born in Charleston, S. C., March 7, 1899; graduate of Porter Military Academy and College of Charleston; veteran, World War I; married Elizabeth deRosset Myers in 1923 (died 1947); married Mrs. Mary Cecil, 1948; children, Burnet, Junior; Mrs. George D. Paul, and Elizabeth; Episcopalian; cotton exporter, alderman, city of Charleston, 1927–30; mayor of Charleston, 1931–38; chairman, South Carolina Public Service Authority, 1934–38; Governor of South Carolina, 1939–41; delegate of all Democratic city, county, State, and national conventions since 1930; national committeeman; was appointed by President Roosevelt on the Public Works Administration and by President Truman as a member of the American Battle Monuments Commission; elected to finish unexpired term of Honorable James F. Byrnes, 1941; reelected in 1942; reelected in 1948.

OLIN D. JOHNSTON, Democrat, of Spartanburg, S. C.; born near Honea Path, Anderson County, S. C., November 18, 1896; father and mother were E. A. and Lelia (Webb) Johnston, of Anderson, S. C.; married Miss Gladys E. Atkinson, of Spartanburg, S. C., on December 27, 1924; Baptist denomination; was graduated from Spartanburg Junior College in 1915, from Wofford College with A. B. degree in 1921, and from the University of South Carolina with M. A. degree in 1923 and LL. B. degree in 1924; during the First World War served as sergeant, Company C, One Hundred and Seventeenth Engineers, Forty-second Division, serving 18 months overseas; received regimental citation; moved from Anderson to Spartanburg, S. C., in 1924; lawyer, firm of Johnston & Williams; successful lawyer in all courts, both State and Federal; member of the State house of representatives from Anderson County 1923–24 and from Spartanburg County 1927–30; Democratic national executive committeeman 1935–40 and 1944–48; candidate for Governor in 1930, leading field of eight candidates by 15,000 majority in first primary and in second primary missed nomination by less than a thousand votes; in 1934 led field of eight candidates by approximately 20,000 votes in first primary and in second primary defeated opponent by almost 35,000 majority; elected Governor for a second 4-year term in 1942; member of the American Legion, Forty and Eight, Veterans of Foreign Wars, and Disabled American Veterans; member of the Baptist Church and for many years interested in work of Baptist Young People; thirty-second degree Mason, Shriner, Optimist, member of Jr. O. U. A. M., Red Men, Woodmen of the World, Knights of Pythias, and B. P. O. Elks; elected to the United States Senate on November 7, 1944, for the term ending January 3, 1951; reelected on November 7, 1950, for the term ending January 3, 1957.

### REPRESENTATIVES

FIRST DISTRICT.—COUNTIES: Allendale, Beaufort, Berkeley, Charleston, Clarendon, Colleton, Dorchester, Hampton, and Jasper (8 counties). Population (1950), 341,940.

L. MENDEL RIVERS, Democrat, of Charleston, S. C., born in Gumville, Berkeley County, S. C., September 28, 1905; educated in public schools, College of Charleston, and University of South Carolina; admitted to South Carolina bar in 1932; served in the South Carolina Legislature, 1933–36; 1936 to 1940, served as special attorney, United States Department of Justice; admitted to

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practice before Supreme Court of United States; member of Charleston Chapter of Elks, Landmark Lodge of F. & A. M., Junior Order of United American Mechanics, Blue Key Honorary Fraternity, Grace Episcopal Church, Charleston, S. C.; married, has two daughters and one son; elected to Seventy-seventh Congress, November 5, 1940; reelected to the Seventy-eighth Congress; reelected to Seventy-ninth Congress; reelected to Eightieth Congress; reelected to Eighty-first Congress; reelected to Eighty-second Congress.

SECOND DISTRICT.—COUNTIES: Aiken, Bamberg, Barnwell, Calhoun, Lexington, Orangeburg, Richland, and Sumter (8 counties). Population (1950), 415,222.

JOHN JACOB RILEY, Democrat, of Sumter, S. C.; born in Orangeburg, S. C., February 1, 1895; elementary training in Orangeburg County school; was graduated from Orangeburg (S. C.) High School and from Wofford College, Spartanburg, S. C., with A. B. and A. M. degrees; taught in the Orangeburg city schools and at Clemson A. & M. College, Clemson, S. C.; served in the United States Navy in World War I; has been engaged in the real estate and insurance business in Sumter, S. C., for the past 25 years, director of the First Federal Savings and Loan Association of Sumter; past president of Sumter Chamber of Commerce, Wofford College Alumni Association, and of the Sumter Rotary Club; past post commander of Post No. 15, the American Legion; past district commander, the American Legion; head of boys' work, Sumter Post, the American Legion, 1926–44; member, Forty and Eight, B. P. O. E., K. of P., Mason; member, the Methodist Church; married to Corinne Anderson Boyd, of Spartanburg, S. C., in 1917; one daughter, Mrs. Douglas Warren Purdy, Erie, Pa., and one son, O. Beverley 3d; elected to the Seventy-ninth Congress, the Eightieth Congress, and the Eighty-second Congress.

THIRD DISTRICT.—COUNTIES: Abbeville, Anderson, Edgefield, Greenwood, McCormick, Newberry, Oconee, Pickens, and Saluda (9 counties). Population (1950), 307,557.

WILLIAM JENNINGS BRYAN DORN, Democrat; born in Greenwood County, S. C., April 14, 1916, the son of Pearl Griffith Dorn and the late T. E. Dorn; attended Greenwood public schools; in 1938 was elected to the South Carolina House of Representatives and became youngest member of that body; in 1940 was elected South Carolina State senator at the age of 24 and became youngest State senator in the history of South Carolina; in 1942 volunteered for the Army Air Forces and resigned from the State senate; served for 3½ years as an enlisted man, serving in European Theater of Operations with the Ninth Air Force; in 1946 was elected to Congress and became one of the four youngest members of the Eightieth Congress; in 1948 was runner-up in a field of five for the United States Senate, polling more than 83,000 votes; in 1950 was elected to Eighty-second Congress; according to all available records is the only man in American history who, in less than 10 years, served in a State house, State senate, 3½ years in the Army, United States Congress, and made a strong race for the United States Senate; member of American Legion, 40 & 8, Veterans of Foreign Wars, Air Force Association, Farm Bureau, Grange, Junior Chamber of Commerce, Woodmen of the World, Mason, Moose, Baptist Church; State residence, Route 1, Greenwood; occupation, farmer.

FOURTH DISTRICT.—COUNTIES: Greenville, Laurens, Spartanburg, and Union (4 counties). Population (1950), 393,231.

JOSEPH RALEIGH BRYSON, Democrat, of Greenville, S. C., was born in Brevard, N. C., January 18, 1893; moved to Greenville, S. C., in 1900; began working at age of 10 and subsequently spent 15 years as worker in textile mills of Greenville; meantime, attended public schools of Greenville and was graduated from Furman University, with B. A. degree in 1917, and from the University of South Carolina, with LL. B. degree, in 1920; received honorary Doctor of Laws degree from Bob Jones University in 1948; lawyer; volunteered as a private in World War I and served for the duration of the war; member of the South Carolina House of Representatives, 1921–24; served in the State senate, 1929–32; married Miss Ruth Rucker, of Swansea, S. C., and they have five children—Joseph Robert (M. D.), Ruth, William J., David, and Judy; member of the American Legion, Disabled American Veterans, and the Baptist Church, thirty-second degree Mason, Shriner, Woodman, Redman, Junior, Merrymaker, Moose (Loyal Order of Moose), and United Commercial Traveler; elected to the Seventy-sixth Congress on November 8, 1938; reelected to the Seventy-seventh Congress on November 5, 1940; reelected to the Seventy-eighth Congress on November 3,

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1942; reelected to the Seventy-ninth Congress on November 7, 1944; reelected to the Eightieth Congress on November 5, 1946; reelected to the Eighty-first Congress on November 2, 1948; reelected to the Eighty-second Congress on November 7, 1950.

**FIFTH DISTRICT.**—COUNTIES: Cherokee, Chester, Chesterfield, Fairfield, Kershaw, Lancaster, and York (7 counties). Population (1950), 266,321.

JAMES PRIOLEAU RICHARDS, Democrat, of Lancaster, S. C.; born at Liberty Hill, Kershaw County, S. C., August 31, 1894, the son of Norman Smith Richards and the late Phoebe Gibbes Richards; worked on a farm and attended county schools of Kershaw County until 17 years of age; attended Clemson College; graduate of the University of South Carolina; began the practice of law in Lancaster, S. C., September 1921 and has practiced there since that date; elected judge of probate of Lancaster County in 1922, and reelected in 1926 and 1930; while serving third term was elected to the Seventy-third Congress; reelected to Seventy-fourth, Seventy-fifth, Seventy-sixth, Seventy-seventh, Seventy-eighth, Seventy-ninth, Eightieth, Eighty-first, and Eighty-second Congresses; volunteered as private at Camp Styx, S. C., in 1917, a few days after war was declared, and served throughout the war in this country and France with Trench Mortar Battery, Headquarters Company, One Hundred and Eighteenth Infantry Regiment, Thirtieth Division, as private, corporal, and sergeant, and was commissioned as Reserve second lieutenant in February 1919, being discharged March 31, 1919; married on November 4, 1925, to Katharine Hawthorne Wylie, of Lancaster County; they have two sons—Richard Evans and Norman Smith—and one daughter—Jane; member of the Masons, American Legion, and Junior Order United American Mechanics, Veterans of Foreign Wars, and other fraternal organizations; member of the Foreign Affairs Committee since 1935 and chairman since May 15, 1951.

**SIXTH DISTRICT.**—COUNTIES: Darlington, Dillon, Florence, Georgetown, Horry, Lee, Marion, Marlboro, and Williamsburg (9 counties). Population (1950), 383,161.

JOHN L. McMILLAN, Democrat, Florence, S. C.; son of the late M. L. and Mary Alice Keith McMillan, Marion County, S. C.; educated Mullins, S. C., graded and high schools; academic course, University of North Carolina, and completed the Commerce and Finance School, also Law School, at University of South Carolina; member all-time all-South Carolina football team; enlisted in the U. S. Navy at Columbia, S. C., August 2, 1918, relieved from active duty December 17, 1918, and discharged from U. S. Naval Reserve September 30, 1921; married Margaret English, of Mount Pleasant, Tenn., October 1936; member of Baptist Church, Masons, Elks, and Jr. O. U. A. M.; member American Legion Post and Forty and Eight of Florence, S. C., National Blue Key fraternity; served as chairman, House District Committee, during the Seventy-ninth Congress and again selected as its chairman for the Eighty-first Congress; ranks No. 5 on the 30-member House Agriculture Committee; member of National Capital Sesquicentennial Commission, representing the House; elected to Congress in 1938 over five opponents, and reelected over one opponent in 1940 by a majority of 18,000 votes; reelected in 1942 over two opponents by a majority of 17,000 votes; reelected in 1944 without opposition; reelected in 1946 over two opponents with majority of 20,000 votes and without opposition in 1948; also without opposition in 1950.

## SOUTH DAKOTA

(Population (1950), 652,740)

### SENATORS

KARL E. MUNDT, Republican, of Madison, S. Dak.; born in Humboldt, S. Dak., June 3, 1900, the only son of F. J. and Rose E. Mundt, pioneer hardware merchants of that community; educated in the public schools of Humboldt, Pierre, and Madison, in South Dakota; A. B. from Carleton College, Northfield, Minn., 1923; A. M. from Columbia University, New York City, 1927; successively a school teacher and school superintendent in Bryant, S. Dak.; college speech and social science teacher in Eastern State Normal School, Madison, S. Dak.; farm operator and real estate and insurance business; appointed to South

LEGISLATIVE INTENT SERVICE



Dakota Game and Fish Commission (bipartisan) in 1931 for a 6-year term; one-time national vice president of Izaak Walton League; member of Delta Sigma Rho, Pi Kappa Delta, and Tau Kappa Alpha (honorary societies); cofounder and holder of membership certificate No. 1, of National Forensic League, of which he is now national president; editor of the Rostrum; associate editor, the Speaker; former editorial writer, Outdoor America, author of articles in Successful Farming, Collier's, U. S. News and World Report, The Christian Advocate, The Country Gentleman, Liberty magazine, Tomorrow, The Annals of the American Academy of Political and Social Science, Nation's Schools, Fairplay (London), and others; past governor, Minnesota-Dakotas District of Kiwanis International; member National Press Club and the University Club, Washington, D. C.; married in 1924; elected to the Seventy-sixth Congress by a vote of 111,693 to 95,315 for his Democratic opponent; reelected to the Seventy-seventh Congress by a vote of 134,928 to 91,874 for his Democratic opponent; reelected to Seventy-eighth, Seventy-ninth, and Eightieth Congresses with majorities of over 60 percent in each election; elected to the United States Senate from South Dakota in 1948 for the term ending January 3, 1955.

FRANCIS CASE, Republican, of Custer, S. Dak.; born in Iowa; operates ranch in the Black Hills; former newspaper editor and publisher; B. A. and LL. D., Dakota Wesleyan University, and M. A., Northwestern University; married Myrle Graves in 1926; children, Jane Marie, 1935; Francis H., Jr. (d), 1945; served in United States Marine Corps, World War I; State Regent of Education 1931–33; elected to House of Representatives from Second District of South Dakota in 1936 with 51.6 percent of votes cast; reelected in 1938 with 61.4 percent; in 1940 with 66.1 percent; 1942 with 71.8 percent; in 1944 with 69 percent; in 1946 with 73.6 percent; in 1948 with 65.9 percent; in 1950 elected to United States Senate, 160,313 to 90,710; House record includes: Case-Wheeler Water Conservation Act, 1937 and 1946; Renegotiation of Excess War Profits, 1942; Government Corporations Control Act (joint sponsor), 1945; United Nations Invitation to United States, 1945; "Case Bill"—Labor Relations (vetoed), 1946; Synthetic Liquid Fuels Act, 1948, and active in behalf of appropriations to implement 70-group Air Force; member House Committee on Appropriations, 1939–51; House Select Committee on Foreign Aid (1947–48), and Joint Congressional Aviation Policy, Eightieth Congress; member Senate Committee on Public Works.

### REPRESENTATIVES

**FIRST DISTRICT.**—COUNTIES: Aurora, Beadle, Bon Homme, Brookings, Brown, Brule, Buffalo, Campbell, Charles Mix, Clark, Clay, Codington, Davison, Day, Deuel, Douglas, Edmunds, Faulk, Grant, Hamlin, Hand, Hanson, Hughes, Hutchinson, Hyde, Jerauld, Kingsbury, Lake, Lincoln, McCook, McPherson, Marshall, Miner, Minnehaha, Moody, Potter, Roberts, Sanborn, Spink, Sully, Turner, Union, Walworth, and Yankton (44 counties). Population (1950), 491,882.

HAROLD O. LOVRE, Republican, of Watertown, S. Dak.; born in Toronto, S. Dak., January 30, 1904; graduated from the Toronto High School in the year 1922, spent 2 years at St. Olaf, Northfield, Minn., and 3 years at the University of South Dakota at Vermillion, graduating in the year 1927, with an LL. B. degree; practiced law in Hayti, S. Dak., from 1927 to 1944 and at Watertown, S. Dak., from 1944 to 1948; past president of the State Board of Agriculture of South Dakota; past state chairman of the Republican Party for South Dakota; served two terms in the State senate, representing Kingsbury and Hamlin counties, S. Dak.; member of the Lambda Chi Alpha and Phi Delta Phi fraternities; member of the Masonic bodies; former states attorney of Hamlin County, S. Dak., for 8 years; married Viola Florell of Dell Rapids, S. Dak., in 1928 and have four daughters, Janice Ann, 20; Carmen Nedra, 16; Sandra Mae, 14; and Linda Kay, 6; elected to the Eighty-first Congress; reelected to the Eighty-second Congress.

**SECOND DISTRICT.**—COUNTIES: Armstrong, Bennett, Butte, Corson, Custer, Dewey, Fall River, Gregory, Haakon, Harding, Jackson, Jones, Lawrence, Lyman, Meade, Mellette, Pennington, Perkins, Shannon, Stanley, Todd, Tripp, Washabaugh, and Ziebach (24 counties). Population (1950), 158,147.

E. Y. BERRY, Republican, of McLaughlin, S. Dak.; born at Larchwood, Iowa, October 6, 1902; practicing lawyer, newspaper publisher, and editor; LL. B., University of South Dakota; married Rose Hartinger in 1928; children, Robert E. Berry, born 1930; Nila Lee Berry, born 1934; member, State senate 1939, and 1941 legislative sessions; member, Missouri River States Committee, 1940–43; editor, State Bar Association Journal, 1938–50; member, State Board of Regents of Education, 1946–50; elected to the Eighty-second Congress November 7, 1950, with 60.5 percent of votes cast.

## THE HOUSE OF REPRESENTATIVES

SAM RAYBURN, Speaker, 1900 Q Street.
*RALPH R. ROBERTS, Clerk, the Wardman Park.
*JOSEPH H. CALLAHAN, Sergeant at Arms, 1545 Live Oak Drive, Silver Spring, Md.
*WILLIAM M. MILLER, Doorkeeper, 1732 S Street SE.
*FINIS E. SCOTT, Postmaster, 5323 Reno Road.
*‖REV. BERNARD BRASKAMP, D. D., Chaplain, 1421 Montague Street.

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| *Anderson, Jack Z | San Juan Bautista, Calif. | 4201 Massachusetts Ave. | 12 |
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| *†Baker, Howard H | Huntsville, Tenn | 3339 Reservoir Rd | 128 |
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| *Battle, Laurie C | Birmingham, Ala | 2065 38th St. SE | 6 |
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| *Beamer, John V | Wabash, Ind | The Congressional | 36 |
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| *†Bender, George H | Chagrin Falls, Ohio | The Mayflower | 102 |
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| *††Bennett, John B | Ontonagon, Mich | 7304 Bradley Blvd., Bethesda, Md. | 58 |
| *Bentsen, Lloyd M., Jr | McAllen, Tex | Springbrook, route 2, Silver Spring, Md. | 133 |
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| *Betts, Jackson E | Findlay, Ohio | 1801 Key Blvd., Arlington, Va. | 104 |
| *Bishop, C. W. (Runt) | Carterville, Ill | 2633 41st Pl. SE | 34 |
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| *Boggs, J. Caleb | Wilmington, Del | | 21 |
| *Bolling, Richard | Kansas City, Mo | 114 C St. SE | 66 |
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| *Bonner, Herbert C | Washington, N. C | The Roosevelt | 97 |
| †Bosone, Reva Beck | Salt Lake City, Utah | 1711 Massachusetts Ave. | 136 |
| *Bow, Frank T | Canton, Ohio | 2300 Connecticut Ave | 105 |
| *Boykin, Frank W | Mobile, Ala | Hotel Washington | 4 |
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| *Burleson, Omar | Anson, Tex | 2737 Devonshire Pl | 134 |
| *Burnside, M. G | Huntington, W. Va | 800 Crescent Dr., Alexandria, Va. | 143 |
| Burton, Clarence G | Lynchburg, Va | | 139 |
| *Busbey, Fred E | Chicago, Ill | 1814 29th St. SE | 29 |
| *†Bush, Alvin R | Muncy, R. F. D., Pa | The Continental | 115 |
| *Butler, John C | Buffalo, N. Y | | 95 |
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| *Byrnes, John W | Green Bay, Wis | 1215 25th St. South, Arlington, Va. | 146 |
| *†Camp, A. Sidney | Newnan, Ga | 2120 16th St | 25 |
| Canfield, Gordon | Paterson, N. J | | 77 |
| *Cannon, Clarence | Elsberry, Mo | 418 New Jersey Ave. SE. | 67 |
| *†Carlyle, F. Ertel | Lumberton, N. C | The Wardman Park | 99 |
| *Carnahan, A. S. J | Elsinore, Mo | 2834 Fort Baker Dr. SE | 67 |
| *Carrigg, Joseph L | Susquehanna, Pa | | 115 |
| Case, Clifford P | Rahway, N. J | 239 House Office Bldg | 76 |
| *†Celler, Emanuel | Brooklyn, N. Y | The Mayflower | 87 |
| *Chatham, Thurmond | Winston-Salem, N. C | 3508 Prospect Ave | 98 |
| Chelf, Frank L | Lebanon, Ky | | 44 |
| *Chenoweth, J. Edgar | Trinidad, Colo | 6318 Utah Ave | 17 |
| *Chiperfield, Robert B | Canton, Ill | 4800 DeRussey Pkwy., Chevy Chase, Md. | 33 |
| Chudoff, Earl | Philadelphia, Pa | | 113 |
| †Church, Marguerite S | Evanston, Ill | The Shoreham | 31 |
| *Clemente, L. Gary | South Ozone Park, N. Y. | | 82 |
| *Clevenger, Cliff | Bryan, Ohio | 1200 16th St | 103 |
| *Cole, Albert M | Holton, Kans | 2501 Q St | 41 |
| *Cole, W. Sterling | Bath, N. Y | 1610 44th St | 94 |
| *Colmer, William M | Pascagoula, Miss | | 64 |

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82D CONGRESS
1ST SESSION

# H. R. 3760

IN THE HOUSE OF REPRESENTATIVES

APRIL 18, 1951

Mr. BRYSON introduced the following bill; which was referred to the Committee on the Judiciary

# A BILL

To revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents".

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That title 35 of the United States Code, entitled "Patents", is revised, codified, and enacted into law, and may be cited, "Title 35, United States Code, section—", as follows:

## TITLE 35—PATENTS


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### CHAPTER 1—PATENT OFFICE


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## § 1. Establishment

The Patent Office shall continue as an office in the Department of Commerce, where records, books, drawings, specifications, and other papers and things pertaining to patents and to trade-mark registrations shall be kept and preserved, except as otherwise provided by law.

## § 2. Seal

The Patent Office shall have a seal with which letters patent, certificates of trade-mark registrations, and papers issued from the Office shall be authenticated.

## § 3. Officers and employees

A Commissioner of Patents, one first assistant commissioner, two assistant commissioners, and nine examiners-in-chief, shall be appointed by the President, by and with the advice and consent of the Senate. The assistant commissioners shall perform the duties pertaining to the office of commissioner assigned to them by the Commissioner. The first assistant commissioner, or the assistant commissioner senior in date of appointment in the event of a vacancy in the office of first assistant commissioner, shall fill the office of Commissioner during any vacancy in that office until a Commissioner is appointed and takes office. All other officers, clerks, and employees shall be appointed by the Secretary of Commerce upon the nomination of the Commissioner in accordance with law.

## § 4. Restrictions on officers and employees as to interest in patents

Officers and employees of the Patent Office shall be incapable, during the period for which they hold their appointments and one year thereafter, of applying for a patent and of acquiring, directly or indirectly, except by inheritance or bequest, any patent or any right or interest in any patent, issued or to be issued by the Office. In patents applied for thereafter they shall not be entitled to any priority date earlier than one year after the termination of their appointment.

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**§ 5. Bond of Commissioner and other officers**

The Commissioner and such other officers as he designates, before entering upon their duties, shall severally give bond, with sureties, the former in the sum of $10,000, and the latter in sums prescribed by the Commissioner, conditioned for the faithful discharge of their respective duties and that they shall render to the proper officers of the Treasury a true account of all money received by virtue of their offices.

**§ 6. Duties of Commissioner**

The Commissioner, under the direction of the Secretary of Commerce, shall superintend or perform all duties required by law respecting the granting and issuing of patents and the registration of trademarks; and he shall have charge of property belonging to the Patent Office. He may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

**§ 7. Board of Appeals**

The examiners-in-chief shall be persons of competent legal knowledge and scientific ability. The Commissioner, the assistant commissioners, and the examiners-in-chief shall constitute a Board of Appeals, which, on written appeal of the applicant, shall review adverse decisions of examiners upon applications for patents. Each appeal shall be heard by at least three members of the Board of Appeals, the members hearing such appeal to be designated by the Commissioner. The Board of Appeals has sole power to grant rehearings.

Whenever the Commissioner considers it necessary to maintain the work of the Board of Appeals current, he may designate any patent examiner of the primary examiner grade or higher, having the requisite ability, to serve as examiner-in-chief for periods not exceeding six months each. An examiner so designated shall be qualified to act as a member of the Board of Appeals. Not more than one such primary examiner shall be a member of the Board of Appeals hearing an appeal.

**§ 8. Library**

The Commissioner shall maintain a library of scientific and other works and periodicals, both foreign and domestic, in the Patent Office to aid the officers in the discharge of their duties.

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**§ 9. Classification of patents**

The Commissioner may revise and maintain the classification by subject matter of United States letters patent, and such other patents and printed publications as may be necessary or practicable, for the purpose of determining with readiness and accuracy the novelty of inventions for which applications for patent are filed.

**§ 10. Certified copies of records**

The Commissioner may furnish certified copies of specifications and drawings of patents issued by the Patent Office, and of other records available either to the public or to the person applying therefor.

**§ 11. Publications**

(a) The Commissioner may print, or cause to be printed, the following:

1. Patents, including specifications and drawings, together with copies of the same. The Patent Office may multigraph the headings of the drawings for patents for the purpose of photolithography.

2. Certificates of trade-mark registrations, including statements and drawings, together with copies of the same.

3. The Official Gazette of the United States Patent Office.

4. Annual indexes of patents and patentees, and of trade-marks and registrants.

5. Annual volumes of decisions in patent and trade-mark cases.

6. Pamphlet copies of the patent laws and rules of practice, laws and rules relating to trade-marks, and circulars or other publications relating to the business of the Office.

(b) The Commissioner may exchange any of the publications specified in items 3, 4, 5, and 6 of subsection (a) of this section for publications desirable for the use of the Patent Office.

**§ 12. Exchange of copies of patents with foreign countries**

The Commissioner may exchange copies of specifications and drawings of United States patents for those of foreign countries.

**§ 13. Copies of patents for public libraries**

The Commissioner may supply printed copies of specifications and drawings of patents to public libraries in the United States which shall maintain such copies for the use of the public, at the rate for each year's issue established for this purpose in section 41 (a) 9 of this title.

**§ 14. Annual report to Congress**

The Commissioner shall report to Congress annually the moneys received and expended, statistics concerning the work of the Office,

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and other information relating to the Office as may be useful to the Congress or the public.

PROCEEDINGS IN THE PATENT OFFICE

### § 21. Day for taking action falling on Saturday, Sunday, or holiday

When the day, or the last day, for taking any action or paying any fee in the United States Patent Office falls on Saturday, Sunday, or a holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding secular or business day.

### § 22. Printing of papers filed

The Commissioner may require papers filed in the Patent Office to be printed or typewritten.

### § 23. Testimony in Patent Office cases

The Commissioner may establish rules for taking affidavits and depositions required in cases in the Patent Office. Any officer authorized by law to take depositions to be used in the courts of the United States, or of the State where he resides, may take such affidavits and depositions.

### § 24. Subpoenas, witnesses

The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent Office, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent Office.

Every witness subpoenaed and in attendance shall be allowed the fees and traveling expenses allowed to witnesses attending the United States district courts.

A judge of a court whose clerk issued a subpoena may, on proof of the neglect or refusal of a witness, after being duly served with such subpoena, to appear, or after appearing, to testify, enforce obedience to the process or punish the disobedience as in other like cases. No witness shall be deemed guilty of contempt for disobeying such subpoena unless his fees and traveling expenses in going to, and returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for

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refusing to disclose any secret matter except upon appropriate order of the court which issued the subpoena.

PRACTICE BEFORE PATENT OFFICE

**§ 31. Regulations for agents and attorneys**

The Commissioner, subject to the approval of the Secretary of Commerce, may prescribe regulations governing the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Patent Office, and may require them, before being recognized as representatives of applicants or other persons, to show that they are of good moral character and reputation, are possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office.

**§ 32. Suspension or exclusion from practice**

The Commissioner may, after notice and opportunity for a hearing, suspend or exclude, either generally or in any particular case, from further practice before the Patent Office, any person, agent, or attorney shown to be incompetent or disreputable, or guilty of gross misconduct, or who does not comply with the regulations established under section 31 of this title, or who shall, with intent to defraud, deceive, mislead, or threaten any applicant or prospective applicant, or other person having immediate or prospective business before the Office. The reasons for any such suspension or exclusion shall be duly recorded. The United States District Court for the District of Columbia, under such conditions and upon such proceedings as it by its rules determines, may review the action of the Commissioner upon the petition of the person so refused recognition or so suspended or excluded.

**§ 33. Unauthorized representation as practitioner**

Whoever, not being recognized to practice before the Patent Office, holds himself out or permits himself to be held out as so recognized, or as being qualified to prepare or prosecute applications for patent, shall be fined not more than $1,000 for each offense.

PATENT FEES

**§ 41. Patent fees**

(a) The Commissioner shall charge the following fees:

1. On filing each application for an original patent, except in design cases, $30, and $1 for each claim in excess of twenty.

2. On issuing each original patent, except in design cases, $30, and $1 for each claim in excess of twenty.

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3. In design cases: For three years and six months, $10; for seven years, $15; for fourteen years, $30.

4. On every application for the reissue of a patent, $30 and $1 for each claim in excess of twenty over and above the number of claims of the original patent.

5. On filing each disclaimer, $10.

6. On an appeal for the first time from the examiner to the Board of Appeals, $25.

7. On filing each petition for the revival of an abandoned application for a patent or for the delayed payment of the fee for issuing each patent, $10.

8. For certificate of correction of applicant's mistake under section 205 of this title, $10.

9. For uncertified printed copies of specifications and drawings of patents (except design patents), 25 cents per copy; for design patents, 10 cents per copy; special rate for libraries specified in section 13 of this title, $50 for patents issued in one year.

10. For recording every assignment, agreement, or other paper not exceeding six pages, $3; for each additional two pages or less, $1; for each additional patent or application included in one writing, where more than one is so included, 50 cents additional.

11. For each certificate, $1.

(b) The Commissioner may establish charges for copies of records, publications, or services furnished by the Patent Office, not specified above.

### § 42. Payment of patent fees; return of excess amounts

All patent fees shall be paid to the Commissioner who shall deposit the same in the Treasury of the United States in such manner as the Secretary of the Treasury directs, and the Commissioner may refund any sum paid by mistake or in excess of the fee required by law.

## CHAPTER 2—PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS

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DEFINITIONS

## § 100. Definitions

When used in this title unless the context otherwise indicates—

(a) The term "invention" includes discoveries.

(b) The term "process" includes method, and a new use of a known process, machine manufacture, composition of matter or material.

(c) The terms "United States" and "this country" mean the United States of America, its territories and possessions.

(d) The word "patentee" includes not only the patentee to whom the patent was issued but also the successors in title to the patentee.

PATENTABILITY OF INVENTIONS

## § 101. Inventions patentable

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

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**§ 102. Conditions for patentability; novelty and loss of right to patent**

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in any printed publication in this or any foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in any printed publication in this or any foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than six months in design cases or twelve months in other cases before the filing of the application in the United States, or

(e) the invention was described in an application for patent by another filed in the United States before the invention thereof by the applicant for patent, which first-mentioned application issued as a patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was in fact made in this country by another who had not abandoned it and who was using reasonable diligence in this country in reducing it to practice or had reduced it to practice.

**§ 103. Conditions for patentability; non-obvious subject matter**

A patent may not be obtained though the invention is not identically disclosed or described in the prior art set forth in section 102 of this title, if the differences between the subject matter sought to be patented and that prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.



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### § 104. Invention made abroad

In proceedings in the Patent Office and in the courts, an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country, except as provided in section 119 of this title. Where an invention was made by a person, civil or military, while domiciled in the United States and serving in a foreign country in connection with operations by or on behalf of the United States, he shall be entitled to the same rights of priority with respect to such invention as if the same had been made in the United States.

APPLICATION FOR PATENT

### § 111. Application for patent

Application for patent shall be made by the inventor, except as otherwise provided in this title, in writing to the Commissioner. Such application shall include: (1) a specification as prescribed by section 112 of this title; (2) a drawing as prescribed by section 113 of this title; and (3) an oath by the applicant as prescribed by section 115 of this title. The application must be signed by the applicant and accompanied by the fee required by law.

### § 112. Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

### § 113. Drawings

When the nature of the case admits, the applicant shall furnish a drawing.

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**§ 114. Models, specimens**

The Commissioner may require the applicant to furnish a model of convenient size to exhibit advantageously the several parts of his invention.

When the invention relates to a composition of matter, the Commissioner may require the applicant to furnish specimens or ingredients for the purpose of inspection or experiment.

**§ 115. Oath of applicant**

The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition, or improvement thereof, for which he solicits a patent; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by certificate of a diplomatic or consular officer of the United States, and such oath shall be valid if it complies with the laws of the state or country where made. When the application is made as provided in this title by a person other than the inventor, the oath may be so varied in form that it can be made by him.

**§ 116. Joint inventors**

When an invention is made by two or more persons jointly, they shall apply for patent jointly and each sign the application and make the required oath, except as otherwise provided in this title.

If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Commissioner, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor making the application, subject to the same rights which the omitted inventor would have had if he had been joined. The omitted inventor may subsequently join in the application.

Whenever a person is joined in an application for patent as joint inventor through error, or a joint inventor is not included in an appli-

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cation through error, and such error arose without any deceptive intention, the Commissioner may permit the application to be amended accordingly, under such terms as he prescribes.

**§ 117. Death or incapacity of inventor**

The Commissioner may receive applications of and issue patents to legal representatives of deceased inventors and of those under legal incapacity, upon compliance with the requirements and on the same terms and conditions applicable to the inventor.

**§ 118. Filing by other than inventor**

Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed to assign the invention in writing, or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage; and the Commissioner may grant a patent to such inventor upon such notice to him as the Commissioner deems sufficient, and on compliance with such regulations as he prescribes.

**§ 119. Benefit of earlier filing date in foreign country; right of priority**

An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed; but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing.

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No application for patent shall be entitled to this right of priority unless a claim therefor and a certified copy of the original foreign application, specification and drawings upon which it is based are filed in the Patent Office before the patent is granted, or at such time during the pendency of the application as required by the Commissioner, not earlier than six months after the filing of the application in this country. Such certification shall be made by the patent office of the foreign country in which filed and show the date of the application and of the filing of the specification and other papers. The Commissioner may require a translation of the papers filed if not in the English language and such other information as he deems necessary.

**§ 120. Benefit of earlier filing date in the United States**

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States by the same inventor shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or any application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

**§ 121. Divisional applications**

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions; and the other invention or inventions may be made the subject of divisional applications. A divisional application shall be entitled to the benefit of the filing date of the original application if it complies with the requirements of section 120 of this title. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent Office or in the courts against a divisional application or against the original application or any patent issued on either of them, for the purposes of section 103 of this title if the divisional application is filed before the issuance of the patent. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Commissioner may dispense with signing and execution by the inventor. The validity of

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a patent shall not be questioned for failure of the Commissioner to require the application to be restricted to one invention.

**§ 122. Confidential status of applications**

Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner.

EXAMINATION OF APPLICATION

**§ 131. Examination of application**

The Commissioner shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Commissioner shall issue a patent therefor.

**§ 132. Notice of rejection; reexamination**

Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

**§ 133. Time for prosecuting application**

Upon failure of the applicant to prosecute the application within six months (or such shorter time, not less than thirty days, as shall be fixed by the Commissioner, and the applicant notified thereof in writing) after any action therein, of which notice shall have been given or mailed to the applicant, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

**§ 134. Appeal to the Board of Appeals**

An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the examiner to the Board of Appeals, having once paid the fee for such appeal.

**§ 135. Interferences**

Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application,

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or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of three examiners of interferences whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office.

No claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may be made in any application unless such a claim is made within one year from the date on which said patent was granted.

REVIEW OF PATENT OFFICE DECISIONS

**§ 141. Appeal to Court of Customs and Patent Appeals**

An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Customs and Patent Appeals, thereby waiving his right to proceed under section 145 of this title. A party to an interference dissatisfied with the decision of the board of interference examiners on the question of priority may appeal to the United States Court of Customs and Patent Appeals, but such appeal shall be dismissed if any adverse party to such interference shall, within twenty days after the appellant has filed notice of appeal according to section 142 of this title, files notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 146 of this title. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under section 146, in default of which the decision appealed from shall govern the further proceedings in the case.

**§ 142. Notice of appeal**

When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and shall file in the Patent Office his reasons of appeal, specifically set forth in writing, within such time after the date of the decision appealed from, not less than sixty days, as the Commissioner appoints.

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**§ 143. Proceedings on appeal**

The United States Court of Customs and Patent Appeals shall, before hearing such appeal, give notice of the time and place of the hearing to the Commissioner and the parties thereto. The Commissioner shall transmit to the court certified copies of all the necessary original papers and evidence in the case specified by the appellant and any additional papers and evidence specified by the appellee and in an ex parte case the Commissioner shall furnish the court with the grounds of the decision of the Patent Office, in writing, touching all the points involved by the reasons of appeal.

**§ 144. Decision on appeal**

The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent Office, and the decision shall be confined to the points set forth in the reasons of appeal. Upon its determination the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and govern the further proceedings in the case.

**§ 145. Civil action to obtain patent**

An applicant dissatisfied with the decision of the Board of Appeals may, unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

**§ 146. Civil action in case of interference**

Any party to an interference dissatisfied with the decision of the board of interference examiners on the question of priority, may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the Commission appoints or as provided in section 141 of this title, unless he has appealed to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided. In such suits the record in the Patent Office shall be admitted on motion of either party upon the terms and

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conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent Office when admitted shall have the same effect as if originally taken and produced in the suit.

Such suit may be instituted against the party in interest as shown by the records of the Patent Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs. The Commissioner shall not be a necessary party but he shall be notified of the filing of the suit by the clerk of the court in which it is filed and shall have the right to intervene. Judgment of the court in favor of the right of an applicant to a patent shall authorize the Commissioner to issue such patent on the filing in the Patent Office of a certified copy of the judgment and on compliance with the requirements of law.

ISSUE OF PATENT

**§ 151. Time of issue of patent**

The patent shall issue within three months from the date of the payment of the final fee, which shall be paid not later than six months after written notice to the applicant of allowance of the application, but the Commissioner may accept the final fee if paid within one year after the six months' period for payment, and the patent shall issue.

**§ 152. Issue of patent to assignee**

Patents may be granted to the assignee of the inventor of record in the Patent Office, upon the application made and the specification sworn to by the inventor, except as otherwise provided in this title.

**§ 153. How issued**

Patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Commissioner or have his signature placed thereon and attested by an officer of the Patent Office designated by the Commissioner, and shall be recorded in the Patent Office.

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### § 154. Contents and term of patent

Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the right to exclude others from making, using, or selling the invention throughout the United States, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof.

## CHAPTER 3—PATENTS AND PROTECTION OF PATENT RIGHTS

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AMENDMENT AND CORRECTION OF PATENTS

### § 201. Reissue of defective patents

Whenever any patent through error is deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, without any deceptive intention, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended

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application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Commissioner may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

**§ 202. Effect of reissue**

The surrender of the original patent shall take effect upon the issue of the reissued patent, and every reissued patent shall have the same effect and operation in law, on the trial of actions for causes thereafter arising, as if the same had been originally granted in such amended form, but in so far as the claims of the original and reissued patents are identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent, to the extent that its claims are identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent.

No reissued patent shall abridge or affect the right of any person or his successors in business who made, purchased or used prior to the grant of a reissue anything patented by the reissued patent, to continue the use of, or to sell to others to be used or sold, the specific thing so made, purchased or used, if the making, using or selling of such thing does not infringe a valid claim of the reissued patent which was in the original patent.

The court before which such matter is in question may provide for the continued manufacture, use or sale of such thing made, purchased or used as specified in the preceding paragraph hereof, or for the manufacture, use or sale of which substantial preparation was made before the grant of the reissue, and it may also provide for the continued practice of any process patented by the reissue, practiced, or for the practice of which substantial preparation was made, prior to the grant of the reissue, to the extent and under such terms as the

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court deems equitable for the protection of investments made or business commenced before the grant of the reissue.

**§ 203. Disclaimer**

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid, and the patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, and recorded in the Patent Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

**§ 204. Certificate of correction of Patent Office mistake**

Whenever a mistake in a patent, incurred through the fault of the Patent Office, is clearly disclosed by the records of the Office, the Commissioner may issue a certificate of correction stating the fact and nature of such mistake, under seal, without charge, to be recorded in the records of patents. A printed copy thereof shall be attached to each printed copy of the patent, and such certificate shall be considered as part of the original patent. Every such patent, together with such certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form. The Commissioner may issue a corrected patent without charge in lieu of and with like effect as a certificate of correction.

**§ 205. Certificate of correction of applicant's mistake**

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Commissioner may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require re-examination. Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form.

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**§ 206. Misjoinder of inventor**

Whenever a patent is issued on the application of persons as joint inventors and it appears that one of such persons was not in fact a joint inventor, and that he was included as a joint inventor by error and without any deceptive intention, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate deleting the name of the erroneously joined person from the patent.

Whenever a patent is issued and it appears that a person was a joint inventor, but was omitted by error and without any deceptive intention, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate adding his name to the patent as a joint inventor.

The misjoinder or nonjoinder of joint inventors shall not invalidate a patent, if such error can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Commissioner shall issue a certificate accordingly.

OWNERSHIP AND ASSIGNMENT

**§ 211. Ownership; assignments**

Subject to the provisions of this title, patents shall have the applicable rights of personal property.

Applications for patent, patents, or any interest therein, shall be assignable in law by an instrument in writing. The applicant, patentee, or his assigns or legal representatives may in like manner grant and convey an exclusive right under his application for patent, or patents, to the whole or any specified part of the United States.

A certificate of acknowledgment under the hand and official seal of a person authorized to administer oaths within the United States, or, in a foreign country, of a diplomatic or consular officer of the United States or an officer authorized to administer oaths whose authority is proved by a certificate of a diplomatic or consular officer of the United States, shall be prima facie evidence of the execution of an assignment, grant or conveyance of an application for patent or patents.

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 its date, or prior to the date of such subsequent purchase or mortgage.

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**§ 212. Joint owners**

In the absence of any agreement to the contrary, each of the joint owners of a patent may make, use or sell the patented invention without the consent of and without accounting to the other owners, but neither of the owners may grant licenses or assign his interest, or any part thereof, without the consent of the other owners or without accounting to them.

GOVERNMENT INTERESTS IN PATENTS

**§ 221. Issue of patents without fees to Government employees**

The Commissioner may grant, subject to the provisions of this title, to any officer, enlisted man, or employee of the Government, except officers and employees of the Patent Office, a patent without the payment of fees, when the head of a department or agency certifies the invention is used or likely to be used by or for the Government and the applicant in his application states that the invention described therein, if patented, may be manufactured and used by or for the Government for governmental purposes without the payment to him of any royalty thereon, which stipulation shall be included in the patent.

**§ 222. Time for taking action in Government applications**

Notwithstanding the provisions of sections 133, 145, and 151 of this title, the Commissioner may extend the time for taking any action to three years, when an application has become the property of the United States and the head of the appropriate department or agency of the Government has certified to the Commissioner that the invention disclosed therein is important to the armament or defense of the United States.

INFRINGEMENT OF PATENTS

**§ 231. Infringement of patent**

(a) Except as otherwise provided in this title, whoever without authority makes, uses or sells any patented invention, within the United States during the term of the patent therefor, infringes the patent.

(b) Whoever actively induces infringement of a patent shall be liable as an infringer.

(c) Whoever knowingly sells a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of

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commerce suitable for substantial noninfringing use shall be liable as a contributory infringer.

(d) No patent owner otherwise entitled to relief for infringement or contributory infringement of a patent shall be denied relief or deemed guilty of misuse or illegal extension of the patent right by reason of his having done one or more of the following: (1) derived revenue from acts which if performed by another without his consent would constitute contributory infringement of the patent; (2) licensed or authorized a person to perform acts which if performed without his consent would constitute contributory infringement of the patent; (3) sought to enforce his patent rights against infringement or contributory infringement.

**§ 232. Temporary presence in the United States**

The use of any invention in any vessel, aircraft or vehicle of any country which affords similar privileges to vessels, aircraft or vehicles of the United States, entering the United States temporarily or accidentally, shall not constitute infringement of any patent, if the invention is used exclusively for the needs of the vessel, aircraft or vehicle and is not sold in or used for the manufacture of anything to be sold in or exported from the United States.

REMEDY FOR INFRINGEMENT OF PATENT, AND OTHER ACTIONS

**§ 241. Remedy for infringement of patent**

A patentee shall have remedy by civil action for infringement of his patent.

**§ 242. Presumption of validity; defenses**

A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it.

The following shall be defenses to any action involving the validity or infringement of a patent and shall be pleaded:

(1) Noninfringement or absence of liability for infringement,

(2) Invalidity of the patent or any claim thereof on any ground specified in chapter 2 of this title as a condition for patentability,

(3) Failure to comply with any requirement of sections 112 or 201 of this title,

(4) Any other fact or act made a defense by this title.

In actions involving the validity of infringement of a patent the party asserting invalidity or noninfringement shall give notice in the pleadings or otherwise in writing to the adverse party at least thirty days before the trial, of the country, number, date, and name of the patentee of any patent, the title, date, and page numbers of any publication to be relied upon as anticipations of the patent in suit or,

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except in actions in the United States Court of Claims, as showing the state of the art, and the name and address of any person who may be relied upon as the prior inventor or as having prior knowledge of or as having previously used or offered for sale the invention of the patent in suit. In the absence of such notice proof of the said matters may not be made at the trial except on such terms as the court requires.

**§ 243. Injunction**

The several courts having jurisdiction of cases under this title may grant injunctions in accordance with the principles of equity to prevent the violation of any right secured by patent, on such terms as the court deems reasonable.

**§ 244. Damages**

Upon adjudging a patent valid and infringed, the court shall award the claimant damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court.

When the damages are not found by a jury, the court shall assess them. In either event the court may increase the damages up to three times the amount found or assessed.

The court may receive expert testimony as an aid to the determination of damages or of what royalty would be reasonable under the circumstances.

**§ 245. Attorney fees**

The court in exceptional cases may award reasonable attorney fees to the prevailing party.

**§ 246. Time limitation on damages**

Except as otherwise provided by law, no recovery shall be had for any infringement committed more than six years prior to the filing of the complaint or counterclaim for infringement in the action.

**§ 247. Limitation on damages; marking and notice**

Patentees, and persons making or selling any patented article for or under them, may give notice to the public that the same is patented, either by fixing thereon the word "patent" or the abbreviation "pat.", together with the number of the patent, or when, from the character of the article, this can not be done, by fixing to it, or to the package wherein one or more of them is contained, a label containing a like notice. In the event of failure so to mark, no damages shall be recovered by the patentee in any action for infringement, except on proof that the infringer was notified of the infringement and continued to infringe thereafter, in which event damages may be recovered

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only for infringement occurring after such notice. Filing of an action for infringement shall constitute such notice.

**§ 248. Action for infringement of a patent containing an invalid claim**

Whenever, without deceptive intention, a claim of a patent is invalid, an action may be maintained for the infringement of a claim of the patent which may be valid. The patentee shall recover no costs unless a disclaimer of the invalid claim has been entered at the Patent Office before the commencement of the suit.

**§ 249. Notice of patent suits**

The clerks of the courts of the United States, within one month after the filing of an action under this title shall give notice thereof in writing to the Commissioner, setting forth so far as known the names and addresses of the parties, name of the inventor, and the designating number of the patent upon which the action has been brought. If any other patent is subsequently included in the action he shall give like notice thereof. Within one month after the decision is rendered or a judgment issued the clerk of the court shall give notice thereof to the Commissioner, and the Commissioner shall, on receipt of such notice, forthwith, enter the same in the file of such patent.

**§ 250. Interfering patents**

The owner of an interfering patent may have relief against the owner of another by civil action, and the court may adjudge the question of the validity of any of the interfering patents, in whole or in part. The provisions of the second paragraph of section 146 of this title shall apply to actions brought under this section.

**§ 251. False marking**

(a) Whoever, without the consent of the patentee, marks upon, or affixes to, or uses in advertising in connection with anything made, used, or sold by him, the name or any imitation of the name of the patentee, the patent number, or the words "patent," "patentee," or the like, with the intent of counterfeiting or imitating the mark of the patentee, or of deceiving the public and inducing them to believe that the thing was made or sold by or with the consent of the patentee; or

Whoever marks upon, or affixes to, or uses in advertising in connection with any unpatented article, the word "patent" or any word or number importing that the same is patented, for the purpose of deceiving the public; or

Whoever marks upon, or affixes to, or uses in advertising in connection with any article, the words "patent applied for," "patent pending," or any word importing that an application for patent has been made,

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when no application for patent has been made, or if made, is not pending, for the purpose of deceiving the public—

Shall be fined not more than $500 for every such offense.

(b) Any person may sue for the penalty, in which event one-half shall go to the person suing and the other to the use of the United States.

### § 252. Nonresident patentee; service and notice

Every patentee not residing in the United States may file in the Patent Office a written designation stating the name and address of a person residing within the United States on whom may be served process or notice of proceedings affecting the patent or rights thereunder. If the person designated cannot be found at the address given in the last designation, or if no person has been designated, the United States District Court for the District of Columbia shall have jurisdiction and summons shall be served by publication or otherwise as the court directs. The court shall have the same jurisdiction to take any action respecting the patent or rights thereunder that it would have if the patentee were personally within the jurisdiction of the court.

## CHAPTER 4—PLANTS AND DESIGNS

PLANTS

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301. Patents for plants.
302. Description, claim.
303. Grant.
304. Assistance of Department of Agriculture.

DESIGNS

311. Patents for designs.
312. Right of priority.
313. Term of design patent.
314. Additional remedy for infringement of design patent.

PLANTS

### § 301. Patents for plants

Whoever invents or discovers and asexually reproduces any distinct and new variety of plant, other than a tuberpropagated plant, may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for plants, except as otherwise provided.

### § 302. Description, claim

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible.

The claim in the specification shall be in formal terms to the plant shown and described.

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### § 303. Grant

In the case of a plant patent the grant shall be of the right to exclude others from asexually reproducing the plant or selling the plant so reproduced.

### § 304. Assistance of Department of Agriculture

The President may by Executive order direct the Secretary of Agriculture in accordance with the requests of the Commissioner to carry into effect the provisions of this title with respect to plants (1) to furnish available information of the Department of Agriculture, (2) to conduct through the appropriate bureau or division of the Department research upon special problems, or (3) to detail to the Commissioner officers and employees of the Department.

DESIGNS

### § 311. Patents for designs

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

### § 312. Right of priority

The right of priority provided for by section 119 of this title shall be six months in the case of designs.

### § 313. Term of design patent

Patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant, in his application, elects.

### § 314. Additional remedy for infringement of design patent

Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit, but not less than $250, recoverable in any United States district court having jurisdiction of the parties.

Nothing in this section shall prevent, lessen, or impeach any other remedy which an owner of an infringed patent has under the provisions of this title, but he shall not twice recover the profit made from the infringement.

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SEC. 2. Section 21 of the Act approved July 5, 1946, 60 Stat. 435, (United States Code, title 15, sec. 1071, 1946 ed.) is amended by changing "Revised Statutes 4911" appearing in said section to read "35 United States Code, section 141"; by changing "section 4915, Revised Statutes" appearing in said section to read "35 United States Code, sections 145 and 146"; and by changing "Revised Statutes 4915" appearing twice in said section to read "35 United States Code, section 146".

SEC. 3. If any provision of Title 35, as enacted by section 1 hereof, is declared unconstitutional or is held invalid, the validity of the remainder of this title shall not be affected.

SEC. 4. (a) This Act shall take effect on January 1, 1952 and shall apply to all applications for patent filed on or after such date and to all patents granted on such applications. It shall apply to further proceedings on applications pending on such date and to patents granted on such applications except as otherwise provided. It shall apply to unexpired patents granted prior to such date except as otherwise provided.

(b) Section 102 (d) of Title 35, as enacted by section 1 hereof, shall not apply to existing patents and pending applications, but the law previously in effect, namely the first paragraph of R. S. 4887 (U. S. Code, title 35, sec. 32, first paragraph, 1946 ed.), shall apply to such patents and applications.

(c) Section 119, second paragraph, of Title 35 as enacted by section 1 hereof shall not apply to existing patents.

(d) The period of one year specified in section 102 of Title 35 as enacted by section 1 hereof shall not apply in the case of applications filed before August 5, 1940, and patents granted on such applications, and with respect to such applications and patents, said period is two years instead of one year.

(e) Nothing contained in Title 35, as enacted by section 1 hereof, shall operate to nullify any judicial finding on the validity of any patent by a court of competent jurisdiction.

(f) Nothing in Title 35, as enacted by section 1 hereof, shall affect any provision of the Atomic Energy Act of 1946 (Aug. 1, 1946, ch. 724, 60 Stat. 755).

SEC. 5. The sections or parts thereof of the Revised Statutes or Statutes at Large enumerated in the following schedule are hereby repealed. Any rights or liabilities now existing under such sections or parts thereof shall not be affected by this repeal.

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| | | 2 | | 376 | 35 | 33. |
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| June 15 | 249 | | 64 | 215 | 35 | 78. |

[1] The part relating to the granting of patents to Government employees without fees.
[2] The part relating to certified copies of drawings and specifications.
[3] The part relating to fees for recording assignments.
[4] The part amending R. S. 4894.
[5] The part relating to the price of copies of patents.
[6] The part relating to payment of fees.
[7] The part relating to the fee for copies of specifications and drawings of patents.

LEGISLATIVE INTENT SERVICE (800) 666-1917

LEGISLATIVE INTENT SERVICE (800) 666-1917

82D CONGRESS
1ST SESSION

# H. R. 3760

## A BILL

To revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents".

By Mr. BRYSON

APRIL 18, 1951

Referred to the Committee on the Judiciary

X re HR 3760

United States
*of* America

# Congressional Record

PROCEEDINGS AND DEBATES OF THE 82d CONGRESS, FIRST SESSION

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LEGISLATIVE INTENT SERVICE (800) 666-1917

UNITED STATES GOVERNMENT PRINTING OFFICE, WASHINGTON, 1951

# HISTORY OF BILLS AND RESOLUTIONS

## SENATE BILLS

S. 1—To provide for the common defense by establishing a universal training program, and for other purposes.
Mr. Russell, Mr. Byrd, Mr. Chapman, Mr. Johnson of Texas, Mr. Kefauver, Mr. Hunt, Mr. Bridges, Mr. Saltonstall, Mr. Morse, Mr. Knowland, Mr. Cain, and Mr. Malone; Committee on Armed Services, 86.—Reported with amendments (S. Rept. 117), 1418.—Debated, 1527, 1563, 1590, 1599, 1652, 1673, 1709, 1710, 1723, 1757, 1763, 1778, 1897, 1920, 1925, 1970, 1977, 1978, 1981, 1986, 2042, 2058, 2068, 2032, 2160, 2168.—Amended and passed Senate, 2207.—Referred to House Committee on Armed Services, 2303.—Reported with amendment (H. Rept. 271), 2521.—Made special order (H. Res. 171), 3198, 3199.—Debated, 3205, 3297, 3366, 3406, 3588, 3673, 3752, 3877.—Amended and passed House, 3914.—House insists on its amendment and asks for a conference, 3915.—Conferees appointed, 3915.—Senate disagrees to House amendment and agrees to a conference, 3934.—Conferees appointed, 3938.—Conference report (No. 535) submitted in Senate, 5988.—Conference report submitted in House, 6010.—Conference report agreed to in Senate, 6026.—House agrees to conference report, 6252.—Examined and signed, 6281, 6283.—Presented to the President, 6284.—Approved [Public Law 51], 6780.

S. 2—To authorize the Secretary of the Interior to issue patents for certain lands to certain settlers in the Pyramid Lake Indian Reservation, Nev.
Mr. McCarran; Committee on Interior and Insular Affairs, 86.

S. 3—To provide for Federal loans and grants for the construction, remodeling, improvement, and extension of school facilities.
Mr. McCarran; Committee on Labor and Public Welfare, 86.

S. 4—To supersede the provisions of Reorganization Plan No. 3 of 1946 by reestablishing the offices of registers of land offices, and providing for appointment of the Director and Associate Director of the Bureau of Land Management, and for other purposes.
Mr. McCarran; Committee on Expenditures in the Executive Departments, 86.

S. 5—To provide for research into and demonstration of practical means for the economical production, from sea or other saline waters, or from the atmosphere (including cloud formations), of water suitable for agricultural, industrial, municipal, and other beneficial consumptive uses, and for other purposes.
Mr. O'Mahoney; Committee on Interior and Insular Affairs, 86.

S. 6—To aid in preventing shortages of petroleum and petroleum products in the United States by promoting the production of synthetic liquid fuels.
Mr. McCarran; Committee on Interior and Insular Affairs, 86.

S. 7—To amend the Civil Aeronautics Act of 1938, as amended, to provide for the merger and the consolidation of international air carriers for the United States, and for other purposes.
Mr. McCarran and Mr. Brewster; Committee on Interstate and Foreign Commerce, 86.

S. 8—To create an independent Air Safety Board.
Mr. McCarran; Committee on Interstate and Foreign Commerce, 86.

S. 9—To amend the Civil Aeronautics Act of 1938, as amended, to provide for the regulation of noncertificated air carriers and contract air carriers, and for other purposes.
Mr. McCarran; Committee on Interstate and Foreign Commerce, 86.

S. 10—Providing for the issuance of certificates of statutory compliance with certain national standards to certain corporations, trade associations, and labor organizations engaged in or affecting commerce.
Mr. O'Mahoney; Committee on Interstate and Foreign Commerce, 86.

S. 11—To provide for the appointment of committees to conserve the assets of persons of advanced age, mental weakness, or physical incapacity.
Mr. McCarran; Committee on the District of Columbia, 86.—Reported with amendments (S. Rept. 171), 2363.—Amended and passed Senate, title amended, 3625.—Referred to House Committee on the District of Columbia, 3806.—Reported back (H. Rept. 631), 6840.—Passed House, amended, title amended, 7076.—Senate disagrees to House amendments and asks for a conference, 8505.—Conference appointed, 8505.—House insists on its amendments and agrees to a conference, 9353.—Conferees appointed, 9353.—Conference report (No. 1026) submitted in House and agreed to, 12265.—Conference report submitted in Senate and agreed to, 13215.—Examined and signed, 13320, 13405.—Presented to the President, 13409.—Approved [Public Law 196], 13732.

S. 12—To amend the Civil Aeronautics Act of 1938, as amended.
Mr. McCarran; Committee on Interstate and Foreign Commerce, 86.

S. 13—To permit the sale of gold within the United States, its Territories and possessions, including Alaska, and for other purposes.
Mr. McCarran; Committee on Banking and Currency, 86.

S. 14—To improve the administration of justice by the creation of an Administrative Court of the United States.
Mr. McCarran; Committee on the Judiciary, 86.

S. 15—To amend section 215 of title 18 of the United States Code.
Mr. McCarran; Committee on the Judiciary, 86.—Reported back (S. Rept. 3), 351.—Passed Senate, 717.—Referred to House Committee on the Judiciary, 840.—

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S. 16—To provide for payment of an annuity to widows of judges.
Mr. McCarran; Committee on the Judiciary, 86.—Reported with amendment (S. Rept. 716), 10662.—Objected to, 12391, 12945.

S. 17—To provide general rules of practice and procedure before Federal agencies.
Mr. McCarran; Committee on the Judiciary, 86.—Reported with amendments (S. Rept. 413), 6332.—Amended and passed Senate, 6854.—Referred to House Committee on the Judiciary, 7007.

S. 18—To authorize suits against the United States to adjudicate and administer water rights.
Mr. McCarran; Committee on the Judiciary, 86.—Reported with amendments (S. Rept. 755), 11416.—Objected to, 12391, 12947.

S. 19—To establish uniform qualifications for jurors in the Federal courts.
Mr. McCarran; Committee on the Judiciary, 86.

S. 20—To provide for the use of 25 percent of grazing receipts from national forests for the making of range improvements within such forests.
Mr. McCarran; Committee on Agriculture and Forestry, 66.

S. 21—To amend the War Claims Act of 1948 so as to provide for the payment of certain tort claims to employees of contractors with the United States.
Mr. McCarran; Committee on the Judiciary, 86.

S. 22—To amend the Internal Revenue Code, as amended, and the Federal Alcohol Administration Act, as amended.
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S. 23—For the relief of William D. Norris.
Mr. McCarran; Committee on the Judiciary, 86.

S. 24—To amend the act entitled "An act to provide better facilities for the enforcement of the customs and immigration laws," approved June 20, 1930, as amended.
Mr. McCarran; Committee on the Judiciary, 86.—Reported back (S. Rept. 289), 4135.—Passed Senate, 4849.—Referred to House Committee on Public Works, 5066.—Reported back (H. Rept. 899), 10419.—Passed House, 11484.—Examined and signed, 11509, 11572.—Presented to the President, 11509.—Approved [Public Law 154], 12206.

S. 25—To amend an act entitled "An act to establish a uniform system of bankruptcy throughout the United States," approved July 1, 1898, and acts amendatory thereof and supplementary thereto.
Mr. McCarran; Committee on the Judiciary, 86.



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S. Res. 197—Relating to the proposed plans to consolidate veterans' activities for the east coast into a single district office in Philadelphia, Pa.
Mr. Ives, Mr. Lehman, Mr. Lodge, and Mr. Saltonstall; Committee on Finance, 10592.

S. Res. 198—Increasing the limit of expenditures by the Committee on the Judiciary relating to the internal security of the United States.
Mr. McCarran, from Committee on the Judiciary (S. Rept. 718) and referred to Committee on Rules and Administration, 10662.—Reported with amendment (S. Rept. 841), 12208.—Amended and passed Senate, 12208.

S. Res. 199—Relative to the death of Representative Frank Fellows, of Maine.
Mrs. Smith of Maine; considered and agreed to, 10679.

S. Res. 200—Favoring retaliatory action against newspaper correspondents from Communist countries.
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S. Res. 202—Authorizing the Committee on Armed Services to employ additional personnel.
Mr. Russell; Committee on Rules and Administration, 11017.—Reported with amendment (no written report), 11216.—Amended and passed Senate, 11216.

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S. Res. 204—Increasing the limit of expenditures by the Committee on Appropriations.
Mr. McKellar; Committee on Rules and Administration, 11115.—Reported, considered, and agreed to, 12208.

S. Res. 205—Providing for the printing of the Interstate Commerce Act, with supplementary and related acts.
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S. Res. 206—Extending the authority and increasing the limit of expenditures for the investigation of personnel needs and practices of governmental departments and agencies.
Mr. Johnston of South Carolina, Mr. Monroney, Mr. Smathers, Mr. Langer, Mr. Carlson, and Mr. Welker; Committee on Post Office and Civil Service, 11119.—Reported back (S. Rept. 740) and referred to Committee on Rules and Administration, 11216.—Reported with amendment (S. Rept. 937), 12932.—Amended and passed Senate, 13084.

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Mr. Capehart, Mr. Brewster, Mr. Tobey, Mr. Kem, Mr. Williams, and Mr. Bricker; Committee on Interstate and Foreign Commerce, 11161.

S. Res. 208—Opposing limitations on the telecasting of events of general interest to the general public.
Mr. Hendrickson; Committee on Interstate and Foreign Commerce, 11161.

S. Res. 209—Increasing the limit of expenditures by the Committee on Rules and Administration.
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S. Res. 210—To investigate certain activities of officers and employees of the Department of Agriculture.
Mr. Kem, Mr. Schoeppel, Mr. Welker, Mr. Hendrickson, Mr. Ferguson, Mr. Martin, Mr. Wherry, Mr. Aiken, Mr. Butler of Nebraska, Mr. Ives, Mr. Bricker, Mr. Bennett, Mr. Butler of Maryland, Mr. Capehart, Mr. Langer, Mr. Malone, and Mr. Flanders; Committee on Agriculture and Forestry, 11425.

S. Res. 211—Citing Herman Orman for contempt of the Senate.
Mr. O'Conor, from Special Committee to Investigate Organized Crime in Interstate Commerce (S. Rept. 777), 11490.—Passed Senate, 12406.

S. Res. 212—Citing Patrick Joseph Size for Contempt of the Senate.
Mr. O'Conor, from Special Committee to Investigate Organized Crime in Interstate Commerce (S. Rept. 778), 11490.—Passed Senate, 12407.

S. Res. 213—Citing Joseph C. Baldassari for contempt of the Senate.
Mr. O'Conor, from Special Committee to Investigate Crime in Interstate Commerce (S. Rept. 779), 11490.—Passed Senate, 12407.

S. Res. 214—Citing Joseph Scalleat for contempt of the Senate.
Mr. O'Conor, from Special Committee to Investigate Crime in Interstate Commerce (S. Rept. 780), 11490.—Passed Senate, 12407.

S. Res. 215—To appoint a committee to discuss problems of common interest with the Consultative Assembly of the Council of Europe.
Mr. Wiley; Committee on Foreign Relations, 12023.—Reported back (S. Rept. 889) and referred to Committee on Rules and Administration, 12573.—Reported with amendment (S. Rept. 938), 12933.—Amended and passed Senate, 12933.

S. Res. 216—To refer to the Court of Claims the bill (S. 1051) for the relief of Thomas Barron.
Mr. McCarran, from Committee on the Judiciary (S. Rept. 882), 12385.—Ordered to be placed on the calendar, 12385.—Passed Senate, 12954.

S. Res. 217—To investigate applications filed with the Secretary of the Interior for approval of certain leases for submerged oil lands.
Mr. Malone; Committee on Interior and Insular Affairs, 12431.

S. Res. 218—To investigate the rate of matériel shipments by the United States to the North Atlantic Treaty Organization forces.
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S. Res. 219—Increasing the limit of expenditures by the Committee on Foreign Relations.
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S. Res. 220—Relative to the death of Representative Stefan, of Nebraska.
Mr. Butler of Nebraska and Mr. Wherry; considered and agreed to, 12556.

S. Res. 221—To amend rule XXVII relative to authority of conferees.
Mr. Ferguson; Committee on Rules and Administration, 12756.

S. Res. 222—To print for the use of the Senate document room a certain number of copies of Senate Document 69, Eighty-second Congress, relative to views on the military situation in the Far East.
Mr. Bridges; Committee on Rules and Administration, 13060.

S. Res. 223—To investigate the administration of the post office at Vancouver, Wash.
Mr. Cain; Committee on Post Office and Civil Service, 13087.

S. Res. 224—To refer to the Court of Claims the bill (S. 122) for the relief of the Ann Arbor Construction Co.
Mr. McCarran; from Committee on the Judiciary (S. Rept. 262), 13211.—Ordered placed on Senate Calendar, 13211.—Passed Senate, 13550.

S. Res. 225—Favoring increased allocations of steel, copper, and aluminum for construction of schools and hospitals.
Mr. Humphrey, Mr. Moody, and Mr. Knowland; ordered to lie on the table, 13356.—Amended and passed Senate; title amended, 13445.

S. Res. 226—Requesting the President to proceed with the negotiation of a treaty of peace with Germany.
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S. Res. 227—Establishing a Special Committee To Coordinate Refugee Relief.
Mr. Nixon, Mr. Knowland, Mr. Brewster, Mr. Bridges, Mr. Carlson, Mr. Hendrickson, Mr. Ives, Mr. Monroney, Mr. O'Conor, Mr. Smathers, Mr. Wiley, and Mr. Bennett; Committee on the Judiciary, 13496.

S. Res. 228—Extending the best wishes of the Senate to Senator Wherry, of Nebraska, for a speedy recovery from his present illness.
Mr. McFarland and Mr. Saltonstall; considered and agreed to, 13666.

S. Res. 229—To investigate the proposed reorganization of the Missouri Pacific Railroad Co.
Mr. Johnson of Colorado, Mr. McMahon, Mr. Connally, Mr. Johnson of Texas, Mr. Kefauver, Mr. Tobey, Mr. Long, Mr. Wherry, Mr. Kerr, Mr. Monroney, Mr. Stennis, Mr. Carlson, Mr. McClellan, Mr. Eastland, and Mr. Butler of Nebraska; Committee on Interstate and Foreign Commerce, 13662.

S. Res. 230—Felicitating former Senator Joseph E. Ransdell, of Louisiana, on the occasion of his ninety-third birthday.
Mr. Ellender; considered and agreed to, 13710.

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Mr. Rankin; Committee on Veterans' Affairs, 22.—Reported with amendment (H. Rept. 6), 433.—Made special order (H. Res. 83), 617.—Debated, amended,

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and passed House, 618.—Referred to Senate Committee on Finance, 663.—Reported with amendments (S. Rept. 91), 1278.—Debated, 1452, 1466, 1515,

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H. R. 3749—To provide for the granting of financial aid to Israel.
Mr. Corbett; Committee on Foreign Affairs, 4022.

H. R. 3750—Prohibiting lithographing or engraving on envelopes sold by the Post Office Department, and for other purposes.
Mr. Hagen; Committee on Post Office and Civil Service, 4022.

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Mr. Staggers; Committee on the Judiciary, 4023.

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Mr. Crosser; Committee on Interstate and Foreign Commerce, 4110.

H. R. 3756—To revise, codify, and enact into law title 2 of the United States Code entitled "The Congress."
Mr. Bryson; Committee on the Judiciary, 4110.

H. R. 3757—To revise, codify, and enact into law title 20 of the United States Code entitled "Education."
Mr. Bryson; Committee on the Judiciary, 4110.

H. R. 3758—To revise, codify, and enact into law title 21 of the United States Code entitled "Food and Drugs."
Mr. Bryson; Committee on the Judiciary, 4110.

H. R. 3759—To revise, codify, and enact into law title 23 of the United States Code entitled "Highways."
Mr. Bryson; Committee on the Judiciary, 4110.

H. R. 3760—To revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents."
Mr. Bryson; Committee on the Judiciary, 4111.

H. R. 3761—To amend the Tariff Act of 1930 to provide for the free importation of twine used for baling hay, straw, and other fodder and bedding material.
Mr. Harvey; Committee on Ways and Means, 4111.

H. R. 3762—To establish the Federal Agency for Handicapped, to define its duties, and for other purposes.
Mr. Havenner; Committee on Education and Labor, 4111.

H. R. 3763—To amend the Communications Act of 1934 so as to require that ferryboats and other passenger ships navigating certain bays and sounds shall, unless fitted with radiotelegraph installations, be fitted with radiotelephone installations.
Mr. Havenner; Committee on Interstate and Foreign Commerce, 4111.

H. R. 3764—To amend the act of June 21, 1940, relating to the alteration of certain bridges over navigable waters, so as to include highway bridges, and for other purposes.
Mr. McCormack; Committee on Interstate and Foreign Commerce, 4111.—Committee on Interstate and Foreign Commerce discharged, and referred to the Committee on Public Works, 6181.

H. R. 3765—To provide for overtime compensation for employees of the United States Public Health Service, Foreign Quarantine Division.
Mr. Murphy; Committee on Post Office and Civil Service, 4111.

H. R. 3766—To authorize the leasing of restricted Indian lands in the State of California for public, religious, educational, recreational, business, residential, and other purposes requiring the grant of long-term leases.
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H. R. 3767—To provide for a per capita payment from funds in the Treasury of the United States to the credit of the Indians of California.
Mr. Poulson; Committee on Interior and Insular Affairs, 4111.

H. R. 3768—To repeal provisions of the Social Security Act which require State plans for old-age assistance, aid to dependent children, aid to the blind, and aid to the permanently and totally disabled, to restrict the use of disclosure of information concerning applicants and recipients to purposes directly connected with the administration of such plans.
Mr. Reed of New York; Committee on Ways and Means, 4111.

H. R. 3769—To establish the Federal Agency for Handicapped, to define its duties, and for other purposes.
Mr. Rhodes; Committee on Education and Labor, 4111.

H. R. 3770—For the relief of Alfreda Alfieri.
Mr. Buckley; Committee on the Judiciary, 4111.

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Mr. Fogarty; Committee on the Judiciary, 4111.

H. R. 3772—For the relief of Cecil Lennox Elliott.
Mr. Forand; Committee on the Judiciary, 4111.—Reported back (H. Rept. 749), 8621.—Laid on the table (S. 1282 passed in lieu), 9534.

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Mr. Javits; Committee on the Judiciary, 4111.

H. R. 3775—For the relief of Dr. Orlando Artuso and family.
Mr. Kelley of Pennsylvania; Committee on the Judiciary, 4111.

H. R. 3776—For the relief of Equitable Infants Wear, Inc.
Mr. Klein; Committee on the Judiciary, 4111.

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H. R. 3778—For the relief of Wong See Sun.
Mr. Poulson; Committee on the Judiciary, 4111.

H. R. 3779—For the racially ineligible fiancée of a United States citizen veteran of World War II.
Mr. Ribicoff; Committee on the Judiciary, 4111.

H. R. 3780—For the relief of Mr. and Mrs. Earnest Merl Kersh.
Mr. Williams of Mississippi; Committee on the Judiciary, 4111.

H. R. 3781—Relating to the promotion of veterans of World War II in the field service of the Post Office Department.
Mr. Anfuso; Committee on Post Office and Civil Service, 4131.

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Mr. Byrnes of Wisconsin; Committee on Interior and Insular Affairs, 4132.—Reported back (H. Rept. 642), 7090.—Passed House, 7587.—Referred to Senate Committee on Interior and Insular Affairs, 7613.—Reported with amendment (S. Rept. 585), 8989.—Amended and passed Senate, 9696.—House concurs in Senate amendment, 9806.—Examined and signed, 9842, 0913.—Presented to the President, 9913.—Approved [Public Law 118], 10366.

H. R. 3783—To redefine the term "employee of the Government," as used in chapter 171 of title 28, United States Code (relating to tort claims procedure), so as to include within such term certain caretakers employed by the National Guard.
Mr. Davis of Wisconsin; Committee on the Judiciary, 4132.

H. R. 3784—To provide for the transfer of the Spanish-Mexican Land Grant Papers to the custody of the secretary of State of California.
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H. R. 3785—To amend title 18, United States Code, to increase the criminal penalty provided for persons convicted of gathering or delivering certain defense information to aid a foreign government in time of peace.
Mr. Kearney; Committee on the Judiciary, 4132.

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H. R. 3787—Conferring jurisdiction upon the United States District Court for the Western District of Wisconsin to hear, determine, and render judgment upon the claims of Stanley J. Nietupski and Sarah Jane Nietupski.
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Mr. Mitchell; Committee on the Judiciary, 4132.

H. R. 3789—For the relief of Roosevelt Pollard, the General Exchange Insurance Corp., and Fred Warren.
Mr. O'Brien of Michigan; Committee on the Judiciary, 4132.—Reported back (H. Rept. 840), 0841.—Passed House, 10473.—Referred to Senate Committee on the Judiciary, 10498.

H. R. 3790—Making appropriations for the Department of the Interior for the fiscal year ending June 30, 1952, and for other purposes.
Mr. Kirwan; Committee on Appropriations, 4132.—Reported back (H. Rept. 339), 4222.—Debated, 4191, 4281, 4360, 4620, 4730.—Amended and passed House, 4755.—Referred to Senate Committee on Appropriations, 4766.—Reported with amendments (S. Rept. 499), 7570.—Debated, 7617, 7633, 7643, 7656, 7699, 7716, 7769, 7774, 7790, 7840, 7843, 7864, 7868, 7941, 7057, 8019, 8043, 8116, 8131.—Amended and passed Senate, 8139.—Senate insists on its amendments and asks for a conference, 8139.—Conferees appointed, 8130.—House disagrees to Senate amendments and agrees to a conference, 8415.—Conferees appointed, 8415.—Conference report (No. 775) submitted in House, 9217.—House recommitted conference report, 9221.—Conference report (No. 888) submitted in House and agreed to, 10203.—Conference report submitted in Senate and agreed to, 10316.—Examined and signed, 10418, 10420.—Presented to the President, 10494.—Approved [Public Law 136], 11198.



LEGISLATIVE INTENT SERVICE (800) 666-1917

# PATENT LAW CODIFICATION AND REVISION

# HEARINGS

BEFORE

## SUBCOMMITTEE NO. 3 OF THE COMMITTEE ON THE JUDICIARY HOUSE OF REPRESENTATIVES

EIGHTY-SECOND CONGRESS

FIRST SESSION

ON

# H. R. 3760

A BILL TO REVISE AND CODIFY THE LAWS RELATING TO PATENTS AND THE PATENT OFFICE, AND TO ENACT INTO LAW TITLE 35 OF THE UNITED STATES CODE ENTITLED "PATENTS"

JUNE 13, 14, AND 15, 1951

**Serial No. 9**

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# PATENT LAW CODIFICATION AND REVISION

WEDNESDAY, JUNE 13, 1951

HOUSE OF REPRESENTATIVES,
SUBCOMMITTEE NO. 3 OF THE COMMITTEE ON THE JUDICIARY,
*Washington, D. C.*

The subcommittee met at 10 a. m. pursuant to notice, the Honorable Joseph R. Bryson (subcommittee chairman) presiding, for consideration of H. R. 3760, which is as follows:

[H. R. 3760, 82d Cong., 1st sess.]

A BILL To revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents"

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That title 35 of the United States Code, entitled "Patents", is revised, codified, and enacted into law, and may be cited, "Title 35, United States Code, section—", as follows:

## TITLE 35—PATENTS


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### CHAPTER 1—PATENT OFFICE


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### § 1. Establishment

The Patent Office shall continue as an office in the Department of Commerce where records, books, drawings, specifications, and other papers and things



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pertaining to patents and to trade-mark registrations shall be kept and preserved, except as otherwise provided by law.

**§ 2. Seal**

The Patent Office shall have a seal with which letters patent, certificates of trade-mark registrations, and papers issued from the Office shall be authenticated.

**§ 3. Officers and employees**

A Commissioner of Patents, one first assistant commissioner, two assistant commissioners, and nine examiners-in-chief, shall be appointed by the President, by and with the advice and consent of the Senate. The assistant commissioners shall perform the duties pertaining to the office of commissioner assigned to them by the Commissioner The first assistant commissioner, or the assistant commissioner senior in date of appointment in the event of a vacancy in the office of first assistant commissioner, shall fill the office of Commissioner during a vacancy in that office until a Commissioner is appointed and takes office. All other officers, clerks, and employees shall be appointed by the Secretary of Commerce upon the nomination of the Commissioner in accordance with law.

**§ 4. Restrictions on officers and employees as to interest in patents**

Officers and employees of the Patent Office shall be incapable, during the period for which they hold their appointments and one year thereafter, of applying for a patent and of acquiring, directly or indirectly, except by inheritance or bequest, any patent or any right or interest in any patent, issued or to be issued by the Office. In patents applied for thereafter they shall not be entitled to any priority date earlier than one year after the termination of their appointment.

**§ 5. Bond of Commissioner and other officers**

The Commissioner and such other officers as he designates, before entering upon their duties, shall severally give bond, with sureties, the former in the sum of $10,000, and the latter in sums prescribed by the Commissioner, conditioned for the faithful discharge of their respective duties and that they shall render to the proper officers of the Treasury a true account of all money received by virtue of their offices.

**§ 6. Duties of Commissioner**

The Commissioner, under the direction of the Secretary of Commerce, shall superintend or perform all duties required by law respecting the granting and issuing of patents and the registration of trade-marks; and he shall have charge of property belonging to the Patent Office. He may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

**§ 7. Board of Appeals**

The examiners-in-chief shall be persons of competent legal knowledge and scientific ability. The Commissioner, the assistant commissioners, and the examiners-in-chief shall constitute a Board of Appeals, which, on written appeal of the applicant, shall review adverse decisions of examiners upon applications for patents. Each appeal shall he heard by at least three members of the Board of Appeals, the members hearing such appeal to be designated by the Commissioner. The Board of Appeals has sole power to grant rebearings.

Whenever the Commissioner considers it necessary to maintain the work of the Board of Appeals current, he may designate any patent examiner of the primary examiner grade or higher, having the requisite ability, to serve as examiner-in-chief for periods not exceeding six months each. An examiner so designated shall be qualified to act as a member of the Board of Appeals. Not more than one such primary examiner shall be a member of the Board of Appeals hearing an appeal.

**§ 8. Library**

The Commissioner shall maintain a library of scientific and other works and periodicals, both foreign and domestic, in the Patent Office to aid the officers in the discharge of their duties.

**§ 9. Classification of patents**

The Commissioner may revise and maintain the classification by subject matter of United States letters patent, and such other patents and printed publications as may be necessary or practicable, for the purpose of determining

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with readiness and accuracy the novelty of inventions for which applications for patent are filed.

**§ 10. Certified copies of records**

The Commissioner may furnish certified copies of specifications and drawings of patents issued by the Patent Office, and of other records available either to the public or to the person applying therefor.

**§ 11. Publications**

(a) The Commissioner may print, or cause to be printed, the following:

1. Patents, including specifications and drawings, together with copies of the same. The Patent Office may multigraph the headings of the drawings for patents for the purpose of photolithography.
2. Certificates of trade-mark registrations, including statements and drawings, together with copies of the same.
3. The Official Gazette of the United States Patent Office.
4. Annual indexes of patents and patentees, and of trade-marks and registrants.
5. Annual volumes of decisions in patent and trade-mark cases.
6. Pamphlet copies of the patent laws and rules of practice, laws and rules relating to trade-marks, and circulars or other publications relating to the business of the Office.

(b) The Commissioner may exchange any of the publications specified in items 3, 4, 5, and 6 of subsection (a) of this section for publications desirable for the use of the Patent Office.

**§ 12. Exchange of copies of patents with foreign countries**

The Commissioner may exchange copies of specifications and drawings of United States patents for those of foreign countries.

**§ 13. Copies of patents for public libraries**

The Commissioner may supply printed copies of specifications and drawings of patents to public libraries in the United States which shall maintain such copies for the use of the public, at the rate for each year's issue established for this purpose in section 41 (a) 9 of this title.

**§ 14. Annual report to Congress**

The Commissioner shall report to Congress annually the moneys received and expended, statistics concerning the work of the Office, and other information relating to the Office as may be useful to the Congress or the public.

PROCEEDINGS IN THE PATENT OFFICE

**§ 21. Day for taking action falling on Saturday, Sunday, or holiday**

When the day, or the last day, for taking any action or paying any fee in the United States Patent Office falls on Saturday, Sunday, or a holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding secular or business day.

**§ 22. Printing of papers filed**

The Commissioner may require papers filed in the Patent Office to be printed or typewritten.

**§ 23. Testimony in Patent Office cases**

The Commissioner may establish rules for taking affidavits and depositions required in cases in the Patent Office. Any officer authorized by law to take depositions to be used in the courts of the United States, or of the State where he resides, may take such affidavits and depositions.

**§ 24. Subpoenas, witnesses**

The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent Office shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent Office.

Every witness subpoenaed and in attendance shall be allowed the fees and traveling expenses allowed to witnesses attending the United States district courts.

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A judge of a court whose clerk issued a subpoena may, on proof of the neglect or refusal of a witness, after being duly served with such subpoena, to appear, or after appearing, to testify, enforce obedience to the process or punish the disobedience as in other like cases. No witness shall be deemed guilty of contempt for disobeying such subpoena unless his fees and traveling expenses in going to, and returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret matter except upon appropriate order of the court which issued the subpoena.

PRACTICE BEFORE PATENT OFFICE

**§ 31. Regulations for agents and attorneys**

The Commissioner, subject to the approval of the Secretary of Commerce, may prescribe regulations governing the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Patent Office, and may require them, before being recognized as representatives of applicants or other persons, to show that they are of good moral character and reputation, are possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office.

**§ 32. Suspension or exclusion from practice**

The Commissioner may, after notice and opportunity for a hearing, suspend or exclude, either generally or in any particular case, from further practice before the Patent Office, any person, agent, or attorney shown to be incompetent or disreputable, or guilty of gross misconduct, or who does not comply with the regulations established under section 31 of this title, or who shall, with intent to defraud, deceive, mislead, or threaten any applicant or prospective applicant, or other person having immediate or prospective business before the Office. The reasons for any such suspension or exclusion shall be duly recorded. The United States District Court for the District of Columbia, under such conditions and upon such proceedings as it by its rules determines, may review the action of the Commissioner upon the petition of the person so refused recognition or so suspended or excluded.

**§ 33. Unauthorized representation as practitioner**

Whoever, not being recognized to practice before the Patent Office, holds himself out or permits himself to be held out as so recognized, or as being qualified to prepare or prosecute applications for patent, shall be fined not more than $1,000 for each offense.

PATENT FEES

**§ 41. Patent fees**

(a) The Commissioner shall charge the following fees:

1. On filing each application for an original patent, except in design cases, $30, and $1 for each claim in excess of twenty.

2. On issuing each original patent, except in design cases, $30, and $1 for each claim in excess of twenty.

3. In design cases: For three years and six months, $10; for seven years, $15; for fourteen years, $30.

4. On every application for the reissue of a patent, $30 and $1 for each claim in excess of twenty over and above the number of claims of the original patent.

5. On filing each disclaimer, $10.

6. On an appeal for the first time from the examiner to the Board of Appeals, $25.

7. On filing each petition for the revival of an abandoned application for a patent or for the delayed payment of the fee for issuing each patent, $10.

8. For certificate of correction of applicant's mistake under section 205 of this title, $10

9. For uncertified printed copies of specifications and drawings of patents (except design patents), 25 cents per copy; for design patents, 10 cents per copy; special rate for libraries specified in section 13 of this title, $50 for patents issued in one year.

10. For recording every assignment, agreement, or other paper not exceeding six pages, $3; for each additional two pages or less, $1; for each additional patent or application included in one writing, where more than one is so included, 50 cents additional.

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11. For each certificate, $1.

(b) The Commissioner may establish charges for copies of records, publications, or services furnished by the Patent Office, not specified above.

### § 42. Payment of patent fees; return of excess amounts

All patent fees shall be paid to the Commissioner who shall deposit the same in the Treasury of the United States in such manner as the Secretary of the Treasury directs, and the Commissioner may refund any sum paid by mistake or in excess of the fee required by law.

## CHAPTER 2—PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS

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DEFINITIONS

### § 100. Definitions

When used in this title unless the context otherwise indicates—

(a) The term "invention" includes discoveries.

(b) The term "process" includes method, and a new use of a known process, machine manufacture, composition of matter or material.

(c) The terms "United States" and "this country" mean the United States of America, its territories and possessions.

(d) The word "patentee" includes not only the patentee to whom the patent was issued but also the successors in title to the patentee.

PATENTABILITY OF INVENTIONS

### § 101. Inventions patentable

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof,

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may obtain a patent therefor, subject to the conditions and requirements of this title.

**§ 102. Conditions for patentability; novelty and loss of right to patent**

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country or patented or described in any printed publication in this or any foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in any printed publication in this or any foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than six months in design cases or twelve months in other cases before the filing of the application in the United States, or

(e) the invention was described in an application for patent by another filed in the United States before the invention thereof by the applicant for patent, which first-mentioned application issued as a patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was in fact made in this country by another who had not abandoned it and who was using reasonable diligence in this country in reducing it to practice or had reduced it to practice.

**§ 103. Conditions for patentability; non-obvious subject matter**

A patent may not be obtained though the invention is not identically disclosed or described in the prior art set forth in section 102 of this title, if the differences between the subject matter sought to be patented and that prior art such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made

**§ 104. Invention made abroad**

In proceedings in the Patent Office and in the courts, an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country, except as provided in section 119 of this title. Where an invention was made by a person, civil, or military, while domiciled in the United States and serving in a foreign country in connection with operations by or on behalf of the United States, he shall be entitled to the same rights of priority with respect to such invention as if the same had been made in the United States.

APPLICATION FOR PATENT

**§ 111. Application for patent**

Application for patent shall be made by the inventor, except as otherwise provided in this title, in writing to the Commissioner. Such application shall include: (1) a specification as prescribed by section 112 of this title; (2) a drawing as prescribed by section 113 of this title; and (3) an oath by the applicant as prescribed by section 115 of this title. The application must be signed by the applicant and accompanied by the fee required by law.

**§ 112. Specification**

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying ont his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure or acts in support thereof and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

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**§ 113. Drawings**

When the nature of the case admits, the applicant shall furnish a drawing.

**§ 114. Models, specimens**

The Commissioner may require the applicant to furnish a model of convenient size to exhibit advantageously the several parts of his invention.

When the invention relates to a composition of matter, the Commissioner may require the applicant to furnish specimens or ingredients for the purpose of inspection or experiment.

**§ 115. Oath of applicant**

The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition, or improvement thereof, for which he solicits a patent; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by certificate of a diplomatic or consular officer of the United States, and such oath shall be valid if it complies with the laws of the state or country where made. When the application is made as provided in this title by a person other than the inventor, the oath may be so varied in form that it can be made by him.

**§ 116. Joint inventors**

When an invention is made by two or more persons jointly, they shall apply for patent jointly and each sign the application and make the required oath, except as otherwise provided in this title.

If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Commissioner, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor making the application, subject to the same rights which the omitted inventor would have had if he had been joined. The omitted inventor may subsequently join in the application.

Whenever a person is joined in an application for patent as joint inventor through error, or a joint inventor is not included in an application through error, and such error arose without any deceptive intention, the Commissioner may permit the application to be amended accordingly, under such terms as he prescribes.

**§ 117. Death or incapacity of inventor**

The Commissioner may receive applications of and issue patents to legal representatives of deceased inventors and of those under legal incapacity, upon compliance with the requirements and on the same terms and conditions applicable to the inventor.

**§ 118. Filing by other than inventor**

Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed to assign the invention in writing, or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage; and the Commissioner may grant a patent to such inventor upon such notice to him as the Commissioner deems sufficient, and on compliance with such regulations as he prescribes.

**§ 119. Benefit of earlier filing date in foreign country; right of priority**

An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest

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date on which such foreign application was filed; but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing.

No application for patent shall be entitled to this right of priority unless a claim therefor and a certified copy of the original foreign application, specification and drawings upon which it is based are filed in the Patent Office before the patent is granted, or at such time during the pendency of the application as required by the Commissioner, not earlier than six months after the filing of the application in this country. Such certification shall be made by the patent office of the foreign country in which filed and show the date of the application and of the filing of the specification and other papers. The Commissioner may require a translation of the papers filed if not in the English language and such other information as he deems necessary.

**§ 120. Benefit of earlier filing date in the United States**

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States by the same inventor shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or any application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

**§ 121. Divisional applications**

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions; and the other invention or inventions may be made the subject of divisional applications. A divisional application shall be entitled to the benefit of the filing date of the original application if it complies with the requirements of section 120 of this title. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent Office or in the courts against a divisional application or against the original application or any patent issued on either of them, for the purposes of section 103 of this title if the divisional application is filed before the issuance of the patent. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Commissioner may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Commissioner to require the application to be restricted to one invention.

**§ 122. Confidential status of applications**

Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner.

EXAMINATION OF APPLICATION

**§ 131. Examination of application**

The Commissioner shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Commissioner shall issue a patent therefor.

**§ 132. Notice of rejection; reexamination**

Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

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**§ 133. Time for prosecuting application**

Upon failure of the applicant to prosecute the application within six months (or such shorter time, not less than thirty days, as shall be fixed by the Commissioner, and the applicant notified thereof in writing) after any action therein, of which notice shall have been given or mailed to the applicant, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

**§ 134. Appeal to the Board of Appeals**

An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the examiner to the Board of Appeals, having once paid the fee for such appeal.

**§ 135. Interferences**

Whenever, an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of three examiners of interferences whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office

No claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may be made in any application unless such a claim is made within one year from the date on which said patent was granted.

REVIEW OF PATENT OFFICE DECISIONS

**§ 141. Appeal to Court of Customs and Patent Appeals**

An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Customs and Patent Appeals, thereby waiving his right to proceed under section 145 of this title. A party to an interference dissatisfied with the decision of the board of interference examiners on the question of priority may appeal to the United States Court of Customs and Patent Appeals, but such appeal shall be dismissed if any adverse party to such interference shall, within twenty days after the appellant has filed notice of appeal according to section 142 of this title, files notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 146 of this title. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under section 146, in default of which the decision appealed from shall govern the further proceedings in the case.

**§ 142. Notice of appeal**

When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and shall file in the Patent Office his reasons of appeal, specifically set forth in writing, within such time after the date of the decision appealed from, not less than sixty days, as the Commissioner appoints.

**§ 143. Proceedings on appeal**

The United States Court of Customs and Patent Appeals shall, before hearing such appeal, give notice of the time and place of the hearing to the Commissioner and the parties thereto. The Commissioner shall transmit to the court certified copies of all the necessary original papers and evidence in the case specified by the appellant and any additional papers and evidence specified by the appellee and in an ex parte case the Commissioner shall furnish the court with the grounds of the decision of the Patent Office, in writing, touching all the points involved by the reasons of appeal.

**§ 144. Decision on appeal**

The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent Office, and the decision shall be confined to the points set forth in the reasons of appeal.

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Upon its determination the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and govern the further proceedings in the case.

**§ 145. Civil action to obtain patent**

An applicant dissatisfied with the decision of the Board of Appeals may, unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

**§ 146. Civil action in case of interference**

Any party to an interference dissatisfied with the decision of the board of interference examiners on the question of priority, may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the Commission appoints or as provided in section 141 of this title, unless he has appealed to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided. In such suits the record in the Patent Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent Office when admitted shall have the same effect as if originally taken and produced in the suit.

Such suit may be instituted against the party in interest as shown by the records of the Patent Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs. The Commissioner shall not be a necessary party but he shall be notified of the filing of the suit by the clerk of the court in which it is filed and shall have the right to intervene. Judgment of the court in favor of the right of an applicant to a patent shall authorize the Commissioner to issue such patent on the filing in the Patent Office of a certified copy of the judgment and on compliance with the requirements of law.

ISSUE OF PATENT

**§ 151. Time of issue of patent**

The patent shall issue within three months from the date of the payment of the final fee, which shall be paid not later than six months after written notice to the applicant of allowance of the application, but the Commissioner may accept the final fee if paid within one year after the six months' period for payment, and the patent shall issue.

**§ 152. Issue of patent to assignee**

Patents may be granted to the assignee of the inventor of record in the Patent Office, upon the application made and the specification sworn to by the inventor, except as otherwise provided in this title.

**§ 153. How issued**

Patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Commissioner or have his signature placed thereon and attested by an officer of the Patent Office designated by the Commissioner, and shall be recorded in the Patent Office.

**§ 154. Contents and term of patent**

Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the right to exclude others from making, using, or selling the invention throughout the United

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States, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof.

## CHAPTER 3—PATENTS AND PROTECTION OF PATENT RIGHTS

### AMENDMENT AND CORRECTION OF PATENTS

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### AMENDMENT AND CORRECTION OF PATENTS

### § 201. Reissue of defective patents

Whenever any patent through error is deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, without any deceptive intention, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Commissioner may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of original patent

### § 202. Effect of reissue

The surrender of the original patent shall take effect upon the issue of the reissued patent, and every reissued patent shall have the same effect and operation in law, on the trial of actions for causes thereafter arising, as if the same had been originally granted in such amended form, but in so far as the claims of the original and reissued patents are identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent, to the extent that its claims are identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent.

No reissued patent shall abridge or affect the right of any person or his

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successors in business who made, purchased or used prior to the grant of a reissue anything patented by the reissued patent, to continue the use of, or to sell to others to be used or sold, the specific thing so made, purchased or used, if the making, using or selling of such thing does not infringe a valid claim of the reissued patent which was in the original patent.

The court before which such matter is in question may provide for the continued manufacture, use or sale of such thing made, purchased or used as specified in the preceding paragraph hereof, or for the manufacture, use or sale of which substantial preparation was made before the grant of the reissue, and it may also provide for the continued practice of any process patented by the reissue, practiced, or for the practice of which substantial preparation was made, prior to the grant of the reissue, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before the grant of the reissue.

**§ 203. Disclaimer**

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid, and the patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, and recorded in the Patent Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

**§ 204. Certificate of correction of Patent Office mistake**

Whenever a mistake in a patent, incurred through the fault of the Patent Office, is clearly disclosed by the records of the Office, the Commissioner may issue a certificate of correction stating the fact and nature of such mistake, under seal, without charge, to be recorded in the records of patents. A printed copy thereof shall be attached to each printed copy of the patent, and such certificate shall be considered as part of the original patent. Every such patent, together with such certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form. The Commissioner may issue a corrected patent without charge in lieu of and with like effect as a certificate of correction.

**§ 205. Certificate of correction of applicant's mistake**

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Commissioner may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require re-examination. Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form.

**§ 206. Misjoinder of inventor**

Whenever a patent is issued on the application of persons as joint inventors and it appears that one of such persons was not in fact a joint inventor, and that he was included as a joint inventor by error and without any deceptive intention, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate deleting the name of the erroneously joined person from the patent.

Whenever a patent is issued and it appears that a person was a joint inventor, but was omitted by error and without any deceptive intention, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate adding his name to the patent as a joint inventor.

The misjoinder or nonjoinder of joint inventors shall not invalidate a patent, if such error can be corrected as provided in this section The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Commissioner shall issue a certificate accordingly.

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OWNERSHIP AND ASSIGNMENT

**§ 211. Ownership; assignment**

Subject to the provisions of this title, patents shall have the applicable rights of personal property.

Aplications for patent, patents, or any interest therein, shall be assignable in law by an instrument in writing. The applicant, patentee, or his assigns or legal representatives may in like manner grant and convey an exclusive right under his application for patent, or patents, to the whole or any specified part of the United States.

A certificate of acknowledgment under the hand and official seal of a person authorized to administer oaths within the United States, or, in a foreign country, of a diplomatic or consular officer of the United States or an officer authorized to administer oaths whose authority is proved by a certificate of a diplomatic or consular officer of the United States, shall be prima facie evidence of the execution of an assignment, grant or conveyance of an application for patent or patents.

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 its date, or prior to the date of such subsequent purchase or mortgage.

**§ 212. Joint owners**

In the absence of any agreement to the contrary, each of the joint owners of a patent may make, use or sell the patented invention without the consent of and without accounting to the other owners, but neither of the owners may grant licenses or assign his interest, or any part thereof, without the consent of the other owners or without accounting to them.

GOVERNMENT INTERESTS IN PATENTS

**§ 221. Issue of patents without fees to Government employees**

The Commissioner may grant, subject to the provisions of this title, to any officer, enlisted man, or employee of the Government, except officers and employees of the Patent Office, a patent without the payment of fees, when the head of a department or agency certifies the invention is used or likely to be used by or for the Government and the applicant in his application states that the invention described herein, if patented, may be manufactured and used by or for the Government for governmental purposes without the payment to him of any royalty thereon, which stipulation shall be included in the patent.

**§ 222. Time for taking action in Government applications**

Notwithstanding the provisions of sections 133, 145, and 151 of this title, the Commissioner may extend the time for taking any action to three years, when an application has become the property of the United States and the head of the appropriate department or agency of the Government has certified to the Commissioner that the invention disclosed therein is important to the armament or defense of the United States.

INFRINGEMENT OF PATENTS

**§ 231. Infringement of patent**

(a) Except as otherwise provided in this title, whoever without authority makes, uses or sells any patented invention, within the United States during the term of the patent therefor, infringes the patent.

(b) Whoever actively induces infringement of a patent shall be liable as an infringer.

(c) Whoever knowingly sells a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use shall be liable as a contributory infringer.

(d) No patent owner otherwise entitled to relief for infringement or contributory infringement of a patent shall be denied relief or deemed guilty of misuse or illegal extension of the patent right by reason of his having done one or more of the following: (1) derived revenue from acts which if performed by another without his consent would constitute contributory infringement of the patent; (2) licensed or authorized a person to perform acts which if performed without his consent would constitute contributory infringement of the patent; (3) sought to enforce his patent rights against infringement or contributory infringement.

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**§ 232. Temporary presence in the United States**

The use of any invention in any vessel, aircraft, or vehicle of any country which affords similar privileges to vessels, aircraft, or vehicles of the United States, entering the United States temporarily or accidentally, shall not constitute infringement of any patent, if the invention is used exclusively for the needs of the vessel, aircraft, or vehicle and is not sold in or used for the manufacture of anything to be sold in or exported from the United States.

REMEDY FOR INFRINGEMENT OF PATENT, AND OTHER ACTIONS

**§ 241. Remedy for infringement of patent**

A patentee shall have remedy by civil action for infringement of his patent.

**§ 242. Presumption of validity; defenses**

A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it

The following shall be defenses to any action involving the validity or infringement of a patent and shall be pleaded:

(1) Noninfringement or absence of liability for infringement,

(2) Invalidity of the patent or any claim thereof on any ground specified in chapter 2 of this title as a condition for patentability,

(3) Failure to comply with any requirement of sections 112 or 201 of this title,

(4) Any other fact or act made a defense by this title.

In actions involving the validity of infringement of a patent the party asserting invalidity or noninfringement shall give notice in the pleadings or otherwise in writing to the adverse party at least thirty days before the trial, of the country, number, date, and name of the patentee of any patent, the title, date, and page numbers of any publication to be relied upon as anticipations of the patent in suit or, except in actions in the United States Court of Claims, as showing the state of the art, and the name and address of any person who may be relied upon as the prior inventor or as having prior knowledge of or as having previously used or offered for sale the invention of the patent in suit In the absence of such notice proof of the said matters may not be made at the trial except on such terms as the court requires.

**§ 243. Injunction**

The several courts having jurisdiction of cases under this title may grant injunctions in accordance with the principles of equity to prevent the violation of any right secured by patent, on such terms as the court deems reasonable.

**§ 244. Damages**

Upon adjudging a patent valid and infringed, the court shall award the claimant damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court.

When the damages are not found by a jury the court shall assess them. In either event the court may increase the damages up to three times the amount found or assessed.

The court may receive expert testimony as an aid to the determination of damages or of what royalty would be reasonable under the circumstances.

**§ 245. Attorney fees**

The court in exceptional cases may award reasonable attorney fees to the prevailing party

**§ 246. Time limitation on damages**

Except as otherwise provided by law, no recovery shall be had for any infringement committed more than six years prior to the filing of the complaint or counterclaim for infringement in the action.

**§ 247. Limitation on damages; marking and notice**

Patentees, and persons making or selling any patented article for or under them, may give notice to the public that the same is patented, either by fixing thereon the word "patent" or the abbreviation "pat.", together with the number of the patent, or when, from the character of the article, this cannot be done, by fixing to it, or to the package wherein one or more of them is contained, a label containing a like notice. In the event of failure so to mark, no damages shall be

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recovered by the patentee in any action for infringement, except on proof that the infringer was notified of the infringement and continued to infringe thereafter, in which event damages may be recovered only for infringement occurring after such notice. Filing of an action for infringement shall constitute such notice.

**§ 248. Action for infringement of a patent containing an invalid claim**

Whenever, without deceptive intention, a claim of a patent is invalid, an action may be maintained for the infringement of a claim of the patent which may be valid. The patentee shall recover no costs unless a disclaimer of the invalid claim has been entered at the Patent Office before the commencement of the suit.

**§ 249. Notice of patent suits**

The clerks of the courts of the United States, within one month after the filing of an action under this title shall give notice thereof in writing to the Commissioner, setting forth so far as known the names and addresses of the parties, name of the inventor, and the designating number of the patent upon which the action has been brought. If any other patent is subsequently included in the action he shall give like notice thereof. Within one month after the decision is rendered or a judgment issued the clerk of the court shall give notice thereof to the Commissioner, and the Commissioner shall, on receipt of such notice, forthwith, enter the same in the file of such patent.

**§ 250. Interfering patents**

The owner of an interfering patent may have relief against the owner of another by civil action, and the court may adjudge the question of the validity of any of the interfering patents, in whole or in part. The provisions of the second paragraph of section 146 of this title shall apply to actions brought under this section.

**§ 251. False marking**

(a) Whoever, without the consent of the patentee, marks upon, or affixes to, or uses in advertising in connection with anything made, used, or sold by him, the name or any imitation of the name of the patentee, the patent number, or the words "patent," "patentee," or the like, with the intent of counterfeiting or imitating the mark of the patentee, or of deceiving the puhlic and inducing them to believe that the thing was made or sold by or with the consent of the patentee; or

Whoever marks upon, or affixes to, of uses in advertising in connection with any unpatented article, the word "patent" or any word or number importing that the same is patented, for the purpose of deceiving the public; or

Whoever marks upon, or affixes to, or uses in advertising in connection with any article, the words "patent applied for," "patent pending," or any word importing that an application for patent has been made, when no application for patent has been made, or if made, is not pending, for the purpose of deceiving the public—

Shall be fined not more than $500 for every such offense.

(b) Any person may sue for the penalty, in which event one-half shall go to the person suing and the other to the use of the United States.

**§ 252. Nonresident patentee; service and notice**

Every patentee not residing in the United States may file in the Patent Office a written designation stating the name and address of a person residing within the United States on whom may be served process or notice of proceedings affecting the patent or rights thereunder. If the person designated cannot be found at the address given in the last designation, or if no person has been designated, the United States District Court for the District of Columbia shall have jurisdiction and summons shall be served by publication or otherwise as the court directs. The court shall have the same jurisdiction to take any action respecting the patent or rights thereunder that it would have if the patentee were personally within the jurisdiction of the court.

## CHAPTER 4—PLANTS AND DESIGNS

### PLANTS

Sec
301. Patents for plants.
302. Description, claim.
303. Grant.
304. Assistance of Department of Agriculture.

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DESIGNS

311. Patents for designs.
312. Right of priority
313 Term of design patent
314. Additional remedy for infringement of design patent.

PLANTS

**§ 301. Patents for plants**

Whoever invents or discovers and asexually reproduces any distinct and new variety of plant, other than a tuberpropagated plant, may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for plants, except as otherwise provided.

**§ 302. Description, claim**

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible.

The claim in the specification shall be in formal terms to the plant shown and described.

**§ 303. Grant**

In the case of a plant patent the grant shall be of the right to exclude others from asexually reproducing the plant or selling the plant so reproduced.

**§ 304. Assistance of Department of Agriculture**

The President may by Executive order direct the Secretary of Agriculture, in accordance with the requests of the Commissioner, to carry into effect the provisions of this title with respect to plants, (1) to furnish available information of the Department of Agriculture, (2) to conduct through the appropriate bureau or division of the Department research upon special problems, or (3) to detail to the Commissioner officers and employees of the Department.

DESIGNS

**§ 311. Patents for designs**

Whoever invents any new, original, and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

**§ 312. Right of priority**

The right of priority provided for by section 119 of this title shall be six months in the case of designs.

**§ 313. Term of design patent**

Patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant, in his application, elects.

**§ 314. Additional remedy for infringement of design patent**

Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit, but not less than $250, recoverable in any United States district court having jurisdiction of the parties.

Nothing in this section shall prevent, lessen, or impeach any other remedy which an owner of an infringed patent has under the provisions of this title, but he shall not twice recover the profit made from the infringement.

SEC. 2. Section 21 of the Act approved July 5, 1946, 60 Stat. 435 (United States Code, title 15, sec. 1071, 1946 ed.), is amended by changing "Revised Statutes 4911" appearing in said section to read "35 United States Code, section 141"; by changing "section 4915, Revised Statutes," appearing in said section to read "35 United States Code, sections 145 and 146"; and by changing "Revised Statutes 4915" appearing twice in said section to read "35 United States Code, section 146."

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SEC. 3. If any provision of Title 35, as enacted by section 1 hereof, is declared unconstitutional or is held invalid, the validity of the remainder of this title shall not be affected.

SEC. 4. (a) This Act shall take effect on January 1, 1952, and shall apply to all applications for patent filed on or after such date and to all patents granted on such applications. It shall apply to further proceedings on applications pending on such date and to patents granted on such applications except as otherwise provided. It shall apply to unexpired patents granted prior to such date except as otherwise provided.

(b) Section 102 (d) of Title 35, as enacted by section 1 hereof, shall not apply to existing patents and pending applications, but the law previously in effect, namely, the first paragraph of R. S. 4887 (U. S. Code, title 35, sec. 32, first paragraph, 1946 ed.), shall apply to such patents and applications.

(c) Section 119, second paragraph, of Title 35, as enacted by section 1 hereof, shall not apply to existing patents.

(d) The period of one year specified in section 102 of Title 35 as enacted by section 1 hereof shall not apply in the case of applications filed before August 5, 1940, and patents granted on such applications, and with respect to such applications and patents, said period is two years instead of one year.

(e) Nothing contained in Title 35, as enacted by section 1 hereof, shall operate to nullify any judicial finding on the validity of any patent by a court of competent jurisdiction.

(f) Nothing in Title 35, as enacted by section 1 hereof, shall affect any provision of the Atomic Energy Act of 1946 (Aug. 1, 1946, ch. 724, 60 Stat. 755).

SEC. 5. The sections or parts thereof of the Revised Statutes or Statutes at Large enumerated in the following schedule are hereby repealed. Any rights or liabilities now existing under such sections or parts thereof shall not be affected by this repeal.

| Revised Statutes | U. S. Code, 1946 edition | |
|---|---|---|
| | Title | Section |
| Section: | | |
| 475 | 35 | 1 |
| 476 | 35 | 2 |
| 478 | 35 | 3 |
| 479 | 35 | 5 |
| 480 | 35 | 4 |
| 481 | 35 | 6 |
| 482 | 35 | 7 |
| 483 | 35 | 6 |
| 486 | 35 | 10 |
| 487 | 35 | 11 |
| 488 | 35 | 12 |
| 489 | 35 | 13 |
| 493 | 35 | 78 |
| 494 | 35 | 20 |
| 495 | 35 | 17 |
| 496 | 35 | 19 |
| 4883 | 35 | 39 |
| 4884 | 35 | 40 |
| 4885 | 35 | 41 |
| 4886 | 35 | 31 |
| 4887 | 35 | 32 |
| 4888 | 35 | 33 |
| 4889 | 35 | 34 |
| 4890 | 35 | 34 |
| 4891 | 35 | 34 |
| 4892 | 35 | 35 |
| 4893 | 35 | 36 |
| 4894 | 35 | 37 |
| 4895 | 35 | 44 |
| 4896 | 35 | 46 |
| 4898 | 35 | 47 |

| Revised Statutes | U. S. Code, 1946 edition | |
|---|---|---|
| | Title | Section |
| Section—Continued | | |
| 4899 | 35 | 48 |
| 4900 | 35 | 49 |
| 4901 | 35 | 50 |
| 4903 | 35 | 51 |
| 4904 | 35 | 52 |
| 4905 | 35 | 53 |
| 4906 | 35 | 54 |
| 4907 | 35 | 55 |
| 4908 | 35 | 56 |
| 4909 | 35 | 57 |
| 4911 | 35 | 59a |
| 4912 | 35 | 60 |
| 4913 | 35 | 61 |
| 4914 | 35 | 62 |
| 4915 | 35 | 63 |
| 4916 | 35 | 64 |
| 4917 | 35 | 65 |
| 4918 | 35 | 66 |
| 4919 | 35 | 67 |
| 4920 | 35 | 69 |
| 4921 | 35 | 70 |
| 4922 | 35 | 71 |
| 4923 | 35 | 72 |
| 4929 | 35 | 73 |
| 4930 | 35 | 76 |
| 4931 | 35 | 77 |
| 4933 | 35 | 73 |
| 4934 | 35 | 78 |
| 4935 | 35 | 79 |
| 4936 | 35 | 79 |

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| Statutes at Large | | | | | U. S. Code, 1946 edition | |
|---|---|---|---|---|---|---|
| Date | Chapter | Section | Volume | Page | Title | Section |
| 1883—Mar. 3 | 143 | Part [1] | 22 | 625 | 35 | 45. |
| 1887—Feb 4 | 105 | 1 | 24 | 387 | 35 | 74. |
| | | 2 | 24 | 388 | 35 | 75. |
| 1888—Feb 18 | 15 | | 25 | 40 | 35 | 39. |
| 1891—Mar 3 | 541 | 1 part [2] | 26 | 989 | 35 | 14. |
| 1896—May 19 | 204 | | 29 | 124 | 35 | 78. |
| 1897—Mar. 3 | 391 | 1 | 29 | 692 | 35 | 31. |
| | | 2 | | 692 | 35 | 69. |
| | | 3 | | 693 | 35 | 32. |
| | | 4 | | 693 | 35 | 37. |
| | | 5 | | 693 | 35 | 47. |
| | | 6 | | 694 | 35 | 70. |
| | | 7 | | 694 | 35 | 48 |
| 1898—June 10 | 423 | 1 | 30 | 440 | 35 | 6 note. |
| 1899—Feb 28 | 227 | | 30 | 915 | 35 | 46. |
| 1902—Apr. 11 | 417 | | 32 | 95 | 35 | 39. |
| May 9 | 783 | | 32 | 193 | 35 | 73. |
| 1903—Mar 3 | 1019 | 1 | 32 | 1225 | 35 | 32 |
| | | 2 | | [1226] | 35 | 35. |
| | | 3 | | 1226 | 35 | 46. |
| 1908—May 23 | 188 | | 35 | 245 | 35 | 46. |
| May 23 | 189 | | 35 | 246 | 35 | 41. |
| May 27 | 200 | 1 part [3] | 35 | 343 | 35 | 78 |
| 1915—Jan 14 | Pub. Res. 61. | | 38 | 1221 | 35 | 15. |
| Mar. 3 | 94 | 1 | 38 | 958 | 35 | 33 |
| | | 2 | | 959 | 35 | 34. |
| 1916—Feb 15 | 22 | 1 | 39 | 8 | 35 | 2. |
| 1916—July 6 | 225 | 1 part [4] | 39 | 348 | 35 | 37. |
| 1919—Nov. 4 | 93 | 1 part [5] | 41 | 335 | 35 | 78. |
| 1920—Mar 6 | 94 | 1 part [6] | 41 | 512 | 35 | 79. |
| 1921—Mar 3 | 126 | 1 | 41 | 1313 | 35 | 80. |
| | | 2 | | 1314 | 35 | 81. |
| | | 3 | | 1314 | 35 | 82. |
| | | 4 | | 1314 | 35 | 83. |
| | | 5 | | 1314 | 35 | 84. |
| | | 6 | | 1314 | 35 | 85. |
| | | 7 | | 1314 | 35 | 86. |
| | | 8 | | 1315 | 35 | 87. |
| 1922—Feb. 18 | 58 | | | | | |
| | | 3 | 42 | 390 | 35 | 11 |
| | | 5 | | 391 | 35 | 39 |
| | | 6 | | 391 | 35 | 47 |
| | | 7 | | 391 | 35 | 54 |
| | | 8 | | 392 | 35 | 70 |
| | | 9 | | 393 | 35 | 78 |
| 1925—Mar. 4 | 535 | 1 | 43 | 1268 | 35 | 88 |
| 1927—Feb. 7 | 67 | | 44 | 1058 | 35 | 49 |
| Feb 14 | 139 | 1 | 44 | 1098 | 35 | 2. |
| | | 2 | | 1099 | 35 | 78. |
| Mar. 2 | 273 | 1 | 44 | 1335 | 35 | 37 |
| | | 3 | | 1335 | 35 | 7 |
| | | 4 | | 1336 | 35 | 52. |
| | | 5 | | 1336 | 35 | 57. |
| | | 8 | | 1336 | 35 | 59a. |
| | | 9 | | 1336 | 35 | 60 |
| | | 10 | | 1336 | 35 | 61. |
| | | 11 | | 1336 | 35 | 63 |
| | | 12 | | 1337 | 35 | 66 |
| | | 13 | | 1337 | 35 | 78 |
| | | 14 | | 1337 | 35 | 21. |
| 1927—Mar 3 | 364 | | 44 | 1394 | 35 | 72a. |
| 1928—Apr 30 | 460 | | 45 | 467 | 35 | 45 |
| May 24 | 730 | | 45 | 732 | 35 | 64. |
| May 31 | 992 | 1 | 45 | 1012 | 35 | 40a |
| | | 2 | | 1013 | 35 | 40b |
| | | 3 | | 1013 | 35 | 40c |
| | | 4 | | 1014 | 35 | 40d |
| 1929—Mar. 2 | 488 | 2b | 45 | 1476 | 35 | 59a, 60, 63. |
| 1930—Apr. 11 | 132 | 1 | 46 | 155 | 35 | 2 |
| | | 2 | | 155 | 35 | 7 |
| | | 3 | | 155 | 35 | 78. |
| | | 5 | | 156 | 35 | 22 |
| | | 6 | | 156 | 35 | 23. |
| May 23 | 312 | 1 | 46 | 376 | 35 | 31, 40. |
| | | 2 | | 376 | 35 | 33 |
| | | 3 | | 376 | 35 | 35 |
| | | 4 | | 376 | 35 | 56a. |
| | | 5 | | 376 | 35 | 32a. |
| | | 6 | | 376 | 35 | 32b. |
| 1932—June 30 | 314 | 308 | 47 | 410 | 35 | 78 |
| | | 309 | | 410 | 35 | 78 |

See footnotes at end of table.

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| Statutes at Large | | | | | U. S. Code, 1946 edition | |
|---|---|---|---|---|---|---|
| Date | Chapter | Section | Volume | Page | Title | Section |
| 1936—June 19 | 94 | | 49 | 1529 | 35 | 32. |
| 1938—May 9 | 188 | | 52 | 342 | 35 | 11a. |
| 1939—Aug. 5 | 450 | 1 | 53 | 1212 | 35 | 31, 32, 69, 73. |
| | | 2 | | 1212 | 35 | 31 note |
| Aug. 5 | 451 | 1 | 53 | 1212 | 35 | 52. |
| | | 2 | | 1212 | 35 | 67. |
| | | 3 | | 1212 | 35 | 59a. |
| | | 4 | | 1212 | 35 | 63 |
| Aug. 5 | 452 | 1 | 53 | 1213 | 35 | 51. |
| Aug. 7 | 568 | | 53 | 1264 | 35 | 37 |
| Aug. 9 | 619 | 2 | 53 | 1293 | 35 | 41 |
| | | 3 | | 1293 | 35 | 78 |
| 1941—Aug. 18 | 370 | | 55 | 634 | 35 | 47. |
| 1946—July 5 | 541 | 301 part [7] | 60 | 471 | 35 | 78. |
| Aug. 1 | 726 | | 60 | 778 | 35 | 70 |
| Aug. 8 | 910 | 9 | 60 | 943 | 35 | 109. |
| 1950—Mar. 4 | 50 | | 64 | 11 | 35 | 7. |
| June 15 | 249 | | 64 | 215 | 35 | 78 |

[1] The part relating to the granting of patents to Government employees without fees.
[2] The part relating to certified copies of drawings and specifications
[3] The part relating to fees for recording assignments.
[4] The part amending R. S. 4894.
[5] The part relating to the price of copies of patents.
[6] The part relating to payment of fees.
[7] The part relating to the fee for copies of specifications and drawings of patents.

Present: Representatives Bryson, Ramsay, Boggs, Rogers, Crumpacker, and Bakewell.

Also present: Charles J. Zinn, law revision counsel, Committee on the Judiciary; L. James Harris, committee counsel, Committee on the Judiciary.

Mr. BRYSON. Gentlemen, the committee will come to order, and as our friend Congressman Jennings used to say, "We hate to find ourselves like an Egyptian mummy, pressed for time."

We received a telegram this morning from the Democratic whip, Hon. Percy Priest, that we would be expected to be on the floor, and the House meets at 12 o'clock. We will try to make some arrangements about it, however.

We are pleased to note the interest in this hearing; and we will proceed as expeditiously as possible.

The first witness on the schedule is our law revision counsel, Mr. Charles J. Zinn, who will now make a brief statement.

The acoustics in this room are not too good, and if some of you gentlemen have difficulty in hearing you might move up here and occupy some of the seats nearer to the front.

All right, Mr. Zinn.

## STATEMENT OF CHARLES J. ZINN, LAW REVISION COUNSEL, COMMITTEE ON THE JUDICIARY

Mr. ZINN. Mr. Chairman, I will make a brief preliminary statement regarding the background and objectives of this bill. As its title indicates the bill, H. R. 3760, is intended to revise and codify the laws relating to patents and enact into law title 35 of the United States Code entitled "Patents."

By a fortunate distribution of committee functions your subcommittee is charged both with the revision of the laws and with the consideration of bills relating to patents.

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This bill is part of the comprehensive program of revising and enacting into law all the titles of the United States Code. Up to the present time 9 out of the 50 titles of the code have been revised and enacted into law and the committee is now engaged in the consideration or preparation of bills relating to a number of additional titles.

The present patent laws consist of about 60 sections of the Revised Statutes of 1874, together with over 60 acts of Congress passed since that date amending various sections of the Revised Statutes or making new enactments not related to any section of the Revised Statutes.

Since the sections of the Revised Statutes relating to patents were merely a compilation of the act of 1870, our present patent law, which is set out in title 35 of the United States Code, is essentially the act of 1870 with subsequent enactments.

The last general revision of the patent laws was the act of July 8, 1870, which was part of a program to revise and consolidate all the laws of the United States. In 1866 Congress passed a law providing for the revision and consolidation of the statutes of the United States. The Commission which was appointed to perform this work prepared a preliminary draft of the part relating to patents and copyrights in 1868, and a second preliminary draft in 1869. The following year the statutes relating to patents and copyrights as revised, simplified, arranged, and consolidated by the Commission was reported to Congress, and at the same time referred to the Committee on Patents and a bill was introduced by the chairman a few days later.

The object of the Commission on Revision of the Laws was only to revise, arrange, and consolidate the statutes in force and the draft reported from the Commission presumably was for this purpose only.

The probable reason for referring the matter to the Committee on Patents was that during this same period there had been many suggestions for amending the patent laws in substance, and it appears that the Committee on Patents studied the draft of the Commission and changed it by various amendments on matters of substance. The bill thus introduced was enacted on July 8, 1870, 16 United States Statutes 198, and included the subjects of copyrights and trade-marks as well as patents.

When the Revised Statutes as in force on December 1, 1873, were enacted on June 22, 1874, the sections of the act of 1870 were distributed in various parts of the Revised Statutes.

For many years there was considerable agitation for a complete restatement and codification of all the laws of the United States inasmuch as the only such codification—the Revised Statutes of 1873—had become generally outmoded on all subjects.

In 1926, in response to widespread recognition of the need therefor, and after nearly 7 years' effort on the part of the Committee on the Revision of the Laws, the Congress adopted the United States Code, which was a codification of the existing general and permanent laws of the United States arranged in 50 titles according to subject matter, and which was declared to be prima facie evidence of the law.

Because of the enormity of that code Congress decided that it should undergo a testing period before it was enacted into positive law.

The code has now been subjected to such a testing period lasting 25 years, and the program of your committee enacting the titles into law has been in progress for several years.

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About 2 years ago it was suggested that since this subcommittee had jurisdiction over both the revision of the laws and the subject of patents we ought to undertake the preparation of the present bill.

The work was initiated by the preparation of a preliminary draft of a Proposed Revision and Amendment of the Patent Laws, which was printed and distributed in February of last year.

The preliminary draft included a collection of a large number of proposed amendments which had come to the attention of the Congress, as well as the codification itself. The preliminary draft was widely distributed with a request for criticisms and suggestions. As a result of the comments received, the committee decided to eliminate numerous proposed changes from the bill and defer them for later consideration, and to limit the bill to the main purpose of codification and enacting title 35 into law, with the further object of making a number of minor procedural and substantially noncontroversial changes.

Numerous suggestions were received by the committee from the patent bar and the public. Taking into consideration the suggestions and criticisms and other comments which had been received by the committee, a bill was prepared and introduced in the Eighty-first Congress, H. R. 9133, dated July 17, 1950. This bill was widely distributed and again comments were received by the committee from the patent bar and others. As a result of this material, the bill was reintroduced in revised form as the bill before us, H. R. 3760.

In the preparation of the draft leading to the present bill, all acts of Congress relating to or mentioning patents which have been enacted since 1874 were collected and studied, and those acts which had not been specifically repealed were used in preparing the drafts.

The changes introduced in the bill were obtained mainly by a study of all the bills relating to patents which had been introduced in Congress since 1925, and in addition the reports of various committees making studies of the patent laws, reports and recommendations of private groups, and other miscellaneous sources.

The committee as a matter of policy for a number of years has been calling on official and unofficial experts in the field to assist the committee, and our committee has been very fortunate in receiving the assistance of various persons like Mr. P. J. Federico of the Patent Office, and Captain Robillard of the Department of Defense; and the coordinating committee of the bar has rendered invaluable service to the committee in the preparation and study of the bill, and the report which will follow.

Mr. BRYSON. Thank you. Are there any questions?

## STATEMENT OF HENRY R. ASHTON, REPRESENTING THE COORDINATING COMMITTEE ON REVISION AND AMENDMENT OF THE PATENT LAWS OF THE NATIONAL COUNCIL OF PATENT LAW ASSOCIATIONS

Mr. BRYSON. Mr. Ashton, will you give the reporter your full name and address and in what capacity you now appear?

Mr. ASHTON. My name is Henry R. Ashton.

I appear in support of H. R. 3760 on behalf of the Coordinating Committee on Revision and Amendment of the Patent Laws, of which I am chairman.

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Mr. BRYSON. You may be seated if you like, Mr. Ashton.

Mr. ASHTON. Thank you.

Mr. BRYSON. Do you have a prepared statement?

Mr. ASHTON. Yes, I have, of which 40 copies have been supplied to you, and I have additional copies here if anyone wishes a copy.

Mr. BRYSON. Do you have any preference as to whether you be permitted to make your complete statement before any questions are asked, or would you like to have questions propounded as you go along?

Mr. ASHTON. I have no objection whatsoever to having questions asked as I go along. However, we might expedite it a little more if they were withheld to the end.

Mr. BRYSON. We do want to conserve time because we have a number of witnesses to be heard this morning.

Mr. ASHTON. Yes, sir.

Mr. BRYSON. And we have to be as rapid as possible; so you may proceed.

Mr. ASHTON. Thank you. The committee was organized February 8, 1950. The following patent law associations, patent committees of general bar associations, and industrial associations have been regularly represented on or have otherwise participated in the work of this committee:

National Council of Patent Law Associations
American Patent Law Association
American Bar Association, Patent Section
American Drug Manufacturing Association
Association of the Bar of City of New York, Patent Committee
Boston Patent Law Association
Chicago Patent Law Association
Cincinnati Patent Law Association
Cleveland Patent Law Association
Colorado Bar Association, Patent Section
Columbus Bar Association, Patent Committee
Connecticut Patent Law Association
Dayton Patent Law Association
District of Columbia Bar Association, Patent Section
Los Angeles Patent Law Association
Manufacturing Chemists Association
Michigan Patent Law Association
Milwaukee Patent Law Association
Minnesota Patent Law Association
National Association of Manufacturers
New Jersey Patent Law Association
New York Patent Law Association
Oregon Patent Law Association
Philadelphia Patent Law Association
Pittsburgh Patent Law Association
Rochester Patent Group
St. Louis Bar Association, Patent Section
San Francisco Patent Law Association
Seattle Patent Law Association
Toledo Patent Law Association

You will recall, Mr. Bryson, that on May 23, 1950, on the floor of the House of Representatives, you formally advised the House of the undertaking by your committee to revise and codify the patent laws. You called the attention of the House to your committee's now well-known committee print, which was prepared for and was issued by your committee on January 10, 1950, and which has served as the basis of all the work that has since been done, culminating in H. R. 3760 now under consideration. At the same time you very graciously made the following statement:

I am heartened by the manner in which the organized patent bar has come forward in a commendable and constructive fashion to help Congress in undertaking this formidable assignment. Your instantaneous cooperation has been one of the most dramatic evidences of the democratic process that I have had the pleasure of witnessing. With the attitude you have adopted I am confident that we shall perform a painstaking, objective study of the subject that will ultimately produce a body of laws which will serve our future as well as the present ones have served our past.

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And you further said with reference to the patent bar:

> If you learned gentlemen feel disposed to question the diligence of your legislators in considering your patent problems, lay it not to our lack of interest but rather to your own talented disagreement.

We in the National Council of Patent Law Associations were familiar with the much too frequent inability of the patent bar to agree on various proposals to amend the patent laws. Although it may be an overstatement to refer to some of our disagreements as "talented disagreements," they were nevertheless disagreements and sometimes made it exceedingly difficult if not impossible for your committee to obtain the enactment of constructive patent legislation.

Encouraged by the experience of the Trade-Mark Coordinating Committee which worked on the Lanham Act, the officers of National Council of Patent Law Associations, whose membership includes the 19 principal patent law associations in the country, called a meeting in Washington on February 8, 1950, for the purpose of forming a coordinating committee to coordinate the views of the patent law associations, other organizations, and individuals with respect to the proposed revision and amendment of the patent laws contained in your committee print.

Nearly all of the member associations sent representatives to this first meeting, and those present voted unanimously to form the coordinating committee. A drafting committee, consisting of Giles S. Rich, of New York, and Paul A. Rose, of Washington, D. C., was appointed at the same meeting and instructed—

> to prepare a revision and amendment of the patent laws based upon the committee print containing only such changes in existing laws as in the judgment of the drafting committee would meet with substantial approval of the patent profession.

A number of industrial associations then joined in the work of the coordinating committee. The committee print was subjected to thorough study by all the associations represented, and numerous reports and suggestions were sent to the drafting committee. These reports and suggestions were studied by the drafting committee which prepared a careful redraft representing its best judgment of those provisions that would meet with general approval. Seven hundred and fifty copies of this redraft were printed by our committee and distributed on April 14, 1950, to the legislative committees of the represented associations. At a second meeting of the coordinating committee held on May 9 and 10, 1950, this redraft was carefully considered section by section, was reprinted with the changes adopted at this 2-day meeting, and was then submitted to your committee. With the assistance of this redraft, H. R. 9133 was prepared by your committee and introduced in the House on July 17, 1950.

H. R. 9133 was widely distributed, our committee alone having distributed 4,000 copies to the patent profession and industry. H. R. 9133 was then subjected to close study by the legislative committees of our associations and by the associations themselves over a period of 6 months, which again submitted their reports to our drafting committee. The drafting committee not only studied these reports but also earlier bills to amend the patent law, such as the Wiley bill, S. 2518. In addition, it carefully examined the patent laws of other countries, including those of Great Britain and Canada. Based upon

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this thorough study, the drafting committee submitted proposals for changes in H. R. 9133 to a third meeting of the coordinating committee held on December 6 and 7, 1950. At this meeting H. R. 9133 was considered and voted upon section by section, and our resulting final draft was presented to your committee.

During the early spring of this year, and I think this is of great significance, this draft was subjected to the most thorough and careful scrutiny at a 3-day meeting here in Washington of the patent section of the American Bar Association, the results of which were also reported to your committee.

I may say a number of the most able patent lawyers in the country not only attended that meeting, but vigorously participated in it. As is well known to you, much additional work was then done by your law revision counsel, Mr. Zinn, and your counsel, Mr. Harris, which culminated in the introduction on April 18, 1951, of H. R. 3760, now under consideration

H. R. 3760 was promptly distributed to the 5,428 patent lawyers and agents registered to practice before the Patent Office, to the industrial associations, and other interested persons. Since April 18, 1951, H. R. 3760 has been carefully studied by the legislative committees of the several associations on our committee preparatory to a fourth coordinating committee meeting held in Washington on May 22, 1951. Thirty persons representing 27 associations attended this meeting. H. R. 3760 was considered section by section, and the relatively few changes which were favored have been communicated to your committee.

It should also be stated that all of the reports which have come to the coordinating committee or its drafting committee during the year and one-half of its existence have been made available to your committee through your committee's counsel.

It is my understanding that one of the "talented disagreements" of the patent bar on legislative matters prompted your committee to initiate this important program of revising and codifying the patent laws. In so doing your committee rendered a most valuable service to our country. You have afforded those most interested in a sound patent system an opportunity to demonstrate that they also have talent for a large measure of agreement, when the matter involved is of major importance. It is our earnest hope and belief that the National Council of Patent Law Associations, to which our coordinating committee owes its origin and whose good offices it employs, will in future stand ready to support the work of your committee by coordinated effort like that employed in helping to develop the bill now under consideration.

It can at least be said that in this instance we have worked effectively among ourselves and with your committee. Certainly no other piece of patent legislation has ever received such thorough consideration by as many qualified persons over such an extended period of time.

There is submitted herewith a list of the approximate membership of the several patent-law associations which have been represented on our committee or have otherwise cooperated with it. The total membership of these associations is nearly 5,000. I do not have available the number or names of the companies which are members of the industrial associations which have worked with our committee. Of

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the total companies represented in these associations, the small companies far outnumber the larger ones.

Several of our associations expect to present at these hearings their own reports and resolutions in support of H. R. 3760. However, I have been asked to present letters or resolutions from the other associations, copies of which are attached to my statement.

These resolutions are 18 in number. I have an extra copy of them which I can hand up to the committee. I would like to submit them, and with the chairman's permission I would like quickly to refer to two or three of them so that the committee will see exactly the character of them, if I may have that permission.

Mr. BRYSON. You may do that.

Mr. ASHTON. I woud like first to call attention to the resolution of the Chicago Patent Law Association. The letter is addressed to me, and it is dated June 6, 1951. It states:

> At a board meeting of our association today we unanimously passed the following resolution:
>
> "*Resolved*, That H. R. 3760 with the changes recommended by the coordinating committee of the National Council of Patent Law Associations at its meeting on May 22, 1951, be approved as a whole."
>
> As you may know, the present bill H. R. 3760 and its predecessor H. R. 9133 have been the subject of very intensive study by the Patent Law Association of Chicago. We conducted a series of symposia last year under the direction of several subcommittees appointed to consider various sections of the bill, which symposia were well attended by members of our association. Copies of the reports of each subcommittee were printed and distributed to all members of the association, and the final reports of our legislative committee and the board of managers were also printed and distributed to all our members.
>
> Similar subcommittees were again appointed this year for consideration of H. R. 3760. The above resolution therefore may be considered as representing the results of a most careful study by our association.

Now, that is a direct statement of the type of work which was conducted by every one of these associations.

The particular resolutions which I wish to present are the resolution of the Boston Patent Law Association, in addition to the Chicago resolution which I just read, the resolution of the Cleveland Patent Law Association; the resolution of the Colorado Bar Association; the resolution of the Columbus Bar Association; the resolution of the Connecticut Patent Law Association; the resolution and letter of the Dayton Patent Law Association; the resolution of the Los Angeles Patent Law Association; the resolution of the Michigan Patent Law Association, of the Milwaukee Patent Law Association, and the Minnesota Patent Law Association.

I do not know whether Mr. Levy plans to present the resolution of the New Jersey Patent Law Association. He apparently is not here, so I present, as I am authorized to do, the New Jersey Patent Law Association's resolution.

It may be that Mr. Neave later will have the opportunity to and wish to present the resolution of the New York Patent Law Association. I might quickly refer to that at this time. It is a resolution passed by the board of governors of that association on May 24, 1951, and states:

> *Resolved*, That the president of the New York Patent Law Association, acting on behalf of its board of governors, is authorized to endorse and to testify in support of the Bryson bill, H. R. 3760; he is also similarly authorized to endorse and support the recommendations finally made by the coordinating committee as valuable suggestions for improvement in the bill which should be included in it if possible.

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I also have the resolutions of the Philadelphia Patent Law Association; of the Pittsburgh Patent Law Association; of the St. Louis patent section of its bar association, and the resolution of the San Francisco Patent Law Association and of the Toledo Patent Law Association, which I now offer to the committee.

Mr. BRYSON. They will be included in the record.

(The matter referred to is as follows:)

THE BOSTON PATENT LAW ASSOCIATION,
*Boston, Mass., June 6, 1951.*

HENRY R. ASHTON, Esq.,
*New York, N. Y.*

DEAR SIR: At a meeting of the executive committee of the Boston Patent Law Association on June 5, 1951, it was—

"*Resolved*, That the executive committee of the Boston Patent Law Association fully supports the passage of H. R. 3760, preferably with the proposed changes adopted at the meeting of the coordinating committee on May 22, 1951."

Respectfully,

M. R. JENNEY, *Secretary.*

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THE PATENT LAW ASSOCIATION OF CHICAGO,
*June 6, 1951.*

MR. HENRY R. ASHTON,
*New York, N. Y.*

DEAR MR ASHTON: At a board meeting of our association today we unanimously passed the following resolution:

"*Resolved*, That H. R. 3760 with the changes recommended by the coordinating committee of National Council of Patent Law Associations at its meeting on May 22, 1951, be approved as a whole."

As you may know, the present bill H. R. 3760 and its predecessor H. R 9133 have been the subject of very intensive study by the Patent Law Association of Chicago. We conducted a series of symposia last year under the direction of several subcommittees appointed to consider various section of the bill, which symposia were well attended by members of our association. Copies of the reports of each subcommittee were printed and distributed to all members of the association, and the final reports of our legislative committee and the board of managers were also printed and distributed to all our members

Similar subcommittees were again appointed this year for consideration of H. R 3760 The above resolution therefore may be considered as representing the results of a most careful study by our association.

Yours very truly,

CLARENCE F. POOLE,
*Representative of the Patent Law Association of Chicago.*

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THE B. F. GOODRICH CO.,
*Akron, Ohio, May 31, 1951.*

Cleveland Patent Law Association. Approval of H. R. 3760.

HENRY R. ASHTON, Esq.,
*New York, N. Y.*

DEAR MR. ASHTON: At its annual meeting on May 29, 1951, the Cleveland Patent Law Association approved the following resolution:

"*Resolved*, That the Patent Law Association approves in principle the recodification of the patent laws set forth in the bill H. R. 3760 now pending in the House of Representatives subject to such corrections as are being made by the coordinating committee of the Council of Patent Law Associations."

I believe that this will give the assurance which you will wish to have for presentation to the House Judiciary Committee, while permitting correction of the various errors and ambiguities on which your committee has been working.

Very truly yours,

HAROLD S. MEYER,
*Chairman, Legislative Committee, the Cleveland Patent Law Association.*

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WHITEHEAD & VOGL,
*Denver, Colo., May 25, 1951.*

AMERICAN PATENT LAW ASSOCIATION,
*Washington, D. C.*

GENTLEMEN: The report of the Laws and Rules Committee on H. R. 3760, Eighty-second Congress was fully discussed by the patent section of the Colorado Bar Association at its meeting held on May 24, 1951, and the report was unanimously approved.

I was instructed by the meeting to advise you to this effect.

Yours very truly,

CARLE WHITEHEAD,
*Secretary, Patent Section, Colorado Bar Association.*

---

THE JEFFREY MANUFACTURING CO.,
*Columbus, Ohio, June 7, 1951.*

HENRY R. ASHTON, Esq.,
*New York, N. Y.*

DEAR SIR: The patent committee of the Columbus Bar Association, by unanimous action, recommends the passage of H R. 3760, with those changes approved by the coordinating committee of the National Council of Patent Law Associations

Very respectfully.

HARKER H HITTSON,
*Chairman, Patent Committee, Columbus Bar Association*

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RESOLUTION UNANIMOUSLY ADOPTED AT A FULL MEETING OF THE CONNECTICUT PATENT LAW ASSOCIATION ON MAY 24, 1951

*Resolved,* That the advisory committee of the coordinating committee on revision and amendment of the patent laws be empowered to represent the Connecticut Patent Law Association in behalf of the support of H. R. 3760 with such appropriate changes as in the discretion of said committee seem necessary in view of the activities of the coordinating committee and such opposition as may develop from unexpected and unanticipated sources as may be necessary to accomplish acceptance of this hill by Mr. Bryson's subcommittee.

THE CONNECTICUT PATENT LAW ASSOCIATION,
THOMAS A JOHNSON, *President.*

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THE DAYTON PATENT LAW ASSOCIATION,
*Dayton, Ohio, June 8, 1951.*

HENRY R. ASHTON, Esq.,
*New York, N. Y.*

DEAR MR. ASHTON: At the regularly scheduled meeting of the Dayton Patent Law Association which was held on June 8, the recommendations of the coordinating committee with respect to proposed changes in H. R 3760 were considered and approved in their entirety.

In other words, our association has gone on record as favoring the support of H. R. 3760 at the coming hearings, whether or not all of the changes proposed by the coordinating committee are made, but with the understanding that every effort should be made to have these changes adopted.

Yours very truly,

EDWIN S. DYBVIG, *Secretary.*

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PATENT LAW ASSOCIATION OF LOS ANGELES,
*June 5, 1951.*

HENRY R. ASHTON, Esq.,
*National Council of Patent Law Associations,*
*Washington, D. C.*

DEAR MR. ASHTON: Onr legislature committee has recommended, and I bave been authorized by our board of governors to say, that:

(1) The Patent Law Association of Los Angeles supports the passage of H. R. 3760 of the Eighty-second Congress; and



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(2) The Patent Law Association of Los Angeles approves the changes approved by your coordinating committee at its meeting in Washington on May 22, 1951, but delegates full authority to your committee to negotiate those changes.

Very truly yours,

LYNN L. STEELE.

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RESOLUTION OF THE BOARD OF DIRECTORS OF THE MILWAUKEE PATENT LAW ASSOCIATION, ADOPTED JUNE 8, 1951

*Resolved*, That the Board of Directors of the Milwaukee Patent Law Association adopt the following policy with respect to the Bryson bill (H. R. 3760):

That our association present a united front with the other patent organizations of America before the House Committee on the Judiciary, in endorsement of the Bryson bill, and that Henry R. Ashton, Esq., be authorized in his discretion, to so inform the House committee.

That advocacy of alternative legislation by our association, be for the present withheld, at least until the House develops its attitude toward the Bryson bill.

That, so long as the Bryson bill is treated as a mere "revisor's bill," largely noncontroversial, and thus appears likely to pass the House substantially in its present form, advocacy of alternative legislation continue to be withheld.

That, if the Bryson bill passes the House in substantially its present form, then advocacy of alternative legislation continue to be withheld, so long as final passage seems likely, but that we reserve the right to attempt to obtain the adoption by the Senate of such amendments as our legislative committee (subject to control by our board of directors) may deem necessary, however keeping such amendments to the smallest possible number.

That, if the Bryson bill be defeated in either the House or the Senate, or even merely becomes a controversial measure with serious opposition in either the House or the Senate, then we reserve the right to work for the introduction of alternative legislation

And that the secretary be instructed to mail a copy of his resolution at once to Mr. Ashton.

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THE MINNESOTA PATENT LAW ASSOCIATION,
*June 7, 1951.*

NATIONAL COUNCIL OF PATENT LAW ASSOCIATIONS,
*Washington, D. C.*

(Attention of Mr. Francis D. Stephens, chairman of committee on patent legislation.)

DEAR MR. STEPHENS: At the annual meeting of the Minnesota Patent Law Association on May 17, 1951, at which time the writer took over as president for the coming year, the resolution was passed approving H. R. 3760, now being considered by Congress.

In picking up the loose ends, the writer notes that no notification of this was forwarded to you; hence, this letter.

Yours very truly,

THE MINNESOTA PATENT LAW ASSOCIATION,
*Ralph F. Merchant, President.*

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RESOLUTION OF THE NEW JERSEY PATENT LAW ASSOCIATION, NEWARK, N. J., JUNE 1, 1951

*Resolved*, That the New Jersey Patent Law Association approves in principle the provisions of H. R. 3760 and the various sections therein, and, moreover, approves and adopts as its own views such modifications in H. R. 3760 as may be presented by the coordinating committee on revision and amendment of the patent laws of the National Council of Patent Law Associations; and be it

*Resolved further*, That spokesmen for said coordinating committee, in expressing the views of the coordinating committee at hearings with respect to said bill, are specifically recognized as setting forth the official views of the New Jersey Patent Law Association; and be it

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*Resolved further*, That the chairman of the legislation committee of the New Jersey Patent Law Association is hereby authorized to present this resolution in behalf of the New Jersey Patent Law Association.

MAURICE W. LEVY,
*Chairman of the Legislation Committee, New Jersey Patent Law Association.*

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THE PHILADELPHIA PATENT LAW ASSOCIATION,
*Philadelphia, Pa., June 8, 1951.*

HENRY R. ASHTON, Esq.
*National Council of Patent Law Associations,*
*Washington, D. C.*

DEAR MR. ASHTON: H. R. 3760, together with the amendments proposed by the coordinating committee in its most recent session, has been considered in detail by the legislative committee of this association, and in general by the board of governnors All members of both groups approve the bill as a whole. Eleven members of the legislative committee and five members of the board of governors approve it without qualification. The three remaining members of the legislative committee and the two remaining members of the board of governors, though approving the measure as a whole, express some reservation as to one or more specific points.

There has not been sufficient time to procure a vote from the entire membership of this association.

The only sections queried specifically were: As to substantive provision, sections 203, 231, and 248. As to matters of terminology, sections 100, 102, 116, and 122. Mr. Klein, chairman of the legislative committee, is writing to you with reference to these sections.

Yours very truly,

ARTHUR SYNNESTVEDT, *President.*

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PITTSBURGH PLATE GLASS CO.,
*Pittsburgh, Pa., June 4, 1951.*

HENRY R. ASHTON, Esq.,
*Chairman of Coordinating Committee,*
*National Council of Patent Laws Associations, New York, N. Y.*

DEAR MR. ASHTON: The Patent Law Association of Pittsburgh cannot as a hody act in time to pass a resolution supporting the passage of H. R 3760.

Under the circumstances, I have polled the members of the board of managers of tbe association, and they have authorized me to write you this letter for use at the hearings before the subcommittee of the Judiciary Committee as showing that the governing body of this association supports the passage of H. R. 3760.

Very truly yours,

OSCAR L. SPENCER,
*President, the Patent Law Association of Pittsburgh.*

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ST. LOUIS, MO, *June 12, 1951.*

NATIONAL COUNCIL OF PATENT LAW ASSOCIATIONS,
*Washington, D. C.:*

Patent section of St. Louis Bar Association approves H. R. 3760 of Eighty-second Congress but expressed strong sentiment for more direct and stronger definition of invention and suggest restudy of paragraph B of section 231 to more accurately define tortuous inducement of infringement.

NEAL E. WILLIS,
*Secretary, Monsanto Chemical Co*

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PATENT LAW ASSOCIATION OF SAN FRANCISCO,
*June 8, 1951.*

Mr. HENRY R. ASHTON,
*Chairman, Coordinating Committee on Revision and Amendment of the Patent Laws, New York City, N. Y.*

DEAR MR. ASHTON: The Patent Law Association of San Francisco, acting through its board of governors, endorses H. R. 3760 and urges approval and

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early enactment thereof. It is hoped that the changes in H. R. 3760 suggested by the Coordinating Committee on Revision and Amendment of the Patent Laws will be incorporated in the bill.

Very truly yours,

PATENT LAW ASSOCIATION OF SAN FRANCISCO,
STEPHEN S. TOWNSEND, *President.*

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RESOLUTION OF THE TOLEDO PATENT LAW ASSOCIATION

*Resolved*, That the Executive Committee of the Toledo Patent Law Association approves the passage of H. R. 3760 as amended by the suggestions made and presented by the coordinating committee of the National Council of Patent Law Associations; and that the secretary be, and hereby is, directed to transmit copies of this resolution to the National Council of Patent Law Associations.

Certified to be a true copy of a resolution adopted by the executive committee of the Toledo Patent Law Association at a meeting held Thursday, May 31, 1951.

HENRY K. LEONARD, *Secretary.*

Mr. BRYSON. Incidentally, those resolutions to which you have made reference apparently represent the larger associations in the country.

Mr. ASHTON. The ones I have presented at the moment represent at least two-thirds or more of all the patent law associations in the country, including a number of the smaller associations, as you will see from the list of membership at the back of my statement.

Mr. BRYSON. Yes.

Mr. ASHTON. There were included in our group all of the patent law associations in the country. In fact they all worked with us, so they include all of the large ones, and also all of the small ones.

In conclusion, I wish to thank the chairman, the other members of this committee and the committee's counsel for the opportunity we have had to assist in this important work. It also seems appropriate to record here our thanks to the officers and members of the legislative committees of our associations and other individuals who have worked so diligently, and finally to thank Messrs. Federico, Rich, and Rose without whose untiring and invaluable help the work of the coordinating committee could not have been carried on.

At the last meeting of the coordinating committee on May 22, 1951, an advisory committee was appointed to act for the coordinating committee at these hearings. Several members of this advisory committee, in addition to myself, are present. They will be glad to testify and to answer questions on any part of the bill if your committee so desires.

I thank you.

Mr. ROGERS. May I ask a question, Mr. Chairman?

Mr. BRYSON. Congressman Rogers desires to propound a question.

Mr. ASHTON. Yes, sir.

Mr. ROGERS. You made a statement, I think, on page 3 of your statement——

Mr. ASHTON. Yes, sir.

Mr. ROGERS. In which you said—

only such changes in existing law as in the judgment of the drafting committee would meet with substantial approval of the patent profession.

Of course, we would infer from that that it was not unanimous as to all of the terms and conditions of this latest recodified law; that is correct, is it not?

Mr. ASHTON. You see, Mr. Rogers, at the time that resolution was passed by our coordinating committee at the very first meeting we

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had before it your committee print which contained a number of new proposals in the law as well as codifications, and there were a number of proposals in that which everyone recognized at once would be controversial.

This group organized itself, therefore, on the basis of having a redraft made on which we thought we could get substantial agreement, and this committee included industrial associations, and so forth, and the drafting committee worked up and brought into the committee a revision leaving out the controversial matters, and which, in its judgment it felt would meet with general approval, but you must bear in mind that the whole project is primarily codification.

Mr. ROGERS. We appreciate the good work that the committee has done and, of course, we are trying to arrive at what may have been controversial matters therein.

Mr. ASHTON. Are you inquiring as to within the committee itself, on various phases of the bill?

Mr. ROGERS. Let me ask you this question: I understand the present bill, H. R. 3760, is one that has been more or less agreed upon among members of the Patent Attorneys' Associations, subject to some of the recommendations in May.

Mr. ASHTON. The coordinating committee met May 22 and adopted a list of suggestions, and they were suggestions to your committee. They were adopted by most of the associations as changes which they would like to see made in the bill. Most of them feel that the bill as a whole is a desirable bill, and they hope that these changes which are clarifying and not controversial matters in any way should be made.

It is not at all strange that there should be some suggestions for changes which would develop. Also the bill was prepared by your committee and changed in a number of respects so that it had to be thoroughly considered again.

Mr. ROGERS. Then do I understand that concerns the proposed clarifying amendments you have filed here with the clerk?

Mr. ASHTON. That is so.

Mr. ROGERS. That you have filed with the clerk of the committee?

Mr. ASHTON. That is right.

Mr. ROGERS. And as a result they will be discussed by the various members who appear here, and pointed out from time to time by those representing the committee that has gone through all of this work?

Mr. ASHTON. Well, they can be discussed by me, for example, or someone else. They are of such a character that we have not been thinking of them as requiring much discussion, because they are pretty apparent on their face.

Mr. ROGERS. That is, they are clarifying amendments?

Mr. ASHTON. That is right.

I might add that we are continuing this policy which we have had throughout of transmitting all of the suggestions that come to us to your committee counsel. I should add in that connection that suggestions of improvement in language and some substantive suggestions that should not meet with any opposition at all have been proposed, and that material is being sent to your counsel for this committee as soon as it is received by us.

Mr. ROGERS. Do I understand also that your committee has received suggestions from others than the members of the Patent Law Associations concerning the provisions of this bill?

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Mr. ASHTON. Yes, sir. I should say we have all of these industrial associations as well in our organizations, and, of course, they represent industry, as I have stated, and these associations, of course, around the country have received suggestions from a very large cross section of the country.

The way the association worked was this: for example, in Chicago they received suggestions from various people, and they took all of those together and considered them in their open meetings, and then made their report and sent their representatives to our committee. So, in order to inquire as to the scope of the study and the suggestions which have been made we have also to reach out to these associations which held all of these meetings, and all of the material, I repeat, that has come to us has been regularly supplied to your committee.

Mr. BRYSON. Are there any further questions?

Our counsel has just handed me a letter from the Michigan Patent Law Association, dated June 11, in which they state that the Michigan Patent Law Association endorses and recommends the enactment of H. R. 3760.

THE MICHIGAN PATENT LAW ASSOCIATION,
*Detroit, Mich., June 11, 1951.*

Mr. HENRY R. ASHTON,
*Chairman of the Coordinating Committee On Revision and Amendment of the Patent Laws,*
*Care of The National Council of Patent Law Associations, Washington, D. C.*

DEAR MR. ASHTON: The Board of managers of the Michigan Patent Law Association having been duly empowered to act for the association in the matter of the revision and amendment of the United States patent laws, have under date of June 11, 1951 passed the following resolution:

"Whereas there is now pending in Congress a bill to revise and codify the patent laws, H. R. 3760; and

"Whereas this association's patent law revision committee has studied that bill and its predecessor and has participated in the joint study thereof with representatives of other patent law associations and trade associations conducted by the Coordinating Committee on Revision and Amendment of the Patent Laws; and

"Whereas the membership of this association in open meeting have considered the predecessor bill H. R. 9133 of the Eighty-first Congress and have expressed approval of that bill; and

"Whereas the patent law revision committee has reported that H. R. 3760 with changes proposed by the said coordinating committee is similar in principle to H. R. 9133 and is a desirable bill: Now, therefore, be it

"*Resolved*, That the Michigan Patent Law Association endorses and recommends to the Congress the passage of H. R 3760 preferably with the clarifying changes recommended by the coordinating committee on revision and amendment of the patent laws; that the chairman of the said coordinating committee be authorized to represent this association at the congressional hearings on the bill and; that the secretary send copies of this resolution to Michigan Senators and Representatives, to the Subcommittee No. 3 of the House Judiciary Committee and to the chairman of the coordinating committee."

It is assumed that you will take the necessary action to see that this resolution is brought to the attention of all interested parties. It would be appreciated if copies could be forwarded to the undersigned of any decisions, minutes of meetings, testimony or hearing reports that may be subsequently published relative to the proposed congressional bill, H. R. 3760.

Very truly yours,

GEORGE W. TALBUETT,
*Secretary-Treasurer.*

Mr. ASHTON. Yes, I just received a copy of it this morning, and I include it in with those papers I handed up to the committee.

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Mr. BRYSON. If there are no further questions, we will call Mr. Federico at this time.

Mr. FEDERICO. Yes, sir.

(The matter above referred to is as follows:)

CHANGES IN H. R. 3760 MADE AT THE COORDINATING COMMITTEE MEETING IN WASHINGTON, MAY 22, 1951

Chapter 1, section, 1 page 2: Line 10, strike out "clerks".

Chapter 2, section 100, page 8: Line 2, after "includes" insert ", but is not limited to,".

Line 3, after "includes" insert ", but is not limited to,".

Line 4, after "machine" insert a comma and after "matter" insert a comma.

Chapter 2, section 102, page 9: Line 1, strike out "A person shall be entitled to a patent unless—" and insert "An invention shall not be patentable if—".

Line 12, change "inventor" to "applicant".

Paragraph (g): The coordinating committee was not satisfied with either the language of the Bill or the suggested changes proposed at the meeting since none of them wholly took care of the situation. The matter was left to Mr. Federico to prepare a redraft. After consultation with others Mr. Federico recommends the following paragraph which is intended to codify the existing law:

> "(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other."

Chapter 2, section 103, page 9: Line 1, strike out "obtained though" and insert "refused or declared invalid when".

Line 2, strike out "in the prior art" and insert "as".

Line 3, strike out "if" and insert "unless".

Line 4, change the first "that" to "the".

Chapter 2, section 112, page 10: Line 12, after "structure" insert ", material".

Line 14, after "thereof" cancel period and insert ", whether or not known at the time the invention was made."

Chapter 2, section 116, page 12: Line 2, after "intention" insert "on the part of the omitted inventor".

Chapter 2, section 118, page 12: Line 3, after "agreed" insert "in writing" and after "invention" strike out "in writing".

Chapter 2, section 121, page 13: Line 12, after "title" insert a comma.

Line 13, after "patent" insert "on the other application."

Chapter 2, section 135, page 15: Line 12, change "No" to "Any".

Line 13, after "may" insert "not".

Line 14, strike out "is made" and insert "has been made in such application prior to the issuance of said patent or".

Chapter 2, section 141, page 15: Line 9, change "files" to "file".

*Chapter 2, section 146, page 16:*

Line 4, change "Commission" to "Commissioner".

*Chapter 3, section 201, page 18:*

Line 1, after "patent" strike out "through error".

Line 4, after "patent" insert "through error and".

*Chapter 3, section 202, page 19:*

Line 15, change "if" to "unless".

Line 16, strike out "does not" and change "infringe" to "infringes".

Line 19, strike out "such thing" and insert "like things".

*Chapter 3, section 203, page 20:*

Line 2, insert a period after "invalid" and change "and" to "A".

Line 3, strike out "the" before "patentee".

*Chapter 3, section 206, page 21:*

Line 9, after "intention" insert "on the part of the omitted inventor".

*Chapter 3, section 211, page 21:*

Line 16, change "patents" to "patent".

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*Chapter 3, section 212, page 22:*

Strike out entire paragraph and substitute the following:

"Whenever two or more persons own a patent jointly, either by the issuing of the patent to them jointly or by reason of the assignment of an undivided interest in the patent or by reason of succession in title to such interest, each of the joint owners, in the absence of any agreement to the contrary, shall be entitled to make, use or sell the patented invention, or license others so to do, or assign or encumber his interest without accounting to the other joint owners."

*Chapter 3, section 231, page 23:*

Line 1, after "liable" insert "for infringement".
Line 9, strike out "a person" and insert "another".

*Chapter 3, section 241, page 23:*

Line 2, after "patent" insert "with the right to a trial by jury except in cases heretofore cognizable only in a court of equity."

*Chapter 3, section 242, page 23:*

Line 6, change "any claim" to "the claims" and after "thereof" insert "in suit".
Line 11, change "of" after "validity" to "or".

*Chapter 3, section 244, page 24:*

Line 1, strike out "the court" and insert "damages"; after "shall" insert "be" and change "award" to "awarded".
Line 2, strike out "damages".

*Chapter 3, section 251, page 25:*

Line 10, after "patented" insert "or made by a patented process".

## STATEMENT OF P. J. FEDERICO, EXAMINER IN CHIEF, UNITED STATES PATENT OFFICE, WASHINGTON, D. C.

Mr. BRYSON. Mr. Federico, will you please identify yourself for the record?

Mr. FEDERICO. Mr. Chairman and gentlemen of the committee, my name is P. J. Federico. I am an Examiner in Chief in the Patent Office, and I am appearing at the request of the chairman and with the consent of the Commissioner to give an explanation of the background of the bill, and to supply any information relating to the patent laws that the committee might ask for.

Mr. BRYSON. You may be seated, Mr. Federico.

Mr. FEDERICO. Mr. Zinn, in his statement, referred to the Patent Act of 1870 with subsequent enactments adding to or changing various sections of that original act. The first patent law was enacted in the second session of the First Congress in 1790. As a matter of fact, when the First Congress met one of its very first items of business was the consideration of patents and copyrights, and the first patent bill was H. R. 10 of the First Congress.

These patent laws are enacted by Congress in accordance with the provisions of the Constitution in article I, section 8, which provides that:

> The Congress shall have power * * * to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

This provision was unanimously adopted by the Constitutional Convention following suggestions for Federal jurisdiction over patents and over copyrights which had been made in the Convention by James Madison, of Virginia, and Charles Pinckney, of South Carolina.

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Each of these gentlemen proposed separate provisions relating to patents and copyrights which were merged into the general statement we now have by the Drafting Committee of the Convention, and was then adopted without any dissenting voice.

The provision merits more study than has actually been given to it, particularly in the matter of the language used.

The background shows that it was a merging of two suggestions for patents and copyrights, the balanced construction and the usage current then and later indicates that it is really two provisions written into one sentence.

The first provision would be to promote the progress of science by securing for limited times to authors the exclusive right to their writings. The word "science" in this connection, has the meaning of knowledge in general, which is one of its meanings today.

The other provision would be that Congress has the power to promote the progress of useful arts by securing for limited times to inventors the exclusive right to their discoveries. The first patent law and all patent laws up to quite a good time later were entitled "Acts to promote the progress of useful arts."

The first law which was enacted, on April 10, 1790, vested the jurisdiction to issue patents in a Board consisting of the Secretary of State, the Attorney General, and the Secretary of War. The person principally interested and the leader of the group was the Secretary of State, Thomas Jefferson, who was greatly interested in the subject matter of patent law.

Mr. BRYSON. He was a patentee himself.

Mr. FEDERICO. He was not actually a patentee, but he was the inventor of a number of different devices, most of them being gadgets. Jefferson has been called a lover of gadgets, and I think there is even a poem about it.

Mr. BRYSON. He had a few good qualities too.

Mr. FEDERICO. The law made their power absolute, and also provided for the various things that would be necessary in the patent law.

While the Board, and particularly Thomas Jefferson, was quite favorable to the granting of patents, and granted them with great consideration, the other duties of the members of this Board, in view of their high offices, made it impossible for them to devote too much time to this work, and as a result of suggestions the law was changed in 1798 to make the granting of patents a clerical function. Patents were granted to anyone who applied on fulfilling the formal requirements and filing the necessary papers and fees.

This law continued on the books until 1836 when the dissatisfaction with the free granting of patents without any examination as to novelty or other matters led to the appointment of a select committee by the Senate which introduced a bill that became the new law which was enacted on July 4, 1836.

This new law contains the fundamental principles of our present patent law. It created a Patent Office with a Commissioner of Patents at the head, and examiners with the function of examining applications for patents and the power to refuse patents, which was not present in the previous law.

Then, of course, the law had a great many other provisions in it relating to details of procedure, enforcement of patents, and matters of that sort.

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Amendments were made to this act of 1836 at various times until in 1870 the law was completely revised by the Commission and the committee that Mr. Zinn has referred to.

The present bill in a sense, then, is the second combined revision of the patent laws by the Committee on the Revision of the Laws and the committee in charge of patents.

I will describe the bill, endeavoring to give the over-all picture of the structure of the bill and its provisions.

Of course, the main thing in the bill is difficult to describe, because to do so it would have to be compared with the Revised Statutes of 1874 and its language and arrangement, and the various acts passed since. The organization, language, arrangement, and matters of that sort which make the present bill seem comparatively simple cannot be appreciated without comparison with the existing statutes.

The bill divides the sections into four chapters. The subject of patents has been divided into three main topics.

The first chapter contains the sections of the law relating to the Patent Office generally, its powers and duties and some ancillary matters of that kind.

The second chapter collects the sections relating to the conditions under which a patent may be obtained and the procedure in obtaining patents.

The third chapter has the sections relating to patents themselves and the protection of rights under patents, and matters relating to that phase of the subject.

Stated generally, the three chapters relate to, first, the Patent Office; second, obtaining a patent; and third, the patent itself. Of course, it has not been possible to maintain this three-part division strictly, and there may be a slight amount of overlapping of the three phases of the subject.

In addition to the three chapters mentioned, a further chapter collects the laws relating to patents for plants and to patents for designs, which are treated as supplementary topics.

The organization of the bill and the arrangement of the sections is such that many new topics relating to the patent laws which have come up through the past, or which have not been considered at the moment, can readily find their place in the organization.

I will now try to give a bird's-eye view of the sections themselves.

The sections are divided into several groups of more or less homogeneous subject matter with unnumbered subheadings.

The first subgroup in chapter 1 relates to the Patent Office and its sections; the establishment of the Patent Office; the seal; officers and employees, restrictions on officers and employees as to interest in patents; bond of the Commissioner; duties of the Commission; the Board of Appeals, and the Patent Office Library. Very little change is introduced in these sections; there is a change in section 3 relating to a successor of the Commissioner when the office is vacant, filling a gap in the present law.

There is a change in section 4 on the ability of Patent Office employees to obtain patents.

Of course, the sections in this chapter apply to the Patent Office as such and include trade-marks, as well as patents, when they go to organizational and procedural matters.

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Then there is this section on classification of patents, which is one of the functions of the Patent Office; supplying certified copies of records; the listing of publications put out by the Patent Office; the exchange of copies of patents with foreign countries; copies of patents for public libraries, and the annual report to Congress.

There is very little change in these sections other than language matters, and possibly other minor changes.

The next group of sections collect some of the details relating to procedure in the Patent Office which apply generally, and have little or no changes in them.

The next group, sections 31, 32, and 33, relate to practice before the Patent Office. In them the language has been rearranged and divided into several sections.

There has been no change of substance in these sections, except in the third of this group which is a criminal provision for unauthorized practice. The language has been considerably simplified, and the maximum fine has been raised from $100 to $1,000.

In the next group of sections, relating to Patent Office fees, there have been a few readjustments in some minor fees, and one change in the fee for an appeal to the Board of Appeals.

That concludes the description of chapter 1, which, in the main, represent purely formal changes, with only a few changes over the present law.

Chapter 2 relates to patentability of inventions and grant of patents, some of the sections of which might require a little more explanation.

Referring to section 101 first, this section specifies the type of material that can be the subject matter of a patent.

The present law states that any person who has invented any new and useful art, machine, manufacture, or composition of matter, or any now or useful improvement thereof may obtain a patent.

That language has been preserved except that the word "art" which appears in the present statute has been changed to the word "process."

"Art" in this place in the present statute has a different meaning than in the phrase "useful arts" in the Constitution, and a different meaning from that of the word "art" in other places in the statutes, and it is interpreted by the courts to be synonymous with "process" or "method". The word "process" has been used to avoid the necessity of explaining every time the word "art" as used in this place means "process or method," and it does not mean the same thing as the word "art" in other places.

The definition of "process" has been added in section 100 to make it clear that process or method is meant, and also to clarify the present law as to certain types of methods as to which some doubts have been expressed, although not very substantial doubts.

Section 101 says, "subject to the conditions and requirements of this title" after stating the subject matter that can be patented. The conditions under which a patent may be obtained must follow, and section 102 selects the conditions relating to novelty.

Now, under section 101 a person may have invented a machine or a manufacture, which may include anything under the sun that is made by man, but it may not necessarily be patentable unless the conditions are fulfilled.

Section 102 in paragraphs (a), (b), and (c) repeat the conditions in the present statutes relating to novelty; if the invention was known

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or used before, or described in any printed publication, et cetera, it cannot be patented.

Subsection (a) is the present language, although the interpretation by the courts excludes various kinds of private knowledge not known to the public.

Paragraph (d) relates to a bar to patentability when the inventor has previously obtained a patent in a foreign country, which represents a change, a liberalizing change, in the present law.

Paragraph (e) is another condition that has been expressed in a decision of the Supreme Court that is now expressed in the statute.

Paragraph (f) merely emphasizes that it is the inventor who applies for the patent, and it is probably unnecessary.

Paragraph (g) relates to the question of priority of invention between rival inventors.

Now, section 102 in general may be said to describe the statutory novelty for an invention, that it must be new in the manner described.

Section 103 does something attempted for the first time in our statute, and that is to write down a condition which exists in the law and has existed for well over 100 years, but only by decisions of the courts.

We have an invention which has been made and which is new in the sense that the same thing has not been made or described before. It still may not necessarily be patentable if the difference between this new thing and what was before known is not considered sufficiently great to warrant a patent.

That has been expressed in a large variety of ways in decisions of the courts and in writings.

Section 103 is an attempt to state it in the statute. It refers to the difference between the subject matter to be patented and the prior art, meaning what was known before; if this difference is such that the subject matter as a whole would have been obvious at the time to a person skilled in the art, then this new thing cannot be patented.

That language paraphrases language which has been used quite often in decisions of the courts, and the section was added with the thought that having it expressed would be a good thing to do rather than having it deductible from a large number of decisions of the courts. This section may introduce more definiteness and have some stabilizing effect, and may prevent great departures which have appeared in some cases.

Section 104 is merely a section of the present law which need not be described.

The next group of sections relates to the application for a patent. They describe the requirements of the application where only a few minor changes have been made.

Sections 116 and 118 introduce a new thing in our law. Our statute is very strict in requiring that only the inventor may apply for a patent. These two sections provide for certain types of situations where it may be impossible for the inventor to apply, or in the case of a joint invention one of the joint inventors has been inadvertently included or excluded; the sections provide all of the safeguards necessary for the inventor.

Section 119, the first paragraph is the provision in the present law, with an added requirement in the second paragraph.

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Sections 120 and 121 express in the statute certain things which exist in the law today that have not been written into the statue, and in so doing make some changes in the concepts involved.

Section 122 places into the statute the secrecy of patent applications, which has existed in the Patent Office ever since any of us remember.

The next group of sections relate to the examination in the Patent Office of the application; rejection by the examiner; the right to reconsideration; the time within which an applicant must reply to actions; time for prosecuting application; appeal to the Board and interferences between rival claimants for a patent.

Very little has been changed in this group of sections except a minor revision in the interference section.

The next group of sections relates to the review of Patent Office decisions.

The act of 1836 provided for the first time for the refusal of patents by officials known as examiners. The Senators working on the bill were quite jealous of the rights of the public and provided very ample means of reviewing the action of the Patent Office. In fact, there are two types of review. The applicant may appeal to a court of appeals especially provided, or he may file suit in the district court against the Commissioner to get his right adjudicated by the court.

This group of sections makes no fundamental change in the various appeals and other review of Patent Office action, but has made a few changes in the procedure in various instances to correct some of the problems which have appeared in the past and which have appeared in bills presented and considered by the committee, particularly in section 146. These details need not be described, except to state that they are mainly procedural.

The next group of sections relate to the issuance of a patent and the time and manner of issue.

Section 154 relates to the contents of the patent and the grant. The present statute corresponding to this section states that the patent grants the exclusive right to make, use, and vend the invention. That phrase has led to considerable difficulty in understanding because the statute does not grant the right to make, use, or sell, but only the exclusive part of it, and in numerous decisions, particularly decisions of the Supreme Court, it has been stated that all the patent does is grant the right to exclude others from making, using, or selling the invention, and the language used by the Supreme Court corresponding to what the old language means has been inserted in this particular section.

That finishes chapter 2. If the time is short I might stop and resume discussion of chapter 3 later if necessary.

Mr. BRYSON. That suggestion might be best, Mr. Federico, in view of the fact that you will be here right along, and we do have a number of out-of-town witnesses here today.

Mr. FEDERICO. Yes.

Mr. BRYSON. Your analysis of the bill up to now has been excellent, and we appreciate it.

Mr. ROGERS. I want to ask him some questions later on.

Mr. BRYSON. You will be available, will you, Mr. Federico?

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Mr. FEDERICO. Yes; I will be here right along, if any questions arise.

Mr. BRYSON. Thank you.

Mr. Paul Rose.

Mr. ROSE. Yes, sir.

## STATEMENT OF PAUL A. ROSE, WASHINGTON, D. C., CHAIRMAN OF THE LAWS AND RULES COMMITTEE OF THE AMERICAN PATENT LAW ASSOCIATION

Mr. BRYSON. Mr. Rose, will you identify yourself for the record?

Mr. ROSE. My name is Paul A. Rose, of Washington, D. C. I am appearing here as chairman of the laws and rules committee of the American Patent Law Association by authority of the board of managers of the association to present to the committee the recommendations of the association with respect to H. R. 3760.

Mr. BRYSON. All right, sir, you may proceed. You may sit down if you like.

Mr. ROSE. Mr. Chairman, the American Patent Law Association endorses H. R. 3760, Eighty-second Congress, and recommends its passage when amended to include the proposals contained in the report of its laws and rules committee, a copy of which is attached hereto.

Mr. BRYSON. That is a printed copy?

Mr. ROSE. Yes, sir; of which I have supplied 25 copies for the committee's use.

The association has followed with interest the proceedings which have resulted in the drafting and introduction of H. R. 3760, beginning with the committee print, mentioned by Mr. Zinn and Mr. Federico, issued by the Judiciary Committee in January 1950, and has been actively represented on the Coordinating Committee sponsored by the National Council of Patent Law Associations to assist and advise the Judiciary Committee in the task of codifying the patent laws.

When H. R. 3760 was introduced, the laws and rules committee of the American Patent Law Association immediately undertook to examine it in detail and, after having done so, rendered a report which was considered and approved by the board of managers of the association. This report was then submitted to the entire membership of the association, and each member was given the opportunity to approve the report of the laws and rules committee without modification or to state in detail where and in what respects this report should be changed. The membership of the association has now voted by written ballot to adopt the report of its laws and rules committee by an overwhelming majority of those voting.

Of 1,370 members in the United States qualified to vote 524 returned signed ballots.

I might interpolate here, Mr. Chairman, to say that we consider that a very good return on the basis of past referenda that we have undertaken to conduct of the association.

Of this group 520 approved adoption of the report of the laws and rules committee, either without reservation or with definitely stated reservations, and 4 disapproved the report in its entirety and hence wholly disapproved the bill. Of the 520 approvals of the report, 388

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were without reservation and 132 included statements disapproving or advocating modification of 1 or more of the recommendations contained in the report.

Those recommendations of the committee, as set forth in the committee report, which evoked the greatest comment from those who voted were with respect to the sections of the bill which are listed below. The vote upon the corresponding committee recommendations in each case is also given. It will be understood that reference to the committee report for a full and complete understanding of the nature of the vote received will be necessary.

In this table which we have included in our statement, we have eliminated single suggestions from various members, where only one suggestion or disapproval was received because that would make the table too long, but have selected those which are most numerous.

I would like to read this table because it shows how few people really are in disagreement with the general feeling in favor of the bill or with our recommendations with respect to it for amendment. They are very few.

On section 4 of the bill there were 512 votes favorable, and only 8 opposed. We had a very slight clerical change in that section, and the 8 opposition votes went to the 1-year limitation on the filing of applications by examiners after leaving the office. Those eight thought that 1 year was a little too harsh.

On section 102 (g) there were 507 votes favorable to the recommended revision; 7 were opposed, and 6 proposed other changes.

On section 103 there were 510 favorable votes, and 10 opposed, but clarified their opposition with suggestions for further amendment to the section to strengthen it, rather than being disapprovals of the principle.

On section 112 there were 510 favorable and 10 opposed, but with accompanying suggestions for amendment indicating approval in principle.

On section 119 there were 515 favorable and 5 opposed with accompanying suggestions for amendment.

On section 135, 512 were favorable, and 8 were opposed with accompanying suggestions for amendment.

On section 212, the committee recommended a substitute section for section 212, and that was approved by 505 votes in favor of it, and 15 opposed who wished to retain the section as is in the bill.

On section 231 there were 501 favorable, and 19 opposed to one or more subsections or proposed clarifying amendments.

We proposed an additional section to the bill calling for publication by the Commissioner at the request of applicants for patents which may or may not thereafter mature into patents.

On that proposed additional section 474 votes were in favor of its addition, and 46 were opposed to the addition.

No other section of the bill received more than four comments or suggestions for amendments. So, I think this table illustrates that the membership of the American Patent Law Association is overwhelmingly in favor of the bill with the amendments proposed by its laws and rules committee.

The specific suggestions and comments received from the members as a result of the referendum have been omitted from this statement,

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but will be made available to the committee or its counsel upon request.

Mr. BRYSON. We would like to have you submit them to our counsel as other agencies of Government do.

Mr. ROSE. We have done that in the past in working with the coordinating committee and we will make those available to the counsel.

(The statement submitted by Mr. Rose is as follows:)

STATEMENT OF THE AMERICAN PATENT LAW ASSOCIATION ON H. R. 3760

The American Patent Law Association endorses H R. 3760, Eighty-second Congress, and recommends its passage when amended to include the proposals contained in the report of its laws and rules committee, a copy of which is attached hereto

The association has followed with interest the proceedings which have resulted in the drafting and introduction of H. R. 3760, beginning with the committee print issued by the Judiciary Committee in January 1950, and has been actively represented on the coordinating committee sponsored by the National Council of Patent Law Associations to assist and advise the Judiciary Committee in the task of codifying the patent laws.

When H. R 3760 was introduced, the laws and rules committee of the American Patent Law Association immediately undertook to examine it in detail and, after having done so, rendered a report which was considered and approved by the board of managers of the association. This report was then submitted to the entire membership of the association, and each member was given the opportunity to approve the report of the laws and rules committee without modification or to state in detail where and in what respects this report should be changed The membership of the association has now voted by written ballot to adopt the report of its laws and rules committee by an overwhelming majority of those voting.

Of 1,370 members in the United States qualified to vote 524 returned signed ballots. Of this group 520 approved adoption of the report of the laws and rules committee, either without reservation or with definitely stated reservations, and 4 disapproved the report in its entirety and hence wholly disapproved the bill. Of the 520 approvals of the report, 388 were without reservation and 132 included statements disapproving or advocating modification of one or more of the recommendations contained in the report.

Those recommendations of the committee, as set forth in the committee report, which evoked the greatest comment from those who voted were with respect to the sections of the bill which are listed below. The vote upon the corresponding committee recommendations in each case is also given. It will be understood that reference to the committee report for a full and complete understanding of the nature of the vote received will be necessary.

*Vote on the committee's recommendation*

Section of H. R. 3760:

Section 4: 512 favorable, 8 opposed.

Section 102g: 507 favorable, 7 opposed to proposed change, 6 proposals for further change.

Section 103: 510 favorable, 10 opposed, with accompanying suggestions for amendment.

Section 112: 510 favorable, 10 opposed, with accompanying suggestions for amendment.

Section 119: 515 favorable, 5 opposed, with accompanying suggestions for amendment

Section 135: 512 favorable, 8 opposed, with accompanying suggestions for amendment.

Section 212: 505 favorable, 15 opposed to proposed substitute section.

Section 231: 501 favorable, 19 opposed to one or more subsections or proposed clarifying amendments.

Proposed additional section (p. 12 of report): 474 favorable, 46 opposed.

No other section received more than four comments or suggestions for amendments.

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The specific suggestions and comments received from the members as a result of the referendum have been omitted from this statement, but will be made available to the committee or its counsel upon request.

Respectfully submitted.

AMERICAN PATENT LAW ASSOCIATION,
By PAUL A. ROSE,
*Chairman, Committee on Laws and Rules.*

REPORT OF THE LAWS AND RULES COMMITTEE OF THE AMERICAN PATENT LAW ASSOCIATION ON H. R. 3760, EIGHTY-SECOND CONGRESS

DULY ADOPTED AT A MEETING OF THE COMMITTEE ON MAY 11, 1951, ATTENDED ALSO BY THE BOARD OF MANAGERS, AMERICAN PATENT LAW ASSOCIATION, WHICH APPROVED THE REPORT

Pursuant to instructions from the board of managers, the laws and rules committee has considered H R. 3760, Eighty-second Congress, a bill to revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents," and presents herewith its report and recommendations with respect thereto.

Your committee favors passage of the bill, amended as hereinafter noted, and recommends that the association adopt as the official position of the association that it favors passage of the bill as so amended, and that the appropriate committees of the Congress be informed of such official position.

At the outset, in order that the bill be viewed in proper perspective, a brief review of the evolution of the bill is appropriate.

In considering this bill it should he borne in mind that the primary objective from the standpoint of the House committee is to restate the patent laws, which have not been examined as a whole since 1870, to improve the language and arrangement and enact as law title 35 of the United States Code, while an additional objective is to make specific changes which may be considered desirable and substantially noncontroversial.

The bill is the culmination of more than 2 years of intensive study and effort on behalf of the subcommittee of the House Judiciary Committee charged with codification of the laws and also with patent and trade-mark matters, the committee staff, the coordinating committee sponsored by the National Council of Patent Law Associations (upon which were represented most of the patent law associations and groups throughout the country, and also a number of industrial and manufacturers' associations), and others interested in the patent law.

The bill had its genesis in a committee print issued by the Judiciary Committee of the House of Representatives January 10, 1950, entitled "Proposed revision and amendment of the patent laws." This committee print, which was issued solely for purpose of discussion and comment, received wide distribution. It included a number of controversial proposals and evoked a great deal of discussion and a very large number of suggestions for revision of the various proposals presented therein. At a meeting in Washington on February 8, 1950, of the National Council of Patent Law Associations, a coordinating committee was established for the purpose of giving direction and purpose to the effort to effect a workmanlike and sound revision of the law of patents. As indicated above, a number of industrial and manufacturers' associations accepted invitations to be represented on the coordinating committee, so that it had the benefit of the counsel of a very wide cross section of the patent bar and American business, large and small.

At the first meeting of the coordinating committee, a drafting committee was appointed to prepare a redraft of the committee print to be based on the comments and suggestions received from the associations, their members and others. The drafting committee received a very large number of suggestions and from these prepared a redraft of the committee print which was submitted to a second meeting of the coordinating committee in Washington on May 9 and 10, 1950. This redraft received very careful consideration and section-by-section action and revision and the resulting redraft was submitted to the House committee. With this redraft as a basis, a bill was prepared by the House committee staff and was introduced into the House as H R. 9133 of the Eighty-first Congress.

H. R. 9133 was given wide distribution to the patent bar and industry and in the light of further suggestions and comments received thereon the drafting committee prepared another redraft which was presented to a third meeting of



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the coordinating committee in Washington on December 6 and 7, 1950. Again the bill received thorough consideration by the coordinating committee and a final draft of a proposed bill for presentation in the Eighty-second Congress was prepared. The drafting subcommittee presented this redraft to the House committee and it was made the subject of a number of conferences between committee counsel and representatives of the major departments of Government. As the culmination of this effort, the draft of the present bill was finally completed and introduced in the House of Representatives on April 18, 1951 as H. R 3760. Most of the controversial proposals have been eliminated from this bill.

From the above discussions it will be observed that the proposals contained in the present bill have received careful consideration by a large cross section of the bar, industry, and others interested in the patent system. It therefore is the hope and expectation of those most closely associated with this important effort to codify and revise the patent laws, that the bill will have the general and wholehearted support of the patent bar and industry, with a minimum of revisions and objections.

While there has been a great deal of rewriting in the interest of clarification and modernization of language, the bill in large measure represents codification of existing law.

In the interest of brevity this report can and will be confined to specific mention only of those sections that embody some important change in, or addition to, existing law which should be brought to the attention of the membership.

### CHAPTER 1

This chapter deals with the establishment and organization of the Patent Office, admission and conduct of attorneys and Patent Office fees.

Section 3 provides for the continued issue of patents in the event of a vacancy in the office of Commissioner, thus correcting a deficiency in the present law. In line 10 it is recommended that "clerks," be canceled as superfluous and to agree with "officers and employees" in section 4.

Section 4 extends the restrictions of the filing of applications by former employees of the Patent Office to a period of 1 year from the severance of their employment, instead of during their term of employment as now provided.

Section 7 retains the authority of the Commissioner to utilize primary examiners on the Board of Appeals for limited periods in order to keep the work of the Board current.

Section 21 provides that when the last day for taking any action in the Patent Office falls on Saturday, as well as on Sunday or a holiday within the District of Columbia, the action may be taken on the next secular or business day. The inclusion of Saturday is in keeping with the close of the Patent Office on that day.

Section 41 includes in the provision for reissue applications a fee of $1 for each claim in excess of 20 over and above the number of claims in the original patent. This is coordinate with the additional fee for excess claims in original applications. This section also raises the appeal fee from $15 to $25.

Your committee recommends approval of chapter I, subject to correction of section 3.

### CHAPTER 2

This chapter deals with definitions, patentability, the application and its prosecution, appeals and issue of the patent.

Section 100. In the definition of "process", 100 b. positively recognized that a new use may be patentable and represents a desirable clarification of the law and Patent Office practice in this regard.

Section 102, paragraph (d) makes a desirable change from existing law in permitting the issue of a corresponding foreign patent before the issue of the United States patent in those cases where the United States application is filed outside the Convention, but before issue of the foreign patent.

The committee disapproves paragraph (g) because it may be interpreted to constitute a secret reduction to practice an anticipation of an issued patent, and recommends that the following language be substituted in lieu thereof:

> "g. before the applicant's invention thereof the invention was in fact made by another who in this country was using reasonable diligence in reducing it to practice or had reduced it to practice, provided such other had not abandoned, suppressed or concealed the invention, and had exercised diligence in putting it into use or in otherwise making knowledge thereof available to the public."

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Section 103 is a statutory declaration of the requisites for invention over prior art and is considered of importance in the statutory declaration of the requirement relative to the skill of the art at the time the invention was made, thereby accentuating that the invention must be viewed in the light of the state of the art as it existed at the time of the invention, rather than in retrospect after the disclosure thereof. The last sentence of this section is of particular importance as it will have a salutory influence by expressing congressional disapproval of the inclination of many courts since the Cuno case to judge an invention not upon its merits but upon collateral considerations such as the manner or route by which it was achieved.

Section 112 in the last paragraph recognizes the validity of combination claims wherein the novelty is expressed in functional terms and while offsetting the much criticized theory of the Halliburton case is advisedly drafted so as not to extend to the point of permitting the use of single means claims.

Section 115 provides for modification of the oath when made by other than the inventor, this being necessary in view of sections 116 and 118.

Section 116 liberalizes the treatment of applications of joint inventors by permitting the addition as well as the deletion of a nonjoined or misjoined inventor and represents a realistic treatment of the many problems arising in the handling of joint inventions.

Section 118 is a new provision providing for the filing by a person in interest when the inventor cannot be found or will not or cannot sign the application and the filing of an application is necessary to prevent loss of rights, such as the running of a public use or the like. The rights of the inventor are safeguarded by providing that the patent will issue to him so that the section will not invite indiscriminate filing by others than the inventor and the Commissioner of Patents will not be required to decide any questions as to the title or rights of an alleged assignee or other person in interest.

Section 119 contains a new provision in the requirement that the right of priority of a first filed foreign application may be obtained only if a certified copy of the foreign application is filed during the pendency of the United States application. This is in keeping with the requirements of most foreign patent laws and is of importance in providing a complete record in the Patent Office from which interested parties can determine the true date to which a patent is entitled without being put to the necessity of independently obtaining from a foreign country a copy of a claimed priority application which in many cases is found to be unavailable to him. In line 10 it is recommended that "such" be changed to "the first" to make it clear that the priority of only the first filed foreign application may be claimed.

Section 120 codifies the present practice relative to the right to the filing date of an earlier application for common subject matter in a continuation application

Section 121 gives statutory expression to division practice and specifically forbids the use of either the original or the division as a reference against the other, dispenses with signing of a true division and provides that a patent will not be questioned for failure of the Commissioner to require division.

Section 135 provides for the automatic cancellation of the claims involved from a losing patent in an interference. The second paragraph is intended to express no change from the existing law.

Sections 145 and 146 change the time for filing a civil action (old R. S. 4915) to conform to the time for appeal to the CCPA.

Section 146 also enables a losing patentee in an interference to file a civil action, and eliminates the old troubles with respect to unrecorded assignees.

Section 154 provides for stating the patent grant in terms of the right to exclude and in this respect is more accurate and realistic in language than existing law.

Your committee recommends approval of chapter 2, subject to the suggested revision of section 102g and the correction of section 119.

CHAPTER 3

This chapter deals with amendment and reissue of patents, intervening rights, assignment, Government interests in patents, infringement and remedies for infringement.

Section 201 represents a liberalization of the reissue practice, providing specifically for broadened reissues and in view thereof places a definite limit of 2 years on the time within which application may be made for a broadened reissue.

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Section 202 in the second and third paragraphs would enact into the law a protection of intervening rights arising before grant of the reissue, and the continuation thereof, and includes protection of the investments of those who have made substantial preparation for manufacture which would not infringe any claim of the original patent which is also included in the reissue. This last provision makes it possible to determine the question of intervening rights by reference to the reissue alone as no claim of the original patent not included in the reissue need be considered.

Section 203 eliminates disclaiming of part of a claim and omits the penalty of invalidity of the whole patent for delay in disclaiming and in the second paragraph introduces a new thought in providing for a disclaimer of the entire or any terminal part of the term of a patent. This last provision should be of value in eliminating questions of double patenting.

Section 205 provides for correction of applicant's mistake and fills a long-felt need in this respect. A fee of $10 is provided for a certificate of correction in such cases

Section 206 provides fer deletion or addition of a misjoined or nonjoined inventor in the case of an issued patent and provides that a patent cannot be held invalid for inadvertent misjoinder or nonjoinder. These are salutory innovations in the law since there is no valid reason why a patent should not be corrected the same as an application in this regard.

Section 211 includes a specific declaration that patents are personal property. It is recommended that "applications for patent" be inserted after "patents" in line 1 of the first paragraph. In the third paragraph, last line "patents" should be singular.

Section 212 is a new provision in providing that joint owners either must join in an assignment or license or account to each other in the absence of an agreement to the contrary. The commmittee disapproves this section because it is believed that the attempt to restrict the rights of joint owners in that manner will create more difficulties and evils than arise under existing law, and recommends that the following language of section 212 of H. R 9133, Eighty-first Congress, be snbstituted:

> "Whenever two or more persons own a patent jointly, either by the issuing of the patent to them jointly or by reason of the assignment of an undivided interest in the patent or by reason of succession in title to such interest, each of the joint owners, in the absence of any agreement to the contrary, shall be entitled to make, use or sell the patented invention, or license others so to do, or assign or encumber his interest without accounting to the other joint owners."

Section 231 relates to infringement and contributory infringement. Paragraph (b) makes one who actively induces infringement liable as an infringer. Paragraph (c) defines contributory infringement and returns this doctrine to its proper place in the patent law, while safeguarding the right to make and vend staple materials and articles of commerce in the normal course of business Paragraph (d) recognizes legitimate exercises of the patent right which have been unduly curtailed or condemned in recent decisions and it is hoped that a congressional declaration in this respect will restore this doctrine to its proper place in the law

Section 232 enacts into law treaty provisions governing the freedom from patent infringement of the use of inventions in ships and vehicles engaged in international trade.

Section 242 in the first paragraph includes a positive declaration of the presumption of validity and places the burden of proving invalidity on the party asserting it. In view of the growing tendency in the recent past for courts to ignore or pay little more than lip service to the doctrine of presumption of validity, it is hoped that this positive declaration by the Congress will be of real value in strengthening the patent system. The third paragraph extends the 30-day notice requirement to references to be relied upon in district courts as showing the state of the art and is calculated to correct an abuse, which has been too prevalent. of the right to introduce without notice surprise references under the guise of "showing the state of the art." Provision is made for the proof of such matters within the discretion of the court even in the absence of the required notice.

In the second paragraph, subparagraph (2), line 1, it is recommended that "any claim thereof" be changed to read "the claims thereof in suit" as invalidity of a claim not in suit should not be a defense. In the third paragraph, line 1, "of" should be "or."

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Section 246 clarifies the application of the statute of limitations in the case of counterclaims.

Section 247 clarifies the dates from which recovery may be had in cases where notice is and is not given by marking and in the last sentence realistically makes filing of an action notice of infringement

Section 248 is companion to section 203 and eliminates any necessity to disclaim invalid claims to save the remainder of the patent.

Section 251 provides a maximum penalty of $500 for false or fraudulent marking and extends the same to improper marking "patent pending" or "patent applied for."

Section 252 provides for designation by patentees resident outside the United States of a domestic representative for the acceptance of service, as in trademark cases, and for service by publication in the absence of such designation.

Your committee recommends approval of chapter 3, subject to the suggested revision of sections 211, 212, and 242.

CHAPTER 4

This chapter deals with patents for plants and designs and is merely a reenactment of existing law in this regard, this bill not purporting to make any revision with respect to these subjects, except section 303 which clarifies and extends infringement of plant patents to include selling.

Your committee recommends approval of chapter 4.

The bill includes four terminal sections, numbered 2, 3, 4, and 5, of formal character which appear on page 28 and which relate to amendments of existing statutes, applicability and savings provisions and repeal of existing statutes.

Your committee recommends approval of sections 2, 3, 4, and 5.

There appears to be a possible duplication of numbering between sections 101–114 and unrepealed sections of present title 35 of the code, but it is assumed that this conflict will be corrected.

PROPOSED ADDITIONAL SECTION

It is believed by your committee that one of the original proposals which received widespread support and was included in the first redrafts and in H. R. 9133, but which was eliminated from the redrafts at the coordinating committee meeting in December 1950, by a close vote, should be added to the bill by way of amendment. This is the section authorizing the publication of applications at applicants' request and expense. In H. R. 9133, the section was the second paragraph of section 121 and read as follows:

> "Pending applications for patents may be printed and published by the Commissioner, at the request and at the expense of the applicant or owner. Such publication shall have the same effect as an issued patent for the purposes of section 102 (e) of this title"

This proposal would extend the present practice of printing abstracts but goes further in recognizing the right to carry the date back to the filing date for purposes of anticipation If this proposal were adopted the application would be printed in full and classified for search purposes.

Your committee recommends approval of this proposal and that it be added to the pending bill

Respectfully submitted.

Committee on Laws and Rules, Paul A. Rose, Chairman, James E. Archer, George C. Arvedson, Stephen Cerstvik, Maurice A. Crews, Laurence B Dodds, Elwood Hansmann, Ford W. Harris, C. Willard Hayes, Joseph G. Jackson, Harry W. Lindsey, Jr, Alexander C. Neave, N. Douglas Parker, Jr., Rowland V. Patrick, Andrew H. Schmeltz, Samuel B. Smith, Richard K. Stevens, Richard Whiting, J. Russell Wilson.

Mr. BRYSON. Are there any questions?

Mr. ROGERS. Do I understand that these recommended changes are the same as those referred to here by Mr. Ashton and the previous witness?

Mr. ROSE. Mr. Rogers, some of them are, and some of them are not. There is no great variance between them. The coordinating committee made more suggestions for change than we did.

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In one respect, in our proposed substitute for section 212, dealing with accounting by joint inventors to one another in the licensing or sale of a patent, the recommendations in the American Patent Law Association report are identical with those of the coordinating committee. The only other matter of real substance or change where we suggested an amendment, as I recall now, was in section 102 (g). The suggestions of the coordinating committee and of our committee vary in language, but they are aimed at the same result. So that, I think we could say that we are in substantial agreement as to the substance of our recommendations with the coordinating committee, although in acting on the bill the laws and rules committee of the American Patent Law Association and its board of managers, and then the membership voting on it, was not bound by the action of the coordinating committee. In fact, our action was taken prior to the coordinating committee meeting, so that we did not have at that time the full benefit of all of the discussion which went on at that time.

Mr. ROGERS. What I was getting at is this: As I understand it, you represent the American Patent Law Association as a group, and their recommendations are set forth in your statement here. Did not your group also constitute a part of the coordinating committee?

Mr. ROSE. Yes, sir.

Mr. ROGERS. And you are in substantial agreement with them, but due to the fact that you adopted this before the coordinating committee had made its final report you were not able to get together on everything. Was there any substantial difference between your committee and the coordinating committee?

Mr. ROSE. The only substantial difference between our committee action and the coordinating committee's recommendations is that we have recommended the addition of the publication section. The coordinating committee thoroughly considered that question and voted against the addition of such a section. On that proposal our members voted, as the table here will show, 474 in favor of the addition of the publication section and 46 opposed.

Mr. BRYSON. So more of your own members voted against that proposal than voted against any of the others?

Mr. ROSE. Yes; more voted against it than against any of the others. That 46 votes opposed to the additional section was twice as many votes as there were against any other proposal or section in the bill.

I might add here for the benefit of the committee that the American Patent Law Association is a thoroughly national group in that it has 1,370 members who are spread all over the country and cover most all of the States of the Union as well as the District of Columbia and that the members of the various committees of the association are selected not only from Washington, where I happen to be from, but our membership includes, or my particular committee includes, members from various sections of the country, including Los Angeles, New York, Chicago, and so forth.

Mr. ROGERS. Is this association a part of the American Bar Association, or is that a separate group?

Mr. ROSE. It is not a part of the American Bar Association, but it is affiliated with the American Bar Association, as I understand it.

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Mr. ROGERS. The American Bar Association does have a patent section?

Mr. ROSE. Yes, sir.

Mr. ROGERS. As do most States?

Mr. ROSE. Yes, sir.

Mr. ROGERS. Many of the members in your association may be in the other associations; that is, individual members may be members of the State patent section of the American Bar Association and your association?

Mr. ROSE. As a matter of fact, Mr. Rogers, I think over half of our members are members of the American Bar Association—that is, the patent section—and the reverse is also true, that a great number of the members of the various patent law associations throughout the country, local groups, and State goups are also members of the association.

Mr. ROGERS. Thank you.

Mr. BRYSON. All right; thank you very much, sir.

## STATEMENT OF GEORGE E. FOLK, ADVISER TO THE COMMITTEE ON PATENTS OF THE NATIONAL ASSOCIATION OF MANUFACTURERS

Mr. BRYSON. Now, we have Mr. George E. Folk as the next witness. I believe Mr. Folk has lately had an operation on his eyes, and he has asked that someone read his statement for him.

Mr. FOLK. Yes, sir.

Mr. BRYSON. Mr. Folk, will you identify yourself for the record?

Mr. FOLK. Mr. Chairman and members of the committee, the information you ask for is contained in the first paragraph of the statement which I filed and will be read to you by Mr. Fred Foulk, so that you will get the information.

Mr. BRYSON. All right.

Mr. FOULK (reading):

Mr. Chairman and members of the committee, my name is George E. Folk. I am adviser to the committee on patents of the National Association of Manufacturers, and I am speaking today for that association, a voluntary organization of more than 16,000 manufacturers, 83 percent of whose members have less than 500 employees each.

The NAM favors this bill, although it has several recommendations, mostly of minor importance, which it would like to see incorporated in the bill.

The committee on patents of the National Association of Manufacturers consists of approximately 150 members representing all classes of industry; the large size, the medium size, and the small companies. I am submitting herewith a list of the membership of the committee which states the names of the members and the companies they represent

To my own knowledge the National Association of Manufacturers for many years has given continued and intensive study to our patent system with the view of improving it wherever possible. It has recognized the importance of inventions and patents in our economy. In 1938, at the time the Temporary National Economic Committee began its investigations, I was retained by the NAM as a consultant with respect to the investigations of the TNEC relating to patents. When the final report of the TNEC was submitted, I was requested to make an analysis and evaluation of the record insofar as it pertained to patents. This report was published in book form in 1942 under the title of "Patents and Industrial Progress" and was given wide distribution.

I continued my relationship as consultant to the NAM committee on patents, and that relationship still exists.

In 1942 our committee on patents undertook to make a survey and suggest constructive reforms that should be inaugurated in the patent system. In other words, the committee desired to take an affirmative stand which would reflect

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its earnest wish to advance proposals for corrective legislation on patents. With this in view, a letter was sent to all of the members of the association's committee on patents for suggestions with respect to improving the patent system and also for suggestions on any other items that should be given consideration. The response was gratifying, and some fifty-odd suggestions were submitted for consideration.

These suggestions covered every phase of our patent system As a result 11 proposals were made by our committee for improving the patent system, and the proposals were approved by the NAM board of directors. This report was given wide publicity and was distributed to the members of the association in April 1943.

A continuing study of the patent system by our committee fully prepared it to cooperate with the National Patent Planning Commission, which was at the same time also studying the subject This National Patent Planning Commission was appointed by President Roosevelt. It consisted of five eminent men representing research, industry, labor, agriculture, and the general public. We met with this Planning Commission and were in a position to answer its inquiries on different phases of the system and also at the request of the Commission submitted a written report on some nine items in which the Commission manifested special interest.

Our committee continued during the subsequent years its consideration of the patent system, especially the reports of the Government-appointed agencies which had made studies and recommendations on the subject. These agencies were:

1. The Science Advisory Board, which had made a report in 1935. (This report was made an exhibit at the hearings of the TNEC.)
2. The Temporary National Economic Committee.
3. The National Patent Planning Commission.

The recommendations made by these agencies were classified by our committee as consisting of (*a*) desirable legislation; (*b*) legislation which was advantageous or disadvantageous, depending on the form in which it was embodied; and (*c*) undesirable legislation. The report of our committee on this subject was published and distributed to the entire membership of the association in July 1944.

Under date of April 20, 1945, President Truman requested Secretary of Commerce Wallace to undertake a study of the operation and effectiveness of the patent laws and to submit recommendations respecting legislative proposals. The committee appointed by Secretary Wallace submitted for consideration an agenda containing several hundred questions bearing on the patent system. These were give careful consideration by our committee and a reply thereto was submitted to Secretary Wallace's committee on December 21, 1945, in pamphlet form entitled "Comments on the Agenda of the Secretary of Commerce's Patent Survey Committee."

Our committee continued its interest and study of proposals for revision of the patent system and under date of June 18, 1946, made a review which was printed in pamphlet form entitled "A Review of Proposals for Revision of the United States Patent System." This pamplet and the afore-mentioned one received wide distribution.

Continuing its intensive study of the patent system and anticipating possible bills for a complete codification and revision of the patent system, our committee in 1948 prepared and submitted to the NAM board of directors a compreheusive report entitled "Recommendations on Proposals for Statutory Revision of the Patent System." This report was approved by the board of directors of the NAM.

Upon the introduction of the Wiley bill, S 2518 of the Eighty-first Congress, our committee appointed a special subcommittee to consider this bill and its various features were given serious and extensive consideration.

Our committee at various times considered and passed upon a large number of other bills pertaining to patents and research. As an example of the more important ones, we called attention to the National Science Foundation bill, which was enacted into law, the atomic-energy bill, which was also enacted into law; and a bill for defining damages and profits in infringement suits, which was likewise enacted into law.

On January 10, 1950, Representative Joseph R. Bryson, chairman of Subcommittee No. 4 of the House Judiciary Committee, submitted a committee print for the use of the Committee on the Judiciary of the House of Representatives. In the foreword of the committee print, Mr. Bryson stated:

"The draft presented is intended primarily to serve as a basis for the expression of opinions. Criticisms and suggestions for improvement of anything con-

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tained in the draft, and suggestions of additional proposals for consideration, as well as support for anything contained in the draft, are especially invited. All comments received before May 1, 1950, will be carefully considered for the preparation of a bill to be introduced on the subject."

Upon the submission of this committee print, our committee on patents appointed a special subcommittee to consider it, since its importance was fully appreciated. This subcommittee consisted of some 25 members and was divided into 5 groups. To each group were assigned those specific portions of the print in which the members of that group were particularly interested and upon which they were well informed. These groups made their report to the full subcommittee, which in turn made its report to the full committee on patents.

The committee print embodied practically every suggestion for the revision of the patent laws that had been made during the previous 20 years. Practically all of these suggestions had previously been given consideration by our committee on patents. Thus we were prepared to submit constructive suggestions with respect to the committee print, as had been requested

The committee on patents of the National Association of Manufacturers was invited to send a representative to the coordinating committee which was formed by various patent bar associations throughout the country and some of the leading trade associations. We accepted the invitation but reserved the right of independent action, and it is in line with such reservation that we submit this statement.

In July 1950 Mr. Bryson introduced into the House a bill for codification and revision of the patent laws, H. R. 9133 of the Eighty-first Congress. Our special subcommittee appointed to consider the committee print also considered this bill and reported to our full committee. After this report a questionnaire was sent to all the members of our committee on patents asking them to express any views that they might have on the bill.

It is unnecessary now to point out the exhaustive study of the bill made by the above-mentioned coordinating committee, inasmuch as that committee has already summarized its own activities.

No action was taken by Mr. Bryson's committee in the House of Representatives on H R 9133, hut on April 18, 1951, a somewhat modified bill, H. R. 3760, was introduced by Mr. Bryson. The subcommittee appointed by our committee first studied the new bill, then later, in a 2-day session, May 15 and 16, our full committee gave a detailed consideration to the bill section hy section. As a result of this intensive study certain changes in the bill were recommended hy our full committee.

Subsequent to this meeting we attended a meeting of the above-mentioned coordinating committee. Some of our recommended changes were, in substance, approved by that committee, and we earnestly hope that they will be deemed acceptable to your committee.

H. R. 3760 contains numerous sections which consist merely of a codification and clarification of existing law without any substantive changes The bill also contains sections which delete from present law certain obsolete provisions which obviously should not be carried over. Both such sections of the hill meet with our full approval. There remains certain other sections which we feel can be improved and we herewith submit such proposed changes for your consideration

H. R. 3760

Section 100. Definitions: It is proposed that paragraph (b) be changed to read:

> "(b) The term 'art' includes process and method whether of one or more steps, and a new use of a known art, machine, manufacture, composition of matter or material."

Section 101 Inventions patentable: It is proposed to substitute the word "art" for the word "process" in this section and throughout the bill wherever appropriate.

The term "art" is broader than the term "process," and no good reason is seen for the limitation contained in the bill.

Section 102. Conditions for patentability; novelty and loss of right to patent: While this section was approved, it was felt that the language of paragraph (g) thereof might be bettered. The substitute language proposed by the coordinating committee seems to effectuate this. That language reads:

> "(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the

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respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other."

Section 203. Disclaimer: As an improvement in language it is recommended that at the end of the second line a period be inserted after the word "invalid" and that the words "and the" be changed to "A."

Section 211. Ownership; assignment: Our committee proposed for the fourth paragraph of this section the corresponding paragraph of the committee print which reads as follows:

"An assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, whose purchase or mortgage is recorded in the Patent Office within three months from its date, or prior to the recordation in the Patent Office of the said first-mentioned assignment, grant, or conveyance, unless the said first-mentioned assignment, grant, or conveyance is recorded in the Patent Office within three months from its date, or prior to such subsequent purchase or mortgage."

This proposed change would protect the right of the original assignee even though he did not record within 3 months provided that the subsequent assignee had not recorded in the Patent Office within 3 months or prior to the recordation in the Patent Office of the first-mentioned assignee.

Section 212. Joint owners: This section makes a substantial change in the existing law with respect to the right of joint owners. Our committee disapproved of such changes and desired that the section be amended to set forth the existing law. The coordinating committee took the same position and recommended a change which in substance is the same as that recommended by our committee.

Section 244. Damages: While this section was approved by our committee it was its opinion that an endeavor should he made to clarify the section with respect to damages. This can be done by the slight changes recommended by the coordinating committee, which are as follows: Line 1, strike out "the Court" and insert "damages"; after "shall" insert "be" and change "award" to "awarded". Line 2, strike out "damages".

Section 250. Interfering patents: Our committee suggested the amendment of this paragraph in accordance with the language of the existing R. S. 4918. The section thus amended would read as follows:

"Any person interested in any one of the interfering patents or in the working of the invention claimed under either of them, may have relief against the owner of another by civil action, and the court may adjudge the question of the validity of any of the interfering patents, in whole or in part. The provisions of the second paragraph of section 146 of this title shall apply to actions brought under this section."

Mr. FOLK. I would like to state that at that meeting in May, a month ago, our committee passed a resolution unanimously instructing me to secure the changes we have suggested, but not to insist on them if such insistence would jeopardize the passage of the bill. In other words, they consider the bill as a whole a desirable one.

Mr. BRYSON. Yes.

Mr. FOLK. There is only one change I would like to especially call your attention to, and that is in sections 100 and 101, changing the word "art" to "process." I think if that is changed in the patent law industry will live to regret it. In the first place "art" and "process" are not synonymous, and especially with the definition which follows there is likelihood of getting a false impression of what a new process consists of. I hope it will be given serious consideration, but as I said we do not want to jeopardize the passage of this bill.

Mr. ROGERS. I think the words "useful process" and "art" are not synonymous in any particular and have two distinct meanings.

Mr. FOLK. Yes, some of the courts have held quite properly, as Mr. Federico pointed out, that "process" has been held by the court to come under the term "art," in new machine and composition of matter.

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That is true, but there are arts which are not processes, and I am afraid that there may be something cut out of the present statute, especially when it comes to the question of what new use consists of. You will find that definition includes new use, process, machine manufacture, or composition of matter. Now, composition of matter under new use is not a process necessarily. The new use of a machine may not be a process. It is simply a new use, and if it is not obvious to one skilled in the art, and otherwise complies with the requirements of the title, there is no reason why it should be limited in the way I think the definition does limit it.

Mr. ROGERS. Are you satisfied with the definition as set forth in section 231 dealing with infringement of patents as recodified there?

Mr. FOLK. That is all right.

Mr. BRYSON. I notice you did not make any recommendation for any changes on that.

Mr. FOLK. Yes.

Mr. ROGERS. Have you compared your recommendation with that of the coordinating committee?

Mr. FOLK. Yes. I attended all of the sessions of the coordinating committee and am perfectly familiar with them. In general we agree, although there are a few exceptions. Most of them are of minor importance, just a question of choice of language largely. Of course, we are going to live with this statute for many years, or others are—I think this is my last appearance before any committee of Congress.

Mr. BRYSON. We hope not, Mr. Folk. How long have you been a student of patent law, Mr. Folk?

Mr. FOLK. I will say that in 1898 I went into the Patent Office as an examiner. I examined patent applications for a couple of years. I was then promoted to the Interference Division, and for the next 5 years I wrote opinions on priority questions that come up in interferences, which were then appealable to the court of appeals in the District.

Then I engaged in the independent practice of law in Chicago for 10 years. At the end of 10 years I was asked by the American Telephone & Telegraph Co. to take charge of some of the litigation they had pending with regard to electronics. I saw that there was so much to be done that I entered into their employment in June of 1915, and continued with them until April 1937, when I reached retiring age.

I then took up this work with the National Association of Manufacturers. They asked me to do so, and I agreed to do so for 3 months, thinking that the hearings of the Temporary National Economic Committee would be concluded at the end of 3 months. I am still with the NAM after 13 years.

Mr. BRYSON. So that you have been actively engaged in patent work for more than 50 years.

Mr. FOLK. Yes, more than 50 years—53 years to be exact.

Mr. BRYSON. Longer than many members here have been living.

I would like to have the record show that I was delighted to find in talking to Mr. Folk that he is a native of our State.

We are very glad to have you here, Mr. Folk.

Mr. ROGERS. You do feel that the definition as given in this section 231 is sufficient protection to the manufacturers on infringement as defined in this bill?

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Mr. FOLK. There was no particular objection to that from our committee and I think that is all right.

Mr. BOGGS. Mr. Chairman, unless counsel of the committee already has it available here I would like to get more examples of how this change of language from "art" to "useful process" affects the situation.

Mr. FOLK. I merely commented on it very briefly. I should be glad to prepare an additional memorandum on the subject if you wish.

Mr. BOGGS. Personally I would like to have it.

Mr. FOLK. I would be very glad to do it.

Mr. BRYSON. Yes, if you will, supplement your statement on that.

Mr. FOLK. I know that industry as a whole is opposed to the change. I do not know why the bar association is not. I am a member of the New York Patent Law Association and the American Bar Association.

Mr. BRYSON. If you will supply us with a memorandum on that we will appreciate it very much. Thank you.

Mr. FOLK. Thank you for your courtesy.

(The memorandum requested is as follows:)

SUPPLEMENTARY STATEMENT RE SECTIONS 100 AND 101 OF H. R. 3760 SUBMITTED BY GEORGE E. FOLK, ADVISER TO THE COMMITTEE ON PATENTS OF THE NATIONAL ASSOCIATION OF MANUFACTURERS

We are in full accord with the objectives sought to be accomplished by the language of sections 100 and 101 of H R. 3760. That is, that it should be made clear that processes may be patentable as such, and that a new use of an old invention may also be patentable. This is in accordance with decisions of the Supreme Court. We fear, however, that the language of these two sections, instead of clarifying the subject, becloud it, and may lead to the necessity of the Supreme Court giving intepretations to the changed language.

The present statutes, Revised Statutes 4886 (35 U. S C. 31), state 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 * * *" may upon complying with certain requirements of law obtain a patent therefor. Section 101 substitutes the word "art" for the word "process," so that section 101 reads: "Whoever invents or discovers any new and useful process, machine, manufacture or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."

Section 101 defines the new term "process" as follows: "The term 'process' includes method, and a new use of a known process, machine, manufacture, composition of matter or material." It is to be feared that this definition of "process," as including a new use, may possibly lead to a construction whereby if the new use cannot be classified as either a process, machine, manufacture, composition of matter or material, it is not within the class of patentable subject matter. Such possible construction would not apply if the term "art" is retained; since the term "art" has a much broader significance than has the term "process."

The substitution of the term "process" for "art" did not occur in the committee print, nor did it occur in any of the preliminary redrafts sponsored by the coordinating committee. Nor did it occur in H. R. 9133. It makes its belated appearance in H. R 3760.

It is probable that the term "art" was originally intended as a catch-all to classify as patentable subject matter what could not be definitely included under either a machine, manufacture, or composition of matter, but which was still a new art. It is fortunate that this term "art" gave the court an opportunity, as it did, to hold that processes came within the scope of the term "art," and that the new use of certain old inventions likewise came within the scope of the term "art."

This catch-all interpretation of the word "art" is found in an able and well-known publication, Robinson on Patents (sec. 164).

The Patent Act of 1793, section 1, provides for patents by any persons who "have invented or discovered any useful art, manufacture, engine, machine, or device, or any improvement therein * * *." This act was in effect until the

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act of 1836 which provided, in section 6, for applications for patent by persons "having discovered or invented any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter. * * *"

The act of 1870 substituted language which is now found in Section 4886 of the Revised Statutes above referred to, retaining, however, the term "art."

Thus, in all previous patent acts the term "art" is found as one of the classes of patentable subject matter. The courts have construed the term as covering a process, and even that the new use of a machine may involve a process.

It is hardly necessary to review the leading decisions of the Supreme Court on the subject of what is included in the term "art." We should not, however, lose any advantage from the often reiterated statements by the Court on this subject. This advantage may be lost if the statute drops the word "art" and substitutes therefor a new term "process," with a new definition thereof.

It would seem preferable if in section 101 of H. R. 3760, in the first line thereof, the familiar term "art" be substituted for the new term "process." The section would then read: "Whoever invents or discovers any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereof may obtain a patent therefor, subject to the conditions and requirements of this title."

Then, to clarify the statutes to comply with holdings of the Supreme Court, or what is not inconsistent with such holdings, it is suggested that the term "art" be defined in section 100 so that paragraph (b) thereof be changed to read substantially as follows: "The term 'art' includes a method or process and a new use of a known process, machine, manufacture, or composition of matter."

We feel that this subject is of sufficient importance to warrant a careful scrutiny before making the changes indicated in sections 100 and 101.

## STATEMENT OF JENNINGS BAILEY, JR., CHAIRMAN OF SECTION OF PATENT, TRADE-MARK, AND COPYRIGHT LAW, AMERICAN BAR ASSOCIATION

Mr. BRYSON. Mr. Jennings Bailey, Jr., chairman of the section of patent, trade-mark, and copyright law, American Bar Association.

Mr. BAILEY. Yes, sir.

Mr. BRYSON. Please identify yourself for the record.

Mr. BAILEY. Jennings Bailey, Jr., Washington, D. C. I am chairman of the section of patent, trade-mark, and copyright law of the American Bar Association.

Mr. BRYSON. You may be seated, if you like.

Mr. BAILEY. Mr. Chairman, the American Bar Association is composed of a number of sections in addition to the association as a whole.

The various sections, however, are no more qualified to speak for the whole association than this committee is qualified to speak for the whole Congress. Nothing is final action of the association until it is approved by the house of delegates of the association. That house of delegates meets twice a year, and as a result we have to have a section meeting, and then we have to get approval by the house of delegates, and the work of the association in some ways is rather slow in getting complete approval.

We had a special meeting of the section of patent, trade-mark, and copyright law in Washington not long ago, at which this matter was thoroughly discussed for 3 days, and, as Mr. Ashton said, many prominent patent attorneys were present at that meeting.

I cannot express to this committee the position taken by the section at that meeting because there has been no opportunity to present that action to the house of delegates, and I am only authorized to speak as to such matters as have been approved by the house of delegates. However, there have been a number of past actions of the

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association approving in principle a number of changes in substance made by this bill. As to the other changes that are made in the bill, so far as I know, as to substantial changes there has been no opposition by the American Bar Association, and the bulk of the bill merely represents codification in language of the present law. If the law is there we do not bother the association asking them to approve it, so we have no trouble about most of this bill. We have gone along with it. The coordinating committee made a number of suggestions for changes in language which clarified the meaning of various sections considerably, and a considerable number of those changes, in fact, most of them, have been adopted and appear in the present draft of the bill.

I think I can also go so far as to say that at the patent section meeting in March there was no enormous opposition to the principle of any section in this bill, although there was naturally some opposition, and much discussion as to language.

Now, the patent section of the American Bar Association would not consider this a perfect bill, because there are a number of changes which have been advocated in the past by the association, and which we will ask the committee at some later date to have included in the patent laws.

However, some of them are unquestionably quite controversial. The bill, as a whole, is certainly a step in the right direction, and in the belief that half a loaf is better than none, I think we can say in general that most parts of it, at least, have been endorsed by the American Bar Association or merely represent the present law.

I would like briefly to refer to a few specific changes in the law that the association has approved. First, section 3 of the bill, the provision allowing an Assistant Commissioner to act in the absence of the Commissioner, or in the case of disability.

Section 115 allowing a single signature to patent applications instead of the old practice under which we had to have applications signed at three different places.

Sections 116 and 206 insofar as they contain the principle by which an inventor who has been improperly included in the application without fraudulent intent may be eliminated without invalidating the application or the issued patent.

Section 119, the second paragraph which requires an applicant claiming benefits under the international convention to file a certified copy of his foreign application in the Patent Office.

Section 121 and the reissue section insofar as allowing the divisional or reissue applications to be signed by the assignee but not requiring the signature by the inventor himself.

Section 146 which allows a patentee who has lost in the Patent Office to have some choice of remedies on appeal, namely, that he can go either to the Court of Customs and Patent Appeals or to the district courts, and the same section which allows a proceeding in the district courts to be brought against the record owners in the Patent Office.

Section 202 defining the intervening right in the event of the reissue of a patent, and section 203 insofar as it revokes a present rule that if one claim is invalid the whole patent is invalid, or requiring the applicant to file a disclaimer.

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Mr. Chairman, those are the substantial changes which the patent section of the bar association has approved.

As to specific changes in language which have been suggested to the coordinating committee, and most of them have been adopted, I would not want to burden the record with them here.

Mr. BRYSON. Did your section sit in with the coordinating committee?

Mr. BAILEY. Yes; we had one or two repersentatives at every meeting of the coordinating committee, and they gave careful consideration to everything we had to say.

Mr. ROGERS. Mr. Chairman.

Mr. BRYSON. Mr. Rogers.

Mr. ROGERS. Do I understand the things you have outlined have been approved by your committee and were also approved by the house of delegates of the bar association?

Mr. BAILEY. Everything I stated has been approved either by the house of delegates or in an earlier procedure by some other body of the American Bar Association.

Mr. BRYSON. Thank you very much.

## STATEMENT OF CECIL C. KENT, FETHERSTONHAUGH & KENT, WINNIPEG, CANADA

Mr. BRYSON. We have a distinguished visitor here from Canada, Mr. Cecil Kent. Mr. Kent, will you come around and will you identify yourself for the record?

Mr. KENT. Yes. My name is Cecil Kent, Winnipeg, Canada, and I would like the opportunity of speaking to Mr. Bryson's bill on my own behalf as a patent attorney and as a reader and student of the philosophy of patent law.

Mr. BRYSON. Do you have a prepared statement?

Mr. KENT. Yes, I have, Mr. Bryson.

Mr. Chairman and gentlemen, I greatly appreciate this opportunity to testify on behalf of Mr. Bryson's bill H. R. 3760. As a Canadian patent attorney registered to practice before your Patent Office, I represent a number of Canadian manufacturers and private inventors who have applications pending in this country. That is because our economy is very closely related to yours. And our Canadian patent law is also very similar in a general way.

Now, this bill is significant in that if it becomes statute law in anything like its present form, I understand it will represent the first major revision in the United States patent laws in nearly 80 years. And if it becomes statute law it will, in my opinion, provide a vitally needed stimulus to free creative enterprise. Society and its technology has gone through profound changes in the last 80 years, profounder possibly than in the preceding 350 or more years. It has been a period of great industrial expansion and your Patent Act, to a useful extent has, I believe, assisted that expansion. The last 20 years, however, have seen a very pronounced modification of the previous expansion—a modification that is in favor of increasing security and protection for the individual in society, but of course at the cost of increasing taxation and governmental control. It is not my intention to criticize this trend, but simply to suggest that it tends to stifle creative or inventive ingenuity, for it is necessity which is the mother

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of invention, and any measure which can be enacted which will offset the inertia caused by too much protection and by too much time spent on filling out forms, and so forth, should be encouraged. When material progress is arrested for any reason it is seldom merely halted, but is more often in some way or other thrown into reverse gear. Living processes, including human society, never stand still. It either advances or declines in terms of the over-all pattern according to all we have been able to observe scientifically and historically.

Now, in two important respects, Mr. Bryson's bill, in my opinion, paves the way toward a more mature and scientific way of thinking about patents in our present-day industrial society. One of these concerns the concept of invention. The other which is the last paragraph of section 112, concerns the use of functional clauses in patent claims—something on which I have already had a good deal to say in various writings and before meetings of patent attorneys in this country and Canada. So it is to these subjects—concept of invention and functional claiming—that I would like to address the main portion of my testimony. After that I would like to be allowed to propose an amendment to the section of the bill covering design patent, section 311.

The subject matter of my testimony therefore falls into these headings: (1) "Concept of invention," (2) "Functional definition in patent claims," and (3) "Scope of protection for design patents."

In talking about invention, I would like to do so as a patent attorney who became a patent attorney (18 or so years ago) as a result of some slight aptitude for inventing mysef. I was also interested in descriptive writing, psychology, and logic, and so, although I have never patented anything to speak of myself, I have made many patentable improvements for clients as well as thinking up a number of ideas of a nonpatentable kind. Most significant perhaps to my testimony this morning is that in all the inventions I have made or worked upon for others, the personal history of its evolution has always held a fascination for me. Besides reading extensively on the subject, I have subjected a number of my ideas to considerable introspective analysis to try and find their germinal points.

As a result of all this I have formed certain ideas about the so-called inventive act. Or rather, it would be more proper to say, I have independently confirmed what I am continually finding out are the views of scientists, psychologists, and so forth, namely that words like "invention," "creation," and so forth, have become surrounded with an enormous enveloping cocoon of metaphysical hocus-pocus. Scientifically, the simplest explanation of the whole phenomenon of so-called invention is that change is going on constantly and unceasingly everywhere, all the time, in ourselves and the external world. But most of these changes are very slow. So we do not notice their infinite gradualism. We only notice, from time to time, the accumulated results of a period of slow persistent change. And when one person, say a scientist, first feels the effect of a series of imperceptible changes in some aspect of nature and remarks on it, the layman may think it's hardly a change worth considering, while other scientists will agree that it is a highly significant change which has taken place, and a highly penetrating observation or set of observations which revealed it. So with inventing, when it comes to making practical use of a totality of many little changes, new practices, and so forth,

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assiduously observed and absorbed by a given investor, and society grabs at that use, I think that invetor should be given a patent if it is possible to do so, and moreover that such a patent should be made somehow or other to stick, and not simply be a governmentally sanctified fraudulent piece of paper.

Now I take it that the intent of the definitions covered by section 100 in Mr. Bryson's bill and the conditions for patentability covered by section 103 have been drafted in the hope of eliciting reactions from the court which are more benevolently disposed toward patented ideas which may ordinarily appear slight, unspectacular, and not especially remarkable to the judicial kind of mind. If that is the purpose of the section I can well agree that as presently worded they may represent the best compromise at this time.

If sections 100 and 103 are embodied in a new patent statute, it seems to me they should have the desirable effect of directing your courts to the newer, more mature orientation which is commencing to prevail toward free but protected creative enterprise in our modern industrial society. With these sections made law and with assiduous public education by way of good magazine articles by members of the patent profession and the inventive public, I can see a future of more harmonious cooperation between that small but immensely valuable creative body in society and the much larger consuming body. Up to now, I should not say that on the whole the relationship has been too good.

Mankind is by nature predatory and the numerically small, perceptive, and sensitive advanced elements of society who we call creative, such as artists and inventors—and it is surprising how many inventors have been artists: Samuel Morse, Fredric Ives, Louis Daguerre, Leonardo da Vinci, and so forth—they have been easy victims. Added to this is the fact that one purpose of the courts is to interpret the inchoate will of society in the main, and thus the problem is admittedly a thorny one. Independently of all this we have the added consideration that courts are probably seldom innately orientated toward art and invention to any experiential extent. Judicial minds, or at any rate those which aspire to the bench, are more concerned with synthesis—sameness finding—while the inventor is more concerned with analysis in the hope of difference finding. Synthesizing ability must be possessed by judges in high degree to discover those principles of sameness in principle which dwell in apparent differences. It is very necessary that judges be able to notice those features of similarity, or sameness, in each new issue that comes up before them so they can apply the nearest law with a minimum of change and bring the problem within its scope. But this same tendency to look for the similarity of pattern is probably at the crux of their difficulty in appreciating a patented invention or an invention sought to be patented. For the inventor, by contrast, is concerned with detecting the differences which dwell in apparent similarities. I do not wish to imply exact polarity or oppositeness between synthesis and analysis. These abilities of course are mixed in all of us. I only wish to emphasize that in over-all terms, inventive activity, creative activity, probably involves more analysis than synthesis if the actual mental steps could be analyzed, while with judicial reasoning processes the tendency is the other way. In a word,

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the inventor introduces change (improvements) on the level of fact while the courts deny it is an improvement on the level of language.

For one of the outstanding examples of destructive sameness finding in recent times, I commend you to the observations of Mr. Justice Douglas in the Supreme Court case of *Great Atlantic & Pacific Tea Company* v. *Super-Market Equipment Corporation*, of December 1950. In that opinion the granting of a number of minor patents of considerable commercial utility but low inventive novelty (all more than 50 years old, incidentally) was most strongly condemned, and so I would like to draw attention to what I think may be an oversight characterizing this sort of familiar disparagement of small inventions and gadget patents by the courts and others. It is this:

If it hadn't been for a host of minor patents issuing week in, week out, building up coral islands of technologic know-how, this one patent which gets it in the neck by the Supreme Court might either not have been invented, or else might quite conceivably be considered only the remarkable but fanciful contrivance of an ingenious psychotic, having no practical utility in a patentless society. I think you will all agree that our society would be very different but for the incentive of the patent system. I am not urging that the patent system has been an unqualified boon to mankind. I am simply suggesting that society would have been different and most people, I believe, take it for granted that it would be less technologically advanced.

So you see, the slight patents of today so often contemptuously dismissed as "trifles," "gadgets" are really the cumulative result of a reservoir of earlier and equally slight inventions. A tremendous amount of all we see around us today in our material culture had its origin in the Patent Office.

Not all made money—only a very little made money, but a great deal of the rest, insofar as it was good copy for magazine editors, science writers, and so forth, found its way into the general knowledge of the more technically minded, some of whom used it to make further patented inventions, and so on. Our accumulated creative know-how as it exists today is the end result of this continuous, dynamic process.

So, since Mr. Bryson's bill introduces a newer and more benevolent concept of inventing, it may be rewarding to try to understand not what inventing is, but what the class of persons we call inventors, do. When following the activity we must call inventing (for want of a better word), I incline to agree with C. Spearman, a psychologist whose work I shall refer to presently, that essentially what we do when engaged in the so-called creative act is to take two or more similar or different ideas or objects known to us and observe their relationships when put together or tested together in various ways. We notice what significant and different happenings take place through their being together in various quantities, positions, or when moved with respect to each other in different ways or at different times. Thus some primitive ancestor of ours, by placing a stick and a stone together a certain way, and rotating the stick, was able to produce the result we call fire, in a new way. Almost certainly he was not searching for a way to produce fire. It is far more likely that the discovery was an accidental one, stumbled upon during play, like most primitive inventions.

But the point is that we tend to notice what happens when two or more things are put together in a novel manner or when we subject

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two or more abstract ideas to a mental-relationship analysis. And we ask, "What possibilities have these happenings?" Then, as possibilities emerge, we construct, either in our minds or on paper or with materials, structural refinements which will help these happenings to occur again more efficiently and with more regular predictability. These again we analyze and accept or reject in increasing profusion until we reach what we choose to consider a conclusion.

Viewed in this step-by-step way it would appear that in terms of quality there is little difference between a so-called great invention and a small invention, although in terms of quantity—or the actual number of individual steps—there can be a very big difference. And, of course, each step in a long and complicated succession of individual steps would involve the additional mental process we call by such names as judgment, reasoning ability, and so forth.

So my belief is that so-called inventive ability is mainly a matter of how much background knowledge a person has soaked up and can force himself to usefully recall—this, plus a "set" or orientation toward the idea or concept of change rather than the concept of stability and unchangeability. There is quite an extensive literature on the nature of creative thinking which I believe this committee might read with considerable profit toward clarifying this matter of inventive genius. Here is a short list:

1. Your Creative Power, by Alex F. Osborn (of the well-known advertising firm of Batten, Barton, Durstine & Osborn).
2. How To Think Creatively, by Elliot D. Hutchinson.
3. Productive Thinking, by Max Wertheimer.
4. Creative Mind, by C. Spearman.
5. The Art of Thinking, by Ernest Dimnet.
6. Invention and the Unconscious, by J. M. Montmasson.
7. An Anatomy of Inspiration, by R. E. M. Harding.
8. The Psychology of the Inventor, by Joseph Rossman.
9. The Creative Adult, by Hughes Mearns.
10. The Art of Thought, by Graham Wallas.

I would also draw to your attention the following articles:

The Relation of the Scientific Hunch to Research, Platt Journal of Chemical Education, page 1969, October 1931.

Articles in Journal of the Patent Office Society of January 1945, June 1948, January 1950, and February 1951, by C. C. Kent.

Even a cursory reading of a few of the above titles will, I think, convince any of you who had any residual doubt, that the attitude toward creative or imaginative activities of the mind, by scientists, psychologists, anthropologists, etc., is not the metaphysical one which some judges appear to have. Neither is it the almost completely negative one which other judges exhibit.

I should perhaps remind you that the idea of inventive genius—that something beyond newness and usefulness—was unknown in the United States until 1850, and then it only came to be a factor in decisions following the leading case of *Hotchkiss* v. *Greenwood*, and not by any legislative enactment on the subject. But that decision provided a precedent which could effectively demolish and patent—Alexander Bell's telephone patent, Marconi's wireless patent—anything. Let's take for example the invention of the Diesel engine by Mr. Rudolf Diesel. If an uncharitably disposed supreme court—

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(your Supreme Court or the Supreme Court of Canada or its equivalent in England, for example) should have got its hands on the Diesel patent it could easily have denied "inventive genius" to the combination which constituted the invention by asserting something like this: First, that the idea of compressing air to the point where it would ignite a charge of fuel was noninventive since everyone who had ever used a bicycle pump knew that air heats up when compressed. Secondly, that the amount of fuel mixed with a given volume of air was merely a matter of critical percentages well within the experimental skill of a chemist who, by a merely routine set of tests could easily determine the conditions of optimum combustibility.

Thirdly, as to the forced injection of the fuel, the courts might have said: "What could be more obvious than that? Things like hypodermic syringes have long been known for injecting liquid charges by piston and cylinder means." Well, that is just a suggestion as to how the immensely valuable Diesel patents might have been invalidated and I can assure you that such arguments could be applied to every great patent which has ever issued without exception. My brothers in the patent profession will, of course, remind me of the powerful body of case law which prohibits the building up of a mosaic of anticipating structures to defeat an invention or a patent. That is true, but what I am concerned to show here is that every big invention is really only a quantity, a plurality of small inventions. If I can succeed in satisfying you of that, then I think it would not be difficult to satisfy yourselves that an invention embodying only one or two steps, or at any rate only a few steps should, if valuable in its results, be as fully entitled to a valid patent as one involving a long chain of steps.

To coin a set of aphorisms:

1. All that mankind can do is to rearrange what he finds in the world.
2. Scientifically speaking we do not "invent."
3. We can only reorganize known structures and thereby produce new relations.
4. These new relations can produce new results.

You see the essential prerequisite to making a practical, successful invention, as in solving any scientific, legal, business, or any practical problem, is to ask oneself the right questions. That sounds easy but, in fact, it is often insuperably difficult. It is in the formulation of the exactly right set of questions that the creative act really lies, whether it be a piece of predominantly creative synthesis or a piece of predominantly creative analysis we are working on. For you cannot give a precise answer to a vague question. But that's what most of us spend most of our time doing—and, of course, we get vague answers. Unsuccessful inventors get vague inventions—unsuccessful, impractical inventions. But when we ask precise questions, the answer is generally at hand. It appears often as if by magic, and it's so easy to label a thing or solution "obvious" after its accomplishment. It generally is obvious. But we fail generally to realize where the real merit lies—in the formulation of the problem—before its structural solution could be arrived at.

Consider Newton's third law of motion for example. (Not a patentable invention, but a good example.) It states: "To every action there

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is an equal and opposite reaction." Well, in a sense it's the very last word in obviousness. Not only mankind, but every moving organism in nature "knows" it, in the sense that it makes use of the law constantly—the squirrel when it jumps from branch to branch, for instance. But Sir Isaac Newton, with our human faculty for language making, asked an ingenious question. The question was: "Can it be that for every action there is an equal and opposite reaction?" Having asked it, it was easy to establish by experiments that such was indeed the case. He probably put to himself numerous preliminary questions of course. But the affirmative proof of the final question is a cornerstone of Newtonian physics, and was revolutionary in its consequences. The formulation of a progressive set of consistently precise questions (even though we are generally not consciously aware of doing so), is, I believe, of the essence of scientific discovery and invention.

Gentlemen, you will understand that I speak predominantly for the small manufacturer and the private inventor. I am not interested in the great corporations, for whom I should imagine the patent system in its present state is all too well suited. It is well suited to the circumstances of the great corporations because of the technical complexity of patent law and the high cost of litigation arising out of that complexity. Furthermore, it is becoming increasingly the case that it is only the wealthy corporations which can produce ideas likely to lead to valid patents. This is because they have vast research facilities. The small manufacturer and the private inventor, on the other hand, are greatly handicapped. They are handicapped in no less than three ways. First, by only being able to draw on a personal background of knowledge or that of a limited staff, and experiment with meager facilities so that there is less likelihood of the development of any worth-while patentable invention. Second, any patent obtained is less likely to be held valid through its probable greater simplicity or obviousness. Third, the economic disadvantage suffered by the small business resulting in lack of advertising and distributing power, capital equipment, etc.

I would like to advert to my earlier reference to a society without a patent system—without a system for rewarding technical innovators. I am aware that some antagonists of the patent system are fond of saying that society would be much as it is had no patent system been instituted. Very obviously it is impossible to prove or disprove such assertions. I only suggest that such a proposition is as unlikely to be the case as it would be if the idea of the joint stock company—shareholding corporation—had not been thought of. But even if it be admitted all that has been invented and commercially adopted would have been invented and adopted in a patentless society—even if this be admitted, please consider all the vast wealth of ideas, suggestions, and so forth, contained in the printed publications or patents not adopted commercially. Only a very small percentage of things patented get taken up commercially. There is a tremendous waste just as there is in nature. But yet, because of the patent-office publication system it is by no means a complete waste on a more mature view. For most of the so-called unsuccessful patents contain, in one way or another, valuable leads to those who come after. Because we have a patent system, in your country and in mine, inventors were encouraged

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to publish their inventions in exchange for getting a patent and the hope of gain which went with it. Without a patent system what incentive would there be for this army of inventors to publish their ideas so that one in a thousand learning selectively from the others might develop an economically valuable invention. The 700 to 1,000 patents a week which have been issuing week in and week out, year in and year out for the past 50 years or so, are repeatedly scrutinized by science writers for the popular-science press, which alone has a monthly sale today of nearly 4,000,000 copies. These inventive incrustacea, these technologic coral-island builders, with all their unsuccessful but duly published ideas, when taken collectively, are every bit as vauable as the so-called inventive genius. Without them he couldn't be the genius he is hailed to be. Just as Andre Malreux says in his monumental History of Art that the only inspiration for a work of art is an antecedent work of art, so the only inspiration for an invention is an antecedent invention. And that seems to me to point up the crucial fallacy in the reasoning of people like Mr. Justice Douglas in his dismissal of the ostensibly slight invention. Such searing denunciation can wither independent creative enterprise no end when you consider the extent to which it is given publicity. I said just now there is a colossal mortality in the world of invention. Yet up to now it had survived (albeit to an attenuated extent). But like a species in nature, mortality can commence to run against survival. This happens when conditions become too precarious to make life worth living. We are in danger of this happening in the patent system.

Mr. BRYSON. Mr. Kent, I am not snre that you understand the situation here, but we were advised this morning by special notice that the bill which is under debate in the House now would require our presence on the floor.

Mr. KENT. Yes.

Mr. BRYSON. It is now 12:15, and the members will have to report to the House.

Mr. BOGGS. Mr. Chairman, so that the present witness will not have to come back I suggest that his entire statement be incorporated in the record.

Mr. BRYSON. Yes, we will be pleased to have your entire statement in the record. If you would like to do that you may do so.

Mr. KENT. I would like to, Mr. Bryson.

(The balance of Mr. Kent's statement is as follows:)

Up to now the high mortality rate among patents has probably been no higher and the cost no greater than the cost of mistakes written off to the average experience an dencountered every day in business and in life generally. The only bad thing about it is the false promise of validity which the otherwise commercially successful patentee gets taken in by. That is bad. And it has most eloquently been argued by Ford W. Harris, in the Journal of the Patent Office Society, No. 12, volume 32, December 5, 1950. I would like to read some extracts from this paper:

> "The public has little interest in whether or not these new things were the result of a flash of genius or the result of long and expensive research and development. The benefit to the public does not, in any degree, depend upon how the new things were produced. Moreover, the public is the ultimate judge of the value of the advance. Unless the new thing is substantially novel and useful, the public will not use it. Our troubles started years ago with *Atlantic Works* v. *Brady* (107 U. S. 192, 27 L Ed. 438), which held "it was not the intention of the patent laws to grant a monopoly for every trifling device, every shadow of a shade of an idea." This statement was approved in *Thompson* v *Boisselier* (114 U. S 1, 29 L. Ed. 76); *Western*

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*Electric Co.* v. *Rochester Tel. Co.* (145 Fed. 41), and other cases over the years culminating in *Cuno Engineering Corp.* v *Automatic D. Corp.* (314 U. S. 84, 86 L. Ed. 63), in which it was said that 'the new device, however useful it may be, must reveal the flash of creative genius, not merely the skill of the calling.' The Cuno case related to the cigarette lighter now found in substantially every automobile, and the words 'however useful' appearing in the Supreme Court's opinion tacitly recognized that this device was very useful. As far as the benefit to the public was concerned, of course, made no difference whether or not the new thing was the result of a flash of genius, and the public has certainly benefited by the new lighter to a very great extent. There is no very logical basis for the objection to patents on trivial inventions; that is, inventions that are merely small contributions to the art. If the step in the art is of no value to the public, the public will not use the invention and the patent is a harmless nullity. If the public finds a trivial invention useful in any degree, it will pay for the use of it to an amount proportional to its demonstrated utility, and it is no more than fair that it should do so. On the other hand, the value of any step in the art is very hard to predict in advance. After the patent has issued the degree of public acceptance may fix its value.

"Established industries move in small steps and not by flashes of genius, and progress by such small steps should be encouraged by patents It is hard to understand the courts' abhorrence for such small steps. However, if we agree that there should be some floor to the degree of utility, it is entirely unnecessary for the Patent Office to use the fiction of invention to establish and maintain it. The Patent Office is fully empowered by R. S. 4893, 35 U. S. C. 36, to screen out and refuse to issue trivial patents as, under this statute, the Commissioner is empowered to refuse to issue a patent on any invention if he considers it is not sufficiently useful and important to merit a patent. This is exactly what the average rejection for lack of invention over the prior art means. The examiner tacitly admits that the application has made a step in the art but holds that the step was not of sufficient extent to merit a patent. Now it is entirely fitting and desirable that the Patent Office should retain this power. An examiner is the sole bargaining agent for the people of the United States in negotiating with applicants for patent. Every application is an offer by the applicant to allow full particulars as to his invention to be made public in return for the allowance of certain claims presented in the application, and the prosecution of the average application proceeds by a series of offers by the applicant as to claims he is willing to accept as his price for the bargain.

"It is obviously proper for the Commissioner, through his deputy, to refuse to make a poor bargain for his principal, the public. It is strange that, if the Commissioner refuses to make what he thinks is a poor bargain, we are now able to go to the courts and ask them to make such a bargain If any person offers to buy anything else from a Government agency and the agency refuses to make the bargain, he cannot take the matter to any court. Obviously, it is my opinion, the Patent Office should abandon rejections for lack of invention over the prior art but retain and exercise its right to reject claims on the ground that, in the opinion of the examiner, the invention claimed is not sufficiently useful and important to merit a patent. I also think that such a rejection should be reviewable by the Board of Appeals but should not be appealable to any court. In other words, I think if the Patent Office decides it does not think it should make the proposed bargain, that should settle the matter.

"The applicant would be only negatively injured by such a refusal to grant a patent. His invention has been maintained in secrecy during the pendency of his application and if his application is rejected no disclosure is made to the public. He is exactly where he was before he made his application. He has failed to make a bargain and therefore, there is no contract to rescind or reform.

"Practically there is very little harm resulting from the examiner's hiding behind this fiction of invention except that arising from waste of time in arguments over the rejection for lack of invention which are upon a metaphysical plane; metaphysics in this, and other cases, being merely one person talking about something he does not understand, and cannot prove, to another person who does not understand him and cannot disprove what he says.

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"Great harm, however, is done by the courts under this fiction. An applicant has made an advance in the art and convinced the Patent Office that his advance is sufficiently useful and important to merit a patent. A bargain has been made, the applicant's price has been paid by the publicizing of his invention and he has obtained a patent containing some claims. (But, notwithstanding this bargain, if the patent is involved in litigation) the court simply considers de novo a question already decided by the Patent Office and if the court decides that the patent was invalid due to lack of invention over the prior art, it is simply holding that the Patent Office made a poor bargain. It rescinds the bargain, takes away the patentee's rights due solely to a mistake in judgment by the Patent Office, the applicant not being at fault in any way. Of necessity, it allows the public, whose agent, the Commissioner, made the bargain, to retain all the advantages arising from the bargain, since the applicant's invention has been fully disclosed to the public. The inventor has lost due to a triple play of the legislative to the administrative to the judicial departments of the Government. Congress promised to give him a patent if he conformed to certain statutes, the Patent Office checked to see that he so conformed, and the courts nullified the whole deal."

The patent records old and new are being scanned by searchers by the hundreds every day year in and year out, the purpose of which can roughly be put under these headings:

1. On behalf of inventors who believe they may have a new idea.
2. By engineers, etc., in search of ideas
3. By science publishers who publish collectively around 4 million copies of magazines per month, as I have already stated.
4. By attorneys searching to find anticipations to defeat patents already granted.

The last form of searching, in my opinion, is wrong And my contention is pretty much what I take to be that of Harris, whom I have just quoted, although it is not exactly in line.

My suggestion is this: That the great body of technical know-how in the United States Patent Office, should remain available to public study as it is now, but that it should no longer be citable as prior art, unless, it is under 25 years old I mean it should no longer be possible to support the refusal of a patent solely by the production of any printed material published more than 25 years ago. You will thus recognize that I would allow the repatenting (subject to some restrictions which could, I think, only be satisfactorily elicited by study) of anything which was a practical, modernized version of a patent, publication, etc., more than 25 years old, provided of course that any public use of the published or earlier patented idea had also been abandoned for more than 25 years, and provided that such repatenting would not be permitted until the modernized device were actually on the market, and then only for terms varying, I should say, from 1 to 5 years at the discretion of the Patent Office. Intention to apply for a repatent would have to be made, say 8 months ahead of a contractual manufacturing date, and a bond of indemnity for nonperformance might have to be posted. Intention to apply for repatent would also have to be well and thoroughly published to the trade so that the regrant could be opposed on production of proof of user or publication within the last 25 years.

Whether the proposals I have just sketched would stand up to the rigorous analysis of a panel of experts seriously considering them remains to be seen. All the same, I am surprised how well they have stood up to the objections which have confronted me in a desultory way during the years since I first formulated the proposal. You see, it is as Mr. Harris, whom I have been quoting, said, that the public has little interest in whether a new thing is a result of a flash of genius or how the new things were produced. I don't think the public either cares when the new thing was originally produced. As a matter of fact, I think that what Dr. Samuel Johnson said about story-writing is very applicable to inventions, that if it's good it's not new, and if it's new it's no good. And this whole question of newness, what does it mean anyway? To whom should an invention be new? Why should an invention have to be new in the fictitious sense of being "unborn knowledge" on both the scientific and the popular levels? Wouldn't it be of more benefit to the public if the word "new" in the patent sense meant "information currently or recently made available to the public in concrete manufactured form"?

My proposal of terminating once and for all the Patent Office citation of what I call ancient anticipations would permit the regrant of patents for short

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terms under conditions which would insure that the public would get the benefit of the invention. At the present time there are many patents which have long since entered the public domain. A small percentage were once produced commercially. Others were patented before the market was ripe for their commercial exploitation Anyhow, whatever their history, my proposal would insure that such old patents if regranted, would be new as usable experiences to the contemporary generation. It is one of the standard arguments for the grant of limited patent monopolies in the first place that (a) nothing is taken away from the public which it formerly enjoyed and (b) that the monopoly is given to the public after a limited period for enjoyment of reward. But the crucial fact is, and remember I am speaking more particularly of the inventions of small manufacturers and private individuals, not the big developments of great corporations so much—that if a patented invention is not taken up commercially during its lifetime it won't get taken up after it has expired for the reason that no nursing-period protection can be obtained upon it again Consequently the public doesn't get the benefit of it anyway. Every patent attorney, I am sure, has had the experience of clients coming into their office with an idea, often in a field they are wholly familiar with and declaring that a search is quite unnecessary because they know that nothing like it has appeared before. Accordingly they want to patent it and commercialize it forthwith. The patent attorney, however, points out that it often happens that a search shows an idea to have been anticipated years before even when that idea has been made by someone who has been in the trade all his life. So reluctantly your client agrees to a search, and you make it. You find what you half expected to find, namely, that the thing has been done before, much to the disgust of your client who invariably, according to my experience, washes it right out of his mind forthwith. Who is the loser? The public, surely, is the biggest aggregate loser in these cases.

Then there are those inventions on which it has only been possible to get weak patents, subsequently pirated by powerful competitors, thus forcing infant industries out of business during the nursing period. The pirates secure the improvement on the nonverbal level of fact because the courts have denied it is an improvement on the level of verbal fiction. In this case the public gets the improvement all right, but I want to ask you, gentlemen, was it along such swashbuckling lines as these that the "progress of useful arts" was supposed to be fostered? Is that what your founding fathers intended when they wrote these words into the Constitution? The public only got the improvements because the manufacturer mistakenly believed he was protected If he had known how impotent the patent system really was, the public would probably have remained without it, just as, for example, the public would probably have remained without the time and temper-saving cashier's counter in self-service grocery stores, which was the subject matter of Turnham's patent No. 2,242,408, held invalid by the Supreme Court last December when the owner of the patent tried to stop the A & P Tea Co. from using it without permission. Now it is here, it will no doubt stay. But I do suggest that it is highly likely that this valuable invention would never have seen the light of commercial usage had the inventor known what a fraudulent grant the present kind of patent so often is.

Mr. Chairman and gentlemen, I think you will agree that we need to encourage free creative enterprise among small manufacturers and private inventors. If that is so, a patent system is needed in which inventors and small-business men can put their trust. Otherwise they will tend to keep inventions secret. In examining my copy of Patent Claims by Ridsdale Ellis published in 1949, I notice a publisher's reference to another book by the same author entitled "Patent Assignments and Licenses, Including Trade Secrets." In reference to trade secret law the reference included this pregnant remark:

> "The various stringent rules laid down recently by the Supreme Court with regard to the requirements for a patentable invention are bringing to the fore, in a way never presented before, the advisability of operating inventions as secret processes instead of securing a patent which may be held invalid by the Court later."

Now we don't want to go back to the medieval practice of trade secrecy. Those of you who are familiar with the situation in the Atomic Energy Commission are well aware of the extent to which the leading scientists of this country are irked by the secrecy regulations under which they have to work. Compel manufacturers to adopt measures of secrecy as their only recourse against competition, and a chaotic condition would quickly arise.

I have two clients in western Canada—chemists—who have invented chemical means for removing skins from potatoes, which has been sanctioned by the pure-

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food departments of both Canada and the United States. Operating their invention secretly, they are supplying peeled potatoes to a number of large concerns such as airlines, railroads, etc Without consultation with patent attorneys, but evidently based on their appraisal of the worthlessness of the patent system through their reading of newspapers and professional journals, they decided not to patent but to keep their process secret. Only just recently have I had an opportunity of interceding, I hope successfully, before they are barred under the 1- and 2-year provisions of the United States and Canada, respectively, to suggest that they at least apply for patents before it is too late, if only in view of the impendency of a new patent law and a better deal for inventors, and pointing out that they can at least withdraw their applications and thereby try to preserve their secrecy later on if they still prefer to do so.

I can so well understand the position of these inventors. They so well exemplify the dilemma in which the small-business man finds himself. The big corporation has these three distinctive advantages:

1. A much greater possibility of making inventions which will rise to the heights required for patentable validity by the courts through greater research facilities.

2 More money to prosecute infringement violence, and to defend themselves against any infringement they desire to embark upon.

3. Economic advantage, that is to say, mightier distribution systems, advertising resources, and manufacturing assets.

However, the only feasible amelioration of this imbalance in favor of the smaller manufacturer and private inventor would appear to be valid patents for slight improvements, equally with the big corporation In this connection, of course, your courts have said a number of times that the Constitution did not contemplate getting protection on every slight improvement. Well, of course, what is meant by "slight improvements" depends on time and circumstance.

Probably your founding fathers did not contemplate the modern industrial state. They could hardly be expected to any more than we can be expected to contemplate society 150 years ahead from now But, contemplating the constitutional clause as suggested by Mr Carl B Lutz in his article in the Journal of the Patent Office Society for February 1950, one is struck by the suitability of the language used, to our rather technically refined patent needs of today. As you know, the clause reads:

> "The Congress shall have power * * * To promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

Well, the burden of Mr. Lutz' clarification of this clause · That there has been a wrong emphasis, or a wrong coupling up of the word "science" with the words "inventors" and "discoveries." It is his contention by contrast, that the terms which should be coupled up fall into two groups The first group is the words "science," "authors," and "writings." The second group is useful arts, inventors, and discoveries. Mr. Lutz would therefore have the clause read as follows, insofar as patent rights are concerned:

> The Congress shall have power * * * to promote the progress of useful arts, by securiug for limited times to inventors the exclusive rights to their discoveries.

Then, obviously, so far as contributions in the more exalted field of science are concerned, the clause would read:

> The Congress shall have power * * * to promote the progress of science, by securing for limited times to authors the exclusive rights to their writings.

I suggest, from the point of social practicability, that is what may well have been intended. If so, it seems to have been lost sight of, although a persuasive answer to the strictures of Mr. Justice Douglas in the A. & P case which I have referred to already.

In our society we have two forms of registration. One is compulsory registration, a practice whereby the State may know what is being done by whom along a given line, and that compliance has been made to certain requirements. The other form of registration is elective registration. In this case the registrant, by a voluntary submission to authority, abrogation of certain freedoms, loss of certain advantages (in the case of inventions, secrecy) may gain other immunities and rights after examination of his right to them. In a good elective registration system, such as that governing trade-marks and copyright, this right eliminates the continuous need for anxiety and vigilance. There is a spirit and a flexibility to these forms of registration which breeds a feeling of security

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and freedom to operate Such a feeling of freedom is utterly lacking in the patent system.

Careful meditation upon the definitions in section 100 and the conditions for patentability in section 103 of Mr. Bryson's bill, as now amended, read in comparison with the present patent statute gives one a feeling of cautious optimism. If the present bill goes through, a somewhat more benevolent attitude may be accorded by your courts toward patents on inventions which are refinements of earlier crudities even though ostensibly slight.

Creative imagination is the faculty of conjuring past experiences, distorting them, and fitting or relating them in new and often fantastic ways. In our aggressive, extroverted, but anxiety-ridden society, it is too often looked upon as a kind of suspect ability, is a somewhat frowned on activity, and something that should not be too much encouraged. So-called efficiency seems to require its all but complete suppression But the point I am leading to is this: The inventor, although a man of creative imagination—an artist—is also, to the extent that he has developed a successful invention, or a number of successful inventions, a person who has exercised other leavening influences to modify his primitive imagination. These influences we hold in high esteem in our society.

We call them by such names as energy, superior reasoning ability, resourcefulness, persistency, and confidence. But, more than anything else perhaps, the commercially successful inventor has combined creative imagination with reasoning power and high discriminatory ability. He is a disciplined personality, a person who has shown himself able to bridle this dangerous, somewhat disreputable faculty called creative imagination. He is a cool, collected, integrated person who has passed the test of a very exacting, capricious, consuming public. Why should his position, under these circumstances, be more precarious than that of an artist or an author holding copyright in a picture, play, or book? Why should he be discriminated against more than, say, a manufacturer who, by nothing more than the making and selling of a common article, has been able to build up a valuable good will and preference for his make of the article through the virtually unassailable monopoly-ownership of a more or less ordinary symbol or design—that thing which we call a trade-mark?

Let us try and talk less nonsense about patents, including that which first distorts and then implies contemporary validity to outworn statements such as used by some proponents of the patent system. I refer particularly to the well-known story about Commissioner Ellsworth, who in 1844 (as quoted in The Story of the American Patent System—U. S. Department of Commerce, 1940) reported:

> "The advancement of the arts, from year to year, taxes our credulity and seems to presage the arrival of that period when human improvement must end."

This is usually changed to a reference to "A Commissioner of Patents who, around 1935, gave up his job because he believed just about everything had been invented."

The facts are that since 1844 more than 2 million patents have been issued in the United States alone, and just about everything has been invented in the crude, out-of-date patent-system sense of the word (or at least in the Supreme Court sense of the word). According to the formula of prior-art searching which examiners must follow, there is literally nothing the examiner cannot find an anticipation for or is justified in getting enthusiastic about. But if we face the fact that we live in an age when older basic ideas are being refined for more highly discriminating needs, then we can entertain the idea of patents on acceptable re-created ideas. There should be less emphasis today upon the spectacular thrust into the unknown as the only true requisite of the patent grant. The "flash of genius" doctrine is really nothing more than a concealed way of asserting that the only thing entitled to a patent is that which evokes the gasp of amazement and the state of emotional bedazzlement. The courts will have to take increasing notice of smaller and smaller differences. I said just now that one of the attributes of today's successful inventor is a highly developed discriminative ability or critical insight. The reason this is so necessary today is because the vast and confusing accretion of knowledge we possess can be as much of a handicap as an asset. Today, an important factor in successful inventing lies in knowing what to reject among our mountainous pile of technical know-how, and out of the vast number of false leads the ability to pick the right one—in other words the ability to see the wood in spite of the trees.

Copying, imitating, and acting from habit are basic patterns of behavior of high survival value up to a point. They come unconsciously, naturally and easily,

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To consistently resist these tendencies requires discipline and effort, but the compensation for doing so, to the creative mind, is this: That wandering away from the paths of habit and convention can bring rich rewards in terms of uncommon sense. The inventor finds, for example, that there is often nothing more misleading than an obvious fact. He also finds sometimes that the most wildly improbable turns out the best possible. Or the indulgence of fantasy concerning the wildly improbable suggests or leads to the practically possible.

So, I will conclude this first section of my testimony with the most earnest hope that the spirit of progress which characterizes sections 100 and 103 of your bill will at least suffer no contraction. The reference to obviousness, "ordinary skill," and particularly the reference to "subject matter as a whole" are vital to section 103 in my opinion The last reference particularly implies what modern philosophy and science have long taken to be axiomatic in nature that "the whole is greater than the sum of the parts." The primitive practice of anatomizing inventions to discover "the manner in which the invention was made" must be thrown into the discard, as your section 103 now explicitly states in words almost the same as those used in the recommendations of the United States Patent Planning Committee in its report to the President of June 1948. We need our inventors. They must not be allowed to become an extinct species, for their demise would stultify initiative everywhere and waste the creative capital of democracy when it is most necessary to find such ways of preserving it as offer themselves, in the face of other deadening influences like the big corporation, taxation, insurance, and paternalism generally And I should think there would be no better institution to fight communism than a liberalized patent system having the backing of a single competent court of appeal. As Dr. James Bryant Conant, president of Harvard University, recently said in warning against too much regimentation of research. "We of the mid-twentieth century have been moving forward to a considerable degree because of the momentum accumulated in the days of the amateur and the lone inventor" Let us not lose that momentum For remember, apart from all material reward, a patent is a "symbol of achievement" which can bring satisfaction even when it brings no cash dividends. Many a private "patentee" has been able to derive valuable self-esteem and consolation from his title, by virtue of which he has been able, symbolically, to identify himself with "great inventors." This is a human tendency which we all have somewhere, somewhat in our make-up, and should not be laughed off contemptuously by those in authority. I have dealt with the need for satisfying this craving—the need for more symbolic rewards, honors, citations, etc., in my forthcoming book "Patents De-Pending," but I have said enough on the topic of invention, and so will pass on now to "Functional claiming."

### FUNCTIONAL CLAIMING

I would next like to discuss the third paragraph of section 112 of Mr. Bryson's bill. It reads:

> "An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure or acts in support thereof, and such claims shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

Such a section is, in my opinion, very much needed in a revised patent statute adeqnate for today's industrial society. However, I find it a little difficult to recognize any valid reason for the expression "element," or the expression "combination" From my remarks on invention per se, you may recognize that I regard every invention, in the final analysis, as a combination of at least two elements Almost anything that can be defined as a "thing," from the commonest up, in contrast to what we define as material (string, paper, etc.) consists of at least two verbally identifiable parts. Thus, for example, a nail consists of a shank and a head, a hairpin consists of two prongs and a connecting portion, etc , etc. There never has been a binding definition of a combination in a patent sense. The courts, in patent cases, have generally relied upon ad hoc definitions, and accordingly I would very respectfully submit the following as an amendment to the last paragraph of section 112:

> "A claim for an invention may be expressed in terms of the means or steps effected by the structure of the invention for performing its specified function, without reciting the structure beyond what is deemed necessary for clear definition, and such claim shall be construed to cover the structure or material or equivalents thereof described in the specifications for performing the specified function."

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It was in the celebrated case of O'Riley versus Morse in 1852 that functional definitions in patent claims were first denounced. Since then the patentable invention has been predominantly defined in terms of what it *is* rather than what it *does*. The reason for the suppression of functional claims of the early kind was obvious enough. They tended to embrace everything for a similar purpose in their tentlike expanse. They were often crude and greedy definitions, and they probably deserved to be thrown out. Furthermore, there was not much objection to their prohibition because in the latter half of the Nineteenth century mechanisms were slow in diversifying compared to the present rapid rate of structural innovation. So over a long period there was rough agreement as to what a given term or noun stood for. For example, a given part was either a wheel or not a wheel But nowadays with the great number of new shapes, to all of which a comparatively short list of standard names must be applied, the doctrine of structural claiming versus functional claiming is in need of some semantic analysis, if only because there are instances in which a structural claim has illegitimately appropriated territory which a functional claim could not appropriate—because functionally different That's something which the prohibition against function apparently didn't anticipate.

The engineering arts have a somewhat meagre vocabulary in comparison with the vocabularies of architecture, biology, etc. This is doubtless because these subjects are much older in origin. Two hundred years ago there was no machinery worth speaking of. All the same, subjects like architecture and biology, equally with mechanics, deal with three-dimensional configurations, some of which have very useful parallels with engineering practice. A number of terms from other sciences have crept into engineering, but on the whole it is still a somewhat impoverished vocabulary by comparison, and accordingly I have been working for some years on a technical dictionary which I believe will enrich our technical vocabularies by a system of reference to structural synonyms from fields like architecture, biology, zoology, botany, etc.,

One difficulty about claiming an invention in terms of the names of structural components is that there is increasing disagreement as to whether a part is or is not what you have chosen to call it. Thus, for example, I once had an instance of an open wire screen which was made to reciprocate or move back and forth in its own plane, and while thus moving would function as a solid barrier. I therefore called it a barrier, which I thought was structural enough anyway. However, the term was refused because it was only "temporarily" a barrier—only a barrier while it was moving. The expression, although a noun, was therefore rejected as functional. I only achieved a satisfactory solution by urging the reasonableness of calling it what it behaved like.

As the great anthropologist Bronislau Malinowski said:

"The meaning of a word must be gathered, not from a passive contemplation of this word, but from an analysis of its function with reference to a given culture."

In my most recent article for the Journal of the Patent Office Society of February 1951, I have, I think, demonstrated that even unlikely looking stationary objects, can be claimed almost wholly functionally, and with as much specificity or narrowness of detail as can be done by structural claiming In fact, I think logicians would agree that the functional form of claim, they call it "teleological definition," is the most perfect way to define a given structure with deductive inevitability. And it has the advantage of clearness of meaning. This greater clearness of meaning arises from the fact that a common, already existing word (noun) cannot bring a definite understanding about unknown structure, and every invention involves some unknown or new structure naturally. The drawings and the specifications of the new patent describe the new structure admittedly, but how much territory is to be reasonably considered as the equivalent of what is pictured and described? Well, the result is that when a potential competitor trying to determine how closely he may approach a patent and how far he must keep away, with many present-day claims, often ends up far less certain as to what he may and may not safely do, than he would if he had a dynamic and predominantly functional definition to read. Specifically he has to decide how much inventive territory is fenced in by the common existing nouns used, but applied to a new use.

Now, by contrast, when you analyze a functional claim which speaks about what the invention does, and sets forth the way it works, far greater understanding may be expected. No two people can ever possibly agree exactly on what anything is. But they can agree pretty well as a rule on what a thing

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does, because what it does can be tested by seeing it do it, while what it is cannot be so tested. John Doe, for example, may say, "This is a wheel, because it is circular, symmetrical, rotatable, and rimmed" but Jack Smith may say, "It is not a wheel because it's too wide to be properly called a wheel; it is a roller." Then Jack Jones comes along and says: "It is neither a wheel nor a roller; it's a pulley, because its rim is cambered." So the argument may go on indefinitely, because with the small stock of mechanical nouns we have to cover a great many different actual shapes, everyone has a different picture in his mind, just as each one of you conjures up a different picture in his mind when I utter the word "kettle" and ask you to visualize same. The picture you get also tends to resist eradication, and to the extent it does so, blocks mental receptiveness toward the views of the other fellow. It's in ways like these that big lawsuits are started—because of differences in interpretation. I know of no other field of writing where "isness" is a required practice to the extent that it is in patent claiming. And in my article in last February's Journal, I have translated a section of the Patent Act and a clause of a standard licensing agreement into this kind of form to illustrate its absurdity.

I feel sure you will see, from what I've just said, how the structural form of claim can encourage the most sterile sort of arguments—"'tis—'tisn't" arguments as I call them. The examiner or the courts can say that such-and-such a part is not "properly speaking" what you have called it. If you reply on the same level, in effect all you have said is that is *so* what you have called it. I do not want to launch into an exposition of general Semantics in this testimony. I refer you to my articles for that. All I want to suggest here is that it's really exquisitely unimportant *what* you *call* a thing so long as you make your structural and functional meanings clear. That is the only effective way of communicating so far as I am concerned—and by functional, actional, behaviouristic claims you can do just that—you can communicate more effectively If, for example, a person persists in describing a thing to a practical man, say a piece of machinery, in terms of what it is, that listener will almost certainly get impatient and ask "What is it for?" If a description in terms of use is still not forthcoming he will then say, "Let's have a look at it," or "Let's see it in operation." He is only trying to get behind the smoke screen of words to the nonverbal plane of reality Language itself progresses from the primitive naming stage to the operational way of talking, and every child repeats this linguistic evolutionary development. A child first asks, "What is it?" When a little older it inquires, "What is it for?" Then, only when it has developed fairly considerable reasoning power does it ask, "How does it work?"

Functional claiming is highly desirable in my opinion because it will enable laymen to understand the scope of the patent they are examining. Even when, as may often be necessary, particularly in a narrow patent, the claim must be drafted with meticulous use of functional language, still it will be a lot clearer than the structural jargon now used, and which, without doubt, has been most improperly used sometimes on behalf of big corporations to breed uncertainty, anxiety, and doubt as to whether it's safe to ignore their patents. To that extent, structural claiming has played into the hands of big business, and functional claiming will tend to terminate it. Functioual language has a vital dynamic character from which we feel satisfied we know what is meant, because, on muscular, tactile, and other sensory levels—concretely experiencing levels, we are all very similarly constituted. We have all felt, seen, and so forth, much the same things, performed basically the same bodily operations, and so forth, but this is in sharp distinction to the case on abstract reasoning levels, which are language levels. There, the experience of the educated man and the relatively uneducated man differ widely, introducing widely different verbal meanings.

The great philosopher, George Santayana, has said:

"Grammar, philosophically studied, is akin to the deepest metaphysics, because in revealing the constitution of speech, it reveals the constitution of thought and the hierarchy of those categories by which we conceive the world."

Well, as long as we define patented inventions predominantly in terms of structure we certainly are, in my opinion, conceiving the things of the world capable of being covered by patents, in a fictitious way. It is a way which causes a maximum of disagreement because of the individually different preconceptions which all of us have about concrete objects, especially when applied to a new use or in a new combiuation, as they invariably are in patents

In the last analysis, if you only want to know what it "*is*" that has been patented why have claims at all? The drawings illustrate the invention. The description explains its construction The only real need for claims should be

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to define what you cannot always see—the actual useful operation the invention performs, and how it does so, in order that you can enclose this operation and manner of performance against infringement. Only when defining constructs without reference to utility should a structural approach be used, as in the case of design patents. The form of claim you employ in design patents bears out my point. You simply say: "What I claim as my invention is the ornamental design for a so-and-so substantially as shown." It's left to the courts to decide what variations trespass on the patent. But when a thing has another attribute—its essential attribute—that of utility—over a design patent, it seems folly not to anchor your method of definition to that essential attribute—especially as I have already said, when the full significance cannot always be observed from a passive perusal and is only revealed when the thing is actually built and tested.

Lastly, in relation to functional claims, I put forward the suggestion that every patent should have at least one carefully drafted functional claim if only for insertion in the abridgements which appear in the week's Official Gazette of issued patents. I'm sure everyone will agree most of these abridgements are virtually meaningless at the present time. They simply show one view from the drawings greatly reduced in size, and one claim, which, being structural, seldom gives any useful information. Of course, better even than this would be a required drawing and an operationally descriptive summary particularly for the Gazette. But a clear functional claim should be nearly, if not quite, as good in most cases, as I visualize such claims.

### DESIGN PATENTS

I would next like to discuss section 311 of the bill which relates to patents on designs. As you all know, the successful manufacturer and the successful inventor today seldom loses sight of this vital aspect of modern merchandising. It is design alone that sometimes puts one product out in front in the race for sales leadership, and it's through design that successful inventors often succeed in selling their ideas. Now, most people think that industrial design simply means eye-appeal, or "streamlining," but actually it is a great deal more than that. Some of the considerations involved in successful industrial designing come under such headings as greater comfort, improvement in balance, for example; and it has been amply proved that workers will take much more care of an expensive machine too which is smooth and well-organized as to its component parts than one that looks like a Rube Goldberg contraption.

I have said in an article on the subject that a well-designed industrial product is one that "looks like what it is, only more so." For instance, a heavy-duty implement like a truck or a bulldozer should be designed to enhance its appearance of strength. If the article is a piece of scientific equipment like a camera or a radio, then the look of scientific precision should be emphasized. Nor is it always a question of pleasing appearance. For example, I can cite a piece of mining machinery which was very dangerous if not handled with respect, and it had been deliberately "industrially designed" to make it look like what it was, for the greater safety of its users. Its formidable appearance was not entirely intrinsic to the machine; nevertheless, it had a look of greater functional fitness than any of its competitors.

Now your section 311 reads like this:

"Whoever invents any new, original, and ornamental design for an article of manufacture may obtain a patent therefore, subject to the conditions and requirements of this title."

But from what I have said I think you will recognize that modern industrial design is more than a matter of mere ornament. In a machine tool, for example, it is well within the industrial designer's field to arrange the controls, their location, how they feel during use, and so forth. Even how the machine or article sounds during operation can be important.

In the article I've just mentioned I referred to an after-shave bottle I had. The neck had a long thread, instead of the usual short, single turn thread. The screw cap was a heavy, black plastic disc. The result was that you could spin it on and spin it off like a wheel. That was a pleasing sensation, and also more practical than a single turn thread which requires a twist of the wrists, sometimes resulting in dropping the bottle if the hands are wet. Good industrial design then can mean such things as a clean snap to a lever, a long smooth push to a controller button, a good grip in a saw, a nice whip to a rod—anything in fact that gives a breath of life to the lifeless, and provides that "pick me up and

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use me" appeal. I therefore define good industrial design as greater product enjoyment.

Accordingly, I would like to suggest a definition of design to be included in Mr. Bryson's bill substantially in accordance with what I have suggested to the Patent Institute of Canada which is also working on a new industrial design act for Canada. It is this:

"In this act, the expression 'design' means features of shape, pattern, ornament, operation, location of parts, or relationship of materials, colors, surface-effects or any combination of the foregoing, which, in a finished article, appeal to and are judged by the senses, and other than as a useful invention under this act, or additionally thereto, and does not include any features of shape, pattern, ornament, location of parts or relationship of material, colors, surface-effects, or any combination of the foregoing, which are dictated solely by the function which the article was made to perform."

My last suggestion in connection with the design provisions of your bill, is that you consider the inclusion of a claim or claims for industrial design patents beyond the brief form now used As you know, the standard form of claim now used in design patents is: The ornamental design, for a so-and-so (naming the class of article) or the like, substantially as shown.

Now I think the important place that industrial design occupies in modern industry should entitle industrial design patents to a more careful form of definition than that. I would, therefore, recommend a claim or claims along the lines of regular utility-patent claims, except that such claims would be formal, or in other words structural, of necessity, since considerations of utility per se are excluded from design patents. I mean that you could not sensibly write a functional claim or claims for subject matter which had sensory appeal only. Structural claims would, therefore, be the proper form to use in these cases.

And the reason for a claim or claims for design patents will, I think, be obvious; without a definition of any sort the intending competitor is bound to be uncertain as to how close he may come and how far he must stay away. There are many industrial designs which contain a structural idea of considerable aesthetic originality, and infringement should not be allowed by the merest change. Of course, I admit that you would have to use names for the things or parts or configurations in your structural claim or claims in design cases, but what you meant pretty accurately by the names chosen, could be defined in the specification, somewhat as I have described on pages 130 and 131 of my article in last February's Journal of the Patent Office Society. There is not much objection to structural terms in a claim when clearly defined, even in patents of utility.

For instance, I have recently designed a bed having these design features: It has enclosing ends with side curtains between them. It may or may not have a light fabric top which can be drawn across or left rolled or drawn back according to choice, so that a complete enclosure or just a surrounding curtain effect can be attained. Now clearly, this idea had its origin in the big, four-poster beds of the eighteenth century But my proposal is a very light and airy modernization of those gloomy affairs, and could, I believe, be successfully promoted by one of the more exclusive furniture houses.

However, the design patent which I shall obtain upon the idea will be highly uncertain as to the extent of protection I shall have upon the obvious variations occurring to others after seeing it. Sufficient protection I can obtain perhaps by taking out several design patents to cover the most likely modifications. My submission therefore is that close variations of novel designs should be protectable by means of one patent having provision for a brief specification and a claim or set of claims as in utility patents.

Finally, the design-example I have just given serves to indicate my reason for the expression "or additionally thereto" in my proposed definition of a "design" You see, a bed like this with side curtains and an optional draw-top, either flat or sloping like a roof, could be argued as subject matter for a utility patent. The curtains and top with their characteristics of enclosure and movability are certainly things that function to some useful extent. Yet improved utility had hardly any place in my mind when thinking up the proposal. My main object was aesthetic or sensory novelty, and it developed concurrently with the advertising angle I thought might fit in with it. So my definition of design is intended not to annul those utility patents which can be had for designs possessing incidental utility. After all, some might think this bed is better, an improvement, and in a sense more "useful" to them than an open bed There

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are many instances of a similar kind, and so this is something which I suggest be carefully kept in mind, although I am aware of those decisions in which the coexistence of a utility patent and a design patent have been held not mutually fatal as applied to the present patent statute.

This ends my testimony. Thank you, Mr. Chairman and gentlemen.

Mr. BRYSON. You understand we are especially anxious to give you every opportunity since you are here from our neighboring country up there.

We will stand in adjournment until tomorrow, Thursday, at 2 o'clock. The hearing is tentatively set for tomorrow at 2 o'clock. We will close now to definitely meet at 10 o'clock Friday morning, but if possible we will proceed tomorrow afternoon at 2 o'clock, and we will again meet on Friday.

Mr. ASHTON. When is it likely to be known definitely whether you will sit tomorrow afternoon?

Mr. BRYSON. Mr. Harris will try to keep in touch with the House.

(Thereupon, at 12:15 p. m., the subcommittee adjourned until tomorrow, Thursday, June 14, 1951, at 2 p. m.)

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# PATENT LAW REVISION AND CODIFICATION

**THURSDAY, JUNE 14, 1951**

HOUSE OF REPRESENTATIVES,
SUBCOMMITTEE NO. 3 OF THE COMMITTEE ON THE JUDICIARY,
*Washington, D. C.*

The subcommittee met at 2 p. m., pursuant to recess, in room 346, Old House Office Building, Hon. Joseph R. Bryson (chairman of the subcommittee) presiding.

Mr. BRYSON. The subcommittee will come to order.

Gentlemen, Mr. Kane wishes to make a brief statement. As I understand it you wish to reserve the right to file a written statement?

## STATEMENT OF AL PHILIP KANE, KANE & KOONS, WASHINGTON, D. C.

Mr. KANE. That is correct, Mr. Chairman.

Mr. Chairman and members of the subcommittee, my name is Al Philip Kane. I am a member of the District of Columbia bar, a member of the law firm of Kane & Koons, general practicing attorneys, not patent attorneys or patent lawyers, in the city of Washington, D. C. I appear here today on behalf of Victor J. Evans & Co., registered patent attorneys and McMorrow, Berman, and Davidson, registered patent attorneys.

We are particularly interested in sections 31, 32, and 33 of the bill which is before the subcommittee. We have been having certain discussions with members of the committee staff with regard to the phrasing of those sections, and we desire to continue our discussions with the staff to see if the differences which we have between ourselves and the staff can be ironed out amicably and to our satisfaction.

We therefore desire at this time merely to state we do intend to continue our discussions and that we reserve the right to file a written statement. We hope that if we are unable to iron out our differences, we may have the privilege of an oral statement at some later date.

Mr. BRYSON. We will try to grant that.

So we may understand your position concretely, it revolves around the custom of advertising?

Mr. KANE. That is correct.

Mr. BRYSON. You wish to retain the status quo in this pending bill?

Mr. KANE. That is correct.

Mr. BRYSON. You wish to continue the practice that lawyers follow now?

Mr. KANE. Yes; subject to approval of the advertising by the Commissioner of Patents, which is the present practice.

Mr. BRYSON. You will try to get together with our staff in the hope of working out your differences and respective views at an early date?



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Mr. KANE. We are holding ourselves available for meetings with the staff at the staff's convenience.

Mr. BRYSON. Thank you.

Mr. Scott, will you identify yourself?

## STATEMENT OF JOHN W. SCOTT, SCOTT & LITTMAN, WASHINGTON, D. C.

Mr. SCOTT. I am John W. Scott. I am a member of the firm of Scott & Littman, attorneys, 1025 Vermont Avenue, Washington, D. C. I appear here for Clarence O'Brien and Harvey B. Jacobson, patent attorneys.

I join in the statement that Mr. Kane has just made. I, too, am working with the group. We hope that there can be some satisfactory solution of the problems which we have been working on with the staff.

I would like to reserve the right in case that does not materialize to submit a statement on behalf of my clients and also be heard at whatever further session of the committee may be held in that regard.

Mr. BRYSON. We will try to extend every courtesy possible. Thank you.

Mr. SCOTT. Thank you.

Mr. BRYSON. We now have Captain Robillard of the United States Navy. We will be pleased to have you come around.

Do you have a prepared statement?

## STATEMENT OF CAPT. GEORGE N. ROBILLARD, UNITED STATES NAVY, APPEARING FOR THE DEPARTMENT OF DEFENSE

Captain ROBILLARD. Mr. Chairman, I understand that you have received the copy of the report. I have not prepared any statement in addition. I would like to add a few comments to what is in the report.

(The report is as follows:)

DEPARTMENT OF THE NAVY,
OFFICE OF THE JUDGE ADVOCATE GENERAL,
*Washington, D. C., June 14, 1951.*

HON. EMANUEL CELLER,
*Chairman, Committee on the Judiciary,*
*House of Representatives.*

MY DEAR MR. CHAIRMAN: Your request for comments on H. R. 3760, to revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents," has been referred to this Department for the preparation of a report thereon expressing the views of the Department of Defense.

The purpose of this proposed legislation is expressed in the title of the bill.

The Department of the Navy, on behalf of the Department of Defense, interposes no objection to the enactment of H. R. 3760 subject, however, to certain amendments which are recommended hereinafter for the reasons stated in connection therewith

(*a*) In line 1 of section 101, insert the word "art," before the word "process" and make the same change in line 2 of section 115.

The above changes are recommended to avoid misinterpretation. H R. 3760 has eliminated the term "art" now appearing in the present law (35 U. S. C. 31) and substitutes the word "process." The term "art" is as old as the patent law and finds its basis in the constitutional provision permitting the establishment of patent laws. It has a well-defined meaning and has been construed by the courts in numerous cases.

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(*b*) Delete subsection (g) of section 102 and insert the following in lieu thereof: "before the applicant's invention thereof the invention was in fact made by another who in this country was using reasonable diligence in reducing it to practice or had reduced it to practice, provided such other had not abandoned, suppressed or concealed the invention after reduction to practice, and had exercised diligence in putting it into use or in otherwise making knowledge thereof available to the public."

This subsection as now written in the bill could be interpreted to constitute a secret reduction to practice in anticipation of an issued patent. This interpretation is contrary to existing law and is not approved by the Department of Defense. The above amendment would prevent such an interpretation.

(*c*) Add the following paragraph to section 122 of the bill.

"Pending applications for patents may be printed and published by the Commissioner, at the request and expense of the applicant and owner. Such publication shall have the same effect as an issued patent for the purposes of section 102 (e) of this title."

This paragraph was included in H. R. 9133, Eighty-first Congress, and received strong support from governmental agencies. It will permit governmental agencies to have applications printed and published and thus save the cost of prosecuting them to allowance. If the application is full disclosure then publication will make it "prior art" and give to the Government the same protective position as does an issued patent. The procedure is presently followed under administrative orders of the Commissioner of Patents. Statutory authority would remove any doubt of the legality of this procedure.

(*d*) In line 1 of section 201, strike out the words "through error."

In line 4 of section 201, insert the words "through error and" before the word "without".

As presently drawn the words "through error" could be construed as referring to the words "is deemed" whereas these words should refer to "by reason of a defective specification or drawing or by reason of the patentee claiming more or less than he had a right to claim in the patent." The recommended change will assure the proper construction.

(*e*) Strike out the first sentence in section 211.

Although patents have always been recognized as property, they have not been recognized as persoual property but as having the attributes of several kinds of property. The opinion in *Solomons* v. *United States* (21 Ct. Clms. 479), points out wherein patents are a novelty in the law, certain respects wherein they differ from personal property, and certain similarities thereof to real property. It is not considered desirable to discard over a century of law relating to patent property and replace it with the rules of personal property.

(*f*) Delete all after the catch line in section 212 and insert in lieu thereof the following:

"Whenever two or more persons own a patent jointly, either by issuing of the patent to them jointly or by reason of the assignment of an undivided interest in the patent or by reason of succession in title to such interest, each of the joint owners, in the absence of any agreement to the contrary, shall be entitled to make, use or sell the patented inventions or license others so to do, or assign or incumber his interest without accounting to the other joint owners."

This section of the bill provides that joint owners must either join in an assignment or license or account to each other in the absence of an agreement to the contrary. It is believed that this requirement unnecessarily restricts the rights of joint owners. The above amendment, which was section 212 of H. R. 9133, Eighty-first Congress, is considered preferable.

(g) Add the following sentence to section 246:

"With respect to infringement committed by or on behalf of the Government, the period between the date of receipt by the Government of a written claim for compensation for infringement and the date of mailing by the Government of a notice to the claimant that his claim has been denied shall not be counted as part of the 6 years, unless suit is brought before the last mentioned date."

Governmental agencies have authority to settle claims prior to suit and this authority has proved very useful in resolving and disposing of claims against the Government without the necessity of the effort and expense of litigation. It is noted, however, that a claimant who seeks to proceed administratively to settle his claim prior to suit may lose his right to recover compensation for a period of the time equivalent to the time required to process the claim admin-

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istratively since the statute of limitations has been running against the claimant during this period of time. Because of this many claimants have filed suit rather than proceeding to a final administrative determination. The intent of Congress in providing for the administrative compromise and settlement of claims was to reduce the over-all cost of determining the existence of Government liability, both from the Government's standpoint and that of the claimant. The above amendment is needed to protect this intent.

(h) In subsection (e) of terminal section 4 on page 28 of the bill add the following at the end before the period: "prior to the effective date of this Act."

This amendment will clarify the application of this subsection.

This report has been coordinated within the Department of Defense in accordance with procedures prescribed by the Secretary of Defense.

The Navy Department has been advised by the Bureau of the Budget that there is no objection to the submission of this report on H. R. 3670 to the Congress.

For the Secretary of the Navy.

Sincerely yours,

G. L. RUSSELL,

*Rear Admiral, United States Navy, Judge Advocate General of the Navy.*

Mr. BRYSON. I would like to state before Captain Robillard proceeds, and I hope you will not object, it might be that some of you busy lawyers here have not seen the current issue of the Saturday Evening Post. It would be profitable and interesting if you would get a copy and see the article that is in there.

Captain ROBILLARD. The report has been cleared by the Bureau of the Budget. In the report, you will find that we request but eight changes on behalf of the Department of Defense in the codification. I think that is an outstanding tribute, Mr. Chairman, to your committee and to the coordinating committee. We can generally make eight changes in a single paragraph.

Of those eight changes there are two in particular to which I would like to address myself and invite your attention. The first is an addition to section 122. You will find it on page 2 of the report where we ask that a paragraph be added which will permit the printing and publication of pending applications without the necessity of prosecuting them through to an allowance. The reason we are particularly interested in that, from the viewpoint of the Government, is that we feel that our policy of issuing patents in the name of the Government only from the viewpoint of establishing a protective position results in a tremendous waste of time, effort, and money, which could be saved if we could print and publish the application and make it a complete disclosure with the same effect as the patent.

Merely as an example, we have in our own Navy Department approximately 800 to 1,000 cases which are Government-owned. If this provision were enacted into legislation, we could probably publish all of those without the necessity of any further prosecution, saving a tremendous amount of time on our part and certainly relieving the Patent Office of a tremendous burden.

The second provision which I wish to emphasize is the addition to section 246 which, in effect, is the statute of limitations for recovery under a patent. At present, a patent owner's remedy against the Government is by suit in the Court of Claims, unless they reach a satisfactory settlement with those agencies which have authority to settle the cases.

We would like to add the provision to toll the statute of limitations during the pendency of a claim in an administrative agency so that

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neither of us would have the pressure on us to try to reach a settlement and the patent owner would not be losing his right to go into the Court of Claims in the period between the time he files the claim and we finally reject it. It would be particularly beneficial to the Government, I think, in view of the fact that in many instances we can often arrive at a very satisfactory compromise, many times including settlements for past infringement and future use, which, of course, is extremely important to use where the patent has not expired and we will continue to use it.

Mr. CRUMPACKER. I see that this language which you have recommended here says that the period of time from the date a written claim is received until the date of mailing of a notice of denial shall not be counted in the 6-year period unless suit is brought before the last mentioned date. If a claim were filed, say, 5 years after the infringement and negotiations continued for more than one year thereafter, and no suit was filed, then from the time that the 6-year period had expired until the Government saw fit to act on the claim the patentee would be entirely without remedy or recourse, would he not?

Captain ROBILLARD. Your point is well taken, sir. The language is poor. That was not the intent. The intent was to toll that period.

Mr. CRUMPACKER. Then if you strike the part beginning with the words "unless on", would that create any new defects?

Captain ROBILLARD. We did want to point out if a claim is pending and during that pendency the claimant brings suit, then the statute would start running.

Mr. CRUMPACKER. The filing of the suit tolls the statute in any event, does it not?

Captain ROBILLARD. Yes. I think it is right to strike it out. Would you let me give it a little more thought and discuss it with the committee in case we have any worries about it?

Mr. CRUMPACKER. Yes.

Mr. BRYSON. When we go into executive session to mark the bill up, we would appreciate your being available to assist us in making any changes.

Captain ROBILLARD. They are the two which I consider very important. The others, I think, are directed more to clarification than anything else. That is all I have to say.

Mr. BRYSON. You do not care to discuss the others?

Captain ROBILLARD. No, sir. I do not think they are important enough to take up the time of the committee.

Mr. BRYSON. Thank you, Captain.

We wish to offer for the record here a statement dated June 13, 1951, from the Federal Security Agency and likewise a statement dated June 12, 1951, from the National Advisory Committee on Aeronautics.

(The statements referred to follow:

FEDERAL SECURITY AGENCY,
*Washington, June 3, 1951.*

HON. JOSEPH R BRYSON,
*Chairman, Subcommittee No. 3, Committee on the Judiciary,*
*House of Representatives, Washington 25, D. C.*

DEAR MR. CHAIRMAN: This letter is in response to your request of April 30, 1951, for a report on H. R. 3760, a bill to revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents."

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Each year a number of inventions are made by employees of this Agency, and also by other individuals engaged in research work supported wholly or in part by Public Health Service fellowships or grants in aid of research. Where the invention is of such a nature that it should be patented in the public interest, the Agency takes steps to secure a patent The preparation and prosecution of patent applications is handled for us by the Department of Justice, and we assume that Department may have its own recommendations with respect to this bill. Our comments will be confined to points relating to the ownership and assignment of inventions and patents, and to the waiver of patent fees in certain cases.

1 *Section 212 "Joint Owners".*—This section of the bill provides that in the absence of any agreement to the contrary, where an invention is made jointly by two or more persons "neither of the owners may grant licenses or assign his interest, or any part thereof, without the consent of the other owners or without accounting to them." This constitutes an important change from the present law, under which each joint owner has an independent interest in the patent. There are two aspects to this interest. At present, in the absence of an agreement to the contrary each coowner of an undivided interest in a patent can independently make, use, and sell the invention, i. e, the thing or process invented, without the consent of the other owners and without accounting to them for any profits; and this rule is preserved in section 212 of the present bill. However, under existing law a joint owner ordinarily can also assign or grant his interest in the patent itself, or can grant licenses under the patent, without the consent of his coowners and without accounting to them; and this aspect would be changed by the language quoted above.

The exact meaning of the quoted language is not entirely clear, however. It might be interpreted as requiring a coowner either to obtain the consent of his coowners or to account to them, before granting licenses or assigning his interest in the patent. On the other hand, it could also be read as requiring him to do both. In the latter event particularly, the change in the law would create a problem for this agency in certain cases and presumably also for other Government agencies making research grants.

This difficulty arises out of the circumstance that patentable inventions sometimes result from research performed by a research scientist who, for example, may have been receiving a Public Health Service fellowship, but who may have been working in a laboratory jointly with one or more other individuals who received no support from public funds. In such cases, the inventor who had received Federal funds in support of his work would be free, under existing law, to fulfill without the consent of his coinventor any agreement he may have made for the purpose of receiving the research award. For example, that agreement might call for the assignment of his interest in the patent, without remuneration, to the Government, or the inventor might be authorized to assign his interest in the patent to a suitable institution for administration in the public interest. In the event of such assignment, the Government or other assignee in turn is also free to grant licenses under any such patent to any commercial firm or other person who may wish to make use of the invention. However, without the agreement of the colleague who participated in the research (who was under no obligation to the Government), it would appear that the Government might be impeded in receiving any interest in the invention or granting any licenses under it, even though the invention resulted from a substantial investment of public funds This would be equally undesirable from the point of view of the coinventor, since the Government would be involved in any action he wished to take with respect to his interest in the patent.

If the bill were passed in its present form and narrowly interpreted, it might be difficult to take effective steps to protect the public interest in such inventions For example, it would not always be practicable to enter into advance agreements with each person who might collaborate in the research, because it would be very difficult to identify in advance each scientist or assistant who might participate and who therefore would have to be a party to the agreement. Even if the identity of all such individuals could be ascertained, the main purpose of the research grants and fellowships is to promote the increase of knowledge and to train skilled personnel, rather than to make inventions, and a patentable invention results from only a small percentage of them. Therefore it would be necessary to enter into a large number of agreements, only a small fraction of which would be useful.

If it is decided to enact a provision which will accomplish the general objectives of section 212, this agency would have no objection, provided it clearly

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permits (1) a joint inventor, without receiving any remuneration therefor, to assign his interest in a patent application or in a patent, or to give a license, without incurring any obligation to his co-owners by reason of having made such assignment or granted such license; and (2) permits the Government or other assignee or licensee to issue royalty-free licenses or sublicenses in the public interest under such application or patent without incurring any obligation to the co-owners.

It is suggested that this result might be obtained and at the same time provide for an accounting of remuneration actually received, by revising the last clause of section 212 to read somewhat as follows:

> "* * * and any owner may grant licenses or assign his interest, or any part thereof, without the consent of the other owners, provided that he must account to them for their proportionate shares in the event he receives any remuneration therefor."

This recommendation is substantially in accord with the views of a committee appointed by the Chairman of the Government Patents Board to consider this question.

2. *Section 221: "Issue of patents without fees to Government employees".*—This provision derives from the "no-fee" act of March 3, 1883, as amended (35 U. S. C. § 45), which authorizes the Commissioner of Patents to waive the fee for inventions by Federal employees if they are liable to be used in the public interest and if the employee gives the Government a license to use the invention. There are a few changes in language, such as the requirement of a certification that the invention is used or likely to be used "by or for the Government," rather than used "in the public interest" as in the present law.

In addition to inventions owned by employees, there are inventions conceived by our employees under circumstances where the Government is entitled to the assignment of all rights in the invention or of certain lesser rights therein. Moreover, as indicated earlier in this report, there are some inventions made by individuals who are not Federal employees, under agreements whereby the Government is entitled to an assignment of some or all rights in the invention because it resulted from research work financed in whole or in part from public funds. The research activities of the Public Health Service, whether undertaken directly by employees or indirectly through grant-supported research, at times result in valuable inventions in the nature of chemical or biological discoveries which may be of substantial value for use in the field of public health and medicine. These inventions might in some cases be highly useful in the public interest, even if not manufactured or used directly by or for the Government. The Public Health Service can of course arrange for filing patent applications on nonemployee inventions and pay the usual Patent Office fees out of appropriated funds which may be available for that purpose. However, this simply means the transfer of such funds back into the Federal Treasury, with an incidental administrative expense and possible delay in handling the paper work needed for a transfer of funds.

It would therefore seem to be a logical clarification of section 221 if it were revised to conform to present practice by including expressly employee inventions assigned or to be assigned to the Government. It would be very desirable in that connection to retain the language of the existing statute ("in the public interest"), because the more restrictive requirement that the invention is likely to be used "by or for the Government" might operate to discourage the patenting of some inventions made with the use of public funds where it would be in the public interest to secure a patent.

It would also seem to be logical and justifiable to extend the scope of section 221 to include cases where the invention is made by a person not technically a Federal employee, if it resulted from the expenditure of public funds and if the Government has rights in the invention (frequently, but not always, being entitled to the assignment of all domestic rights therein). It is believed that this limited extension of the section to cover certain nonemployee inventions resulting from publicly financed research might not involve any very large increase in the number of waivers by the Patent Office, as compared with those under the present statute. If believed to be desirable, the waiver could be made discretionary in accordance with rules to be formulated by the Commissioner. Suggested language to carry out this recommendation is enclosed for the committee's consideration.

This agency has no objection to the enactment of the bill, but we recommend that it be modified as suggested above.

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The Bureau of the Budget advises that there is no objection to the submission of this report to your committee.

Sincerely yours,

JOHN L. THURSTON,
*Acting Administrator.*

SUGGESTED LANGUAGE FOR THE REVISION OF SECTION 221

The Commissioner may grant, subject to the provisions of this title, to any officer, enlisted man, or employee of the Government, except officers and employees of the Patent Office, or to any individual whose invention was made in connection with activities financed wholly or partially from Federal funds, a patent without the payment of fees, when the head of a department or agency, or a responsible official duly authorized in writing to act on his behalf,[1] certifies that the invention is used or likely to be used in the public interest, and further when either (1) such official also certifies that to the best of his information and belief the Government has been assigned or is entitled to the ownership of all rights in the invention or to a specified lesser interest therein,[2] or (2) the applicant in his application states that the invention described therein may be manufactured and used by or for the Government for governmental purposes without the payment to him of any royalty thereon, which stipulation shall be included in the patent.

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NATIONAL ADVISORY COMMITTEE FOR AERONAUTICS,
*Washington, D. C., June 12, 1951.*

Hon. JOSEPH R. BRYSON,
*Chairman, Subcommittee No. 3, Committee on the Judiciary,*
*United States House of Representatives, Washington, D. C.*

DEAR MR BRYSON: Permit me, in the absence of Chairman Hunsaker, to reply to your letter of April 30, 1951, in which you requested an expression of the views of this committee concerning H. R. 3760, a bill entitled "To revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled 'Patents'."

The revision and codification of the existing patent laws is considered desirable and H. R. 3760 is regarded as a generally satisfactory means of accomplishing this end. The bill was discussed at the meeting of the Government Patents Board on May 14, 1951, and it was concluded that a further study should be made of the possible effects of the passage of the bill upon the rights of the Government to inventions made by Government employees.

An interagency working committee was accordingly established by the Chairman of the Government Patents Board. This committee, which included the NACA representative on the Board, met on May 21, 1951. It was agreed that section 212 of H. R. 3760, as now written, if enacted into law, would complicate the acquisition by the Government of rights under patents granted jointly to two or more inventors not all of whom are Government employees. It was, therefore, agreed that recommendation should be made to revise the wording of section 212 to read substantially as follows:

"In the absence of any agreement to the contrary, each of the joint owners of a patent may make, use, or sell the patented invention without the consent of and without accounting to the other owners, and any owner may grant licenses or assign his interest, or any part thereof, without the consent of the other owners provided he accounts to them for any material consideration received therefor."

A satisfactory alternative to the revision suggested would be a return to the wording of section 212 of H. R. 9133 of the Eighty-first Congress

The NACA is in agreement with the foregoing recommendation and has no other comments to offer regarding H. R. 3760.

Sincerely yours,

J. W. CROWLEY,
*Associate Director for Research.*

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[1] This phase is intended to make it clear that the head of an agency could authorize the execution of the necessary certificates by some other responsible official in the agency, such as, for example, by the Surgeon General of the Public Health Service

[2] The phrase "or to a specified lesser interest therein" is designed to cover cases where the Government is entitled to the ownership of something less than all rights in an invention, such as, for example, cases where the foreign rights are retained by the inventor, or where the Government is entitled only to the interest of one or more joint inventors, and not to the interest of all of the joint inventors.

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Mr. BRYSON. We now have the privilege of hearing Dr. S. B. Fracker of the Department of Agriculture.

## STATEMENT OF S. B. FRACKER, ASSISTANT TO RESEARCH ADMINISTRATOR, DEPARTMENT OF AGRICULTURE

Mr. FRACKER. My name is S. B. Fracker, assistant to the Research Administrator in the Department of Agriculture, and representative of the Department of Agriculture on the Government Patents Board. I am appearing in favor of the bill now under consideration by the committee with the suggestion of two changes in section 221 of the bill.

The committee has been supplied with copies of a letter of June 12 from the Assistant Secretary of Agriculture on this subject. I wish merely to make a few brief informal comments.

Section 221 of the bill constitutes a restatement of what is commonly known as the Nonfee Act under which inventions by Government employees in the course of their duties or otherwise may be patented without the payment of patent fees. The original authorization to accomplish this purpose was passed on March 3, 1883, and has been continued with little change since that time.

Under present law in accordance with the orginal statute, when a patent application is filed under the Nonfee Act by an employee of the Government for a patent on an invention resulting from his research, the head of the agency is required to certify that the invention is "in the public interest." The inventor is also required to give the Government shop rights.

Section 221 of the bill before the committee changes the certification requirement so that Government inventions are exempt from the payment of fees, "when the inventions are to be used or likely to be used by the Government."

I should like to comment on the difference in the meaning of these two phrases and the effect of the changes. The change in the language will undoubtedly be satisfactory with respect to military inventions where the Government is the principal user and in many cases is the only purchaser of the product or the device invented. The Department of Agriculture, however, was established for the purpose of the development and dissemination of knowledge and the type of research that is carried on in the Department is not research aimed toward the development of articles for the procurement by Government. The Government, in most cases, is not the principal user of the invention. Accordingly, the Department feels that the language in the present law, "in the public interest," is more satisfactory as a description of the type of inventions that come from Department of Agriculture research than the proposed change.

I would like to illustrate the difference by mentioning a number of recent patents.

For example, one issued on February 20, 1951, assigned to the Secretary of Agriculture covers a process for the glazing of fruit that is to be stored, transported, and sold in frozen packages. The fruit so glazed under this process remains separate. The individual pieces of the individual fruits do not cohere in a solid mass in the package as is now the case with frozen fruit available on the market. It can be packed mechanically instead of by hand. The berries, cherries, or individual pieces of larger fruits are frozen hard and the glazing pro-

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tects it so it is not injured in storage or transportation. No sirup is required to fill the interstices between the pieces of fruit. It is clear that an invention of this type is primarily directed, first, to the better utilization of horticultural crops, and, second, to the advantage of the consumer in having a more desirable product. It is probable that at some time in the future the Quartermaster Corps may have occasion to use some such products, but a description of the invention as being "in the public interest" is more applicable than to say that the product is "likely to be used by and for the Government."

There is another type of invention to which this difference is also applicable. Some of the inventions, particularly in the Bureau of Agriculture and Industrial Chemistry and at the Forest Products Laboratory of the Department, involve products that are intermediate to further manufacturing processes, and are directed primarily to the utilization of farm and forest products without regard to the end uses that may later be developed. For example, a patent issued on February 27, 1951, provides certain methods for treating feathers to get them into a protein form. In this form the material may later be used by manufacturing companies for a wide variety of materials, including the development of fibers, bristles, and similar articles, or the development of protein feeds for poultry, or the manufacture of plastics, or many other different uses to which protein materials can be put.

The invention is intended primarily to provide for the utilization of feathers when in surplus, and while the Government might at some time use some of the end products manufactured, the Government is not likely to engage in the treatment of feathers for this purpose.

The committee is doubtless also familiar with the work of the Department in the development of certain medicinal products from agricultural products. One of these that has come into use is Rutin, now made largely from buckwheat. It is a product used in medicine to reduce the danger of bleeding, in the case of persons whose capillaries and other blood vessels have become fragile and brittle with a tendency to break under pressure or damage.

There are several patents in regard to the method of manufacturing and purifying this product. These inventions are better described as "in the public interest," rather than as "to be used by and for the Government."

As another illustration, a Department employee has applied for a public-service patent on a method of removing the last traces of fatty materials from starch. This is a process that is useful in many industrial fields in connection with any product in which defatted starch is of value. It is not likely to be employed by Government agencies, but it is in the interest of the use of agricultural products and in the interest of consumers.

That is one suggestion we are making with respect to section 221 of H. R. 3760, that the language go back to the wording that was used in H. R. 9133 of the last Congress, namely, use the term "in the public interest" in place of the proposed change.

In the Secretary's letter to the committee, there is an additional suggestion which does involve a change in the present law in case the committee wishes to consider it. This relates to the cooperative research of the Department. Under various statutes the Department

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of Agriculture carries on considerable research in cooperation with the agricultural experiment stations.

It also engages in contract research with various contractors. Such research sometimes results in patentable inventions by persons who are carrying out all their investigations at the expense of the Government, but they are not Government employees.

Under present law the Nonfee Act is available only for inventions made by Government employees. Therefore, when there is an invention by a contractor or a cooperating agency working on a Government grant or an allotment or under a Government contract, it cannot now be patented under the Nonfee Act. In such cases either the Department pays the fee, or the rights, under the cooperative agreement, may be granted to the cooperator, depending on the equities in the particular case. In some cases possibly no application for patent is filed.

In the case of inventions made wholly or partially at Government expense where a cooperating inventor assigns patent rights to the Government, or dedicates such rights to the public, the Department recommends that the inventor should not be required to pay the patent fees. The Secretary's letter to the committee suggests a modified language for this paragraph, section 221, providing for such authorization.

I shall be glad to leave with the counsel of the committee for consideration as further illustrations of the type of patents referred to that are of general interest to the public a list of all of the patents that were granted to the Bureau of Agricultural and Industrial Chemistry, one of the Bureaus that carries on research of this type during the fiscal year 1950.

The committee can note from this list the title of the patents, the nature of the Department inventions that come under this law.

Thank you, Mr. Chairman.

Mr. BRYSON. Would you like to have this letter from the Secretary included in the record?

Mr. FRACKER. I would be glad to have it included in the record, if you will, sir.

(The letter referred to follows:)

DEPARTMENT OF AGRICULTURE,
OFFICE OF THE SECRETARY,
*Washington, June 12, 1951.*

Hon. JOSEPH R BRYSON,
*Subcommittee No. 3, Committee on the Judiciary, House of Representatives.*

DEAR MR. BRYSON: This is in response to your letter of April 30, 1951, requesting a report on H R. 3760, a bill to revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents."

We have previously urged inclusion of a number of additional items as outlined, for example, in our letter to you of June 1, 1950, commenting on the preliminary draft of the proposed revision and amendment of the patent laws. However, it appears that these proposed items are of controversial nature and may have been omitted from the bill for this reason.

We believe the major portion of the bill advances the patent laws and should be enacted. Except for one item discussed in detail below, we do not oppose the bill and do not propose to press, at present, for several of the additional items referred to above. The Department is not, however, abandoning its contention that legislation along the lines we have previously urged should be adopted.

The item of H. R. 3760 which is objectionable to the Department is found in section 221. According to this section, filing an application under the Nonfee Act would require certification hy the head of a department or agency that the "inven-

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tion is used or likely to be used by or for the Government * * *." The corresponding language of the present law (35 U S. C. 45) requires certification that the "invention is used or liable to be used in the public interest." This change in language may be significant to the operation of this Department.

Much of the Department's research is intended primarily for advancing agriculture and other industries, and use of a resulting invention by or for the Government is incidental. It is the policy of the Department to patent such inventions with dedication of the patent rights to the public or assignment to the Government, thus to assure that the results of the research for which the public has paid will inure to the benefit of the public; that is, patents are obtained as a safeguard to prevent unwarranted patenting by others. It is customary to file the application for such an invention under the nonfee act certifying that the invention is "used or liable to be used in the public interest," without regard to direct use by or for the Government.

If section 221 of H. R. 3760 passes in its present form and is construed to be limited to inventions used or likely to be used by or for the Government itself, as, for example, in procurement of devices including the invention, it may result in removing many of the Department's inventions from the benefits of the nonfee act.

This Department is opposed to the proposed change. There is as much or more reason to place an application under the nonfee act when the entire domestic patent rights are dedicated to the public or assigned to the Government as when merely a license in the invention is given the Government for its own use.

The payment of Patent Office fees by the Department on these applications would, of course, be possible. However, there is no advantage to the Government in doing this, but a considerable disadvantage. Payment of fees from one department to another involves a cumbersome procedure. It includes costly details of operation and is time consuming. Applications deposited in the Patent Office may lie for several weeks waiting for completion of the operation of making the payment. This delay in obtaining a filing date may result in valuable rights properly belonging to the Government or the public being acquired by private parties.

We wish to call attention to our recommendations of June 1, 1950, in which it was indicated that this Department acquires some patent rights to inventions from persons who are not Government employees; as, for example, rights acquired by virtue of a research contract, and that it would be desirable for applications for such inventions to be included under the nonfee act. To this end we recommend that section 221 of the bill be amended to read as follows:

"The Commissioner may grant, subject to the requirements of law, to any officer, enlisted man, or employee of the Government, except officials and employees of the Patent Office, a patent without the payment of any fee, when the head of a Department or agency certifies that the invention described in the patent application is used or liable to be used in the public interest and the applicant in his application states that the invention may be manufactured and used by or for the Government for governmental purposes without the payment to him of any royalty thereon, which stipulation shall be included in the patent, or to any person who assigns the domestic patent rights for an invention to the Government or dedicates such rights to the public, when the head of a department or agency certifies that the invention was made wholly or partially at Government expense."

We again recommend that the act be amended to read as above set forth. The Bureau of the Budget advises that there is no objection to the submission of this report.

Sincerely,

K. T. HUTCHINSON,
*Assistant Secretary.*

Mr. CRUMPACKER. This issuance of patents without fees, has that been in the law for some time?

Mr. FRACKER. Since 1883, approximately 68 or 70 years ago.

Mr. CRUMPACKER. When you use the term "in the public interest," would it not be a fair statement to say in the general sense that any really worth-while patent is issued in the public interest? Is that not a pretty broad term?

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Mr. FRACKER. I suppose there are patents that are issued that benefit either the inventor or the assignee more than they do the public. In the case of the Department of Agriculture, the purposes for which the Department was established would be our basis for determining whether inventions that come up in our regular work would be in the public interest.

Mr. CRUMPACKER. I presume the fees charged by the Patent Office are scaled primarily just to pay their expenses of operation, are they not?

Mr. FRACKER. I am not familiar with how they are scaled.

Mr. BRYSON. We have that.

Mr. CRUMPACKER. What I am thinking is, in the interest of more orderly governmental accounting so that it will be easier, particularly for a Congressman looking at the appropriations bills, to know where the money is being spent and why, would it not be more appropriate to let these other Government agencies pay the normal fees, irrespective of what the purpose of the patent is, and keep the Patent Office on a self-sustaining basis rather than have what you might call subsidy payments covered up in the Patent Office appropriation? I think, in the interest of arranging your bookkeeping so that you can see where the money goes and for what purpose, it would be more proper even though the Government is merely taking money out of one pocket and putting it in another. Then would it not be better to eliminate this provision entirely and merely have the Government departments pay the normal fees?

Mr. FRACKER. The financial effect on the Government is the same either way.

Mr. CRUMPACKER. I can see that. It is the same number of dollars either way, but it is a matter of bookkeeping.

Mr. FRACKER. The making of those transfers has two disadvantages—the clerical cost within the Government and the delay in certain cases while payment is going through, which would affect the processing of the patent. Otherwise the matter is one for determination of general Government policy.

Mr. CRUMPACKER. I can recognize those two objections to doing it that way. I would think, however, that you would probably have a fairly steady flow of this type of application through your department. That is, year in and year out there would be about the same number of patents, something you could anticipate in the budget request. Is that right?

Mr. FRACKER. The department applies for patents on inventions in numbers approximating about 100 a year, varying above and below that by 20 or 30 percent perhaps.

Mr. BRYSON. Thank you, Dr. Fracker.

We will now hear from Mr. Edward R. Walton.

## STATEMENT OF EDWARD R. WALTON, JR., REPRESENTING THE DISTRICT BAR ASSOCIATION FOR THE DISTRICT OF COLUMBIA

Mr. WALTON. Mr. Chairman and members, I am Edward R. Walton, Jr., a member of the bar of the District of Columbia and also chairman of its patent committee this year. I am here representing the Bar Association for the District of Columbia.

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BAR ASSOCIATION OF THE DISTRICT OF COLUMBIA,
*Washington, D. C, June 12, 1951.*

EDWARD R. WALTON, Esq.,
*Chairman, Committee on Patent Law,*
*Munsey Building, Washington 4, D. C.*

DEAR ED: The board of directors, after full consideration of the final report of the patent law committee, which you personally presented to the board at its meeting on June 7, upon motion duly made, seconded, and carried:

(1) Approved the recommendation of your committee and authorized the chairman or other member duly designated by the committee to appear before the appropriate committees of Congress to urge the passage of H. R. 3760, with proposed amendments, favored by the committee.

(2) Approved the balance of the report with an expression of appreciation to the committee for the excellent work done during the past year.

With kindest regards,

Sincerely yours,

JUSTIN L. EDGERTON, *Secretary.*

Our committee studied H. R. 3760 very carefully, particularly in view of the amendments that were proposed by the so-called coordinating committee. The only way I have to refer to them is by date of May 22. I suppose your committee knows what they refer to. This study was reported to the association of the District of Columbia and was approved by that association.

We recommend the passage of H. R. 3760 so amended. Although there were a number of other questions that arose, our association felt the present bill represented a very large area of agreement between the patent lawyers and would probably be as large an area of agreement that could be expected at this time. Therefore, we would like to see its passage, particularly with those amendments.

Thank you, sir.

Mr. BRYSON. Thank you, sir.

We would like to offer for the record at this point a statement from the State Department dated June 13, 1951, a statement from the Chamber of Commerce of the State of New York in which they recommended passage of the bill dated June 7, 1951, and a telegram from the Seattle Patent Law Association recommending the passage of the bill, said telegram being dated June 13, 1951.

(The documents referred to follow:)

DEPARTMENT OF STATE,
*Washington, June 13, 1951.*

HON. JOSEPH R. BRYSON,
*Chairman, Subcommittee No. 3, Committee on the Judiciary, House of Representatives.*

MY DEAR MR. BRYSON: Reference is made to your letter of April 30, 1951, transmitting a copy of H. R 3760, to revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents."

The Department understands that H. R. 3760 is essentially a codification of existing laws and involves no major changes in patent legislation. There are, however, a few minor modifications proposed in H R. 3760 which have some bearing on foreign relations. Specific comments of the Department of State on these modifications are as follows:

1. *Section 102, "Conditions for patentability."*—Subsection (d) of this section will operate to the advantage of foreign nationals applying for United States patents as compared with provisions of existing law. Under the present law if a foreign patent is issued before a United States patent on the same invention and the foreign application was filed more than a year prior to the United States application, a United States patent cannot be secured. Under the new provision a patent may, nonetheless, be secured provided the application is filed in the United States prior to issuance of a patent in a foreign country.

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Since the existing law appears unnecessarily harsh and United States nationals do not face a similar disability in most foreign jurisdictions, the Department fully supports this modification.

2. *Section 119, "Right of priority based on foreign application."*—This section adds a new requirement to the patent law by providing that no application or patent shall be entitled to priority based on a foreign application unless a claim for such right and a certified copy of the original foreign application are filed with the Patent Office. It also provides that the Commissioner may require an English translation and such other information he deems necessary. It is understood that these requirements are desired by the Patent Office for administrative reasons and that they are no more rigid than requirements in many foreign countries.

3. *Section 232, "Temporary presence in the United States."*—This section provides that no patent shall prevent the use of an invention in any ship, vessel, aircraft, or land vehicle of another country temporarily entering the United States. This provision accords with the requirements of article 5 of the International Convention for the Protection of Industrial Property. Since the United States is a party to this convention, the Department regards it as desirable that this provision be written into our domestic patent law.

4. *Section 252, "Service and notice; nonresident patentee."*—This section provides that a nonresident patentee may designate by notice to the Patent Office a person within the United States on whom process or notice may be served and that in lieu of such designation such notice or process may be served upon the Commissioner. The Department understands that this provision has been added for the benefit of American residents desiring to bring action against foreign owners of United States patents. At the present time American manufacturers threatened by charges of infringement of United States patents by persons resident abroad are especially handicapped by inability to bring suit for declaratory judgment. Most foreign countries in their patent laws require foreign owners of patents issued by them to have resident agents upon whom service may be made.

The Department has no objections to any of these modifications or to enactment of the bill as drafted.

The Department appreciates the invitation to have a representative present at the hearings on this bill. However, in view of the technical and legal nature of the modifications, and apparent absence of any controversial problems relating to foreign affairs, the Department does not believe that it could make any material addition to the testimony of the Patent Office. The Department would, of course, be glad to send a representative should your committee desire a further expression of the Department's views on any problem presented by the proposed legislation.

The Department has been informed by the Bureau of the Budget that there is no objection to the submission of this report.

Sincerely yours,

BEN H. BROWN, JR.,
*Acting Assistant Secretary for Congressional Relations,*
(For the Secretary of State).

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CHAMBER OF COMMERCE OF THE STATE OF NEW YORK

At the regular monthly meeting of the Chamber of Commerce of the State of New York held June 7, 1951, the following resolutions and report presented by its committee on law reform were unanimously adopted:

PROPOSED REVISION OF PATENT LAWS

*To the Chamber of Commerce:*

The committee on law revision offers the following:

The last general revision of our patent laws was the act of July 8, 1870, which was enacted as part of a program to revise and consolidate all the laws of the United States

The present patent law, as set out in title 35 of the United States Code, is, therefore, essentially the act of 1870, with subsequent amendments.

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As orginally compiled and published, the United States Code was not enacted as law but only prima facie evidence of the law. Consequently, the Congress from time to time, has undertaken to revise and enact various titles of the code.

During the past several years, there have been substantial efforts regarding the revision and enactment of title 35, Patents.

On July 17, 1950, a bill to revise and codify the patent statutes was introduced in the House of Representatives. It was drafted by a subcommittee of the House Judiciary Committee, after a considerable study of all congressional acts relating to patents, which had been passed since the early 1870's. Generally known as the Bryson bill, the measure derived its name from the chairman of the subcommittee, Joseph R. Bryson (D), South Carolina.

This 1950 measure not only undertook to revise, arrange, and consolidate the various patent acts; but also endeavored to present various amendments of substance

Following the introduction of the measure, numerous suggestions with respect to it were made by patent-law associations and other technically competent private groups; and these suggestions were subsequently coordinated by a committee appointed by the National Council of Patent-Law Associations.

The resnlt is a new Bryson bill, H. R. 3760, introduced on April 18, 1951, containing most of the suggestions made by the coordinating committee of the National Council of Patent-Law Associations.

Like its predecessor, the new bill has the dual objective of revising and consolidating existing laws, and of offering certain substantive amendments.

In its consideration of the currently proposed legislation, tbe chamber's committee on law reform readily concluded that the first objective *i. e.*, the revision and consolidation of existing statutes, constitutes a step long overdue. Since the last general revision of these laws was some 80 years ago, there would appear to he little question as to the desirability of such revision.

Insofar as the second objective is concerned, it is to be noted that the drafting of amendments of substance was the result of prolonged and careful study. In drafting amendments to existing laws, the following sources were consulted: (1) All bills relating to patents which have been introduced in Congress since 1925; (2) Reports of the Science Advisory Board, the Temporary National Economic Committee, and the National Patent Planning Commission, and, (3) reports and recommendations of private groups such as patent-law associations and patent section of the American Bar Association.

Because of the highly intricate and technical nature of the subject, the committee on law reform believes that it should not endeavor to pass judbment on each individual amendment. Nevertheless, it is the opinion of the committee that the amendments, in general, represent improvements in existing patent law.

The more important amendments to the present law are discussed briefly. The proposed law makes a provision that the manner in which an invention is made shall not negative patentability. Some question has been raised as to whether or not a new device or process discovered by experimentation constitutes a patentable invention and the bill now says these are patentable.

Court decisions are in conflict as to so-called intervening rights, and section 202 clarifies the law thereof.

In the interest of national defense the powers of the Commissioner to keep inventions owned by the Government secret have been enlarged.

Many schemes have arisen by which others pirate a patented invention by making a part only thereof and selling the part to another who completes the patented invention The conrts held as early as 1871 that such acts which contribute to infringement are infringements of the patent. In recent years, however, the courts have whittled away at this doctrine of contributory infringement so that it is now nonexistent, leaving many patentees without remedy to protect their patented inventions. The proposed bill reestablishes the principle, though not to the same extent, that contributory infringement is infringement of a patent.

The bill also makes it possible for a court to take any action respecting a patent or rights thereunder of a patentee not resident in the United States. Under the present patent laws such patents cannot be reached except at the will of the nonresident owner.

* * * * * * *

In view of the fact that our last general revision of the patent laws dates back to the 1870's, the committee on law reform believes that the chamber should place itself on record as supporting any soundly conceived proposal—such as that contained in H. R 3760—which would revise and consolidate existing patent statutes.

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And, while the committee does not feel empowered to request endorsement of the specific amendments of substance embodied in the bill, it wishes to emphasize that these amendments were included only after the most careful study, and with full consideration to suggestions of technically competent private groups. Now, therefore, be it

*Resolved*, That the Chamber of Commerce of the State of New York endorses, in principle, H. R. 3760, which would revise, codify, and enact into law title 35 of the United States Code, entitled "Patents"; and which would add to title 35 certain amendments of substance; and be it

*Resolved*, That the chamber urges the Congress to act favorably upon this or generally similar legislation; and be it further

*Resolved*, That copies of this report be sent to all Members of Congress.

Respectfully submitted.

AUGUST IHLEFELD, *Chairman*,
MATTHEW G. ELY,
JOHN M. MONTSTREAM,
BEVERLEY R. ROBINSON,
EUSTACE SELIGMAN,
EDWIN S. S. SUNDERLAND,
BRONSON TREVOR,
*Committee on Law Reform*,
ROBERT L. HAMILL, *President*.

Attest:

B. COLWELL DAVIS, JR., *Executive Secretary*.

NEW YORK, *June 7, 1951*.

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SEATTLE, WASH., *June 13, 1951*.

NATIONAL COUNCIL OF PATENT LAW ASSOCIATIONS,
*National Press Building, Washington, D. C.*:

The Seattle Patent Law Association by special committee for the consideration of H R. 3760, approves that bill as it is proposed to be amended in the coordinating committee's report of May 22, 1951, subject to further consideration of section 102 (g) which may better state the law of interferences. In principle this proposed legislation is approved and its passage is supported.

FORD E. SMITH, *Chairman*.
ROBERT W. BEACH.
RICHARD SEED
ORLAND M. CHRISTENSEN.
BENJAMIN F. BERRY.
DUANE C. BOWEN.

Mr. BRYSON. Mr. T. Hayward Brown, of the Department of Justice.

## STATEMENT OF T. HAYWARD BROWN, CHIEF, PATENT LITIGATION UNIT, CLAIMS DIVISION, DEPARTMENT OF JUSTICE

Mr. BRYSON. Please proceed, sir.

Mr. BROWN. Mr. Chairman, I appreciate the opportunity to express the views of the Department of Justice concerning H. R. 3760. The primary purpose of the present bill is the codification of the statutes relating to patents. The Department of Justice is in accord with this general objective and recognizes that your subcommittee has made notable accomplishments in codifying the law in other fields.

In addition to the codification objective of the present bill, the bill also proposes to make various changes of substance in the patent laws. Ordinarily codification bills are very restricted in the actual changes in substance made in the law. There is one danger in introducing changes in the law in a codification bill in that the changes may be major or may be controversial and would overshadow the general objectives of the codification bill.

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In cases of codification there is a general presumption of a legislative intent to follow existing statutes, notwithstanding changes in phraseology, which would not be applicable where the law is also being amended substantively. As a result, it becomes difficult to ascertain upon a doubtful point whether a substantial change in existing law or merely a change in language was intended and the ultimate effect may be to cause confusion in the interpretation of the law.

It is particularly important that the patent law not be unsettled or rendered ambiguous at this time of National emergency when patents will play a large part in the expansion of industry incidental to National defense needs.

The Government has a particular interest in this since it must pay, directly or indirectly, for the use of patent rights in such expansion and in the rearmament program.

There is also the danger that in attempting to revise the whole patent law insufficient consideration may be given to particular sections and their interrelationship with the consequence that unintended changes in the law may result.

It is suggested that if enactment of the present Title 35 into law is deemed necessary, this be done without attempting to revise the law substantively at the same time.

If, on the other hand, over-all substantive changes are deemed necessary, it would seem better to handle such changes by separate enactments. If it is thought desirable, however, to enact the bill in its present form, there are certain features of the measure which would seem to require further consideration. I will discuss the particular sections that the Department feels may deserve further consideration. Section 100 of the bill, "definitions," defines "invention" to include discoveries. While the term "discovery" is used in the patent law as synonymous with invention and it has been recognized that the act of discovery is an essential part of the invention, under existing law discoveries, as such, are not patentable.

The section might have the effect of creating doubt as to existing law on the subject of discovery and might result in opening the door to a huge new area of patents, and permit the creation of monopolies in some of the fundamental and far-reaching discoveries in the fields of chemistry, physics, medicine, mathematics, et cetera.

The Department would be opposed to the creation of any new area of monopoly which would be exempt from the operation of the antitrust laws in the absence of clear evidence that such extension is necessary to provide adequate incentive for scientific effort. There would appear to be no such necessity with respect to the broad field of "discovery."

Section 100 also defines the term "process" to include a "new use of a known process, machine, manufacture, composition of matter or material." Under present law it is not invention to apply old and well-known materials, processes, or devices to new uses in other and analogous arts. However, if an old device or process be put to a new use, which is not analogous to the old use, and the adaptation of the old device or process to the new use is of such a character as to require the exercise of the inventive faculty to produce it, a patent may be granted for the new use. The Department is opposed to this section if it is intended to materially extend existing law, to uses that are obvious or to uses that do not require invention.

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Section 103 of the bill, "conditions for patentability; nonobvious subject matter," provides that:

A patent may not be obtained though the invention is not identically disclosed or described in the prior art set forth in section 102 of this title, if the differences between the subject matter sought to be patented and that prior are are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

This section is rather ambiguous in phraseology and its meaning is not clear. Section 103 apparently attempts to state one of the present negative rules of invention that mere mechanical skill is not invention. This rule has a long history and background and the standard of mechnical skill depends upon the nature of the art in question. The wisdom of attempting to codify this rule in one sentence is questionable and in any event this is only one test of invention and it should not, in the opinion of this Department, be made the sole test. Insofar as this section may be intended to change the present law, we are opposed to it. If no change is intended, we think that the language should be clarified.

There are some sections of the bill that have been discussed in the Deputy Attorney General's letter that you have on file in which he reports favorably on the sections, pointing them out as being new legislation that the Department agrees with.

To shorten my presentation, I will omit mention of those sections. They include section 104 and other sections that I will mention later.

Section 112 relating to patent specification contains a provision that—

an element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure or acts in support thereof, and such claim shall be construed to cover the corresponding structure, materials, or acts described in the specification and equivalents thereof.

This section may substantially alter existing law. At present the courts will invalidate a single "means" claim when it is functional; that is, when it covers all means for performing an act, or when the step described as a "means" is the precise point of invention. The burden at present is upon the patentee to describe his invention in exact terms and it is not clear to what extent he might be relieved of this duty under the proposed section.

The section further introduces into the statute for the first time the controversial doctrine of equivalents without defining its scope. The Department sees no necessity for this section since the courts have rarely invalidated a patent merely because of the language used in a claim when it is clear that the patentee only intended to refer to, but not to claim as his invention, means which were old in the art.

Section 118 of the present bill introduces a new concept heretofore unknown to the United States patent law. This section permits an assignee or a person to whom the inventor has agreed to assign an invention in writing to apply for a patent whenever the inventor cannot be found or refuses to execute an application. The patent to be applied for under this section will issue to and in the name of the inventor unless a court of competent jurisdiction orders a transfer thereof to the party to whom the inventor has agreed to assign the invention. This new section is believed to be highly desirable in that it would

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permit employers, including the Government, to file applications for patent on inventions made by employees who are unavailable when an application is ready to be filed. This is not uncommon in these troublous days when many military and other personnel are beyond the seas when needed for the execution of a patent application. The section does not change any substantive rights. It merely permits the timely filing of an application by the party who thinks he has an interest therein without in any way affecting the inventor's rights.

Section 144, "Decision on appeal," embodies the existing statute except that it omits the last sentence of the present section 4914 (35 U. S. C. 62) which states that—

> no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

Deletion of this sentence might be interpreted as expressing a congressional intent to make patent validity conclusive where the patent had been upheld by the Court of Customs and Patent Appeals in what is frequently an ex parte action. This Department would be opposed to such a change in the law and suggests that the bill be amended so as to retain the above language.

With respect to section 202, it is suggested that if the existing court law is to be embodied in a statute, as that section contemplates, the established court rule of due diligence in applying for a reissue should be included as well as the present rule that a delay of more than 2 years will create a presumption of intervening rights in the public.

Section 212 of this bill provides that in the absence of agreement, joint owners of a patent may not individually grant licenses or assign their interest without the consent of the other owners or without accounting to them. This section introduces a new concept to the patent law but it is believed to be a salutary one for inventors very often know little or nothing about the patent laws. Enactment of this section would protect a joint inventor against an unscrupulous coinventor or coowner.

Paragraph (b) of section 231 provides that any person who actively induces infringement shall be liable as an infringer. Paragraph (c) provides that it shall constitute contributory infringement to sell a component part of a patented machine, manufacture, combination or composition or material or apparatus for use therewith, if a—

> material part of the invention especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use * * *

Paragraph (d) provides that:

> No patent owner otherwise entitled to relief for infringement or contributory infringement of a patent shall be denied relief or deemed guilty of misuse or illegal extension of the patent right because he has done one or more of the following: (1) Derived revenue from acts which if performed by another without his consent would constitute contributory infringement of the patent; (2) licensed or authorized a person to perform acts which if performed without his consent would constitute contributory infringement of the patent; and (3) sought to enforce his patent rights against infringement or contributory infringement.

These provisions would result in writing into the patent statutes for the first time the strictly judicial doctrine of contributory infringement, a doctrine which has been the subject of considerable controversy and has been properly limited by the courts in recent years.

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This Department is opposed to extending the law of contributory infringement. The revision would clearly extend it in several respects. In the first place, paragraph (b) would put the contributory infringer in the same category as a direct infringer, thereby subjecting him to the limitations and liabilities of the latter.

Paragraph (d) would greatly impair the salutary doctrine that a patentee who has misused his patents may not recover in a suit for either direct or contributory infringement. The Supreme Court has held that a requirement by a patentee that users purchase from him or his exclusive licensee unpatented parts not within the scope of the patent, was a misuse of the patent and barred recovery even though contributory infringement was assumed to exist. This doctrine is a most important factor in the enforcement of the antitrust laws with respect to tying arrangements and the Department is opposed to any impairment thereof.

It is not clear to what extent paragraph (b) is intended to enlarge the present law on contributory infringement. The phrase, "actively induces infringement" might cover many situations which are not now considered to be contributory infringement. Paragraph (c) also appears to enlarge the scope of contributory infringement. While some cases have indicated that one who sells an article not capable of use except in an infringing manner is liable for contributory infringement even in the absence of actual knowledge of the infringement, the sounder approach would seem to be that such facts merely give rise to a rebutable presumption of intent to infringe.

The first paragraph of section 242 (Presumption of validity; defenses) provides that a patent shall be presumed to be valid and the burden of establishing invalidity shall rest upon the party asserting it. The Department objects to these provisions since at present the presumption of validity is not embodied in a statute and is merely a qualified rule of evidence. Also under present law this presumption does not always hold true, for example in cases where the Patent Office fails to cite or consider pertinent references or prior art.

Section 203 (Disclaimer of invalid claim) and 248 (Suit for infringement when a claim may be invalid) substantially alter the present law as to a statutory disclaimer. Section 203 omits the provision of the present statute (R. S. 4922; 35 U. S. C. 71) that "no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer." Under this provision, the courts have held that the entire patent may be void if a prompt disclaimer is not filed. Section 248 of the proposed bill, on the contrary, expressly provides that au action for infringement may be maintained despite failure to disclaim an invalid claim, the only penaly being that no costs may be recovered.

The present rule requiring a prompt disclaimer of invalid claims is intended to place upon the patentee the burden of restricting his claims to his actual invention. This accords with the basic idea of the patent laws that a patentee may only claim the invention he had disclosed in his patent. The present law even goes so far as to require the prompt disclaimer of claims similar to one which has been held invalid. The public interest requires the formal cancellation of invalid claims so that they may no longer be used to harass the public through nuisance litigation and misleading impressions of legitimate scope of the patent, and thus discourage the public's use of technology that it is entitled to use freely.

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Section 251 raises the false marking penalty from $100 and costs to a flat $500. This change is believed to he desirable in that it will aid the policing of false marking. With the present law the informant bringing a qui tam action rarely receives more than $50, which does not pay him for his time and trouble.

Section 252 (Service and notice; nonresident patentee) provides that a nonresident patentee may designate by notice to the Patent Office a person within the United States on whom process or notice may be served and that in lieu of such designation such notice or process may be served upon the Commissioner. This is a new section. It does not represent codification, but the Department has indicated that it is in favor of this.

The department understands that this provision has been added for the benefit of American citizens desiring to bring action against foreign owners of United States patents. At the present time American manufacturers threatened by charges of infringement of United States patents by persons resident abroad are especially handicapped by inability to bring suit for declaratory judgment. Most foreign countries in their patent laws require foreign owners of patents issued by them to have resident agents upon whom service may be made.

Except for the specific sections to which objections or questions have been raised, the Department of Justice is not opposed to H. R. 3760.

Mr. BRYSON. Thank you, Mr. Brown.

Mr. Lanham, we are always pleased to have you present.

Would you like to make some comment or statement that would be helpful and constructive here?

## STATEMENT OF FRITZ G. LANHAM, FORMER REPRESENTATIVE FROM TEXAS

Mr. LANHAM. Mr. Chairman and members of the committee: I had not intended to testify. I am not a patent attorney.

Mr. BRYSON. You are a patent authority, though.

Mr. LANHAM. I had the pleasure of serving for about a quarter of a century on the Committee of Patents of the House of Representatives. I thus acquired some familiarity with the structure of our patent system and also in appearances which I have made before this committee since my voluntary retirement from the Congress after 28 years of service.

I am and have been since my retirement a representative of the National Patent Council, which is a nonprofit organization of smaller manufacturers primarily interested in the education of the public with reference to the importance of our patent system and the fact that patents make jobs and promote the development of our economy.

However, that council is not a patent law association. Because of their interest in its policy many patent attorneys are connected with it as associates.

It is to be assumed that there is some diversity of opinion and sentiment among those patent attorneys who are associates with reference to certain provisions of the pending proposal, just as we have seen outcropping here in the testimony some differences of opinion concerning special sections. Consequently my appearance is merely as an individual in compliance with the request of the chairman just made and not as a representative of the National Patent Council.

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This bill seeks to codify provisions with reference to patents. Certainly a codification measure is desirable, but in my judgment, what is placed in the law codifying patent provisions should be, insofar as possible, noncontroversial. Certain controversies have arisen in the discussion thus far and likely further differences of opinion as to a few provisions will be presented by other witnesses. There are one or two such provisions in particular which I recall have been the subject matter of hearings before this subcommittee heretofore, notably perhaps in the last Congress, one having to do with the test of invention or patentability and the other having to do with contributory infringement.

I recall that among others I testified on each of those matters before the subcommittee in the Eighty-first Congress. It appears that they are still somewhat controversial.

Would it be advisable, therefore, in view of the fact that this bill seeks the codification of the patent laws, to eliminate one or two controversial provisions from present consideration and have separate consideration of each in proper and appropriate bills which would permit much more detailed and thoughtful study of the matters involved than would be possible in such testimony as will be given before this subcommittee? That would not prevent codification of provisions which could be agreed upon.

I recall, for instance, in my long service on the Committee on Patents, I was requested to endeavor to get an enactment with reference to trademarks that would be more in keeping with modern conditions and practices in view of the fact that the old laws of 1905 and 1920 had become somewhat obsolete and not applicable to the business conditions and practices today. Though I have now, and had then, no personal interest in any trade-mark except as a consumer, I undertook that task. It was quite a comprehensive undertaking, technical in many aspects just as the consideration of this measure involves many technical considerations.

I labored as the chairman of a subcommittee with different personnel in each Congress through four different Congresses to get the final enactment of the trade-mark law now on the statute books. When we first began the consideration of that subject matter, those who appeared were, speaking figuratively, at one another's throats. There was great diversity of opinion concerning provisions that should be incorporated in such a law.

So I served perhaps more or less, as a mediator and conciliator and tried to get the groups together upon something with reference to which they could agree.

Finally, after 4 years of such effort and the introduction of several different bills with modifications which had been suggested, we got the enactment, with the terms of which practically all of those in original disagreement found themselves quite in conformity and accord.

We took up those bills, section by section, and heard testimony upon each section, in order that we might have all of the facts and information upon which we could base our final judgment.

Here are many provisions of this bill, some of them very technical as evidenced by the testimony thus far adduced. I believe by proper conferences practically all of the differences can be settled and the codification effected. I merely inquire as a policy of procedure whether

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it would be wise just now to include one or two highly controversial provisions in the codification or leave them for early consideration in separate bills for more extended and detailed discussion and study.

We are all anxious to have a proper codification of the patent laws, and the coordinating committee has labored diligently with such a purpose. We are all specially anxious to have them properly protective of the patentee, because upon the ingenuity of this country through the incentive of our patent system we have attained the progress and prosperity which has made us the first Nation of the world. Let us keep so and let us be very sure that whatever we enact will retain that incentive and inspire these workers of America, who give us so many things useful for our progress, to carry on their laudable undertakings.

It is very interesting, in that connection, to note that many and perhaps most of our very useful inventions which have greatly accelerated our progress and our prosperity have come from most humble sources.

Leonardo da Vinci was in a way an authority on aviation, but they had no internal combustion motor in his day and there was no practical application of his ideas.

Langley and others worked with aviation, and finally two bicycle dealers down in North Carolina disclosed that it was practical. Instance after instance of a comparable nature could be cited with reference to so many of our most important discoveries.

Let us be very sure that whatever we enact is not only going to continue the incentive of humble people as well as others to promote our progress, but let us see to it also that in their discoveries they are protected, as has been intended in this Government ever since we first had our patent law, largely through the efforts and the activity of Thomas Jefferson.

These random throughts may not be helpful to you, and they are purely my individual opinions. Although I have no patent and I have made no discovery, I doubt if anyone, by reason of my long service on a similar committee and the realization of the importance of protecting our patent system, has any gerater interest in seeing proper legislation continue so that that incentive will continue which will make for our greater progress and prosperity. Let us hope that to this end proper codification may be had as promptly as possible.

Mr. BRYSON. We are much obliged to you.

I am sure we are starting toward the same objective. I believe the record will disclose this particular committee has sought to give ample opportunity and study to any controversial issue that we now consider or we may consider.

You know we have distributed literally thousands of the proposed revision and codification to every possible agency. These representatives from these well established reputable organizations from every point throughout the country are feeding us with their suggestions and thoughts. In these hearings here we are going to give everyone an opportunity to be fully heard, whether he favors or opposes. There will be no disposition to shorten these hearings at all.

Mr. LANHAM. I appreciate that, Mr. Chairman. I am well advised concerning the fairness of this committee. I am well advised also concerning its unremitting activity to bring about the very objectives in which you and I, and I think all of the loyal American citizens, are properly interested. And please understand that I am not opposing codification and that I have merely offered a suggestion with refer-

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ence to procedure in the consideration of one or two controversial issues.

Mr. ROGERS. You recognize that the revision and the old Committee on Patents is all accumulated here in this subcommittee under the reorganization?

Mr. LANHAM. I appreciate that.

Mr. ROGERS. Do you think, due to the fact we have this controversy existing as to what constitutes the law makes it almost an insurmountable task to recodify the law?

Mr. LANHAM. I think most of the provisions in this bill before you can be codified.

I would not appear as being opposed to codification of patent laws. I think we should codify what is not highly controversial and what through conferences can be agreed upon.

Mr. ROGERS. Have you, in the study of this proposed bill, any particular objection to any particular provision that you feel should not go in there without a thorough study and a different bill introduced to take its course through Congress?

Mr. LANHAM. Let me repeat, I am not a patent attorney. I am not versed in all of these technical provisions. I feel that with reference to practically all of the provisions of this bill some agreement can be reached from the standpoint of codification. On one or two controversial provisions I think the action should assure a basis of clarity for judicial interpretation and the protection of the discoverers of useful and novel inventions. In other words, the code concerning them should be both fair and definite.

Mr. ROGERS. In other words, you feel, to take the noncontroversial ones, make that the codified bill and then the controvsrsial ones could be considered separately?

Mr. LANHAM. They could be enacted as amendments to the codification and in that way perhaps we would get a better final result. There are several provisions here concerning which there is some slight controversy. I think those differences can be ironed out and most of the bill could thus be codified without any particular difficulty.

Mr. BRYSON. Thank you, sir.

Mr. Federico, will you come around, please?

## STATEMENT OF P. J. FEDERICO, UNITED STATES PATENT OFFICE

Mr. BRYSON. Mr. Federico, before you begin, may I ask: Has the Department of Commerce made a formal report on the pending bill?

Mr. FEDERICO. The Department of Commerce has made a report, but I am sorry to say we have not yet got it back from the Bureau of the Budget. We expect it today or tomorrow and will file it with the committee. The report will speak for itself. If I may speak before the report comes in, it raises no special objections and has one or two suggestions.

Mr. BRYSON. It goes along the general lines of the other departments?

Mr. FEDERICO. Yes.

Mr. BRYSON. Favoring the enactment of the bill preferably with certain amendments?

Mr. FEDERICO. In general; yes.

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Mr. BRYSON. But favoring the enactment of the general principle?

Mr. FEDERICO. Yes.

Mr. BRYSON. Would you care to address yourself or make any statement or comments on the positions taken by the different department representatives here today or who testified yesterday, or would you care to make any statement on your own observations?

If so, you may proceed.

Mr. FEDERICO. With respect to the reports from the other departments, I am sorry to say I do not feel in a position to comment on their specific suggestions for the reason that most o fthem I have seen today for the first time. The Department has not had the opportunity to make a report on them.

I would like to state generally that the reports of the three departments that have testified orally strike me that some of their proposals are things that none of the other departments would have any special objection to. A large number of them relate to matters of language and clarification which could be straightened out by some slight discussion. Possibly all of the reports of the departments on all points, except one or two, might be brought into agreement between the departments. I do not feel that I can comment on any of the specific provisions.

Mr. BRYSON. Without giving further study to them?

Mr. FEDERICO. They would have to be studied.

Shall I continue with the survey of the structure of the bill?

Mr. BRYSON. Yes.

Mr. FEDERICO. As 1 stated yesterday, chapter I of the bill collects the provisions relating to the Patent Office. Chapter II collects the provisions relating to the requirements for obtaining a patent and the procedure in obtaining a patent.

Chapter III deals with the patent itself after it has been granted.

The first group of sections relate to correcting and amending a patent, which is a necessary thing.

Sections 201 and 202 are a development of the present statute relating to what are called reissues. Under certain circumstances the patentee may obtain a new patent to replace the old one to correct various defects that he may have discovered in the patent. These two sections together replace the present one, making a number of clarifications with a few additions of further developments in the subject which I do not believe need to be gone iuto at the moment.

Section 203 relates to another form of correction of a patent known as the disclaimer. The patentee files a paper in the Office which is recorded. He disclaims certain things from the scope of his patent or disclaims certain claims. This subject of disclaimers in the present law has resulted in a great deal of confusion and uncertainty in certain situations, which are almost ridiculous at times. Consequently, the bill in two sections—203 and 248—has introduced certain changes relating to disclaimers. One of these changes is that only a whole claim can be disclaimed. A claim cannot be rewritten by filing a paper in the Patent Office. Only a whole claim can be disclaimed.

The second change relates to the situation when a patent has two or more claims and one of them may be discovered to be invalid.

Under the existing law, there is a provision in the statute that says that the invalid claim must be disclaimed without unreasonable

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delay in order to save the rest of the patent. What that unreasonable time might be is quite confusing, and the present law does not as a matter of fact, prevent the patentee from suing again on the invalid claim if he so wishes.

So, the bill has eliminated that requirement. It has left the situation that if one claim of a patent is invalid, the patentee may take it out. He may still sue on the remaining claims which have whatever validity they might have on their own merits. That is, one bad claim does not affect the other claims, unless they are themselves bad.

Other provisions of the bill perhaps take care as well as is done in the present law of the possibility of a patentee suing again after his patent has been held invalid. That can be done today and the bill makes no change in that situation, except that certain provisions might tend to deter doing such a thing.

Mr. BRYSON. How many times can he renew his request for a patent?

Mr. FEDERICO. You mean if he has been refused a patent?

Mr. BRYSON. Yes.

Mr. FEDERICO. That goes to obtaining a patent. Under the statute, the applicant has an absolute right to a reconsideration with whatever amendment, not changing the invention, he wishes to present. By the practice of the Patent Office in its regulations there may be two, three, or more reconsiderations until the matter reaches clearer issues which are closed one way or the other.

Mr. BRYSON. Must he supplement his petition by what we would call in the general practice "after discovered" or "newly discovered" evidence?

Mr. FEDERICO. Again referring to obtaining a patent and the procedure in the Office, if the Patent Office refuses the patent the first time, he is at liberty to present whatever he wishes, arguments, tests, affidavits, evidence. He is free to do anything he wishes. Whatever he does is reconsidered in the light of his arguments. He is given a new examination. That may continue for one or two times more after that.

Mr. BRYSON. In the discretion of the examiner?

Mr. FEDERICO. To a large extent, yes.

Mr. ROGERS. Getting back to this subject of section 203 of disclaimer you referred to a moment ago, did I understand you to say that the law at the present time is that in the event a man wants to disclaim he has got to disclaim the whole patent?

Mr. FEDERICO. No; the whole claim.

Mr. ROGERS. How does this new section 203 affect that? There was some testimony it omitted part of the statute.

Mr. FEDERICO. Under the bill, he must disclaim the whole claim. Under the present law, as it is worded, he may revise a claim.

The change in the present law is in omitting the requirement that an invalid claim must be disclaimed within a reasonable time; that is, must be taken out of the patent within a reasonable time to save the validity of other claims in the patent.

Mr. ROGERS. If he does not disclaim within a reasonable time under the present set-up, does that vitiate the entire patent?

Mr. FEDERICO. That theoretically vitiates the entire patent, but he is still free to sue on that invalid claim again.

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Mr. ROGERS. He would not get very far.

Mr. FEDERICO. That is right.

Mr. ROGERS. Your objective in this section 203 is to change it in what manner?

Mr. FEDERICO. That particular change is made by section 248, rather than section 203.

They dovetail together. The manner of making that change is if a claim is invalid, held invalid by a court, the patentee may disclaim it himself if he wants to and in the usual case he will. If he does not disclaim it, nothing happens to the remaining claims.

Mr. ROGERS. If he disclaims as to those that are invalid, he still retains the valid one?

Mr. FEDERICO. Yes.

Mr. ROGERS. That is the present law?

Mr. FEDERICO. Yes. Of course, if a patentee does not disclaim under the present law and under the bill he cannot recover costs in a suit.

Under a later provision in this bill, which is in the present law, too, if a patentee sues on a patent that is invalid and the suit is wholly unjustified, the court could assess him attorneys' fees as well as costs, so there are deterrents to suing on a claim or on a patent that is invalid. The deterrents under the bill are about the same order as under the present law.

In making these comments, I am making them only by the way of explanation of what was the intention in introducing these particular provisions into this bill, rather than arguing for or against any of them.

Referring still to the correction of patents, section 204 is a section for correcting by a certificate a clerical error due to the Patent Office.

Section 205 is a section that is new in the patent law that permits the Patent Office to correct by a certificate a clerical error of the patentee.

Section 206 is a new section in the law that is correlated with section 116 in chapter 2 relating to a mistake in joining a person as a joint inventor. Very often two or three people make an invention together. They must apply as joint inventors. If they make a mistake in determining that the third one is one of the three inventors that actually made the invention, they do so at their peril.

This provision permits a bona fide mistake in joining a person as inventor or in failing to join a person as an inventor to be corrected.

The next group of two sections relates to assignments and ownerships.

Section 212 introduces a change over the present law relating to joint ownership.

The next two sections collect provisions now in the law referring to Government interests in patents without making any significant change except in language.

The next group of sections relates to infringements of patents.

Section 231, paragraph (a), is merely a declaration of what constitutes infringement.

Incidentally, there is no declaration of what constitutes infringement in the present statute. It is actually not really necessary because the granting clause grants exclusive rights and infringement would be any violation of that grant.

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Mr. ROGERS. Just to interrupt you there, do I understand your position to be that, so far as section 231 is concerned, that any rights of infringement of the patent exist under the present law?

Mr. FEDERICO. Section 231 (a), the first paragraph. I was referring to the first paragraph in that statement.

Now, paragraphs (b), (c), and (d) bring up the subject that has been referred to as contributory infringement, on which I understand some other people are going to speak, and I do not think it advisable to go into too much detail at the moment, except to state that paragraph (c) which is the key section, was devised by the groups working on it as an attempt to state in statutory form the theory of what has been called contributory infringement of patents in a manner which, looked at from certain points of view, might be considered restrictive of what has been held in the past and looked at from some other points of view might be considered broader.

Mr. ROGERS. What is the present status of the contributory infringement? Is that based upon statutes, or a court decision?

Mr. FEDERICO. It is entirely on court decisions in suits on infringement of patents.

Mr. ROGERS. Then this part that is added here in 231 (c) is something new, so far as——

Mr. FEDERICO. As being stated in the statutes is concerned, yes.

Mr. ROGERS. Do you consider that the section (c), to which you referred, will change the decisions that have been announced by the Supreme Court, or is this just an attempt to say what these decisions have heretofore held?

Mr. FEDERICO. There has been so much argument about what the Supreme Court decisions do mean that I am afraid I cannot answer that question.

If a person takes the position that the decisions mean a certain thing, then it could be said these do not do very much. But it is very easy to take another position, that the decisions mean something quite different; in which event the section would do something.

Mr. ROGERS. Would anybody's rights be affected in any manner if we eliminated this section 231 (c) and (d) altogether?

I will put it this way: if the Court eventually is to pass upon it, do you know of any necessity why the Congress of the United States should determine what an infringer is, whether he is a contributor, or what?

Mr. FEDERICO. Speaking personally, my view would be that the only necessity is a desire to have clarity in the law.

Mr. ROGERS. Do you not know that lawyers have existed for many years upon disputes, and we have never been able to get anybody that could write a law that applied to all situations?

Do you think that this would clarify it in any manner if it was enacted, that is, the definitions as set forth here and of what constitutes a contributory infringement?

Does this clarify it in any manner so that it may be a guide to the lawyers in the future?

Mr. FEDERICO. Yes.

Well, it would clarify it to this extent: That having a written formula in the statute, you have a guidepost which would settle or determine the way the development of the law would be after that would be passed.

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Without a guidepost, there would be a lot of floundering. Eventually there might be something stable.

Mr. ROGERS. Do you think that this, as written here in 231, is the guidepost or the interpretation that some have placed upon decisions that have been rendered by the Supreme Court dealing with contributory infringement?

Mr. FEDERICO. I think it represents what a large body thinks is an interpretation of a large number of decisions in the past.

Mr. ROGERS. Would it necessarily follow that if we did include it in this bill, that the argument would be that Congress has at least accepted the interpretation that certain individuals have placed upon these decisions, as to what constitutes contributory infringement, and say that Congress is satisfied to interpret those decisions in this manner?

Mr. FEDERICO. I think it would. I think it would be picking a path.

Mr. ROGERS. And in that manner clarify an issue that lawyers are unable to give the clients proper advice upon when the question of contributory infringement is brought up?

Mr. FEDERICO. Yes. I think it would do a great deal to that extent.

Mr. BRYSON. Although the Supreme Court, of course, would follow its precedent by exercising its right to have the last guess, the last say-so.

Mr. FEDERICO. Section 232 is a new section in the law relating to infringements, but it is of relatively little importance and it follows a paragraph in a treaty that the United States adhered to.

Mr. BRYSON. Mr. Federico, may I ask you to go back to section 212 for the moment. Would you care to comment on that as to whether or not it should remain as is, or in conformity with the ideas expressed by the National Advisory Committee on Aeronautics?

Are you familiar with their views on the subject?

Mr. FEDERICO. I have not seen them; no, sir.

Well, I will state what 212 does in a problem concerning it.

Under the present law, which is by decisions and not by expression in the statute, if two persons own a patent jointly, either one can do what he pleases in respect to making and using the invention for his own profit and granting licenses to others and selling his share, or any part of his share, without regard to the other one.

That is stated generally.

Under the provision here, the two owners could still each manufacture the invention for their own profit, but if one granted licenses or sold his interest to others, he would have to account to the other owner, or get his consent.

Now, some problems have arisen in that change, and I think there are quite a few suggestions that have come to the committee to not make the change at the present moment. There is an advantage in having the change, but some problems have been mentioned in connection with doing it in the form here stated.

Mr. BRYSON. We have the several views as expressed by these agencies.

The Federal Security Agency inquires as to the effect or desirability of adding this clause onto the end of the suggested section 212:

> And any owner may grant license or assign his interest or any part thereof without the consent of the other owner, provided that he may account to them for their proportionate shares in the event he receives any remuneration therefor.

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Is not that in substance about what you said?

Mr. FEDERICO. That is in substance what the section says, and that suggestion becomes one of language and clarity, to me.

Mr. BRYSON. When we go into marking up the bill, we will have these several suggestions before us and we will, of course, try to work out the best language possible.

Mr. CRUMPACKER. While we are in this part of the bill, I would like to get back to the section 221.

I asked the witness a while ago about these fees in the Patent Office, and he said he did not know.

Can you tell me, Mr. Federico? Are the fees designed primarily to reimburse the patent office for its expenses of operation, or what is the basis for fees?

Mr. FEDERICO. In actual practice the fees received by the Patent Office for various services provided for, for which a fee is provided, bring in about 55 to 60 percent of the amount of expenditures of the Patent Office.

So that in practice the fees do not cover the expenses of operation.

Mr. CRUMPACKER. Do you have any idea, in round figures, what percentage of the total business of the Patent Office might come under this particular section?

Mr. FEDERICO. This section provides that when the other Government departments are handling a case for an invention of a Government employee, they do not pay the fees which are $30 on filing and $30 on granting of the patent.

The number applied for and granted under that section varies considerable.

During the war years, it was higher than before or after.

In addition to that, the Patent Office does a lot of other things for Government departments without fees, for which it would charge a fee to a private individual.

I would say, merely guessing at the moment, that the total services that the Patent Office does for other departments, including this item as well as other items, might well run to about $100,000 a year.

Mr. CRUMPACKER. What are your total expenses in a year's time?

Mr. FEDERICO. The total expenses of the Patent Office?

Mr. CRUMPACKER. By $100,000, are you referring to the fees that are not collected or——

Mr. FEDERICO. Just fees that are not collected from other departments of the Government.

Mr. CRUMPACKER. What are your total fees, then? Do you know that offhand?

Mr. FEDERICO. The total fees collected in a year would be, say, $6 million a year for this purpose. It is roughly around there.

Mr. CRUMPACKER. Are these fees fixed by statute?

Mr. FEDERICO. All fees are fixed by statute—they are in an earlier section of the bill—except a variety of small items that are fixed by the Department under authority contained in various statutes on fixing fees for services.

Mr. CRUMPACKER. This particular bill does not make any change in them, does it—or does it?

Mr. FEDERICO. This particular bill readjusts two fees in a minor manner, makes a change in one fee, and, other than that, leaves the system of fees alone.

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Mr. CRUMPACKER. How long has it been since there has been any substantial change in the fee system?

Mr. FEDERICO. The basic fees for obtaining a patent were changed to what they are now about 20 years ago.

Mr. CRUMPACKER. That is all.

Mr. FEDERICO. I will take up the next group of sections now.

Mr. ROGERS. May I interrupt you?

You had reference there to section 241; is that right?

Mr. FEDERICO. Yes.

Mr. ROGERS. Could I interrupt you to go back again to section 231?

While we appreciate any opinions or statements that you are giving us, it more or less is to help the committee and is in no manner binding, so far as the Department or the Patent Office is concerned. You are appearing here to assist us in any manner possible.

You were present at the time that the Department of Justice expressed their displeasure to section 231, pointing out that it may interfere with the antitrust laws.

Have you made any particular study of that, or do you know how that may affect it in any manner whatsoever?

Mr. FEDERICO. I would like to ask not to speak on that point at the moment. I do understand that several witnesses are going to comment on that.

Mr. ROGERS. I appreciate your position, and thank you.

Mr. FEDERICO. Beginning with 241 are a group of sections relating to remedy for infringement of a patent, the suit in the courts. The present statutes on this matter are in quite a mess because they were written quite some time ago and court procedure and the names of actions, and so on, have changed considerably since then.

So the present sections were substantially reorganized into a group of sections fitting in at this place, with some slight changes.

The beginning section is a declaration which serves as a preliminary to the others.

Section 242 introduces a declaration of the presumption of validity of a patent, which is now a rule made by courts in decisions, but has had no expression in the statute.

The defenses to an action for infringement are stated in general terms, changing the language in the present statute, but not changing the substance materially.

The next section relates to injunctions and the next to damages, the next to attorney fees, the statute of limitations, and to marking and notice; all of which together replace present statutes on suits, with a good deal of reorganization in language to attempt to clarify the statement of the statutes.

Mr. CRUMPACKER. May I interrupt again at this point?

Mr. FEDERICO. Yes.

Mr. CRUMPACKER. On attorney fees, it says the court in exceptional cases may award reasonable attorney fees. Does not that open the door to all kinds of interpretations as to what is meant by the language, or is there already a body of law as to what "exceptional cases" are intended?

Mr. FEDERICO. The present statute says the court may award reasonable attorney fees to the prevailing party; which was introduced into the law by an act of 1946.

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The hearings and the reports of the committees showed that they intended that to apply to exceptional cases without going into detail, and the court decisions have followed that principle of awarding attorney fees in exceptional cases.

What that constitutes is left, and stays left, to the discretion of the court that is conducting the case.

Mr. CRUMPACKER. Should not there be some kind of an expression of the particular areas that they intended to apply to? I never saw any statutory language as unclear to the uninitiated as that would be. It may mean something to an experienced patent lawyer, but just to look at that——

Mr. FEDERICO. That provision, as I said, came into the statute in 1946. There have been a number of rulings on it. In some cases the courts have denied attoney fees and in others, they have allowed them.

Mr. CRUMPACKER. You say the 1946 statute just said that the court in its discretion may award reasonable attorney fees; is that right?

Mr. FEDERICO. Yes.

Mr. CRUMPACKER. But this term "exceptional cases" is introduced for the first time here, is it not?

Mr. FEDERICO. Yes. It was picked up from the reports in passing that first law, which indicated that that was what was meant, and the decisions of the courts that have followed that.

Mr. CRUMPACKER. That is all.

Mr. BRYSON. Proceed, Mr. Federico.

Mr. FEDERICO. Section 248 is the other companion section to the disclaimer point that I mentioned before.

Sections 249 and 250 involve merely changes in language.

Section 251 is a criminal statute relating to falsely marking an article as being patented when it is not patented; which is now in the present law.

But this section revises it and makes a few changes as to the fine for false marking and a few other things, and also makes it an ordinary criminal action as well as an informer action that is in the present statute.

Section 252 is a new section that is needed to obtain jurisdiction over foreign patent owners, those that do not reside in the United States. That is necessary on some occasions.

Mr. BRYSON. That has been discussed by a previous witness.

Mr. FEDERICO. Yes.

Chapter 4 is the chapter that collects the provisions relating to plant patents and to design patents.

In the group of sections relating to plants, there is no change in the present law except in section 303, relating to the nature of the right granted by a plant patent.

The wording here is that the plant patent grants to the patentee the right to exclude others from reproducing the plant and selling the plant so reproduced.

Under the present law, there is some ambiguity in interpretation, and this section settles what the interpretation should be in the manner indicated.

The next groups of sections relates to design patents.

The only effort in this group was to state the present statute.

In the committee's preliminary print that introduced this codification the statement was made that the subject of design patents was

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reserved for later consideration, and the present code merely puts it in its place without attempting to make any changes in the statute.

Following that are a few miscellaneous provisions with a table of statutes repealed, and that concludes the description of the bill.

Mr. BRYSON. Thank you, Mr. Federico.

We have one other witness, the President of the New York Patent Law Association, Mr. Neave.

## STATEMENT OF ALEXANDER C. NEAVE, PRESIDENT, NEW YORK PATENT LAW ASSOCIATION, NEW YORK CITY

Mr. NEAVE. I am Alexander C. Neave, of New York City. I am here on behalf of the New York Patent Law Association, Mr. Chairman.

Our committee has written your committee a letter, Mr. Chairman.

Mr. BRYSON. We have your letter. Would you like to read it, or would you like to have it submitted for the record and make comments on it?

Mr. NEAVE. May I have it submitted for the record? I do not think it necessary for me to read it.

Mr. BRYSON. All right.

(The letter referred to follows:)

THE NEW YORK PATENT LAW ASSOCIATION,
*June 8, 1951.*

Re Bryson, H. R. 3760, Codification of the patent laws

HON JOSEPH R. BRYSON,
*Chairman, Subcommittee No. 3, Committee on the Judiciary,*
*House of Representatives, Washington, D C.*

DEAR SIR: The committee on patent law and practice of this association, after making a thorough study of the Bryson H.R. 3760, and of its predecessor in the Eighty-first Congress, H. R. 9133, reached the following conclusion in regard to bill H.R. 3760:

"The committee highly recommends the adoption of this bill by Congress as soon as possible. Certainly no patent legislation of recent years has been given as much study and careful thought as has this bill. It is our opinion that the bill not only clarifies the existing law but also, in those instances in which it revises that law, achieves a proper balance between the protection of the public from extension of monopoly rights and the encouragement to inventors to make and disclose their inventions so that 'the progress of science and useful arts' will be promoted in accordance with the provision of the Constitution."

This committee also concluded that the bill would be improved if a few changes were made. These and other proposed changes were discussed and voted upon at a meeting of the coordinating committee appointed by the National Council of Patent Law Associations That committee has made certain recommendations which, in the opinion of our committee, would materially improve this proposed legislation. Since we understand that these changes will be submitted to you, we will not burden the record by including them in this letter We wish to emphasize, however, that we are in entire agreement with the coordinating committee that these changes should be made.

On May 24, 1951, the governors of the New York Patent Law Association passed the following resolution:

"*Resolved*, That the president of the New York Patent Law Association, acting on behalf of its board of governors, is authorized to endorse and to testfy in support of the Bryson bill H. R. 3760; he is also similarly authorized to endorse and support the recommendations. finally made by the coordinating committee as valuable suggestions for improvement in the bill which should be included in it if possible."

Sincerely yours,

ALEXANDER C. NEAVE, *President.*

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Mr. NEAVE. Mr. Ashton has read to your committee a resolution favoring the bill in question.

The letter also contains an extract from our patent law committee's report on the bill. A great deal of study over a period of 2 years was given the bill by our committee.

There is one additional matter which is not contained in our letter to your committee that I would like to mention, since the matter has been brought up by Captain Robillard.

The committee of our association which considered the bill believed that it would be advisable to have included in the bill a section of a character which Captain Robillard referred to, with respect to publication of applications. That suggestion was specifically made to the coordinating committee and was discussed in their meetings, in several of their meetings.

The committee, as a whole, voted against such a provision, and in interest of not having a talent for disagreement, we thought we would not press the matter.

We believe, however, that since the Navy has made the suggestion, it might be helpful to your committee to have some specific language with respect to that matter.

Of course, I have no idea whether the Navy would approve of the language, because Captain Robillard has not seen that.

The language which we are suggesting—and conceivably it might be a separate section, section 123—is as follows:

> Pending applications for patents may be printed and published by the Commissioner, at the request and at the expense of the owner or applicant if he be the owner. Such publication shall have the effect as an issued patent for the purposes of section 102 (a) of this title.

The only other matter that I would like to mention is to comment upon the statement by Mr. Lanham that there are in the bill a number of controversial sections.

Our association does not feel that is so.

In that connection, I would like to call the attention of the committee to the fact that the Department of Justice's report on the bill contains only eight suggestions or criticisms. I would say criticisms of eight paragraphs.

When you consider that the Antitrust Division has had quite a talent for criticizing patents, I think that is a real accomplishment.

I also feel, although I have not had much time to study the criticisms that the Department of Justice has made—that practically all of the criticisms are of such a character that they can be taken care of upon further consideration.

I believe that many of them are perhaps justified if the bill is understood. It may be that the bill is not sufficiently clear.

As to such remaining criticisms as they have, I think it is entirely a matter of whether the Antitrust Division's policies with respect to patents, which became fairly sharp at the time Mr. Arnold came into the Department, should be followed, or whether it is this committee that should recommend and urge the legislation that should be passed.

I feel that the work that has been done by the Department of Justice on this bill and the comments that they have made to it show that the bill is an excellent bill, and we recommend it very highly to your committee.

Mr. BRYSON. Thank you very much.

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Mr. ROGERS. May I ask this: You state that, in your opinion, there are not enough controversial things in this recodification that would justify our not going ahead with the codification and that there are, as pointed out by Mr. Lanham, possibilities; that is, he points out possibilities, and it has been directed to our attention perhaps this contributory infringement is one controversial point.

Do you feel that the section here, 231, as it is now written, actually states what the decisions of the courts have announced within recent years?

Mr. NEAVE. My difficulty in answering that Mr. Rogers, is rather the same difficulty Mr. Federico had. The law is in a considerable state of confusion on that point. I prefer not to go into it because it is going to be gone into tomorrow, I believe, by somebody who is more capable of doing it than I am.

On the other hand, I do very much feel that where the law is in a very confused situation, it is up to the Congress to clarify it.

Mr. ROGERS. Do you think that this clarificaton is sufficient in words as placed in the section 231 to properly advise the legal profession and the manufacturers as to when and where they may be likely to become contrbutors to a patent infringement?

Mr. NEAVE. As to that, I think that this will very much help the lawyers in straightening the matter out. It does not go the whole way, but it is better than nothing, and it will help us in knowing what the law is, insofar as it goes.

Mr. ROGERS. The main objective so far, of the legal profession, as I understand it, is to have it clarified.

Mr. NEAVE. That is right, sir.

Mr. ROGER. It is not so much as to which way it may go as to how far a man must act before he becomes a contributor to an infringement.

Mr. NEAVE. That is always a matter depending upon the facts themselves.

Mr. ROGERS. That is all.

Mr. BRYSON. Mr. Crumpacker, do you have any questions of Mr. Neave?

Mr. CRUMPACKER. No questions.

Mr. BRYSON. I believe that is all.

Thank you, sir.

Mr. NEAVE. Thank you, Mr. Chairman.

Mr. BRYSON. We will meet in the morning at 10 o'clock, gentlemen.

(Thereupon, at 4:10 p.m., the hearing recessed, to reconvene at 10 a.m., Friday, June 15, 1951.)

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# PATENT LAW CODIFICATION AND REVISION

FRIDAY, JUNE 15, 1951

HOUSE OF REPRESENTATIVES,
SUBCOMMITTEE NO. 3 OF THE COMMITTEE ON THE JUDICIARY,
*Washington, D. C.*

The subcomittee met at 10 a. m., Hon. Joseph R. Bryson (subcommittee chairman) presiding.

Mr. BRYSON. Gentlemen, the committee will come to order. We want to make as much time as possible today, due to the fact that some of the gentlemen have come a great distance.

Mr. Mosier, counsel for Glen Martin Co.; did you want to be heard?

## STATEMENT OF HAROLD MOSIER, REPRESENTING PATENT COMMITTEE, AIRCRAFT INDUSTRY ASSOCIATION

Mr. MOSIER. Mr. Chairman, my name is Harold Mosier. On behalf of the patent committee of the Aircraft Industry Association I ask leave to file with the committee a short statement for the record on this matter. I have already given copies to the clerk.

Mr. BRYSON. You are familiar with and have read the bill, have you?

Mr. MOSIER. I am not a patent lawyer, and I am afraid I do not know much about the bill, but I am told by our people that this statement approves the bill.

Mr. BRYSON. And you have already submitted a statement?

Mr. MOSIER. Yes, I have.

(The statement referred to is as follows:)

STATEMENT OF AIRCRAFT INDUSTRIES ASSOCIATION OF AMERICA, INC., WASHINGTON, D. C., RE H. R. 3760

The aircraft industry is a manufacturing industry but it is also a contracting industry. It produces highly technical products by virtue of continuous research and development which is based upon the changing needs of its customers, both Government and commercial. This industry fluctuates considerably in its size and relationship to other industries. During peacetime it does not rank among the larger industries and the industry as a whole is composed of many small units.

A committee of representatives of manufacturers of aircraft and aircraft components has reviewed H. R. 3760 and also all of the previous drafts. It is believed that the following suggested changes will strengthen existing laws and will result in indirect savings to Government and to industry.

Section 100 Definitions:

Delete: (b) The term "process" includes method, and a new use of a known process, machine manufacture, composition of matter or material.

Comment: The definition of section 100(b) is too broad. It was obviously intended to merely cover new use of chemical compound without alteration or



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change in the compound. As it appears in the bill, it would cover any new use of any old material or machine and this is a question that should be left to the Court, as in the past, as to whether such use amounts to invention

Section 101. Inventions patentable Add the following paragraph:

"When an application for patent includes a machine and a process performed by the machine, even though the machine can perform no other process, and the process cannot be performed by any other machine or by hand, claims to the process and claims to the machine for performing the process may be present in the same application and the subsequently issued single patent."

Comment The addition of this paragraph will permit uniformity of procedure among the seventy examining divisions of the United States Patent Office. An applicant is frequently confronted with the requirement to file separate application for invention merely because his original application contains claims to the invention expressed in the form of "process" or "method" and in the form of "description" of the article or machine for carrying out the new process or method. The practice in the Patent Office is not uniform and some examiners seem to have the mistaken idea that it is improper to present claim to the method and apparatus in the same application even though only one invention is present or if only one invention is present, they contend that the applicant is not entitled to both forms of claim in expressing the invention. The proposed paragraph will sanction the inclusion of methods and apparatus claims to an invention in a single application.

Section 102.—Conditions for patentability; novelty and loss of right to patent: Revise paragraphs (a) and (b) to insert the language in italics:

(a) the invention was *publicly* known or *publicly* used by others in this country, or patented or described in any printed publication in this or any foreign country, *which publication was available in this country* before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in any printed publication in this or any foreign country *which publication was available in this country* or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

Comments. Many publications foreign to the United States are not available to the American inventors because the publications have not been exported out of the countries of origin. An example of this is Germany in times of war and Russia, both during times of war and peace. Therefore, the American inventors should not be penalized or bound by the text of the publications which are not and never have been available in this country. The American patent system is intended to encourage new development by making information on the patented invention available to the public to add to the common fund of technical knowledge. The American inventor should only be charged with *public* knowledge and *public* use by others in establishing his rights to a United States patent. Likewise, he should only be charged with knowledge of printed publications in foreign countries which are available in this country.

Section 103. Conditions for patentability, nonobvious subject matter: Revise this paragraph to insert the language in italics and to delete the stricken language:

A patent may not be [obtained though] *refused or declared invalid when* the invention is not identically disclosed or described in the prior art set forth in section 102 of this title, if the differences between the subject matter sought to be patented and that prior art are such that the subject matter as a whole [would have been obvious] *involved more than the ordinary skill of the art* at the time the invention was made [to a person having ordinary skill in the art to which said subject matter pertains.] Patentability shall not be negatived by the manner in which the invention was made.

Comments: The revision in language herein proposed is intended for clarification. These conditions for patentability, since they relate to "a patent" must apply to the obtention or refusal of a patent by the Patent Office or the considerations of a judicial tribunal on validity or invalidity. The conditions should be the same in either case. The second change rearranges the thoughts expressed to qualify what "would have been obvious" is intended to mean.

Section 112. Specification: In the fifth line of the first paragraph substitute "preferred" for "best".

Comments: An applicant indicates in his specification at the time of filing his application what he then considers the "preferred" mode for carrying out his invention to be but it may be very difficult for him to determine at this early date that it is the "best" mode, and a mistaken judgment at the time of filing

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as to the "best" mode has been found very troublesome in enforcing the rights granted under the patent, and also in some situations in foreign filing based upon the application filed in the United States.

Section 117. Death or incapacity of inventor: Revise the paragraph to read as follows:

"The Commissioner may receive applications [of] *from, transact all business with,* and issue patents to legal representatives of deceased inventors and those under legal incapacity, upon compliance with the requirements and on the same terms and conditions applicable to the inventor."

Comments: The amendment suggested under this section is required to enable the legal representative of an insane or decedent inventor to act fully in such capacity as, for example, carrying out the procedure outlined in section 206.

Section 122. Confidential status of applications: Add a paragraph as follows:

"Pending applications for patents may be printed and published by the Commissioner, at the request and at the expense of the applicant or owner Such publication shall have the same effect as an issued patent for the purposes of section 102 (e) of this title."

Comments: This expedient should be available to enable an applicant to dedicate his application and any invention therein contained to the public at any time by publication.

Section 135. Interferences: Revise the second sentence to insert the words "and ancillary proceedings, including motions," after "the question of priority of invention"

Comments: Under the present practice the primary examiner hears motions in the interference procedure which he has set up between the parties who have patent applications before him for the same or similar subject matter. If the interference has been set up in error between the parties for any one of several reasons, e.g., the counts may not read upon the disclosures, the primary examiner who made this error, sitting as a hearing examiner in ancillary interference proceedings, is in effect, reviewing his own previous decision and passing upon his own error. The proposed amendment requires that such review be before the Board of Interference Examiners to ensure that a review of a question ancillary to priority of invention shall be heard by the same tribunal responsible for deciding the primary question. It may be argued that such "ancillary proceedings, including motions," is decided adversely by the primary examiner under the present practice, can be reviewed at final hearing. It should then be pointed out that this is not an adequate answer because the parties to such an interference are put to a tremendous unnecessary expenditure of time and money continuing the interference after the erroneous decision by the primary examiner in order to get his case to final hearing to obtain such a review Many interferences to which inventors are subjected by the Patent Office and the years of delay that result from his application being involved in an interference could be avoided if a prompt judicial review could be had of the motions at an early stage in the interference. The Patent Office would save in time and money because the Board of Interference Examiners could hear and determine interferences at a stage when they are very simple and the issues clear rather than at the final hearing stage where the record is voluminous and must be read and the issues throughly confused by such voluminous records and testimony.

Motions have been heard and decided in the past by interference examiners prior to the present practice. Experience shows that the Board of Interference Examiners is the proper place for such hearings.

Section 203. Disclaimer: Delete the stricken words from the second paragraph as follows:

"In like manner any patentee [or applicant] may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted [or to be granted.]

Comment: The second paragraph can only apply to a "patentee" and to a "patent". The amendment is, therefore, required as it is obvious that a patent "to be granted" has no certain "term" or in other words, the term cannot be determined at that time.

Section 211. Ownership; assignment: Add a new fifth paragraph as follows:

"The assignor of a patent shall not be permitted to deny or contest, directly or indirectly, the validity of such patent; and a licensee under a patent shall not be permitted to deny or contest, directly or indirectly, the validity of such patent for the duration of such license."

Comment: The purpose of the above proposed addition is to nullify the effect of the decisions of the United States Supreme Court in the following cases:

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*Scott Paper Co.* v. *Marcalus Manufacturing Co.* et al, 326 U. S.—66th Sup. Ct —90 L. Ed. 67 U. S. PQ 193, and *McGregor* v. *Westinghouse Electric and Manufacturing Co.*, U. S. 67th Sup Ct.—91 L. Ed. 72 U. S. PQ 21.

In the first of these cases, the Supreme Court permitted Marcalus the patentee assignor, to deny the validity of his *own* patent when sued by Scott as assignee for infringement of the assigned patent. Thereby this decision upset the doctrine of estoppel which had been in effect in the case law for many years and probably has opened the door to the possibility of fraud in dealings between the assignor and assignee of a patent. In the McGregor case, the Supreme Court permitted the Westinghouse Company, McGregor licensee, to assert and contest the validity of the patent *under which it held a license* during the term and life of that license, thereby vitiating and nullifying another doctrine of estoppel that has been part of the case law for many, many years.

Section 212, Joint owners: Revise the paragraph as indicated:

In the absence of any agreement to the contrary, each of the joint owners of a patent may make, use or sell the patented invention *or may grant licenses or assign his interest* without the consent of and without accounting to the other owners. [but neither of the owners may grant licenses or assign his interest, or any part thereof, without the consent of the other owners or without accounting to them.]

Comment: The revisions in this paragraph are required to resolve the difficulties often encountered in ownership of a patent where one of the joint owners is absent, missing, or hostile to the other joint owner or owners.

Section 231. Infringement of patent.

Delete paragraph (b) as follows:

(b) Whoever actively induces infringement of a patent shall be liable as an infringer.

Comment: (b) Subsection (b) is too broad in its scope and too vague to be administered properly without doing an injustice. For example, no one can tell what "actively induces" means or how much or how little may be done in the regular course of business without fear of being accused of "actively inducing" infringement. The remainder of the subsections of this section seems to be sufficient to re-establish the doctrine of contributory infringement.

Section 242. Presumption of validity; defenses: In the first line of the paragraph under sub-paragraph (4) correct the typographical error "of" to "or" and from the sixth and seventh lines of that paragraph, delete "or, except in actions in the United States Court of Claims"

Comment: There is no reason to except actions in the Court of Claims from this requirement that the party give notice of the patents or publications that will be relied upon in the trial. It is more important that this be doue in the Court of Claims than in some trial in the Federal Court because in the Court of Claims some patents receive their sole adjudication.

## STATEMENT OF JAMES E. ARCHER

Mr. BRYSON. The first witness on our official calendar today is Mr. James E. Archer.

Mr. ARCHER. Mr. Chairman, from the committee of the Connecticut Patent Law Association, I merely want to say that we passed a resolution which gave Mr. Ashton authority to speak for the association, and since he has carried out that authority and has already said so much and so well I think I need not add any more to his statement.

I was asked by our association to be here and to make known our support of this bill.

Mr. BRYSON. Thank you very much.

Mr. ARCHER. Thank you.

## STATEMENT OF I. J. FELLNER, MANAGER, PATENT DEPARTMENT, DR. SALSBURY'S LABORATORIES, CHARLES CITY, IOWA

Mr. BRYSON. Our next witness is Mr. Fellner, of Charles City. Will you please identify yourself?

Mr. FELLNER. My name is I. J. Fellner, manager of the patent department of the Salsbury's Laboratories, Charles City, Iowa.

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Mr. BRYSON. Do you have a prepared statement?

Mr. FELLNER. No, sir, I have not. I just want to make a few comments. Would you permit me to talk on sections 101 and 103?

Mr. BRYSON. Very well.

Mr. FELLNER. Of course, these comments are comments rather in the way of suggestions for improvement than criticism, and I just want to point out to you the difference between the old language in H. R. 9133 and the new version in H. R. 3760.

As far as section 101 is concerned the language in H. R. 3760 reads as follows: "Whoever invents or discovers any new and useful process, machine, manufacture or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor," and so forth.

That is the wording in the new proposed bill.

Now in the old bill, H. R. 9133, there was the additional qualification as to what inventions are:

> An invention in the nature of a discovery as embodied in a new and useful art, machine, manufacture or composition of matter, or new and useful improvements thereof may be patented.

I feel that the deletion of this paragraph in the old version might give rise to certain implications, namely, that the invention in any event must be in the nature of some kind of mechanical structure, but that the discovery, for instance, of a new principle of nature which can be embodied in some useful art, machine, or composition of matter that such discovery might not be patentable.

To illustrate the case I would like to point to an opinion which was recently rendered by the Supreme Court of the United States in *Funk Brothers Seed Company* v. *Kalo Inoculant Company*. This was a case in which the inventor had found or discovered that among six different species of mutually inhibitive bacteria there are certain strains in each species which can be mixed selectively without harmful effects on each other for the purpose of fixing nitrogen in certain leguminous plants. This was a very important discovery, for the simple reason that it permitted the agriculturist, or the farmer to buy one single package of these various strains and use it for different crops, such as alfalfa crops and soybeans, and to store inoculants in large packages. Before that invention was made he had to buy a special package for each and every one of his crops and if he kept the different inoculants in one package they would not preserve their usefulness very long.

It presented a great problem to the farmer as to how to get the right and compatible mixture for the purpose of enhancing the development of the crop.

The discovery in that particular case was that there is such a thing as a specific strain in each bacterial species, within the six different possibilities which is not subject to mutual inhibition.

The Supreme Court pointed out that this invention was simply a discovery of a law of nature which cannot be patented, and which is not patentable subject matter in accordance with the statute.

However, the statute actually reads:

> Any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter may receive a patent—

and the controversial question was: Was this a patentable new or useful composition of matter? The Supreme Court of the United

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States thought it was not a patentable invention. I therefore prefer the text in the previous version of H. R. 9133 stating that an invention in the nature of the discovery which is embodied in a new and useful art or composition of matter may be patented. This language would make it clear that if the heart of the invention lies in the discovery of a principle or law of nature, such a discovery might be patentable if it can be embodied in a new and useful application.

Now it is for this reason that I felt that it would be very useful for avoiding ambiguity to have the previous section 2 of H. R. 9133 reincorporated into the proposed legislative text, so that it be made clear what we understand by invention, and have it specifically understood that where a discovery has been made which involves a natural principle and is useful and practically applicable, but such application of the newly discovered principle of nature does not in itself call for inventive ingenuity, that it be then likewise recognized that an invention has been made.

The old version, of course, provides suitable language, to clarify that an inventor who made a discovery embodied in a new and useful art or composition of matter, may have a patentable discovery.

If we have that section in the law I do not think that a decision like the one I referred to could ever be rendered. But what would happen if we went along with the decision of the Supreme Court in the Funk Bros. case is that about 90 percent of the patents in the pharmaceutical industry would have to be thrown out.

For instance, in our own laboratories, we have extensive research farms, out in Charles City, Iowa, with tens of thousands of experimental chickens. What we are doing, or what we are trying there to do, is to save the husbandman and the poultry industry millions of dollars by showing these people how to overcome certain infectious conditions, certain contagious diseases in poultry, which cost the industry millions of dollars every year.

First we discover the therapeautic action of certain drugs on the infected birds; we incorporate them, as ingredients into food mixtures, mixing them in the drinking water or feed. These ingredients, which are synthesized in the laboratory, represent new developments. They will help to overcome the afore-mentioned conditions, will eliminate certain kinds of diseases and conquer such diseases as coccidiosis or black head which have wiped out so many flocks of chicks in the past.

Now most of these inventions representing the discovery of new effects in known chemicals would be absolutely nonpatentable, under the Funk brothers decision.

Mr. BRYSON. Are they patentable today?

Mr. FELLNER. They are patentable, but unfortunately we are afraid, I would say, about bringing these patents into court and having them tested for validity and infringement, because we know, that under the quoted decision of the Supreme Court respecting the discovery of a law of nature it is questionable whether such patents would be upheld.

Mr. WILLIS. Is that consistent with the statement just made that they are patentable today?

Mr. FELLNER. They are patentable in the Patent Office, but being patentable in the Patent Office is one thing; and being sustained by the courts is another. Many patents have been granted in the Patent Office, but opinions differ in different courts. For instance, the patent

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I referred to in the Funk brothers versus Kalo case was upheld in the circuit court of appeals. It had been held invalid by the district court and it was invalidated again in the Supreme Court of the United States. This shows the far-going differences of opinion concerning the patents of this type.

Mr. WILLIS. And the point you are advocating would be taken care of under the old bill, the wording of H. R. 9133?

Mr. FELLNER. Yes, sir.

Mr. WILLIS. In the language which is not carried into the new bill. And it is your point that it could be cleared up, and that your difficulty has come about by the omission of the second paragraph of section 101 in H. R. 9133. Let us get down to the specific reasons.

Mr. FELLNER. I would say if we had that section in the previous language, "an invention in the nature of a discovery as embodied in a new and useful art, machine, manufacture or composition of matter may be patented", I believe that would cover it. That would cover the case where an inventor finds in an old compound a new remedy, a new drug, for instance, to combat certain diseases or certain epidemic conditions in flocks or even in human beings.

However if you repeal this section such action might possibly be taken as a reversal of your original position, of the previously defined concept of patentable discovery and it might be read, let us say, as if the committee wanted to exclude inventions of that type which were originally included in the proposed legislative text as if the new and abbreviated version actually repeals that which was accepted by the previous language in H. R. 9133.

I understand, in our new version the term "invention" has been defined as including discoveries under section 100 (A), but I still think that this single sentence, the statement in this definition, might be subject to various interpretations, and I do not believe that it would be as clear as if the original version were used where you said that "an invention in the nature of a discovery as embodied," or if it can be embodied "in a new and useful art, machine, manufacture or composition of matter may be patented."

In other words, the case where the heart of the invention just resides in the discovery, but the practical application thereof suggests itself and does not call for any inventive genius is not conclusively covered. In other words, if the essence of the invention is merely a discovery of a law of nature it would seem from the Supreme Court decision that it might be construed as not being an invention. The invention in the case cited resulted from the discovery that the useful bacterial strains were not mutually inhibitive.

If we can express this concept in the new law, by retaining the previous language, I believe we would be greatly helped by adequate patent protection. When you are engaged in industrial development by inventing hundreds of useful things, when you are carrying on painstaking research in 4 laboratories, you do not intend just to dedicate, so to speak, all of this research to the public right from the beginning so that practically anybody can take a free hold of it.

It is for this reason that I suggest that the previous language in paragraph 101 be reinstated.

Mr. WILLIS. You mean paragraph 101 in H. R. 9133?

Mr. FELLNER. Yes, sir.

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Mr. WILLIS. That is the point I thought you had in mind. I am simply trying to follow you clearly.

Mr. FELLNER. Yes, sir. Now, if I may, I would like to say just a few words in reference to the provisions contained in section 103. Section 103 touches upon——

Mr. CRUMPACKER. Before you go into that may I ask you a question?

Mr. FELLNER. Yes, sir.

Mr. CRUMPACKER. I am afraid I am not quite clear as yet. H. R. 9133 is the act you referred to as the old bill?

Mr. FELLNER. Yes.

Mr. CRUMPACKER. Referring to section 101. You think that the second paragraph which is entirely omitted in the pending bill, would if included give you this protection?

Mr. FELLNER. I think it would give better protection, if I had to interpret the wording.

Mr. CRUMPACKER. In the paragraph of the new bill, the word "art" is omitted. Do you thing including it would help?

Mr. FELLNER. Of course the question of what is art may be very controversial. We do not know how the courts might define it; for instance, it may or may not cover a treatment.

Mr. CRUMPACKER. Then you are not recommending the word "art" be included?

Mr. FELLNER. I would have no comment on that.

Mr. CRUMPACKER. If the second paragraph is included?

Mr. FELLNER. I would have no comment on that. But I certainly would have a comment on the term "composition of matter."

Mr. WILLIS. As I understand it, from the point of view of the industry you represent, their requirements would have been met by the adoption of section 101 of the old bill, H. R. 9133, particularly using the second paragraph beginning with "an invention in the nature of a discovery"?

Mr. FELLNER. Yes, sir.

Mr. WILLIS. You do not consider that the new bill, section 101 of H. R. 3760 with the definition, accomplishes what you have in mind? In other words, is it not simply a question of some condition? Does not the definition preceding section 101, embodied in section 100, carry all the implications you used in the second paragraph of section 101 of H. R. 9133? You see, in H. R. 9133 you did not have the definition contained in section 100 of the new bill. Now with these definitions, would not they supply the purpose of the second paragraph in the old bill? What it was intended to cover?

Mr. FELLNER. I would be inclined to admit that, had we not had the same situation in spite of the present law which also reads "any person who has invented or discovered" as provided in Revised Statutes 4886, 35 U. S. C., 31. And yet we are confronted with the decision on "unpatentable discoveries" in the case of *Funk* v. *Kalo*, rendered by the Supreme Court. That is why we would rather have the clear and specific wording of H. R. 9133 in the law. If the present statute cannot be considered as including inventions of that type, I thought that the provision 101 with the mere definition of the term "invention" to include discovery, might still not cover that type of case.

Mr. WILLIS. Just take a look at section 100 of this bill, the pending bill.

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Mr. BRYSON. Subsection (a).

Mr. WILLIS. Subsection (a) of section 100, which states the term "invention" includes discoveries. Does that answer it?

Mr. FELLNER. Yes, sir, but does not the old law, 4886, say the same thing "any person who has invented or discovered any new and useful art".

Mr. WILLIS. Well I thought you were satisfied with the present law, and that your only objection was that the new bill did not embody, that is, the language in H. R. 9133 was omitted; that was your quarrel with the pending bill?

Mr. FELLNER. I do not want to broaden it; I just want to have it clarified. And I would like to say——

Mr. WILLIS. I think it should be clear.

Mr. FELLNER. I certainly would like to see clarification on the point, where the invention resides in the discovery of a law of nature, or a principle of nature, where such a discovery can be practically employed, where it has some useful application and can be embodied in something like medicine, whether it is an art or a treatment.

Such things, we think, should be patentable. However I have grave doubts whether the new language even used in connection with the definition under section 100 (a) would take care of that, because the definition alone might give rise to differing interpretations. The old section provides a clarifying statement, the old section in H. R. 9133, I mean.

Mr. BRYSON. There is no intention to change the law as it is presently written; the purpose is just to make it clearer.

Mr. FELLNER. I understand that, Mr. Chairman. I merely think that the original wording as set out in H. R. 9133 is very much clearer—I might say, modifies the bare definition in the pending bills by making unequivocal that which might now be merely inferrible.

Mr. WILLIS. You would prefer, or rather advocate an amendment to carry out what you have in mind?

Mr. FELLNER. That is what I am actually trying to do.

Mr. WILLIS. But I do not think that is what this particular bill is intended to accomplish.

Mr. FELLNER. I was suggesting only carrying the language of the old version in H. R. 9133 into the pending bill, for the purpose of clarifying the language, so as not to give rise to judicial differences of opinion in the courts as to what might be considered as patentable discoveries. That question is answered in the old version of H. R. 9133, and by reincorporating that language into the new bill, its adoption would remove controversies on questions of patentable discoveries.

Mr. BRYSON. We will give careful consideration to your suggestion.

Mr. CRUMPACKER. I am still confused as to just what the special language is that you were recommending. In paragraph two, here in the "old bill" as you have referred to it, "an invention in the nature of a discovery" may be patentable. That is your understanding of it?

Mr. FELLNER. That is right.

Mr. CRUMPACKER. The wording in the bill we now have, in section 100 entitled "Definitions", the term "invention" includes discoveries. What is the special distinction there you have in mind?

Mr. FELLNER. The special distinction is that you still might have—you still might say the invention is merely a discovery of a principle or law of nature, and that in addition to this discovery, the actual

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practical embodiment must display inventive ingenuity. That is what I am concerned about. A court may hold again that it is not sufficient to give consideration only to the genius of discovery as the heart of the invention, but may also find it necessary, in accordance with the statute that the actual embodiment or practical application of the discovery calls for inventive ingenuity. And I personally feel that this is not quite justifiable, because the real heart of the invention must be recognized in the discovery of the law of nature.

I also believe that this was the original concept of what is provided for in Revised Statutes 4886. But in order to make that clear and to avoid controversies such as arose in connection with the Supreme Court decision in the case of *Funk Bros.* v. *Kalo Co.*, I believe it to be necessary and advisable to define it clearly that an invention may be patentable if the heart of the invention resides in the discovery of a principle of nature. But under the mere definition, as provided in the pending bill, such an interpretation is only acceptable but not clearly called for.

Mr. CRUMPACKER. It seems to me that, to accomplish the purpose which you seek to accomplish, you will need clearer language than is in either bill, the present law or the pending bill, or the old bill, because all three of them use the same language, with just slightly different arrangement of the words.

Mr. FELLNER. Well, I would say that the second paragraph of section 101 makes things pretty clear by definition. If you say that "an invention in the nature of a discovery as embodied in a new and useful art, machine, manufacture, or composition of matter" may be patented, you are recognizing the fact that in addition to mechanical inventions, in addition to inventions which display structural novelty, a discovery of a principle of nature may likewise be the basis of a patentable invention.

Mr. CRUMPACKER. Does not the language of the pending bill say "whoever discovers any new and useful process, machine, manufacture, or composition of matter" may obtain a patent covering it? I would think that would specifically cover the case you referred to. And, if the Supreme Court has interpreted the words as you indicate, I do not see how including that language in the paragraph would cause them to make a different interpretation.

Mr. FELLNER. I believe that the Supreme Court in that particular case did not interpret it in the way the bill here originally contemplated. If the law had been couched in such language and if such language had been before the Supreme Court, I believe a different decision in *Funk* v. *Kalo* would have been reached, because the Supreme Court under such language would have recognized invention in the evidence of discovery as it was, however, the Court was able to hold that a discovery of a law of nature is not patentable if the practical application thereof is so simple that, as soon as the discovery was made, the practical application suggested itself. In other words, it is not an invention, but just a discovery, and a discovery is not patentable.

But if you go to the point of adding that an invention in the nature of a discovery, embodied in a new and useful art, or composition, that is if you can give a practical embodiment to that particular principle of nature, such as the discovery of the usefulness of a particular drug which under certain conditions you can incorporate in a new and useful

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composition that such an invention can be patented, I believe that would afford adequate protection to the pharmaceutical industry.

Mr. BRYSON. Will you move on to the next paragraph. Our time is running short.

Mr. FELLNER. As far as section 103 is concerned, the old version in H. R. 9133 provided for objective criteria in evaluating the invention in the following language:

> Patentability as to this condition—

referring to the preceeding paragraph—

> shall be determined by the nature of the contribution to the art, and shall not be negatived by the manner in which such contribution may have been accomplished.

I notice that in the new version of H. R. 3760 the words "Patentability as to this condition shall be determined by the nature of the contribution to the art" have been omitted. And, I am asking myself whether this deletion again is to be understood as a mere revision of language or whether the committee thought that the original wording was too broad, and that actually the inventive standards should be set in accordance with, for instance, such type of decisions as those in the Great Atlantic case recently rendered in the Supreme Court.

I question whether the manufacturer is sufficiently protected under the language as formulated in section 103 of the new bill, H. R. 3760, what does it mean that patentability shall not be negatived by the manner in which the invention was made?

I raise this question of interpretation in view of a decision that was rendered by the Supreme Court 2 years ago, wherein it was held that no invention was made where the same was the product of organized research, in other words, organized research such as in a big laboratory, where people are given certain assignments and everybody has a little piece of the job to work on. The Court said that, had the invention been accomplished by a single inventor, it would justify the conclusion that a patentable invention is present. But if it is the product of organized research "We cannot recognize it as such." Now, if this is merely meant by——

Mr. BRYSON. That is what the language of the pending bill seeks to take care of.

Mr. FELLNER. Yes; but the language does not take care of the situation, for instance, where a man has recognized a need of long standing in an industry or in some other field, and has for that problem found a solution which looks to everybody very simple, yet for which the art had been waiting for many years. It took, for instance, 20 or 30 years to bring about the merchandise handler in the Great Atlantic case, which novelty was immediately accepted by the public and saved the people in the self-serve stores a lot of expenses and manpower, and increased the daily cash receipts by 33 percent. This is a meritorious contribution to the art, where the factor of convenience is the significant criterion of invention.

In that particular case, the inventor built a bottomless tray which can be moved back and forth to handle merchandise at the counter of a grocery store. This innovation became a vital necessity. It was readily accepted and everybody considered it a valuable contribution to the art.

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The question now before the committee is, whether it is of the opinion that we should have a positively evaluative criterion for inventions. In other words, shall we say that evidence of invention is recognized in the fact itself that a new device or a new machinery satisfying a need of long standing is presented where the inventor is the first to recognize that need and has found the solution, though it be simple for it, and where the solution was readily accepted by the trade? Is that evidence of invention or not?

I thought the committee was of that opinion when I read the original version in H. R. 9133, where it was specified that "patentability as to this condition shall be determined by the nature of the contribution to the art." In other words, evidence of invention is the readiness with which the novelty has been accepted; it is spelled out by the value which actually resides in the contribution to art. Under this definition we would not have to go into a particular inquiry with regard to the question of inventiveness or what has been called "inventive genius," which terms have been used by various Supreme Court decisions and in various other court opinions.

Now, in the new bill, this positive criterion of evidence of invention has been omitted. Does that mean to repeal that part of the original concept according to which evidence of invention may actually be represented by the value of the thing that has been invented or has been found by the inventor? We thought it did.

Mr. BRYSON. We think not.

Mr. FELLNER. Maybe not?

Mr. BRYSON. We think not. But, of course, we would be glad to evaluate your views.

Mr. FELLNER. Do you think that the sentence in the second paragraph "patentability shall not be negatived by the manner in which such invention was made" broadens, so to speak, the concept of invention so as to include the positive criteria as found in the original bill.

Mr. BRYSON. I do.

Mr. FELLNER. We thought that by the deletion of this criterion from the old bill, H. R. 9133, we would just find ourselves in the same situation as before, in that the term "invention" remain unspecified, or relatively unspecified, and that it would continue to be subject to judicial interpretation. That is why we thought it would be very valuable to have this clarifying language in the law so that it would say what is patentable and what is not.

Mr. BRYSON. Of course, the report accompanying the bill will elaborate on your views and the other views that may be expressed on these matters.

Mr. FELLNER. Thank you, Mr. Chairman.

Mr. BRYSON. We will call next Mr. G. Wright Arnold. Do you have a prepared statement, Mr. Arnold. First, I think you should identify yourself for the record.

## STATEMENT OF G. WRIGHT ARNOLD, SEATTLE, WASH.

Mr. ARNOLD. Mr. Chairman, my name is G. Wright Arnold, senior member, Arnold & Mathis, 1612 Smith Tower, Seattle, Wash., lawyers specializing in the practice of patent and trade-mark causes, member of the following organizations:

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American Bar Association; patent section of the American Bar Association; American Patent Law Association; board of managers of American Patent Law Association; Washington State and Seattle Bar Associations, and president of Seattle Patent Law Association; graduate, Harvard Law School, 1913; worked in the office of Patent-Law Instructor Odin Roberts, son of George Litch Roberts, one of the defendants of Alexander Graham Bell patents and author of Patentability and Patent Interpretation, which was the result of some 25 years of careful analysis of Supreme Court decisions before writ of certiorari was required.

Mr. BRYSON. You have just come in from the West?

Mr. ARNOLD. 3:30 this morning.

Mr. BRYSON. We are pleased to have you. Do you wish to read your statement, or would you like to submit it and make comments on it?

Mr. ARNOLD. I think that in part I will read it, and in part I will use it as a background for the points I want to make; so, I will not miss any of them.

Mr. BRYSON. Very well. We want you to take the time that you require, but of course, we are pressed for time.

Mr. ARNOLD. Yes.

Mr. BRYSON. You may proceed, as you wish.

Mr. ARNOLD. First, I want to say this, gentlemen: that I am here with the firm conviction that this section 103 that I am referring to is one of the most important sections of the patent law, in the present bill you are considering.

Mr. BRYSON. It is a very short section, but you say very important.

Mr. ARNOLD. It is very important, I believe. It will be noted that we have here and we are dealing with the question of patentability.

We have in section 101 the language "Whoever invents or discovers any new or useful process, machine, manufacture," and so on. As has been said, down through the times one of the great troubles has been to determine what is "new." Just because we have a device never found in this particular form does not mean that it is new in the patentable sense.

The testimony is directed to the importance of adding to section 103 the following clause:

**Whenever there is established a new functional relationship between any of the factors which are required for rendering an invention in the industrial art practically operative, patentable novelty shall be found.**

That is the clause I seek to have added to section 103. We seek to have an objective approach, which was approved by the Patent Planning Commission of which Mr. Kettering was Chairman, as found in its report in 1943, paragraph 14.

The test proposed by section 103 turns upon a question of whether or not the invention of the applicant is "obvious" in view of the state of the art or whether it is not obvious. Such test is definitely subjective; what is obvious to one person is not obvious to another. The objective test overcomes this difficulty and provides a degree of definiteness entirely lacking in the subjective test.

The witness seeks to add the above paragraph to the section. Thus, those who desire to follow the so-called "obvious" test will still have such test as a part of the law and those who wish to apply the objective test will likewise have the same as a part of the law. That is,

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those who bring their inventions into the objective test will have that further protection, I submit; and, if there are those who wish to apply the subjective test, they may do so.

It will be understood that many of the examiners in the Patent Office at the present time are following the objective test. Thus, by adding the above clause to section 103 we have true codification of present practice so far as the Patent Office is concerned.

We positively need the objective test for protection of valid patents in the adjudication of patent causes by the courts.

As a summary statement, therefore, witness contends that section 103 should be amended by simply adding the sentence:

Whenever there is established a new functional relationship between any of the factors which are required for rendering an invention in the industrial art practically operative, patentable novelty shall be found.

You may ask what do we mean by the objective test; in that connection illustrations will be helpful. I will use an illustration by Mr. George L. Roberts, author of the text. Suppose we have 12 men busily screwing on the lids of shipping cases for machines being shipped out of a particular plant, and they are using hand screw drivers. Now, suppose (he said) that I take a brace and bit and take out the bit and put in a screw driver, and let us assume that had never been done before, and with the greater efficiency resulting from the brace that we can now reduce the number of men from 12 to 3, so that we are making a great contribution with the substituted tool. Would that be an invention? And the answer was "No," because there is no new functional relationship between the brace and the new screw-driver tool as compared to the function of the brace and the old bit.

That is where this new functional relationship comes in. The old brace gives it a rotary motion, and pressure downward, but it does the same thing with the screw-driver tool that it does with the bit, and here it does not make any difference how much you may increase the efficiency of the operators. That is simply applying what we already know, and it is not new in the sense of being patentable.

Now, let us take the illustration exemplified by the barbed-wire-fence case. There we have the case of one barb in the prior art secured to the carrier wire by a single loop; that is, it was pivotably secured to the wire and the point could be pushed over to one side of the vertical as it was only pivotably mounted. In the patent in question, which resulted in the barbed wire as we know it, the inventor applied the barbed wire to the carrier wire by making a bearing on the carrier wire. That is, he wrapped the barb two times around the carrier wire which gave a supporting bearing which held the barb at 90 degrees to the carrier wire. Thereby he had an effective barb that was not pivotably mounted. In other words, he applied a barb that resisted being turned to one side so that it had a new functional relationship to the carrier wire, which the court held patentable.

And I might say at this point, that Mr. Roberts in making his analysis of the cases had no a priori definition with which to be biased in the quest. It took him some 25 years of analyzing all of the cases before the Supreme Court before we had the requirements for the writ of certiorari. And all of that analysis is laid out in the text. This text, by the way, is not something new. It has been

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the subject of publication for some 25 years, and was copyrighted in 1927.

Now, you may ask, how does the new functional test apply in the chemical field? In the chemical field let us take the case of the Borated Cotton. The prior art showed cotton batting had been used saturated with boracic acid solely, but such cotton saturated with boracic acid would crystallize; it tended to dry upon the cotton and form crystals which impaired its effectiveness or efficiency and irritated the sensitive tissues of a wound.

On the other hand we also had cotton batting saturated with glycerine, but the glycerine was not as effective an antiseptic as boracic acid, so what this particular inventor did was to combine the two, and then we had this situation: The glycerine prevented the boracic acid from crystallizing, and thus we had a new functional relationship and the greater antiseptic properties of boric acid were made available. The patent was sustained.

So, we have applied this to both the chemical field and the mechanical field—this test of new functional relationship.

The National Patent Planning Commission, of which Mr. Charles F. Kettering was the Chairman, stated in their 1943 report:

> The most serious weakness in the present patent system is the lack of a uniform test or standard for determining whether the particular contribution of an inventor merits the award of the patent grant. * * *
>
> It is inconsistent with sound national policy to continue to grant patents with existing uncertainty as to their validity, and unfair to the inventors of this country and to manufactnrers and investors who have proceeded on the basis of a protective security in the form of a patent issued to them by the Federal Government. * * * A promising improvement would be for Congress, by legislative enactment, to lay down a reasonable, understandable test by which inventions shall be judged both from the standpoint of the grant of the patent and the validity of the patent thereafter.

Lawbooks abound with cases where the court has variously stated, in effect, "In our opinion the patented device is obvious to those skilled in the art," or at other times have stated, "It is well within the skill of the art." This occurs even when the device or invention has filled a long-felt need and the public has manifested such is the case by the wide adoption of the invention.

After spending years in inventing, developing, and marketing the device of an invention and after spending large sums of money in such efforts, it is submitted that it is a travesty of justice to be met with a holding of a court that the patent is invalid for the reason that, "In the opinion of the court the invention is within the skill of the art." Such a conclusion is clearly of a subjective character. In short, the reasoning amounts to nothing more than, "I think anyone skilled in the art could make such an invention." When legal decisions have no more of a logical background than this certainly the patent system as an incentive to mechanics and industrial leaders cannot truly serve its purpose. The reward of efforts of inventors and financial backers and industrial leaders involving years of their life and large sums of money certainly should not be determined on so uncertain a test. After the solution of the problem, of course, it is obvious. Ex post facto knowledge renders much obvious.

Mr. Roberts, in the introduction, page viii of his text, very definitely pointed out that the commonly employed facts of obviousness or

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mechanical skill or genius, and so forth, were entirely subjective in character. He sought an objective test and states:

> No question of patent law has perplexed bench and bar more than that of patentability. For the most part, if not invariably, this question has been approached on the subjective side; many have been the speculations on the subtle distinction between the inventive faculty or "genius," and the skill or ingenuity normally exercised by persons skilled in an art; the criteria suggested for the definition of this distinction have, the author submits, failed to satisfy the standards of logic because quite as subtle, indefinite, and incapable of definition as the subjective qualities they are invoked to define.

Thus we have the origin of the terms "subjective" and "objective" in the report of the National Patent Planning Commission and thus also we have in support of the new functional relationship test a very carefully prepared text by one of the recognized leaders of the patent profession. In short, if the committee recommends the adoption of the inclusion of the new functional relationship test to section 103 and the same becomes law, the courts will have a two-volume text, the result of 25 years of effort, which carefully analyzes and applies the test to the Supreme Court cases obtaining before the requirement for the writ of certiorari. The test, it will be noted, satisfies all those cases with the exception of 3 which are deemed anomalous.

In the Patent Office the examiners have great difficulty in trying to decide questions of patentable novelty. For the most part they rely upon the subjective test and the more conscientious they are the more difficulty they have in trying to decide whether the applicant's contribution is obvious in view of the prior art or whether it is not obvious. The time and energy involved in correspondence and conference by solicitors with the examiners in attempting to point out that an applicant's invention is not obvious and that it is patentable consumes a very large percentage of the examining corps time. In this connection the examiner often answers an applicant:

"In view of the references [that is, prior patents of Joe Doe and Harry Roe] it is held that the device of applicant is obvious and therefore not patentable." The applicant then often answers, "Since the patent of Joe Doe was issued 25 years previous and the one to Harry Roe was issued 18 years ago, it is submitted that it has not been obvious."

All such comments and answers manifestly are based on purely subjective processes rather than objective reasoning. In this connection Mr. Roberts states:

> The course of nearly any patentable invention leads first through the Patent Office, where the solicitor and examiner oscillate between cooperation and controversy. If both parties to the transactions in this bureau possessed a reliable criterion, derived from judicial authority, by which to determine whether or not each subject matter presented is a patentable invention, how much time and effort in argument might not be spared.

There is another point, which is that the functional relationship is not something taken out of the air, something conceived out of the air. It is deduced from the jndicial decisions, it has all of that backing. If we want to know what sulfur is we do not ask anybody is it obvious as to whether that is sulfur or not. We apply the objective test, such as has it a certain boiling point or not, does it combine with other chemicals in certain proportions, and we know definitely this is sulfur. We want to get the same approach to patentability. We cannot do it exactly, and in saying that I am not detracting from its reliability.

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Take the case of the barbed wire. Today you might have an argument about it, that it is just an adaptation, but we know there was a functional relationship. The inventor made that barb stand up and do the work, and that invention made it possible to fence in the great areas of the plains and made our great cattle industry possible, something that is quite pertinent today, by the way.

Mr. Roberts worked some 25 years or more in carefully digesting all the Supreme Court cases before writs of certiorari were required and there deduced the test set forth in his text and hereinabove as the paragraph desired to be added to section 103.

On page 8 of the introduction, Mr. Roberts stated:

> In making this essay, the author had no a priori definition of his own with which to be biased in the quest. Only after analysis and comparison of the cases did the definition appear, which harmonizes all this group of cases—181 of them—with the negligible exception of 3 which the author is obliged to regard as anomalous and out of step with the impressive procession formed by the others.

Let it be particularly noted that many of the examiners in the Patent Office at the present time are applying the objective test of Mr. Roberts. Some have declared that they place great reliance upon Mr. Roberts' text and have been applying his objective test in their work.

So, this committee is not being asked to bring in something new that has no precedent, that has no testing or previous history.

The National Patent Planning Commission head, Mr. Charles F. Kettering, who recommended the objective approach calls attention to the difficulties of the subjective approach, and the confusion we are in at the present time.

Now, I do not want to be misunderstood in the slightest degree, I am not stating that the Commission approved these very words, and I will get the wording of the report which is:

> The Commission therefore recommends the enactment of a declaration of policy that patentability shall be determined objectively by the nature of the contribution to the advancement of the art, and not subjectively by the nature of the process by which the invention may have been accomplished.

There you have objectivity contrasted with subjectivity.

Accordingly, if the above paragraph set out in the beginning is added to section 103 we would have the law recodified as it is being practiced by many examiners today. Unfortunately, we do not have the advantage of such practice in many of the courts and the addition would give needed protection against subjective tests and nullifying of patents where direct new functional relationships exist between the factors of the combination. If the addition here sought to be added to section 103 is not added, then we have given statutory endorsement for the first time to the "obviousness" test without a corresponding endorsement of the objective test followed by many of the examiners of the Patent Office.

There may be those who feel that we are now trying to put something into definite form that is too rigid, that it might take care of some little invention and require that to be patented where it would not be today by the obviousness test. I submit that is not any answer. I call your attention to the barb-wire case. Let us remember that this test must be applicable at the time when the inventor comes to the attorney. The inventor should not have to wait until after he has

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made his contribution to the art. The lawyer who takes that man's money is taking it to tell that man whether or not he has a patentable invention. It is a question as to whether or not we should be taking that man's money on a mere guess Personally I do not take them on that basis. When a man comes in, if I cannot find a new functional relationship involved in that man's invention, where I feel it has some other test than the subjective test I tell him that I do not think he has a chance for a sustainable patent, and if he insists upon going forward with it anyhow then I give him a letter to that effect, stating that he can take his chances on whether or not the Patent Office will allow one on the basis of the obviousness test. This is very seldom.

The Patent System of the United States provides great new frontiers for our graduates from electrical, mechanical, and chemical engineering institutions as well as for the ordinary mechanic who does not have the advantage of a university technical training. Other countries have great resources and have great ability, but they have not made the progress which this country has. Certainly when all the factors are weighed, the conclusion is inevitable that the patent system of the United States is directly responsible for a great part of the success of our country economically and militarily, and I consider these words right here of the utmost importance: I consider this committee the real national defense committee of our country. You have in your hands the power of deciding whether we are putting into this proposed law one of the keys to this whole patent system. If you do not have a proper test for patentable novelty you cannot get a worthwhile patent, and if you do get a patent then when you do get into the court you have the risk of having the court tell you, "We think this comes within the skill of the art." Just as in the following case, in which the court said:

> Although we think the method advanced by appellants might well result in a saving of time, that of itself does not necessarily involve invention. On the contrary, although the method advanced by appellants eliminates or consolidates some of the steps of Williams—

one of the prior parties—

> we believe such elimination and consolidation is within the skill of the art. *In re Zobel and Helfenbein* (88 U S., P. Q. 367, 369).

Now, after a party has invested years of his life in a patent, and has induced his friends to bring in their money and help him, to be told after that: "We think this comes within the skill of the art," is not a satisfactory reason for judicial decision. It is almost unthinkable that we have such an illusory basis of testing for patentable novelty. I suggest, most respectfully, it is high time we get down to an objective (new functional relationship) test to give the inventors, the manufacturers and industrial leaders something to guard their interests.

The patent laws constitute some of the most democratic legislation we have. If a man is working at B's bench, on B's time and he conceives of a new idea that idea is his. It is not that of his employer's unless he has made a written agreement to assign the right to his inventions, or has been hired as an inventor. The American Federation of Labor out our way will not allow its men to sign up agreements that any inventions they make belong to their employers. They have to take it up with the unions, and they will make an arrangement whereby he is hired as an inventor, and then he is paid accordingly.

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A mechanic without an inventor's contract should never have to assign all of his time that he gives to an idea and all of the work he gives to it to an employer. He should be recognized as the iron worker who got the idea of discharging steel into one large receptacle and thereby separating out the gross, and the steel company, as you know, provided a trust fund for him, and took out his patent, and created royalties to protect that man. This is the kind of a democratic nation we have. Right down to the grass roots.

The patent system has made it possible for us to serve most of the world by supplying necessary food for their daily living. The standards of living are recognized in the United States to be far superior to that of other countries. If this is to continue, then the patent system, it is respectfully submitted, must be protected.

Mr. ROGERS. Mr. Arnold, may I interrupt you there?

Mr. ARNOLD. Yes.

Mr. ROGERS. Do I understand you contend that at any place in this law that this will prohibit contracts?

Mr. ARNOLD. No, your Honor. I have no such conception as that. All I am trying to do in these sentences is to emphasize the importance of our patent stystem. I consider this patent system fundamental to the idea of the protection of our country.

Mr. ROGERS. We too agree in that, I am sure.

Mr. ARNOLD. That is good. There are some, though, who think that a patent is a monopoly. I am glad you raised this issue. They say it is a monopoly. Now, that is entirely a wrong term to apply to a patent. Dean Wigmore of Northwestern University hit that idea. He has pointed out that the patent lawyers are derelict in not stopping the use of the words "patent monopoly." It is no more of a monopoly than your automobile or your library. Nobody can use those without your permission. An invention is only your property for 17 years.

Mr. ROGERS. I was curious about your remarks when you made reference to labor unions and corporations, and the labor unions insisting that if a man goes to work as an inventor that he be paid as an inventor.

Mr. ARNOLD. Exactly.

Mr. ROGERS. There is nothing in this law that would prohibit that.

Mr. ARNOLD. No; not a bit. I had no conception, and no thought of suggesting any such idea, and I am glad you make that clear, and I want to be definitely understood on that point.

Mr. ROGERS. Have you any thoughts on the proposition of the large corporations who hire individuals as inventors and require them to assign their interests to anything that may be developed from their inventive knowledge to the corporation, and whether or not that increases this democratic system or leads to monopoly?

Mr. ARNOLD. No. I am glad you asked that question. This is Mr. Rogers, is it not?

Mr. ROGERS. Yes; Rogers.

Mr. ARNOLD. I am glad you asked that question. I feel that the requirement that they do sign contracts and get paid accordingly opens up a field for employment for our graduate engineers, both chemical and electrical.

Mr. ROGERS. It opens up the employment for them, but, on the other hand, by virtue of that arrangement or contract which it is necessary to sign at the time they accept employment, is there not a tendency

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to get all of the new patentable inventions into the hands of those large corporations with the result that there may be a monopoly given to those who maintain the laboratories? Do you see any possibility out of this law that might develop as a result of that practice?

Mr. ARNOLD. I do not see anything in this law that is pertaining that way any more than we have at the present time, but as to our present course I submit that we are very well protected.

My experience after 37 years' work in this field is this: I find men that do complain at times, "That I had to sign up when I went with the company that I would assign my inventions to them. I stayed with them a certain period of time, and after that I left because I wanted to have the advantage of my own inventions." That is also bringing about at the present time arrangements for the party to share in inventions, that is, to share in the awards of the invention. In other words, there is that tendency to break away from a company and start out on your own, and that is bringing about an increase sharing in those rewards.

Mr. ROGERS. We have also had instances of those who have accepted employment and helped to perfect an invention and then left the company and attempted to make use of the articles that were patented by the employer.

Mr. ARNOLD. Unfortunately, Mr. Rogers, we have weaknesses among inventors as well as others insofar as ethical situations and fidelity to the employer is concerned, but I submit in those cases our regular laws would take care of that breach of faith on the part of the employee.

In the meantime, that young man or engineer, electrical engineer, or chemist, must remember that he received the benefit of equipment that may be beyond the power of any individual laboratory to own, and you have to have these expensive types of equipment sometimes in order to meet the requirements to make an invention, particularly in the electrical field. I am not trying to assist in any way in the field of monopoly, in the sense that we are taking away what was there before, with the definition that was put out or given before. As to the question of what constitutes, or what is a true definition of monopoly, we have: Monopoly—a license or privilege allowed by the king, for the sole buying and selling, making, working, or using of anything whatsoever: Whereby the subject in general is restrained from that liberty of manufacturing or trading which he had before. Blackstone (4 Com., p. 159) (Coke in His Institute, Vol. 3, p. 181, confirms Blackstone) a patent adds what we did not have before.

Mr. ROGERS. So far as this bill is concerned there is notbing that would add to or subtract from the situation that may exist in the industry concerning the employees' assignability that is now in the law.

Mr. ARNOLD. No; I see nothing in there that would do that.

Of course, I have come here with the one thought of confining my attention to the one thing that I consider the key of this whole matter, namely, section 103, Conditions for Patentability. For those who like obviousness as the test, the addition of the clause sought by the witness does not take that away from them. Let them have the obviousness test, but we also would like our suggestion included. If the field of patentability covers a certain area, if it covers 1 square foot, we would like to have one little area up here of 2 square inches of that area, so that whenever it is established that in the invention

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there has this new functional relationship then in that group of cases that patentability shall be found.

Mr. ROGERS. Then you suggest here because the courts many times determined that it is not patentable, you feel that we should write the code so that the attorneys and inventors may thereafter determine by reading the code whether it is patentable or not; that is your thought, is it not?

Mr. ARNOLD. The thought is to have in the code a test that will be objective in character.

Mr. ROGERS. What assurance can you give us that if it is written into this code that the courts will not place different interpretations upon it than you or I may place upon it as we read it, as they have done in the past?

Mr. ARNOLD. I think that is a most relevant question, and I am very glad to have that question asked.

I am certain I cannot foretell the future, but I do submit when we have a text that has been out for 27 years, and involving work of some 25 years of research and analysis of all of the cases in the Supreme Court of the United States, 181, that is, before a writ of certiorari was required, when we have all of that, and when we have a two-volume text on this one question involving an analysis of all of those cases, pointing out just how this principle of functional relationship is applied, I submit that Congress may well publish a test in line with the treatise. Such a test should help the Court as a guide, but we cannot know.

Mr. ROGERS. Do you not feel that with section 103, inclusive of 104, we have pretty well covered that field of the 181 cases that have been decided, trying to put it in concise language?

Mr. ARNOLD. No; I do not think so, Mr. Rogers. I feel that it is better also to put in the objective test. It is the "nonobvious" and obvious character of section 103 that is exactly what Mr. Roberts is contending against.

Mr. BRYSON. Would you have us spell it out by statute so plain and simple that he who runs may read?

Mr. ARNOLD. I cannot hear you; pardon me.

Mr. BRYSON. I say would you have us spell out by statute the rule of obvious patentability so plain and simple that he who runs may read, including the Supreme Court?

Mr. ARNOLD. I would have you put in just those words we have suggested because that is the definition of objective patentability or new functional relationship that Mr. Roberts has worked out after so many years of effort. I do submit with that clause in there, taken directly out of his text, that we have backing it up two volumes of cases that will help the courts in elucidating and applying that test.

Mr. BRYSON. Of course, you are assuming that we follow the rule of stare decisis.

Mr. ARNOLD. It is mandatory, just like in other fields of the law involving a certain given situation, it is mandatory. When you come in to secure a patent and your patent lawyer says, "I find new functional relationship here so that you are entitled to a patent on that," your application goes to the Patent Office, and your lawyer shows the examiner why prior-art patents do not have that new functional relationship. After that happens, we assume that you get your patent. Then you get out into the courts later, and then you can

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point out the situation to the court and put in your evidence and your opponents can bring up new evidence showing that as a matter of fact the functional relationship existed before, that it was existing in the art, and the court can hold the alleged new functional relationship was old then you have not established a new functional relationship. But if there is a new functional relationship then it is mandatory on the court to find patentability in support of your invention upon the basis of which you have spent years of your life and years of work, and have invested the money of your friends involving investments of possibly hundreds of thousands of dollars.

Mr. ROGERS. Assuming, for the purpose of this question, that we should adopt your definition as set forth on page 2 of your prepared statement, your suggested addition to section 103, could you therefore conceive of an instance where a man, having applied for and received a patent from the Patent Office, could have the same declared invalid by the court?

Mr. ARNOLD. I think there, Mr. Rogers, our chances would be much improved. You cannot tell what some court may hold. They may hold it is invalid.

Mr. ROGERS. That is the point I am getting at. Even if we took the language you offer here and added it to this code we would still have that hiatus, that there is a likelihood that the court still, in its inherent power has the right to declare a patent invalid, the point that you have complained about, because the functional relationship had not been established under the old or under the new law.

Mr. ARNOLD. In such a case I would not be done with that particular court. There would be an appeal there from that court's decision.

Mr. ROGERS. Let us forget the lower court and say you are in the higher court.

Mr. ARNOLD. Yes; fine.

Mr. ROGERS. And you see in the higher court the same hiatus or fear that is now held by the industry and the inventors that the patent is not valid and cannot be determined to be a valid patent until finally it is passed upon by the highest court of the land, would your definition here or any other phase of this law have removed that fear and made it positive?

Mr. ARNOLD. Of course, Mr. Rogers, please understand that I am not saying that Mr. Roberts has discovered the last ironclad test that we can always submit to the Supreme Court——

Mr. ROGERS (interposing). That may be, but the point, as I understand it, is, you know that the proposition of trying to recodify this law has been going on for some time.

Mr. ARNOLD. Yes, indeed.

Mr. ROGERS. And there are a number of men who are interested in the business, and some of them, such as yourself, have devoted a great deal of time to it.

Mr. ARNOLD. Indeed they have.

Mr. ROGERS. As you have stated in your testimony here, the objective is to try to establish with some security after a patent has been issued by the Patent Office that thereafter the courts will never set it aside. Now, that is more or less some part of your statement this morning.

Mr. ARNOLD. Yes; it is part of it, but not conclusive, because I think we have the right——

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Mr. ROGERS (interposing). Now, following that through——

Mr. ARNOLD. Yes.

Mr. ROGERS. If this law is adopted or if we recodify it as we set it forth here, you will admit it will relieve the fears and apprehensions of some, and that there is a likelihood that when the Patent Office has issued a patent that the court is more likely to adhere to this recodified law?

Mr. ARNOLD. No, Mr. Rogers. That is my great fear. That is why I am so anxious and so much concerned about this matter. This statute now says, "Conditions for patentability; nonobvious subject matter." We have never had a test of this kind of statutory language before that I know of, and if I am wrong some of my friends can quickly correct me, but we now have in section 103, "Conditions for patentability; nonobvious subject matter." Going into the question of whether it is obvious or not is subjective. That emphasizes the very thing we object to, namely, the uncertainty. What is obvious to one man is not obvious to another.

If we add the proposed new functional relationship test (the objective test) we certainly would not be in any worse condition even though we do not cure everything. I have faith in the courts that they would try to follow what is clearly suggested by Congress, and with the textbook behind it to show what the meaning of that phrase is, the courts would have a clearly chartered course. How great is our confusion is depicted positively by Justice Jackson when he stated in the case of *Jungersen* v. *Ostby & Barton Co.* (80 U. S. P. Q. 36):

> It would not be difficult to cite many instances of patents that have been granted improperly, I think, and without adequate tests of invention by the Patent Office.

Parenthetically I will state that the Patent Office will come through in a bigger percentage of the cases with justification than we have had from the Supreme Court in the last several years. To continue statement of Justice Jackson:

> But I doubt that the remedy for such Patent Office passion for granting patents is an equally strong passion in this Court for striking them down *so that the only patent that is valid is one which this Court has not been able to get its hands on.* [Italics ours.]

Mr. ROGERS. That is the point we are trying to make, that regardless of what we agree to in this revised code in attempting to recodify all of the law you would still have this problem when you get to the Supreme Court of the United States.

Mr. ARNOLD. If we had this test we are recommending in there now what would be the situation? Let us take a concrete case. Let us take the Great Atlantic & Pacific case just decided. That is a simple case. In that case it was a matter of a frame without any bottom to it, with an open end, devised for sliding over a table.

Mr. BRYSON. One of those little wagons that telescopes with another?

Mr. ARNOLD. No; that is a wagon, Mr. Bryson. I am speaking about the case where there was a counter—you come with the little cart to the counter on which is a little framework device slidingly mounted—and you place the groceries of your purchase in this little frame. The clerk, after dealing with the preceding customer, draws

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the frame with your groceries up to her station. She can pull these groceries up there and let go without any further action, and the frame is retracted for the next customer coming along. The evidence showed in that case that there had been a tremendous increase in the number of customers served and in a shorter time, that it was of benefit to the customer and of advantage to the store. So, we had all of the industrial worthiness in that matter, and benefit given to the public in that invention. Then that went to the court, and Justice Florence Allen, of the sixth circuit, at Cincinnati, pointed out in her opinion in the circuit court of appeals that the defendant admitted that there had been no such prior arrangement as that which constituted this bottomless open framework with open front, and yet the Supreme Court, and I do not know how they ever missed it, went right on and said there was no arrangement in this at all that was new, and yet here we have in that very case that situation.

If the court does not want to listen to the record we cannot stop that, but I want to point out that in that case Justice Allen very clearly pointed out the new functional relationship, because when that frame was pulled up there you let go and all of the groceries were left there at station of clerk on the counter. The alleged anticipating court article then depended on was the billiard-ball triangle, where you take billiard balls and put them in a triangle and very carefully pick up the triangle when the balls are in position.

The new functional relationship was in there in that case, and yet the court struck it down.

Mr. ROGERS. That is the point. If we took your amendment and put it in there, do you think the Court would then be prohibited from arriving at the same conclusions? Suppose this law had been recodified and your amendment was in there, would the Court then have been bound to have arrived at some different conclusion, or what would have been the situation?

Mr. ARNOLD. Off the record.

(Discussion off the record.)

Mr. ARNOLD. The question is very pertinent, and I am glad to have it asked. I am not submitting, Mr. Rogers, that we have something that is perfect, but if I cannot get a plane that will take me clear across the country I will take one that will get me as far as I can go, to Minneapolis, for example, and transfer to another one, and so forth, until I get into Washington. Let us get as far as we can with our objective test.

In this case I think if we had a law like this that many members of the Court, who have no idea, so far as they have evidenced they do not seem to have any idea of the logical test that gives them any kind of a basis for making a determination, and that is why Mr. Jackson has pointed out here that the only patent that is valid is one which "this Court has not been able to get its hands on." I think that is a more serious indictment than I have ever heard a patent lawyer make of a court, and I do feel if we had this law that when the functional relationships are established we have the point established that this does deal with some degree of certainty, and that that is a good law.

In legal jurisprudence that principle of law is good which works out the greatest justice with the greatest uniformity and certainty to the greatest number.

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Mr. ROGERS. We have had testimony from a number of organizations on this bill before, and you think it would be improved by adding this section?

Mr. ARNOLD. Very definitely do I feel that way. I do not see how logically it could be otherwise because what we are doing here is preventing the Court from holding that it is an invention within the skill of the art as the sole explanation. How can we expect anybody to be willing to spend money on developing and carrying on on a test lacking in a rational basis. Now when the life of our country is at stake, when we have economic burdens to meet, one of our workmen must be equal to thousands of others, and one of our soldiers must have equipment that makes him the equal of many thousands of the enemy. Our patent laws should be just as clear, sound, and certain in their operation as they can be, and this test would certainly give help to that situation.

Mr. BRYSON. Mr. Arnold, we are indebted to you for the comprehensive and very thorough way in which you have presented your statement. We hate to remind you that you have consumed an hour now. Will you not try to sum up your remarks soon? I am sorry that we are limited for time.

Mr. ARNOLD. I think the main points have been brought out. Certainly this addition that I am trying to have added is certainly the key to our patent system, it really is the fundamental one, because we cannot have incentive if a man comes home tired at night and gets an idea that comes into his head and says, "Why should I try to work that out, patents are too uncertain?" If we cannot give him some incentive some assurance that he is going to be protected he will not be working at his lathe or bench. He will ask, "Why work something out at great expense and give it to the public." That patent incentive of old is now being whittled away by the adverse decisions of the courts, and I feel very strongly that is destructive to the American way of life.

In a word, I do not know how I can make it more definite than this, that the principle in moral life and everywhere that leads to life more abundant is right, and that the principle in moral life and everywhere that leads to life less abundant is wrong. In the same way that principle of law which gives the greatest justice and the greatest certainty is right. The objective test will give a sound basis for justice with certainty and uniformity.

I thank you each and every one.

Mr. BRYSON. We thank you, sir, and we will certainly give due consideration to your advice.

## STATEMENT OF I. E. McCABE, CHIEF ENGINEER, AND CHAIRMAN OF THE BOARD, MERCOID CORP., CHICAGO, ILL.

Mr. BRYSON. Mr. McCabe, representing the Mercoid Corp.

Mr. MCCABE. Yes, sir.

Mr. BRYSON. Mr. McCabe, will you identify yourself for the record?

Mr. MCCABE. I am an inventor, and I am chief engineer, and chairman of the board of the Mercoid Corp. of Chicago.

Mr. BRYSON. What is the Mercoid Corp?

Mr. MCCABE. It is a manufacturer of automatic controls of various types. We manufacture several thousand assembly and control devices.

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Mr. BRYSON. We have heard mention of your company in connection with a decision of the Supreme Court.

Mr. MCCABE. Yes, I believe you have. I have here a statement of which I have brought 25 copies.

Mr. BRYSON. Sit down, and please observe the rule we have impressed on the other witnesses. Do you desire to read your statement or file it for the record?

Mr. MCCABE. For the purpose of discussion I would like to point out two or three matters I have mentioned in my statement, and file it for the record.

Mr. BRYSON. Your statement will be put in the record in full, and you may make such comments as you care to make.

(The statement referred to is as follows:)

COMMENTS ON H. R 3760 (82D CONG., 1ST SESS.), TO REVISE AND CODIFY THE LAWS RELATING TO PATENTS AND THE PATENT OFFICE, AND TO ENACT INTO LAW TITLE 35 OF THE UNITED STATES CODE ENTITLED "PATENTS"

(Prepared by I. E. McCabe, chief engineer and chairman of the board of the Mercoid Corp., Chicago, Ill.)

My name is Ira E. McCabe, chief engineer and chairman of the board of the Mercoid Corp. of Chicago, Ill., manufacturers of automatic controls and switches. I filed my first patent application in 1913 and since that time more than 125 patents have carried my name, and I have patents pending as well as others to be filed. Incidentally, a considerable number of my inventions have found commercial use, and I have prospered therefrom In my opinion, gathered from personal experience and direct knowledge, our country under the constitutional powers granted to Congress "to promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive rights to their respective writings and discoveries" has attained the greatest advances of any country in the world and for so little. Stimulating invention is important, but it must be done within the constitutional limitation "to promote the progress of science and useful arts." Failure by the Congress to observe this may in the long run destroy the patent system, and it is because of a personal fear that this may occur that I am here to oppose H R. 3760 with respect to section 231 relating to contributory infringement.

Patents are monopolies, and the framers of our Constitution were aware that patents so granted should be properly limited and only for the purposes described, namely:—"to promote the progress of science and useful arts."

H R. 3760 is titled "A bill to revise and codify the laws relating to patents and the Patent Office and to enact into law title 35 of the United States Code entitled 'Patents' ". This would seem to be an admirable purpose, but I note many new matters not before included in the code and many of these of a controversial nature which have not been individually accepted by the Congress, or possibly in some cases even considered before

It would seem to me that inclusion of these controversial matters in a revision of existing statutes is both improper and unwise, as some of these proposals, such as section 231 and particularly paragraphs (b), (c), and (d), I am sure, cannot stand on their own and only by associating them with the bill as a whole could they ever be enacted into law.

As an inventor, engineer, researcher, and businessman I can assure you that there is more to this than appears in the phrasing, innocent as it may seem. The people who deal with obtaining of patents and litigating them when infringements are involved do not deal with their impact or effect upon the public other than relating to their own problems.

The courts have had to deal with the abuses, and a study of the decisions and the matters relating thereto, will often disclose why they felt impelled to become emphatic.

Section 231, Chapter 3, Infringement of Patent, has previously appeared in substance as separate bill H. R. 5988, Eightieth Congress, and H. R. 3866, Eighty-first Congress. I testified at the hearings before the subcommittee of the Committee on the Judiciary in each instance, in opposition thereto. I do not find in the present bill any changes in section 231 which has removed the objectionable features of the earlier proposals.

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In our business we manufacture several thousand specifications of instruments and switches. Our order department must process forty or fifty thousand orders per year, and our product is used in innumerable products and places. We employ less than 500 people in our organization, and it can readily be seen that no order department could screen these orders for possible contributory infringement throughout the field of industry involving nearly 600,000 unexpired patents embodying several million claims It must be remembered that each claim is recognized as a separate invention Certainly in the manufacture of the devices themselves we make every effort to avoid building infringing structures and even then disputes will arise involving prior usages and consequent invalidity or whether the device is within the scope of a patent or not. Yet, if this proposed law were to become effective, every time a customer ordered a control with some deviation such as a smaller bulb in a temperature instrument or made of a certain alloy to withstand chemical effects we would then assume possible patent liability, not because our device is an infringing device but because our customer brought about such infringement with a control he had "especially made." True, the bill says in paragraph (c) of section 231 that an infringer is one who "knowingly sells" for an infringing use and one therefore might deny knowledge to avoid liability. On the other hand, as Mr Justice Jackson said in his dissenting opinion in the case of *Mercoid Corp.* v *Mid-Continent Inv Co* (320 U. S. 661, January 3, 1944) :

"But want of knowledge or innocent intent is not ordinarily available to diminish patent protection. I do not see how intent can make infringement of what otherwise is not. The less legal rights depend upon someone's state of mind the better.

"The practical issue is whether we will leave such a combination patent with little value indeed or whether we will give it value by projecting its economic effects to elements not by themselves a part of its legal monopoly. In these circumstances I think we should protect the patent owner in the enjoyment of just what he has been granted—an abstract right in an abstruse combination—worth whatever such a totality may be worth. I see no constitutional or statutory authority for giving it additional value by bringing into its monopoly all or any of the unpatentable parts."

The last sentence in the above quotation by Justice Jackson is one which I hope this committee will give consideration to in passing upon the advisability of bringing into the patent monopoly the unpatentable parts and whether or not Congress has free rein to grant such monopoly to the inventor.

Many advance the idea that inventions involving old devices increase the use for them and that the maker therefore is not entitled to sell for these new purposes. One of our items is heating thermostats for heating systems in various furnaces. The other day it was predicted that atomic energy would furnish home heat produced directly in the home furnace. Controls for such a furnace would obviously require construction of special materials—so they would be "especially made"—but such use would subtract from the sale of present heating systems thereby decreasing sales of heating thermostats in present systems. Why should the new system gather into it the monopoly of the older unpatented devices and by what stretch of imagination can the future inventor of the atomic energy furnace be said to have added the heating thermostat to the arts and sciences "constitutionally specified"?

Is it constitutional for one to include in the monopoly granted him by patent the discoveries of others? The power of Congress to permit patents to issue is a constitutional grant defined by article I, section 8. It provides for the grant for a limited time to inventors the exclusive right to their inventions comprising their discoveries. The power of Congress in connection with these grants is well expressed by Mr Justice Douglas in the case of the *Great A. & P. Tea Co.* v. *Supermarket Equipment Corp.* (U. S Sup. Ct., 87 USPQ 306) :

"It is worth emphasis that every patent case involving validity presents a question which requires reference to a standard written into the Constitution. Article I, section 8, contains a grant to the Congress of the power to permit patents to be issued. But unlike most of the specific powers which Congress is given that grant is qualified. The Congress does not have free rein, for example, to decide that patents should be easily or freely given. The Congress acts under the restraint imposed by the statement of purpose in article I, section 8 The purpose is 'to promote the progress of science and useful arts.' The means for achievement of that end is the grant for a limited time to inventors of the exclusive right to their inventions."

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Every patent is the grant of a privilege of exacting tolls from the public. The framers plainly did not want those monopolies freely granted. The invention to justify a patent had to serve the ends of science—to push back the frontiers of chemistry, physics, and the like; to make a distinctive contribution to scientific knowledge. That is why through the years the opinions of the Court commonly have taken "inventive genius" as the test.[1] It is not enough that an article is new and useful. The Constitution never sanctioned the patenting of gadgets. Patents serve a higher end—the advancement of science. An invention need not be as startling as an atomic bomb to be patenable. But it has to be of such quality and distinction that masters of the scientific field in which it falls will recognize it as an advance. Mr. Justice Bradley stated in *Atlantic Works* v. *Brady* (107 U. S. 192, 200), the consequences of a looser standard:

"It was never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea, which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufactures. Such an indiscriminate creation of exclusive privileges tends rather to obstruct than to stimulate invention. It creates a class of speculative schemers who make it their business to watch the advancing wave of improvement, and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country, without contributing anything to the real advancement of the arts. It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to lawsuits and vexatious accountings for profits made in good faith."

While the above quotation is directed to the validity of patents—the quality and distinction marking invention—the same consideration may be given to the right of Congress to grant combination patents with the patentee privileged to include in his monopoly the patented and unpatented elements included in his combination but not his invention The Constitution may well limit the patentee, and Congress the power to grant him, a patent monopoly only for his invention and not to anything else related thereto, to which he is not the inventor.

Since the decisions in the Mercoid cases the Mercoid Corp. has been free from harassment and litigation for the first time in many years of the sort regarding which you will find mentioned in my statement filed in H. R. 5988 of the Eightieth Congress and my testimony in H. R. 3866 of the Eighty-first Congress involving this same problem of contributory infringement. I am also attaching herewith copy of a statement submitted to the committee at the hearings on H. R. 3866 but which I have noted was not included in the printed record thereof.

I therefore recommend that paragraphs (b), (c), and (d) of section 231 be eliminated from this bill.

A few days ago I attended a meeting held for the purpose of discussing this bill. A representative of a large chemical company, long a customer of the Mercoid Corp, remarked during a luncheon that they employed a process in the manufacture of one of their products which did not infringe a patent but by the addition of a Mercoid-switch infringement would then exist. Now, chemical plants order many "especially made" switches from us for use in their various processes, and in some cases our salesmen may know what they are intending to use them for. In many other cases we don't know, and in some cases we are not permitted to know.

We give our customers a patent warranty but that refers to the device we sell him and not to what he may do with it, and we limit ourselves to the things we sell because our knowledge is concentrated there. Should section 231 of this bill become law "knowingly selling," "especially made," or "especially adapted," as well as "substantial noninfringing," all will become highly controversial phrases construed by various patent lawyers to suit each situation, and as quoted before in Justice Bradley's words "it embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to lawsuits and vexations accountings for profits made in good faith."

Furthermore, as to damages in contributory infringement cases, the court's discretion will be governed by statutory definition and in section 244 there has

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[1] "Inventive genius," Mr Justice Hunt in *Reckendorfer* v. *Faber* (92 U S 347, 357); "genius or invention," Mr Chief Justice Fuller in *Smith* v. *Whitman Saddle Co.* (148 U S 674, 681); "intuitive genius," Mr Justice Brown in *Potts* v. *Creager* (155 U. S. 597, 607), "inventive genius," Mr Justice Stone in *Concrete Appliances Co.* v. *Gomery* (269 U S 177, 185); "inventive genius," Mr Justice Roberts in *Mantle Lamp Co* v *Aluminum Products Co.* (301 U S 544, 546 (33 USPQ 421–422)); *Cuno Corp* v *Automatic Devices Corp* (314 U S 84, 91 (51 USPQ 272, 275)), "the flash of creative genius, not merely the skill of the calling."

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been no distinction drawn between infringement and contributory infringement so that in the case of the chemical company to whom a switch might be sold under doubtful circumstances, and I have already referred to this situation in the previous paragraph where we might sell an item costing at the most a few dollars, we would find ourselves liable for damages "adequate to compensate for the infringement," which section 244 says the court "shall award"—not "may award"—and furthermore there is nothing in section 241 that compels a suit against the chemical company as an infringer in this situation as against us as a contributory infringer (what opportunities for blackmail lie here?).

Referring to section 242, presumption of validity; defenses; I would like to see included provisions specifically dealing with contributory infringement suits. In my statement on H. R. 5988, pages 81 and 82, I state:

"It is an old axiom of patent law relating to validity that that which it later infringes, it earlier invalidates.

"I should like to see included in any bill defining contributory infringement a section specifying that:

"That which constitutes contributory infringement by the accused, if by him is proved to constitute that which he likewise did more than 1 year before the filing date of the patent in suit, upon which the cause of action is based, invalidates said patent."

As a closing observation the proposed bill states, as its purpose, that it is to provide for the protection of patent rights where enforcement against direct infringers is impracticable.

"Since the owner of the patent wishes a convenience when he sues for contributory infringement instead of suing the direct infringer, is not the alleged contributory infringer entitled to be relieved of going out and finding a direct infringement constituting a reduction to practice which he may never have had a reason to have carried out himself, although, he may have supplied materials and the instructions for so doing more than 1 year prior to the filing of the application and be able to prove his own actions although unable to go further to the satisfaction of the court as to his instructions having been followed?"

I do not find any safeguards here under section 242 and certainly as a maker of controls instead of a chemical manufacturer I can be accused only of doing certain things as a contributing infringer, and if I have done such things more than 1 year prior to the alleged contributory infringement that of which I am accused if earlier should invalidate regardless of whether or not the purchaser carried out the direct infringement.

Even aside from my comments on sections 241, 242, and 244 I again say that paragraphs (b), (c) and (d) of section 231 should be eliminated and that the question of contributory infringement is something to be determined by the court rather than to be set out in statutory definition.

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Mr. McCabe. I particularly oppose sections 231 (b), (c), and (d) on contributory infringement.

It is my understanding that these items were up before the committee in previous bills on contributory infringement. The numbers were then H. R. 5988 and H. R. 3866. I testified before this committee on those items, and I find in this bill that some of the objectives which were stated in the original bill have been left out, and in order that you may appreciate the situation, and what may result from it—I am not trying to tell you what to do—I am trying to tell you what may happen. We make a large number of devices and people come to us in the industry from distant points. At this moment with all other defense work going on we have been building our standard devices, but they come in to us and say, "We want this part of stainless steel, and we want this dimension here, and we are going to use it for some process." When you realize that there are some 600,000 patents and millions of claims involved under the present status of this bill, in conection with other modifications of the bill, and we become liable as contributory infringers, you can see it would be impossible for us

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to know in all cases whether we infringed or not. When we build these instruments we usually get an idea whether the particular device we make would infringe a patent on that device, but there are hundreds of uses for these instruments, and we have a number of salesmen out, and a number of people handling incoming orders in our business which is small, and employs less than 500 people. The number of orders involved is between 40,000 and 50,000 every year. This bill includes salesmen, we were told. He might know the use but not know it is patented, I believe the wording in the bill is, "Knowingly sells," and I will refer to it:

> Whoever knowingly sells the component of a patented machine, manufacture, combination, or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use shall be liable as a contributory infringer.

"Knowingly sells" will thus become highly controversial, and it will be construed by various patent lawyers to meet their particular situation. We have had in the past experience of that nature. I need not tell you of the importance of the cases, but if you go into those cases you will see the thing I am talking about. Those words mean different things to different people, and the attempt is usually made by the lawyers to get the Court to accept their construction of those words. For instance, take the words "knowingly sells" this device, and later they sue you, and they state, "You made this article to infringe this patent." The question is what does "knowingly" made mean. If a man said he was going to use it on a chemical process, that he was going to use it there, and for instance it might infringe a chemical process or system, if he used a Mercoid switch he might have used it knowingly. If he did, it would infringe a patent, but without it, it would not infringe it. Suppose this man added the switch, and he told the salesman, "I am going to use that on such and such a process." He would not probably say that it infringes a patent, but the inference might be there, and in the future where would we be if the owner of that patent decided to sue us?

There is nothing in this bill that compels the owner of the patent to sue the infringer because in section 231 it states under (c), "Whoever knowingly sells"—and suppose we knowingly sell this article—"shall be liable as a contributory infringer."

When section 231 was first proposed as H. R. 5988, it was "to provide for the protection of patent rights where in enforcement against direct infringers is impractiable." That was the purpose of that bill, but this bill does not qualify at any time. It does not say you must sue the direct infringer if practicable. I find nothing in the bill requiring that. I might supply a $10 or a $15 item for use in a very large process. They might use it in that process and we could be subjected to defend a suit against such a form of infringement and be unable to protect ourselves. We had sold the product in good faith. We knew our product that we built was not an infringing device, but it was put to infringing use. There is the question of what "knowingly" means.

We might have been selling this device for some other purpose, but the words "noninfringing use" are very substantial words when you get them in the hands of a man fighting a case. We had that in the Mercoid case, and even in the case that was involved there there was

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another use. The Court held there was no proof it was used that way, but the attorney then proceeded on the opposite line to show that there is no other use. When you put the word "substantial" in front of it, can you tell me what "substantial" means?

I have here a device. Here is a switch we build, and perhaps it will help you to understand. This was made for a customer who needed it. Here it became another structure. We took this off and this [indicating]. Part of this we specially made, and the customer ordered this. He says he is going to use this on something, and at the time it sounds innocent enough, and we sell it to him in good faith.

Mr. ROGERS. Referring to the last instrument you had in your hand, is that a stable line?

Mr. MCCABE. This is a stable article [indicating]. The words in this section (c) are "or especially adapted for use." You cannot put this on that job. Our customers order this (another part) made up. This is welded in. There it is still the same switch, but with this wording the construction by the people in the patent field would be, it is especially made. I do not think that was the intent there, but it is what will happen when we get out in the field and you make this law. At present the court could have some discretion in it.

Mr. ROGERS. May I interrupt you there just a moment?

Mr. MCCABE. Yes.

Mr. ROGERS. Section 231 (c) says—

**especially made or especially adapted for use in an infringement of such patent.**

Mr. MCCABE. That is right.

Mr. ROGERS. Then it goes ahead and says—

**and not a staple article or commodity of commerce suitable for substantial noninfringing use shall be liable as a contributory infringer.**

Mr. MCCABE. That is right.

Mr. ROGERS. Now, the intent there is that where one especially makes it for the purpose of infringing a patent, if an individual did especially make an item for that purpose, for the purpose of infringing a patent, do you not think that the patentee should have some redress?

Mr. MCCABE. Provided it is especially made, but the point that I made in my last session with this committee on this last bill before this was that the fact that if you had a commercially noninfringing use it would relieve you of infringement. In this case you have added the words which say, "substantial noninfringing use."

If you will read my testimony in that previous case, and I would like very much for you to do that, because I believe you will catch the difference in the inflection on this, and noninfringing use in one case might relieve you of contributory infringement when you were not entitled to it. On the other hand it might convict you of contributory infringement in a case where you were perfectly innocent of any intent to injure the inventor. You have sold your product, but because the customer came in and asked you to put this particular thing on it that is not something you sell normally, you are no longer relieved of infringement.

It seems to me whether you have knowledge or not you have got to sit down and get the facts concerning that particular situation and not be governed by a statutory definition. For instance, in some of our transactions we will sell any number of items, $15 or $20 items that

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have been purchased especially under this construction of the words of the act, and they get on these devices. Now, there may only be one infringement, but the patent owner may have known of the infringement, and by what stretch of the imagination should we be held liable when they can reach the direct infringer? The original purpose of the bill H. R. 5988 said where it was not convenient to reach the direct infringer.

Here is a case which I think you will agree can be brought under this act as it is now stated. In other words it is possible where we sold to this man who said, "We have this chemical process," and if he buys a Mercoid switch which infringes, in that case why should the patent owner be permitted to sue us on that small item when he can reach the direct infringer?

Now, I invent something, but I cannot do everything in the world, I do not have all the knowledge and research, so why should I be subjected, or my company be subjected, to suit because it sold this thing when the purpose is to reach the direct infringer? The point is, why is this necessary to sue a contributor in order to reach these people who use these things? What about the individual part maker? Why should not there be some guaranty of protection to the man against such suits?

Mr. ROGERS. Do they attempt in the latter part of section 231 (c) to say that it does not apply to articles or commodities in commerce; do you feel that is not broad enough?

Mr. MCCABE. I feel that it is one in which there would be considerable dispute, because it says "substantially."

I point this out in connection with a case that was made, in connection with the phonograph record, Leeds & Catlin: Why put that word in the statute for something that I am not building if it is to relieve me from being a contributing infringer?

At the time I said I thought it was wrong. On the other hand, when you include the word "substantial" what constitutes substantial? Here is a case it seems to me where we have to leave it to the discretion of the court that can judge the infringer or the contributing infringer from the facts, and can handle them.

As it is now, it will be a statutory definition, which in my own mind will destroy or endanger small business in the merchandising of products, because I think it will be susceptible of interpretations that can endanger small business.

Mr. ROGERS. You told the committee about a suit that went to the Supreme Court?

Mr. MCCABE. Yes.

Mr. ROGERS. And you have in the past been bothered with suits evidently of that kind, that one particular suit. Would it increase or decrease the likelihood of suits if this section 231 were adopted?

Mr. MCCABE. I think you would find it absolutely would greatly increase them, because it is much easier to sue the man in small business, because he would not have the means to defend himself. For instance, in the chemical industry, how much would I know about the chemical industry, to know whether a product was this or that, when anything I might know about it would be without background particular to that field.

Now I have some 125 patents and I have not had to go to court except in one instance and the case was settled out of court—and may I stop

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long enough to say that I think most patent cases that reach the Supreme Court are of the doubtful validity type and I do not feel that all of them that go are justified in going there.

Now in case you throw the burden on us, for instance, to try to police the entire patent field and have knowledge of everything to avoid the pitfalls, it would be like buying this building from a stranger—it would not be a very good thing.

I hope I have made myself clear to you in my brief, as it sets up several cases and imaginary cases in order that you can see the way it will operate.

Mr. BRYSON. That is in your brief?

Mr. MCCABE. Yes, and I hope you will study it; you will see the error that has been made.

Another thing that should be limited in this matter of contributory infringement is the reference to any person who contributes to the infringement of a patent shall be liable as the infringer. Suppose in the case referred to it was found there was an infringement in a chemical process upon using a certain item. I think there should not be the right to sue the supplier of that item. The infringer is using it; it is something we have developed and made available to all industry. This is not a separate matter. And it would not be a matter of justice to hold the contributor for damages based on profits derived from the process, and not hold the direct actual infringers who might be able to avoid, for some reason or other, the financial responsibility. One person may be financially responsible from profits derived from the direct infringement while the other is not from the sale of the part. Why should he be held liable any time it goes on sale?

Mr. CRUMPACKER. Are you opposed to the whole doctrine of contributory infringement, or opposed only to the special language used here?

Mr. MCCABE. I am opposing the statutory definition, of the right of approval by the court.

Mr. ROGERS. Does your brief suggest any other language more desirable?

Mr. MCCABE. As I have said before, I am not enough of a lawyer to make definitions, I do not believe. I have not seen the definition that I feel is acceptable—I do not believe that the contributing infringer has been—well, I may say, I believe there have been cases which I think have consumed much time before they have been held to be contributors. And I feel that with the removal of the discretionary power from the court, where it must find contributory infringement—the court only has to find the facts, and then he is governed by section 244.

Now suppose I have a patent that is infringed, the infringer would have under section (c)—he would be held liable as an infringer without that provision in 244.

Mr. ROGERS. You would rather leave it to the court to determine who is the infringer?

Mr. MCCABE. I think the contributor should be held in these cases that are brought in good faith, although there is nothing here that guarantees against the abuse. It says:

> The court shall award the claimant damages adequate to compensate for the infringement.

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It does not say he may. It is my feeling it is a mistake to give the court in that section the directive to say the man has been damaged, and inflict damages upon the contributory infringer who is not the real culprit, you may say; it may be a chemical company which has no connection with it.

What I am trying to point out is there are cases where there is abuse, and if there is abuse then I would deal with it by the actual infringer. But a contributing infringer can be held for many times the profit that he himself could ever have earned or the plaintiff could ever have earned out of the infringement. To make it possible to allow many time the amount of profit in contributory infringement would be terrific.

I do not believe that was intended by the people who wrote this law; I do not think it should have that kind of interpretation. Whether the courts would do it I do not know.

I question personally whether this act to extend the patent beyond the monopoly of the invention or discovery, I question whether it is constitutional or not. I do not believe that the Congress—and let me say I respect, of course, the Congress—but what I am trying to say is what should be done and what could be done under the provision of the Constitution which provides that Congress has the power "to promote the progress of science and the useful arts by securing for limited times to authors and inventors the exclusive rights to their respective writings and discoveries." I do not think that when you extend this right it is within the scope of the constitutional powers granted.

Mr. BRYSON. We are very much obliged to you. We are called to the floor now. Due consideration will be given to your full statement and we will have access also to the statement you have made heretofore, year before last.

MAY 23, 1949

COMMENTS ON H. R. 3866 (81ST CONG., 1ST SESS.) DEFINING "CONTRIBUTORY INFRINGEMENT"

(Submitted by I. E. McCabe, chief engineer and chairman of the board of the Mercoid Corp., Chicago, Ill.)

I have previously studied the predecessor bill H. R 5988, and appeared before the subcommittee of the Committee on the Judiciary, House of Representatives, Eightieth Congress, to express my concern in the contents thereof. I find that the present bill H. R 3866 is identical with H. R 5988 and, therefore, take substantially the same stand in opposition thereto as with the previous bill

I have read the record made of the hearings before the committee on H. R. 5988 and have no issue to make with the proponents of the bill, as expressed in the record, with regard to defining contributory infringement in such a way as will restore the doctrine formerly announced in the Leeds & Catlin case without giving sanction to the abuses presently condemned in the misuse doctrine exemplified in the Carbice case

I am opposed to any bill which will extend the patent monopoly into fields of commercial staple goods and unpatented and patented articles consumed, used, or incorporated as component parts of a patented structure or process when such goods or articles are not made by the patent, distinguishable from other such goods capable of substitution beyond a change in physical form, or, by size or shape, or immaterial designs.

I do not believe the bill in its present form, nor, by any of the proposed amendments a matter of record in the earlier hearings, properly defines what constitutes contributory infringement.

In earlier days, in citing the Leeds & Catlin case, the United States Supreme Court, with reference to it, attributed certain specific characteristics to the ele-

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ment comprising that which one made and sold to become a contributory infringer (*Bassick Mfg. Co.* v. *Hollingshead Co.*, and *Rogers et al.* v. *Alemite Corp.*, 298 U. S. 415, 425, and *Lincoln Engineering Co.* v. *Stewart-Warner Corp.*, 303 U. S. 542, 552).

There the Court spoke of "Elements which were novel" and "neither of which possessed utility without the other," "each element was necessary to the operation of the other," "an entirely novel principle was disclosed, the disc not only performed a new function, but performed it in combination with another new element."

I do not believe that minor and insignificant changes to goods for the sole purpose of attempting to distinguish it from staple articles of commerce and where the change is not a requirement of the patent, make of such articles, things of the class of the phonograph record or disk as we know it today and which constituted the contributing infringing article of the Leeds & Catlin case. There the "elements" or "parts" making up the patented combination bore evidence in themselves of being novel—novel as a part as was the whole combination when assembled.

When an ordinary staple article of commerce can be made adaptable for use in a patented combination, not by any demand of the patent itself, but merely by an expression of choice by one who practices or promotes the practice of the patented invention I do not believe that in the light of the Leeds and Catlin case or the Kerosene Lamp case, later referred to, that such modified staple articles of commerce thus become "especially made" so as to be characterized as "Elements which were novel; not possessing utility without the other; performing a new function in combination with another new element, etc," such as could be ascribed to the disk of Leeds and Catlin or the burner mechanism of the patented lamp.

The kerosene-lamp patent, as explained in the earlier hearings on H. R. 5988, related to a combination of elements comprising a base, a chimney, and a new and improved burner mechanism. It has been pointed out that when one, not licensed to do so, attempted to make and sell all but the chimney and thus selling not the whole of the patented combination (all the elements of the patent claim) claim he did not infringe, the court found no difficulty in finding that what the defendant had done was a virtual infringement and held him liable. There certainly is no issue to be made with such a holding.

However, while this example was cited by a proponent of the bill to show the first case of contributory infringement arising out of selling a part of a whole patented combination, no one has raised the question as to the propriety of such a patentee attempting to so prevent the sale of the chimney. To be sure, like the phonograph disk, the new elements—the novel elements involved in the cited lamp case, were those unlawfully being made and sold, but what of the chimney? If the chimney were a standard article of commerce, would one be free to make and sell it for assembly in the patented combination? And, if the lamp base were so designed (not as required by the patent, but by choice of the manufacturer), the chimney would likewise have to be made special to be mounted upon it. This required shape of the chimney could thus then be said to be especially made and adapted for use in the patented combination, and so distinguish it from other commercially available chimneys: The necessary shape of the chimney base to fit the lamp base may be such as to render it without other use.

I do not believe that such a change in the character of a staple article of commerce reclassifies it as one which a patentee can expand his combination patent monopoly to cover There can be many instances where existing articles of commerce can be used, some of which I have had experience with, but which by necessitating some slight change the standard article becomes especially made to permit charges of contributory infringement to be made

The purpose of obtaining "use" or "combination" patents on the part of many is to attempt to obtain a monopoly in some element of the combination upon which he otherwise could not obtain one. It is an attempt to do that with a patent which otherwise he could not. If the kerosene-lamp patentee were a glass manufacturer, his interest could readily be in gaining a monopoly in the use of glass for manufacturing the chimney.

Mr. Swingle, as disclosed in the record of the hearings on H. R. 5988, contended the bill did not go far enough to leagalize a situation where a manufacturer of aluminum foil in developing a new use for the foil, such as in the making of milk-bottle caps, should be privileged to license out the patented method of cap making on the basis of a license grant requiring the purchase of

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aluminum foil from the manufacturer as a requisite to use of the patented cap making. If this were made possible, the aluminum-foil manufacturer could prevent the use of other aluminum foil by the cap maker and obtain in effect a monopoly on foil for that use, although a patent could not be had on the aluminum foil. Given enough use patents to acquire a large aluminum-foil volume, the aluminum-foil manufacturer could secure a monopoly in the manufacture of such foil as though he had a patent on it, since his patent-assured volume would sustain his unassured volume (not protected by patented use) to enable him to undersell his competitor in such markets to virtually obtain a complete monopoly.

The bill in its present form is intended to prevent this practice (Carbice doctrine) but with the "especially made or adapted for use" provisions, seems to provide a way for such practices to be legally restored, for the foil, as used in the patented way may be required to he of a special thickness or size to be handled by the machine not particularly required in that form elsewhere or it may be specially coated or carry imprint of customer indentification such that in that form its use in a patented machine would be marked.

It is my opinion that the real difficulty in defining contributory infringement resides in the way in which one can express what is to be understood as coming within the meaning of especially made and adapted for use in infringement of a patent and which will not grant more to the patentee than that to which he is justly entitled and which will not encourage abuses which through public resentment will bring damaging attacks upon our patent system.

It should not be possible for any interpretation to be placed on such a definition that would give to a patentee the right to embrace within his monopoly all or any of the elements or materials—old, unpatented, or patented—which become "especially made or adapted for use" by virtue of a choice or demand made by one practicing the patent. If the character of the thing used is determined by the one who practices or promotes the practice of the patent and not by virtue of the patentee through his patent teachings and from which novelty can be ascribed to it so that, as such, it becomes a requisite to the proper assembly or operation of the patent, I do not believe it should be as an element per se, a patentee's right to embrace it within his patent monopoly. If we adhere to defining elemtnts such as the phonograph record of the Leeds v. Catlin case, we shall be setting proper limits for those things which can be said to be "especially made, etc"

Without some limits to "especially made," enactment of such a bill into law would serve as a great incentive for groups of individuals or manufacturers to adopt and cause to be suplied to the public patented products not of themselves of great merit over unpatented products except that these things would be protected by patent whereby monopolies of one kind or another could he set up. As an inventor who has had many patents issued and is familiar with many patents issued to others, I can point out that one with knowledge of the art and a resourceful mind can readily patent many inconsequential arrangements upon which patents can nevertheless be obtained for such exploitation even though they may not represent a great advance in the art.

There is one other aspect to this objection to including "elements," not properly defined, within the patentee's patent monopoly. This is with reference to the public's rights.

In many instances, the "element" of a combination patent which a patentee may charge when sold, as contributing to infringement is, per se, patented by another. As long as the element, per se, remains patented, both patentees may deal with one another on a mutually agreed basis. The exclusive rights granted to a patentee expire after 17 years and thereafter it becomes the property of all the people. Assuming that the combination patent was granted at a later date, both the patentee on the element, per se, as well as the public, may lose their rights in the element, per se, when the patent thereon expires. The patentee of the combination may thus assume a monopoly on a thing upon which a patent has expired. The patentee on the element, per se, who had to be respected by the other as long as his patent existed, may be forced to pay tribute after his patent expires. The public may well be obliged to pay more for an item upon which, per se, a patent has expired than they were obliged to pay before, for competition may well he lessened if not removed.

I believe that we should also give consideration to the effect of a definition of contributory infringement upon the replacement of parts in a patented combination. Would the definition wipe out the present rule that an expendable element in a patented combination may be replaced without infringement? It

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is conceivable that if it did, it would become highly profitable for some companies to accept recognition, or a pool, of certain patents as a means of becoming the sole source for parts in the repair of their products. What this could mean in cost to the public and the effect upon competitive parts makers today is not difficult to imagine. One need not look further beyond the automotive field, radio, and home-appliance goods, to realize the possibilities and the effect of dealing only with designated suppliers.

I have tried to point out possible effects of the proposed bill based upon personal knowledge and experience with the patent system. In 1913 I applied for my first patent, and since that time more than 125 patents have carried my name. More than 80 of these have not expired, and I still have pending applications and new inventions on the way. The greater majority of my inventions have attained commercial use, and I have been further associated not only with their development, but with the manufacture, exploitation and sale of my inventions as chief engineer and chairman of the board of the Mercoid Corp., Chicago, Ill. I have also had experience with patent litigation on numerous occasions during the past 25 years.

The Mercoid Corp.'s business is based on patents, the rights thereunder being obtained by license with others and myself. As an individual, I have never chosen nor deemed it necessary to file suit for infringement of any of my patents, except in one instance on a joint invention many years ago in which case the defendant agreed to cease the infringement. The Mercoid Corp., however, has not escaped suits for infringement and is fully conscious of the varied attempts to utilize patents to control the sale of various commodities. The corporation's successful defense of such suits has not been limited to the principle upon which the United States Supreme Court decided the recent Mercoid cases, but rather, in the other instances, on the ground of invalidity and noninfringement.

The late Judge Evans, United States Circuit Court of Appeals, Seventh Circuit, in his study of the disposition of patent cases by the courts shows a total of 462 opinions from October 1936 to May 1941. During that period more than 900,000 patents existed, including expiring and issued patents.

Of the patents in litigation, about three-fourths were held invalid or not infringed, so that it is good reason to conclude that the defendants' reasons for fighting infringement suits were not frivolous, and it is therefore to be expected that the outsome of such suits can be adverse to the patentee for the Patent Office when granting issue of the patent may not have available that information in the hands of people familiar with the art.

There were 81 cases held valid and infringed or less than 1 in 11,000 patents and assuming these to have been deliberate infringements, it can still be said that there is strong approval and respect for the inventor and his patent. There are more than 600,000 patents in force and nearly 150,000 pending applications with a rate of filing of patent applications greater than ever showing that we have a healthy and active group of inventive forces operating under our present system.

As much as it may be desirable on the part of some to have a statutory definition of contributory infringement, I view with much skepticism the attempts to so define it and with great apprehension the results which may follow the enactment of the chosen worded bill. This patent system of ours, it would appear, seems to be functioning quite well, and nothing seems to have particularly stifled the inventive minds of the Nation either by virtue of a questionable degree of reward which a patentee may expect or by the method to which he may have to resort to exploit his patented invention.

Mr. McCARE. I am sorry. I thought perhaps you might want to ask me more questions, because I am very sincere in trying to be of assistance in the sense of getting a good revision. I hope you will remove the objectional provisions in section 231 (b), (c), and (d) in the bill.

Mr. BRYSON. Thank you very much.

Without objection the committee will resume its hearings at 2 o'clock.

(At 12:10 p. m. a recess was taken until 2 p. m. of the same day.)

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AFTERNOON SESSION

The committee reconvened at 2 p. m. at the expiration of the recess.

Mr. BRYSON. Come to order, please.

Captain Robillard, will you come forward, please?

## STATEMENT OF CAPT. GEORGE N. ROBILLARD, UNITED STATES NAVY, APPEARING FOR THE DEPARTMENT OF DEFENSE

Captain ROBILLARD. Mr. Chairman, I only want to take about a half minute. Yesterday I discussed the eight suggestions the Department of Defense had to make, but I failed to note in the record that we otherwise approve the bill.

Mr. BRYSON. Thank you so much. When you say "we" whom do you mean?

Captain ROBILLARD. The Department of Defense approves the bill.

Mr. BRYSON. You speak for all three of the branches?

Captain ROBILLARD. I am representing the Department of Defense—the Army, Navy, and Air Force.

Mr. BRYSON. We are glad to see that they finally are coordinating.

Captain ROBILLARD. It happens occasionally.

Mr. BRYSON. Mr. Rich, we spoke to you informally before the noon hour. Will you come forward, please, and identify yourself for the record? Give your name and in what capacity you appear.

## STATEMENT OF GILES S. RICH, ESQ., NEW YORK, N. Y.

Mr. RICH. Mr. Chairman, my name is Giles S. Rich and I am from New York. I am a practicing patent lawyer and have been in practice for 21 years. I appear here as a member of the advisory committee of the Coordinating Committee of which Mr. Ashton spoke in his testimony.

As you will recall he also stated that I am and have been a member of the drafting committee which assisted in the preparation of the suggestions which the Coordinating Committee submitted to the counsel for your committee.

Mr. BRYSON. Do you have a prepared statement?

Mr. RICH. I do not have any prepared statement.

Mr. BRYSON. All right, sir; you may proceed.

Mr. RICH. I have been asked to address my remarks to section 231, which is the infringement section of this bill. I should perhaps explain why I should be selected to deal with this particular part of the bill. I am, of course, very familiar, due to my activities on the Coordinating Committee, with the very great amount of work which has gone into the entire bill on the part of the committee counsel and the Coordinating Committee and all of the associations which worked independently and sent the fruits of their labors to the Coordinating Committee.

I also know, of course, how the labors of the Coordinating Committee commenced on the basis of your committee print which was prepared after studies of all the legislative proposals of the past 25 years.

The infringement section, however, has perhaps received even more consideration than any other part of the bill. As Mr. McCabe pointed

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out to you this morning, much of section 231 is based upon two prior bills which were considered in two previous Congresses—H. R. 5988 of the Eightieth Congress and H. R. 3866 of the Eighty-first Congress. Those bills dealt specifically with a subject which your reporter has recorded in reporting the testimony of these hearings as contributory fringe.

Mr. BRYSON. With the fringe on top.

Mr. RICH. I can also recall having made a valiant effort to explain in previous hearings on one of those bills what the difference was between contributory infringement and contributory negligence. Somebody wanted to know who contributed to what. So perhaps I should state at the outset that wherever there is contributory infringement there is somewhere something called direct infringement, and to that direct infringement someone has contributed. It is a very different thing from a concept like contributory negligence. And it is an old doctrine that has been in the law for some eighty-odd years.

In 1897 in a well-known case, *Thompson-Houston Electric* v. *Ohio Brass* (80 Fed. 712), the then Judge Taft said of this doctrine:

> If this healthful rule is not to apply to trespass upon patent property, then indeed the protection which is promised by the constitution and laws of the United States to inventors is a poor sham Many of the most valuable patents are combinations of nonpatentable elements and the only effective mode of preventing infringement is by suits against those who, by furnishing the parts which distinguish the combination, make it possible for others to assemble and use the combination and who, by advertisement of the sale of such parts and otherwise, intentionally solicit and promote such invasions on the patentee's rights.

Now, Judge Taft was on very sound ground in making those statements.

Mr. BRYSON. That was Judge William H. Taft?

Mr. RICH. Who was subsequently President of the United States.

Mr. BRYSON. Was he Chief Justice then?

Mr. RICH. At that time he was on the Circuit Court of Appeals, I believe of the Sixth Circuit.

Mr. BRYSON. We frequently hear his name, or the family name, mentioned here on Capitol Hill now.

Mr. RICH. Coming specifically to 231, which I have called the infringement section, it seems to me that this is a codification of the finest kind. It does not deal exclusively with contributory infringement, but with the whole subject of infringement which is a logical part of any codification of the patent laws. You will observe that it begins with section (a) in which infringement generally is for the first time set forth in any patent statnte. The laws that we have now say nothing whatever on the subject of infringement. They simply create a right and leave it to the courts to enforce it. But section (a) deals specifically with the matter and says what shall be infringement. That, of course, is direct infringement, which is the making, using, or selling of the patented invention without permission.

Then if you go over to section 241, in the next subsection of this bill, you find it states what remedy the patentee shall have in case of infringement. So it is a very neat and logical arrangement.

Now, the origins of the rest of 231 are to be found in these two previous bills which I mentioned. And I will not go into great detail about them, because the hearings were published, and I presume it was because I testified at some length on both of those bills that I was

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asked to deal with the subject here today. Paragraph (b), (c), and (d) can be compared with the old bills in this fashion: Paragraph (b) of H. R. 3760 comes from the first section of the old bills, which had no number, and provides that any person who shall actively induce infringement of a patent shall be liable as an infringer.

In the old bills section 2 was purely introductory, and then we had sections 3 and 4. Now, those sections have been very neatly combined by your own committee counsel into the single section (c) of the present bill. We previously had a positive statement coupled with negative statement looking at the opposite side of the situation, and your counsel felt that that was an unnecessary thing to do. You could just as well say what it was and be done with it. And it has turned out very nicely.

Section (d) comes from section 5 of the old bills and deals with a topic which has come to be known in the patent law as the misuse doctrine, and I will have something to say about that in a moment.

I would like to say why I think this is codification of the finest kind. We do have in the law the doctrine of contributory infringement at the moment. In the last case in the Supreme Court, by which some people think the doctrine was abolished, it was actually specifically recognized by the Court. Only they said they couldn't apply it.

On the other hand, we have the conflicting doctrine called the misuse doctrine, and we have to deal with both of them if we are to tackle the problem at all.

In the cases known as the Mercoid cases the doctrine was to a large extent upset and rendered obscure. In the course of testimony on these previous bills it became unquestionably clear that there was a great deal of disagreement about the state of the law. How much contributory infringement do we have? Do we have any? The very decisions out of which this confusion arose, the Mercoid cases, show that there is confusion because the Mercoid case was decided by a divided Court in a five to four opinion, and the Court managed to render five separate opinions. There was one majority opinion by Mr. Justice Douglas in which Justices Stone and Rutledge concurred. There was a separate concurring opinion by Justices Black and Murphy and there were three separate dissenting opinions, the first by Justices Roberts and Reed, the second by Justice Frankfurter, and the third by Justice Jackson.

That opinion itself left things in a rather confused state.

Now, it was not an easy task for even the experienced members of the patent bar to take this situation and try to clarify it and codify it because the courts had not laid down any clear-cut line. That is the problem with which we wrestled. What we have been trying to do all along is to pick a sensible line in accordance with public policy as it seems to exist today, and to make it as clear as we possibly can. And that I think we have done within the limits of the English language. You cannot deal with situations which are, of necessity, going to vary and make language so clear that it is beyond any interpreting at all. That is what we have courts for.

But I think with all the work that has been done in the course of these 4 years since the introduction of the first bill on contributory infringement, that we have come up with a solution which suits practically everybody.

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Now, I do not want you to get the impression that this is a controversial matter. I think the fact that at the last Coordinating Committee there was practically no controversy at all should carry a lot of weight. There was much discussion about a couple of changes of language. I don't think there is any question whatever about the desirability of dealing with this subject, and trying to clarify it, because nobody could say that they do not want the law made as clear as possible except those elements of society whose interests it is to keep things in a state of confusion.

Now, as to our solution, I think that if anything, it is on the ultra conservative side. This language has grown over the course of 4 years into a condition which has met with almost unanimous approval by the patent bar. It has taken a good deal of educating, it is a difficult concept to come to grips with. They call patent law the metaphysics of the law, and I would say that this contributory infringement business is the metaphysics of patent law. That is one reason I do not intend to go into it here today.

Mr. BRYSON. So it is the metaphysics of the metaphysics.

Mr. RICH. It is the meta metaphysics, beyond the beyond, you might say.

Mr. CRUMPACKER. Mr. Chairman?

Mr. BRYSON. Yes, sir.

Mr. CRUMPACKER. We have received protests from manufacturers of replacement parts for such things as automobiles, farm tractors, and the like, who evidently feel that the language used in this H. R. 3760 would make them contributory infringers of patents on the original article, the tractor or something of that sort.

Would you care to state your views on that subject, Mr. Rich?

Mr. RICH. Those were the most vociferous objectors to the old bills on the subject. Whether or not they would be liable would depend on the facts in each particular case. And I think that the best way to clear that up is to take up section (c) and deal with the matter specifically and point out to you the limitations that are there, which have to be met before anybody is held liable, and then leave it to you to decide whether a parts supplier should be held liable or not, depending on the kind of a part he may be supplying.

If the part he is supplying is in substance the very thing which was invented, it seems to me personally, that he is an infringer, and he should not be let off on some little technicality that there is something minor in the whole apparatus that he is not supplying.

Mr. CRUMPACKER. Now, to take specific examples, I presume that an automobile, a complete automobile, is not now and has not been for a good many years subject to a patent, although there may be some component parts which are covered by patents.

Mr. RICH. That is correct.

Mr. CRUMPACKER. Now, say you manufacture something like a crankshaft or a king pin or a spindle or spring or some item like that, for an automobile which in itself is not patentable, and the item itself is also unpatentable. How could there be any infringement of a patent? That is something I do not understand.

Mr. RICH. I don't either, because if the item itself is not patentable——

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Mr. CRUMPACKER. If neither the component part or the machine it goes into is patentable, I do not see where there could be infringement.

Mr. RICH. Neither do I.

May I read section 231 (c):

Whoever knowingly sells a component of a patented machine, manufacture, combination or composition, or a material or an apparatus for use in practicing a patented process—

and note the next phrase—

constituting a material part of the invention—

that means part of the inventive contribution that the patentee made, something new that did not exist before that came from him, and that is an important limitation which is in here which was not in the old bills—

especially made or especially adapted for use in an infringement of such patent—

another prerequisite—

and not a staple article or commodity of commerce suitable for substantial noninfringing use shall be liable as a contributory infringer.

I think that you would agree with me that just from the reading of that it is evident that that is an exceedingly restrictive provision.

Mr. CRUMPACKER. Could you cite me some specific example of what would be a violation of that?

Mr. RICH. Yes. With great pleasure I would like to give you what I believe is the latest case on this whole subject, for which I am indebted to our colleagues in Chicago. This is an oral opinion by Judge Barnes handed down on the 28th of May of this year in the case of Amalgamated Dental Co. against the William Getz Corp. in the United States District Court of Illinois, Eastern Division.

The patent involved in this litigation is No. 2,249,694, and it is for material for taking dental impressions.

Now, just let me explain generally what this patentee invented. You have all had the unpleasant experience of getting impressions taken with hot wax which makes your mouth burn, and with plaster of Paris which has to be knocked to pieces to be removed, and this patentee decided that he would produce a material which would set without either heating or cooling, and which would be elastic so that it could be removed without pain. And he succeeded in doing so, and apparently this is now a successful business.

The invention is claimed in two different ways: It is claimed as a method and it is claimed as a material The court in its opinion talks mostly about the method, but from a brief quotation from the opinion you will clearly gather the nature of the invention.

Or, perhaps it would be more clearly set forth if I read you one claim to the method.

Claim 1 of the patent says:

Method of forming a material for taking impressions which comprises mixing calcium sulphate with an aqueous solution of an alginate to form a stiff elastic gel.

Note the words "aqueous solution."

Mr. BRYSON. That is very plain.

Mr. RICH. In this method there is water involved, and likewise with the material claims an aqueous solution is called for. Other chemicals apparently could be added to this mixture which these

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claims I read describe in the simplest form, and you will see them mention in the opinion which says as to the defendant's contention:

> Now, here it is said that the method set forth in the patent in suit involves the use of water; that the plaintiffs, owning the patent, sell, generally speaking, sodium alginate, sodium carbonate, calcium carbonate and anhydrous calcium sulphate, or their equivalents and thereby grant licenses to—

I assume that is it—

> thereby grant licenses to dentists to use the method of the patent, which involves the use not only of those four chemicals sold, but also water, and thereby the plaintiffs are misusing the patent since they do not sell water—they are selling an unpatented article.

This is a fine contention under the Mercoid case. I would make it myself if given an opportunity. Anything recited in a patent claim which is omitted avoids infringement. That is a very old and well-established rule. And these claims include water in the expression "aqueous" and the omission of the water avoids infringement, at least direct infringement, and you have to rely on the doctrine of contributory infringement, although this case does not mention it by name.

Judge Barnes says:

> I decided the Mercoid case in the district court and I held the patent was misused there, and I decided the so-called Lecithin case, and that was another misuse case, and I held misuse there, and I am not unfamiliar with these doctrines—

but when he comes to this case, he says,—and this shows you the trouble the courts are having today:

> Now, I do not see the wrong in this case which I saw very clearly in the Mercoid case, and likewise saw very clearly in the Lecithin case.

And now for the students of jurisprudence he says:

> And since I do not see the wrong, of necessity, it is presented to me to find out some reason why I do not see it. And I guess the best reason which has been suggested is the water referred to in this patent is just an environment I guess that is as good a reason as anyone can suggest. I do not see why it is not valid.
>
> And at any rate it would seem to me to be absurd—it would just be reducing a very excellent rule to an absurdity—to say that this plaintiff is misusing its patent because every time it sells a mixture of sodium alginate, sodium carbonate, calcium carbonate, and anhydrous calcium sulfate, or their equivalents, it does not also sell a little water. I think that would be reducing the rule to an absurdity.
>
> And, as I say, the best reason that has been suggested to me as to why the rule does not apply is that the water just constitutes the environment in which these chemicals perform.
>
> At any rate, I do not think there has been any violation of the rule laid down in the Mercoid case.

Logically, he cannot get around the Mercoid case. What he says in effect is: "Let's throw the water out of the claim and treat the claim as though it did not have any water in it, and then we have a case of direct infringement, and we do not have to worry about the Mercoid rule."

That is the same sort of problem that hits the courts regularly every time they get a fact situation of this kind, and now they decide one way and now they decide another.

Mr. CRUMPACKER. Another example that occurs to me. That is the jet aircraft engine. I understand that most of the basic features of these engines are covered by English patents. I do not think



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any trouble will come up over it, inasmuch as assignments or agreements have been made for the use of the patent. I suppose if you were asked a question concerning some nut or bolt used in a jet aircraft engine, you would say that that is not an essential part or basic part, nor is it a key to the basic invention, so therefore the manufacturer of the nut or bolt would not be guilty of contributory infringement.

But, take for example the fuel-metering device which is manufactured by the Bendix Aviation Corp. Now, that, I would judge, would be awfully hard to say was not a basic part of the invention, because it was one of the key things that had to be developed in order to make a jet aircraft engine work.

Now, the Bendix Aviation Corp. may have a license on some of the British patents, too, but supposing they developed a jet fuel-metering device that was substantially different from any previously existing, and sold that to manufacturers of jet engines. Would they possibly be guilty of contributory infringement?

Mr. RICH. You have posed, sir, a very complicated question, which may be answered either way, and I am not trying to dodge the issue. But if the patentee invented the very fuel-metering device which Bendix chooses to manufacture without a license——

Mr. CRUMPACKER. That would be a direct infringement, of course.

Mr. RICH. But if this fuel-metering device is claimed in the patent in some language which says in combination, a combustion chamber which was old, a metering device of a specific character, and so forth, then the defense is, well, we do not sell combustion chambers, we only sell the metering devices, and knowing somebody else is going to put them in the combustion chamber, I would say perhaps it should be held to be an infringement.

But you have got to go into the facts, and the court has to go into the facts, and it is a question of whether it is a case like the first contributory infringement case that ever was decided, the old kerosene-lamp case, or whether it is like some of the other early cases.

Now, just let me give you two examples: You know what a kerosene lamp looks like, with a globe to hold the oils and the brass works and the glass chimney.

And in the first case, which is discussed in the previous hearings on the contributory infringement bills, the invention was in the brass works; they were sold, I believe, attached to the base, but without any chimney, and the claim in the patent included a chimney as a positive element. The defendant sold lamps without chimneys too, just the way the plaintiff did, and the defense was: "We don't infringe because your claim includes a chimney."

And the court said never mind this technicality, this is virtual infringement because when this lamp is sold there is a certain inference that somebody is going to put a chimney on it.

On the other hand, one of the next cases that came along, which is the first one in which the words "contributory infringement" were ever used, the device which was sold was a little relay which could be used in all sorts of places. And there was no proof connecting the sale of this relay with any direct infringement, and for that reason the plaintiff did not prevail. But even if there had been some such proof, it was still a common article of commerce, let us say, and many

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cases came along later dealing with articles of that kind holding that to let a patentee control the sale of common articles such as stove pipe and sheet iron and nuts and bolts would be too great an interference with trade and should not be tolerated.

This thought goes back to the very earliest days. It was lost sight of in the gay nineties, this doctrine became greatly inflated, it was greatly abused, the courts justifiably cracked down on it. The whole situation got a bad smell, and in due course, this new doctrine of misuse was evolved which sort of counteracted it, and we are today left with a dilemma which we are trying to straighten out.

Mr. CRUMPACKER. I was merely citing those examples to try and clear up my own thinking on the application of this section.

Mr. RICH. Well, in each case you would have to look at the details and see what was invented, and in effect whether the alleged infringer is appropriating somebody else's invention, or whether he is not. And the one thing we have definitely tried to do is to exclude the people who sell common articles of commerce, staples, things that had nothing to do with the invention, nuts, bolts, cement, sand, nails, lumber, even things especially adapted, as Mr. McCabe pointed out this morning, to fit things into other people's apparatus, unless they are a material part of the invention. And I think that Mr. McCabe has overlooked the fact that we have added those words to this statute.

I would just like to say a word about paragraph (d) of section 231.

Mr. ROGERS. Before going to that, may I make inquiry concerning section (c) of 231.

Do I understand that that is just an attempt to clarify what the judicial decisions have said constituted contributory infringement?

Mr. RICH. I could not say, sir, yes or no, because the judicial decisions have said so many different things at so many different times.

Mr. ROGERS. That is the point I am getting at.

Mr. BRYSON. There are many of them in controversy.

Mr. RICH. This field of patent law is the only one I know of in which the Supreme Court has specifically overruled itself.

Mr. ROGERS. That leads to the next thing.

Mr. RICH. That means that when you ask me a question like that I have to say: Of what period of time are you speaking?

Mr. ROGERS. This committee was given some information to the effect that this bill was merely a restatement of statutory law plus common accepted interpretations of the Supreme Court or higher court decisions, that in its nature, the entire bill should not be a controversial one. And we come to the question of infringement of patents, as set forth here in section 231, and we recognize that the law before was: That he who does infringe shall be liable under the court decisions, which takes care of section (a) as I understand it of 231.

And then (b) is one who induces another to infringe, why, he is liable as an infringer.

And under (c) we have, as you have testified, and many others, some decisions of the court that reached to a contributor. That is, one who sets about as you demonstrated, and in many other instances, to get around—let us put it point blank—that many people sit around and try to arrive at some manner and method in which to get around a patent.

Mr. RICH. May I say that section (c) does not primarily deal with that particular kind of a situation, it deals more with a situation

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where the economics of the industry is such, perhaps, that the invention is not sold in the form in which it is claimed in the patent; it is sold in a slightly incomplete form like the lamp without the chimney, so that there is a technical defense based on the omission of something mentioned in the claim. As in this O'Donnell Moulding Material case, the stuff was sold in the package as a dry powder which the dentist mixed up with water, but the water was included in the claim. So it was not an attempt by anybody to avoid infringement, it was a situation in which the patentee found it practically impossible to enforce this patent unless he could proceed against somebody who was not technically a direct infringer, but who was a person who did everything calculated to bring about the infringement.

Mr. ROGERS. In that instance he would be a direct infringer and not contributory. Is that not the case that you illustrated?

Mr. RICH. Not under the technical interpretation of the patent law. The reason is that the defendant who is doing these acts is not making or using or selling the invention claimed in the patent, but something different.

Mr. ROGERS. Some part of it.

Mr. RICH. And the minute there is any difference between what he is selling or making or using and the claim language, then it becomes something other than a direct infringement and you have to put a different label on it, and it is called contributory infringement. And the important thing that the courts all seize upon and the thing that makes all the trouble is that the thing which does not meet the terms of the claim becomes "an unpatented thing."

Mr. ROGERS. I am not sure I follow you.

Mr. RICH. It is not covered by the claim, the claim doesn't fit. It is like a puzzle, you cannot put the one down on the other, and make them fit, there is a difference. The minute there is a difference, there is no infringement, therefore, you have to go after them under this doctrine of contributory infringement.

Mr. ROGERS. Have you seen them go after the one who, according to this definition, knowingly, prepares the article—and this article is a material part of it—for the special purpose of using it to infringe the patent. You make all those requirements necessary in order that he may be guilty as a contributor.

Now, were you present yesterday when the Justice Department man testified?

Mr. RICH. I was not present, but I know the testimony.

Mr. ROGERS. You know the testimony?

Mr. RICH. I have read it.

Mr. ROGERS. You know their thinking in the matter. It might lead to further antitrust violations, or monopolies. Have you any comments in that regard?

Mr. RICH. I do have comments on the statement, with which I do not agree with respect to its conclusions.

I do not agree that this section, if enacted, would extend the law of contributory infringement.

There again we have a point of view. If you take the point of view that there is no such things as contributory infringement today, then this bill would extend the doctrine by bringing it back into force to a certain extent. But as I remember the testimony of the representative of the Department of Justice on the second contributory infringe-

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ment bill, it was to the effect that the Supreme Court had not abolished the doctrine of contributory infringement, that it was still there for application in a proper case, and that is what we are trying to do in the bill, make sure it is there for application in the proper case.

Mr. ROGERS. Then I take it from your statements, that there is some difference of opinion among those engaged in the practice of patent law as to whether or not the Supreme Court in its decisions has done away with contributory infringement.

Mr. RICH. There is a great difference of opinion.

Mr. ROGERS. There is a great difference.

Mr. RICH. There is a great difference of opinion on the part of the bar and also apparently on the part of the judiciary, because down in the fourth circuit, in the case of *Florence-Mayor Nuway* v. *Hardy* (77 USPQ 439), the court held the defendant liable for contributory infringement and said the Mercoid case did not apply, and that the proper rule was that of *Henry* v. *Dick*, which was the case which the Supreme Court overruled in the Motion Picture Patent case, when it reversed itself as I mentioned earlier.

That is what they did there, and in correspondence with the attorney for the winning party in that case, he said to me flatly, "Obviously the circuit court did not properly apply the Mercoid case, and I am sure that if we had gone up we would have been reversed."

Mr. ROGERS. Then in effect this recodification, particularly as to section 231, would point out to the court, at least that it was the sense of Congress that we remove this question of confusion as to whether contributory infringement existed at all, and state in positive law that there is such a thing as contributory infringement, or at least it be the sense of Congress by the enactment of this law that if you have in the Mercoid case done away with contributory infringement, then we reinstate it as a matter of substantive law of the United States and that you shall hereafter in a proper case recognize or hold liable one who has contributed to the infringement of a patent.

That is the substantive law that we would write if we adopted this section 231 as it now exists. Is that not about right?

Mr. RICH. That is a very excellent statement, and I am very glad that you made it, because the opinion of all of us in the patent bar is that this is a situation in which the decisions of the court have left us so much at sea that only Congress can solve the problem.

Mr. ROGERS. Now, I, like Mr. Crumpacker have had some letters and pose this question: They place an interpretation on this to this effect: Suppose I were the manufacturer either through a special order or I had it in my regular order of business, maybe a staple article. Of course, if it is a staple article then it would not apply. But suppose he came in on a special order and told me that he would be using it, and by the use in a certain machine then I would have an obligation to go and ascertain whether or not it violated this patent or this machine that had been patented, and that that is an obligation that is placed upon me as the manufacturer and that never existed in the law before.

Now, could you enlighten us as to what obligation the manufacturer may have had to make an investigation of that situation prior to the Mercoid case or afterward?

What I mean by that is: Did he, prior to that time, lay himself liable as a contributory infringer prior to the Mercoid case or had his status changed any by the Mercoid case, or would that depend upon

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the interpretation that you have illustrated here, that one set of the members of the bar say that it has done away with contributory infringement and the other says that it has not. And this is just merely for the purpose of trying to clarify it. But in the clarification, does it place the manufacturer of these articles under any greater handicap than he had before if this was passed as a law?

Mr. RICH. I don't think it places him under any greater handicap than he was under for a long time.

As I suggested, in the old days, back before 1917, say, there was a contributory infringement doctrine which really flourished. Almost anybody who made any part of a patented invention, especially an element of a combination, might be held liable. And business lived with this for 25 years without much trouble. I don't think he is under any greater handicap than every businessman is under in taking the risk of infringement every time he makes anything.

There are ways of finding out, and he is certainly not terribly handicapped when he has to go and do this knowingly. He has to know what he is doing this for, and then if he is doing it knowingly, he only has to consult his counsel as to whether what he is supplying constitutes a material part of the invention, and so on, complying with the rest of (c). And this is an ultra conservative type of contributory infringement. You have to balance the equities in this situation. It puts a little hardship on some businessmen to find out what their patent was. But on the other hand, remember this: there may be twenty or thirty percent of all the patents that are granted that cannot practically be enforced against direct infringers because of the nature of the invention and the way it is claimed in the patent.

Like this dental compound, it is simply not feasible to go around the country suing every dentist who buys a package of this stuff, and the practical way to give the patentee some way to enforce this patent right that he has been given is to let him go after the brains of the enterprise, the person who is really responsible and not the innocent end user.

Mr. ROGERS. Well, I take it, then, that this would include the chemicals that you are talking about, that are necessary in a dental case, that if I manufactured one of them, and Mr. Crumpacker manufactured another and the chairman manufactured another, and you manufactured the fourth ingredient necessary to make this up, we are engaged in a business, probably making that particular chemical which we call a staple article.

Now, by virtue of the fact that the man has the patent on it, the rest of the world, if they want to, can go down here to the Patent Office and see that combination, and suppose that Mr. X then sees that combination and he then comes to me and the other manufacturers and buys in large quantities and proceeds to infringe the man's patent, and we know that when he buys it, that he is going to use it for that purpose.

Mr. RICH. You and each of you, it seems to me, are beyond question, specifically excluded by the language of paragraph (c).

Mr. ROGERS. Because we have a staple article or——

Mr. RICH. Yes; because what you are selling is not a material part of the thing which was invented, which was a combination of chemicals which has to be brought together from the ordinary sources of those chemicals.

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Mr. ROGERS. But here, I as the manufacturer—it may be a staple article and it may not—but I as a manufacturer of a certain part, have it to sell, and as I have pointed out the other four would have certain parts of it to sell, and in fact the man comes in and tells us what he is going to use it for. We then would knowingly sell him a component part of a thing that we know he is going to use to infringe a patent.

Mr. RICH. But you are still excluded because it is a staple. Either it is a staple or it is just a commodity of commerce, which has some other substantial noninfringing use.

Mr. ROGERS. Yes.

Well, then, you feel, when we sell a staple article or commodity of commerce, that any who have engaged in the business of handling those things, although we know the individual who purchased it is going to infringe a patent, that there would not be any liability on us, although we may have especially prepared that, or knew that it would be especially adapted for that purpose, that that would relieve the manufacturer from it?

Mr. RICH. I definitely do so feel. We definitely wrote this language to take care of the very situation which you have given us as an example: The chemical manufacturer who makes chemicals to order, knowing what is going to be done with them or not knowing what is going to be done with them. One of the worries of the chemical manufacturer is that his customers come in and say, "Make us up so-and-so, according to this description, and we won't tell you what we are going to do with it; it is none of your business."

Mr. ROGERS. Well, then, changing the subject for a moment, do you think that the adoption of section (c) of this section 231 will lead back to the practice that existed as I believe you said, back in 1914?

Mr. RICH. Well, not that far back. You cannot compare it to a definite era, but it would alleviate the confusion which has arisen as a result of the Mercoid case. This whole misuse doctrine began in 1932, I believe, in the Carbice case, where the dry ice was involved, and it would not touch the result of the Carbice decision.

There would be no possibility under this section of utilizing the patent to monopolize the sale of dry ice which was a staple article of commerce, or a commodity of commerce which had been known 80 years. It would still be misuse as in the Carbice case, even though this section were enacted.

Mr. BRYSON. Have you finished, Mr. Rich?

Mr. RICH. I was about to make one remark on paragraph (d) when we became involved in this last discussion, and all I want to say about it is this: It deals with the misuse doctrine, and the reason it is necessary is that the Supreme Court has made it abundantly clear that there exist in the law today two doctrines, contributory infringement on the one hand, and misuse on the other, and that, where there is a conflict, the misuse doctrine must prevail because of the public interest inherently involved in patent cases.

Other decisions following Mercoid have made it quite clear that at least some courts are going to say that any effort whatever to enforce a patent against a contributory infringer is in itself misuse. The cases are cited in the old hearings. Therefore, we have always felt—we who study this subject particularly—that to put any measure of contributory infringement into law you must, to that extent and to

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that extent only, specifically make exceptions to the misuse doctrine, and that is the purpose of paragraph (d).

It goes with, supports, and depends upon paragraph (c).

Mr. BRYSON. We are very much obliged to you, Mr. Rich, thank you.

Mr. RICH. Thank you, Mr. Chairman.

Mr. BRYSON. We will next hear from Mr. Fugate, of the Department of Justice. Will you come forward, please, and identify yourself for the record?

## STATEMENT OF WILBUR L. FUGATE, TRIAL ATTORNEY, ANTITRUST DIVISION, UNITED STATES DEPARTMENT OF JUSTICE

Mr. FUGATE. Mr. Chairman, my name is Wilbur L. Fugate, and I am a trial attorney in the Antitrust Division of the Department of Justice.

Mr. BRYSON. Do you have a prepared statement?

Mr. FUGATE. No, sir; I do not.

I just wish to amplify some of what Mr. Brown said yesterday.

Mr. BRYSON. Do you contemplate requiring much time?

Mr. FUGATE. No, sir; I do not believe so, particularly in view of Mr. Rich's comments.

I will address my remarks specifically to section 231, which he has just commented upon.

Mr. BRYSON. All right, you may proceed.

Mr. FUGATE. First, I wish to refer to the statement of the Department of Justice at the hearings on H. R. 3866 of the Eighty-first Congress ,a former bill to enact this doctrine of contributory infringement into law, and in substantially the same form as this bill.

The doctrine of contributory infringement arose out of a common-law doctrine that one who aids another in committing a tortious act may find himself guilty of a tort.

One case, at least, has defined "contributory infringement" as the intentional aiding of one person by another in the unlawful making, using, or selling of a patented invention.

It has been settled that there is no contributory infringement without direct infringement. It has also been settled, as Mr. Rich stated, that the sale of a staple article of commerce to a direct infringer does not constitute contributory infringement, even though the seller of a staple article knows that it is to be used in direct infringement.

So much for contributory infringement on the one hand.

The other doctrine which Mr. Rich mentioned is that of misuse of patents which has a long history. It was perhaps given body in the Mercoid decision. The "misuse of patents," insofar as it has anything to do with contributory infringement, is the doctrine that one who has a patent may not license that patent upon condition that the purchaser may not deal in goods of another; or, in other words, that the purchaser purchase unpatented supplies exclusively from the patentee.

A similar doctrine has been written into law in section 3 of the Clayton Act.

Now, the Mercoid case merely held that the practice in that case was substantially similar to this "misuse" doctrine, or this "tie-in clause" doctrine which the court had formerly announced. In the Mercoid case the patentee and his exclusive licensee had engaged in

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the practice of selling an unpatented Stoker switch together with a license that the sale of the Stoker switch gave the purchasers a license to use a patented furnace assembly.

Then, in order to enforce that practice, the patentee sued suppliers of the unpatented Stoker switch for contributory infringement.

Now, the Mercoid case merely held that where there is misuse of a patent, where there is, in effect, a "tie-in clause" arrangement, which is a misuse of patents, no recovery can be obtained even though contributory infringement exists. The Supreme Court in the Mercoid case assumed that contributory infringement did exist.

Now, at the hearings of H. R. 3866, the Department submitted a list of cases subsequent to the Mercoid case in which it seemed—to us, at least—to be apparent that there was no confusion as to the doctrine of the Mercoid case, where contributory infringement did exist, and no misuse existed, why then there was no obstacle to recovery; but, where the patentee was misusing his patent, he could not recover even though contributory infringement did exist.

Mr. ROGERS. Pardon me for just a moment. Do I understand that your interpretations of the present decisions are to the effect that the Court does recognize contributory infringement?

Mr. FUGATE. Yes, sir.

Mr. ROGERS. As a cause of action?

Mr. FUGATE. Yes, sir.

Mr. ROGERS. And that this definition of "contributory infringement" is any different from that recognized in the decisions?

Mr. FUGATE. Yes. We believe that the definitions are considerably different.

Mr. ROGERS. Would you point that out?

Mr. FUGATE. I will point those differences out. I will divide it into two phases, if I may. First, the definition of "contributory infringement" proper and then the provision relating to the misuse doctrine.

You were interested, Mr. Rogers, a while ago as to whether or not someone who knowingly sold an article, especially adapted for use in a patented combination, could be guilty of contributory infringement even though he did not know it was to be so used.

Under the present law, I do not believe that he would be guilty of contributory infringement.

In that connection, I might cite the case of Lane against Park, 49 Fed. 454, in which it was held that a manufacturer who cut metal plate according to a pattern and ordered by a buyer for infringing use was not himself guilty of contributory infringement in the absence of knowledge of the purpose for which the metal plate was to be used.

I believe that represents the law on that subject.

Now, as to the fact that the article is especially adapted for infringing use, I wish to quote from the old case of *Henry* v. *A. B. Dick* (224 U. S. 1) a case which was overruled as to the misuse doctrine but not as to this particular statement. The Court in this case said that such a "presumption"—that is, the presumption that if an article is especially adapted for use in an infringing manner there is an intent that it be so used—"arises when the article so sold is only adapted to an infringing use."

You will note that it is merely a presumption and that, if the intent doesn't exist, at least under that case, here can he no contributory infringement; and I believe that is still the present law.

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Mr. ROGERS. Recognizing that the present law gives the cause of action against the one who has contributed to the infringement, I believe you take that position, although some of the members of the bar say that that is not the law. But, assuming that to be the law from the interpretations of the various court decisions, how does section 231 in any manner misstate that law or enlarge upon it and, if so, how?

Mr. FUGATE. I believe that it does. Sub-section (c) states that "whoever knowingly sells a component of a patented machine." Nowhere in subsection (c) is there any reference to knowledge that the component part is to be used in an infringing manner.

Mr. ROGERS. You think that the fact that it says "whoever knowingly sells a component of a patented machine" without also putting——

Mr. FUGATE. If that means that whoever shall sell a component part of a patented machine knowing that it will be used in a patented combination or something of that sort, why, I would think that it does state the present law. But I understood that Mr. Rich took the opposite view.

Mr. ROGERS. What I am getting at is that this section (c) says "whoever knowingly sells" and so on "for use in practicing a patented process, constituting a material part of the invention." Now, under that definition he has got to knowingly sell a component part knowing that it constitutes a material part of the invention.

Mr. FUGATE. That is why I am not clear as to the meaning. I am not sure that it means that.

In fact, as I understood from Mr. Rich, he doesn't think it means that.

Mr. ROGERS. As I understood Mr. Rich, he said that there were some who just felt that the Mercoid case did away with contributory infringement.

Mr. FUGATE. I don't believe the Mercoid case enters into this particular part. It may be a matter of language. At any rate, if this means "whoever knowingly sells a component of a patented machine" knowing that it is to be used in an infringing manner, why, I believe it states the present law of contributory infringement.

Mr. CRUMPACKER. It is purely a matter of semantics, as I see it. That is, the "knowingly" refers to the fact that it is to be used as a component rather than to his selling of it.

Mr. FUGATE. That is the question that I raise; yes.

Mr. CRUMPACKER. Your objection is to the phrasing of the thing rather than to the substance of it?

Mr. FUGATE. It is to the language.

Mr. CRUMPACKER. To put it differently, if the language means that the "knowingly" refers to the use of the article as a component part in some patented thing, then you say that it correctly states the law.

Mr. FUGATE. I believe so.

Mr. CRUMPACKER. Your objection is that you don't think the language clearly indicates that that is what the "knowingly" is supposed to refer to?

Mr. FUGATE. Yes, sir.

Mr. BRYSON. It seems to me that if he sells it at all he knows he sells it.

Mr. FUGATE. He knows he sells it; but, as in this case that I mentioned, the cutter of the metal plate according to a special pattern

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didn't know that that was to be used in an infringing manner, that it was to be used in a patented combination.

Mr. ROGERS. Inasmuch as you recognize that the law still gives a cause of action against the contributor who helps infringe, would there be any objection on the part of the Justice Department to clarify that law in definite words so that there would not be the confusion that the gentlemen have testified to? Or is the objection by the Justice Department to the fact that you are fearful that if this is in the law it may lead to monopoly and drive out those who may have the incentive to manufacture something new or comparable to the patented article?

Mr. FUGATE. I believe we oppose it for both reasons. The Department objects to writing the doctrine of contributory infringement into the law. It is not particularly a patent doctrine. It arises from a common-law source. Therefore, it doesn't seem to have any particular place in the codification of the law of patents.

Mr. ROGERS. You think that there is not a great deal of confusion among patent attorneys as to what constitutes contributory infringement; that is, more than as to what constitutes negligence in any ordinary damage suit, recognizing that it is impossible for us to write a rule of law for every rule of conduct of every individnal?

Mr. FUGATE. Yes, sir; that is the position.

Mr. ROGERS. For that reason any attempt to do it would not cover the entire field, and if this particular field were covered in some manner it would lead people to violate the so-called antitrust law?

Mr. FUGATE. Yes, sir. Our primary objection to section 231 is subsection (d); that is, the misuse doctrine. Now, at present under the Mercoid case, as I have stated, if there is misuse of patents, the patentee cannot recover either for direct infringement or contributory infringement.

Now, this section attempts to say that if there is contributory infringement the patentee may recover even though there is also misuse.

In other words, as I read the section, it would have the effect of wiping out a good deal of the law relating to misuse of patents, particularly with reference to tying-in clauses.

Mr. ROGERS. As I understood Mr. Rich, it was to the effect that this subsection (d) only went so far as to say that it is a misuse of a patent and that they couldn't recover and that it didn't go ahead and also make a contributor liable; or does it?

Mr. FUGATE. As I interpret section (d) it says that if there is contributory infringement the patentee may recover even though there is misuse. It says that if he seeks to enforce his patent rights against infringement or contributory infringement, that is, under 3 of subsection (d), reading from subsection (d), "The patentee shall not be denied relief or deemed guilty of misuse or illegal extension of patent rights."

Mr. ROGERS. Do you think there is any possibility that the Justice Department and the coordinating committee can arrive at a solution of this problem at all so that you may remove the confusion that you say exists?

Mr. FUGATE. I can't speak for the Department on that. I am sure that wherever there is a question of confusion in the law we are always willing to cooperate in any attempt to remedy it. We have taken the position that we don't think there is any confusion in the law in this

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respect, and even so we would be opposed to doing away with the misuse doctrine in preference to the contributory infringement doctrine.

Mr. ROGERS. In other words, you want the misuse doctrine to stand under the decisions as announced?

Mr. FUGATE. Yes, sir.

Mr. ROGERS. And you think that section (d) would change those decisions in certain respects?

Mr. FUGATE. Yes, sir.

Mr. ROGERS. And so far as you are concerned, you don't think that any confusion exists as to what constitutes contributory infringement under the present law?

Mr. FUGATE. Yes. I might also say that I think this section comes under the heading of a controversial issue. I don't believe that it should be included in a codification bill.

Mr. ROGERS. You say "controversial." As I understand the controversy, it is as to whether or not the Supreme Court still recognizes an action for contributory infringement. Now, you take the position that they still do recognize that and that there is no confusion as a result of their decisions.

Now, that is your position, is it not?

Mr. BRYSON. Although a recent decision was decided by a 5 to 4 division of the Court from which came five separate reports, and that fact does not indicate that there is any confusion?

Mr. FUGATE. That was the Mercoid case, I believe, which Mr. Rich had reference to and in which the opinions all agreed on the misuse doctrine.

Now, since that time the Supreme Court has affirmed the Mercoid decision in a number of cases.

Mr. BRYSON. Would you list them, please, for the record?

Mr. FUGATE. For one there is the *United States* v. *Line Material Co.*

Mr. BRYSON. How was the Court divided in that case?

Mr. FUGATE. I don't believe there was any dissent from the Mercoid case. That was 33 United States 287.

Another case is the *United States* v. *Paramount Picture* (334 U. S. 131).

I believe there are many others in which the Court cited the Mercoid case with approval.

Mr. BRYSON. Are there any other questions?

Mr. CRUMPACKER. Yes. You say that the Department is opposed to this subsection (d)?

Mr. FUGATE. Yes.

Mr. CRUMPACKER. In its entirety?

Mr. FUGATE. Yes; I believe so.

Mr. CRUMPACKER. You mean to say that a patentee should be denied relief because he has previously sought to enforce his patent rights against an infringer?

Mr. FUGATE. Not if he has been guilty of misuse of patents previous to that.

Mr. CRUMPACKER. It doesn't say that.

Mr. FUGATE. It says—

**no patent owner otherwise entitled to relief for infringement or contributory infringement of a patent shall be denied relief for or deemed guilty of misuse or illegal extension of the patent.**

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Mr. CRUMPACKER. And it names three things, the third of which is that he has sought to enforce his patent rights.

Mr. FUGATE. Well, now, if that is applied generally, it includes a case where there is a misuse.

Mr. CRUMPACKER. Why?

Mr. FUGATE. Because it is all-inclusive. No one shall be guilty of misuse if he has sought to enforce his patent rights against infringement or contributory infringement. As I read it, you might also add "even though he has misused his patent."

In the Mercoid case, for example——

Mr. CRUMPACKER. It says that he shall not be deemed guilty of misuse because he has done one of these three things. It doesn't say that he shall be deemed not guilty of misuse because he has done this. I think you are reading it backward. That is, he may have done all three of these things and still be guilty of misuse, as I interpret the language.

Mr. FUGATE. That is not the way Mr. Rich interpreted it. As I understood his testimony, he said that where there was contributory infringement the doctrine of misuse would be limited, that it would be an exception to the doctrine of misuse. That is also the way I interpreted it.

Mr. CRUMPACKER. It seems to me that the language is clear, and it says that he shall not be denied relief or be deemed guilty of misuse because of having done any of these three things. It doesn't say the reverse of that, that because of having done these things he shall be deemed not guilty of misuse.

Mr. FUGATE. In the Mercoid case a suit for contributory infringement was part of the general plan of misuse of the patent. In other words, that was part of the plan of operation, the sale of the stoker switches which were unpatented with the license to use them in a patented assembly. That license was given only to purchasers of the stoker switches from the patentee or his exclusive licensee. Any others were sued for contributory infringement.

Now, the Supreme Court held that that plan of operation was substantially the same as conditioning the licensing of a patent on the condition that the purchaser purchase unpatented supplies from the patentee.

Mr. ROGERS. You are objecting to section (d) because these three things indicate that if he should do any one of the three or all of them he could still recover. Subsection (1) says "derived revenue from acts which if performed by another without his consent would constitute contributory infringement of the patent." Subsection (2) says "licensed or authorized a person to perform acts which if performed without his consent would constitute contributory infringement of the patent."

Subsection (3) says "sought to enforce his patent rights against infringement or contributory infringement."

Now, in the misuse of patents have they taken those three items as outlined there and said that that constituted misuse of a patent and as a result have denied the patentee the right to recover? Have they heretofore had decisions to that effect?

Mr. FUGATE. I believe you are reading into that or rather interpreting that as meaning that a patentee shall not be deemed guilty of misuse of patents merely because he brings an infringement suit.

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Now, if that is all it means, why, of course, the Department doesn't oppose it.

Mr. CRUMPACKER. Do you find anything intrinsically wrong in any of these three acts enumerated there? Is the Department opposed to a patentee doing any of these three things enumerated in this paragraph?

Mr. FUGATE. As we read the section——

Mr. CRUMPACKER. Never mind the preamble. I mean just specifically those items enumerated, the three items. Does the Department consider any one of those acts as undesirable or contrary to public policy?

Mr. FUGATE. I do not believe you can read them without reading them in connection with the preamble. Of course, if you mean does the Department oppose a patentee suing to enforce his rights by either direct or contributory infringement action, of course, we do not oppose that. We have no objection to a patentee enforcing his patents.

However—and this is not only my interpretation—you have heard Mr. Rich interpret it as meaning that it makes an exception to the law of misuse of patents where contributory infringement exists. As I say, it is not only my own interpretation of the section.

Mr. ROGERS. If under the present law a man should do any one of the three things outlined in section (d), is he denied the right to recover because he may have performed one of those three acts?

Mr. FUGATE. Not in and of themselves.

Mr. ROGERS. What is that?

Mr. FUGATE. Not in and of themselves.

Mr. CRUMPACKER. How about a combination of the three or any two of the three?

Mr. FUGATE. Not having had any part in writing the language, I am not certain what it means. But I am convinced that upon Mr. Rich's interpretation and upon the interpretation which the Department of Justice has placed on it, it does seriously impair the doctrine of misuse of patents in favor of the doctrine of contributory infringements.

Mr. ROGERS. In other words, the Department's attitude is that it should be the duty of the Court to ascertain whether or not there has been a misuse of the patent?

Mr. FUGATE. Yes.

Mr. ROGERS. Without the Congress saying that if he has misused it in these three separate items—well, I will put it this way: You do not feel that the Congress should say that if he has misused it in these three ways that he should thereafter be permitted to recover if the Court should decide otherwise?

Mr. FUGATE. Don't misunderstand me, that I think that any of these things in and of themselves are a misuse of patents. All I am saying is that if misuse exists the Court should be able to deny recovery on the ground of misuse of patents despite the fact that contributory infringement may exist.

Mr. ROGERS. Do you know of any instances where the courts have denied recovery where a patentee has performed, by virtue of the fact that the patentee has performed any one of the three acts?

Mr. FUGATE. Well, the Mercoid case itself was a case where the patentee was attempting to enforce his rights in an action of con-

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tributory infringement. Now, as I read this section, he would have recovered in that case, in the Mercoid case, under this section.

Mr. ROGERS. If this section had been in the law expressed by Congress at the time the Mercoid case was decided, then by virtue of either one, two, or three, there would have been a recovery because it may have come within one of those?

Mr. FUGATE. All the patentee was doing there was seeking to enforce his patent rights against contributory infringement. He was denied recovery for infringement because he was misusing his patent. But all he was attempting to do was to bring a suit for contributory infringement, and the Court assumed that that existed in that case.

Mr. ROGERS. I may have misunderstood the Mercoid case. Wasn't it misuse because he was requiring the purchase of something for the furnace?

Mr. FUGATE. That was misuse, and the misuse was sufficient to defeat recovery for contributory infringement.

Mr. ROGERS. Do you think any one of those three items set forth in subsection (d) would fit into the Mercoid case in any manner?

Mr. FUGATE. I believe so.

Mr. CRUMPACKER. I would like to make the observation that this is one of the few points in this bill where the language is clear and unequivocal, and it seems to me capable of only one interpretation, and that interpretation is entirely contrary to that which the Department seems to be placing upon it.

Mr. FUGATE. I believe Mr. Rich placed the same interpretation upon it. I would like to ask him if that is his interpretation.

Mr. Rich, as you interpreted this section, it would make an exception of the misuse doctrine where contributory infringement existed?

## STATEMENT OF GILES S. RICH, NEW YORK CITY, N. Y.

Mr. RICH. I will agree with that to this extent: That as I testified it is necessary to make an exception to misuse to the extent that you revive contributory infringement in paragraph (c), and this whole section (d) is entirely dependent on (c). Where (d) refers to contributory infringement, it only refers to contributory infringement as defined in (c) and nothing more.

Mr. CRUMPACKER. In other words, all it says is that bringing an action against someone who is guilty of contributory infringement is not a misuse of the patent.

Mr. RICH. That is true. And there is a reason for this language. The reason is to be found in a decided case, *Stroco Products* v. *Mullenbach* (67 U. S. P. Q. 168), where a district judge out in California granted a motion for summary judgment of dismissal before trial on the ground that the complaint was merely an attempt to use the patents to maintain an unlawful monopoly of an unpatented article. The patent claimed a combination of elements for arc welding and the method.

The defendant sold control units for use in the combination and for practicing the method and furnished wiring diagrams, and advertised the use of his product.

Knowledge and intent on the part of the defendant were stipulated. He knew what his products were going to be used for. There was no evidence in the case whatsoever, there having been no trial, of any attempt to misuse the patent otherwise than by bringing the suit.

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The court dismissed the suit "according to the principles announced in Mercoid and for the reasons therein stated."

That is a clear case where merely bringing a suit against one alleged to be a contributory infringer was per se misuse of the patent. Now, that is about as far as the logic of the Mercoid decision can be carried.

Mr. FUGATE. The judge in that case had no trouble deciding that this was not misuse in bringing them to suit.

Mr. RICH. He held that the bringing of this suit was per se misuse. That was the end of it. You can't sue a contributory infringer—period.

There have been other cases like that. I have them here. *The Lincoln Electric Co.* v. *The Linde Air Products Co.* (80 U. S. P. Q. 59) is the same situation.

Mr. BRYSON. We have been getting along beautifully all during this hearing. It seems as though we have run into a period of confusion here. It might be like the judge down home of whom it was said that the more light you turned on him the blinder he got. That may be what has happened to the committee here. If you experts here in this particular field seem confused, imagine those of us who sit here and who have had no special training.

Mr. RICH. Mr. Chairman, you do not in the least surprise me; and if you have a minute it might help this committee and it might help the Department of Justice, if it is in an amiable mood, to know a little bit of the history of this section, which, as I said, came from those old contributory infringement bills.

The whole thing started in New York, not in Wall Street, but in New York where I come from.

Mr. BRYSON. Well, coming from the South, I would say that you come into court with unclean hands.

Mr. RICH. Now, we have a patent law association up there, as you have heard, which decided to tackle this problem of contributory infringement after the Mercoid decision and propose some legislation.

We worked on it through the Patent Law and Practice Committee for about a year and a half to 2 years before any bill was proposed. The origin of this contributory infringement section was a proposal made by Mr. Robert Byerly, as the older hearings show.

It just happens that contributory infringement has been a hobby of mine since the Carbice case was decided about 1932. I wrote an article on it at that time, disclosing that I hadn't the slightest comprehension of what the court had done. Therefore, I shall not even cite it.

Since then I have learned quite a lot.

Mr. Byerly wrote a proposal which was in substance along the lines of paragraph (c) which revived contributory infringement and which was submitted to me and to other members of the committee. I said, "That is fine, but it won't work because the reason we don't have contributory infringement is that every time you try to enforce a patent against a contributory infringer, the court says it is misuse and throws you out."

Now, the funny thing about all of these misuse cases is that what the defendant does has nothing to do with the decision. It is never a question of whether or not there was infringement. They don't decide whether the defendant is guilty or not guilty, whether he infringed or didn't infringe.

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They say to the plaintiff, "You are a bad boy, and you came here with unclean hands. You will not have the aid of this court of equity."

Nobody realized that this had happened until a suit was brought first against a contributory infringer and lost, whereupon the plaintiff's attorney said, "That is too bad, we will have to sue the direct infringer."

They sued the direct infringer, and the court said, "Too bad, you don't appreciate the ground of the earlier decision. It is the plaintiff's fault that he can't recover, not the defendant's, and it doesn't make any difference whom he sues."

Mr. ROGERS. Now, let me interrupt you there. I thought I asked the question whether or not the law gave a cause of action to the patentee against a contributor, one who contributes to the infringement, and I thought the answer was that in those cases they did have a cause of action. Now, was I wrong in getting that impression, that is, that there is an action, or that a cause of action exists at all where, in the proper cases, a man can contribute and can be recovered against?

Mr. RICH. I can only tell you that they do, even today.

Mr. ROGERS. All right, that is my impression as to the answer that was given. Now, following that, the next question is this: Would the fact that you then institute a suit against one who has contributed to the infringement result in a court automatically dismissing it because you have instituted a suit?

Mr. RICH. I can only say that they do. It depends on what court you are in.

Mr. ROGERS. What was that?

Mr. RICH. It depends on what conrt yon are in.

Mr. ROGERS. Well then, do they dismiss it, though, because the action has been stated?

Mr. RICH. Oh, no.

Mr. ROGERS. Or do they dismiss it because you have filed a lawsuit?

Mr. RICH. No. They dismiss it because in attempting to utilize the patent to cover something which it doesn't literally cover in its claims, you are thereby attempting to extend the monopoly which is contrary to public policy and constitutes misuse.

Mr. ROGERS. That would apply in all cases?

Mr. RICH. It can if the defendant's attorney raises the point and the judge is sympathetic. But if it is down in the fourth circuit where they are not sympathetic, they may just brush off a defense based on the Mercoid case.

Mr. ROGERS. Can you conceive of a set of facts whereby one may be an infringer and a patentee has not by any act of his performed an act that was contrary to public policy that would cause the court not to dismiss the lawsuit? Have we ever had a case of that character that you know of?

Mr. RICH. Not that I can recall specifically. The trouble usually is that the plaintiff is in business, and he has a patent which he thinks protects some aspect of his business. If he isn't in business at all and is just sitting there with a paper patent invention which has never been commercialized in any way, then he can hardly be guilty of unclean hands. That situation hasn't come up yet.

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Mr. ROGERS. As I understand so far, any action for contributory infringement has never been successful. Is that right or is it wrong?

Mr. RICH. The plaintiff has rarely recovered in an action for contributory infringement since the Mercoid case.

Mr. ROGERS. Well, at any time before the Mercoid case?

Mr. RICH. Oh, yes, of course. This doctrine has been in the law, as I said, for 80 years, and many patentees have recovered against contributory infringers.

Mr. ROGERS. All right, but since the Mercoid case have there been any recoveries?

Mr. RICH. Yes. In Florence-Mayo Nuway against Hardy, there was a recovery. That was in the Circuit Court of Appeals for the Fourth Circuit in 1948, I think.

In the Tenth Circuit in 1948, the case of *National Machine Works* v. *Harris* (79 U. S. P. Q. 350), there was a recovery.

Mr. FUGATE. May I just read from that case Mr. Rich mentioned. Maybe it will clarify the issue a little bit. Judge Phillips said:

> It is urged that Gerner and National should have been denied relief under the doctrine announced in *Mercoid Corporation* v. *Mid-Continent Company* (320 U. S 631). In the instant case Gerner and National are using the patent not to monopolize the sale of what is not patented, but to prevent Harris and Calhoun from infringing and aiding others to infringe what is patented, Harris and Calhoun would be guilty of contributory infringement.

That is one of the cases that I believe we cited in the last hearing as indicating that the doctrine of contributory infringement still existed.

Mr. ROGERS. It does still exist, and Mr. Rich's thought is that if the man is ever engaged in business, since the Mercoid case, he may have committed some act that is contrary to public policy and the court would deny him relief because of that act.

Mr. FUGATE. Now, that comes down to what the court decides is or is not the misuse of patents.

Mr. ROGERS. Yes.

Mr. FUGATE. Mr. Rich mentioned the Carbice case. The Carbice case, I believe, was the case in which contributory infringement was defeated, not from the misuse angle, but because the component part was really a staple article of commerce, and therefore it wasn't contributory infringement at all.

In fact, when the court in the Mercoid case refers back to the Carbice case, they say that the doctrine of misuse hadn't been enunciated at that time.

Mr. RICH. May I participate in this dialog which I greatly enjoy because I teach patent law?

Mr. ROGERS. You probably have some apt pupils here.

Mr. RICH. Carbice was historically the first case of misuse, although the word is not used in that case. The reason for the decision in favor of the defendant is stated in these words:

> Relief is denied because the Dry Ice Corp. is attempting, without sanction of law, to employ the patent to secure limited monopoly of unpatented material used in applying the invention.

That is the key to that case. It was affirmed and explained again shortly thereafter by the same court, the same judge, in Lutch versus Barber, where they were selling asphalt emulsion for curing roads. There was a patented process for curing the roads, and the asphalt

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emulsion was old stuff. They said in effect, "The same reason, relief denied, no distinction."

Mr. ROGERS. I thought I had a clear understanding of the question. We do recognize that there is a cause of action for contributory infringement. Now, that is admitted. But the Mercoid case, as I understand it, was decided on the theory that the patentee was misusing his patent and, therefore, although one may have contributed and been guilty as a contributory infringer, nevertheless relief was denied because of the misuse of the patent.

Mr. RICH. That is correct.

Mr. ROGERS. That is correct up to that point?

Mr. RICH. That is exactly in line with Carbice, which, of course, is the case on which the Supreme Court was relying.

Mr. ROGERS. All right. Now, due to what many members of the patent bar believe, that it did away with contributory infringement cases, you feel that we should now state as a positive law a cause of action against contributory infringement as set forth in section (c), and that if he has done one of the three things in section 4, that shall not be considered a misuse of his patent, and thereby reestablish what you thought you had before the Mercoid case. Isn't that about what the situation is?

Mr. RICH. That is what we are driving at. I appreciate now that I never finished the statement I intended to make when I got up here, the history behind the reason for paragraph (d).

When the proposal was made to reenact contributory infringement or the equivalent of paragraph (c), a simple enactment, "this shall constitute contributory infringement," I pointed out to the author that it wouldn't work because contributory infringement was still with us as a legal doctrine. The only reason the plaintiff got no recovery was that he was held guilty of misuse.

So this, like the cat in Alice in Wonderland that was there but disappeared all but its smile, to be brought back and have a body again, meant that you had to do something about misuse. You had to say that insofar as we want contributory infringement back, the act shall no longer be labeled as misuse, thus throwing the man out of court.

So attached to paragraph (c) we have a paragraph (d) that says that the recovery, the enforcement against contributory infringers, the holding out of the patent against contributory infringers, and granting them licenses, the use of it to protect the business and making money out of it, and getting your reward as a patentee, all of these things shall not be misuse, and then contributory infringement, which we have had all the time, would become effective again to the extent that they wish to have it so.

Mr. CRUMPACKER. Well, as you interpret this paragraph (d), would it in any way prevent a court from holding the monopolistic practices referred to as being misuse of patents?

Mr. RICH. I beg your pardon, sir? I was distracted.

Mr. CRUMPACKER. As you interpret this paragraph (d) as it now reads, would it in any way prevent a court from holding the monopolistic practices referred to as being a misuse of a patent? That is, where a patentee had actually been engaged in trying to gain a limited monopoly of unpatented articles through the use of a patent.

Mr. RICH. If we assume that staples are excluded from paragraph (c)?

Mr. CRUMPACKER. Yes.

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Mr. RICH. The answer is that (d) would not prevent their being held, the acts being held to be misuse.

Mr. FUGATE. I might point out that in the Mercoid case the stoker switch may not or may have been a staple article of commerce especially adapted for use in a patented combination. In other words, it was contributory infringement. The court recognized that. However, as Mr. Rich pointed out, it was the action of the plaintiff which made him ineligible to come into court and recover for contributory infringement.

Mr. ROGERS. May I ask this further question? Do you know of any case where the plaintiff was denied relief because he had accepted revenue from acts which, if performed by another without his consent, would constitute contributory infringement of the patent? That is number one.

Mr. RICH. The Barber Asphalt case, I think is typical of that, and to some extent the Carbice case. In the Carbice case there was a form of license on the invoice. In the Barber Asphalt case they tried to distinguish on the ground that they had no agreements with anybody, so that what they were doing was deriving revenue in the form of profits from the sale of the unpatented staple commodity for use in the invention.

Mr. ROGERS. So the court then said that that act constituted something leading toward monopoly or contrary to public policy, and for that reason denied relief to the plaintiff?

Mr. RICH. That is correct.

Mr. ROGERS. Now, as to No. 2, are there any cases where licensed authorized persons performed acts which, if performed without their consent, would constitute contributory infringement of the patents?

Mr. RICH. Well, that is the Mercoid type of situation.

Mr. ROGERS. Yes.

Mr. RICH. It must, of course, be realized that if we had had a statute like this, the Mercoid case might have been tried differently, on a different theory. But it deals with granting licenses to people who would otherwise be contributory infringers, not direct infringers, because they are only making part or less than the whole of the invention.

Mr. ROGERS. Well now, do you know of any case where they have denied relief to the plaintiff where he had sought to enforce his patent rights against infringement or contributory infringement on this section 3?

Mr. RICH. Do you mean section 2, licensing?

Mr. ROGERS. No, section 3 of (d).

Mr. RICH. That is sought to enforce?

Mr. ROGERS. Yes.

Mr. RICH. That is the *Stroco Products* v. *Mullenbach* case.

Mr. ROGERS. Then the effect of (d) with the (3) in there would be to say to the Supreme Court that it is the sense of this Congress that where you have heretofore denied relief to the plaintiff, you shall henceforth grant him relief if he has only performed one, two, or three of these acts in (d), and that is why the Department of Justice is objecting to it?

Mr. FUGATE. Yes, sir.

Mr. ROGERS. And it would therefore necessarily follow that by taking (c) and (d) together we are asking the Supreme Court to not

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follow the line of reasoning of declaring that a man shall be denied his day or damages if he has done any one of these three acts. Isn't that what it amounts to?

Mr. RICH. That he shall not be denied his day or damages merely because he has done one, two, or three, or all of these acts if the contributory infringement referred to in (d) is of a type which falls within the specific terms of (c).

Now, a suggestion has come to me during this discussion which may bring the views of Justice and of the patent bar together. That would be to insert in the third line of paragraph (d) before the last word "by" the word "solely" so that he shall not be deemed guilty of misuse or illegal extension of patent rights solely by reason of his having done one or more of the following.

If he has gone beyond those and done other acts which could be misuse, then the misuse doctrine would be applicable.

Mr. ROGERS. But then even with the word "solely" we would still say to the Court that if he had done one of these, he could now be permitted to recover?

Mr. RICH. If he has not misused it otherwise. If it comes within the terms of (c). If he tries to license somebody, for instance, to manufacture a staple article of commerce, to be sold in a patented invention and collect royalties, let us say, for the manufacturing of salt tablets to be used in a patented vending machine or dry ice to be used in a patented shipping container, that will be misuse because it doesn't come within the terms of (c).

Mr. ROGERS. I might ask the further question as to whether you think we have a very good chance of explaining all of this on the floor of Congress in trying to recodify the laws of patents?

Mr. RICH. No comment.

Mr. BRYSON. Any further questions?

Mr. RICH. I think there are many other sections in the law which you would have difficulty in explaining on the floor of Congress, too.

Mr. BRYSON. Mr. Crumpacker has some questions.

Mr. CRUMPACKER. Referring again for a moment to paragraph (c), do you think it is possible that the phrasing could be improved upon there to remove the possible misinterpretation referred to?

Mr. RICH. I don't know.

Mr. CRUMPACKER. Particularly with respect to the word "knowingly" and as to what the word "knowingly" refers to.

Mr. RICH. I think it is clear to most of us that "knowingly sells a component of a patented machine" means to us that you know that the component is going into that machine. You don't have to know that it is patented. You don't have to know the number of the patent, and you don't have to know that the machine that it is going into constitutes an infringement. You just know its ultimate destination.

Mr. CRUMPACKER. But the way it is phrased the word "knowingly" refers directly to the word "sells."

Mr. FUGATE. As I understand it, Mr. Rich only intends it to refer to the word "sells." The one who sells it need not know that it is to be used in a patented combination.

Mr. CRUMPACKER. As I understand it, the wrong that is supposed to be committed is the knowledge that it is going as a component in a patented machine.

Mr. RICH. Or maybe he is just selling tapered pins.

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Mr. CRUMPACKER. I say that he knows that he is selling it. He may not know that it is to be a component in a patented article.

Mr. RICH. I think that is a construction which nobody would ever put on this section. Anybody who sells, of course, knows that he is selling it. There is no point in saying "knowingly" if that is all it means.

Mr. CRUMPACKER. The Department of Justice has put that construction on it. That is why I raised the question.

Mr. RICH. I can hardly believe that they would.

Mr. FUGATE. I would like to know whether Mr. Rich is construing "knowingly" as meaning that the supplier knows that it is to be used in an infringing manner.

Mr. ROGERS. And constitutes a material part of the patent.

Mr. FUGATE. Yes, that is the point.

Mr. RICH. I have already explained that he knows how it is to be used. He doesn't have to know about the patent, he doesn't have to be legally advised of that infringement.

Mr. CRUMPACKER. To someone who isn't familiar with this subject, it is not at all clear what elements you are supposed to know about and what elements you don't need to know about, in order to violate the section. I think it could be made much more specific and more understandable.

Mr. BRYSON. We will have an opportunity to try to rectify those different things. Gentlemen, we have run now——

## STATEMENT OF I. E. McCABE, CHICAGO, ILL.

Mr. MCCABE. May I have a word?

Mr. BRYSON. We hate to cut you off.

Mr. MCCABE. For this discussion that has gone on, I have an answer.

Mr. BRYSON. What do you mean by a "word"?

We are going to leave the record open for 10 days, and any of you gentlemen who have not had an opportunity to testify, if you will identify yourself now for the record——

## STATEMENT OF A. ARNOLD BRAND, CHAIRMAN, COMMITTEE ON PATENTS AND TRADE-MARKS, AND TRADE PRACTICES, CHICAGO BAR ASSOCIATION

Mr. BRAND. If your Honor please, I would like to identify myself as A. Arnold Brand, chairman of the committee on patents, trade marks, and trade practices of the Chicago Bar Association. That is the general bar association in Chicago.

I was going to speak in support of the bill as chairman of the committee because the association itself, through its board of managers, has not had an opportunity to review the entire matter. But as chairman of the committee, I was going to approve the bill with certain specified modifications.

I understand that those have already been presented by the coordinating committee, so if you will leave the record open we will supplement this appearance in support by a written addendum within the 10 days.

Mr. BRYSON. That will be fine.

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Mr. BRAND. When does the 10 days expire? Would they expire on the 24th?

Mr. BRYSON. We will observe the usual legal rule as to 10 days.

Mr. ROGERS. Make it the 25th.

Mr. BRAND. That will not include Sundays, holidays, and high feast days, I hope, and, if so, I will be glad to have it in by Monday a week.

Mr. BRYSON. We will certainly appreciate your doing that, and we are sorry we couldn't have all of you gentlemen testify at length.

I think there was another gentleman here. I would like to have him identify himself. Will you come around and give your name and the capacity in which you appear?

(Addendum referred to was not furnished by time of going to press.)

## STATEMENT OF R. S. OULD, PATENT ATTORNEY, WASHINGTON, D. C.

Mr. OULD. My name is R. S. Ould, and I am a patent attorney here in Washington, D. C.

Mr. BRYSON. Do you wish to file a statement?

Mr. OULD. Yes, I would like to file a statement, Mr. Chairman.

What I had intended doing, if I had been able to, was to talk very briefly about sections 116, 118, and 206.

Mr. BRYSON. We appreciate that and we hope this will serve your purpose. Members of Congress, you know, constantly have to revise and extend their remarks, so you have a precedent for that.

Now, there is another gentleman here.

## STATEMENT OF JOSEPH ROSSMAN, PATENT ATTORNEY, PHILADELPHIA, PA.

Mr. ROSSMAN. I should like to have the privilege of filing a brief statement. My name is Joseph Rossman. I am a patent attorney, and formerly examiner in the United States Patent Office. I represent several corporations and individual inventors.

Mr. BRYSON. Where are you located?

Mr. ROSSMAN. I am located in Philadelphia, Pa., and also here in Washington, D. C.

Mr. BRYSON. You are one of those Philadelphia lawyers.

We will be very glad to have you file your statement.

Are there any other gentlemen appearing pro or con, in favor or otherwise?

Now, in view of this gentleman's sickness, we want to be over generous with him. Will you just proceed.

Mr. MCCABE. I believe Mr. Rich stated in his testimony a few minutes ago that inventors are not able to license patents similar to those involved in the Mercoid-Mid-Continent case, involving stokers, without violating the antitrust laws. I have a letter here from one of our salesmen dated May 11, 1951, and I want to state something here which I think will help you a lot.

In the Mercoid case on the stoker, the man licensed his patent out to a maker of one of the parts (a control). Now, here is a man who has a patent on a similar thing. He says:

The above owns the right to a patent, concerning the automatic cleaning of industrial filters by some method of air jets, I believe, and quite a number of

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leading manufacturers of industrial stokers have taken out license on this system.

A differential pressure control is required to regulate the operation of the cleaning apparatus. He wishes us to propose descriptive specifications and a list price on a unit for this application, and if that seems satisfactory to him, he will purchase two of the units immediately for use in his own test laboratory. If these units that he would use perform satisfactorily, he will write a specification and recommend it to each licensee who, in turn, would each purchase their requirements directly from Mercoid.

Now this patent owner, he didn't go out and try to make money on the controls. Now, suppose we had approached him and taken a license and said, "The only way you can get this thing is by buying this control from us." That is the improper method which the Supreme Court in the Mercoid decisions objected to. That is what you are repealing or changing in section 231 (d).

The letter I have just quoted from shows you that there are methods for these owners of patents to license their patents. He is licensing his properly. He is recommending a control. He is not saying where they must buy it. We will sell it in a perfectly safe way and even with his cooperation. He needs that control for his purpose and we have to design some specifications for it.

Now, there is an approach, I think, that these people are forgetting—that is, that the patentee can go out and operate in a legal manner and not go out and make his money on the unpatented articles. The Supreme Court decision was very definite on that—that you cannot go out—and we have not operated that way.

Rather than take up more of your time, I would suggest you again read the Mercoid decision.

I believe there was an error made by Mr. Rich as to the Supreme Court decision on the Mercoid Midcontinent case being a 5-to-4 decision on the question of contributory infringement.

The disagreement of the Court was with respect to the subject of res adjudicata, relating to misuse as a defense, on the grounds that the defense could have been raised in an earlier suit but wasn't. As to the misuse principle, the Court was also unanimous in the Mercoid Minneapolis-Honeywell case. I believe that you will find that there are ways for these inventors to license their patents without conditioning the same to obtain a monopoly on unpatented (by them) material. We are working with inventors right along. We are not trying to obtain a monopoly. This man found a way to meet a stoker invention and he is doing it nicely and he isn't infringing and isn't practicing the patent improperly; nor are we infringing his patent.

Mr. Bryson. We will certainly reread the Mercoid case.

Gentlemen, we are very much obliged to you, you highly technically trained attorneys of patent law.

As declared, we will leave the record open and those of you, even those who have not appeared in person, who have pertinent suggestions to make may submit them within this period.

Under those conditions the oral hearing has been concluded.

(Whereupon, at 4: 20 p. m., the hearing was concluded.)

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# APPENDIX

EXECUTIVE OFFICE OF THE PRESIDENT,
BUREAU OF THE BUDGET,
*Washington, D. C., June 28, 1951.*

HON. EMANUEL CELLER,
*Chairman, Judiciary Committee,*
*House of Representatives, Washington 25, D. C.*

MY DEAR MR CHAIRMAN: Reference is made to H. R. 3760, a bill to revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents," which is now pending in your committee.

An examination of this bill indicates that it vests directly in the Commissioner of Patents most of the functions relating to patents. In so doing, it conflicts with, and would partially nullify, Reorganization Plan No. 5 of 1950, which became effective May 24, 1950. This plan transferred to the Secretary of Commerce all functions then vested in other officers and agencies of the Department, except those vested in hearing examiners, the Inland Waterways Corporation, and the Civil Aeronautics Board. It also authorized the Secretary to provide for the performance of any of his functions by any officer, employee, or agency of the Department. As a result of this reorganization plan, the patent functions are now legally vested in the Secretary of Commerce but are performed by the Commissioner of Patents by delegation by the Secretary.

Reorganization Plan No. 5 of 1950 is one of a series of reorganization plans which have become effective within the last 2 years transferring the functions of nearly all subordinate officers and agencies to the Secretary in the case of six civil departments. A similar transfer has been effected by statute (Public Law 73, 81st Cong.) with respect to a seventh department, the Department of State. These transfers have been made to carry out two basic recommendations for improving departmental administration which were made by the Commission on Organization of the Executive Branch of the Government in its Report on General Management of the Executive Branch, namely:

"*Recommendation No. 14.*—Under the President, the heads of departments must hold full responsibility for the conduct of their departments. There must be a clear line of authority reaching down through every step of the organization and no subordinate should have authority independent from that of his superior" (p. 34).

"*Recommendation No. 20.*—We recommend that the department head should be given authority to determine the organization within his department" (p. 41).

These recommendations embody fundamental principles of effective administration which have been worked out through years of experience in Government and industry and have been widely applied in large business organizations.

By vesting all functions directly in the head of the department, subject to delegation by him, these plans eliminate question as to the authority and responsibility of the department heads for the effective administration of the affairs of his department. At the same time these plans enable the department head to make adjustments in the internal organization of his department by revising the delegations of the functions legally vested in him.

While in each case the head of the department initially redelegated the transferred functions to the officers who had previously possessed them, a number of changes in delegations have already been made to gear the departments for the administration of defense activities. In the case of the Department of Commerce, the reorganization plan made it possible for the Secretary to transfer from the existing bureaus a number of units and activities needed in setting up the National Production Administration to handle defense responsibilities assigned to the Department. Though the reorganization plans were drafted with-



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out particular reference to a defense emergency and became effective a month before the invasion of Korea, they have proved a valuable tool in organizing the administration of the defense program.

As conditions change and new problems arise, these reorganization plans will greatly facilitate the adaptation of departmental organization to the new requirements. However, if the bills adopted by the Congress to enact titles of the code into definite law vest the functions in subordinate officers, this possibility will soon be blocked and the purpose of the reorganization plans destroyed

For these reasons, it is very important that new legislation, and especially the bills enacting entire titles of the code, adhere to the pattern established by recent reorganization plans of vesting functions in the heads of departments rather than in bureau chiefs and other subordinate officers. This principle has long been observed by the Congress in case of certain departments, particularly tht Departments of State, Post Office, and Agriculture, and now applies to the other civil departments. In this connection it should be noted that the Congress has followed this principle in the numerous regulatory laws administered by the Department of Agriculture as well as those relating to its operating programs

Accordingly, I should urge that your committee revise H R. 3760 to vest the functions in the Secretary of Commerce rather than the Commissioner .of Patents.

Sincerely yours,

ELMER B. STAATS, *Acting Director.*

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THE SECRETARY OF COMMERCE,
*Washington, June 20, 1951.*

Hon. JOSEPH R. BRYSON,
*Chairman, Subcommittee No. 3, Committee on the Judiciary,*
*House of Representatives, Washington, D. C.*

DEAR MR. CHAIRMAN: This letter is in further reply to your communication of April 30, 1951, requesting the comments of the Department concerning H. R. 3760, a bill to revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents."

This bill, if enacted, would codify the patent laws, enact title 35 of the United States Code into law, and make certain revisions in existing patent laws. The Department of Commerce is fully in accord with the purpose of H. R. 3760 but finds it necessary to object to the use of language inconsistent with the provisions of Reorganization Plan No. 5 of 1950.

On March 13, 1950, the President transmitted to the Congress Reorganization Plan No. 5 of 1950, which vested in the Secretary of Commerce the responsibility for the performance of all other offices of the Department and all functions of all agencies and employees (with exceptions not here relevant) of such Department Resolutions unfavorable to the plan failed to pass either House and the plan became effective March 24, 1950.

In testifying before the Committee on Expenditures in the Executive Departments of the House of Representatives, the Secretary of Commerce stated that—

"The central idea of the plan is to make the Secretary of Commerce responsible in fact as well as in theory for the operations of the Department which he heads. Without reservation, I am convinced sincerely that this plan is entirely sound in terms of both theory and practical operation."

In his testimony before the committee at that time the Secretary dealt at some length and went into considerable detail concerning the functions of the Patent Office and the effect of the passage of the plan on the location and supervision of those functions. He stated:

"I have no intention of changing the present procedure or the present powers of the Patent Commissioner or the Patent Office, and I have already announced my intention of authorizing the Commissioner and the Patent Office to continue to carry on their functions in accordance with their present statutory powers."

A departmental order carrying out this announced policy was promulgated immediately when the plan went into effect.

Enactment of H. R. 3760 in its present form without providing for the vesting of the functions described therein in the Secretary of Commerce would effect a partial repeal of Reorganization Plan No. 5, and we are opposed to any such result Accordingly, it seems appropriate that provision be made in the proposed codification for continuing the amendment made by this plan.

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It appears that amendment of H R. 3760 to provide for the performance of the functions by the Secretary of Commerce would be the procedure which would be the most satisfactory, since the resulting bill would clearly set forth the officer of the Government with primary responsibility. We will be glad to work with the staff of the committee in the task of making appropriate amendments to the bill for this purpose.

As an alternative, but less direct and therefore less desirable, method of accomplishing this purpose we suggest the addition to the bill of a section reading somewhat as follows:

"SEC. —. For the purposes of Reorganization Plan No. 5 of 1950, this Act shall be deemed to have been enacted prior to the effective date of such plan."

Language similar to that here proposed was adopted by the Congress in enacting the Social Security Act Amendments of 1950 (Public Law 734, 81st Cong.).

Apart from the problems arising with regard to Reorganization No. 5 the Department believes that the selection of the statutes to be included in the title, and the changes in the language required by the arrangement and the omission of obsolete material have been in general, very well carried out in the bill.

In addition to the codification the bill also proposes to make various changes of substance in the patent laws. Since most if not all of the changes introduced are of a minor character or are of a procedural nature and substantially noncontroversial, or, are such that general unanimity of opinion can be easily obtained, the Department has no objection to the changes proposed.

If we can be of further assistance in this matter in any way, including technical assistance by experts in our Department, please call on us.

We are advised by the Bureau of the Budget that it would interpose no objection to the submission of this report.

Sincerely yours,

D. W. RENTZEL,
*Acting Secretary of Commerce.*

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THE NATIONAL EDITORIAL ASSOCIATION,
*Washington D. C., June 25, 1951.*

Representative JOSEPH R. BRYSON,
*House Office Building, Washington, D. C*

DEAR MR. BRYSON: It is our understanding that subcommittee No. 3, of which you are chairman, has just completed a series of hearings with respect to H. R. 3760. The proposed omission of the following, "by word, circular, letter, or by advertising" provokes some concern on the part of our newspapers. There have been so many attempts to curtail advertising with respect to Patent Office that we are frankly suspicious that this omission could be construed as granting the Commissioner of Patents additional control over advertising by patent attorneys or agents.

The National Editorial Association is a trade organization representing approximately 6,000 newspapers published largely in small towns, some weekly, some semiweekly, and several hundred dailies, and having distribution in every State of the Union. The South Carolina Press Association is one of our affiliated groups. So long as advertising conforms to established principles of truth and decency and its effect is not contrary to the public welfare, we are committed to defend its use against all further restrictions.

I am sure that the publishers of your State and other areas represented by our membership will appreciate your thoughtful consideration in clarifying H. R. 3760 to the extent that the Patent Office cannot possibly interpret any section of the bill as giving it arbitrary control over advertising.

Very truly yours,

ED M. ANDERSON,
*Chairman, Legislative Committee,*
*National Editorial Association.*

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A. PAUL CONNOR,
ATTORNEY AND COUNSELLOR AT LAW,
*Baltimore 17, Md., May 14, 1951.*

Re Patent advertising ethics.

Hon. J. K. BRYSON,
*Member of Congress,*
*Washington, D. C.*

DEAR CONGRESSMAN: I suggest that you look into the following phase in patent matters. It seems that some patent attorneys expend some $5,000 a month in paid advertising in periodicals. The same attorneys employ learners to make up their applications, but get the full fee for the work, leaving the impression with the inventors that they are getting the personal service of the members mentioned in the title of the concern.

If requested, the Commissioner of Patents would be glad to furnish data on this phase of patent practice. It would seem consistent with good practice to limit the expenditure for paid commercial advertising by patent attorneys to $1,000 a month at normal rates (no discounts or rebates). And put this in the statute, so it will be enforceable.

Yours very truly,

A. PAUL CONNOR.

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KANE & KOONS,
*Washington, D. C., June 15, 1951.*

CHARLES J. ZINN, Esq.,
*Law Revision Counsel, House Judiciary Committee,*
*House of Representatives, Washington, D. C.*

DEAR MR. ZINN: In our brief conversation of yesterday, I gave you a reference to volume 61, page 941, of the Reports of the American Bar Association (1936), which showed that Mr. Howson, of Philadelphia, recommended the amendment of title 35, section 11, of the United States Code (R. S. 487), by striking out from the second sentence thereof the words "by word, circular, letter, or advertising." An examination of that reference will further show that Mr. Howson explained that the presence of those words in the statute had been construed "by some" as recognizing by inference that some advertising by patent attorneys is proper, and that, as the statute then and now stands, there is a question as to whether or not the Commissioner has the power to prohibit registered patent attorneys from advertising, except when done with misleading intent.

From the report of the committee on ethics and grievances of the American Bar Association to the section of patent, trade-mark, and copyright law (1939), it is very clear that Conway P. Coe, when he was Commissioner of Patents, interpreted the law as preventing him from prohibiting advertising. The following is a quotation from that report:

"That subsequently a conference was held at Chicago on February 19, 1939, at which it was agreed that the most desirable action would be the Commissioner's promulgation of a rule prohibiting the practice but that, irrespective of how favorably disposed he might be, he would not take such action unless the present statute be clarified by amendment, as it is his view that under it he does not have the authority to do so. He has been advised that the following portion of section 11 of the present act: 'or who shall with intent to defraud in any manner, deceive, mislead, or threaten any applicant or prospective applicant or other person having immediate or prospective business before the Office by word, circular, letter, or by advertising' are words which limit the broad disciplinary authority which the statute apparently intends to vest in him."

Reference is also made to volume 65, Reports of the American Bar Association (1940), pages 470 et seq. On page 471 it appears that the section of patent, trade-mark, and copyright law reported to the American Bar Association in 1940:

"The Commissioner of Patents alone has power to discipline registrants who are not lawyers, and it is asserted that the power given him by statute (R. S. 487, 35 U. S. C. 11) is insufficient to enable him to forbid all advertising because the present statute, by mentioning advertising, impliedly authorizes it."

The section thereupon recommended to the bar association—for the purpose of accomplishing the result of enlarging the Commissioner's power in order to make it possible for him to forbid advertising—the enactment of a statute which would omit from the law the words "or who shall, with the intent to defraud

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in any manner, deceive, mislead, or threaten any applicant or prospective applicant or other person having immediate or prospective business before the Office by word, circular, letter, or by advertising."

I have deemed it advisable to give you these further references because you apparently had not been advised that the patent law section of the American Bar Association has for more than 15 years been attempting to have the word "advertising" deleted from the statute. By writing this letter I do not intend to foreclose my right to file the written statement which we discussed yesterday. This letter is intended merely as something which you may use in your discussion of the matter in the executive session next week.

Thanking you for your courtesies in this matter, I am

Very truly yours,

AL. PHILIP KANE.

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POPULAR SCIENCE PUBLISHING CO.,
*New York, N. Y., July 9, 1951.*

MR. JOSEPH R. BRYSON,
*Chairman, Subcommittee No. 3, Committee on the Judiciary,*
*House of Representatives, Washington, D. C.*

DEAR MR. BRYSON: Thank you for your very courteous letter of July 6 regarding the status of that part of H R. 3760 in which we are interested.

In addition to any other material that has been submitted to you and your associates in relation to section 32, I would like to take a moment of your time to incorporate in this letter the statement that as publisher of one of the largest circulation magazines in the country (more than a million every month) of interest to inventors, we have, over the years, received a negligible number of complaints from inventors about the patent attorneys using our columns. In fact, our present editor tells me that since September 1948 we have had no complaints whatsoever from our readers about patent attorneys.

So I hope that whatever form the bill you are now working on takes it will preserve the rights of patent attorneys to effectively tell inventive Americans that their services are available.

With best regards, I am,

Cordially yours,

GODFREY HAMMOND, *Publisher*

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NEW ORLEANS, LA., *May 9, 1951.*

Hon JOSEPH R. BRYSON,
*House of Representatives,*
*Washington, D. C.*

DEAR SIR: I have recently completed reading your bill H. R. 3760 that is to revise and codify the laws relating to patents and the Patent Office.

I respectfully make the following comments and suggested amendment to your bill after having had over 20 years' personal experience in patent matters, working for both patent attorneys and inventors.

I sincerely believe there is a large number of people like myself who are now doing a certain kind of patent work that will become illegal to perform should your bill as it is now written become a law.

I am speaking of those of us who are now employed by patent attorneys from time to time to write their specifications, claims, and amendments, and then return the same to them for prosecution in the United States Patent Office I have been employed for this type of work when the local attorney is busy or when he desires the benefit of my years of experience as a mechanical engineer with invention development experience I am, of course, always paid by the job. Another hardship, your bill as it now stands will be on the engineer who assists the development of an invention for a person of very limited means and is then employed to make a patent drawing, write the specifications and claims. The work is then given to the inventor for whatever disposal he sees fit.

No one wants to see the inventor protected and the legal profession preserved more than I do, but I feel that there is a certain type of worker, as described in the last paragraph, that is more and more being placed in an impossible position. Therefore, I suggest that the following be added to chapter 1, section 31, of your bill. Patent Office; practice before Patent Office; regulations for agents and attorneys.

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Suggestion: "That the Commissioner of Patents shall issue a certificate of authority to write patent specifications, claims, and amendments to anyone who shall present written proof from a registered patent attorney or agent that the person making application for certificate has been employed by them continually for 3 years or part time for 5 years; that the certificate shall state if the person is qualified just to write specifications, or the claims, or the amendments, or all three, and if they are qualified to write the same for chemical, electronic, or mechanical inventions; that a charge of $10 shall be made for each certificate."

The above-suggested addition does not in any way whatsoever suggest, approve or recommend that a person other than as now licensed be permitted to practice before the Patent Office. In fact, I would even make it a crime for the telephone directories to list people whose ads in the yellow section suggest they are patent attorneys. (Some people still do this in spite of all the laws and the Patent Office well knows of the fact.)

Another thing sir, a large number of people are mislead about inventions and patents by the report they receive on searches, yet, anyone in Washington, D. C., can advertise they make patent searches and send any kind of a report they see fit. They can work for an attorney and still only half do the job without being found out for months, and there is no restrictions put on this practice or are people required to show they are qualified to make a patent search before doing so.

One other matter often overlooked is the fact there is practically no school in most parts of the country where one can go and take a course in patent law.

I trust you will give serious consideration to the above matter and be able to make some form of amendment to your bill that will permit others like myself to continue to perform certain useful services to inventors and patent attorneys with limited funds. Services, I respectfully repeat, are not desired by us to be taken as the practice of patent law. I am sure that neither you or the Commissioner of Patents have any desire to force me out of work, yet, what can one do should your bill be passed? Patent attorneys here in the South do not by themselves have enough work to keep one busy, and I for one cannot afford to move and try to make a connection with a patent attorney in another city. No course of instruction in patent law is given in this area.

A letter as to my ability in patent work given by a registered patent attorney and former examiner in the Patent Office is not taken as proof enough under the present law for me to be granted an agent's license, and I know from experience that I cannot pass an examination for the same without first taking a course in patent law. This latter is not because I do not know everyday procedure but because I am not up on the finer points of the subject.

Trusting I may have the pleasure of hearing from you regarding this matter.

Sincerely yours,

J. OWEN EVANS

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1821 TWENTY-FIRST AVENUE, LONG ISLAND CITY, N Y
*May 15, 1951.*

HON. JOSEPH R. BRYSON,
*Chairman, Subcommittee on Patents Trade-Marks, and Copyrights,*
*House of Representatives, Washington 25, D. C*

DEAR MR BRYSON: As a member of the patent bar for the past 9 years, previous to which time I was an examiner in the United States Patent Office for 11 years, I have been deeply interested in H R. 3760 which you recently introduced. Thank you for sending me a copy of your bill.

I have read over the provisions of your bill and believe that it will do much to clarify and strengtben the patent law However, I should like to recommend that one additional clause be added in order to clarify the application of section 4 of chapter 1.

I believe that this section was not meant to apply to applications which were filed prior to the effective date of the act, nor to patents which have been or will be issued on such applications. Although section 4 of chapter 4 was probably designed to exempt such applications from the provisions of section 4 of chapter 1, I believe that such exemption should be made more explicit, and several members of the patent bar with whom I have discussed this matter agree with me. I therefore recommend that a section, somewhat as follows, be added to the bill:

"Section 4 of title 35, as enacted by section 1 hereof, shall not apply to applications filed prior to the date on which this Act shall take effect, nor to patents

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issued or to be issued on such applications, but the law previously in effect, namely Revised Statutes 480 (U. S. C., title 35, sec. 4, 1946 ed.) shall apply to such patents and applications."

I should like to make another recommendation. All patent examiners are qualified as engineers. The provisions of the above section of the bill would greatly reduce their ability to get employment as research and development engineers, since their employers would be placed at a great disadvantage in respect to inventions which such employees might make within 1 year after they left the Patent Office. To give sufficient notice to examiners who are contemplating employment as engineers, it is recommended that the provisions of the above section should not be made effective as to applications which are filed within 1 year after the date of enactment of the act. To incorporate such a provision, a section, such as the following, might be added, in place of the above-proposed section:

"Section 4 of title 35, as enacted by section 1 hereof, shall not apply to applications filed prior to one year from the date on which this Act shall take effect, nor to patents issued or to be issued on such applications, but the law previously in effect, namely Revised Statutes 480 (U. S. C., title 35, sec. 4, 1946 ed.) shall apply to such patents and applications".

Thank you for your consideration of this matter.

Respectfully yours,

BENJAMIN FOX.

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NEWARK 2, N. J., *May 24, 1951.*

In re H. R 3760.

COMMITTEE ON THE JUDICIARY,
*House of Representatives,*
*Washington, D C.*
(Attention: Mr. Bryson.)

DEAR MR. BRYSON: I respectfully express the opinion that section 33 of the above entitled bill is not broad enough. The words, "holds himself out," to me mean that for a person to fall within the condemnation of that section, there must be a direct active representation. It is my thought that this section should be expanded by the insertion before the word "holds" in line 2 thereof the following: "renders services in the preparation or prosecution of applications for a patent before the Patent Office, or offers to render services in the preparation or prosecution of applications for a patent before the Patent Office,".

Thus, if this amendment is added, without any "holding out," or any representations of any kind, the mere fact of the rendition of these services without a representation of qualifications will constitute an offense.

Would it not also be desirable to provide in this section some mechanism for enforcement of the penal provisions such as a statement where the complaint shall be made, i. e, where the acts were performed, and that the United States district attorney for the particular area shall be empowered to initiate the prosecution as well as any interested citizen.

Very respectfully yours,

NORMAN N. POPPER.

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RADIO PATENTS CORP.,
*New York 16, N. Y., June 20, 1951.*

Hon. JOSEPH R. BRYSON,
*Member, Judiciary Committee, House of Representatives,*
*Washington, D. C.*

DEAR SIR: My attention has been called to your proposed bill, H R. 3760, revising the patent laws. I believe there should be included therein a clause protecting inventors or inventions made abroad We have a number of associates abroad, such as the General Electric Co., Ltd, and I might cite the following example:

Scientists would be working in the laboratory on a new development—perhaps a very important contribution and invention. In the laboratory there may be two or three assistants. While they keep careful records of their experiments and developments, they do not file an application until they have completed their experiments and determined best results; or, if a provisional application is filed, it gives a general outline without details

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If an assistant should leave the employ of the laboratory or should by chance mention to a friend something about this development and this information is published in England, this publication would be beyond the control of the inventor. The inventor then proceeds as quickly as possible to file a provisional application to protect himself in England. Within the year he files in the United States, claiming the convention date. The uncontrolled publication of some of the information would invalidate his American application and patent as far as the disclosure is concerned due to this publication.

On the other hand, if his actnal date of filing his application in the United States were allowed to be equivalent to or the same as the convention date, he he would get his desired protection. Therefore, I recommend that the actual date of filing in the United States under a convention date should be the convention date as far as publications are concerned describing work done by the inventor himself. The present law does not protect an inventor in such situations where publication is beyond his control. On the other hand, an American inventor is protected abroad under similar situations. Therefore, it is unfair and in due time Americans may lose valuable rights abroad if the foreign countries should retaliate against this unfair situation here.

As outlined on page 9, paragraph 102, the present bill provides that the invention mnst not be published more than 12 months prior to the filing of the application in the United States. This should be limited to state that it must not be published by others or as the discovery of others, other than the inventor. The inventor should have the right to patent protection providing he files his application within 12 months of his publication anywhere and then providing he files an American application equivalent to such foreign application under the convention date.

I hope you will give this due consideration, as situations are constantly arising which are very unfair to inventors, especially those residing abroad.

Very truly yours,

RADIO PATENTS CORP.,
WILLIAM DUBILIER, *President.*

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PATENT EQUITY ASSOCIATION, INC.,
*New York, N. Y., June 18, 1951.*

HON. EMANUEL CELLER,
*House of Representatives,*
*Washington, D. C.*

DEAR SIR: As directed by the board of directors of the Patent Equity Association, I am sending you herewith 10 copies of a resolution of the board in reference to H R 3760, Eighty-second Congress, first session, for the use of the members of your committee

Very truly yours,

T IRVING POTTER, *President*

RESOLUTION

Referring to H. R. 3760, Eighty-second Congress, first session, a bill to revise and codify the laws relating to patents, and so forth, the hoard of directors of Patent Equity Association, Inc, hereby resolves as follows:

1. The bill evidences much careful thought.
2. The provisions of the bill are, for the most part, sound and constructive.
3 The bill is endorsed, except for section 102 (e), which should be eliminated, and section 212, which should be clarified if retained.
4. Section 102 (e) would perpetuate various anomalous results that have developed under court decisions, e g., the following results:

(I) An inventor invents a new window screen and sells a few to try out the market An early customer then invents a lock particularly adapted for that screen—and hurries to the Patent Office with an application which necessarily discloses the screen in order to show how the lock works. This second inventor is honest, and his application claims only the lock, not the screen. The first inventor then files an application on his screen within the year permitted by section 102 (b), and obtains his patent. Later the second inventor's patent issues on the lock Years later, after both inventors are dead, the first inventor's screen patent is invalidated by the subsequently issued lock patent which made no claim whatever to the

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screen. Thus, the first inventor's screen patent is invalidated on the first inventor's own invention, even though the first inventor filed within the year permitted by section 102 (b), and even though no one other than the first inventor ever even claimed to have invented the screen! This remarkable doctrine stems from *Alexander Milburn* v. *Davis-Bournonville* (270 U. S. 390). In that case, the two applications were filed only 5 weeks apart, and only one of the applicants claimed to be the inventor of the invention which the court struck down.

(II) Under section 102 (e) information which is not available to the public when an inventor files his application becomes prior art against his patent ex post facto—through an earlier filed application subsequently issuing as a patent. And in view of section 103, the earlier filed application does not even have to disclose the invention; instead, it is added, ex post facto, to other things to synthesize the invention—and by hindsight at that.

5. Section 212 is new to the law, and it probably will make things worse instead of better. If retained, it should be clarified. As worded, it is not at all clear whether a joint inventor who grants a license has to both obtain the consent of the other inventor and account to him or only either (a) obtain consent or (b) account.

6. The president of Patent Equity Association, Inc., is directed to forward 10 copies of this resolution to the Committee on the Judiciary, House of Representatives.

BOARD OF DIRECTORS, PATENT EQUITY ASSOCIATION, INC.

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THE B. F. GOODRICH CO.,
*Akron, Ohio, June 1, 1951.*

COUNSEL, JUDICIARY COMMITTEE, SUBCOMMITTEE NO. 3,
*House of Representatives, Washington, D. C.*

SIRS: I have been informed of the work of the coordinating committee sponsored by the Council of Patent Law Associations in reviewing drafts of the proposals for recodification of the patent laws, and in particular in proposing corrections in the bill H. R. 3760, on which hearings are scheduled to commence on June 13.

I approve of the proposals made by the coordinating committee, but believe that they may not have gone as far as is desirable in clarifying the most important of all the sections of the bill, which is section 102. As it stands, this section, defining what is patentable, suffers from some faults in draftsmanship, including use of words without antecedents, use of different words to designate the same thing, use of special words of art without definition, and a somewhat illogical and confusing arrangement.

I am sure that you are as deeply concerned as any of the many people more directly interested in the patent laws in having the recodification state the law with the greatest clarity, and I consequently invite your most careful consideration of the following additions and changes, which are intended to be and are believed to be codification of existing law, with no changes in effect from what was intended in section 102, and the immediately adjacent sections as introduced before the Congress:

100. *Definitions.*—Add the following subparagraph:

"(e) The word 'applicant' includes not only an inventor but also joint inventors, and personal representatives and assignees when entitled to take action in connection with applications for patent."

101. *Inventions patentable*—In line 1, after "any" insert "invention which is a."

101–A. *Date of invention* (new section to be inserted between 101 and 102).—"An invention shall be deemed to be made when conceived by and actually reduced to practice by or on behalf of the inventor or constructively reduced to practice by the filing of an application for patent, provided that an asserted prior invention or prior knowledge, use, or publication, may be overcome by proof of reasonable diligence in adapting and perfecting the invention from a time just before the earliest activity of the rival inventor or the earliest date of knowledge use or publication, and continuing until the reduction to practice."

102. *Conditions for patentability: novelty and loss of right to patent.*—Rewrite the section as follows: "An applicant shall not be entitled to a patent for an invention if the inventor or inventors named in the application for patent



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did not themselves invent it, nor if the invention has been abandoned, nor if any of the following prior art exists:

(*a*) the invention was known or used by others in this country, or patented or described in any printed publication in this or any foreign country, before the invention was made by the named inventors; or

(*b*) the invention was patented or described in any printed publication in this or any foreign country or in public use or on sale in this country, more than 1 year before the date of the application for patent in the United States; or

(*c*) the invention was described by another in an application for patent filed in the United States before the invention was made by the named inventors, and issued as a patent; or

(*d*) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country before the date of the application for patent in this country on an application filed more than 6 months in design cases or 12 months in other cases before the filing of the application in the United States; or

(*e*) the invention was, in fact, made in this country by another, who had not abandoned it, before it was made by the named inventors.

In addition to the foregoing, I would like to comment on proposals to amend the bill by replacing the word "abandoned" by the phrase "abandoned, suppressed or concealed." I would like to urge most emphatically that this not be done, since the words "suppressed or concealed" have been used by judges to characterize certain acts as being tantamount to abandonment, but, if imported into the statute, would have far greater and entirely unintended effects in penalizing inventors who follow the normal practice of developing their inventions in secrecy.

In conclusion, I wish to commend those who have devoted so many hours to work on this bill, for the excellent results, and to urge that it be approved with such corrections as may be needed to make it say exactly what it is intended to say.

Very truly yours,

HAROLD S. MEYER,
*Patent Counsel.*

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JENNINGS & CARTER,
*Birmingham, Ala., May 8, 1951.*

Hon. JOSEPH R. BRYSON,
*Member of Congress,*
*Washington, D. C.*

DEAR MR BRYSON: I am writing to you to give you my wholehearted support of bill H. R. 3760, a bill to codify the patent laws of the United States.

I have carefully studied this bill, and I sincerely believe that it is far better than the existing statutes. I note with particular interest section 103 in which the obviousness of subject matter is made the test of patentability, and I believe that this definitely improves the situation. In my opinion, the Supreme Court has by its recent decisions taken a long step toward ruining our patent system, and I believe that this bill, if enacted into law, will aid in curing some of the judicial misconceptions about the purpose, scope, and beneficial results of our patent system.

While I do not know if it would be practical, it occurs to me if the bill could contain as a sort of preamble a statement of the sense of Congress to set forth the intent of the act that this might have some beneficial effect on its construction by the Supreme Court. It is amazing indeed to all who are familiar with the subject, as I know you are, that patents are treated so differently from copyrights when both stem from the same clause of the Constitution. The only answer I can think of is that while judges do not invent they do write books. It must be a subconscious reaction which prompts them to treat the two classes of property so differently.

I call your attention to the obvious error in the use of the word "of" instead of "or", section 242 (4). Other than this formal change, I have no suggestions to make and certainly wish to congratulate you on a fine job. Let us hope that the bill will pass because I for one sincerely believe that it will be to the best interest of the country for this to become law.

Respectfully,

JENNINGS & CARTER,
By HUGH P. CARTER.

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GRAND RAPIDS, MICH., *May 8, 1951.*

Hon. J. R. BRYSON,
*House of Representatives, Washington, D. C.*

DEAR SIR: I have a copy of the bill H. R. 3760, which was introduced by you and referred to Committee on Judiciary.

At the present time the last sentence of section 103 that "Patentability shall not be negatived by the manner in which the invention was made" is an important matter which unquestionably should be in the bill. In addition, and perhaps supplementing it, it is believed that the matter of looking at or considering invention and patentability should be done objectively and not subjectively. When considered objectively, the test is, What did the invention do? When considered subjectively, which is the way most theorists and impractical men want to do the job, it is based upon the mental attitude of the individual, the judge, or the Patent Office examiner. Even the best-qualified cannot do justice when affirming or denying patentability subjectively.

Some years ago, I believe in the first term of President Roosevelt, a committee was appointed which made a report recommending the objective method.

I do not know where it could be introduced into the statute, but additionally I believe that it should be put into the statute appropriately the thought that a valid patent is property and not a monopoly. A valid patent must have as a basis creation of something new which did not exist before. Analogous to the building up of valuable property by hydraulic dredging, for example, to fill in swampland along a river, lake, bay, or the like, such property when created should belong to the creator. There is no question ever raised as to monopoly when real estate is created. But somehow through false propaganda it is the belief of many—and in the many are several of the judges who pass upon patents—that an owner of a patent is to be treated as any other monopolist. This is based upon the fact that the owner of a patent has a right to exclude others from practice of his invention. Seemingly this right to exclude in the case of patent property is considered a monopoly, with all the odium which goes with the name; but right of all other property, either real or personal, to exclude others—in other words, to monopolize it—is perfectly right and justified but not in the case of one who creates through invention valuable patent property, which is no more an odious monopoly than a farmer who owns 80 acres of land is, to all people except Communists and their helpers, a monopolist because of his right of exclusion, lasting forever to exclude others from his farm.

Yours very truly,

FRANK E. LIVERANCE, Jr.,
*Associated With Laurence, Woodhams, Mills & Price.*

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TOLEDO, OHIO, *May 9 1951.*

In re H. R. 3760, a bill to recodify the patent laws, April 18, 1951, referred to the Committee on the Judiciary.

Hon. JOSEPH R. BRYSON,
*Chairman of the House Committee on Patents,*
*Washington, D. C.*

SIR: There is appreciated the supply of copy of the above, which forwarding is understood as submitted for comment from here.

Page 9, section 102 (a), line 1. before "known" it is suggested there he inserted "publicly"; otherwise, it would seem that one having the know-how could keep such indefinitely from the public and thereby failing to promote the useful arts purpose of the patent laws. Unless "publicly" be inserted as above proposed, the secret operator who does not choose to let the public have the know-how after 17 years, or at any time, is thus enabled to stand in the way of protecting the one who is willing to take out a patent for the property-right term, thereafter leaving such open to all.

Under this section, is it not proper to identify Patent Office-published Abstracts of Applications of no anticipation standing prior to such publication, regardless of how long prior thereto filing may have occurred.

Section 103, delete all but the last sentence. This term "Obvious" opens the door for destroying all patent-invention property. The requirements of a patent applicant are that the disclosure made shall be "Obvious"; i. e., in such explicit detail that anyone who is skilled in the art, by perusing thereof, may carry through the invention at the time. The obvious support required to obtain the property right is by this proposed enactment blasted into a nullity.

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Page 10, section 202, second paragraph, line 3, change "grant" to "filing."

Of course, the new claim developed for the reissue should have property right attach thereto only from the grant of the reissue deed, to which date the infringer is clear of liability. Quite frequently a patentee notes that a later-issued patent to someone else contains claims which the earlier patentee may rightly make as a prior inventor. Surely it is not the purpose of Congress to reward the second to operate clear of the property-right award in the reissue. Filing date of original should have like status as continuation (sec. 120) and divisional (sec. 121), and not give interferant and all others, active prior to reissue new claim grant, a noninfringement status.

Otherwise, this H. R. 3760 is approved as desirable, and more so than Eighty-first Congress' H. R. 9133.

Respectfully,

GEORGE E. KIRK.

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SHEPHERD & CAMPBELL,
*Washington, May 15, 1951.*

COMMITTEE ON THE JUDICIARY,
*House of Representatives, Washington, D. C.*

GENTLEMEN: This is in reference to H. R. 3760, a bill to revise and codify the laws relating to patents.

I wish to suggest the following modification be made in the bill by adding sections 103a and 103b to read as follows:

"103a. A case of patentability shall be deemed to have been established when the device of the application achieves a new and useful result, which no single prior device is capable of producing and which result goes beyond mere increased excellence of workmanship.

"103b. A case of patentability shall also be deemed to have been established where a new assembly and relationship of parts accomplishes an old result in a markedly more facile economical and efficient way and especially where a marked saving in time or labor by the user results."

My reasons for urging this modification are as follows:

Section 103, as proposed in the bill, leaves the grant or refusal of a patent too much to the whim of the Patent Office examiners. What one examiner would deem to be "obvious" another might deem to rise to the dignity of invention. It is highly desirable to lay down some positive rule rather than a negative one, if possible.

Just as no one would plant an orchard and prune and spray and cultivate the same through the early years of growth if Tom, Dick, and Harry could appropriate the fruit when the orchard came into bearing, so no creator of a new device will go to the very great initial expense of putting a new device on the market and building up a demand for it if the business pirate can then step in, have dies made from his device, and cut his market to pieces.

This Nation has grown great largely because of the hundreds of thousands of small businesses built up through the activities of the American inventor, and all doubts should be resolved in his favor.

If the old and known devices are just as good as his, then let the infringer stick to them. If they are not as good, to the extent that the purchasing public consistently demands the new article, then that should be sufficient to show that a nonobvious thing has been done.

It must be borne in mind that the patent examiner looks at patent applications with eyes instructed by the applicant's work, and the tendency is strong to dismiss with the wave of the hand that which might represent many days of work and experimentation and the expenditure of large sums of money

That such tendency exists has repeatedly been recognized by the courts, and the more learned and experienced the judge, the more likely is he to recognize that fact

See *Faries Mfg. Co.* v *Brown & Co.* (121 Fed. 547):

"The eye that sees a thing already embodied in mechanical form gives little credit to the eye that first saw it in imagination, but the difference is just the difference between what is common observation and what constitutes the act of creation. The one is the eye of inventive genius; the other of the looker on after the fact"; and

*International Tooth Crown Co.* v *Richmond* (30 Fed. 775):

"It is not difficult, after the fact, to show by argument how simple the accomplishment was, and by aggregating all the failures of others to point out the plain and easy road to success. This is the wisdom after the event that often forfeits invention, and levels it to the plane of mere mechanical skill."

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Mr. Justice Grier, one of the ablest patent jurists this country has ever had, in *Livingston* v *Jones* and *Adams* v. *Jones* (1st Fischer 526 and 531), said that the patentee of the earlier patents "came so near the patented device or machine that they might have discovered it if they had only thought of it."

In *Sickles* v. *Gloucester Manufacturing Co.* (1st Fischer 234), Mr Justice Grier said:

"But it is not an unusual case, even among learned engineers, to see a thing after it is done, which never occurred to their minds before. I am disposed to distrust that wisdom which succeeds the event.

Respectfully submitted.

FRANK G. CAMPBELL.

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LAFAYETTE, IND., *May 22, 1951.*

Re H. R 3760, patent codification.

Hon. JOSEPH R BRYSON,
*Chairman, Patents Subcommittee, Judiciary Committee,*
*House Office Building, Washington, D. C.*

DEAR CHAIRMAN BRYSON: As a member of the American Patent Law Association, I have voted in support of recommendations of the APLA committee in regard to patent codification

It is important to minimize controversy, not only in your committee hearings but also in the functioning of the patent system. The APLA committee's recommendations that the courts maintain a hands-off policy as regards disputes amongst joint patent owners by prolonging the established rule that a joint owner can grant licenses exemplifies this desiderata of minimizing litigation by relatively unambiguous, though sometimes unjust rules

The likelihood of patent litigation could be greatly reduced, and the cost of what patent litigation did occur could be significantly lowered, by eliminating the obsolete public-use defense. Under modern conditions, any public use of significance is described in printed publications. It should be the public policy to encourage the publication of anything susceptible to public-use interpretation instead of promoting what is judicially classified as 'public use" but which for practical purposes is substantially secret Since starting your patent-codification work several years ago, you probably have not encountered significant opposition to what should be your guiding principle that the infringer with unlimited funds should be given no advantage for invalidating a patent not available to a cautious businessman studying the advisability of investing large sums in a patent.

For the same reasons, literature search standards should be imposed upon the printed publications invalidating a patent. Foreign newspapers, nonanalogous textbooks, fantastic fiction, etc., so remote from a businesslike literature search, should not benefit the infringer.

Accordingly, I urge that sections 102 (a) and (b) be revised. I have underlined the essence of my proposal:

(*a*) The invention was, in this or any foreign country, begore the inveution thereof by the applicant for patent, patented or described in *any printed publication discoverable by professional literature searchers using the diligence appropriate to evaluating the wisdom of purchasing a patent*, or

(*b*) The invention was, in this or any foreign country, more than 1 year prior to the date of the application for patent in the United States, patented or described in *any printed publication discoverable by professional literature searchers using the diligence appropriate to evaluating the wisdom of purchasing a patent.*

My suggestions could probably be incorporated in the bill without arousing controversy among the patent bar. If, however, substantially these same proposals have been urged, thoroughly investigated, and vigorously opposed by significant segments of patent specialists, it might be more expedient for your committee to ignore my belated recommendations. Accordingly, I am submitting these comments to you, while encouraging you, through my vote in support of the recommendations of the APLA committee, to pass the recodification without extensive changes in H R. 3760.

Respectfully,

JOHN EWBANK.

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NEW YORK, N. Y., *June 21, 1951.*

Re patent bill H. R. 3760.

Hon. JOSEPH R. BRYSON,
*House Office Building, Washington 25, D. C.*

DEAR MR. BRYSON: This bill contains some very troublesome clauses which ought to be well considered in their implications before the bill is enacted. In its present form, the bill represents the complete destruction of the patent system, if I understand the implications of the bill correctly.

In order to make this clear to you I will explain it very briefly:

1. The harsh attitude of the courts toward patents threatens to destroy the rewards of research by giving developed inventions, by court action, to the first person who is willing to seize them for profit.

2. This unfortunate severity has driven research organizations to contemplate the abandonment of the patent system and the institution of a policy of secrecy. This is simple self-defense.

3. Paragraph 102G of the patent bill goes beyond this right of secrecy, permits every research organization to keep its inventions secret and then makes those secret inventions an anticipation for any similar patent granted to an inventor who is willing to publish his invention under the provisions of the patent law.

4. At present, inventions kept secret do not anticipate those which are made public under the patent system. This paragraph adds to the prior art every invention which has been secreted in all the research organizations and will destroy the patent system by making the patents of such precarious nature as to be worthless.

5. The research organizations which contribute their funds to the development and well-being of the Nation are entitled to protection, but that protection should come from a just enforcement of patents against infringers.

Very truly yours,

JOHN L. SEYMOUR.

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CHICAGO, *May 18, 1951.*

Re H. R 3760 (Bryson) Patents.

HOUSE JUDICIARY COMMITTEE,
*House Office Building, Washington, D. C.*

GENTLEMEN: Section 103 (p. 9) is considered objectionable as tending further to confuse the question of what constitutes patentable invention.

It is recommended that the section be (*a*) deleted; (*b*) amended to read as follows:

"SEC. 103. CONDITIONS OF PATENTABILITY.—A patent may be obtained provided the invention is not identically described or disclosed in the prior art set forth in section 102 of this title, and provided that the differences between the subject matter sought to be patented and said prior art are such that the subject matter as a whole could not be reproduced without modification of the prior art as it existed at the time the invention was made."

Proposed section 103 purports to codify (without clarifying) a theory of case law which is responsible for a great deal of confusion in the administration of the patent law, i. e., What is mechanical skill?

What constitutes "mechanical skill" is a purely subjective question, and like "invention" is practically indeterminate and not susceptable of ultimate definition.

Section 103 as printed would perpetrate a source of confusion.

Respectfully,

CALLARD LIVINGSTON.

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JUNE 25, 1951.

Hon. JOSEPH R. BRYSON,
*Chairman and Members of House Judiciary Subcommittee No. 3,*
*Old House Office Building, Washington, D. C.*

DEAR SIRS. This is written to answer certain questions which have arisen relative the testimony of the witness. Parenthetically let it be noted while witness criticizes the subjective test (now comprising sec. 103) to contrast same with objective test, yet witness would let subjective test remain but also would include objective test.

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INDEX OF SUPPLEMENTAL LETTER

I. Exact reading of full text of section 103 urged by witness. No change in wording of first paragraph now constituting section 103.

II Objective test and meaning of an application to example. "Objective" definition from Webster.

III. Advantages of objective test to following: Patent Office, inventor, patent solicitors, judges, Federal court, and public.

IV. Objections to subjective test: Indefiniteness, speculation—double mental imaging.

V. Assurance courts will follow objective or any test enacted into law by Congress.

VI. "Independently of and apart from * * *."

VII. Answer to two contentions disapproving objective test.

VIII. The Supreme Court in decision prior to writ of certiorari never held patent claim void for lack of patentable invention except where no new functional relationship was established. * * * Objective test harmonizes the cases.

IX. Rebuttal of allegation that courts have not applied the objective test. * * * On contrary courts have applied same and spoken in terms of functions and specifically approved George L. Roberts statement of the objective test.

X. Conclusion.

I. EXACT READING OF FULL TEXT OF SECTION 103 PROPOSED

Witness desires section 103 of H. R. 3760 to read:

"SEC. 103. CONDITIONS FOR PATENTABILITY; NONOBVIOUS SUBJECT-MATTER AND NEW FUNCTIONAL RELATIONSHIP.—A patent may not be obtained though the invention is not indentically disclosed or described in the prior art set forth in section 102 of this title, if the differences between the subject-matter sought to be patented and that prior art are such that the subject-matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject-matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

"Independently of and apart from the above, a patent may be obtained for an invention and patentable novelty shall be found therefor, whenever there is established a new functional relationship between any of the factors which are required for rendering an invention in the industrial art practically operative."

With the section thus worded, not a single change has been made in the first paragraph now constituting section 103. The added second paragraph constitutes the objective test (new functional relation) which witness requests to be added to the section. The first paragraph allows to the applicant the obvious or nonobvious test of patentability. The second paragraph allows to the applicant the objective or new functional relationship test and renders more certain the patent grant when it is established that there are new functional relations existing between the cooperating factors and such establishing shall render patentable novelty finding mandatory.

II. OBJECTIVE TEST—MEANING OF AND APPLICATION TO EXAMPLES

"Objective": (Webster's New International Dictionary).

Noun: "That which is objective or external to the mind."

Adjective: "Emphasizing or expressing the nature of reality as it is apart from self-consciousness; treating events or phenomena as external rather than as affected by one's reflections or feelings; expressing facts without distortion from one's personal feelings or prejudice."

Witness gave example of an invention comprising a screw-driver tool being inserted in the chuck of a brace and bit type which enabled the operators to work with much greater efficiency. Is the functional relationship of the screw-driver tool to the chuck of the brace old? This is a direct question of fact external to "feelings" of examiner or judge. It is not a question of whether it appeals to him as obvious or not—obviousness is addressed to his "feelings" and is essentially subjective. The answer to the question is that the same functional relationship is found between the chuck of the brace and the bit as between the chuck and the screw-driver tool. The chuck of the brace gives rotary motion and pressure downward just as it does when the screw-driver tool is substituted for the bit. Therefore, patentability should be denied.

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The barb wire gives the affirmative of the application of the objective test. The functional relation of holding the barb at 90 degrees to the carrier wire by a bearing formed by two wraps of the wire of the barb was new. And the Supreme Court held the patent valid.

III ADVANTAGES OF OBJECTIVE TEST TO FOLLOWING

(1) Inventor: May know with far greater certainty whether his contribution is one to be awarded a patent and if a patent is allowed whether it probably will be sustainable in court, and this before he spends years of his life and great sums of money in its development and marketing. At present, he may be met with a court decision stating with no greater logical basis, than "We think the invention is obvious to those skilled in the art."

(2) Patent Office: The objective test affords so excellent a criterion for a precise definition of a patentable invention that burden of Patent Office will be greatly lightened.

(3) Solicitor: Serves as a measure or criterion in advising as to patentable novelty and also in his constructive work of preparing specification and claims of patent applications.

(4) Judges of Federal courts: Supplies a criterion defined from judicial authority to aid them to sound and consistent judgment in patent cases.

(5) Public: Public in adopting machines or inventions can know whether it is infringing or not with far greater certainty This means less litigation.

Application of the objective test has advantage of a two-volume text illustration, derivation, and application to adjudicated cases.

IV OBJECTIONS TO SUBJECTIVE TEST, I E, OBVIOUSNESS, WHICH IS THE TEST OF SECTION 103 AS PRESENTLY SET FORTH

Indefiniteness: What is obvious to one man is not obvious to another. After being taught how to solve a problem, of course it is "obvious." Surely, such is not a reliable criterion to test whether a contribution is patentable. Yet this is what the committee is asked to enact into law as the only measure of patentability. Note well witness would let section 103 remain as is but would add the objective test

Example: Inventor files patent application. Examiner replies rejecting claims thereof, stating "In view of prior art cited references, it is obvious to those skilled in the art to do what applicant proposes." How is the Solicitor to answer on rational basis such contention which amounts to nothing more than "we think anyone skilled in the art could overcome the problem you faced." How can examiner know that—it is only opinion. All are entitled to opinions. Solicitor may reply "Patents you have cited are all old and no one member has solved the problem—same has awaited solution by applicant and so it could not be obvious after so many years"

Assuming finally patent is allowed:

Applicant is happy and with it induces friends to subscribe funds for development and marketing. After say eight years, a rival sees the inventor is making good and he infringes, and after expensive court contest of two or more years——court says "we believe the invention is obvious," or as sometimes stated, "is within the skill of the art" or "does not rise to the dignity of an invention" or "is only mechanical skill"—all subjective answers. Surely one who thus has been led into losing years of his life and his own money and that of his friends, cannot find much incentive in a patent system based upon a test so lacking in logical basis.

Speculation: In applying "obviousness" test, one speculates upon whether the relationship is obvious or not obvious to those skilled in the art—a double mental assumption or imagining.

First, one must imagine one possessed of the skill of those in a prior art, and then second, he must imagine whether such a one would deem the invention obvious. He must reach the conclusion in his feelings (being a subjective process) about obviousness after he has been taught the solution by the inventor whose contribution he is judging—meantime trying to keep such instruction out of his mind. Surely this adds up to a real mental gymnastic trick.

All such indefiniteness and speculation is avoided by the objective test.

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### V. ASSURANCE COURTS WILL FOLLOW OBJECTIVE OR ANY TEST ENACTED INTO LAW BY CONGRESS

No one can give such assurance, it is respectfully submitted

To escape the utter confusion depicted by Justice Jackson when he states " * * * that the only patent that is valid is one which this court has not been able to get its hands on" (80 U. S. P. Q. p. 36). It is to be devoutly expected that the courts will welcome a reliable test founded on logic and derived from judicial authority.

Also, we may still trust that stare decisis will contribute to uniformity of judicial determination when a criterion is presented which harmonizes the Supreme Court decisions prior to requirment for writ of certiorari.

### VI. "INDEPENDENTLY OF, AND APART FROM * * *"

Inserted to make objective test separate from subjective test in first paragraph. Thus, an invention which does not have a new functional relationship may still be adjudged patentable if deemed nonobvious. An invention which has new functional relationship as set forth in second paragraph cannot be held nonpatentable because deemed to be obvious, since it fulfills the requirement of the restrictive objective test which is "independent of and apart from * * *."

### VII. ANSWER TO TWO CONTENTIONS DISAPPROVING OBJECTIVE TEST

First, in substance, "not sure that objective test is the solution." No other test was suggested deemed to be better. It is submitted that so long as the objective test offers a great improvement over the subjective test and is the only one proposed derived from judicial authority and is the only one having a published text book fully setting forth and applying the test, then such objection is outweighed.

Second, in substance, "The proposal would require the Patent Office to grant a patent and presumably the courts to sustain it if it involved any new functional relationship however minor or insignificant it might be." No example of any such minor or insignificant invention was given. Would the barb wire case be of such "minor" or "insignificant" character? Here we have a subjective approach in the question of what is "minor" or "insignificant." Assuming there is such: It is submitted that any new functional relationship which such objector may be fearing would be one which would produce a result which could readily be obtained by a nonequivalent device. However, this may be the increased advantages of the objective over the subjective test, it is submitted, well warrants its inclusion as suggested herein.

Moreover, it is submitted, it is precisely where the change is small as in the barb wire case that the inventor needs the approximation to a criterion for precise definition of a patentable invention as afforded by the objective test proposed, and thus inventions of the inherent order of the barb wire case will be protected.

### VIII. THE SUPREME COURT IN DECISION PRIOR TO WRIT OF CERTIORARI NEVER HELD PATENT CLAIM VOID FOR LACK OF PATENTABLE INVENTION EXCEPT WHERE NO NEW FUNCTIONAL RELATIONSHIP WAS ESTABLISHED. * * * OBJECTIVE TEST HARMONIZES THE CASES

The following paragraph supplies an assurance drawn from the history of the Supreme Court patent determinations which constitutes a most unique endorsement of said test.

"In view of the fact that not a century has elapsed since the Federal courts began to consider questions arising under patents for invention, and that in every branch of law, much time and long experience are ordinarily required for the determination of principles which are to settle its uniform administration; it may be regarded as remarkable, not to say marvelous; that the Supreme Court has never yet decided a patent claim to be void for lack of patentable invention in its subject matter, except where no new functional relationship was established by or between the things claimed It is true that the reason from time to time assigned for denying patentablility to the various alleged inventions involved in the 131 cases cited as belonging to this category, have not been explicitly stated in the judicial opinions rendered thereon, to be grounded upon the absence of any new functional relationship in the subject matter claimed; but it is manifest

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from careful analysis that the entire series of such cases may be satisfactorily explained and harmonized by the application of such a test. They were all decided within a period of 75 years, 1850–1925; and they serve to show how successful the conservative attitude of the Supreme Court has been in preserving the rights to genuine inventors, notwithstanding the difficulties attending the discrimination of the new from the old. * * *" (Patentability and Patent Interpretation, page 170.)

IX. REBUTTAL OF ALLEGATION THAT COURTS HAVE NOT APPLIED THE OBJECTIVE TEST—ON CONTRATY COURTS HAVE APPLIED SAME AND SPOKEN IN TERMS OF FUNCTIONS AND SPECIFICALLY APPBOVED GEORGE L. ROBERTS' STATEMENT OF THE OBJECTIVE TEST

N. B.—How Court in these cases look at "duty" or "office" or "function" which the elements or factors perform in an invention and compares them with functions of factors of prior devices rather than ask, Is this "obvious"? (Italics are ours unless otherwise indicated.)

The Supreme Court in cases cited and extracted below has expressly analyzed the differences between elements of prior art and invention before the Court and has used the term *"functions"* in so doing.

Moreover, the District Court in *Submarine Signal Corp.* v. *General Radio Co. et al.* (D. C. Mass. July 20, 1926) states that the test of invention is objective, criticizes the subjective test as impractical and states (citing with approval) that the court has considered the unpublished notes of George L. Roberts, Esq. of the Suffolk bar. It is interesting to note parenthetically that, in this case, the winning plaintiff was represented by the eminent law firm of which three distinguished members on the coordinating committee formulating the present bill are members or associates. The objective test was good law then and it is submitted it is good law now and should be included in the present bill.

This Submarine Signal Corp. case will be quoted first, since it is so directly in point.

*Submarine Signal Corp.* v. *General Radio Co. et al.* (D. C. Mass., July 20, 1926. 14 F. 2d 178) (courts and other tribunals have adopted and cited this case with approval in many cases):

"The defendants rely principally upon the Berggraf device as showing an anticipation of the plaintiff's invention. They adopt the conventional method of testing an invention, by contending that a person skilled in the art, having this device at hand, could produce the plaintiff's apparatus by certain changes. (That is it would be 'obvious' insert ours). This contention shows the unsatisfactory nature of the 'skilled mechanic' criterion of invention.

"A test of invention may be either subjective or objective. We may determine either the novelty of an idea or the novelty of the result of this idea. The first test is impractical. Psychology is not yet so exact a science as to allow us to classify and arrange in order of importance the ideas of the human brain. Nor does it assist us to substitute for the brain of the patentee, whose idea we are criticizing, the brain of that *imaginary* person of the patent law, the skilled mechanic. The test is still that of the relative importance of ideas.

"George L. Roberts, Esq., of the Suffolk bar, has considered this subject in an unpublished treatise which I have been privileged to study. He shows that the true test of invention is the novelty of the result, and that this result must be criticized by comparing it with the machines, processes or methods known before. *The test is an objective one.* If the result of an idea is a machine or process involving *a new function* or *an old function* arrived at by new means, the embodiment of the idea is patentable. In *an exhaustive* survey of all the cases relating to the question of patentable novelty in the Supreme Court of the United States, from the earliest times down to 1915, Mr. Roberts has shown that the test above suggested is consistent with them all, with three exceptions, which he regards as anomalous."

The above speaks most clearly and positively in favor of the objective test. Since the objective test has thus been made a part of the law by judicial decision, why should it not now be embodied in the statutory law?

Justice Clifford. *Union Paper Bag Machine Co.* v. *Murphy* (97 U. S. 120, 125 (24th ed. 935)):

"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 names 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*

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*it*, and to find that one thing is substantially the same as another, if it performs substantially 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 when they perform different *functions* or in a different way, or produce a substantially different result."

(How well these words fit the analysis given relative the barb wire fence and the brace and bit-screw driver illustration given by witness.)

The above language of Supreme Court in testing for patentable novelty in determining infringement was applied in *Hiler Audio Corporation* v. *General Radio Co.* (26 F. (2d) 475, 479 D. C. 1928).

"Notwithstanding the slight mechanical difference in construction, the two devices perform the same *function* in the *same way*, and accomplish substantially identical results. The two cores in the defendant's impedance coupler are the mechanical equivalents of the single core in plaintiff's unit."

"* * * The testimony shows that the iron portion of the core structure between the coils of the defendant's unit *function* as a magnetic path * * *."

N. B.—How Court is comparing function of element by element, is not speculating whether it is "obvious" or whether it is "only mechanical skill." Who knows, the boundaries of these subjective terms? No one, it seems clear.

Judge Brewster endorsed the obective test explained above by Judge Lowell in this manner:

"I also derive assistance from the learned opinion of Judge Lowell in *Submarine Signal Corp.* v. *General Radio Co.* ((D. C.) 14 F. 2d 178, 181), wherein he points out that the "true test of invention is the novelty of the result, and that this result must be criticized by comparing it with the machines, or processes, or methods known before. *The test is an objective one* If the result of an idea is a machine or process involving a new *function*, or an *old function* arrived at by *new means*, the embodiment of the idea is patentable"

The court proceeds comparing and using term "functions."

*Wright* v. *Yuengling* (155 U. S. 57, 58):

"Wright's only invention, then, was in the combination of the cylindrical guide with the trough shown in the Farrar patent. Did this accomplish a new and valuable result it is quite possible that a patent therefor might have been sustained, but we do not find this to be the case The cylindrical guide performs the *same functions* as in the prior patents: the trough in which the connecting rod works in the Farrar patent, is practically the same as in the Wright patent, and the combination is a mere aggregation of their respective *functions*, if the combination of the trough and cylindrical guide of the Wright patent gives greater lightness and strength to the frame than the combination of the trough and the flat guides of the Farrar patent, it is a mere matter of degree, a carrying forward of an old idea, a result, perhaps, somewhat more perfect than had theretofore been attained, but not rising to the dignity of invention. * * * "

*Reckendorfer* v. *Faber* (92 U. S. 347, 358):

After comparing duty of lead and the eraser of a pencil, the court stated:

"* * * There is no relation between the instruments in the performance of their several *functions*, and no reciprocal action, no parts used in common."

*Richards* v. *Chase Elevator Co.* (158 U. S 299, 302, 303, (1894)):

"* * * So long as each element performs some old and well-known *function*, the result is not a patentable combination, but an aggregation of elements * * *"

"Not a new *function* or result is suggested by the combination in question * * *".

*Grinnell Washing Machine Co* v. *Johnson Co* (247 U. S. 426, 433, (1917)):

"In *Specialty Mfg. Co* v. *Fenton Metallic Mfg. Co* (174 U. S. 492, 498), the rule was again tersely stated:

"Where a combination of old devices produces a new result, such combination is doubtless patentable; but, where the combination is not only of old elements but of old results, and *no new function* is evolved from such combination, it falls within the rulings of this Court in *Hailes* v. *Van Wormer* (20 Wall. 353, 368), etc. (citing cases).

"Applying the rule thus authoritatively settled by this Court, we think no invention is shown in assembling these old elements for the purposes declared. No *new function* is 'evolved from this combination'; the new result, so far as one is achieved, is only that which arises from the well-known operation of each one of the elements"

*Lincoln Engineering Co.* v. *Stewart-Warner Corp.* (303 U. S. 545, 549 (1937)):

"* * * The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different *function* or operation

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than that theretofore performed or produced by them is not patentable invention. And the improvement of one part of an old combination gives no right to claim that improvement in combination with other old parts which perform no new *function* in the combination. Though the respondent so concedes, it urges that in the combination of the Butler patent, the headed nipple performs a new and different *function* from that which it has heretofore performed, in other combinations, in that, when the coupler is withdrawn from the nipple, at the end of the greasing operation, the rounded head of the nipple "cocks" the jaws of the coupler for the next operation. * * * Moreover, the argument is unsound since the old art includes instances where the head of a nipple or fitting performs a similar *function* when the chuck is disengaged from it."

69 Corpus Juris Secundum, section 55, p. 275, Copyright 1951, states that:

"A test sometimes resorted to in distinguishing between inventiveness and mere mechanical skill is whether some new result is brought about by new means or by a new arrangement of old ones (40). *The latter is an objective test* (41). Measured by it, *invention is involved* if the result of an idea is a method or thing involving a *new function* (42) or an old function arrived at by new means."

The above exemplifies the use of the objective test in dealing with the *functions* of the elements even to 1937. The referring to *functions* shows that the Court is not thinking subjectively.

Surely this committee would not knowingly take away what basis we have for the applying of the objective test. By not including the proposed paragraph, the committee, in effect, it is submitted, would be taking away from inventors the protection they now have in applying the subjective test. Even when new functional relationships are established at present, the courts are under no obligation to hold patentable novelty exists. This is why the proposal includes the mandatory feature so that, after an inventor has spent years developing and marketing his patented invention, he will not have his rights lost to an infringer with the Court simply stating "we *think* the invention is within the skill of the art" or its equivalent.

X. CONCLUSION

With all humility and with all earnestness, the witness most sincerely petitions this committee to include the objective test as set forth herein. It is the key to overcoming the confusion which now besets the patent system.

The National Patent Planning Commission, Charles F. Kettering, chairman, in its 1943 report recommended "that patentability shall be determined objectively * * *". That committee was referred to the text of Mr. Roberts by the witness so that it was the test of Mr. Roberts' text which was recommended.

This Judiciary Committee is the real national-defense committee, because you have it in your power to recommend the test for patentable novelty which is a criterion derived from judicial authority, the only test proposed that has been so derived formally. Our workmen need the best of machines to enable them to turn out a thousandfold more goods than rivals abroad to maintain our economic life: our soldiers need equipment to make them the equal of a thousandfold of the enemy to preserve our liberties. Our very existence as a nation is in large measure dependent upon a sound patent system

Including the objective test in section 103 (H. R. 3760), it is submitted, will help restore the wholesome incentive to the patent system and thereby help maintain our American way of life economically and militarily.

*As a matter of irrefutable logic, it is submitted that the objective test should be included in the present bill.*

If any question relative to the above arises which the committee or any member of the committee desires to have answered, the witness will appreciate the opportunity of seeking the answer.

Most sincerely and respectfully submitted.

G. WRIGHT ARNOLD.

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WASHINGTON, D. C., *June 18, 1951.*

Hon. JOSEPH R BRYSON,
*Chairman, Subcommittee on Patents, House Judiciary Committee,*
*Washington, D. C.*

SIR: You will probably recall that I appeared before your committee last week as chairman of the patent committee of the Bar Association of the District of Columbia to express the approval of said association with respect to H. R. 3760, as amended, particularly by the proposed amendments of the coordinating com-

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mittee of the National Council of Patent Law Associations, which amendments had been presented to your staff and dated May 22, 1951

Having attended these hearings, I would like to suggest individually and on my own responsibility, as a member of the bar of the District of Columbia and as a practicing patent lawyer, four further amendments which seem to me to be desirable and which probably may compose the differences between the present language of the bill and some points urged by several of the witnesses. These proposed amendments are as follows:

1. In section 100 of the bill, subsection (a), I would revise to read as follows:

"(a) The term 'invention' includes, but is not limited to, discoveries made in the useful arts."

Also in section 101 of the bill, line 1, after "discovers" insert ", in the useful arts,".

My contribution in the above-revised sentences resides in the words "in the useful arts" This definitely limits inventions and discoveries in the manner defined in article 1, section 8, clause 8 of the Constitution of the United States. Patents for inventions and discoveries, according to the balanced phraseology of this portion of the Constitution, are limited to the useful arts, and it is my contention that the implementing law should recite this fact. In accordance with this balanced writing, science (or general knowledge) was never intended to be subject matter of patents but the subject matter of copyrights, and no previous implementing law passed by the Congress has ever included science as patentable subject matter. It should, therefore, as said above, be definitely stated in the present bill that the inventions and discoveries are those made in the useful arts

2. I am in agreement with the statement made or given to your committee by Mr. G. Wright Arnold of Seattle, Wash.; and, therefore, suggest that at the end of section 103 of the pending bill that the following paragraph be added for the reasons that he has urged:

"Whenever there is established a new functional relationship between any of the factors which are required for rendering an invention in the *useful arts* practically operative, patentable novelty shall be found"

3. With respect to the discussion before your committee concerning section 231, I have the following suggestions to make which I believe will compose the differences which were emphasized in the discussion between Congressman Rogers, Mr. Fugate of the Department of Justice, and Mr. Rich. Consequently, I suggest that subsection (c) of section 231 be rewritten as follows:

"(c) Whoever sells a component of a patented machine, manufacture, combination, or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention especially made or especially adapted for use in an infringement of such patent and not a staple article or commodity of commerce suitable for substantial noninfringing use, and who has knowledge at or prior to said sale that said component material or apparatus is to be used in a manner that will result in an infringement of such patent, shall be liable for infringement as a contributory infringer."

4. My other and last suggestion has to do with subsection (d) of section 231 and consists merely of inserting the word "solely" after the word "done" in line 4 of said subsection (d). All witnesses seem to agree that neither any nor all of the three acts by a patent owner, as mentioned in subsection (d), should or would constitute a misuse of the patent, if only these three conditions are present, or any one of them, and consequently relief should not be denied nor should there be any guilt of misuse or of illegal extension of the patent right. Thus, the inclusion of the word "solely" at the place indicated in subsection (d) and the rewriting of subsection (c), as above suggested, should remove all objections raised by Mr. Fugate.

I know that your correspondence on this matter has been very large, and I hope that the above does not overburden you, but I sincerely offer the above suggestions with the recommendation that they be incorporated in the present bill.

Respectfully submitted.

EDW. R. WALTON, JR.

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PHILADELPHIA, PA., *June 18, 1951.*

Re H. R. 3760

Hon. JOSEPH R. BRYSON,
*Chairman, Subcommittee No. 3,*
*United States House of Representatives,*
*Washington, D. C.*

DEAR SIR: I appreciate the opportunity you have given me during the hearings on H. R. 3760 to file a statement. I have been a student of the patent system for over 25 years, having been an examiner in the Patent Office from 1923 to 1935 and in private practice as a patent attorney since 1935, representing large and small corporations as well as individual inventors. I have thus had an opportunity to observe the workings of our patent system inside the Patent Office as well as in industry.

I should like to state that I am heartily in favor of the enactment of H. R. 3760 and urge your committee to give it favorable action and also to take into serious consideration the suggestions presented by the coordinating committee of the Patent Law Association. I attended all the hearings and have been impressed by the remarkable unanimity of agreement of representatives and industry from all over the country in favor of this bill.

There is just one matter I should like to mention which is not in H. R. 3760, but it has been suggested during the hearings to insert a provision for permitting the Patent Office to publish patent applications which would merely serve as publications or disclosures of technical information without having the status of a patent. However, it was proposed to make such published applications effective as of their filing date. I regard this suggestion as being highly undesirable because it may be very harmful to inventors. It would be possible to file applications in the Patent Office containing a great deal of speculative technical material which might vaguely refer to possible desired improvements or results without having any technical or factual basis. Such applications could be kept pending for several years and then finally published so as to prevent a bona fide inventor from getting a patent because such publication would be effective not from its publication date but from its filing date in the Patent Office. During all the time the application was pending, it would not be available to the public since the Patent Office processes all applications in secrecy. Such hidden disclosures secretly slumbering in the Patent Office for years would bring panic and disaster upon bona fide inventors working on their own who might spend all their time and money in developing an invention without any inkling of such hidden data and then suddenly find themselves cut off from any chance of getting a patent by a published application suddenly issued by the Patent Office having a date going back perhaps 4 or 5 years. Accordingly such proposal would be very detrimental to inventors.

Furthermore, such proposal would pervert the function of the Patent Office which is established to grant patents and not to function as a publication agency of what may be unreliable or questionable technical information which may be vague, unchecked, highly speculative, and never examined rigorously for its technical competency and reliability. Under the proposal the Patent Office would publish a great mass of technical data which has not been subjected to any critical evaluation and would thus give additional imprimatur to technical information which may be incorrect, misleading, and worthless. Certainly industry and the public welfare will not be promoted by such proposal which at best would operate as a vicious secret technical booby trap to be sprung upon bona fide honest inventors by those who would deprive them of their hard-won inventions.

I am convinced H R. 3760 as a whole is a much-needed step in the right direction. We are badly in need of codification and clarification of our patent laws since no complete overhauling has been done since 1870. Our patent system operates equally and effectively for the little inventor as well as the big corporations in offering a powerful incentive to the inventor to make inventions and to the businessman to invest capital in new enterprises. From these joint incentives the public has obtained tremendous benefits which it would otherwise never get. As a result, we have achieved during the past century a remarkable technical advance never made previously in all of human history. Our patent system has thus been the mainspring of our entire industrial development. It has spurred on the individual inventor and the businessman to apply their brains, energy, and resources to give us our technology and standard of living which are foremost in the whole world.

In recent years, however, there has been a serious decline in the number of inventions made in our country, although our population and economy has

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been steadily growing. In spite of the greatly increased expenditures by Government and industry on research work the number of inventions made annually as measured by the patents granted each year has steadily declined at an alarming rate. I believe one of the causes of this decline can be attributed to the confusion and uncertainty of our patent laws as shown by the decisions of the courts in patent cases. As a result the incentive to invent has been greatly diminished.

The number of individual inventors working on their own has steadily declined so that as a result today most of the research and inventing is done only by corporations and large research organizations. The businessman today hesitates very much in backing an inventor because of the state of uncertainty of our patents and the very unfavorable attitude of the courts, especially the Supreme Court, in enforcing patents. Today our Federal judges look for every possible technicality and excuse to invalidate a patent and they seem to overlook the social benefits which the public derives from benefits so wisely provided for in our Constitution. I therefore believe that H. R. 3760 is a step in the right direction and should help to eliminate some of the existing confusion and uncertainty.

We are involved today in a world struggle which may subject our economic and political philosophy possibly to the ultimate test of survival against the completely hostile and destructive philosophy of communism. Today we seem to be outnumbered by the total population dominated by Communist philosophy. Fortunately, our superior technology, I am sure, will enable us to preserve our social system which stands for the dignity and freedom of the individual. However, we must make certain that we maintain our technical superiority and this can be done only by encouraging and developing new inventions. This can be accomplished effectively as we have done in the past by offering adequate incentives and rewards to inventors and business to develop inventions and put them to work for us.

The individual inventor must be encouraged and rewarded more than ever before if we are to win our fight against communism. I refer you to my book, The Psychology of the Inventor, to indicate further the vital role of the individual inventor in our economy and some of the pitfalls which he encounters which we should help remove.

The inventor is our greatest and most vital national resource. He was a vital agent in building our present industrial economy in a region void of any technical facilities when the colonists settled here. He deserves to be honored and duly rewarded for his creative work which enriches the public welfare. The inventor should be recognized as a citizen of great importance because he is a public benefactor. He should therefore be given an opportunity to obtain his due reward through his patents by making sure that proper respect and adequate legal consideration is given to his patent property.

President Franklin D. Roosevelt said:

"Patents are the keys to our technology; technology is the key to production; production is the key to victory." (TNEC hearings, pt. 1, p. 2, 1942.)

The Supreme Court has aptly summed up the vital function of the inventor by saying in *U. S. v. Dubilier Condenser Corp.* (289 U. S. 178):

"An inventor deprives the public of nothing which it enjoyed before his discovery, but gives something of value to the community by adding to the sum of human knowledge."

In a recent editorial in Chemistry and Engineering News, June 11, 1951, the following very important statement is made:

"Research palaces and superduper production facilities are meaningless unless adequately staffed with highly skilled scientists and technologists. Completely outnumbered reputationwise by those behind the iron curtain, our one chance of survival is the continuation of our superiority in fundamental and applied research and vast production of literally thousands and thousands of items vital to both our civilian economy and modern warfare. The fast-approaching bottleneck of too few scientists and technologists can well be the most efficient secret weapon possessed by Stalin and the Politburo. If the present trend is not shortly reversed, our leadership in science and technology will disappear and will be supplanted by Russian domination in science and technology for we can be dead sure that Russia is straining every effort to overcome our present lead. Once our technical superiority is lost our political liberty will be gone."

Dr. James B Conaut, president of Harvard University, recently stated at the dedication of the new laboratories of the du Pont Co. the following:

"The typical inventor was essentially an empiricist. Indeed, we used sometimes to speak of the cut-and-try methods of experimentation as Edisonian

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methods. Therefore, as theory developed in physics and chemistry and penetrated into practice, as the degree of empiricism was reduced in one area after another, the inventor was bound to disappear. Today the typical lone inventor of the eighteenth and nineteenth centuries has all but disappeared. In his place in the midtwentieth century came the industrial research laboratory and departments of development engineering

"The second point is that the revolutionary advances in theoretical science were made very largely by amateurs And clearly almost all the great advances in industry until this century were made by the independent inventor. These men have passed. They have no intellectual descendants Will their twentieth century equivalents—the professional scientist, the applied-science laboratory, the engineering group—be able to carry on? Some of you may be inclined to laugh at this question. Why, of course, you will say. Look at what has happened in the past 30 years You yourself have just spoken of the startling advances in applied chemistry Look at the electrical industry; the new way of advancing science, pure and applied, is far better than the old. Perhaps; but I submit it is too soon to draw definite conclusions. There is such a thing as momentum in human affairs as well as in physics. And I submit that we of the midtwentieth century have been moving forward to a considerable degree because of the momentum accumulated in the days of the amateur and the lone inventor. At all events, there is sufficient doubt about the ability of the new ways to be substituted for the old for us to examine the problem with some care."

I believe that one of the best ways to insure the continued and increased production of inventions is to make sure our patent system is in a healthy state. H. R. 3760 will help toward that end, but we need more action and I urge you, Mr. Bryson, to have your committee investigate other phases of our patent system with a view to possible legislation so as to make sure inventions will be produced at an adequate rate to maintain our technological superiority to insure our survival over communism.

I therefore suggest that your committee hold hearings to investigate the following subjects which I believe urgently need legislative action:

### 1. REFORM OF PATENT OFFICE PROCEDURE

The Patent Office is one of the most efficient and oldest administrative agencies in our Government. It has done a remarkably fine job under the present statutes and with insufficient personnel and facilities. The present Rules of Procedure were completely revised in 1949 and are a tremendous improvement over the old rules. However, the Patent Office necessarily must operate within the confines of the present patent statutes and accordingly has not been able to make much needed reforms in procedure We have today a highly complex and involved procedure in the Patent Office full of hazards and pitfalls for the inventor Our whole patent-claim structure has grown to a gigantic monstrosity, full of metaphysical and semantic absurdities. This is costing inventors endless grief, expense, and loss of patent rights. The prosecution should be simplified to reduce present-day high cost of prosecuting patent applications. The Patent Office also needs better facilities for literature and prior-art searches.

The present interference procedure in the Patent Office involving conflicting claims to the same invention is extremely technical, complex, and expensive. This procedure should be thoroughly overhauled.

### 2. PATENT LITIGATION REFORM

Patent litigation has become extremely expensive and hazardous in the Federal courts. Most Federal judges frankly don't like to handle patent cases because they lack the necessary technical background. Justice Frankfurter has said, for example, "Judges must overcome their scientific incompetence as best they can." (*Marconi* v. *U. S.* (320 U. S. 1).) Your committee should give consideration to the establishment of special patent courts for adjudicating patents.

### 3. STIMULATING INVENTIONS

Congress should study the question of stimulating and fostering new inventions and how to best accomplish this through the patent system or perhaps through additional means such as through grants-in-aid of inventors to help inventors develop inventions, to patent them and to enforce them so as to get their due reward.

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Consideration should also be given to the problems of small business investing in new inventions and how we can stimulate and encourage businessmen to spend money on research and developing inventions so as to ensure adequate incentives and reasonable returns from such efforts and investment. Due consideration should be given to the tax problems involved in such investments, granting of priorities for materials and manpower, etc , so as to further the public interest.

If we are to prevail over the evil forces conspiring against our free-enterprise system and individual liberty, we must turn to the inventor to rescue us. The inventor has liberated us from physical slavery, from a filthy precarious animal existence to the possibility of living a full and rich life. He has freed us from the adverse forces of our physical environment so that we are no longer slaves to natural forces The inventor has given us our physical environment in which the dignity of the human individual can rise to its utmost heights. Today the inventor can also save us from loss of our individual liberty and freedom and our American way of life by giving us the physical implements to fight and overcome our enemies. The inventor is our most precious asset and savior against the serfdom of communism. We must do everything possible to encourage and help him or we will surely perish

Respectfully,

JOSEPH ROSSMAN.

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123 SOUTH BROAD STREET, PHILADELPHIA, PA ,
*June 22, 1951.*

Re H. R 3760.

Hon. JOSEPH R BRYSON,
*House Office Building,*
*Washington, D. C.*

DEAR MR BRYSON. The suggestion made during the hearings on this bill to amend section 122 (confidential status of applications) to include the second paragraph of section 121 of former H R. 9133 (or its equivalent), if adopted and enacted into law, would, I believe, so emasculate our patent system as to virtually destroy its vitalizing force in our economy.

My views in this respect are more fully set forth in the attached counterpart of a letter which I wrote to a member of the coordinating committee when H. R. 9133 was before it for consideration. It is my understanding that the coordinating committee voted against this provision tor the publication of patent applications in large part on the basis of the views expressed in my letter, and it is for this reason that I feel certain that you and the other members of your subcommittee would prefer to have these views before it for consideration.

In addition, I should like to point out that, to the best of my knowledge, in all instances where the pros and cons were fully developed before a vote was taken, the members of all groups considering this provision have voted it down Obviously, a vote taken on a matter as to which no issue is presented, or on which only the pro side is presented, is rather meaningless The thonght here is that you might wish to determine rather exactly how the vote was taken on this matter in the case of group representation before your subcommittee.

From the nature of the attached you will no doubt conclude that I am in the employ as patent counsel of a small company, which is true. I have not employed company stationery simply because I wish to bring out that the views expressed are my own.

It is my sincere hope that this letter and the attached will receive your most careful consideration.

I am enclosing extra copies so that you may distribute them among the members of your subcommittee if you wish.

Yours very truly,

HUGO A. KEMMAN.

Re H R 9133—Codification of the patent laws.

DECEMBER 1, 1950

DEAR ANDY: I have given the second paragraph of section 121 of H. R 9133 some further study, and I believe that it might be quite properly labeled the section to prevent competitors from getting patents. In this connection you will recall the often-told story about the company that published material (upon which it could not do a great deal of research in view of more pressing projects)

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in a newspaper in a small town in the South which was more or less isolated in the hill country. In this way it obtained publications which were quite effectively hidden, but which could be used to anticipate any patents which a competitor might obtain in fields which the company wished to hold open for its own possible entry at a later date.

As you know, no research program is ever capable of even beginning to exhaust all of the possibilities in a field The way to hold open that portion of the field which cannot be immediately explored is to make all manner of suggestions therein, whether responsible or irresponsible, and obtain publication thereof in the hope that this will anticipate the other fellow's patent

The difficulty, of course, is in obtaining publication, particularly of material not supported by factual data. One method is that referred to above. Another method which has been resorted to is the taking out of a patent in a foreign country which employs the registration system, such as France. In both instances, however, many patents have nevertheless issued because it was always difficult to get such publication under the nose of the examiner. Then too, both systems of publication had a very serious drawback in that they provided a competitor with the current thinking of the company making the publication, if the competitor got wise to what was going on. So we come along with the second paragraph of section 121 which is really made to order. There will no longer be any difficulty in getting the publication under the nose of the examiner for he will have been examining the very application being published, and there will no longer be any danger of providing one's competitor with one's current thinking, for the whole subject matter may be kept in secret for from three to five or more years by merely keeping the application pending in the Patent Office No idea that doesn't click is worth much after this period, so that the public will gain nothing from its publication.

Then too, we must not overlook the fact that this provides a very effective tool in breaking a competitor's morale in the development of new ideas, and in keeping new competitors from entering the field. In warfare it is well recognized that the greatest morale breaker for the enemy is to let him complete a vast project before you blow it to pieces for him He, of course, has been operating with the mistaken idea that his activities would not be noticed by the other side, the same as a competitor (or a potential competitor) operates in developing a new idea. So after a competitor spends large sums of money in developing a new process, or in bringing out a new product, with the belief that he has the field preempted by way of patents, all that need be done is to expose the proper card, namely, the proper patent application, to effectively anticipate everything which he has done. If the timing is right, the application may be published before the competitor's patents issue, thus preventing their grant. The interference procedure should help in ascertaining what applications a competitor has pending.

As you know, any publication is effective as a reference, irrespective of the amount of irresponsible material it may contain. Furthermore, in accordance with recent decisions, a mere suggestion is sufficient to anticipate. So we have everything very nicely set up for those companies who, while paying lip service, in fact find the patent system to be a disconcertingly restrictive nuisance. Many companies are so large that they do not need a patent system for purposes of doing business. Some have arrangements whereby they exchange new ideas freely among themselves. Their patent departments are maintained largely for defensive purposes and for the purposes of attracting competent research men who somehow have a preference for seeing their contributions reach the public in the form of patents. On the whole, however, such companies would be far better off if the whole patent system were abolished, or in lieu thereof, the number of patents very greatly restricted so as to make the patent system ineffective. In widespread business operations, the dangers of patent infriugement are quite troublesome, particularly when a company wishes to expand even further.

It follows that if the second paragraph of section 121 is enacted into law, it will mark the beginning of the end of our patent system as a vitalizing force in our economy. I will not question its constitutionality, but it certainly nullifies that which the fathers of the Constitution had in mind.

As you no doubt know, the present practice in many foreign countries is such that before a patent issues the specification must be conformed to the claims, eliminating all excess matter. My foreign associates have just given me a sampling of such countries and they are England, Switzerland, Germany,

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Holland, Sweden, Norway, Denmark, Finland, and possibly Japan, which is expected to follow its previous practice in this respect. Such practice was undoubtedly adopted to do away with the many broad irresponsible statements that foreign patents used to contain. In fact there was a time when such statements in foreign patents were so irresponsible that this became recognized by the United States Patent Office in decisions refusing to rely upon such statements as anticipations. You no doubt will recall certain decisions of this kind.

It seems to me that we should try to benefit by the experience of others in connection with such statements and not insist on learning the hard way.

I could say much more in speaking against the second paragraph of section 121, but I believe the above will give you some things to think about.

Yours very truly,

HUGO A. KEMMAN.

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DENVER, COLO., *June 20, 1951.*

SUBCOMMITTEE No. 3, JUDICIARY COMMITTEE,
*House of Representatives,*
*Washington, D. C.:*

Patent-codification bill. Proposals to publish patent applications reflect perversion of constitutional intent in and seek return of caveats long discarded as unsuited to American economic philosophy. Original committee-print proposal has been repeatedly considered and defeated by patent coordinating committee and individual groups. Proposals are inimical to individual inventors and small businesses and can benefit only large corporations who would neither seek nor require patents to maintain their dominance. Government defense agencies should if necessary be accorded a personal defense unavailable to general public.

Very respectfully,

MAURICE W. LEVY.

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GOVERNMENT PATENTS BOARD,
OFFICE OF THE CHAIRMAN,
*Washington, D. C., June 18, 1951.*

HON. EMANUEL CELLER,
*House of Representatives,*
*Washington 25, D. C.*

DEAR MR. CELLER: In response to your request of May 24 for an expression of views on the proposed legislation, H. R. 3760, I would submit the following statement as an indication of my views as Chairman of the Government Patents Board, in which the Board concurred at its meeting on June 4.

The Government Patents Board and this Office were established by Executive Order 10096, issued by the President on January 23, 1950, to provide for a uniform patent policy for the Government with respect to inventions made by Government employees and for the administration of such policy.

The only provision of H. R. 3760 with which the activities of this Office and the Board are likely to be concerned is section 212. If this section is to be included substantially as proposed, it is suggested that the section be amended (1) in lines 3–4 by deleting the words "but neither of the owners" and substituting "and any owner"; (2) in line 5 by deleting the words "or without accounting" and substituting "provided he accounts"; and (3) in line 6, before the period, by inserting the words "for any material consideration therefor"

While the above amendments would be preferred if the section is to be included substantially as proposed, there would be no objection to the reinstatement of the similarly numbered section 212 in H. R. 9133, Eighty-first Congress.

I am advised that the Bureau of the Budget would interpose no objection to the submission of this report to the Congress for its consideration. If I can be of further assistance to you in this matter please call upon me.

Sincerely yours,

ARCHIE M. PALMER, *Chairman.*

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C E. NIEHOFF & Co, AUTOMOTIVE PRODUCTS,
*Chicago, Ill, June 6, 1951.*

Subject bill H. R 3760.

HON CHAUNCEY W. REED,
*House of Representatives,*
*Congress of the United States Washington, D. C.*

DEAR CONGRESSMAN REED: May I direct your attention to the above bill, H R. 3760, page 22, section 231, parts B, C, and D referring to infringement of patents.

In my opinion this brings up a controversial matter which has been previously objected to and we are again objecting to it, as we did in the original bill, H. R. 5988, of the Eightieth Congress, and also in the bill H. R. 3866, of the Eighty-first Congress; both of which were discussed with your Judicial Committee in previous years.

Actually section 231, parts B, C, and D, headed "Infringement of patents," brings up an issue which looms as a very serious factor to us. We are engaged in the manufacture of replacement parts for the maintenance of automobiles, trucks, busses, tractors, and so forth, and it is only a relatively few years ago when we had to defend successfully a number of suits brought by General Motors which were carried to the court of appeals, in which the same issue of supplying unpatented parts for replacement to a distributor, such as used on automobiles of today, was determined

The Supreme Court refused General Motors a hearing, thus sustaining a successful appeal. If General Motors had succeeded in their appeal, it may have resulted in giving the car manufacturers a complete monopoly on replacement parts or such unpatented parts, resulting therefore in an unreasonable level of prices to the motoring public

We said at that time, that it was emphatically demonstrated through the World War II period, that these large concerns were unable to supply the needed parts for cars, trucks, busses, farm implements, and so forth, and it was the smaller manufacturer that helped to supply their needs Actually, this bill might affect our business very seriously for the future.

We believe the comments made by J. Carter Fort, of the Association of American Railroads, emphatically set forth the seriousness of this bill, section 231, parts B, C, and D in the maintenance of railroad transportation, in objecting to bill H. R 5988 and as shown on pages 82 and 83 under Serial No 21, subcommittee hearings of the Eightieth Congress It is our belief, therefore, that this is a controversial matter which has been previously objected to and we are, therefore, submitting this to you as a member of the Judicial Committee for your consideration of the same matter which is now appearing in the new bill.

Thanking you for your kind attention that you may give this problem, we remain,

Sincerely yours,

C. E. NIEHOFF.

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DEPARTMENT OF JUSTICE,
OFFICE OF THE DEPUTY ATTORNEY GENERAL,
*Washington, July 3, 1951.*

HON. EMANUEL CELLER,
*Chairman, Committee on the Judiciary,*
*House of Representatives, Washington, D C.*

MY DEAR MR CHAIRMAN: I enclose an extension of the testimony of Mr. Wilbur Fugate, of this Department, relative to H R. 3760, a bill to revise and codify the patent laws.

Mr. Fugate testified before Subcommittee No. 3 of your committee on June 15, 1951, but time did not permit a completion of his statement. Mr. Bryson, chairman of Subcommittee No. 3, stated at the conclusion of the oral hearings that the record would remain open for additional statements.

The Department as stated in our letter to you of June 13, 1951, is particularly concerned as to the possible effect of section 231 of the proposed bill in limiting the application of the patent misuse doctrine. The rule that a patentee who has misused his patents may not recover in a suit for direct or contributory infringement is, in the opinion of the Department, a salutary principle which is important in the enforcement of the antitrust laws.

Yours sincerely,

PEYTON FORD,
*Deputy Attorney General.*

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EXTENSION OF TESTIMONY OF MR. WILBUR L. FUGATE, ANTITRUST DIVISION, DEPARTMENT OF JUSTICE

Section 231 of H. R 3760 is substantially the same as H R. 3866 of the Eighty-first Congress, first session, and particular reference is made to the statement of the Department of Justice upon that bill (hearings before Subcommittee No. 4 of the Committee on the Judiciary, House of Representatives, Eighty-first Congress, first session, on H. R. 3866, May 25 and June 3, 1949, Serial No. 17, pp. 50–60, 63–64, 75–79).

Subsection (d) of section 231 is particularly objectionable in the opinion of the Department since, although couched in general terms, its effect is to permit a patentee to sell unpatented parts for a patented device or combination and at the same time prohibit his competitors, by suit for contributory infringement, from selling such unpatented materials in competition with him Mr. Giles Rich, of the New York Patent Bar Association, who aided in drafting this section, has testified that subsection (d) (1) was designed to overrule the Barber Asphalt case (*Barber Asphalt Co* v. *La Fera Grecco Contracting Co.* (116 F. 2d 21, C. A 3, 1940)); that (d) (2) was designed to overrule the Mercoid cases; and that (d) (3) was designed to overrule the Stroco case (*Stroco Products, Inc* v. *Mullenbach* (67 U. S. P. Q. 168, D. C., S. D. Calif., 1944)). The proponents of this section of the bill, accordingly, do not so much wish to clarify the law as to change it.

In the first Mercoid case (*Mercoid Corp.* v. *Mid-Continent Investment Co.*, 320 U. S. 661 (1944)), the Supreme Court (unanimous on this issue) applied the misuse doctrine to a case involving contributory infringement and held that where there was a conflict between the two, the misuse doctrine must prevail. The misuse doctrine, in this connection, is that a patentee may not extend the monopoly of his patent by attempting, by means thereof, to control competition in unpatented articles. The practice by a patentee of granting a license to those who buy unpatented articles from him and suing for contributory infringement those who do not buy from him comes within this rule as laid down by the Supreme Court. The Stroco case is merely an illustration of the rule. The courts with few exceptions, have applied the Mercoid cases as holding that there can be no recovery for contributory infringement if the patentee has misused his patents, but that without such misuse the patentee may recover for contributory infringement. The cases of *Florence-Mayo Nuway Co.* v. *Hardy* (168 F 2d 778, C. A 4, 1948) and *Harris* v *National Machine Works* (171 F. 2d 85 (C. A. 10, 1948)), far from disregarding the Mercoid case as suggested by Mr. Rich, both refer to and follow it. The case of *Henry* v *A. B. Dick* (224 U. S. 1), overruled in *Motion Picture Co* v. *Universal Film Co.* (243 U. S. 502), was cited in the Florence-Mayo case merely for a statement as to what constitutes contributory infringement. The Court of Appeals of the Fourth Circuit still regarded this statement as good law in the absence of any misuse of the patents there involved. On pages 78 and 79 of the hearings on H. R 3866 (81st Cong.) previously referred to, the Department of Justice listed 1948 and 1949 cases (to the date of the hearings) showing that there is no confusion in the law at present with respect to contributory infringement. This list supplemented a list of earlier cases set forth at pages 77 and 78 of the hearings on a similar bill (H. R 5988) introduced in the Eightieth Congress A list of subsequent cases decided from 1949 to 1951 is submitted as an appendix to this statement.

To summarize, the Department of Justice objects to section 231 since its effect might be to carve out an area in which the antitrust laws would not operate. Acts which are a misuse of patents, particularly the expansion of the patent to cover unpatented articles might no longer be a misuse The proponents of the bill indicate that such a result is contemplated in the language of section 231 The courts are not confused as to the Mercoid doctrine and the Department opposes making an exception to the misuse doctrine under the guise of clarifying the law.

APPENDIX

(Prepared by the Department of Justice)

1949–51 FEDERAL CASES CONSTRUING THE MERCOID CASES

1. Cases discussing the effect of the Mercoid case on the contributory infringement doctrine.

*Jordan* v. *Hemphill Co.* (180 F. 2d 457, 461 (C. A. 4, 1950)), Judge Dobie:

(3) We are not impressed by the statement in defendant's brief that charges of contributory infringement are obsolete. What Mr. Justice Douglas said in

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*Mercoid Corporation* v. *Mid-Continent Investment Co.* (320 U. S. 661, 669), was: "The result of this decision, together with those which have preceded it, is to limit substantially the doctrine of contributory infringement. What residuum may be left we need not stop to consider."

Our own views on that subject were very clearly expressed by Chief Judge Parker, in *Florence Mayo Nuway Co.* v. *Hardy* (168 F. 2d 788, 785): "There is nothing to the contrary in the decision in *Mercoid Corporation* v. *Mid-Continent Investment Co.* (320 U. S. 661, 64 S. Ct. 268, 88 L. Ed. 376). That case merely applies the salutary rule that a combination patent may not be used to protect an unpatented part from competition. Nothing of that sort is involved here. What the defendants are doing is manufacturing and selling machinery with the knowledge, purpose and intent that it shall be used in a combination which will infringe. The case is one where plantiff is using his patent not to monopolize the sale of what is not patented but to prevent defendants from aiding others to infringe what is patented. A clearer case of contributory infringement could not well be imagined than that presented by this record."

*Gray Tool Co.* v. *Humble Oil & Refining Co.* (186 F. 2d 365, 368 (C. A. 5, 1951)), Judge Hutchison:

(5) The principle applied in all of these cases is that no patentee can license or refuse to license upon a condition that the licensee will, in the use of the unpatented materials, use only such material as it purchased from the patentee, nor can he accomplish or endeavor to accomplish this end by a course of business without the issuance of licenses.

This principle was first stated in its simplest form in a contributory infringement suit in connection with the granting of a restricted license, and it was for a time supposed to be applicable only to cases of contributory infringement. It was in *Leitch Mfg. Co.* v. *Barber* (302 U. S. 458), that methods of obtaining a monopoly other than by a license upon condition, were first recognized. There, in a suit against a contributory infringer, the court held that the patent could be abused just as effectively when, by a deliberate plan or scheme, the patentee withholds licenses in order to bring about the same results, as to competition, which he could obtain by granting a written license with a condition, that the patented method may be used only with materials purchased from the patentee.

As a result of that case and the line of cases following, declaring that the effort by suit to stop contributory infringement is evidence of misuse, including particularly the *Mercoid Corp* v. *Mid-Continent Investment Co.* (320 U. S. 661), the doctrine of contributory infringement has been greatly narrowed, if not completely abolished in all cases where the holder of a combination or process patent is also a seller of standard or unpatented material.

2. Cases involving misuse of patents, trade-marks, and copyrights, in which the Mercoid cases are cited.

*Automatic Radio Co.* v. *Hazeltine Research, Inc.* (339 U. S. 827, 832 (June 5, 1950)), Justice Minton:

That which is condemned as against public policy by the "tie-in" cases is the extension of the monopoly of the patent to create another monopoly or restraint of competition, a restraint not countenanced by the patent grant. See, e. g., *Mercoid Corp.* v. *Mid-Continent Investment Co.* (320 U. S. 661, 665–666); * * *

*Burt* v. *Bilofsky* (9 F. R. D. 299, 81 U. S. P. Q. 442 (D. C. N. J., 1949).

*Silvray Lighting, Inc.* v. *Versen* (10 F. R. D. 507, 87 U. S. P. Q 204 (D. C. N. J., 1950)).

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GENERAL SERVICES ADMINISTRATION,
*Washington, June 25, 1951.*

Hon. JOSEPH R. BRYSON,
*Chairman, Subcommittee No. 3, Committee on the Judiciary,*
*House of Representatives, Washington, D. C.*

DEAR MR. BRYSON: This is in reply to your letter of April 30, 1951, which requested the comments of this Administration on H. R. 3760, entitled "A bill to revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled 'Patents'."

This bill has been studied carefully to determine whether it might affect the many special interests of this Administration. Since it appears that none of the functions of this Administration are directly affected by this bill we have no comments to make at this time.

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We have been advised by the Bureau of the Budget that there is no objection to the submission of this report to your committee.

Sincerely yours,

JESS LARSON, *Administrator.*

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MINNEAPOLIS, MINN., *May 14, 1951.*

Hon. JOSEPH R. BRYSON,
*House Office Building,*
*Washington, D. C.*

DEAR MR. BRYSON: I have read and studied with great interest the bill to revise and codify the law relating to patents and the Patent Office. I have been connected with patents and patent procedure since 1905, for some 7 years as an assistant examiner in the Patent Office, and since that time as a practicing lawyer. I think, therefore, I know something about some of the weaknesses which all patent lawyers recognize in the patent laws as they exist at the present time.

I am happy to be able to advise you that I consider that you have done a distinctly outstanding job in drawing up and presenting this measure. If it can be passed with very little, if any, amendments, it will, I believe, do a great deal to stem the tide of opposition both judicial, and in industry, to our patent system.

I don't believe one has to be a patent lawyer to recognize the value to this country of its patent system. Just to illustrate, back in 1895 a patent was secured for a means of regulating hot-air furnaces, which, through operation of a thermostat, turned on and off the drafts of a coal-burning furnace. Certain brave souls who owned that patent and had $1,000 in capital organized and began doing business as Minneapolis Heat Regulator Co. That organization with that small beginning, which unquestionably grew out of the procurement of the above-named patent, has grown into the great Minneapolis Honeywell Co., one of the large and very useful manufacturing corporations of this country. In my own experience I could name quite a few other advances in our industry which were made possible through the procuring of United States patents.

To me the patent system has always seemed one of the most democratic features of a free society. It amounts to a system in which the little man may conceivably think up something upon which he will secure a very substantial reward.

It has been true, by judicial interpretation permitted by the patent law as it now exists, that the patent system has become so circumscribed that first a patent lawyer must hesitate to advise a client that anything has possibility of being patented, and second that where patents have been obtained there is extreme likelihood that they will be found invalid and worthless. So I want to express my personal appreciation of the effort being made through your bill above identified to get an improved and more satisfactory patent law which will still hold out to the inventor the possibility of his obtaining a reward through securing a patent.

It is to be hoped that your bill, either as it is or with very small amendments, may be speedily passed into law. I realize that there may be opposition to the bill and there may be delay, but I am firm in the conviction that if this bill can become law, it will advance the entire American economy.

Yours truly,

F. A. WHITELEY.

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CLEVELAND, *June 12, 1951.*

Re H. R. 3760.

Mr. JOSEPH R. BRYSON,
*House Office Building, Washington, D C.*

DEAR MR. BRYSON: Thank you for your letter of May 24 telling me that hearings on H. R. 3706 will be held on June 13. I should like very much to be there, but this will be impossible and so I will write my impressions, and ask that you include them in the record of the hearings for whatever they may be worth.

Much of the act makes no substantial changes in existing law, and therefore requires no comment other than the rather general proposal that it might cause less confusion to let the present law stand in such respects, so that whatever judicial interpretation has already been made of these sections will continue

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to apply without raising any suggestion that Congress, by repealing a section and substituting another, had meant to give a slightly different effect.

I think this applies pretty generally to sections 1 to 42, 104, 111, 113, 114, 117, 119, 120, 121, 122, 131, 132, 133, 141 to 146, 151 to 154, as far as 201 to 205, 221, 249–250, 252, 301 to 304, 311 to 314.

Starting with section 100, there is a definite attempt to clear up one of the most annoying and confusing aspects of patent law, namely: To provide some guideposts for determining what is patentable invention

The difficulty in the past seems to have arisen from the fact that the Constitution, as well as subsequent legislation, has always used broad and vague words in referring to invention and has left its specific application up to the judgment of the Patent Office and the courts. These worked out various formulas, some of the wilder being the "flash of genius" proposition and Thurman Arnold's attempts to say that what would be an invention if worked out by an individual working in a garret, would not if worked out in the research laboratory of a corporation

I am afraid that some parts of sections 100 et sequitur, are subject to the same criticism, for example: Section 100 (a) provides that "invention" shall include "discovery." Now, discovery is nearly as broad and vague a word as invention, including as it does, geographical discovery and it would seem likely that its use in this connection would lead, on the one hand, to claims that use of old machines or equipment in new environments, where it has not theretofore been recognized that it could be used, or changes or material, amount to discovery; and, on the other hand, to a series of decisions by the courts that this, that, and the other thing is not a "discovery."

Section 100 (b) that "process" includes "method" does not help alleviate the difficulty which now is experienced with "process" and "method" claims, because the practical interchangeability of these two words has been recognized for some time, while the main difficulty arises from two forms of attack on process or method of claims; (1) that they amount merely to reciting the function of an apparatus and (2) that they amount merely to selecting steps from several old processes.

The reference to a new use of a known process, etc., it is believed, is somewhat erroneously included in this clause. Certainly process does not necessarily (or even properly) include machines or compositions of matter Also the words, "machine manufacture" probably were meant to be separated by a comma, or was it meant to imply that a thing made on a machine is "manufactured" by way of explaining away the etymology of the word "manufacture," namely; made by hand. Surely there is something wrong in the way this clause is written.

Section 100 (d): Merely a grammatical error, in that no one has "title to the patentee."

Section 101: Again merely grammatical The first complete word in the third line should be "thereon," not "thereof."

Section 102 seems to be merely restatement of R. S. 4886, but broken down into six subheads

Section 103· The last sentence of this section is very good and it was much needed as it will obviate one of the types of wild decisions above-mentioned. The first sentence, however, opens the door to all the type of rejections in which the examiner takes an old patent which has some remote resemblance to an invention of an application and insists it would have been obvious to anybody to make the changes which the applicant has made

After many years of experience with patents, I have reached the conclusion that you cannot safely leave it to any examiner or any judge to determine how much change one can make without getting away from what somebody can call "obvious."

You can look at any of the now admittedly important inventions and you can go back of any of them and find patents and disclosures of some parts of the same, and a thing always looks so much easier after you know how it is done than it does before Hence, any invitation to the examining corps to stand on their own opinion of what is "obvious" is going to perpetuate the uncertainty which has so long characterized patent practice.

While I agree that an invention should not be predicated on something which is really obvious, I feel that any attempt to write into the law a provision of this kind must somehow, to be effective, exclude the determination of the obviousness of a change by someone who already has the benefit of the inventor's disclosure.

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How effective would Columbus' egg trick have been if he had first stood it on end and then asked the people whether it could be done? I would suggest some limitation, such as a provision to the effect that where a patent or other disclosure has been in existence for a substantial period of time without having made any recorded impression upon the field to which it applies, it shall not be available as a reference against a new invention merely by saying that to make changes in it would be obvious

Section 112: The last paragraph should be very useful in obviating purely technical arguments on whether or not a claim is functional.

Section 115 apparently does not permit an applicant to affirm instead of swear to facts. Possibly there is some general provision, but it strikes me as lacking. There is one other point which occasionally arises which might well be included in this section. In Ohio, the law permits the attorney preparing and filing certain papers in court to take the oath or acknowledgment of the party he represents This, of course, varies from the general rule that the attorney should not act as notary in a case where he appears as counsel.

It would seem, however, that little is gained in a patent application by insisting on another person acting as notary. The applicant generally reads his specifications, looks at the claims and says, "These are too technical for me and sound like the same thing over again. I'll take your word for it." and signs it In this situation, the presence of a third person makes little difference. If the notary is an outsider, he doesn't understand the specifications or claims any better than the applicant, and if he is the attorney's secretary, it is practically the same as if the attorney, himself, acted as notary, so the net result of following the conventional practice is merely that every once in a while it is a nuisance to find a notary when and where you want him

It would seem like a very opportune time and place to provide that the attorney may act as notary on papers to be filed in the Patent Office, at least in those States which permit him to act in swearing his clients in conjunction with litigation.

Sections 116 and 118, I believe, are a distinct step forward as there have been instances in which inventions have been lost by arbitrary refusals to sign or by people getting out of contact, particularly just at the end of a period which raises a statutory bar.

Section 121: In general, this seems to be a useful section, but the reference to the use of a parent or divisional case, against another is a bit ambiguous, particularly in the mention of section 103 Would it not be better to specify clearly that neither a parent nor divisional case could be used as a reference against the other for any purpose?

As to section 134, it seems at the present time that appeal to the Board of Appeals has ceased to have any utility, as the Board of Appeals, apparently, has adopted the policy of never reversing the examiner. Thus, appeal to the Board has degenerated merely into an expensive formality before appealing to the Court of Customs or the Patent Appeals or to action under R. S. 4915 it is even worse than that, in that it gives the Patent Office Solicitor an opportunity to tell the court that there have been two concurring decisions in the Patent Office against the applicant, and particularly with some of the newer judges, this argument seems to be somewhat impressive.

Of course, if the judge would stop and think, he would realize that no case can come before him unless the Patent Office has concurred throughout in denying the applicant a patent; but quite obviously, some of the judges do not reason this far

In other words, the Board of Appeals, while going through the motions of holding a hearing, is, in effect, refusing to hear, and thus harms every applicant whose case goes up on appeal by costing time and money and by providing a plausible-sounding, yet prejudicial argument against him

As to section 135, the sentence providing that a judgment adverse to a patentee shall constitute a cancellation of his claims involved in the interference, may, in some specific cases, work out to absolute injustice, particularly where the Patent Office dissolves the interference on some technical ground from which there is no appeal to the courts, as for instance, on inability to make the counts. In such situations, the patentee would have no basis for an equity suit against the Commissioner because he already has what claims are in his patent. On the other hand, these claims would be negatived by this provision for automatic cancellation.

Section 206 would in a few instances, be beneficial.

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Section 211: The first sentence seems to imply that in some degree, patents are not personal property. This is certainly contrary to the general conception and to the holdings of the courts up to this point.

Of course, if they are not to be considered property, that fact should be clearly stated as it would furnish a basis for the refusal to return them on personal property tax returns. On the other hand, if we follow the presently accepted theory, this sentence should be revised so as not to cast any doubt upon the fact that they are property

I think that section 212 would be a distinct advantage where two joint owners of a patent or application decide that they have come to the parting of the ways.

As to section 222, this seems calculated to create a new kind of long-pending application evil. If the Government wants to keep something secret as a matter of defense, of course that should be allowed; but it should not be able to drag out applications by extending the time for action to 3 years—that is six times what the individual would be allowed on the same identical article—solely because the application belongs to the Government.

It is noted that this section requires no showing that there is any need for keeping an application secret, but merely that it is owned by the Government and has something to do with defense or armament.

As a specific example of what I mean, I understand that the present .30-caliber carbine was designed by Winchester Repeating Arms Co. Had it been designed by the Ordnance Department of the Army, patent applications on it could be drawn out for possibly 15 or 20 years under the provision of section 222; while, as it is, the corporation does not get this advantage but must answer every 6 months and so will get whatever patents it gets within a matter of 3 or 4 years.

There is nothing secret about the carbine in that a great many men handled it, and every good gunsmith, gunner's mate, or anybody else having to do with firearms, understands the mechanism thoroughly anyway. So, had it been devised by the Army, why should its patent protection be drawn out as this section of the bill would permit?

I like the provisions of section 231, indicating clearly that contributory infringement is infringement, and certainly there is nothing out of the way about section 232.

Sections 241 and 242 would seem to cut down on purely technical defenses, but I question whether they will be effective for this purpose. Sections 243 to 246 seem to be reasonable.

As to section 247, I think the second to last sentence should be revised to make it clear that this would apply only to a patentee manufacturing and not marking his product As it reads now, I believe it might be applied to a patentee who has been unable to manufacture and thus has failed to mark any product with a notice and might be used in such an instance to let an infringer escape from responsibility for part of his infringement.

Section 248 does not distinguish between a claim of which the patentee had notice as to invalidity and one to which he did not, but which may subsequently be held invalid. In other words, it penalizes him for bringing suit for the first time on any claims which may be held invalid, and there certainly are plenty of doubtful claims.

Section 251: It is refreshing to see some attempt to bring any violation of the patent law into the criminal category Certainly, one who steals another's intellectual property is as much a thief as one who steals his tangible property, and it becomes somewhat sickening at times, to see how often he gets away with it or gets off with insignificant damages While this little fine does not apply to infringement, it might, at least, be an entering wedge toward providing some real punishment for larceny of ideas

I have gone to some length in discussing details of the bill, not with the intention of boring you to death, but because I feel it really has much of merit in it, but needs a little tinkering up in spots and I rather hope that it will get it and then be favorably considered.

There certainly is need for something that will inspire people with confidence that their inventions are really going to be protected, as they surely do not feel that way now.

The number of patented inventions is still a long way below what it was 20 years ago, (53,473 in 1932—only 20,140 so far in 1951) and at least a million patented ideas short of what should be available if we had maintained the constantly increasing rate of development which had existed for nearly a hundred years prior to the early thirties.

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It is impossible, of course, to guess what the missing million inventions would have meant in increased wealth and convenience had they been made, but you can be sure that it really would have been something.

Sincerely yours,

HARVEY R. HAWGOOD.

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SOANS, GLAISTER & ANDERSON,
*Chicago, June 25, 1951.*

Mr. ROBERT C. WATSON,
*Watson, Cole, Grindle & Watson,*
*Washington, D. C.*

DEAR BOB: Thanks very much for your letter of June 21, 1951. I have not time to express my appreciation at this time the way I would like to do so as I am just leaving for New York. However, I am sending you with this letter two copies of the material, which will be more convenient for you than to refer to my previous correspondence.

Sincerely yours,

C. A. SOANS.

(Mr. Soans' letter and the following material enclosed therewith is published at the request of Mr. Watson.)

SECTION 102 (G) (AS NOW WORDED OR AS PROPOSED TO BE AMENDED BY THE LAWS AND RULES COMMITTEE OF THE APLA)

This paragraph, as compared with paragraph 102 (c), creates a different standard of diligence as between the applicant and the defendant. The defendant's prior invention as a reference to an issued patent is not available as a defense, either if he had abandoned the invention or suppressed it or concealed it. Also, he must have exercised diligence in putting it into use (presumably public use) or in otherwise making knowledge thereof available to the public.

This is quite in accord with my ideas on the subject. In fact, I think that it includes some of my original language However, when we come to the patentee, we find that an entirely different standard of conduct is used. All he has to do is to show that he has not abandoned the invention. In fact, the burden of proof is upon the defendant to show that the patentee has abandoned the invention, an impossible task in most cases, if the patentee has been sufficiently shrewd.

Under this section, if the patentee has the status of first inventor, there is no way that he can lose that status, unless abandonment is proved. It makes no difference whether he has neglected or delayed to inform the public of the invention after his reduction to practice. It makes no difference if he has concealed the invention or suppressed it. He can do either of those things without abandoning it. Furthermore, it changes the law in that a defense under the Metallizing case is no longer available. He can use the invention in secret for profit commercially for years, and under this section 102, as now written, he can get his patent, provided that there is no public use or sale more than 12 months prior to his filing date. Do we want this?

Then again, under the *Gillman* v. *Stern*, doctrine, there is nothing to prevent that patentee from suing a concern which, believing that the invention was unpatentable, or for any other reason, decided not to apply for a patent, but adopted the invention for commercial use in secret. I wish someone would tell me how I am to advise my clients when they ask me whether it is safe for them to keep the process secret while they are using it in commercial production

Under this section as it stands, a person could reinvent the secret Coco-Cola process, assuming that they have such a process, obtain a patent on it and on the face of it, they could enjoin the Coco-Cola Co. from using the process which they have used commercially in secret for 50 years or more. Of course, I agree with you that no court in the land would so enjoin the Coco-Cola Co., but under the bill as written, they could be enjoined.

In connection with my criticism of section 102 (g), as now worded, I would like to throw into the hopper a proposed draft which, so far as I can see now, would remove my fear about advising my clients that they have the right to continue the commercial use of a secret process which later may be reinvented and patented by another person. The APLA amendment to 102 (g) does not restore this common-law right.

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I feel justified in sending you this proposed redraft because I have spent a great deal of time on this particular section, and several other persons have worked on it with me.

SECTION 115

As pointed out at the March meeting at the Shoreham, section 115 does not correspond with section 102, and the way it is written, it merely encourages false swearing, in the case of an applicant who, a few days before he files his application, discovers that somebody in a foreign country made the invention before the applicant did.

SECTION 151

This section fails to establish any ground for the 1-year extension of the payment of the final fee. Under this section, it is not necessary to show any inadvertence or mistake. It seems to arbitrarily extend the 6-month payment period to a period of 18 months. That is one way of lengthening the patent term to 18 years, if that is what is wanted

SECTION 201

It is my understanding that the old 2-year limitation for broadening a patent was based upon the 2-year publication rule, and that when the statute was changed from 2 years to 1 year, there was an inferential change in the 2-year period for broadening by reissue This paragraph of the bill, therefore, is not in accord with the existing law as I understand it.

Furthermore, if the unwritten 1-year rule is changed to a statutory 2-year limit, there may be an inference that diligence in applying for reissue is no longer necessary. The statute should be made clear, in my opinion, that whether the patent is to be narrowed or broadened by reissue, diligence should be required.

SECTION 202

The second paragraph seems to me is entirely too broad in that it says "the specific thing" It seems to me that the intervening user should have the right to make such changes in "the specific thing" as in the normal course of business would occur to a person skilled in the art.

SECTION 206

In this section there is far too much emphasis placed upon the necessity of correction of the patent by the Commissioner

As brought out at the Shoreham meeting, 95 percent of the cases arising under this section would be cases of misjoinder, i e, where the patent contained more names than those of the actual inventor or inventors, or where some of the claims of the patent were joint inventions and other claims were sole inventions.

What is the objection to permitting a court to ignore the extra name or names in the patent? What harm is done to any one so long as all of the patent is owned by a single interest, which is the case in 95 percent of our practice Under this section, as I and others construe it, a court cannot merely ignore the misjoinder but must send it back to the Patent Office or, at any rate, some positive action must be taken by the owner of the patent in order to enable him to sustain his patent. But suppose the trial is suspended, the patent goes back to the Patent Office to be corrected, and when the trial is resumed the court sustains the patent as corrected. What happens then if the court of appeals says that the district court made a mistake, because as they construe the claims and the evidence, in view of the prior art, it was a joint invention Where does that leave the patentee? It seems to me that this procedure of having to go back to the Patent Office in a case like this is useless, cumbersome, and dangerous.

I have no particular feeling on the question of nonjoinder because that, I think, is a very different situation which justifies a much more elaborate and formal procedure particularly in view of the fact that an oath is required.

SECTION 212

The last two lines of this section are susceptible of two interpretations. Under one interpretation, a license or assignment can be made with an accounting, regardless of the consent of the other coowner Under the other interpretation, a license or other grant may not be made unless the two conditions exist, i. e.,

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the consent of the other coowner must be given, and also the grantor is required to account to the other coowner However, except for this ambiguity of language, I would be willing to accept either interpretation, although I believe that consent should not be required provided that we have an accounting in all cases, the same as in the case of any other property owned by a partnership

My real objection to this paragraph is that it makes no attempt to correct the terrible injustice which may be perpetrated upon an uninformed patentee. I refer to the notorious practice of inducing a patentee to sell say 1 percent of his interest in the patent, which enables the owner of the interest to manufacture to any extent without accounting to the patentee for the profits made out of the invention. The proposed bill does nothing to correct this situation, but, I believe, makes it worse in that the patentee, after having sold a tiny fraction of his patent to the nonaccounting manufacturer, could not thereafter sell any other part of his patent or license anyone else to use the patent without the consent of the 1-percent owner, or without accounting to the 1-percent owner.

I cannot see the slightest reason why a patent owned by two persons should not be subject to precisely the same rules as any other property owned by two persons jointly or in partnership. When one member of a partnership deals in the partnership property, he has to account to the other joint owner or copartner. To perpetuate a different rule in the case of a patent right, it seems to me tends to intensify the belief that a patent is not property, whereas it is the contention of patent lawyers generally that a patent is property.

SECTION 231

Paragraph (b) of this title says that one who actively induces infringement is liable as an infringer, whereas paragraph (c) of this title specifies an act which renders the doer liable as a contributory infringer.

The liability for contributory infringement is not defined in section 231, nor in section 241, nor does section 244 deal with contributory infringement. Is there any distinction intended?

Is it the intention of section 231, as a whole, that the liability of the contributory infringer, or shall we say the supplier, shall be liable as a joint tort feasor and, hence, liable for the entire recovery which can be collected by the patentee under section 244 Some of us who have given thought to this question are of the opinion that the damages recoverable from a contributory infringer should be prorated or limited in some way in accordance with the character of his contribution, or possibly to the profit which he makes out of the parts or other facilities which he supplies to the direct infringer

Also it is felt by some of us that there should be no recovery from a supplier except in respect of facilities supplied after actual notice received from the patentee

Paragraph (c) is believed to be inaptly drawn. As it is written, the word "knowingly" qualifies the word "sells" Of course, when a man sells a thing he knows that he sells it Obviously, the word "knowingly" is intended to qualify something else later in the paragraph. The question is whether the word "knowlingly" is intended to apply to the words "shall be made or shall be adapted for use in an infringement of such patent." I will treat the paragraph with that interpretation

Here again the scales are heavily weighted against the struggling manufacturer who has invested his entire small capital in a small business of manufacturing a single item. Let us assume that the item is a machine which includes a casting made of a metal chromium alloy, which castings are produced only by one or two foundries in the United States Obviously, those castings are made in accordance with special patterns or blueprints furnished by the little manufacturer to the foundry.

Let us assume that this small manufacturer has made a prudent investigation of the prior art, and his counsel has advised him either that a certain patent is invalid or that it is not infringed by his machine. However, the owner of this patent, when he realizes that the small manufacturer is competing with him, forthwith notifies these two foundries that if they furnish this special casting to the alleged direct infringer, the foundry will be held liable for damages This foundry thereupon calls upon the little manufacturer to furnish a cash bond to indemnify the foundry against all damages which may be assessed against the foundry for their contributory infringement The little manufacturer having invested all of his capital in his business, which is just about beginning to break even, is unable to furnish the bond, as a result of which the foundry refuses to fill



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his orders for the castings And the same thing happens with the only other foundry which is in a position to make these castings for the little manufacturer.

The result is that without the expenditure of 1 cent for litigation, the owner of the patent has, in effect, obtained an injunction against the little manufacturer, who is thus put out of business because of the patent which he was advised was not infringed by his machine. Perhaps you will say that the little manufacturer can file a declaratory-judgment suit against the patentee. That may be true, but remember that he is out of business, he cannot make any machines, he has no source of income to pay his lawyers and to keep his business running during the pendency of the litigation which may run along for 3 or 4 years. And the fact that he has filed a declaratory-judgment suit does not require the foundries to supply him with castings. Why should they run the chance of being subjected to heavy damages, especially if they have other customers clamoring for castings?

For the reasons stated, I am against paragraph (c). It seems to me that paragraph (b) is all we need. I think that it will take care of 95 percent of those cases in which there is a real need for a right of action against the supplier, and of the remaining 5 percent of the cases, the patentee ought to be satisfied with his right to sue the direct infringer.

As to paragraph (d), however, desirable it may be from the standpoint of a patentee, its inclusion amounts to a request to Congress for a law which will have the effect of spanking the Supreme Court of the United States for its attitude in respect of misuse of patents. And, in this connection, we must not forget that the Supreme Court in deciding these cases has ostensibly reformulated or reexpressed the principles of equity jurisprudence which have been well established in the law for many years, but, according to the Supreme Court, have not been followed in connection with patent rights The wisdom of asking for such legislation at this time it seems to me is open to grave question. It is, in fact, a declaration of war concerning a very delicate question. It is a change in the law as it now stands, which is controversial in the sense that the patent bar is on one side of the question and the Supreme Court is on the other side of the question, and I cannot see any reason why Congress would want to stick its neck out on this issue at this time.

"Sec. 102. Any invention shall be patentable unless:

* * * * * * *

"(g) Another person is entitled to a date of invention prior to that of applicant. The date of invention upon which any person is entitled to rely shall be the date upon which such person, having a full conception of the invention, began work upon said invention in the United States and, with such diligence as was reasonable under all the circumstances of his case, continued such work until he reduced the invention to practice in the United States or filed an application for United States patent disclosing said invention: *Provided*, That any person shall be entitled to the benefit of another person's activities in working upon an invention the conception of which was derived from the former person: *Provided*, That a person who is shown to have failed to take steps to inform the public of said invention until a date which is an unreasonably long time after his reduction to practice or filing of his application, shall not be entitled to a date of invention prior to the date when such steps were taken by him Such steps, by way of example, may be taken by reasonably presenting and prosecuting a claim for said invention in said application, or putting the invention into public use or on sale in the United States, or publishing the same in a printed publication in the United States: *Provided, nevertheless*, That no patent shall be enforceable in respect of any use of the patented invention by another person or his successors in business, if such other person used said invention in the United States for profit before the date of invention of the applicant."

NOTE.—This last proviso is to protect anyone who commenced an unpublished commercial use of the invention if he were to be sued for infringement of a patent validly obtained under the rule stated in *Gillman* v. *Stern* (114 F. 2d 28).

Add the following new paragraph:

(h) Applicant or anyone with his consent at any time, more than 12 months prior to the filing of the application for patent in the United States, had secretly used the invention for profit and not primarily for experimental purposes

NOTE.—This new paragraph recognizes *Metallizing Engineering Co.* v. *Kenyon Bearing* (153 F. 2d 516), and is set up in a new paragraph because paragraph (g) is directed solely to priority of invention by another person and does not apply to applicant's own use for profit.

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459 DOGWOOD LANE,
*Plandome, N. Y., June 1, 1951.*

JOSEPH R BRYSON, M. C.,
*Chairman, Subcommittee 4, Committee on the Judiciary,*
*House of Representatives, Washington, D. C.*

DEAR SIR: Thank you very much for sending me a copy of H. R 3760.

I have reviewed this bill and find it an improvement over its predecessors. There are several points, however, to which I would like to direct your attention.

Section 4, restricting the rights of employees of the Patent Office upon termination of employment: I have never encountered a case of abuse of position by Patent Office employees leaving the Office and am unable to see a basis justifying deprivation of their right to establish a date of invention in the year following termination of their employment.

Section 121: The language of this section, which prevents use of a parent application as a reference against a divisional application, appears to be too broad and I believe might hamper proper functioning of the Patent Office. According to the language of the section, the parent application or patent issuing thereon may not be used against the divisional application regardless of what type of claims are presented in each. It would appear to me that the restriction should apply only against the claims subjected to a requirement for division or their equivalents. Further, reference to section 103 seems ill-advised. Section 103 relates to improvements which would have been obvious at the time the invention was made. Since the divisional or parent case could not go back of the invention date in any event, it could not be used "for the purposes of section 103." I would suggest the section be amended as follows:

Line 10, after the word "against," insert: "the claims subjected to the requirement, when presented."

Line 11, change the word "against" to "in."

Line 12, delete "for the purposes of section 103 of this title."

Section 242, subsection (2), line 1: I believe the expression "any claim" should be "the infringed claims."

In the line following subsection 4, the word "of" (first occurrence) should be "or."

Section 314: While this section seems to follow the present law, there is serious douht in my mind that a minimum recovery is proper. There is no minimum specified for ordinary patent infringement. The minimum liability provision is like the copyright provision in form but not in substance Liability in a copyright case depends upon proof of copying but in a design patent case a second inventor entirely innocent of copying would be forced to pay at least $250 even though no real damage were found.

Page 28: I find the appearance of sections 2, 3, 4, and 5 on this page very puzzling. Where is section 1? Of what chapter are they sections?

Very truly yours,

GEORGE B. CAMPBELL.

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CHICAGO, ILL., *June 18, 1951.*

Re H. R. 3760, especially section 103.

SUBCOMMITTEE ON PATENTS, COMMITTEE ON THE JUDICIARY,
*House of Representatives, Washington, D. C.*

GENTLEMEN: There is a tremendous need for the bill H R. 3760 is intended to be. For the sake of inventive progress and justice, let us not muff the opportunity by passing the bill before it is in the best condition reasonably possible for revitalizing the patent system.

Most of all, this necessitates for section 103, the definition of "patentable invention," a wording which is neither too liberal to patents (lest it be ignored) nor too weak (lest it fail to help even if followed). The phrase "would have been" is too weak Its intention may be good but the words alone invite deciding what "would have been" obvious after the prior-art references had been put side by side. Almost any inventive idea could be induced into the mind of a good mechanic by carefully selecting the right prior patents, placing them in front of him and saying, "What do these two patents together suggest to you?" The test should be: Would the invention have occurred to him without such direction of his thoughts?

Accordingly, if the phrase "would have been" is retained, I urge that the qualification doubtless intended be added The inserted phrase could be, for example, "without guidance by preselection and juxtaposition of the prior art."

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"Obvious": On the other hand, "obvious" is so generous to patents that it is likely not to be followed literally In that event, it will lose all strength by the sheer necessity of departing from it and the consequent lack of statutory determination of where the line should be drawn. For example of excessive generosity, suppose a prior patent indicates that a certain ingredient should be added when a batch is at a temperature at which rapid precipitation will occur, between 150° and 200°, depending on degree of acidity. It is not obvious from this description that with one particular acidity the temperature should be 178°. Yet surely there is no intention to grant a second patent limited to this temperature which any chemist could easily determine by experiment.

"Skill in the art": This phrase does not say what is meant. If a prior patent in the printing industry controls ink supply by a photocell and an amplifier, building the amplifier would not be within the skill of the ordinary printer, but this should not justify granting a patent. Some skill of other arts must also be available and surpassed before invention is present.

The best wording I can think of at present is the following:

"* * * the subject matter as a whole would have naturally occurred at about the time the invention was made to a person having only ordinary skill in the field to which said subject matter relates if he had knowledge of said prior art (all prior art readily available to persons in that field) [words in parentheses preferred] but had no guidance by its preselection, and said subject matter could have been worked out by such person with such ordinary technical assistance as he would have been expected to call upon."

Some other comments are enclosed, separately written up for different sections.

In general, I urge that before reporting the bill, efforts be made to overcome all criticism that is or may be sound

Yours very truly,

LOUIS ROBERTSON.

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### CONTRIBUTORY INFRINGEMENT—SECTION 231

It is expected that an article I have prepared will appear in the July issue of the Journal of the Patent Office Society It is too long to justify inclusion here, especially since a copy has already been sent to Mr. Federico.

In the meantime, I will merely say that subsections (b) to (d) of section 231 should be greatly improved before passage

### MISJOINDER—SECTIONS 116 AND 206

The inclusion as applicant of an extra person, i. e., one in addition to the true inventor, seems to be entirely harmless in all instances except when he himself would improperly gain by it, and in these instances the possible invalidity of the patent is often no discouragement to him but only penalizes the real owner who is innocent.

It would be far better to provide simply: "The naming of an extra person as applicant or patentee shall be disregarded, except that courts may refuse to enforce on behalf of such person his apparent rights as copatentee and, if he dishonestly permitted himself to be named, his rights by assignment. The Commissioner may strike his name, if satisfied that no claim would be jeopardized"

### JOINT OWNERS—SECTION 212

The rule that a 1-percent owner need not account to a 99-percent owner is intolerable. There is no adequate excuse for writing into the statute an unjust rule, especially one not necessarily the law in all States. There is no excuse for having the patent system blamed for unjustness, even if it is to be the law by State determination. The alleged but falacious purpose of warning the ignorant could be accomplished by an express denial of a change, such as:

"* * * and the duty or absence of duty to account to the other owners is not determined by this act."

My preference would be to legislate away the old doctrine completely, but give power to the courts to render justice. For example: "with a duty to account to the other owners on such basis and subject to such exceptions as the courts may deem just."

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TWO-YEAR REISSUE RULE—SECTION 201

The 2-year limit on broadened reissues is unjust. The more basic an invention, the less likely an inventor is to learn within 2 years that his patent cheats him of the protection to which he is entitled. To such exteht as the time limit is justified on any fallacious theory of unfairness in letting the inventor cover later inventions he had not thought of, the time limit should date from his original patent and should apply in original applications long pending The only additional equities against reissues are protected as intervening rights

Nevertheless, if the theory must be applied selectively against reissues, it can be done in a less unfair way by canceling the present last paragraph of section 201 and instead adding to the last paragraph of section 202 the following:

"In the case of any reissue patent enlarging the scope of the claims of the original patent, especially if applied for more than 2 years after the grant of the original patent, the principles of intervening rights set forth in this paragraph may be extended to protect investments of time or resources in invention, patenting, or development, even without the preparation specified in this paragraph."

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NEW YORK, N Y, *June 20, 1951.*

Re H R 3760

JOSEPH R. BRYSON, M C.,
*House Office Building, Washington, D. C.*

SIR: In answer to your letter of some while ago asking for comments on this bill I suggest the following amendments.

(1) Section 42, after "law" at end of section, insert "or for service not rendered" This is particularly aimed at the return of a Board of Appeals fee when an examiner gets cold feet and does not transmit an appeal.

(2) Section 103, end of first sentence, insert: "An applicant's own statement in his application may not be used against him in interpreting prior art" If, within a composition or machine, applicant states he may use an element A or B, and previously A has been similarly used, prior art rather than applicant's application should be relied on to teach the equivalence of A and B if the skilled person does not already know it."

(3) Section 112, after second paragraph, insert: "But no claim shall be declared invalid for lack of distinctness or for undue breadth when the description clearly discloses the subject matter of the claim and the claim is as definite as is reasonably possible without arbitrary limitations."

This is in line with the recognition in plant patents (sec 302) that the patent system need not rest on mere words Justices Burton and Jackson hold this position in a dissent, *Funk Bro* v *Kalo* (333 U. S. 127). It should be remembered that the broad claim always expires and the patentee takes from the public only the use of independently made later inventions and he gives a perpetual disclosure of the invention.

(4) Section 132 in next to the last line insert the sentence: "The applicant shall have the right to amend any claim as often as new reasons for rejection are presented." This is an attempt to force the examiner to give thorough actions at the outset, but if the Patent Office makes an error at any stage applicant can be assured of an opportunity to alter his claim without need for a personal interview with the examiner. As the statute and rules of practice now stand, the distant applicant is at a disadvantage

Broad valid claims help not only the inventor but progress as a whole. Each patent is a challenge to a subsequent inventor, and the broader a claim to be avoided, the more radical must be the line of attack.

As a former research chemist one of my jobs was to see how to avoid patents. The narrow claims did not cause me to learn nearly as much as the broad ones.

At present, especially with chemical inventions, I frequently advise a client to keep his invention secret rather than risk meager patent-system protection of a new process that will possibly be mostly a suggestion to another chemist who may have greater facilities for further study. I have lost fees by such advice but I have gained the confidence of many clients

I personally intend to work only in the chemical field where the chances of keeping the invention secret are good. Of course there are risks, but nothing seems to be more risky than trying to predict how a court will treat a patent claim under the present statutes Even when the decision is in favor of the

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patentee the Supreme Court is capable of reasoning in a manner I simply cannot follow (see Justice Douglas' dissent in *Graver Tank* v. *Linde Air* (636 O. G. 1), decided May 20, 1950)

Yours very truly,

F. R. JENKINS.

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UNITED STATES COURT, EASTERN DISTRICT OF NEW YORK,
*Brooklyn, N. Y., June 20, 1951.*

In re H. R. 3760

Hon. EMANUEL CELLER,
*Old House Office Building,*
*Washington, D. C.*

DEAR MANNIE: Some thoughts concerning this bill have occurred to me which I should like to pass on to you if I may.

I am concerned mainly with the plight into which patents have fallen when the owners run the hazard of litigation. Fundamentally the difficulty in the courts stems from the fact that the term "invention" is not defined in the statute, nor has there been any affirmative legal definition.

More generally, in respect to patent litigation and the difficulties encountered by judges in wrestling with the problem of invention, let me refer to the opinion of Justice Frankfurter in *Marconi* v. *United States* (320 U. S. 61), and to the opinion of Judge Learned Hand in *Parke-Davis Co.* v. *Mulford Co.* (189 Fed. 95, 115). The difficulty apparently was very carefully considered by the National Patent Planning Commission which was appointed by President Roosevelt on December 12, 1941. In its report filed in 1943, it is said:

"The Commission, therefore, recommends the enactment of a declaration of policy that patentability shall be determined objectively by the nature of the contribution to the advancement of the art, and not subjectively by the nature of the process by which the invention may have been accomplished."

In a lecture that I was invited to deliver before the American Chemical Society, New York section, I took the position that the most satisfactory test of invention is just that suggested in the foregoing report. The contribution that an inventor makes to the art, which is presently in need of improvement or development, affords effective and definite evidence; no satisfactory subjective measurement can be employed as a rule of decision. One cannot take an X-ray of the mind.

Now another matter: Courts have lightly treated the so-called presumption of validity which is supposed to attach to the grant of a patent. Such a presumption could be made real and not merely figmentary if in the proposed legislation provision were made for adversary proceedings. Such proceedings could take the form, either before issuance of the patent but after publication of allowed claims in the Patent Office Gazette, of opposition, or of cancellation proceedings after the patent issued. The effect of such a provision would be that when the patent reaches the court for adjudication it could no longer be regarded as the result of merely ex parte consideration.

Another thought is in reference to the misuse of patents. Under present practice the courts, following a direction of the Supreme Court, will refuse to grant relief to one who has misused his patent unless he can show desistance from such misuse prior to the creation of issues in the case. But there is no power in the courts to void a patent for such misuse. That might well be the subject for congressional consideration.

I was glad to find in section 231, subdivision (d), the provision relating to contributory infringement. This provision if adopted will meet the hiatus in the statute pointed out by Mr. Justice Black in *Mercoid Corp.* v *Mid-Continent Investment Co. et al.* (320 U. S. 661).

With kind personal regards, I am

Sincerely yours,

CLARENCE G. GALSTON.

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CINCINNATI, OHIO, *June 13, 1951.*

Re H. R. 3760.

Hon. JOS. R. BRYSON,
*Washington, D. C.*

DEAR MR BRYSON: I take this occasion to express my disapproval of the above-identified bill, together with various proposed amendments and suggestions adduced by various meetings of patent law associations and the like. Essen-

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tially my objection is directed to the attempt to accomplish, incident to codification, the inclusion of controversial aspects into the fundamental law of patents. It is my personal opinion, that patent laws should be codified without any change in substance or subject matter. Thereafter, any additions or deletions that may be proposed by any person or group of persons, may be considered seriatim. Any other handling of the matter will necessarily result in delay in codification, since it is my personal observation that there is no unanimity amongst patent lawyers as to the desirability of the proposed changes in the patent laws.

In making the foregoing observation as to the lack of unanimity, my impression is that there are more patent lawyers who are opposed to the indicated changes in patent law than there are those who approve thereof. I am not unmindful of the fact that the apparent approval of H. R. 3760 by various patent law associations and the like, would appear to indicate the converse of my observation. My observation is predicated upon the fact that at a meeting of the Cincinnati Patent Law Association on June 12, 1951, we considered the referred to H. R. 3760, together with the proposed changes and amendments referred to. After discussion, consideration was given to the question of whether the Cincinnati Patent Law Association should pass a resolution endorsing H. R. 3760, together with the proposed amendments. A motion was made and carried that the entire matter be tabled. The vote was overwhelmingly for tabling the matter. Consequently, I consider that as indicative of disapproval by the majority of the group of patent lawyers there assembled, of inclusion of such proposed changes of patent law in the codification of the current patent laws.

In voicing my objections to the proposed changes in patent law as incorporated in H. R. 3760, I do so as an individual and my reference to the action by the Cincinnati Patent Law Association must be understood as reflecting the background upon which I express my foregoing impressions. Incidentally, the Cincinnati Patent Law Association at that meeting, specifically desired to avoid going on record as an organization opposing H. R. 3760, inasmuch as by so doing it would be opposing the more or less concerted effort on the part of other patent law associations, to further the amendment of patent laws incident to codification thereof.

In view of all of the foregoing, I sincerely recommend that the effort of your committee undertake solely, codification of the current laws on patents and that there be excluded from the product of your committee any changes that any person, group of persons or interests, may now wish to incorporate in the codification of patent laws.

Very truly yours,

FRANK ZUGELTER.

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BAR ASSOCIATION OF THE CITY OF NEW YORK—REPORT OF PATENT LAW COMMITTEE ON BRYSON BILL, H. R. 3760, CODIFICATION AND REVISION OF PATENT LAWS

This committee has studied the Bryson bill, H. R. 3760, and believes that if passed by the Congress, the patent laws will be materially improved.

This committee recognizes the difficulty of getting entire agreement among lawyers not only as to the contents of such legislation but also as to its form. It believes that if no changes were made in the proposed bill it would still be a substantial improvement over the existing law. Nevertheless the committee feels that the bill could be improved if the following changes were made:

Chapter 2, section 103, page 9: In line 2, substitute "as" for "in the prior art" and change the word "that" which is the third word in the fourth line to "the." The purpose of this is to make it clear that all prior art is here meant and not merely the prior art referred to in section 102 which is limited to anticipatory art.

In the fifth line substitute "was" for "would have been."

The reason for this is to avoid the subjunctive form and to emphasize that the criterion of obviousness is to be determined as of the time the invention was made.

Chapter 2, section 121, page 13: In the third line substitute a period for the semicolon, and the word "If" for "and."

In the fourth line substitute "are" for "may be"; strike out the period and insert "directed solely to subject matter described and claimed in the original application as filed"; in the same line substitute "they" for "A divisional."

In line 5 strike out "application."

In line 6 substitute "they comply" for "it complies"

In line 12 insert a period after "title" and strike out "if."

Strike out all of lines 13 and 14

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In line 15 strike out "and claimed in the original application as filed." In the same line substitute "The" and "the."

In line 16, after "execution" insert "of such divisional applications."

The committee finds the thirteenth line of the section ambiguous. This section was intended to prevent the citation of a patent as a reference where division was required by the Commissioner and there was copendency with the application for the issued patent. This particular situation requires definition, which the proposed language accomplishes.

Chapter 2, section 135, second paragraph, page 15: In line 1 substitute "Any" for "No."

In line 2 insert "not" after "may."

Strike out line 3 and substitute the following: "application unless a claim for substantially the same subject matter was made in such application prior to the issuance of said patent or within 1 year from the date on which said patent was granted."

The purpose of this provision is to make sure that the 1-year period will not prevent someone who had previously had claims to substantially the same subject matter, making those claims even after such period. No such limitation was intended by the paragraph as originally drafted

Chapter 3, section 202, page 19 Starting in the fifth line of the second paragraph substitute "unless" for "if," and at the end of the line insert "would have infringed."

In line 6 strike out "does not infringe a valid claim of the reissued patent which was in"

This is for clarification and to get rid of donble negative

In the second line of the third paragraph substitute "like things" for "such thing"

This is to make it clear that the court may allow replicas to be made of the specific things referred to in the second paragraph.

Chapter 3, section 211, page 21. In the first and second lines strike out "applicable rights" and substitute "attributes"

Chapter 3, section 212, page 22: Strike out entire paragraph and substitute the following

"Whenever two or more persons own a patent jointly, either by the issuing of the patent to them jointly or by reason of the assignment of an undivided interest in the patent or by reason of succession in title to such interest, each of the joint owners, in the absence of any agreement to the contrary, shall be entitled to make, use, or sell the patented invention, or license others so to do, or assign or encumber his interest without accounting to the other joint owners."

The committee believes that the existing law should be codified and not changed.

Chapter 3, section 231, page 23 In the second line of page 23 strike out "a contributory" and substitute "an"

In the third and fourth lines strike out "for infringement or contributory infringement of a patent" and substitute "under paragraphs (a), (b), and (c) above"

In lines 8 and 10 strike out "contributory"

In line 12 strike out "or contributory infringement"

Since contributory infringement is a form of infringement and the use of this term does not appear anywhere else in the bill, it seems preferable to refer to all of the acts mentioned in this section as infringement.

Chapter 3, section 252, page 26: The committee has not had sufficient time to consider the law as to whether jurisdiction could properly be obtained of a nonresident patentee served by publication It believes that it would be preferable to add at the end of the paragraph the following:

"Acceptance of the grant of a patent hereafter shall constitute an irrevocable consent to be sued as provided in this section and appointment of the Commissioner of Patents as agent of the patentee to receive service of process under this section"

The eighth line should be changed by striking out "and summons shall be served by publication or otherwise as the" and the words "court directs" should also be stricken out in the ninth line.

Respectfully submitted

Asher Blum, Dean S. Edmonds, James M Heilman, Giles S. Rich, Ralph M Watson, John C. Blair, Cyrus S. Hapgood, Wilfren D. Keith, James B L Orme, Dana M Raymond, William R. Carlisle, Francis X Fallon, Jr, Walter H Free, Oscar W Jeffery, Ernest S. Meyers, Alexander C. Neave, chairman.

MAY 18, 1951.

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STATEMENT OF R S. OULD

With particular reference to section 206 of this bill, and also with reference to sections 116 and 118, it is believed that the present statutory requirements as to the true inventor or inventors being stated in a patent application when originally filed, should be retained, and that the change of a joint application to a sole application, or the removal or addition of an inventor to an application on an allegation of inadvertence, should not be permitted.

If in fact an invention has been made, it should be possible with reasonable effort and within a reasonable length of time to determine who is the true inventor, at the time the patent application is originally prepared and filed. Experience has often shown that when a comparatively large number of persons are alleged to be joint inventors, the fact is that no invention has really been made If each has simply made a small individual separate contribution from his knowledge of the art, there is not joint invention.

There is nothing new in the proposal of section 206 of the present bill; it has been submitted to Congress on a number of occasions In the hearings before the House Committee on Patents, May 9–10, 1940, on H. R 9386 (76th Cong., 3d sess.), as to plural applicants, I pointed out a number of considerations which should receive attention on this problem

If an application in which there are half a dozen or more joint applicants becomes involved in interference proceedings in the Patent Office, when the opposing party prepares to cross-examine the various joint applicants, he will, if this proposal bcomes law, be faced with the possibility that only one of the plurality of joint applicants will eventually be brought forth as the true sole inventor, which considerably complicates and increases the work required to prepare for the interference testimony.

Similarly, in an equity suit in court between interfering patents, or even in an ordinary infringement suit, uncertainty as to who will eventually be brought forth as the true inventor, materially increases the difficulty of preparing for trial.

If a provision of this kind of section 206 is to be enacted at all, it should specify a maximum number of joint inventors who would be entitled to its benefit, say six joint applicants as a maximum.

If the proposed section 206 becomes law, it may be anticipated that applications filed on behalf of large organizations, private or governmental, will be filed in the names of a multiplicity of alleged joint applicants, some of whom have in fact engaged in only administrative activities and cannot be considered to be joint inventors even by great charity and imagination. It has been only the exaction of the existing requirement to state correctly in the original application when filed the name of the true inventor, which has in the past discouraged the addition of the names of alleged joint applicants who were known in fact not to be joint inventors, but who desired for personal laudatory purposes to have the record show that they were inventors.

Probably the most serious practical objection to the present proposal to allow the joining as applicant of persons who are, in truth not inventors, is the discouragement and loss of interest in the making of inventions which will inevitably be experienced by inventors, with resultant decreased inventive contributions. Unless a person has had personal contacts in a research or a development organization, or group, he is likely to have little realization of the sense of fundamental injustice with which creative workers regard every effort to recognize as coauthor or coinventor a person who in fact contributes but the routine efforts of the timekeeper and slave driver

The Constitution authorizes the grant of patents to inventors for their respective discoveries. There is no constitutional provision for granting a patent which sets forth as inventor, the employer, the financial backer, or the boss, of the true inventor. This concept of inventorship was inherent in the particular appreciation of intellectual and spiritual values, and the right of the creative worker in his creation, which was inherent in the genesis of American institutions and Government, and is part of our heritage. It provided for recognizing and rewarding the intellectual creative worker as an originator for his creation contributed to society.

There is no power conferred by the Constitution on any one to declare that a person is the inventor, who in fact is not the inventor.

From the beginning of the American patent system, repeated assaults have been attempted on this concept of the status of the inventor and the creative worker, from every approach. The creative worker constitutes numerically a

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very small percentage in any population group, and the large majority who are not thus gifted are continually casting an appraising and nonunderstanding eye at such rewards as the creative worker may obtain. The entrepreneur has at all times sought to be vicariously recognized as an inventor when he was not, thinking perhaps that his chance of lasting fame would be thereby materially increased. The workman who has simply sawed and bolted as directed, has also sought recognition as the inventor. It is commonplace in patent practice to find that the backer who is to put up a few dollars to finance development of a completed invention, wants to be considered the inventor and to be a joint applicant, and is stopped only when told that no valid patent can be so issued. The essential democratic character of the American patent system is the recognition of the true inventor as such regardless of his financial position. Entrepreneur ability is entitled to its own kind of recognition.

A further objection to the proposed provision of section 206 is that it is likely to prove to be simply an entering wedge to entirely destroy the American concept of inventorship, and to permit the filing of patent applications in the first instance by an alleged employer, or assignee, thus converting the patent system entirely into a system of property rights. There have always been those who have advocated this kind of a patent system. In some foreign countries, as in Great Britain, this view has been approximated, and they have a wholly different concept of who should be the applicant; the person or corporation who has acquired title to an invention or even the returning traveler from foreign lands who brings home another man's idea, old in a foreign land, but new in Great Britain, may apply for an original patent. It is not believed that the record will show that the British system has been as prolific in worth-while inventions as the American system. Corporations as such are certainly incapable of creative work; inventorship is a personal activity.

The concept that a man's brain children are his own in a very real sense, may be said to be a fundamental concept among most peoples, and a part of natural law.

For every reason, the public is entitled to know who is the true inventor, and not simply who is the person that claims the title to the invention.

If a provision such as section 206 becomes law, the determination of the number of applicants for a patent may be expected to become a fishing expedition, using a rule to resolve all doubts in favor of putting in every one who might in some way be considered to be an inventor, instead of trying to ascertain the real facts as to how the invention was made.

There has been testimony before committees of Congress over a period of years, that in a large industrial corporation it is not unusual to get 50 research workers together in a room, all of whom had had something to do with a project, one of whose products was to be covered by a patent application, for the purpose of determining who should be set forth in the application as the applicant and inventor. If it were decided that all 50 were joint inventors and should be joint applicants, the presumption would be that a true invention had not been made.

Particularly in Government research laboratories the effect of including as joint patent applicants the names of persons who are not true inventors often has harmful effects on the morale of the research personnel out of all proportion to the importance to the Government of getting a patent application on the invention on file or even issued. When an individual workers has on his own initiative conceived and completed a meritorious invention, the tendency in such a laboratory often is for the group chief, the section chief, and the division chief to all want to be joint applicants with the true inventor. Government patent counsel may be able to keep this down to including only one boss, or even naming only the true inventor alone, as long as he is fortified by the present requirement of law. If the proposed provision of section 206 is enacted, he will no longer be so fortified, and the addition of a plurality of administrators as applicants can be expected to become the usual thing, regardless of what may be the true facts as to inventorship.

This is one aspect of what in research organizations is called the conflict between the creative mind and the administrative mind, which conflict must be kept under control.

In the past, when a Government section chief has insisted that his name should be added as joint applicant to an application for patent on an invention which, in fact, was made by one sole inventor in his section, the result has often been that this one inventor became absolutely sterile, did not try to make further inventions, and if he did make an invention refrained from reporting it to patent counsel.

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In an extreme case, a Government section chief, upon return from an extended European trip, found that entirely during his absence a man in his section had conceived and completed a meritorious invention. The section chief insisted that his name should appear in the patent application as a joint applicant. Under administrative duress, the true inventor felt himself forced to comply, but never again during a subsequent long tenure of office made a single invention. This instance is not unusual.

The following comments are submitted as to specific sections of the bill:

Section 8—Library: In the Department of Commerce appropriation there should be a separate item for the purchase of scientific and legal books and periodicals for the Patent Office Library, as there always was prior to 1932. Under the present practice of lumping such purchases for the library in with many other contingent expenses, the funds actually available for the purchase of books and periodicals are insufficient. This and various other points regarding the Scientific Library of the Patent Office have been covered in my statement before the House Committee on Patents, hearings on general revision of the patent laws, January 25–28, February 16, 17, 1932, Seventy-second Congress, first session, pages 262–277, and in statements in subsequent hearings. Most of the comments contained in that statement are still applicable.

Section 9—Classification: Reference is made to my statement before the House Committee on Patents, May 23, 1939, on H. R. 3605, Seventy-sixth Congress, first session; to the statement by Richard Spencer on February 17, 1932, before that committee, Seventy-second Congress, first session; and to the report of the Hoover Committee on Patent Office Procedure, April 15, 1926, mentioned at page 85 of the January–February 1932 hearings before the House Committee on Patents. Most of these comments are still applicable. At the end of section 9 it would be well to add a provision somewhat as follows: "and arrange to call to the attention of examiners by the preparation of bibliographical reference lists and otherwise references to books and articles in current periodicals of interest to the staff of the Patent Office in the performance of their duties."

The calling to the attention of examiners of current literature pertinent to their respective technical fields, is a necessary part of the duty of examining applications, imposed on the Commissioner by section 4893, Revised Statutes (U. S. C., title 35, sec. 36), section 131 of this bill. It is probable that the Classification Division is as a practical matter the only part of the Patent Office capable of doing this work. From approximately 1900 to 1912, this kind of work was done by the Classification Division. Particularly at the present time, examiners do not have available 4 or 5 hours a week to look for new literature in their field as it appears, and unless someone else brings it to their attention, they lose touch with the progress of the art.

Section 11—Publications: The following items are suggested for addition to the list of publications of the Patent Office.

"It shall be the duty of the Commissioner to cause to be compiled and printed periodically, compilations of brief illustrated abstracts of all United States patents issued during a given period, in readily understandable language."

The publication of such abstracts or digests would do much to increase the usefulness of the patent system to promote the progress of science and the useful arts, and to make patent literature a much more accessible and assimilable part of technical literature in general. The British Patent Office has for many years prepared and published volumes of such abstracts, and they have been very useful. It is understood that the procedure in the British Patent Office was for the assistant examiner in charge of an application, at the time he made his final review of an application before allowance, and when the interference search was made, to dictate the abstract to a stenographer, while he had the invention clearly in mind anyway, so that very little additional work has been involved. Compilations of such abstracts over a given period constitute a good review of the progress of a given art during that period In many technical fields in recent years, there has been an increased tendency to publish annual reviews of the progress in that field, but in general such reviews do not attempt to cover the patents in the field.

"It shall be the duty of the Commissioner to keep in print and on sale at the regular price for patents, the specifications and drawings of patent applications which have been hertofore printed by the Alien Property Custodian."

During the last war, the Alien Property Custodian printed the specifications and drawings of some thousands of patent applications which had been vested by him and had not matured into patents, to make them accessible to the public. The procedural details of printing and distributing such printed APC specifi-

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cations were taken care of by the Patent Office, which was reimbursed by APC. These printed specifications are now orphans, and not usually kept in print, although they constitute references. The Patent Office should assume responsibility for keeping them available The expense involved would be comparatively small.

"Pending applications for patents may be printed and published by the Commissioner, at the request and at the expense of the applicant or owner Such publication shall have the same effect as an issued patent for the purposes of section 102 (e) of this title."

This provision was the second paragraph of section 121 of H R. 9133 (81st Cong.) and has met with considerable approval. It is understood that it was eliminated from the redrafts of the coordinating committee meeting in December 1950 by a close vote, and its advantages are believed to be apparent, and to have been heretofore amply discussed by others

12. Exchange of copies of patents with foreign countries. Attention is called to the fact that no printed copies of Russian patents have been received by the United States Patent Office since 1927. It would probably be cheaper to purchase these Russian patents, which are far less numerous than United States patents, than to exchange. It is understood that the Russian Government has a standing purchase order for quite a number of copies of every United States patent as it is issued.

13 Copies of patents for public libraries. It is suggested that consideration be given to inserting in line 2, after "in the United States", the words "and Canada". It is believed that if any library in Toronto or Montreal, or other large city of Canada other than Ottawa, desires to have a set of United States patents on file, they should be extended the same privileges as are extended to a library in the United States. Such United States patents in Montreal or Toronto, would be used by many United States citizens and corporations who are industrially active in those Canadian cities, and the very close industrial relations between Canada and the United States will justify this courtesy There is, of course, a set of United States patents in the Canadian Patent Office at Ottawa, although it bas a gap in 1911–12.

As to the present language of section 13 and related section 41–a–9, it appears to be the legislative intent that a public library may obtain the patents issued in 1 year at the rate of $50 a year for previous years as well as the current year, and that the authority of the Commissioner to so supply patents to public libraries is directory rather than permissive. If the authority is not directory, presumably some provision should be made for review of a refusal by the Commissioner to furnish patents to public libraries at this rate. Attention is called to the repeal by this present bill of the act of June 15, 1950, Public Law 549, chapter 249, as to libraries securing at the special rate, patents for preceding years. It appears that the report on the present bill should bring out that the intent is that section 13 shall include the furnishing to libraries of patents for previous years.

102 (d) It is believed that the requirement of the present law should be retained, that no valid United States patent can issue on a United States application based on a foreign patent application, if the United States application is filed outside the convention, that is more than 12 months after the first foreign application, if the foreign application matures into a foreign patent before the United States patent issues. This has had a salutary effect in getting foreigners to file in the United States promptly if they are going to file at all, if this requirement is repealed many foreigners are so dilatory that they will file in the United States long after the convention period has expired, and will impose on the United States Patent Office an increased search burden including search to see whether the corresponding foreign patent has issued Foreign applicants already impose a sufficiently difficult burden on the United States Patent Office, without increasing that burden.

Section 104—Invention made abroad: The last sentence of this section appears to be too broad, and somewhat indefinite as to just what classes of persons are entitled to the benefits It seems probable that this second sentence should be limited to citizens of the United States who are serving in he Armed Forces of the United States abroad. Most any citizen of any country can claim domicile in the United States and can claim that he has been serving in a foreign country with operations on behalf of the United States, and a difficult question is presented.

Section 115—Oath of applicant: The following is suggested to be added at the end of the section

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"In Canada, the oath may be made under his seal of office before a notary public authorized by the laws of the Dominion of Canada or any Province or governmental division thereof to administer oaths as if such notary public were acting within the United States, without diplomatic or consular certificate of authority being necessary."

Experience shows that the official functions of Canadian notaries are carried out with as great decorum and rigor and dependability as those of notaries within the United States. Canadian inventors file many applications in the United States, and an appreciable number of United States citizens living in Canada execute United States patent applications in Canada. It is believed that the official seal of a Canadian notary is sufficient attestation of his authority. The legal system of Canada is much more closely assimilated to that of the United States than is true for any other country. The suggested provision would relieve applicants executing applications in Canada from an unnecessary burden.

Section 116—Joint inventors, section 118, filing by other than inventor: These have been discussed in detail at the beginning of this statement

The following section is submitted for consideration, probably to be inserted following section 119.

"Any patent application claiming the priority of a foreign application which has become abandoned, or upon which a United States patent has not issued within 4 years from the date of the earliest foreign application on which priority is claimed, shall become open to public inspection, and in the discretion of the Commissioner may be printed in form similar to the form of a regular patent."

A provision of this kind was in force in Great Britain for many years. It is the intent of the patent laws that the disclosures filed in the Patent Office and the applications upon which examiners expend much time and energy, shall become available to the public Foreign applicants often impose upon and abuse the United States Patent Office and the American taxpayer, by filing applications in the United States, not with good faith and intent to prosecute the application in good faith in the effort to have a patent issued, but just to get the benefit of the official search of the United States examiner which is much better than that of the Patent Office of his own country, or just to have an application pending in case of a possible interference, and with the intention of probably abandoning the application if he does not get just the claims he wants, or the interference does not develop, and with no real intent that a United States patent shall ever issue. Some foreigners file applications in the United States and execute the application oath after they have received an action by the Patent Office in their own country citing a knock-out reference which they hope the United States examiner will not find, and consider the oath a meaningless formality. If a foreign inventor imposes his application on the United States Patent Office, it is only a fair bargain that he shall give the United States public the benefit of access to his disclosure after 4 years, or after abandonment, and if the disclosure has particular value it should be printed. The present practice of permitting foreigner applicants to file and prosecute applications and then abandon them witbout making them public, is unfair to the American taxpayer and contrary to the spirit of the patent system.

Section 120—Benefit of earlier filing date in the United States: The phrase "termination of proceedings on" in line 6 is believed to be vague and likely to cause difficulty in interpretation. This phrase is probably unnecessary to accomplish the desired intent.

It is believed that the broad provisions of this section make it apparent that, as commented under section 154, the term of a patent should not extend longer than 20 years from the earliest United States filing date whose benefit is claimed. If this limitation is not imposed, an endless chain of continuing applications can be created, carrying effective filing date far back, which has been one of the criticisms of the United States patent system heard for years, particularly before the Temporary National Economic Committee. Also, the practice of filing a carelessly prepared application, getting criticism and references thereon, refiling, and perhaps re-refiling, trying to make the examiner do the work of properly preparing the application, should be discouraged by limiting the term of a patent so obtained.

A proposed new section, as to provisional caveats, probably to follow section 122, is suggested for consideration.

Section 122a—Provisional caveat: Any person who has invented or discovered any new and useful art, machinery, manufacture or composition of matter, or any new and useful improvements thereof, and desires further time to

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mature the same, may, on payment of the fees required by law, file in the Patent Office a provisional caveat setting forth a written description of the same and of its distinguishing characteristics and the manner and process of making, constructing, compounding and using it, and praying protection until he shall have matured his invention. Such person may within 2 years of the date of filing such provisional caveat, file in the Patent Office a complete application for patent as provided for in section 111 of this title, and the application so filed shall have the benefit of the date of filing such provisional caveat for all subject matter actually disclosed in such provisional caveat. Such provisional caveat shall be executed under oath in the same manner as is provided for an application under section 111 by section 115.

There is nothing new about caveats, or provisional patent applications. They were provided for in the United States in the Patent Act of July 4, 1836, section 12, the act of July 8, 1870, section 40, and in section 4902 of the Revised Statutes (1874), and the act of March 3, 1903. They were abolished by the act of June 25, 1910, for reasons which are not clear, but probably involved the difficulty of making interference searches among caveats. A provisional caveat can be useful without requiring that the person filing the caveat be notified by the Patent Office if a regular application to conflicting subject matter is filed. The provision above suggested omits such interference searches.

It appears that at present there is a well-defined demand for a secret Government repository where, for a nominal fee, inventors may simply provisionally file disclosures of their inventions, without having any plan that the disclosure in that form should be examined for patentable novelty, or ever become a patent. Certain attorneys have for years held themselves ready to receive and preserve in their files, disclosures of inventions sent in by inventors, and it has been understood that a considerable number of such disclosures have been sent in for such filing. It is believed to be apparent that if such a repository is to be maintained, it should be under Government control. The Government in 1940 instituted the National Inventors Council, one of whose functions was to provide a repository to which inventors could send disclosures of inventions thought to be useful in the national defense. Various bills relating to the Office of Technical Services of the Department of Commerce have provided for extending the scope of such a Government repository for disclosures of inventions.

It would seem that if any repository for filing such disclosures is to be provided in the Department of Commerce, it should be in the Patent Office.

The British patent law has for a long time provided for the filing of provisional applications, the benefit of whose filing date could be used in the later filed complete application, as to matter actually disclosed in the provisional application. Caveats have been in effect in Canada for a long time.

Section 122—Confidential status of applications: It is believed that the present imposition of secrecy by the Rules of Practice is sufficient, and that in his discretion it should be possible for the Commissioner in suitable cases and with proper procedure, to make applications accessible to persons outside the Patent Office. The phrase at the end of section 122 as now drafted "or in such special circumstances as may be determined by the Commissioner," begs the whole question. If the Commissioner is to exercise discretion, this provision of law is not necessary and the existing rule is sufficient. One of the proposals to combat long-pending applications, before the House Committee on Patents, particularly at the hearings in January, February, March, 1932, has been to open to public inspection all applications which have been on file for 3 years, or other term. It was then said by the chairman of the Patents Committee that he believed that the Commissioner already had that power without specific legislation, but it was nevertheless urged that specific authority of law was desirable as to such 3-year cases. Arguments particularly as to the probability of stirring up interferences were submitted against the proposal. However, if there is to be statutory negation of the power of the Commissioner in this matter, it should be enacted only after consideration of these 1932 and later proposals to use opening of applications to public inspection as a means to combat dilatory prosecution.

In section 131, it is believed that in line 3, following "law", the words "and that the same is sufficiently useful and important" which appear in the present law (R. S. 4893, 35 U. S. C. 36) and have been there for a long while, should be retained. Patents cannot avoid a de minimis rule, wholly separate from all other fields of the law.

Section 154—Contents and term of patent: It is suggested that consideration be given to adding in line 2 after "seventeen years," the words "or twenty years

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from the date of the earliest United States application the benefit of whose filing date is claimed, whichever term is shorter",

This has been discussed above under section 120. Some controls must be imposed against a chain of continuing applications, carrying the effective filing date way back. This practice has long been a serious criticism of the patent system, frequently expressed.

A new section is submitted for consideration as to citing references in files of issued patents, probably to follow section 154, as follows: (154–(a)): "Whenever after the issue of a patent, an officer or employee of the Patent Office shall find a reference to a patent or publication which he considers would have been a pertinent reference for the Patent Office to cite during the prosecution of the application resulting in such patent, he shall prepare and place in the patented application file of such patent a statement citing such reference and pointing out how it is applicable to such issued patent.

"Whenever after the issue of a patent, any person other than an officer or employee of the Patent Office shall find a reference to a patent or publication which he considers would have been a pertinent reference for the Patent Office to cite during the prosecution of the application resulting in such patent, such person may execute and file in the Patent Office an affidavit citing such reference and pointing out how it is applicable to such issued patent. The Commissioner shall cause such affidavit to be placed in the patented application file of such patent, unless he considers that the so-cited reference is wholly impertinent to the snbject matter of the patent."

This is a much simplified way of approaching the problem which has been in view in bills proposed in the past to publish patents for opposition. It is probable that the Commissioner already has power to do this without legislation, but he has never done so and it is doubtful if he will do so without statutory direction. After a patent issues, the public, in appraising the position which it occupies in the art, is entitled to the benefit of all pertinent references, including those previously existing but not found until after the patent issues. Certainly the public should be informed of every pertinent reference found by the staff of the Patent Office after a patent issues, to keep from the public information in the possession of the Patent Office which affects the scope or validity of an issued patent, is contrary to the orderly administration of justice. It not infrequently happens, not long after an assistant examiner has allowed an application and it has issued, that he find a reference which he would have cited if previously found, and he may note such reference on his own copy of such patent, but it is not in the patented file in the record room. This provision does not have in view any specific search for such references to issued patents, by the Patent Office, but simply the references found incidentally in the course of regular work. If a person outside the Patent Office finds a pertinent reference, and wishes it to appear in the patented file, the public is certainly entitled to that information.

Section 206—Misjoinder of inventor: This has been discnssed in some detail at the beginning of this statement.

Section 249—Notice of patent suits: The following changes are suggested:

Line 5 after "patent" insert "or application."

In line 8, after "judgment" insert "or the action or proceeding is stricken from the calendar."

At the end of the section, add:

"The clerk shall also include in such notice, a brief statement of the nature of the action or proceeding, and if the pleadings state one or more specific provisions of law under which such action or proceeding is brought, shall identify such provisions. Within one month after notice of an appeal or other appellate procedure is filed in a court of original jurisdiction or in an appellate court, the clerk of each such court shall give notice thereof to the Commissioner."

Also add at the end: "Tbis section shall apply to courts of appellate jurisdiction as well as to courts of original jurisdiction."

Experience over a period of years with the existing provision (the last sentence of R. S. 4921, 35 U. S. C. 70), has been that the notices sent to the Patent Office by clerks of United States courts are often insufficient to give a person exam'ning the notice in the patented file of tbe patent in which he is interested, any intelligent idea of the nature of the action which has been commenced, or its status, or if there has been judgment; what the effect of the judgment is. Tbe notice usually does not state, if there has been judgment, whether there was an opinion, or whether it was by consent. The person interested may find it neces-

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sary to correspond with the clerk of the court in the effort to obtain the most basic information as to what the case is all about. The notice does not usually state whether the suit is for infringement, or for declaratory judgment of invalidity or noninfringement, or for interference. The original intent of this provision, which was drafted by Robert F. Whitehead after long experience indicated its necessity, is not met by many of the notices which the Patent Office receives from court clerks, and more specific provision is needed.

The unsatisfactory experience with the way that court clerks prepare and send in these notices of suits, was discussed by Karl Fenning, former First Assistant Commissioner of Patents, at the hearings before the Houe Committee on Patents, May 9–10, 1940, on H. R. 9384 relating to disclaimers, at pages 21–22.

In general, as to the more controversial points presented by this bill, including the definition of invention and patentability, the definition that a "process" includes a new use, the provisions as to contributory infringement, and the limiting of pleadable defenses on infringement, it is believed that it would be better and make for more progress to take these provisions out of the present bill, and have individual separate bills and hearings on each of these controversial points, as Mr Lanham has suggested. While in their present form, I am not in favor of these present controversial sections of this bill, I have refrained from detailed comments thereon, in the hope that they would be later taken up in individual hearings, and also because I feel that they are sufficiently controversial so that others will point out objections thereto.

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81ST CONGRESS
2D SESSION

# H. R. 9133

## IN THE HOUSE OF REPRESENTATIVES

JULY 17, 1950

Mr. BRYSON introduced the following bill; which was referred to the Committee on the Judiciary

# A BILL

To revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents".

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That title 35 of the United States Code, entitled "Patents", is revised, codified, and enacted into law, and may be cited, "Title 35, United States Code, section—", as follows:

## TITLE 35—PATENTS


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### CHAPTER 1—PATENT OFFICE


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2. Seal.
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4. Restrictions on officers and employees as to interest in patents.
5. Bond of Commissioner and other officers.
6. Duties of Commissioner.
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Sec.
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PATENT FEES

41. Patent fees.
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## § 1. Establishment

The Patent Office shall continue as an office in the Department of Commerce, where records, books, drawings, specifications, and other papers and things pertaining to patents and to trade-mark registrations shall be kept and preserved except as otherwise provided by law.

## § 2. Seal

The seal provided for the Patent Office before July 8, 1870 is the seal of the Office, with which letters patent, certificates of trade-mark registrations, and papers issued from the Office shall be authenticated.

## § 3. Officers and employees

A Commissioner of Patents, one first assistant commissioner, two assistant commissioners, and nine examiners-in-chief, shall be appointed by the President, by and with the advice and consent of the Senate. The assistant commissioners shall perform the duties pertaining to the office of commissioner assigned to them by the Commissioner. The first assistant commissioner shall fill the office of Commissioner of Patents during a vacancy in that office until a Commissioner of Patents is appointed and takes office. All other officers, clerks, and employees shall be appointed by the Secretary of Commerce upon the nomination of the Commissioner of Patents in accordance with law.

## § 4. Restrictions on officers and employees as to interest in patents

All officers and employees of the Patent Office shall be incapable, during the period for which they hold their appointments and one year thereafter, of applying for a patent and of acquiring, directly or indirectly, except by inheritance or bequest, any patent or any right or interest in any patent, issued or to be issued by the Office, and if they apply for a patent thereafter they shall not be entitled to any

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priority date earlier than one year after the termination of their appointment.

**§ 5. Bond of commissioner and other officers**

The Commissioner and such other officers as he designates, before entering upon their duties, shall severally give bond, with sureties, the former in the sum of $10,000, and the latter in sums prescribed by the Commissioner, conditioned for the faithful discharge of their respective duties and that they shall render to the proper officers of the Treasury a true account of all money received by virtue of their offices.

**§ 6. Duties of commissioner**

The Commissioner, under the direction of the Secretary of Commerce, shall superintend or perform all duties required by law respecting the granting and issuing of patents and the registration of trademarks; and he shall have charge of things belonging to the Patent Office. He may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

**§ 7. Board of Appeals**

The examiners-in-chief shall be persons of competent legal knowledge and scientific ability. The Commissioner, the assistant commissioners, and the examiners-in-chief shall constitute a Board of Appeals, which, on written appeal of the applicant, shall review adverse decisions of examiners upon applications for patents. Each appeal shall be heard by at least three members of the Board of Appeals, the members hearing such appeal to be designated by the Commissioner. The Board of Appeals has sole power to grant rehearings.

Whenever the Commissioner considers it necessary to maintain the work of the board of appeals current, he may designate any patent examiner of the grade GS–13 or higher, having the requisite ability, to serve as examiner-in-chief for periods not exceeding six months each, and any examiner so designated shall be qualified to act as a member of the Board of Appeals. Not more than one such GS–13 grade examiner shall be among the members of the Board of Appeals hearing an appeal.

**§ 8. Library**

A library of scientific and other works and periodicals, both foreign and domestic, shall be maintained in the Patent Office to aid the officers in the discharge of their duties.

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**§ 9. Classification of patents**

The Commissioner may revise and perfect, and maintain, the classification by subject matter of United States letters patent, and such other patents and printed publications as may be necessary or practicable, for the purpose of determining with more readiness and accuracy the novelty of inventions for which applications for patent are filed.

**§ 10. Certified copies of records**

The Commissioner may furnish certified copies of specifications and drawings of patents issued by the Patent Office, and of other records available to the public or to the person applying, upon payment of the rates for uncertified copies and the fee for each certification.

**§ 11. Publications**

The Commissioner may print, or cause to be printed the following:

(a) Patents for inventions and designs, including specifications and drawings, together with copies of the same. The headings of the drawings for patents may be multigraphed in the Patent Office for the purpose of photolithography.

(b) Certificates of trade-mark registrations, including statements and drawings, together with copies of the same.

(c) The Official Gazette of the United States Patent Office, copies of which, and of the following publications, may be exchanged for publications desirable for the use of the Patent Office.

(d) Annual indexes of patents and patentees, and of trade-marks and registrants.

(e) Annual volumes of decisions of the Commissioner of Patents and of the United States courts in patent and trade-mark cases.

(f) Pamphlet copies of the patent laws and rules of practice, laws and rules relating to trade-marks, and circulars or other publications relating to the business of the Office.

**§ 12. Exchange of copies of patents with foreign countries**

The Commissioner may exchange copies of specifications and drawings of United States patents for those of foreign countries.

**§ 13. Copies of patents for public libraries**

The Commissioner may supply printed copies of specifications and drawings of patents to public libraries in the United States which he may approve and which shall maintain such copies for the use of the public, at the rate for each year's issue established for this purpose.

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### § 14. Annual report to Congress

The Commissioner shall lay before Congress annually a report giving a statement of moneys received and expended, statistics concerning the work of the Office, and such other information of the condition of the Office as may be useful to Congress or the public.

ACTIONS IN THE PATENT OFFICE

### § 21. Day for taking action falling on Saturday, Sunday, or holiday

Where the day, or the last day, for taking any action or paying any fee in the United States Patent Office falls on Saturday, Sunday, or a holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding secular or business day.

### § 22. Printing of papers filed

The Commissioner may require papers filed in the Patent Office to be printed or typewritten.

### § 23. Testimony in Patent Office cases

The Commissioner may establish rules for taking affidavits and depositions required in cases pending in the Patent Office, and such affidavits and depositions may be taken before any officer authorized by law to take depositions to be used in the courts of the United States, or of the State where the officer resides.

### § 24. Subpoenas, witnesses

The clerk of any court of the United States, for any district or Territory wherein testimony is to be taken for use in any contested case pending in the Patent Office, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district or Territory, commanding him to appear and testify before an officer in such district or Territory authorized to take depositions and affidavits at the time and place stated in the subpoena. No witness shall be required to attend at any place more than one hundred miles from the place where the subpoena is served upon him: and the provisions of the Federal Rules of Civil Procedure relating to the issuance of subpoenas duces tecum shall apply to contested cases in the Patent Office.

Every witness subpoenaed and in attendance shall be allowed the fees and traveling expenses allowed to witnesses attending the courts of the United States.

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Whenever any witness, after being duly served with such subpoena, neglects or refuses to appear, or after appearing refuses to testify, a judge of the court whose clerk issued the subpoena may, on proof of such neglect or refusal, enforce obedience to the process, or punish the disobedience, as in other like cases. But no witness shall be deemed guilty of contempt for disobeying such subpoena, unless his fees and traveling expenses in going to, returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret invention or discovery made or owned by himself.

PRACTICE BEFORE PATENT OFFICE

### § 31. Regulations for agents and attorneys

The Commissioner, subject to the approval of the Secretary of Commerce, may prescribe regulations governing the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Patent Office, and may require them, before being recognized as representatives of applicants or other persons, to show that they are of good moral character and reputation, are possessed of the necessary qualifications to render to applicants or other persons valuable service, and to advise and assist them in the presentation or prosecution of their applications or other business before the Office.

### § 32. Suspension or exclusion from practice

The Commissioner may, after notice and opportunity for a hearing, suspend or exclude, either generally or in any particular case, from further practice before the Patent Office any person, agent, or attorney shown to be incompetent or disreputable, or guilty of gross misconduct, or who does not comply with the regulations established under section 31 of this title, or who shall, with intent to defraud in any manner, deceive, mislead, or threaten any applicant or prospective applicant, or other person having immediate or prospective business before the Office. The reasons for any such suspension or exclusion shall be duly recorded. The action of the Commissioner may be reviewed upon the petition of the person so refused recognition or so suspended or excluded by the United States District Court for the District of Columbia under such conditions and upon such proceedings as the said court may by its rules determine.

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### § 33. Unauthorized representation as practitioner

Whoever, not being recognized to practice before the Patent Office, holds himself out or permits himself to be held out as so recognized, shall be fined not more than $1,000.

PATENT FEES

### § 41. Patent fees

The following shall be the rates for patent fees:

(a) On filing each original application for a patent, except in design cases, $30, and $1 for each claim in excess of twenty.

(b) On issuing each original patent, except in design cases, $30, and $1 for each claim in excess of twenty.

(c) In design cases: For three years and six months, $10; for seven years, $15; for fourteen years, $30.

(d) On every application for the reissue of a patent, $30.

(e) On filing each disclaimer, $10.

(f) On an appeal for the first time from the examiner to the Board of Appeals, $25.

(g) On filing each petition for the revival of an abandoned application for a patent or for the delayed payment of the fee for issuing each patent, $10.

(h) For certificate of correction of applicant's mistake under section 205 of this title, $10.

(i) For uncertified printed copies of specifications and drawings of patents (except design patents), 25 cents per copy; for design patents, 10 cents per copy; special rate for libraries specified in section 13 of this title, $50 for patents issued in one year.

(j) For recording every assignment, agreement, power of attorney, or other paper not exceeding six pages, $3; for each additional two pages or less, $1; for each additional patent or application included or involved in one writing, where more than one is so included or involved, 50 cents additional.

(k) For each certificate, $1.

(l) For copies of records, publications, or services furnished by the Patent Office, not specified above, for which a charge may be made, such reasonable charge for the same as may be established.

### § 42. Payment of patent fees; return of excess amounts

All patent fees shall be paid to the Commissioner who shall deposit the same in the Treasury of the United States in such manner as the Secretary of the Treasury shall direct, and the Commissioner is authorized to pay back any sum or sums of money paid to him by any person by mistake or in excess of the fee required by law.

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# CHAPTER 2—PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS

PATENTABILITY OF INVENTIONS

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PATENTABILITY OF INVENTIONS

## § 101. Inventions patentable

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, may obtain a patent therefor upon making application for a patent, subject to the conditions and requirements of this title.

An invention in the nature of a discovery as embodied in a new and useful art, machine, manufacture or composition of matter, or new and useful improvement thereof may be patented. The term "invention" when used in this title includes such discoveries.

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The term "art", when used in this title, includes a new use of a known material.

**§ 102. Conditions for patentability. Novelty and loss of right to patent**

An invention shall not be considered new or capable of being patented if

(a) the invention was known or used by others in this country, or patented or described in any printed publication in this or any foreign country, before the invention thereof by the applicant for patent, or if

(b) the invention was patented or described in any printed publication in this or any foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or if

(c) the invention is proved to have been abandoned, or if

(d) the invention was first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country, except as provided by section 118 of this title, or if

(e) the invention was described in an application for patent by another filed in the United States before the invention thereof by the applicant for patent, which first-mentioned application issued as a patent or was published in accordance with section 121, or if

(f) the applicant knew at the time of making his application for patent that he was not the original and first inventor of any material and substantial part of the thing sought to be patented, or if

(g) the invention was in fact invented before the applicant's invention thereof by another who had not abandoned the invention and who was using reasonable diligence in adapting and perfecting the same.

**§ 103. Conditions for patentability, non-obvious subject matter**

A patent may not be obtained though the invention is not identically disclosed or described in the material specified in section 102 of this title, if the differences between the subject matter sought to be patented and said material are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.

Patentability as to this condition shall be determined by the nature of the contribution to the art, and shall not be negatived by the manner in which such contribution may have been accomplished.



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### § 104. Invention made abroad

In proceedings in the Patent Office and in the courts, an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country, other than the filing in a foreign country of an application for a patent for the same invention by reason of which his application for patent in the United States is entitled to have the same force and effect as if filed in the United States on the date on which it was filed in such foreign country.

APPLICATION FOR PATENT

### § 111. Application for patent

Application for patent shall be made by the inventor in writing to the Commissioner. Such application shall include: (1) a specification as prescribed by section 112 of this title; (2) a drawing as prescribed by section 113 of this title; and (3) an oath by the applicant as prescribed by section 115 of this title. The application must be signed by the applicant and accompanied by the fee required by law.

### § 112. Specification

The specification shall contain a written description of the invention, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

### § 113. Drawings

When the nature of the case admits of drawings, the applicant shall furnish one copy signed by the inventor or his attorney in fact.

### § 114. Models, specimens

When the nature of the case admits of representation by model, the Commissioner may require the applicant to furnish a model of convenient size to exhibit advantageously the several parts of his invention.

When the invention relates to a composition of matter, the Commissioner may require the applicant to furnish specimens or ingredients for the purpose of inspection or experiment.

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**§ 115. Oath of applicant**

The applicant shall make oath that he believes himself to be the original and first inventor of the art, machine, manufacture, composition, or improvement, for which he solicits a patent and that he does not know and does not believe that the same was known or used before his invention; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by certificate of a diplomatic or consular officer of the United States, and such oath shall be valid if it complies with the laws of the state or country where made.

**§ 116. Joint inventors**

When an invention is made by two or more persons jointly, they shall apply for patent jointly and each sign the application and make the required oath, except as otherwise provided in this title.

If a joint inventor refuses to join in an application for patent or cannot be found after diligent inquiry, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Commissioner, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor making the application, subject to the rights of the omitted inventor. The omitted inventor may join in the application when found.

Whenever a person was joined in an application for patent as joint inventor by inadvertent error, or a joint inventor was not included in an application by inadvertent error, the Commissioner may permit the application to be appropriately amended, under such terms as he prescribes.

**§ 117. Death or insanity of inventor**

The Commissioner is authorized to receive applications of and to issue patents to legal representatives of deceased inventors and those under legal incapacity, upon compliance with such requirements and on the same terms and conditions applicable to the inventor, and the oath required to be made shall be so varied in form that it can be made by them.

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**§ 118. Right of priority based on foreign application**

An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which, by treaty, convention, or law, affords similar privileges in the case of applications filed in the United States or to citizens of the United States, shall have the same force and effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, provided the application in this country is filed within twelve months from the earliest date on which any such foreign application was filed. But no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in this or any foreign country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing.

No application or patent shall be entitled to the right of priority based on a foreign application as provided for by the preceding paragraph unless a claim for such right of priority and a copy of the original foreign application (with the specification and drawings if any) upon which it is based, certified as correct by the patent office of the country in which filed (which certificate shall also show the date of the application and of the filing of the specification and other papers if different therefrom), are filed in the Patent Office before the patent is granted, or before such time during the pendency of the application, as may be required by the Commissioner provided the same is not earlier than six months after the filing of the application in this country. The Commissioner may require a translation of the papers filed if not in the English language and such other information as he may deem necessary.

**§ 119. Benefit of earlier filing date in the United States**

An application for patent for an invention disclosed in the manner provided by section 112 of this title in an application previously filed in the United States by the same inventor shall have the same effect, as to such invention, as though filed on the date of the prior application, if, and to the extent that, the disclosure of the later application has been continuously pending in the Patent Office since the date of the prior application and if the later application contains a specific reference to the earlier filed application.

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### § 120. Divisional applications

If two or more independent or distinct inventions are claimed in one application, the Commissioner may in his discretion require the application to be restricted to one of the inventions; and the other invention or inventions may be made the subject of divisional applications. A divisional application shall be entitled to the benefit of the filing date of the original application if it complies with the requirements of section 119 of this title. If two or more patents are issued in consequence of a requirement for restriction under this section, neither patent may be used as a reference against the other for the purpose of section 103 of this title. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, signing and execution by the inventor may be dispensed with.

### § 121. Confidential status of applications

Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of this or any other law or in such special circumstances as may be determined by the Commissioner.

Pending applications for patents may be printed and published by the Commissioner, at the request and at the expense of the applicant or owner. Such publication shall have the same effect as an issued patent for the purposes of section 102 (e) of this title.

EXAMINATION OF APPLICATION

### § 131. Examination of application

The Commissioner shall cause an examination to be made of the application and the alleged new invention: and if on such examination it appears that the applicant is justly entitled to a patent under the law, the Commissioner shall issue a patent therefor as provided in this chapter.

### § 132. Notice of rejection

Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined.

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**§ 133. Time for prosecuting application**

Upon failure of the applicant to prosecute the application within six months (or such shorter time, not less than thirty days or any extensions thereof, as shall be fixed by the Commissioner and the applicant notified thereof in writing) after any action therein, of which notice shall have been given or mailed to the applicant, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

**§ 134. Appeal to the Board of Appeals**

An applicant for a patent, any of whose claims have been twice rejected, may appeal from the decision of the examiner to the Board of Appeals, having once paid the fee for such appeal.

**§ 135. Interferences**

Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of three examiners of interferences. The judgment of the board adverse to the claim of an applicant shall constitute a final refusal of the claims involved by the Patent Office and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. Judgment adverse to a patentee when final shall constitute cancellation of the claims involved from the patent.

No amendment for the first time presenting or asserting a claim which is the same as, or for substantially the same subject matter as, a claim of an issued patent may be made in any application unless such amendment is filed within one year from the date on which said patent was granted.

REVIEW OF PATENT OFFICE DECISIONS

**§ 141. Appeal to Court of Customs and Patent Appeals**

An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Customs and Patent Appeals, in which case he waives his right to proceed under section 145 of this title. A party to an interference dissatisfied with the decision of the board of interference examiners on the question of priority may appeal to the United States Court of Customs and Patent Appeals, but such appeal shall be dismissed if any adverse party to such interference shall, within twenty days after the appellant shall have

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filed notice of appeal according to section 142 of this title, file notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 146 of this title. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under section 146, in default of which the decisions appealed from shall govern the further proceedings in the case.

**§ 142. Notice of appeal**

When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and file in the Patent Office, within such time as the Commissioner appoints, his reasons of appeal, specifically set forth in writing.

**§ 143. Proceedings on appeal**

The court shall, before hearing such appeal, give notice of the time and place of the hearing to the Commissioner and the parties thereto. The party appealing shall lay before the court certified copies of all the necessary original papers and evidence in the case, and the Commissioner shall furnish the court with the grounds of the decision of the Patent Office, fully set forth in writing, touching all the points involved by the reasons of appeal.

**§ 144. Decision on appeal**

The court, on petition, shall hear and determine such appeal on the evidence produced before the Patent Office, at such early and convenient time as the court may appoint; and the decision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and govern the further proceedings in the case.

**§ 145. Civil action to obtain patent**

An applicant dissatisfied with the decision of the Board of Appeals may, unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action, if commenced within sixty days after such decision. The court having cognizance thereof may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved, as the facts in the case may appear. Such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on compliance with the requirements of

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law. A copy of the complaint shall be served on the Commissioner and all the expenses of the proceedings shall be paid by the applicant.

### § 146. Civil action in case of interference

Any party to an interference declared in accordance with section 135 of this title dissatisfied with the decision of the board of interference examiners on the question of priority, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by civil action, if commenced within sixty days after such decision or as provided in section 141 of this title. In all suits brought hereunder the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice to the right of the parties to take further testimony. The testimony and exhibits or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

Such civil action may be commenced against the party or parties in interest as shown by the records of the Patent Office, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction. The Commissioner shall not be a necessary party but he shall be notified of the filing of the action by the clerk of the court in which it is filed and shall have the right to intervene in the action.

#### ISSUE OF PATENT

### § 151. Time of issue of patent

The patent shall issue within three months from the date of the payment of the final fee, which fee shall be paid not later than six months from the time when notice of allowance of the application was sent to the applicant; and if the final fee is not paid within that period the patent shall be withheld. The Commissioner may in his discretion receive the final fee if paid within one year after the six months' period for payment has passed and the patent shall issue.

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**§ 152. Issue of patent to assignee**

Patents may be granted to the assignee of the inventor but the assignment must first be entered of record in the Patent Office, and the application must be made and the specification sworn to by the inventor, except as otherwise provided in this title.

**§ 153. How issued**

All patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall either be signed by the Commissioner or have his signature placed thereon and attested by an officer of the Patent Office designated by the Commissioner, and shall be recorded in the Patent Office.

**§ 154. Contents and term of patent**

Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the right to exclude others from making, using, or selling the invention throughout the United States and the territories thereof, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof.

PATENTS OF ADDITION

**§ 161. Patents of addition**

Whenever an application is made for a patent for an improvement on or modification of an invention for which the applicant has previously applied for or obtained a patent, or when an application for patent for an improvement is owned by the same person who owns the prior application or patent, the Commissioner may at the request of the applicant issue the patent for the improvement as a patent of addition. A patent of addition shall not be granted before the grant of the main patent, and the term of a patent of addition shall expire on the same date as the main patent. A patent of addition shall not be refused nor held invalid solely on the ground that the subject matter thereof may not be considered to involve invention, within the meaning of section 103, over the invention of the main patent or other patents of addition thereto, provided the subject matter claimed in a patent of addition is included within the scope of a claim of the main patent.



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# CHAPTER 3—PATENTS AND PROTECTION OF PATENT RIGHTS

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AMENDMENT AND CORRECTION OF PATENTS

## § 201. Reissue of defective patents

Whenever any patent is deemed wholly or partly inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming more or less than he had a right to claim in the patent, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the same invention, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

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The Commissioner may, in his discretion, cause several reissued patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters patent.

Application for reissue of a patent shall be made in the same manner as applications for patent and the provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the original patent, and except that the Commissioner shall publish notice of each application for reissue, and applications for reissue shall be open to the public.

No reissued patent shall be granted enlarging the scope of the original patent unless applied for within one year from the grant of the original patent.

**§ 202. Effect of reissue**

The surrender of the original patent shall take effect upon the issue of the reissued patent, and every patent so reissued shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally granted in such amended form, but in so far as the claims of the original and reissued patents are identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent to the extent that its claims are identical with the original patent shall constitute a continuation thereof and have effect continuously from the date of the original patent.

No reissued patent shall abridge the right of any person or his successors in business to continue the manufacture, use and sale in any amount of anything commenced, or for the manufacture, use or sale of which substantial preparation was made, before the filing of the application for such reissue, which did not constitute an infringement of the original patent.

**§ 203. Disclaimer of invalid claim**

Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid, and the patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of the invalid claim, stating therein the extent of his

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interest in such patent. Such disclaimer shall be in writing, and recorded in the Patent Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him after the record thereof.

**§ 204. Certificate of correction of Patent Office mistake**

Whenever a mistake in a patent, incurred through the fault of the Patent Office, is clearly disclosed by the records or files of the Office, a certificate stating the fact and nature of such mistake, signed by the Commissioner and sealed with the seal of the Patent Office, may be issued, without charge, and recorded in the records of patents, and a printed copy thereof attached to each printed copy of the patent, and such certificate shall thereafter be considered as part of the original patent, and every such patent, together with such certificate, shall have the same effect and operation in law on the trial of all actions for causes thereafter arising as if the same had been originally issued in such corrected form. In the discretion of the Commissioner, a corrected patent may be issued without charge in lieu of a certificate of correction.

**§ 205. Certificate of correction of applicant's mistake**

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Commissioner may, upon payment of the required fee, issue a certificate of correction, provided that the correction does not involve such changes in the patent as would require re-examination, and every such patent, together with such certificate, shall have the same effect and operation in law on the trial of all actions for causes thereafter arising as if the same had been originally issued in such corrected form.

**§ 206. Misjoinder of inventor**

Whenever a patent has been issued on the application of two or more persons as joint inventors and it appears that one of such persons was not in fact a joint inventor, and that he was included as a joint inventor by inadvertence or mistake and without any fraudulent or deceptive intention, the Commissioner may, on application of all the parties and the assignee if any, with proof of the facts and such other requirements as may be imposed, issue a certificate deleting the name of the erroneously joined person from the patent as a joint inventor.

Whenever a patent has been issued on the application of a person as a sole inventor, or on the application of two or more persons as

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joint inventors, and it appears that an additional person was in fact a joint inventor with the applicant or applicants and should have been included as a joint inventor, but was not included through inadvertence or mistake and without any fraudulent or deceptive intention, the Commissioner may, on application of all the parties and the assignee if any, with proof of the facts and such other requirements as may be imposed, issue a certificate adding the name of the erroneously omitted person to the patent as a joint inventor.

No patent shall be held invalid solely because of misjoinder or nonjoinder of a joint inventor, if such error can be corrected in the manner specified in this section, and the court before which such matter may be called in question may order correction of the patent on notice and hearing of all parties concerned.

OWNERSHIP AND ASSIGNMENT

**§ 211. Ownership; assignment**

Subject to the provisions of this title, patents shall be protected as and have the applicable rights of other property, and the rules of law applicable to the ownership and devolution of personal property generally shall apply to patents as they apply to other intangible property.

Every application for patent, or patent, or any interest therein, shall be assignable in law by an instrument in writing, and the applicant or patentee or his assigns or legal representatives may in like manner grant and convey an exclusive right under his application for patent, or patent, to the whole or any specified part of the United States.

If any such assignment, grant, or conveyance of any application for patent, or patent, shall be acknowledged before any person within the United States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in a foreign country whose authority shall be proved by certificate of a diplomatic or consular officer of the United States, the certificate of such acknowledgment, under the hand and official seal of such notary or other officer, shall be prima facie evidence of the execution of such assignment, grant or conveyance.

An assignment, grant or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration,

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without notice, unless it is recorded in the Patent Office within three months from its date, or prior to the date of such subsequent purchase or mortgage.

The word "patentee" when used in this title includes not only the patentee to whom the patent was issued but also the successors in title to the patentee.

### § 212. Joint owners

Whenever two or more persons own a patent jointly, either by the issuing of the patent to them jointly or by reason of the assignment of an undivided interest in the patent or by reason of succession in title to such interest, each of the joint owners, in the absence of any agreement to the contrary, shall be entitled to make, use or sell the patented invention, or license others so to do, or assign or encumber his interest without accounting to the other joint owners.

GOVERNMENT INTERESTS IN PATENTS

### § 221. Issue of patents without fees to Government officers for inventions used in public service

The Commissioner may grant, subject to the requirements of this title, to any officer, enlisted man, or employee of the Government, except officers and employees of the Patent Office, a patent without the payment of any fee, when the head of the department or agency certifies such invention is used or likely to be used in the public interest and the applicant in his application states that the invention described therein, if patented, may be manufactured and used by or for the Government for governmental purposes without the payment to him of any royalty thereon, which stipulation shall be included in the patent.

### § 222. Time for taking action in Government applications

Notwithstanding the provisions of sections 133, 145, and 151 of this title, the Commissioner may extend the time for taking any action to three years, in the case of any application which has become the property of the Government of the United States and with respect to which the head of the appropriate department or agency of the Government has certified to the Commissioner that the invention disclosed therein is important to the armament or defense of the United States.

### § 223. Inventions of Government employees

The President may prescribe regulations governing the ownership of the patent rights to inventions made by officers and employees of the Government during the course of or in consequence of their employment.

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## § 231. Infringement of patent

(a) Any person who makes, uses or sells any patented machine, manufacture, composition of matter or improvement, or uses any patented process or improvement, within the territory of the United States and its Territories during the term of the patent therefor without authority, infringes the patent and shall be liable to a civil action for infringement, except as otherwise provided in this title.

(b) Any person who, after actual notice to him, imports into or uses or sells within the United States or its Territories any product produced in a foreign country by the use of a process covered by a United States patent shall be liable for infringement.

(c) Any person who actively induces infringement of a patent shall be liable as an infringer.

(d) Any person who contributes to the infringement of a patent in the manner set forth in paragraph (c) of this section shall be liable as an infringer.

(e) The sale of a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, if a material part of the invention and especially made or especially adapted for use in an infringement of such patent, and not suitable for substantial noninfringing use, shall constitute contributory infringement.

(f) The mere sale of any staple article or commodity of commerce not especially made or especially adapted for use in a patented invention, and suitable for substantial noninfringing use, shall not of itself constitute contributory infringement, even though sold with the knowledge or expectation that it will be used in an infringement of the patent.

(g) No patent owner otherwise entitled to relief for infringement or contributory infringement of a patent shall be denied relief or deemed guilty of misuse or illegal extension of the patent right because he has done one or more of the following: (1) derived revenue from acts which if performed by another without his consent would constitute contributory infringement of the patent; (2) licensed or authorized one or more persons to perform acts which if performed without his consent would constitute contributory infringement of the patent; (3) sought to enforce his patent rights against infringement or contributory infringement.

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### § 232. Experimental use of invention

The making or using of a patented invention solely for the purpose of research or experiment, or for instruction, in connection with the patented invention, and not for sale or for the making of anything for sale, shall not constitute infringement, without prejudice to the rights of the patentee against anyone who makes for sale or sells the patented invention which may be subsequently used for such non-infringing use.

### § 233. Temporary presence in the United States

No patent shall prevent the use of any invention in any ship, vessel, aircraft or land vehicle of any other country entering the territory of the United States temporarily or accidentally, and such use shall not constitute infringement of any patent, provided such invention is used exclusively for the needs of the ship, vessel, aircraft or land vehicle and is not sold in or used for the manufacture of anything to be sold in or exported from the United States.

### § 234. Use by the Government

Whenever an invention described in and covered by a patent of the United States is used or manufactured by or for the United States without license of the owner thereof or lawful right to use or manufacture the same, the owner's remedy shall be by action against the United States in the Court of Claims or in the District Court of the United States of the district of which such owner is a resident (or, if the owner is not a resident of any district, in the District Court of the United States for the District of Columbia) for the recovery of his reasonable and entire compensation for such use and manufacture. The court shall not award compensation under this section if the claim for compensation is based on the use or manufacture by or for the United States of any article owned, leased, used by, or in the possession of the United States prior to July 1, 1918. This section shall not confer a right of action on any patentee who, when he makes such a claim, is in the employment or service of the Government of the United States, or any assignee of any such patentee, and shall not apply to any device discovered or invented by an employee during the time of such employment or service.

#### REMEDY FOR INFRINGEMENT OF PATENT, AND OTHER ACTIONS

### § 241. Remedy for infringement of patent

Any patentee shall have remedy for violation of any right secured by patent by a civil action for infringement.

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**§ 242. Defenses; presumption of validity**

In any action for infringement the defendant, in addition to absence of infringement or absence of liability for infringement may plead as a defense the invalidity of the patent or any claim thereof on any ground specified in chapter 2 of this title as a condition for patentability, or for failure to comply with the requirement of sections 112 or 201 of this title; or any fact or act made a defense by this title.

In all actions for infringement the party asserting invalidity or non-infringement of a patent shall give notice in writing to the adverse party at least thirty days before the trial, of the number, date, and name of the patentee of any patent, the title, date, and page numbers of any publication to be relied upon as anticipations of the patent in suit or as showing the state of the art, and the name and address of any person who may be relied upon as having prior knowledge of or as having previously used the invention of the patent in suit, and in the absence of such notice proof of the said matters may not be made at the trial.

A patent shall be presumed to be valid unless and until it has been held invalid by the final judgment of a court of competent jurisdiction from which no appeal is or can be taken, and the burden of establishing invalidity shall rest on any person asserting invalidity of the patent.

**§ 243. Injunction**

The several courts vested with jurisdiction of cases arising under this title shall have power to grant injunctions in accordance with the principles of equity to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable.

**§ 244. Damages**

In an action wherein a patent is held valid and infringed, the claimant shall be entitled to recover damages adequate to compensate for any loss suffered from the infringement, the award in no event to be less than a reasonable royalty for the use made of the invention by the infringer, together with such interest from the beginning of the infringement complained of and costs as may be fixed by the court.

When not found by a jury, the court shall assess the damages. In either event the court shall have the power, in its discretion, to increase the damages up to three times the amount found or assessed.

The court is authorized to receive expert testimony as an aid to the determination of damages or of what royalty would be reasonable

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under the circumstances, and such testimony shall be competent and admissible.

**§ 245. Attorney's fees**

The court may award reasonable attorney's fees to the prevailing party upon the entry of judgment.

**§ 246. Limitation on damages; time**

No recovery shall be had for any infringement committed more than six years prior to the commencement of the action.

**§ 247. Limitation on damages; marking and notice**

All patentees, and all persons making or selling any patented article for or under them, may give notice to the public that the same is patented, either by fixing thereon the word "patent" or the abbreviation "pat.", together with the number of the patent, or when, from the character of the article, this can not be done, by fixing to it, or to the package wherein one or more of them is contained, a label containing the like notice. In any suit for infringement by the party failing so to mark, no damages shall be recovered by the patentee, except on proof that the infringer was duly notified of the infringement and continued to infringe after such notice.

**§ 248. Suit for infringement when a claim may be invalid**

Whenever, through inadvertence, accident, or mistake and without any fraudulent or deceptive intention, any claim of a patent is invalid, an action may be maintained for the infringement of any claim of the patent which may be valid, notwithstanding the invalid claim. But in every such case in which a judgment or decree shall be rendered for the patentee no costs shall be recovered unless a proper disclaimer of the invalid claim has been entered at the Patent Office before the commencement of the suit.

**§ 249. Notice of patent suits**

The clerks of the courts of the United States shall within one month after the filing of any action, suit, or proceeding arising under the patent laws, give notice thereof in writing to the Commissioner, setting forth in order so far as known the names and addresses of the parties, names of the inventors, and the designating number or numbers of the patent or patents upon which the action, suit, or proceeding has been brought, and in the event any other patent or patents be subsequently included in the action, suit, or proceeding by amendment, answer, cross bill, or other pleading, the clerk shall give like notice thereof to the Commissioner, and within one month after the decision is rendered or a judgment issued the clerk of the court shall

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give notice thereof to the Commissioner, and the Commissioner shall, on receipt of such notice forthwith, endorse the same upon the file wrapper of the said patent or patents, and incorporate the same as a part of the contents of said file wrapper.

**§ 250. Interfering patents**

Whenever there are interfering patents, the owner of any one of them may have relief against the owner of the other by civil action, and the court may adjudge the question of the validity of any of the interfering patents, in whole or in part. The provisions of the second paragraph of section 146 of this title shall apply to actions brought under this section.

**§ 251. False marking**

(a) Whoever without the consent of the patentee, marks upon, or affixes to or uses in advertising associated with, anything made, used, or sold by him for which he has not obtained a patent, the name or any imitation of the name of the patentee, or the words "patent," "patentee" or the like with the intent of counterfeiting or imitating the mark of the patentee, or of deceiving the public and inducing them to believe that the thing was made or sold by or with the consent of the patentee; or

Whoever marks upon, or affixes to or uses in advertising associated with, any unpatented article, the word "patent" or any word importing that the same is patented, for the purpose of deceiving the public; or

Whoever marks upon, or affixes to or uses in advertising associated with, any article, the words "patent applied for," "patent pending" or any word importing that an application for patent has been made, when no application for patent has been made, or if made is not pending, for the purpose of deceiving the public—

Shall be fined not more than $500 for every such offense.

(b) Any person may sue for the penalty, in which event one-half shall go to the person suing and the other to the use of the United States.

**§ 256. Service and notice; non-resident patentee**

Every patentee not domiciled in the United States may designate by a notice in writing filed in the Patent Office the name and address of some person residing within the United States on whom may be served process or notice of proceedings affecting the patent or rights thereunder. Such notice or process may be served upon the person so designated; but if the person cannot be found at the address given

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in the last designation, or if no person has been designated, such notice or process may be served upon the Commissioner, who shall mail a copy to the address of the patentee as shown by the records of the Patent Office and shall publish a notice thereof in the Official Gazette. The court shall have the same jurisdiction to take any action respecting the patent or rights thereunder that it would have if the patentee were personally within the jurisdiction of the court.

## CHAPTER 4—PLANTS AND DESIGNS

PLANTS

Sec.
301. Patents for plants.
302. Description, claim.
303. Grant.
304. Assistance of Department of Agriculture.

DESIGNS

311. Patents for designs.
312. Right of priority.
313. Term of design patent.
314. Additional remedy for infringement of design patent.

PLANTS

### § 301. Patents for plants

Any person who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents, other than for designs, shall apply to patents for plants except as otherwise provided.

### § 302. Description, claim

No plant patent shall be declared invalid on the ground of non-compliance with section 112 of this title if the description is made as complete as is reasonably possible.

The claim in the specification shall be in formal terms to the plant shown and described.

### § 303. Grant

In the case of a plant patent the grant shall be of the right to exclude others from asexually reproducing the plant or selling or using the plant so reproduced.

### § 304. Assistance of Department of Agriculture

The President may by Executive order direct the Secretary of Agriculture (1) to furnish the Commissioner such available information of the Department of Agriculture, or (2) to conduct through the appropriate bureau or division of the department such research upon special problems, or (3) to detail to the Commissioner such officers

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and employees of the department, as the Commissioner may request for the purposes of carrying into effect the provision of this title relating to plants.

DESIGNS

**§ 311. Patents for designs**

Any person who has invented any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions and applications therefor, shall apply to patents for designs except as otherwise provided.

**§ 312. Right of priority**

The period for the right of priority provided for by section 118 of this title shall be six months in the case of designs.

**§ 313. Term of design patent**

Patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant may, in his application, elect.

**§ 314. Additional remedy for infringement of design patent**

During the term of a patent for a design, it shall be unlawful for any person other than the owner of said patent, without the license of such owner, to apply the design secured by such patent, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or to sell or expose for sale any article of manufacture to which such design or colorable imitation shall, without the license of the owner, have been applied. Any person violating the provisions, or either of them, of this section, shall be liable in the amount of $250; and in case the total profit made by him from the manufacture or sale, as aforesaid, of the article or articles to which the design, or colorable imitation thereof, has been applied, exceeds the sum of $250, he shall be further liable for the excess of such profit over and above the sum of $250. And the full amount of such liability may be recovered by the owner of the patent, to his own use, by civil action in any district court of the United States having jurisdiction of the parties.

Nothing in this section shall prevent, lessen, impeach, or avoid any other remedy which any owner of a patent, aggrieved by the infringement of the same, may have under the provisions of this title, but such owner shall not twice recover the profit made from the infringement.

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SEC. 2. Section 21 of the Act approved July 5, 1946, 60 Stat. 435, (United States Code, title 15, sec. 1071, 1946 ed.) is amended by changing "Revised Statutes 4911" appearing in said section to read "35 United States Code, section 47"; by changing "section 4915, Revised Statutes" appearing in said section to read "35 United States Code, sections 51 and 52"; and by changing "Revised Statutes 4915" appearing twice in said section to read "35 United States Code, section 52".

SEC. 3. If any provision of this title is declared unconstitutional or the application thereof to any person or circumstance held invalid, the validity of the remainder of this title or the application of such provision to other persons or circumstances shall not be affected.

SEC. 4. (a) This Act shall take effect on January 1, 1952 and shall apply to all applications for patent filed on or after such date and to all patents granted on such applications. It shall apply to further proceedings on applications pending on such date and to patents granted on such applications except as otherwise provided. It shall apply to unexpired patents granted prior to such date except as otherwise provided.

(b) Section 102 (d) of title 35, as enacted by section 1 hereof, shall not apply to existing patents, but the law previously in effect, namely the first paragraph of R. S. 4887 (U. S. Code, title 35, sec. 32, first paragraph, 1946 ed.), shall apply to such patents.

(c) Section 118, second paragraph of Title 35 as enacted by section 1 hereof shall not apply to existing patents.

(d) The period of one year specified in section 102 of title 35 as enacted by section 1 hereof shall not apply in the case of applications filed before August 5, 1940, and patents granted on such applications, and with respect to such applications, and patents, said period is two years instead of one year.

(e) No variety of plant which has been introduced to the public prior to May 23, 1930, shall be subject to patent.

(f) Nothing contained in this title shall operate to nullify any judicial finding on the validity of any patent by a court of competent jurisdiction.

(g) Nothing in this title shall affect any provision of the Atomic Energy Act of 1946 (Aug. 1, 1946, ch. 724, 60 Stat. 755).

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SEC. 5. The sections or parts thereof of the Revised Statutes or Statutes at Large enumerated in the following schedule are hereby repealed. Any rights or liabilities now existing under such sections or parts thereof shall not be affected by this repeal.

| Revised Statutes | U. S. Code, 1946 edition | |
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| | Title | Section |
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| 1888—Feb. 18 | 15 | | 25 | 40 | 35 | 39. |
| 1891—Mar. 3 | 541 | 1 part [2] | 26 | 939 | 35 | 14. |
| 1896—May 19 | 304 | | 29 | 124 | 35 | 78. |
| 1897—Mar. 3 | 391 | 1 | 29 | 692 | 35 | 31. |
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| | | 3 | | 693 | 35 | 32. |
| | | 4 | | 693 | 35 | 37. |
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| | | 6 | | 694 | 35 | 70. |
| | | 7 | | 694 | 35 | 43. |
| 1898—June 10 | 423 | 1 | 30 | 440 | 35 | 6 note. |
| 1899—Feb. 28 | 227 | | 30 | 915 | 35 | 46. |
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| 1950—Mar. 4 | 50 | Public Law 452, 81st Cong. | | | 35 | 7. |
| June 15 | 219 | Public Law 519, 81st Cong. | | | 35 | 78. |

[1] The part relating to the granting of patents to Government employees without fees.
[2] The part relating to certified copies of drawings and specifications.
[3] The part relating to fees for recording assignments.
[4] The part amending R. S. 4904.
[5] The part relating to the price of copies of patents.
[6] The part relating to payment of fees.
[7] The part relating to the fee for copies of specifications and drawings of patents.
[8] The first part of the section, excluding the matter following the word "*Provided*."

LEGISLATIVE INTENT SERVICE (800) 666-1917

LEGISLATIVE INTENT SERVICE (800) 666-1917

81ST CONGRESS
2D SESSION

# H. R. 9133

## A BILL

To revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents".

By Mr. BRYSON

JULY 17, 1950

Referred to the Committee on the Judiciary

X re HR 9133

United States
*of* America

# Congressional Record

PROCEEDINGS AND DEBATES OF THE 81st CONGRESS, SECOND SESSION

# *Index*

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LEGISLATIVE INTENT SERVICE (800) 666-1917

UNITED STATES GOVERNMENT PRINTING OFFICE, WASHINGTON, 1950

# HISTORY OF BILLS AND RESOLUTIONS

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LEGISLATIVE INTENT SERVICE (800) 666-1917

# Public Use in Private, or Vice Versa

By D. Journeaux *

Complaints have often been made of the slowness of the procedure that inventors must follow before they can obtain the patents which should rather, in their minds, be pressed upon them. Yet one of the purposes of the patent system of this country is to give to the public the benefit of disclosures of inventions at as early a date as possible. Indeed, the history of our patent laws seems to reveal a series of attempts to determine, by a method of successive approximations, just how soon prospective patentees can be required to file their applications after completing their inventions.

## One year public use

At present a valid patent on an invention cannot be obtained unless the application be filed within one year from the first public use or sale of the invention in the United States. Formerly the length of this period was two years. The thought back of this limitation of public use is that the public should not suddenly see itself deprived of an invention after having enjoyed the unrestricted use of it for a period of years. In this respect a patent assumes a certain similarity to real property; and it was held in a suit for infringement that, if an inventor allows the public at large to use his improvements for many years, "he must be deemed to have made a gift of them to the public, as much as a person who voluntarily opens his land as a highway, and suffers it to remain for a length of time devoted to public use."[1]

The law, at least since its revision in 1870, is perfectly clear as to this requirement. Yet its application has been found so full of difficulties that it has been disregarded by numerous patentees, who were often apparently quite unaware of being tardy.

* Patent Attorney, Allis-Chalmers Manufacturing Company, Reprinted from Allis-Chalmers Electrical Review, which kindly supplied the cuts for the illustrations.

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[1] Whittemore v. Cutter, 1 Gall. 482. Quoted in Shaw v. Cooper, 7 Pet. 292, 8 L.E. 689, 1833.



## What is public use?

Naturally, before different aspects of public use are examined, the question arises, just what does constitute a public use? As is often the case in patent law, a too general definition is dangerous in that it may be inapplicable to some unforeseen set of circumstances. With due caution it may be considered that an invention is in public use when it is used openly by the inventor for its intended purpose and also when it is used by any one beyond the control of the inventor. To apply this rule to any particular instance of use, it is, however, always necessary to bear in mind the explanatory statements made by the courts and the conclusions reached in cases involving similar states of facts.

## Experimental use

Taken literally, the public use statutes were always quite inflexible. It was not very long, however, before inventors, or more probably, their counsel, had the brilliant idea that, if a public use of an invention for more than two years (now one) before filing is a bar to the grant of a patent, there is no reason why some other kind of use could not take place at that time without having such an effect. The most frequent example of innocuous use is experimental use, which has served many times as an excuse for delay during the last six or seven decades. While in many instances a long use of an invention cannot reasonably be interpreted as being experimental, a well proven experimental use made in good faith has often been held by the courts not to be a public use. The authority for this policy is the Supreme Court, which stated that:

"It is sometimes said that an inventor acquires an undue advantage over the public by delaying to take out a patent, inasmuch as he thereby preserves the monopoly to himself for a

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longer period than is allowed by the policy of the law; but this cannot be said with justice when the delay is occasioned by a bona fide effort to bring his invention to perfection, or to ascertain whether it will answer the purpose intended. His monopoly only continues for the allotted period, in any event; and it is to the interest of the public, as well as himself, that the invention should be perfect and properly tested, before a patent is granted for it."[2]

## Profits from Experimental use

Litigants in patent suits have often made legal history out of the fact that experimental use and use for profit may be hard to distinguish, and a use in public may even serve both as an experiment and as a source of revenue. Naturally, if a patentee happened to put his invention to any use at all before the period allowed by law, an infringer will solemnly assert that the use was public and that it invalidates the patent, while the patentee will contend no less strenuously that the use was experimental and hence permissible. The Supreme Court, therefore, went one step further in an attempt to bring order out of this chaos, and stated that:

"A use by the inventor, for the purpose of testing the machine, in order by experiment to devise additional means for perfecting the success of its operation is admissible; and where, an incident to such use, the product of its operation is disposed of by sale, such profit from its use does not change its character; but where the use is mainly for the purpose of trade and profit, and the experiment is merely incidental to that, the principal and not the incident must give character to the use. The thing implied as excepted out of the prohibition of the statute is a use which may be properly characterized as substantially for purposes of experiment.[3]

## Experimental use must be proved

Although the grant of a patent is not accompanied by a guarantee of validity, it is a general rule that a patent is assumed to be valid until sufficient reason is shown in court why it should not have been granted. An infringer,

[2] Elizabeth v. Am. Nicholson Pavement Co., 97 U.S. 126, 24 L.E. 1000, 1878.

[3] Smith & Griggs Mfg. Co. v. Sprague, 123 U.S. 249, 31 L.E. 141, 1887.



who would establish that a patent is invalid because the invention claimed therein was in use before the permissible period, must furnish full and convincing proof of it. If he succeeds in doing so, what will the court do on the basis of his evidence? The answer was well formulated in a court decision stating that:

"Instead of laying down a fixed rule, it seems to us that in each case the court should direct its attention to the fundamental inquiry: Under what circumstances and for what purpose did the public use or sale take place? And, where it appears that there has been a public use or sale more than two years before the application, the burden is thrown upon the patentee to establish, by full, clear, and convincing proofs, that such use or sale was principally and primarily for experimental purposes, and that such purposes were not merely incidental or subsidiary. Whatever expressions may be found in the opinions of the Supreme Court to the effect that a single sale comes within the statutory prohibition, we think a careful examination of the cases shows that the primary and governing consideration is the purpose and object of the inventor in making such sale."[4]

The question whether an invention was in public use or in experimental use, while depending on the inventor's intentions, resolves itself into a question of fact. The inventor's intentions are, no doubt, often obscure or nebulous, and his testimony regarding them after a number of years is, at best, unreliable. Facts carrying out these intentions, however, can be proved by witnesses, and the inventor may then be credited with whatever intentions are consistent with his actions. If his acts and his professed intentions were not in accord, he deserves little sympathy and will probably receive none.

## Experimental use in public

If an inventor decided beforehand that the first use of his invention will be experimental, making his intentions clear to all persons involved in such use, and conducts the use as an experiment, that use may extend over a number of years without invalidating a patent subsequently applied for. Most cub patent attorneys cut their

[4] Swain v. Holyoke Machine Co., 109 F. 154, C.C.A. 1st, 1901.

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legalistic teeth on one instance of such use, which is famous for its extreme length and publicity as well as for the masterly explanation of the law that it occasioned.

The invention in question, shown in Fig. 1, consists of a pavement of wooden blocks with wide joints filled with a mixture of tar and gravel and laid on a waterproof foundation. Upon being sued, an infringer pleaded the patent was invalid because a 75-foot strip of the pavement had been used by the public for six years before the patentee filed his application. This strip was installed in 1848 by the patentee, at his own expense, on a toll road owned by a corporation of which he was treasurer. The

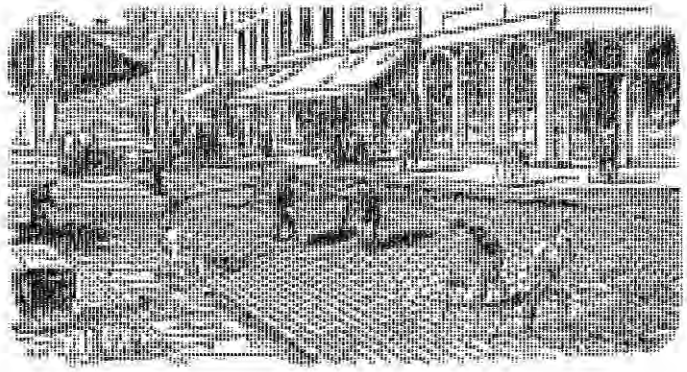


Fig. 1—S. Nicolson's wooden pavement, first used experimentally in 1848. The patent, which was applied for six years later, was nevertheless valid.

patentee made it clear, from the beginning, that it was experimental, and he inspected its condition himself almost daily.

In view of these circumstances, the Supreme Court in 1887 held that there was no public use of the invention and that the patent was valid. Thus was born the paradox of an invention being used by the public for years without being in "public use." But, as an experimental use on that scale was unprecedented, the Court based its decision on the established rules governing the public use of machines, of which it said:



"When the subject of invention is a machine, it may be tested and tried in a building, either with or without closed doors. In either case, such use is not a public use, within the meaning of the statute, so long as the inventor is engaged, in good faith, in testing its operation. He may see cause to alter it and improve it or not. His experiments will reveal the fact whether any and what alterations may be necessary. If durability is one of the qualities to be attained, a long period, perhaps years, may be necessary to enable the inventor to discover whether his purpose is accomplished."[5]

## Public use in private

Going from one extreme to the other, the same court, in 1881, declared another patent invalid in a decision which has set, for generations of patent attorneys, the standard of non-permissible use. This decision also gave us the second paradox of an invention being in "public use" merely because it was used privately by one person other than the inventor. The invention in litigation is

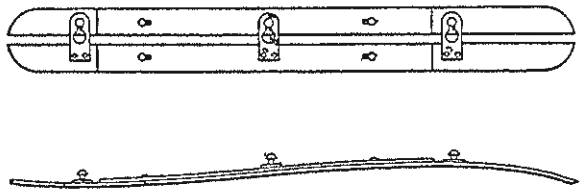


Fig. 2—S. H. Barnes' double leaf corset spring, invented in 1855 and first patented in 1866. The patent, reissued five times, was finally held invalid because of prior use of the invention by one person.

shown in its pristine simplicity in Fig. 2. It is a double leaf corset spring which, at the time of its invention in 1855, no doubt deserved considerable attention. It was devised to replace the disconcertingly breakable single leaf spring then currently in use and to give to the feminine body the softly resilient support now more generally provided for automobile bodies.

[5] Elizabeth v. Am. Nicholson Pavement Co., supra.

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The inventor made some springs and gave them to his future wife to be used by her, but without enjoining her to keep his idea secret. Apparently he did not have in mind that such use be made under his direction as a scientific experiment. In 1866, when the inventor applied for his patent, the springs had somehow, it is stated, gained general acceptance by the trade. But the patentee was too late to gather his reward. In the words of the Supreme Court, the inventor slept on his rights for eleven years. Like Rip van Winkle, he found on awakening that what once belonged to him had passed to others. His patent, to which he belatedly gave so much attention that he and his wife reissued it five times, was held invalid. The general principles of this holding were laid down as follows:

"To constitute the public use of a patent it is not necessary that more than one of the patented articles should be publicly used. . . . Whether the use of an invention is public or private does not necessarily depend upon the number of persons to whom its use is known. If an inventor, having made his device, gives or sells it to another, to be used by the donee or vendee, without limitation or restriction, or injunction of secrecy, and it is so used, such use is public, within the meaning of the statute, even though the use and knowledge of the use may be confined to one person."[6]

## Public use beyond knowledge of user

Use beyond the knowledge of the general public was also fatal to a claim of a patent on the safe construction shown in Fig. 3. The claim was directed to the tapered bolts used for fastening together the plates forming the casing and the door. The patentee made and sold outright a few of these safes more than two years before applying for the patent. The invention embodied in those safes was held in 1883 to be in public use for the reasons that:

"The construction and arrangement and purpose and mode of operation and use of the bolts in the safes were necessarily known to the workman who put them in. They were, it is true, hidden from view, after the safes were completed, and it required a destruction of the safe to bring them into view. But

[6] Egbert v. Lippmann, 104 U.S. 333, 26 L.E. 755, 1881.



this was no concealment of them or use of them in secret. They had no more concealment than was inseparable from any legitimate use of them. As to the use being experimental, it is not shown that any attempt was made to see if the plates of the safes could be stripped off, and thus to prove whether or not the conical bolts were efficient. The safes were sold, and apparently no experiment and no experimental use were thought to be necessary. The idea of a use for experiment was an afterthought. An invention of the kind might be in use, and no burglarious

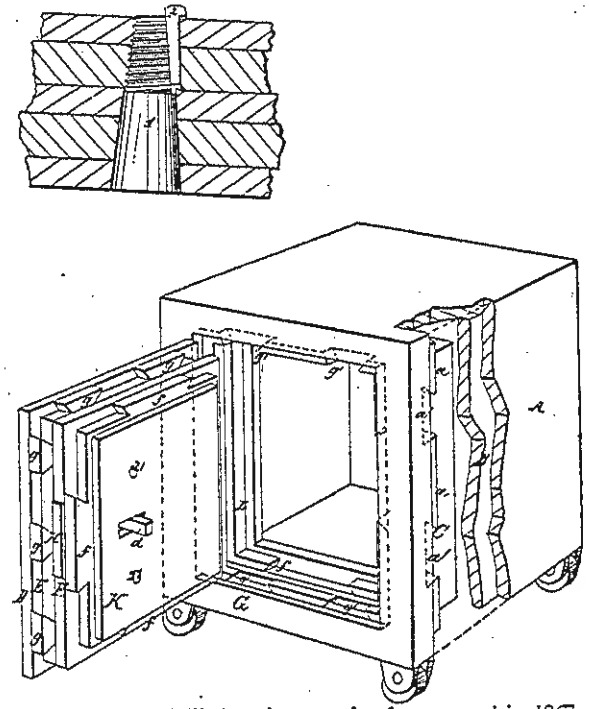


Fig. 3—J. L. Hall's burglar-proof safe patented in 1867. One claim of the patent was invalidated by prior use of the invention although the invention could not normally be detected.

attempt be ever made to enter the safe; and it might be said that the use of the invention was always experimental until the burglarious attempt should be made, and so the use would never be other than experimental. But it is apparent that there was no experimental use in this case, either intended or actual."[7]

## Public use of process

The litigation involving the so-called driven well patent distinguished from the above cases in that the patent

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was for a process and in that the patentee had no participation in the public use which defeated the patent. The latter claimed the method of making a well by driving the well casing into the ground or by first driving a mandrel which is then replaced by the casing. This method had considerable merit, and it is still standard practice for procuring drinking water in rural communities. Both mandrel and casing, shown in Fig. 4, may have been new when the inventor provided them with his process in 1861, but he did not claim them as his invention.

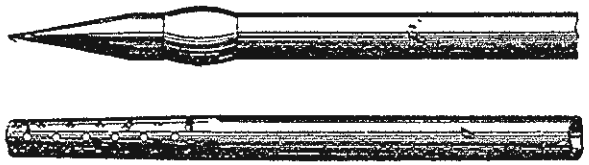


Fig. 4—N. W. Green's driven well invented in 1861, patented in 1868. The patent was held invalid because of prior public use of the invention based on information given by the inventor.

Soon after inveuting his method he demonstrated it in public, and within the next few years wells were driven by some who either had witnessed his demonstration or heard of it. Unfortunately, the patentee delayed applying for his patent until 1866, and in 1887 the patent was held invalid because the driving of the wells constituted a public use of the invention outside of the permissible period. The fact that the invention would not be readily apparent upon inspection of the finished wells was immaterial since it had been used by the makers of the wells, who were members of the public.

[7] Hall v. Macneale, 107 U.S. 90, 27 L.E. 367, 1883.



## Public use of material

Likewise a material used in the manufacture of articles of commerce is in public use even if its processing has rendered its composition unrecognizable. Thus, in 1928, an infringer of a patent for a rubber composition comprising a particular type of vulcanization accelerator pleaded that an accelerator of that type had been used in the manufacture of rubber tires more than two years before the patent was applied for in 1914. The accelerator was destroyed by the vulcanization process before the tires were sold to the public, and there was no way of learning from the finished tires either their composition or the process by which they had been made. Could such use of the material be public? The court answered:

"This was the only kind of use possible and it was public. . . . Once the invention has been embodied in goods which are put in public use it becomes impossible for a later inventor to secure a patent."[8]

## Experimental use disproved

Another invention which had an element of inaccessibility was the cable railway track illustrated in Fig. 5. The inventor designed this arrangement in 1876 for a short line which began operating in 1878, more than two years before he applied for a patent. When suing an infringer in 1892, the inventor argued that this installation was experimental because its construction was still untried; and, therefore, he had doubts as to its permanency. But the circumstances of this use were not similar to those of the pavement case previously considered. The court therefore disagreed with the inventor, stating that:

"He did not treat it as an experimental thing, but allowed it to be appropriated as a complete and perfect invention, fit to be used practically, and just as it was, until it should wear out or until it should demonstrate its own unsuitableness. He turned it over to the owners without reserving any future control

[8] Grasselli Chemical Co. v. National Aniline & Chemical Co., 26 F. (2d) 305, C.C.A. 2d. 1928.

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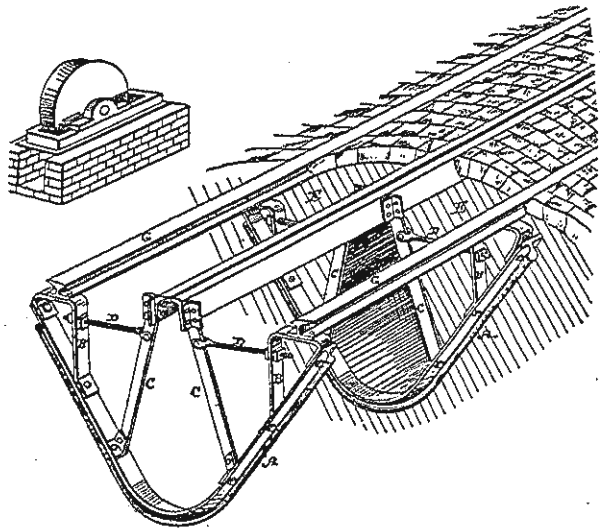


Fig. 5—H. Root's cable railway foundation, invented in 1876, patented in 1882. The patent was held invalid because prior use of the invention could not be proved to be experimental.

over it, and knowing that, except as a subordinate, he would not be permitted to make any changes in it by way of experiment."[9]

## No experimental use after unrestricted sale

Equally unsuccessful was the assignee of a patent for the engine shown in Fig. 6. This engine, operated by hot air, was similar to some toy engines still sold today, but of a species apparently otherwise extinct. It embodied a water pump discharging through the water jacket of the engine cylinder. Several engines were sold outright and installed in Manhattan by the patentee's assignee for pumping water into the attic tanks of residences, a job otherwise incumbent upon the house coachman. At least one engine installed in 1877 was frequently inspected and repaired, sometimes without cost, by the manufacturer. The engine efficiency however was not guaranteed, and

[9] Root v. Third Avenue Railroad Co., 146 U.S. 210, 36 L.E. 946, 1892.



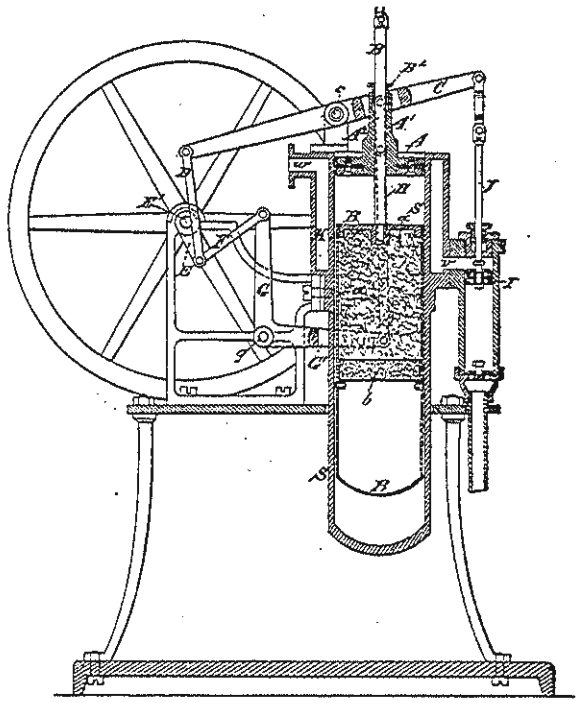


Fig. 6—J. Ericsson's hot air engine of 1877, patented in 1880. The patent was invalidated by prior use of the engine beyond the control of the inventor.

there was no agreement to take it back. After seven years' use it was traded in as part payment for a new engine of similar construction. In an infringement suit it was argued that such a set of circumstances was evidence of experimental use. But the court held in 1893 that the engine had been in public use, stating that:

"If the inventor wishes to keep control of the machine which embodies his invention, to secure his own access to it for examination, and to keep it in the friendly hands of those who, he intends, shall aid him by practical experiment, he must make such restrictions a part of the contract of sale, and the court cannot assume them to exist in the absence of proof."[10]

[10] Delemater v. Heath, 58 F. 414, C.C.A. 2d, 1893.

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## Public use in experimental system

The carbon brush, which has assumed considerable importance in the manufacture of electric motors, is also notable for the peculiar circumstances which led to invalidation of the basic patent granted for it. Fig. 7 shows one of the constructions illustrated in the patent. In 1881 the inventor tried replacing the then current copper brushes by carbon pieces. Later he devised an overhead conveying system utilizing a car running on a cable and

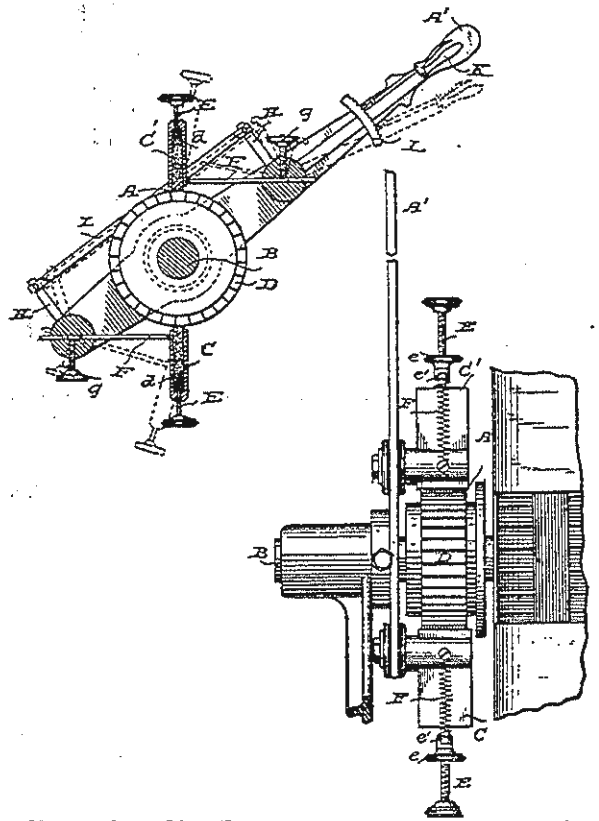


Fig. 7—C. J. Van Depoele's carbon brush for electric motors, invented in 1881, patented in 1888. The patent was held invalid because of prior public use by the inventor in an experiment other than to test the brushes.



propelled by an electric motor. An experimental model of this novel system, driven by a motor provided with carbon brushes, was built in 1885 for the sole purpose of demonstrating its operativeness. The inventor did not need to experiment with the carbon brushes, as he had already found them satisfactory years before. The motor simply did its duty as a motor, and there was nothing experimental about it. Were then the brushes in public use? The court denying the validity of the patent in 1901 found that:

> "There is no dispute on the proof as to what this use was. As to a system for overhead electrical transportation it was experimental, but as a use of carbon brushes in combination with a segmental commutator on an electric motor it was a substantial public use . . . it was a practical use of the invention, since the motor was used occasionally to propel the car in connection with the experiments on the cable system, which the apparatus was intended to embody."[11]

Such was the history of the third paradox of an invention being in public use in an experimental system.

## Experimental use should be planned

The passages above quoted were taken from only a few of a long line of decisions which seem to be relatively free of the apparent or real contradictions often found between court decisions based on different sets of circumstances. It may be deduced from them that an invention will not be held to be in public use if it really requires experimentation at the time of its being used and if the inventor makes it clear that such is his purpose in using it.

With a view to possible future patenting of the invention, it is, therefore, advisable to make it of record that an experimental use is intended even before such use is begun. Any agreements that may be necessary should be reached beforehand with the users of the invention to insure that it remains under the full control of the in-

[11] Thomson-Houston Electric Co. v. Lorain Steel Co., 110 F. 654, C.C. S.D. N.Y., 1901.

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ventor or of his assignee for experimental purposes. Last but not least, the use should be actually conducted as an experiment, and records made of observations from which the desirability of changes or the suitability of the structure under test will be apparent.

Prompt filing advisable during experimental use

It is seldom, however, that an experimental use of a complete invention needs to last as long as one year to determine whether the invention will perform satisfactorily. In general it will be possible to file a patent application on the fully tested invention within one year from the beginning of experimental use. If it is desired to subject the invention to a life test under actual operating conditions or even under abnormally adverse conditions, the experiment may extend over a period of years.

Although application for a patent may still be delayed until the test is completed, nevertheless the inventor may save himself a considerable amount of trouble in establishing or asserting his patent rights by filing his application within one year from the beginning of the experiment. Of course, any protection that he may seek by a patent will be limited to whatever features of his invention were in his mind at the time of filing his application. But if continuance of the test suggests to him some valuable improvements, he may still protect them by other patent applications.



## Infringement of a Markush Claim.

A subscriber to the JOURNAL raises several interesting questions in a communication on the Markush type of claim. The following are among a number of timely comments.

"I am wondering how the Courts would decide a question dealing squarely with the scope of such a claim particularly if the alleged infringement were made through a conceded chemical equivalent not recited in the Markush group. . . . . So many of these claims are now being allowed in the chemical field, that I believe we can anticipate some interesting litigation in the future with respect to this and many other questions of interpretation."

"Based on logic and without any reference to decisions, it seems as though the patentee of a Markush claim should be entitled to a fair range of equivalents. Concededly, if he had claimed only one material, instead of two or more as set out in his claim, he would have been entitled to a range of equivalents commensurate with his invention. Therefore why penalize him for pointing out more specifically and fully, as the statute requires, other materials which can be used. . . . . In other words since each enumerated member of the group would presumably be able to support a separate patent, should not each member be treated individually, and each one (be) allowed its own appropriate range of equivalents?"

"Viewed as a generic claim, which by definition it is, should we restrict the patentee to the precise members named?"

Since this involves a subject for which the Patent Office has a large share of responsibility (because it unlocked the Pandora's box by sponsoring this type of claim) it provides an appropriate subject for discussion. Fortunately for the Office it will not have to construe the patents. This article reviews the theory and practice under which Markush claims are granted and traces a little of their history, in the belief that such presentation will be helpful to those who seek to avoid litigation by keeping out of the forbidden fields of granted patents, or to those who may be required to defend their position if they have inadvertently wandered into a field which a Markush patentee regards as "posted."

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J. H. MERCHANT, *Editor-in-Chief*
R. LEIBOWITZ, *Assistant Editor*
ARTHUR M. HORTON, *Business Manager*
ARTHUR L. LAPOINT, C. E. O'CONNELL, G. O. RALSTON,
*Assistant Business Managers*
104 Academy Ave., Federalsburg, Maryland, or
Box 685, Washington 4, D. C.

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## Preface

This issue of the Journal is devoted to printing the complete text of the new patent law and additional material relating to this law. "An act to revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled 'Patents'," was approved July 19, 1952, to take effect on January 1, 1953. The complete citation of the Act is Public Law 593, 82nd Congress, 2nd Session, Chap. 950, 66 Stat. 792, approved July 19, 1952, and it may be referred to as the Patent Act of 1952.

The Act contains five sections. Section 1 of the Act (it should be noted that when an act has more than one section, "Sec. 2" etc. appear at the beginning of each section after the first, but no number is placed at the beginning of the first section) enacts the patent law as Title 35, Patents, of the United States Code, the beginning of the Act reading as follows:

> Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That title 35 of the United States Code, entitled "Patents," is revised, codified, and enacted into law, and may be cited "Title 35, United States Code, section ——," as follows:

Then follows the text of Title 35 containing ninety-five sections numbered from section 1 to section 293 with gaps in the numbering between the various chapters of the title. As stated in the opening clause of Section 1 of the Act, the various sections of the patent code may be cited as "Title 35, United States Code, Section ——." A short citation would be "35 U. S. C. ——." Inasmuch as there was a prior Title 35 (which, however, was not an enactment but only an editorial compilation), it may be well to add the year 1952 to the citations of the new code so that the citation of Section 102, for example, could read "Title 35 (1952), United States Code, Section 102" or "35 U. S. C. (1952) 102." References to the old Title 35 are distinguished by adding "1946 ed." to the citations.

In this issue of the Journal, the text of new Title 35 is printed in full. Following each section of the code is reprinted a portion of the report of the Congressional committee dealing with that particular section, and following this is reprinted the text of the prior statute dealing with the same subject. With this arrangement there is presented in one place, by sections, the section of the new law, the corresponding section of the old law, and comments made by the Congressional committee in its report.

Following this text of the new patent code is given the text of the additional sections of the Patent Act of 1952 with some notes added.

Following the Act there is given the text of other statutes relating to patents, which are not incorporated in Title 35.

The last item in the present compilation is a table of patent statutes from 1874 to 1952, which can be used to locate the section number of the new code corresponding to any particular section of the old statutes.

The legislative history of the Patent Act of 1952, insofar as official documents are concerned, lies in the following papers:

1. 81st Congress. Proposed Revision and Amendment of the Patent Laws. Preliminary Draft with Notes. January 10, 1950. 98 pages.

2. 81st Congress. H.R. 9133, a bill introduced July 17, 1950 by Representative Bryson of South Carolina. 32 pages.

3. 82nd Congress. H.R. 3760, a bill introduced April 18, 1951 by Representative Bryson of South Carolina. 30 pages.

4. 82nd Congress. "Patent Law Codification and Revision," hearings before subcommittee No. 3 of the Committee on the Judiciary, House of Representatives, 82nd Cong., 1st Sess., on H.R. 3760, June 13, 14 and 15, 1951. Serial No. 9. 230 pages.

5. 82nd Congress H.R. 7794, a bill introduced May 12, 1952, by Representative Bryson of South Carolina. 35 pages.



This is the bill that was enacted; there are three printings of the bill, first, as it was introduced and reported in the House, second, as it was passed by the House without change, and third, as it was reported in the Senate with a number of amendments. The amendments made in the Senate are noted under the appropriate sections.

6. 82nd Congress. House Report No. 1923, May 12, 1952—to accompany H. R. 7794. 72 pages.

7. 82nd Congress. Senate Report No. 1979, June 27, 1952—to accompany H. R. 7794. 72 pages.

House Report No. 1923 is the report by the Committee on the Judiciary of the House of Representatives to the House of Representatives, in which the bill reported is explained. This report is a document of 72 pages. The first part of the report, pages 1-10, consists of a preliminary statement giving some information concerning the bill and its development, and also giving a general description of the bill and its contents. This part of the report is reproduced in full as the first item following this preface.

The next part of the report, pages 11-31, consists of what are called "Revision Notes." These notes are arranged by sections and give the citation of the old law from which the particular section is derived and some information concerning the changes which have been introduced by the new section. These revision notes are here reprinted in full following each section of the new patent code.

The next part of the report, pages 33-67, gives the complete text of all the repealed statutes and where their counterpart may be found in the new code. The report concludes with four tables of statutes, the first and second showing where the subject matter of prior statutes and of the old Title 35 may be found in the new code. The third table lists the laws omitted and repealed, with a brief statement of the reason for the omission and repeal. The substance of these tables is incorporated in the table of patent statutes given at the end of the present compi-

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lation. The last table lists the laws omitted from the code but not repealed; these are mainly laws of a temporary nature and their text is reprinted in this issue of the Journal.

Senate Report No. 1979 is the report by the Committee on the Judiciary of the Senate to the Senate. This report is substantially the same as the House report and it is not necessary to reproduce it. The few differences in the Senate report over the House report are noted in the following text.



# Report of the Committee on the Judiciary

## REVISION OF TITLE 35, UNITED STATES CODE

MAY 12, 1952.—Committed to the Committee of the Whole House on the State of the Union and ordered to be printed

MR. BRYSON, from the Committee on the Judiciary, submitted the following

### REPORT

[To accompany H. R. 7794]

The Committee on the Judiciary submits the following report in explanation of the bill (H. R. 7794) to revise, codify, and enact into law title 35 of the United States Code entitled "Patents," and recommends that the bill do pass. The present bill has been substituted for an earlier bill (H. R. 3760), on which hearings were held, and contains changes recommended by the subcommittee.[1]

### INTRODUCTION

As its title indicates, the purpose of the bill is to revise and codify the laws relating to patents and enact into law title 35 of the United States Code entitled "Patents."[2]

[1] This paragraph does not appear in the Senate Report, which opens with the following:

"The Committee on the Judiciary, to which was referred the bill (H. R. 7794) to revise, codify, and enact into law title 35 of the United States Code entitled "Patents," having considered the same, reports favorably thereon, with amendments, and recommends that the bill, as amended, do pass.

### AMENDMENTS

"Amendment No. 1: On page 9, line 3 of subdivision (d), section 102, strike the word "or" and insert in lieu thereof the word "on."

"Amendment No. 2: On page 29, subdivision (1) of section 282, strike out the word "or" and insert in lieu thereof a comma.

"Amendment No. 3: On page 29, subdivision (1) of section 282, strike out the comma after the word "infringement" and insert in lieu thereof "or unenforceability,".

"Amendment No. 4: On page 29, first line of section 284, strike out "Upon adjudging a patent valid and infringed" and insert in lieu thereof the following: "Upon finding for the claimant"."

[2] This paragraph varies slightly in language in the Senate Report and is then followed by a sentence referring to the Hearings held in the House.

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This bill is part of the comprehensive program of revising and enacting into law all the titles of the United States Code. Up to the present time nine out of the 50 titles of the code have been revised and enacted into law and consideration or preparation of bills relating to a number of additional titles is in process.

For many years there had been considerable agitation for a complete restatement and codification of all the laws of the United States, inasmuch as the only such codification—the Revised Statutes of 1874—had become generally outmoded on all subjects.

In 1926, in response to widespread recognition of the need therefor, and after nearly 7 years' effort on the part of the Committee on the Revision of the Laws, the Congress adopted the United States Code, which was a codification of the existing general and permanent laws of the United States arranged in 50 titles according to subject matter, and which was declared to be prima facie evidence of the law.

Because of the size of that code Congress decided that it should undergo a testing period before it was enacted into positive law.

The code has now been subjected to such a testing period lasting more than 25 years, and the committee's program of enacting the titles into law has been in progress for several years.[3]

### PRIOR REVISION OF PATENT LAWS

The present patent laws consist of about 60 sections of the Revised Statutes of 1874, together with a large number of acts of Congress passed since that date revising various sections of the Revised Statutes or making new enactments not related to any section of the Revised Statutes.

Since the sections of the Revised Statutes relating to patents were merely a compilation of the act of July 8, 1870, 16 Stat. 198, our present patent law is essentially the act of 1870 with subsequent amendatory and supplemental enactments.

The last general revision of the patent laws was the act of July 8, 1870, which was enacted as part of a program to revise and consolidate all the laws of the United States then under way. In 1866 Congress passed a law providing for a commission to revise and consolidate the statutes of the United States. The Commission which was appointed to perform this work prepared a preliminary draft of the part relating to patents and copyrights in 1868, and a second preliminary draft in 1869. The following year a draft of the statutes relating to patents and

[3] This paragraph varies in the Senate Report.



copyrights as revised, simplified, arranged, and consolidated by the Commission was reported to Congress, and at the same time referred to the Committee on Patents; a bill was introduced by the chairman a few days later.

The object of the Commission on revision of the laws was only to revise, arrange, and consolidate the statutes in force and the draft reported from the Commission presumably was for this purpose only.

The probable reason for referring the matter to the Committee on Patents was that during this same period there had been suggestions for amending the patent laws in substance and it appears that the Committee on Patents studied the draft of the Commission and changed it by various amendments affecting matters of substance. The bill thus introduced was enacted on July 8, 1870, 16 Stat. 198, and included the subjects of copyrights and trade-marks as well as patents.

When the Revised Statutes, as in force on December 1, 1873, were enacted on June 22, 1874, the sections of the act of 1870 were distributed in various parts of the Revised Statutes.

### HISTORY OF PRESENT BILL[4]

By a fortunate distribution of committee functions, the Committee on the Judiciary, and the same subcommittee of this committee, is charged both with the revision of the laws and with the consideration of bills relating to patents.

About three years ago it was suggested that, since the same subcommittee of the Committee on the Judiciary has jurisdiction over both the revision of the laws and the subject of patents, we should undertake the preparation of a bill to revise these laws.

The work was initiated by the preparation of a preliminary draft of a "Proposed Revision and Amendment of the Patent Laws," which was printed and distributed in February 1950.

The preliminary draft, in addition to simple codification, included a collection of a large number of proposed changes in the law which had come to the attention of the Congress during the past quarter-century, in the form of bills or otherwise. The preliminary draft was widely distributed with a request for criticisms and suggestions. As a result of the comments received, it was decided not to include most of the proposed changes in a bill but to defer them for later consideration, and to limit the bill to the main purpose of codification and enactment of title 35 into law, with only some minor procedural and other changes deemed substantially noncontroversial and desirable.

[4] The paragraphs under this heading are omitted in the Senate Report.

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Numerous suggestions had been received from the Patent Bar and the public. After consideration of the suggestions and criticisms and other comments which had been received, a bill (H. R. 9133) was prepared and introduced in the Eighty-first Congress on July 17, 1950. This bill was also widely distributed and again comments were received from the Patent Bar and others. As a result, the bill was reintroduced in revised form in the Eighty-second Congress as H. R. 3760.

Hearings were held on H. R. 3760 and as a result of the hearings and material received by the committee the bill was revised and introduced as the present bill.

In the preparation of the various drafts leading to the present bill, all acts of Congress relating to or mentioning patents which have been enacted since 1874 were collected and studied, and those acts which had not been specifically repealed were used in preparing the drafts.

The changes introduced in the bill were obtained mainly from a study of all the bills relating to patents which had been introduced in Congress since 1925, the reports of various committees making studies of the patent laws, reports and recommendations of private groups and individuals, and other miscellaneous sources.

The actual work of preparing the preliminary drafts and the bill was directed and supervised by the committee's law revision counsel, Charles J. Zinn, and its counsel having jurisdiction over patent matters, L. James Harris.

For a number of years the committee has pursued a policy of calling on official and unofficial experts in the subject-matter of the proposed revision to assist it, and it has been most fortunate in receiving the able and helpful assistance of various persons such as Mr. P. J. Federico of the Patent Office, Capt. George N. Robillard, United States Navy, patent counsel of the Department of Defense, Mr. T. Hayward Brown of the Department of Justice, and many others. The Coordinating Committee of the Patent Bar, which was organized under the auspices of the National Council of Patent Law Associations and included representatives of industry as well, has rendered invaluable service to the committee in the preparation and refinement of the bill. Messrs. Henry R. Ashton, Giles S. Rich and Paul A. Rose, particularly, devoted themselves to this work.

## EARLY PATENT LAWS

As has already been stated, the present patent laws consist of the Patent Act of 1870 with subsequent enactments adding to or changing various sections of that original act. The first patent law was enacted in the second session of the First Congress in

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1790. When the first Congress met, one of its very first items of business was the consideration of patents and copyrights, and the first patent bill was H. R. No. 10 of the First Congress.

The patent laws are enacted by Congress in accordance with the power granted by article I, section 8, of the Constitution which provides that:

> The Congress shall have the power . . . to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

This provision was unanimously adopted by the Constitutional Convention following suggestions for Federal jurisdiction over both patents and copyrights which had been made in the Convention by James Madison of Virginia and Charles Pinckney of South Carolina. Each proposed separate provisions relating to patents and to copyrights which were merged by the Drafting Committee of the Convention into the general statement we now have, which was adopted without any dissenting voice.

The background, the balanced construction, and the usage current then and later, indicate that the constitutional provision is really two provisions merged into one. The purpose of the first provision is to promote the progress of science by securing for limited times to authors the exclusive right to their writings, the word "science" in this connection having the meaning of knowledge in general, which is one of its meanings today. The other provision is that Congress has the power to promote the progress of useful arts by securing for limited times to inventors the exclusive right to their discoveries. The first patent law and all patent laws up to a much later period were entitled "Acts to promote the progress of useful arts."

The first patent law, which was enacted on April 10, 1790, vested the jurisdiction to issue patents in a Board consisting of the Secretary of State, the Attorney General, and the Secretary of War. The person principally interested and the leader of the group was the Secretary of State, Thomas Jefferson, who was personally deeply interested in the subject matter of patent law. Jefferson was not a patentee himself, but he was the inventor of a number of devices, most of them being "gadgets."

This first law made the power of the Board to issue patents absolute, and also provided for various things that would be necessary in a general patent law.

While the Board, and particularly Thomas Jefferson, was quite favorable to the granting of patents, and granted them with great consideration, the other duties of members of this Board, in view of their high offices, made it impossible for them

to devote much time to this work, and as a result the law was changed in 1793 to make the granting of patents a clerical function. Under the act of 1793 patents were granted to anyone who applied on fulfilling the formal requirements and filing the necessary papers and fees.

This law continued in force until 1836 when the dissatisfaction with the granting of patents without any examination as to novelty or other matters led to the appointment of a select committee by the Senate which introduced a bill that became the new law which was enacted on July 4, 1836. This new law contains the fundamental principles of our present patent law. It created a Patent Office with a Commissioner of Patents at the head, and examiners with the function of examining applications for patents and with the power to refuse patents, which was not present in the previous law. The law had many other provisions in it relating to details of procedure, enforcement of patents, and matters of that sort.

Amendments were made to this act of 1836 at various times until 1870 when the law was completely revised in the manner above referred to.

The present bill in a sense, then, is the second revision and codification of the patent laws by a committee on the Revision of the Laws and a committee in charge of patents.[5]

### GENERAL DESCRIPTION OF BILL

Although the principal purpose of the bill is the codification of title 35, United States Code and involves simplification and clarification of language and arrangement, and elimination of obsolete and redundant provisions there are a number of changes in substantive statutory law. These will be explained in some detail in the revision notes keyed to each section which appear in the appendix of this report. The major changes or innovations in the title consist of incorporating a requirement for invention in § 103 and the judicial doctrine of contributory infringement in § 271.

The bill divides the statutes into three parts. The first part contains the sections of the law relating to the Patent Office generally, its powers and duties and some ancilliary matters of that kind. The second part consists of the sections relating to the conditions under which a patent may be obtained and the procedure in obtaining patents. The third part contains the sections relating to the patents themselves and the protection of rights under patents, and matters relating to that phase of the subject.

[5] This paragraph varies in the Senate Report.



Stated generally, these three parts relate to, first, the Patent Office, second, obtaining a patent, and third, the patent itself. Of course it has not been possible to maintain this three-part division strictly and there may be some overlapping of the three phases of the subject. In each part the sections are arranged in several chapters of more or less homogeneous subject matter, with chapter headings.

The organization of the bill and the arrangement of the sections are such that new future amendments can readily find their place in the organization. Catchlines of parts, chapters and sections are provided for convenience of reference.

The first chapter in part I relates to the Patent Office and covers the establishment of the Patent Office, its seal, officers and employees, restrictions on officers and employees as to interest in patents, bond of the Commissioner, duties of the Commissioner, the Board of Appeals, the Patent Office library, etc. Very little change is introduced in these sections. There is one change in section 3, relating to a temporary successor to the Commissioner when the office is vacant, filling a gap in the present law. There is a change in section 4 relating to the disability of Patent Office employees to obtain patents.

The next chapter collects some of the details relating to procedure in the Patent Office of general application with no important changes.

The next group, sections 31, 32 and 33 relate to practice before the Patent Office. In them the language of the prior statutes has been rearranged and divided into several sections. There has been no change in substance in these sections, except in the third of this group which is a criminal provision for unauthorized practice. The language has been considerably simplified, and the maximum fine has been raised from $100 to $1,000.

In the next group of sections, relating to Patent Office fees, there have been a few readjustments in some minor fees, and an upward change in the fee for an appeal to the Board of Appeals.

The sections of the first part apply to the Patent Office as such, and, except for provisions specific to patents, include trade-marks as well as patents, where they relate to organizational and procedural matters, since the registration of trade-marks is handled by the Patent Office.

Part II relates to patentability of inventions and the grant of patents.

Referring first to section 101, this section specifies the type of material which can be the subject matter of a patent. The present law states that any person who has invented or dis-

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covered any "new and useful art, machine, manufacture, or composition of matter, or any new or useful improvement thereof" may obtain a patent. That language has been preserved except that the word "art" which appears in the present statute has been changed to the word "process." "Art" in this place in the present statute has a different meaning than the words "useful art" in the Constitution, and a different meaning than the use of the word "art" in other places in the statutes, and it is interpreted by the courts to be practically synonymous with process or method. The word "process" has been used to avoid the necessity of explanation that the word "art" as used in this place means "process or method," and that it does not mean the same thing as the word "art" in other places.

The definition of "process" has been added in section 100 to make it clear that "process or method" is meant, and also to clarify the present law as to the patentability of certain types of processes or methods as to which some insubstantial doubts have been expressed.

Section 101 sets forth the subject matter that can be patented, "subject to the conditions and requirements of this title." The conditions under which a patent may be obtained follow, and section 102 covers the conditions relating to novelty.

A person may have "invented" a machine or a manufacture, which may include anything under the sun that is made by man, but it is not necessarily patentable under section 101 unless the conditions of the title are fulfilled.

Section 102 in paragraphs (a), (b), and (c) repeats the conditions in the existing law relating to novelty.

Subsection (a) is the language of the existing law, recognizing that the interpretation by the courts excludes various kinds of private knowledge not known to the public.

Paragraph (d) relating to a bar to patentability when the inventor has previously obtained a patent in a foreign country, represents a liberalizing change in the existing law.

Subsection (e) is another well-recognized condition imposed by a decision of the Supreme Court which was not expressed in the existing law; for the purpose of anticipating subsequent inventors, a patent disclosing the subject matter speaks from the filing date of the application disclosing the subject matter.

Subsection (f) merely emphasizes that it is the inventor that applies for the patent.

Subsection (g) relates to the question of priority of invention between rival inventors.

Section 102, in general may be said to describe the statutory novelty required for patentability, and includes, in effect, an amplification and definition of "new" in section 101.

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Section 103, for the first time in our statute, provides a condition which exists in the law and has existed for more than 100 years, but only by reason of decisions of the court. An invention which has been made, and which is new in the sense that the same thing has not been made before, may still not be patentable if the difference between the new thing and what was known before is not considered sufficiently great to warrant a patent. That has been expressed in a large variety of ways in decisions of the courts and in writing. Section 103 states this requirement in the title. It refers to the difference between the subject matter sought to be patented and the prior art, meaning what was known before as described in section 102. If this difference is such that the subject matter as a whole would have been obvious at the time to a person skilled in the art, then the subject matter cannot be patented.

That provision paraphrases language which has often been used in decisions of the courts, and the section is added to the statute for uniformity and definiteness. This section should have a stabilizing effect and minimize great departures which have appeared in some cases.

The next group of sections relates to the application for a patent.

Sections 116 and 118 introduce a new element in our statutes. The existing statute is very strict in requiring that only the inventor may apply for a patent. These two sections provide for certain types of situations where it may be impossible for the inventor himself to apply, or where, in the case of a joint invention, one of the joint applicants has been inadvertently erroneously included or a joint inventor inadvertently excluded; the sections provide all the safeguards necessary for the inventor.

Section 119 introduces a minor change.

Sections 120 and 121 express in the statute certain matters which exist in the law today but which had not before been written into the statute, and in so doing make some minor changes in the concepts involved.

Section 122 incorporates into the title the rule of secrecy of patent applications which has existed in the Patent Office for generations.

The next chapter relates to the examination of the application in the Patent Office; rejection by the examiner, the right to reconsideration, the time within which an applicant must reply to actions, time for prosecuting application, appeal to the Board, and interferences between rival claimants for a patent. Very little has been changed in this group of sections except a minor revision in the interference section.

The next chapter relates to the review of Patent Office decisions.

The act of 1836 provided, for the first time, for the refusal of patents by officials known as examiners. The legislature was jealous of the rights of the public and provided adequate means of reviewing the action of the Patent Office. In fact, there are now two types of review. The applicant may appeal to a court of appeals especially provided, or he may file suit in the district court against the Commissioner to have his rights adjudicated by the court.

This group of sections makes no fundamental change in the various appeals and other review of Patent Office action, but has made a few changes in the procedure in various instances to correct some of the problems which have arisen, particularly in section 146. These details are mainly procedural.

The next chapter[6] collects the provisions relating to plant patents, the next those relating to designs, and chapter 17 restates the recently enacted statute relating to secrecy of certain inventions.

Part III deals with the patent itself after it has been granted.

The first chapter of this part relates to correcting and amending a patent.

Sections 251 and 252 are a development of the present statute relating to what are called reissues. Under certain circumstances the patentee may obtain a new patent to replace the old one to correct certain kinds of defects that he may have discovered in the patent. These two sections together replace the present one, make a number of clarifications and a few additions in further development of the subject.

Section 253 relates to another form of correction of a patent known as the disclaimer. The patentee files a paper in the Office which is recorded. He disclaims certain things from the scope of his patent or disclaims certain claims. This subject of disclaimers, in the present law, has resulted in a great deal of confusion and uncertainty in certain situations in the law which at times are almost ridiculous. Consequently, the bill in two sections, 253 and 288, has introduced certain changes relating to disclaimers. One of these changes is that only a whole claim can be disclaimed; a patent can not be rewritten by filing a paper in the Patent Office.

The second change relates to the situation when a patent has two or more claims and one of them may be discovered to be invalid. There is now a provision in the statute under which an invalid claim must be disclaimed without unreasonable delay

[6] The Senate Report reads "Chapter 15" instead of "The next chapter."



in order to save the rest of the patent. What delay is unreasonable is presently quite confusing, and the present law does not, as a matter of fact, prevent the patentee from suing again on the invalid claim if he so wishes.

The bill has eliminated that requirement. It has left the situation so that if one claim of a patent is invalid, the patentee may take it out. He may sue on the remaining claims which have whatever validity they may have on their own merits. That is, one bad claim does not affect the other claims, unless they are also bad for similar reasons.

Other provisions of the bill take care at least as well as is done in the present law of the possibility of a patentee suing again after his patent has been held invalid. That can be done today and no change is made in that situation, except that certain provisions tend to deter doing such a thing.

Section 255, which permits the Patent Office to correct by a certificate a merely clerical error made by the patentee, is new.

Section 256 is a new section in the law that is correlated with section 116 and relates to a mistake in joining a person as a joint inventor. Very often two or three people make an invention together. They must apply as joint inventors. If they make a mistake in determining who are the true inventors, they do so at their peril. This provision permits a bona fide mistake in joining a person as inventor or in failing to join a person as an inventor to be corrected.

The next chapter of two sections relates to assignments and ownership.

Section 262 merely states in the statute a peculiarity relating to joint ownership.

The next two sections collect provisions now in the law referring to the Government ownership of patents, making little change except in language.

The next chapter relates to infringements of patents.

Section 271, paragraph (a), is a declaration of what constitutes infringement. There is no declaration of what constitutes infringement in the present statute. It is not actually necessary because the granting clause creates certain exclusive rights and infringement would be any violation of those rights.

Paragraphs (b), (c), and (d) relate to the subject referred to as contributory infringement. The doctrine of contributory infringement has been part of our law for about 80 years. It has been applied to enjoin those who sought to cause infringement by supplying someone else with the means and directions for infringing a patent. One who makes a special device constituting the heart of a patented machine and supplies it to others with directions (specific or implied) to complete the machine

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is obviously appropriating the benefit of the patented invention. It is for this reason that the doctrine of contributory infringement, which prevents appropriating another man's patented invention, has been characterized as "an expression both of law and morals." Considerable doubt and confusion as to the scope of contributory infringement has resulted from a number of decisions of the courts in recent years. The purpose of this section is to codify in statutory form principles of contributory infringement and at the same time eliminate this doubt and confusion. Paragraph (b) recites in broad terms that one who aids and abets an infringement is likewise an infringer. The principle of contributory infringement is set forth in the provisions of the next paragraph which is concerned with the usual situation in which contributory infringement arises. This latter paragraph is much more restricted than many proponents of contributory infringement believe should be the case. The sale of a component of a patented machine, etc., must constitute a material part of the invention and must be known to be especially made or especially adapted for use in the infringement before there can be contributory infringement, and likewise the sale of staple articles of commerce suitable for non-infringement use does not constitute contributory infringement. The last paragraph of this section provides that one who merely does what he is authorized to do by statute is not guilty of misuse of the patent. These paragraphs have as their main purpose clarification and stabilization.

Section 272 is a new section in the law relating to infringement, but it is of relatively little importance and it follows a paragraph in a treaty to which the United States is a party.

Beginning with 281 is a group of sections relating to remedy for infringement of a patent, the suit in the courts. The present statutes on this matter are in confusion because they were written quite some time ago and court procedure and the names of action and so on have changed since then. So the present sections were substantially reorganized into a group of sections fitting in at this place, with some changes.

Section 281 is a declaration which serves as a preamble to the others.

Section 282 introduces a declaration of the presumption of validity of a patent, which is now a statement made by courts in decisions, but has had no expression in the statute. The defenses to a suit for infringement are stated in general terms, changing the language in the present statute, but not materially changing the substance.

The next few sections relate to injunctions, damages, attorney fees, the statute of limitations, and to marking and notice; all



of which together replace present statutes on suits, with a good deal of reorganization in language to clarify the statement of the statutes.

Section 288 is the companion section to the disclaimer section, 253.

Section 292 is a criminal statute relating to falsely marking an article as being patented when it was not patented, which is now the present law. But this section revises it and makes a few changes, and also makes it an ordinary criminal action as well as an informer action as in the present statute.

Section 293 is a new section that is needed on some occasions to obtain jurisdiction over foreign patent owners that do not reside in the United States.

The revision notes, which follow and constitute a part of this report, point out in more detail the revisions made by the bill.[7]

[This concludes the Preliminary Statement in the House Report, the balance of the Report is described in the Preface.]

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[7] The Senate Report has an additional paragraph reading as follows: "The committee is of the opinion that the codification of title 35 is most desirable in order that the laws relating to patents can be readily accessible and understandable. Previous codifications, such as those of titles 18 and 28, have proved their worth, and after a study of the bill H. R. 7794 the committee believes that it should be given favorable consideration."

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# United States Code
# Title 35—Patents

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### § 1. Establishment

The Patent Office shall continue as an office in the Department of Commerce, where records, books, drawings, specifications, and other papers and things pertaining to patents and to trade-mark registrations shall be kept and preserved, except as otherwise provided by law.

SECTION 1—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 1 (R. S. 475 and Executive Order 4175, Mar. 17, 1925).

The word "all" is omitted from the corresponding section of the existing statute and "except as otherwise provided by law" added, since some old records are kept in the National Archives, see 44 U. S. C., 1946 ed., ch. 8A.

The word "models" has been omitted to remove emphasis on models since they are no longer generally required. They are included by the word "things."

The phrase "and to trade-mark registrations" is added. There is no enactment corresponding to this section in the trade-mark law. The original chapter of the Revised Statutes containing



this section deals with the Patent Office as such in its administration of trade-marks as well as patents. This is explicitly brought out in some of the corresponding sections of the present chapter.

Changes in language are made.

R. S. 475. There shall be in the Department of the Interior an office known as the Patent Office, where all records, books, models, drawings, specifications, and other papers and things pertaining to patents shall be safely kept and preserved.

Executive Order 4175, March 17, 1925. I, Calvin Coolidge, President of the United States of America, under the authority conferred upon me by act of February 14, 1903, entitled "An act to establish the Department of Commerce and Labor" (32 Stat., 826) and by virtue of all other powers thereto me enabling, do hereby transfer from the Department of the Interior to the Department of Commerce, to be administered under the supervision of the Secretary of Commerce, the United States Patent Office, together with all appropriations, the records and all public property of said service in the District of Columbia or elsewhere, as provided in the act of February 14, 1903, supra. The transfer above mentioned shall be effective from and including April 1, 1925.

### § 2. Seal

The Patent Office shall have a seal with which letters patent, certificates of trade-mark registrations, and papers issued from the Office shall be authenticated.

SECTION 2—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 3 (R. S. 478).

"Certificates of trade-mark registrations" is added, see note under section 1. Changes in language are made and the specific date eliminated.

R. S. 478. The seal heretofore provided for the Patent-Office shall be the seal of the Office, with which letters-patent and papers issued from the Office shall be authenticated.

### § 3. Officers and employees

A Commissioner of Patents, one first assistant commissioner, two assistant commissioners, and nine examiners-in-chief, shall be appointed by the President, by and with the advice and consent of the Senate. The assistant commissioners shall perform the duties pertaining to the office of commissioner assigned to them by the Commissioner. The first assistant commissioner, or, in the event of a vacancy in that office, the assistant commissioner senior in date of appointment, shall fill the

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office of Commissioner during a vacancy in that office until a Commissioner is appointed and takes office. The Secretary of Commerce, upon the nomination of the Commissioner in accordance with law, shall appoint all other officers and employees.

The Secretary of Commerce may vest in himself the functions of the Patent Office and its officers and employees specified in this title and may from time to time authorize their performance by any other officer or employee.

SECTION 3—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 2 (R. S. 476, amended (1) Feb. 15, 1916, ch. 22 § 1, 39 Stat. 8, (2) Feb. 14, 1927, ch. 139, § 1, 44 Stat. 1098, (3) April 11, 1930, ch. 132, § 1, 46 Stat. 155).

The temporary designation of the assistant commissioner as Commissioner in case of a vacancy in office is added. This will eliminate complications since present applicable general statutes (5 U. S. C., 1946 ed., § 7) permit a vacancy to be temporarily filled only for not more than 30 days.

Changes in language are made. "Assistant commissioners" is used in the second sentence (and elsewhere in the bill) as referring to all three assistants.

This entire title is subject to Reorganization Plan No. 5 of 1950 (64 Stat. 1263) which vests all functions of the Patent Office in the Secretary of Commerce and authorizes delegation by him. It has been found impractical to so word the various sections of the title, and a general provision has been inserted as the second paragraph of this section of the bill, leaving the wording of various sections of the title in terms of officers previously specified and to whom the functions presently stand delegated.

Sec. 476. There shall be in the Patent-Office a Commissioner of Patents, one first assistant commissioner, two assistant commissioners, and nine examiners-in-chief, who shall be appointed by the President, by and with the advice and consent of the Senate. The first assistant commissioner and the assistant commissioners shall perform such duties pertaining to the office of commissioner as may be assigned to them, respectively, from time to time by the Commissioner of Patents. All other officers, clerks, and employees authorized by law for the office shall be appointed by the Secretary of Commerce upon the nomination of the Commissioner of Patents, in accordance with existing law.



## § 4. Restrictions on officers and employees as to interest in patents.

Officers and employees of the Patent Office shall be incapable, during the period of their appointments and for one year thereafter, of applying for a patent and of acquiring, directly or indirectly, except by inheritance or bequest, any patent or any right or interest in any patent, issued or to be issued by the Office. In patents applied for thereafter they shall not be entitled to any priority date earlier than one year after the termination of their appointment.

SECTION 4—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 4 (R. S. 480).

The language is revised and inability to apply for a patent, included in the original language, is made explicit.

The period of disability is increased to include one year after leaving the Office.

The further restriction, that no priority date earlier than one year after leaving the Office can be claimed, is added.

The one year period is made inapplicable to applications which may be pending when the revised title goes into effect by section 4 (g) of the bill.

R. S. 480. All officers and employes of the Patent-Office shall be incapable, during the period for which they hold their appointments, to acquire or take, directly or indirectly, except by inheritance or bequest, any right or interest in any patent issued by the Office.

## § 5. Bond of Commissioner and other officers

The Commissioner and such other officers as he designates, before entering upon their duties, shall severally give bond, with sureties, the former in the sum of $10,000, and the latter in sums prescribed by the Commissioner, conditioned for the faithful discharge of their respective duties and that they shall render to the proper officers of the Treasury a true account of all money received by virtue of their offices.

SECTION 5—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 5 (R. S. 479).

Specific mention of the office of chief clerk is omitted from the corresponding section of the existing statute, the officers

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requiring bonds, and the amounts of the bonds are to be designated by the Commissioner.

R. S. 479. The Commissioner of Patents and the chief clerk, before entering upon their duties, shall severally give bond, with sureties, to the Treasurer of the United States, the former in the sum of ten thousand dollars, and the latter in the sum of five thousand dollars, conditioned for the faithful discharge of their respective duties, and that they shall render to the proper officers of the Treasury a true account of all money received by virtue of their offices.

## § 6. Duties of Commissioner

The Commissioner, under the direction of the Secretary of Commerce, shall superintend or perform all duties required by law respecting the granting and issuing of patents and the registration of trade-marks; and he shall have charge of property belonging to the Patent Office. He may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

SECTION 6—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 6 (R. S. 481 and 483). The two sections are combined into one with some changes in language.

"And the registration of trade-marks" is added, see note under section 1.

R. S. 481. The Commissioner of Patents, under the direction of the Secretary of the Interior, shall superintend or perform all duties respecting the granting and issuing of patents directed by law; and he shall have charge of all books, records, papers, models, machines, and other things belonging to the Patent-Office.

R. S. 483. The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent-Office.

## § 7. Board of Appeals

The examiners-in-chief shall be persons of competent legal knowledge and scientific ability. The Commissioner, the assistant commissioners, and the examiners-in-chief shall constitute a Board of Appeals, which, on written appeal of the applicant, shall review adverse decisions of examiners upon applications for patents. Each appeal shall be heard by at least three members of the Board of Appeals, the members hearing such appeal



to be designated by the Commissioner. The Board of Appeals has sole power to grant rehearings.

Whenever the Commissioner considers it necessary to maintain the work of the Board of Appeals current, he may designate any patent examiner of the primary examiner grade or higher, having the requisite ability, to serve as examiner-in-chief for periods not exceeding six months each. An examiner so designated shall be qualified to act as a member of the Board of Appeals. Not more than one such primary examiner shall be a member of the Board of Appeals hearing an appeal.

SECTION 7—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 7 (R. S. 482, amended (1) Mar. 2, 1927, ch. 273, § 3, 44 Stat. 1335, (2) April 11, 1930, ch. 132, § 2, 46 Stat. 155, (3) Mar. 4, 1950, ch. 50, 64 Stat. 11).

Some changes in language have been made and the reference to interferences, which are no longer considered by the Board of Appeals has been deleted. Reference to reissues is omitted in view of the general provision in section 201.

R. S. 482. The examiners-in-chief shall be persons of competent legal knowledge and scientific ability. The Commissioner of Patents, the first assistant commissioner, the assistant commissioners, and the examiners in chief shall constitute a board of appeals, whose duty it shall be, on written petition of the appellant, to review and determine upon the validity of the adverse decisions of examiners upon applications for patents and for reissues of patents and in interference cases. Each appeal shall be heard by at least three members of the board of appeals, the members hearing such appeal to be designated by the commissioner. The board of appeals shall have sole power to grant rehearings.

The Commissioner, when in his discretion considered necessary to maintain the work of the board of appeals current, may designate any examiner of the primary examiner grade or higher, having the requisite ability, to serve as examiner in chief for periods not exceeding six months each, and any examiner so designated shall be qualified to act as a member of the board of appeals. Not more than one primary examiner shall be among the members of the board of appeals hearing an appeal.

## § 8. Library

The Commissioner shall maintain a library of scientific and other works and periodicals, both foreign and domestic, in the Patent Office to aid the officers in the discharge of their duties.

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SECTION 8—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 10 (R. S. 486).

Some change in language has been made. "Purchased" is changed to "maintained" to include the existing library and keeping it up by additions. The phrase "and other" is added to include legal works. The last phrase of the corresponding section of the existing statute is omitted as unnecessary.

R. S. 486. There shall be purchased for the use of the Patent-Office a library of such scientific works and periodicals, both foreign and American, as may aid the officers in the discharge of their duties, not exceeding the amount annually appropriated for that purpose.

## § 9. Classification of patents

The Commissioner may revise and maintain the classification by subject matter of United States letters patent, and such other patents and printed publications as may be necessary or practicable, for the purpose of determining with readiness and accuracy the novelty of inventions for which applications for patent are filed.

SECTION 9—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 6 note (June 10, 1898, ch. 430, § 1, 30 Stat. 440).

Changes in language are made.

June 10, 1898, ch. 423, § 1, 30 Stat. 440. That for the purpose of determining with more readiness and accuracy the novelty of inventions for which applications for letters patent are or may be filed in the United States Patent Office, and to prevent the issuance of letters patent of the United States for inventions which are not new, the Commissioner of Patents is hereby authorized and directed to revise and perfect the classification, by subjects-matter, of all letters patent and printed publications in the United States Patent Office which constitute the field of search in the examination as to the novelty of invention for which applications for patents are or may be filed.

## § 10. Certified copies of records

The Commissioner may furnish certified copies of specifications and drawings of patents issued by the Patent Office, and of other records available either to the public or to the person applying therefor.

SECTION 10—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 14 (Mar. 3, 1891, ch. 541, § 1 (part), 26 Stat. 908, 940).

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Reference to other records is added. The fee for certification is omitted as it appears in the table of fees.

Mar. 3, 1891, ch. 541, § 1 (part) 26 Stat. 940. And certified copies of such drawings and specifications may be furnished by the Commissioner of Patents to persons applying therefor upon payment of the present rates for uncertified copies, and twenty-five cents additional for each certification.

## § 11. Publications

(a) The Commissioner may print, or cause to be printed, the following:

1. Patents, including specifications and drawings, together with copies of the same. The Patent Office may print the headings of the drawings for patents for the purpose of photolithography.

2. Certificates of trade-mark registrations, including statements and drawings, together with copies of the same.

3. The Official Gazette of the United States Patent Office.

4. Annual indexes of patents and patentees, and of trade-marks and registrants.

5. Annual volumes of decisions in patent and trade-mark cases.

6. Pamphlet copies of the patent laws and rules of practice, laws and rules relating to trade-marks, and circulars or other publications relating to the business of the Office.

(b) The Commissioner may exchange any of the publications specified in items 3, 4, 5, and 6 of subsection (a) of this section for publications desirable for the use of the Patent Office.

SECTION 11—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., §§ 13 and 16 (R. S. 489; July 9, 1947, ch. 211, § 301 (part), 61 Stat. 299, repeated in prior and subsequent appropriation acts).

Section is amplified to list the publications of the Patent Office, based on 44 U. S. C., 1946 ed., § 283, 283a.

The second sentence of item 1 of the revised section is a provision appearing annually in appropriation acts to enable

the Patent Office to maintain a small printing press to place headings on drawings before the drawings are reproduced.

Language is changed.

R. S. 489. The Commissioner of Patents may print, or cause to be printed, copies of the claims of current issues, and copies of such laws, decisions, regulations, and circulars as may be necessary for the information of the public.

## § 12. Exchange of copies of patents with foreign countries

The Commissioner may exchange copies of specifications and drawings of United States patents for those of foreign countries.

SECTION 12—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § § 15 and 78, part (Jan. 14, 1915, 38 Stat. 1221; Feb. 18, 1922, ch. 58, § 9, proviso in, 42 Stat. 393 [R. S. 4934]).

The first act mentioned applies to Canada only, the second to any country; these are consolidated in one section, specific reference to one country not being necessary.

Language is changed.

Jan. 14, 1915, Pub. Res. 61, 38 Stat. 1221. That the Commissioner of Patents of the United States be, and he is hereby, authorized to exchange with the Dominion of Canada, under such terms of contract as may by him be deemed practicable, printed copies of patents now in the United States Patent Office and hereafter issued by the United States.

See under section 41 for text of R. S. 4934.

## § 13. Copies of patents for public libraries

The Commissioner may supply printed copies of specifications and drawings of patents to public libraries in the United States which shall maintain such copies for the use of the public, at the rate for each year's issue established for this purpose in section 41 (a) 9 of this title.

SECTION 13—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 78, part (R. S. 4934, Feb. 18, 1922, ch. 58, § 9, 42 Stat. 389, 393, amended June 15, 1950, ch. 249, 64 Stat. 215).

The proviso in the schedule of fees of the existing statute is made a separate section and some changes in language are made.

See under section 41 for text of R. S. 4934.



## § 14. Annual report to Congress

The Commissioner shall report to Congress annually the moneys received and expended, statistics concerning the work of the Office, and other information relating to the Office as may be useful to the Congress or the public.

SECTION 14—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 20 (R. S. 494).

Language is changed. The lists referred to in the corresponding section of existing statute, and which are omitted from the revised section, are the indexes provided for in section 11 (a) 4. The month of reporting is omitted. The report contemplated by R. S. 494 has been discontinued since 1925 under authority of 44 U. S. C., 1946 ed., § 212.

R. S. 494. The Commissioner of Patents shall lay before Congress, in the month of January, annually, a report, giving a detailed statement of all moneys received for patents, for copies of records or drawings, or from any other source whatever; a detailed statement of all expenditures for contingent and miscellaneous expenses; a list of all patents which were granted during the preceding year, designating under proper heads the subjects of such patents; an alphabetical list of all the patentees, with their places of residence; a list of all patents which have been extended during the year; and such other information of the condition of the Patent-Office as may be useful to Congress or the public.

# CHAPTER 2—PROCEEDINGS IN THE PATENT OFFICE

Sec.

21. Day for taking action falling on Saturday, Sunday, or holiday.
22. Printing of papers filed.
23. Testimony in Patent Office cases.
24. Subpoenas, witnesses.

## § 21. Day for taking action falling on Saturday, Sunday, or holiday

When the day, or the last day, for taking any action or paying any fee in the United States Patent Office falls on Saturday, Sunday, or a holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding secular or business day.

SECTION 21—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 21 (Mar. 2, 1927, ch. 273, § 14, 44 Stat. 1337).

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"Fixed by statute" is omitted from the corresponding section of the existing statute as unnecessary. Saturday is added as a day on which action need not be taken.

Mar. 2, 1927, ch. 273, § 14, 44 Stat. 1337. That where the day, or the last day, fixed by statute for taking any action or paying any fee in the United States Patent Office falls on Sunday, or on a holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding secular or business day.

## § 22. Printing of papers filed

The Commissioner may require papers filed in the Patent Office to be printed or typewritten.

SECTION 22—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 12 (R. S. 488).

Language is changed and "or typewritten" is added after "printed."

R. S. 488. The Commissioner of Patents may require all papers filed in the Patent-Office, if not correctly, legibly, and clearly written, to be printed at the cost of the party filing them.

## § 23. Testimony in Patent Office cases

The Commissioner may establish rules for taking affidavits and depositions required in cases in the Patent Office. Any officer authorized by law to take depositions to be used in the courts of the United States, or of the State where he resides, may take such affidavits and depositions.

SECTION 23—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 53 (R. S. 4905).

This section is placed in part 1 since it relates to trade-mark cases in the Patent Office as well as to patent cases.

Language is changed.

R. S. 4905. The Commissioner of Patents may establish rules for taking affidavits and depositions required in cases pending in the Patent Office, and such affidavits and depositions may be taken before any officer authorized by law to take depositions to be used in the courts of the United States, or of the State where the officer resides.

## § 24. Subpoenas, witnesses

The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent Office, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent Office.

Every witness subpoenaed and in attendance shall be allowed the fees and traveling expenses allowed to witnesses attending the United States district courts.

A judge of a court whose clerk issued a subpoena may enforce obedience to the process or punish disobedience as in other like cases, on proof that a witness, served with such subpoena, neglected or refused to appear or to testify. No witness shall be deemed guilty of contempt for disobeying such subpoena unless his fees and traveling expenses in going to, and returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret matter except upon appropriate order of the court which issued the subpoena.

SECTION 24—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § § 54, 55 and 56 (R. S. 4906, amended Feb. 18, 1922, ch. 58, § 7, 42 Stat. 389, 391-2; R. S. 4907; R. S. 4908).

Three sections of the existing statute are combined with some changes in language and placed in part 1 since they apply to trade-mark cases in the Patent Office as well as to patent cases. Reference to a repealed statute in the first paragraph is replaced by reference to the Federal Rules of Civil Procedure and certain rules are made applicable.

R. S. 4906. The clerk of any court of the United States, for any District or Territory wherein testimony is to be taken for use in any contested case pending in the Patent Office, shall, upon the application of any party thereto, or of his agent or attorney, issue a subpoena for any witness residing or being within such District or Territory, commanding him to appear and testify before any officer in such District or Territory authorized to take depositions and affidavits at any time and place in the subpoena



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stated. But no witness shall be required to attend at any place more than forty miles from the place where the subpoena is served upon him; and the provisions of section 869 of the Revised Statutes relating to the issuance of subpoenas duces tecum shall apply to contested cases in the Patent Office.

R. S. 4907. Every witness duly subpoenaed and in attendance shall be allowed the same fees as are allowed to witnesses attending the courts of the United States.

R. S. 4908. Whenever any witness, after being duly served with such subpoena, neglects or refuses to appear, or after appearing refuses to testify, the judge of the court whose clerk issued the subpoena may, on proof of such neglect or refusal, enforce obedience to the process, or punish the disobedience, as in other like cases. But no witness shall be deemed guilty of contempt for disobeying such subpoena, unless his fees and traveling expenses in going to, returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret invention or discovery made or owned by himself.

## CHAPTER 3—PRACTICE BEFORE PATENT OFFICE

Sec.
31. Regulations for agents and attorneys.
32. Suspension or exclusion from practice.
33. Unauthorized representation as practitioner.

### § 31. Regulations for agents and attorneys

The Commissioner, subject to the approval of the Secretary of Commerce, may prescribe regulations governing the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Patent Office, and may require them, before being recognized as representatives of applicants or other persons, to show that they are of good moral character and reputation and are possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office.

SECTION 31—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 11 (R. S. 487, amended Feb. 18, 1922, ch. 58, § 3, 42 Stat. 390).

The present statute is divided into two sections, 31 and 32.

Changes in language are made.

R. S. 487. The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may prescribe rules and regulations governing the recognition of agents, attorneys, or other persons representing applicants or other parties before his office, and he may require of such persons, agents, or attorneys, before being recognized as representatives of applicants or other persons, that they shall show that they are of good moral character and in good repute, are possessed of the necessary qualifications to enable them to render to applicants or other persons valuable service, and are likewise competent to advise and assist applicants or other persons in the presentation or prosecution of their applications or other business before the office. And the Commissioner of Patents may, after notice and opportunity for a hearing, suspend or exclude, either generally or in any particular case, from further practice before his office any person, agent, or attorney shown to be incompetent or disreputable, or guilty of gross misconduct, or who refuses to comply with the said rules and regulations, or who shall, with intent to defraud in any manner, deceive, mislead, or threaten any applicant or prospective applicant, or other person having immediate or prospective business before the office, by word, circular, letter, or by advertising. The reasons for any such suspension or exclusion shall be duly recorded. And the action of the commissioner may be reviewed upon the petition of the person so refused recognition or so suspended or excluded by the Supreme Court of the District of Columbia under such conditions and upon such proceedings as the said court may by its rules determine.



### § 32. Suspension or exclusion from practice

The Commissioner may, after notice and opportunity for a hearing, suspend or exclude, either generally or in any particular case, from further practice before the Patent Office, any person, agent, or attorney shown to be incompetent or disreputable, or guilty of gross misconduct, or who does not comply with the regulations established under section 31 of this title, or who shall, by word, circular, letter, or advertising, with intent to defraud in any manner, deceive, mislead, or threaten any applicant or prospective applicant, or other person having immediate or prospective business before the Office. The reasons for any such suspension or exclusion shall be duly recorded. The United States District Court for the District of Columbia, under such conditions and upon such proceedings as it by its rules determines, may review the action of the Commissioner upon the petition of the person so refused recognition or so suspended or excluded.

SECTION 32—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 11 (R. S. 487 amended Feb 18, 1922, ch. 58, § 3, 42 Stat. 390).

See note under section 31.



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## § 33. Unauthorized representation as practitioner

Whoever, not being recognized to practice before the Patent Office, holds himself out or permits himself to be held out as so recognized, or as being qualified to prepare or prosecute applications for patent, shall be fined not more than $1,000 for each offense.

SECTION 33—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 11a (May 9, 1938, ch. 188, 52 Stat. 342).

This is a criminal statute. The language has been considerably simplified and the upper limit of the penalty is increased.

May 9, 1938, ch. 188, 52 Stat. 342. That it shall be unlawful for any person who has not been duly recognized to practice before the United States Patent Office in accordance with the provisions of Section 487 of the Revised Statutes (U. S. C., title 35, sec. 11) and the rules of the Patent Office to hold himself out or knowingly permit himself to be held out as a patent solicitor, patent agent, or patent attorney, or otherwise in any manner hold himself out, either directly or indirectly, as authorized to represent applicants for patent in their business before the Patent Office, and it shall be unlawful for any person who has, under the authority of section 487 of the Revised Statutes (U. S. C., title 35, sec. 11) been disbarred or excluded from practice before the Patent Office, and has not been reinstated, to hold himself out in any manner whatever as entitled to represent or assist persons in the transaction of business before the Patent Office or any division thereof; and any offense against the foregoing provision shall be a misdemeanor and be punished by a fine of not less than $50 and not exceeding $500.

# CHAPTER 4—PATENT FEES

Sec.
41. Patent fees.
42. Payment of patent fees; return of excess amounts.

## § 41. Patent fees

(a) The Commissioner shall charge the following fees:

1. On filing each application for an original patent, except in design cases, $30, and $1 for each claim in excess of twenty.

2. On issuing each original patent, except in design cases, $30, and $1 for each claim in excess of twenty.

3. In design cases: For three years and six months, $10; for seven years, $15; for fourteen years, $30.

4. On every application for the reissue of a patent, $30 and $1 for each claim in excess of twenty over and above the number of claims of the original patent.



5. On filing each disclaimer, $10.

6. On an appeal for the first time from the examiner to the Board of Appeals, $25.

7. On filing each petition for the revival of an abandoned application for a patent or for the delayed payment of the fee for issuing each patent, $10.

8. For certificate of correction of applicant's mistake under section 255 of this title, $10.

9. For uncertified printed copies of specifications and drawings of patents (except design patents), 25 cents per copy; for design patents, 10 cents per copy; special rate for libraries specified in section 13 of this title, $50 for patents issued in one year.

10. For recording every assignment, agreement, or other paper not exceeding six pages, $3; for each additional two pages or less, $1; for each additional patent or application included in one writing, where more than one is so included, 50 cents additional.

11. For each certificate, $1.

(b) The Commissioner may establish charges for copies of records, publications, or services furnished by the Patent Office, not specified above.

SECTION 41—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 78 (R. S. 4934, amended (1) May 27, 1908, ch. 200, § 1 (part) 35 Stat. 317, 343; (2) June 25, 1910, ch. 414 § 2, 35 Stat. 843; (3) Feb. 18, 1922, ch. 58, § 9, 42 Stat. 389, 393; (4) Feb. 14, 1927, ch. 139, § 2, 44 Stat. 1098, 1099; (5) Mar. 2, 1927, ch. 273, § 13, 44 Stat. 1335, 1337; (6) April 11, 1930, ch. 132, § 3, 46 Stat. 155; (7) June 30, 1932, ch. 314, § § 308, 309, 47 Stat. 382, 410; (8) Aug. 9, 1939, ch. 619, § 3, 53 Stat. 1293; July 5, 1946, ch. 541, § 301 (part), 60 Stat. 446, 471. [(9) June 15, 1950, ch. 249, 64 Stat. 215]).

The items in the schedule of fees are rearranged in a few instances and are numbered for convenient reference.

The obsolete fee for appeal from the examiners of interferences to the Board of Appeals is omitted.

The fee for appeal to the Board of Appeals is changed from $15 to $25.

Two provisos in the corresponding section of the existing statute have been made separate sections, see sections 12 and 13.

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The fee for a certificate is changed from 50 cents to $1 to correspond to the same fee in the trade-mark statute.

A new item (8) is added to go with section 205.

An omnibus item to take care of miscellaneous minor fees is added; in view of this, two items in the present schedule are omitted.

The fee for reissue applications is changed slightly.

R. S. 4934. The following shall be the rates for patent fees:

On filing each original application for a patent, except in design cases, $25, and $1 for each claim in excess of twenty.

On issuing each original patent, except in design cases, $25, and $1 for each claim in excess of twenty.

In design cases: For three years and six months, $10; for seven years, $15; for fourteen years, $30.

On every application for the reissue of a patent, $30.

On filing each disclaimer, $10.

On an appeal for the first time from the primary examiners to the Board of Appeals, $15.

On every appeal from the examiner of interferences to the Board of Appeals, $25.

For uncertified printed copies of specifications and drawings of patents, 10 cents per copy: *Provided*, That the Commissioner of Patents may supply public libraries of the United States with such copies as published, for $50 per annum: *Provided further*, That the Commissioner of Patents may supply to any public library approved by the Commissioner, which on January 1, 1949, was receiving such copies under the preceding proviso, such copies for any year in which such library did not receive copies under the preceding proviso upon the payment of $50 per year for any such year. *Provided further*, That the Commissioner of Patents may exchange copies of United States patents for those of foreign countries.

For copies of records made by the Patent Office, excluding printed copies, 10 cents per hundred words.

For each certificate, 50 cents.

For recording every assignment, agreement, power of attorney, or other paper not exceeding six pages, $3; for each additional two pages or less, $1; for each additional patent or application included or involved in one writing, where more than one is so included or involved, 50 cents additional.

For copies of drawings, the reasonable cost of making them.

On filing each petition for the revival of an abandoned application for a patent or for the delayed payment of the fee for issuing each patent, $10.

R. S. 493. The price to be paid for uncertified printed copies of specifications and drawings of patents shall be determined by the Commissioner of Patents: *Provided*, That the maximum cost of a copy shall be ten cents.

Nov. 4, 1919, ch. 93, § 1 (part), 41 Stat. 335. *Provided*, That hereafter 10 cents per copy shall be charged for uncertified printed copies of specifications and drawings of patents.

July 5, 1946, ch. 541, § 301 (part), 60 Stat. 471. *Provided*, That hereafter on July 1, 1946, and thereafter 25 cents per copy shall be charged for uncertified copies of specifications and drawings of patents, and 10 cents per copy for design patents and certificates of trade-mark registration.

## § 42. Payment of patent fees; return of excess amounts

All patent fees shall be paid to the Commissioner who shall deposit the same in the Treasury of the United States in such manner as the Secretary of the Treasury directs, and the Commissioner may refund any sum paid by mistake or in excess of the fee required by law.

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SECTION 42—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 79 (Mar. 6, 1920, ch. 94, § 1 (part), 41 Stat. 503, 512).

Language has been changed.

R. S. 4935. Patent fees may be paid to the Commissioner of Patents, or to the Treasurer or any of the assistant treasurers of the United States, or to any of the designated depositaries, national banks, or receivers of public money, designated by the Secretary of the Treasury for that purpose; and such officer shall give the depositor a receipt or certificate of deposit therefor. All money received at the Patent Office, for any purpose, or from any source whatever, shall be paid into the Treasury as received, without any deduction whatever.

R. S. 4936. The Treasurer of the United States is authorized to pay back any sum or sums of money to any person who has through mistake paid the same into the Treasury, or to any receiver or depositary, to the credit of the Treasury, as for fees accruing at the Patent Office, upon a certificate thereof being made to the Treasurer by the Commissioner of Patents.

Mar. 6, 1920, ch. 94, § 1 (part), 41 Stat. 512. Hereafter all patent fees shall be paid to the Commissioner of Patents, who shall deposit the same in the Treasury of the United States in such manner as the Secretary of the Treasury shall direct, and said commissioner is authorized to pay back any sum or sums of money paid to him by any person by mistake or in excess of the fee required by law.

# CHAPTER 10—PATENTABILITY OF INVENTIONS

Sec.

100. Definitions.
101. Inventions patentable.
102. Conditions for patentability; novelty and loss of right to patent.
103. Conditions for patentability; non-obvious subject matter.
104. Invention made abroad.

## § 100. Definitions

When used in this title unless the context otherwise indicates—

(a) The term "invention" means invention or discovery.

(b) The term "process" means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.

(c) The terms "United States" and "this country"

mean the United States of America, its territories and possessions.

(d) The word "patentee" includes not only the patentee to whom the patent was issued but also the successors in title to the patentee.

SECTION 100—NEW SECTION

Paragraph (a) is added only to avoid repetition of the phrase "invention or discovery" and its derivatives throughout the revised title. The present statutes use the phrase "invention or discovery" and derivatives.

Paragraph (b) is noted under section 101.

Paragraphs (c) and (d) are added to avoid the use of long expressions in various parts of the revised title.

## § 101. Inventions patentable

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

SECTION 101—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 31 (R. S. 4886, amended (1) Mar. 3, 1897, ch. 391, § 1, 29 Stat. 692, (2) May 23, 1930, ch. 312, § 1, 46 Stat. 376, (3) Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212).

The corresponding section of existing statute is split into two sections, section 101 relating to the subject matter for which patents may be obtained, and section 102 defining statutory novelty and stating other conditions for patentability.

Section 101 follows the wording of the existing statute as to the subject matter for patents, except that reference to plant patents has been omitted for incorporation in section 301 and the word "art" has been replaced by "process," which is defined in section 100. The word "art" in the corresponding section of the existing statute has a different meaning than the same word as used in other places in the statute; it has been interpreted by the courts as being practically synonymous with process or method. "Process" has been used as its meaning is more readily grasped than "art" as interpreted, and the definition in section 100 (b) makes it clear that "process or method" is meant. The remainder of the definition clarifies the status of processes or methods which involve merely the new



use of a known process, machine, manufacture, composition of matter, or material; they are processes or methods under the statute and may be patented provided the conditions for patentability are satisfied.

R. S. 4886. 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, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor.

## § 102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

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(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

SECTION 102—SECTION REVISED

Paragraphs (a), (b), and (c) are based on 35 U. S. C., 1946 ed., § 31 (R. S. 4886, amended (1) Mar. 3, 1897, ch. 391, § 1, 29 Stat. 692, (2) May 23, 1930, ch. 312, § 1, 46 Stat. 376, (3) Aug. 5, 1939,, ch. 450, § 1, 53 Stat. 1212).

No change is made in these paragraphs other than that due to division into lettered paragraphs. The interpretation by the courts of paragraph (a) as being more restricted than the actual language would suggest (for example, "known" has been held to mean "publicly known") is recognized but no change in the language is made at this time. Paragraph (a) together with section 104 contains the substance of title 35 U. S. C., 1946 ed., § 72 (R. S. 4923).

Paragraph (d) is based on 35 U. S. C., 1946 ed., § 32, first paragraph (R. S. 4887 (first paragraph), amended (1) Mar. 3, 1897, ch. 391, § 3, 29 Stat. 692, 693, (2) Mar. 3, 1903, ch. 1019, § 1, 32 Stat. 1225, 1226, (3) June 19, 1936, ch. 594, 49 Stat. 1529).

The section has been changed so that the prior foreign patent is not a bar unless it was granted before the filing of the application in the United States.

Paragraph (e) is new and enacts the rule of *Milburn* v. *Davis-Bournonville,* 270 U. S. 390, by reason of which a United States patent disclosing an invention dates from the date of filing the application for the purpose of anticipating a subsequent inventor.

Paragraph (f) indicates the necessity for the inventor as the party applying for patent. Subsequent sections permit certain persons to apply in place of the inventor under special circumstances.

Paragraph (g) is derived from title 35, U. S. C., 1946 ed., § 69 (R. S. 4920, amended (1) Mar. 3, 1897, ch. 391, § 2, 29 Stat. 692, (2) Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212), the second defense recited in this section. This paragraph retains the present rules of law governing the determination of priority of invention.



Language relating specifically to designs is omitted for inclusion in subsequent sections.

[The period of one year specified in paragraph (b) is two years in the case of applications filed before August 5, 1940, see section 4d of the Act.

[As passed by the House, the word "on" in paragraph (d) was misprinted "or," this was corrected by the Senate.

[See section 4b of the Act for limitation of the effect of paragraph (d).]

See under section 101 for text of R. S. 4886.

R. S. 4887 (first paragraph). No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than twelve months, in cases within the provisions of section 4886 of the Revised Statutes, and six months in cases of designs, prior to the filing of the application in this country, in which case no patent shall be granted in this country.

R. S. 4923. Whenever it appears that a patentee, at the time of making his application for the patent, believed himself to be the original and first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country, before his invention or discovery thereof, if it had not been patented or described in a printed publication.

## § 103. Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

SECTION 103—NEW SECTION

There is no provision corresponding to the first sentence explicitly stated in the present statutes, but the refusal of patents by the Patent Office, and the holding of patents invalid by the courts, on the ground of lack of invention or lack of patentable novelty has been followed since at least as early as 1850. This

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paragraph is added with the view that an explicit statement in the statute may have some stabilizing effect, and also to serve as a basis for the addition at a later time of some criteria which may be worked out.

The second sentence states that patentability as to this requirement is not to be negatived by the manner in which the invention was made, that is, it is immaterial whether it resulted from long toil and experimentation or from a flash of genius.

### § 104. Invention made abroad

In proceedings in the Patent Office and in the courts, an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country, except as provided in section 119 of this title. Where an invention was made by a person, civil or military, while domiciled in the United States and serving in a foreign country in connection with operations by or on behalf of the United States, he shall be entitled to the same rights of priority with respect to such invention as if the same had been made in the United States.

SECTION 104—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 109 (Aug. 8, 1946, ch. 910, 60 Stat. 943).

Language has been changed and the last sentence has been broadened to refer to persons serving in connection with operations by or on behalf of the United States, instead of solely in connection with the prosecution of the war.

Aug. 8, 1946, ch. 910, § 9, 60 Stat. 943. That in proceedings in the Patent Office and in the courts of the United States an applicant for a patent for an invention, discovery, or a design, or a patentee, shall not be permitted to establish the date of invention or discovery by reference to knowledge or use thereof, or other activity with respect thereto, in a country foreign to the United States, other than the filing in a foreign country of an application for a patent for the same invention, discovery, or design which, in accordance with and subject to the provisions of section 4887 of the Revised Statutes, as amended, or in accordance with and subject to the provisions of this Act, is entitled to have the same force and effect as it would have had if filed in the United States on the date on which it was filed in such foreign country: *Provided*, That where an invention was made by a person, civil or military, during the time such person was domiciled in the United States or its possessions and was serving in a foreign country in connection with the prosecution of the war on behalf of the United States or its allies, the inventor thereof shall be entitled, in interference and other proceedings



arising in connection with such invention, to the same rights of priority with respect to such invention as if the same had been made in the United States.

## CHAPTER 11—APPLICATION FOR PATENT

Sec.
111. Application for patent.
112. Specification.
113. Drawings.
114. Models, specimens.
115. Oath of applicant.
116. Joint inventors.
117. Death or incapacity of inventor.
118. Filing by other than inventor.
119. Benefit of earlier filing date in foreign country; right of priority.
120. Benefit of earlier filing date in the United States.
121. Divisional applications.
122. Confidential status of applications.

### § 111. Application for patent

Application for patent shall be made by the inventor, except as otherwise provided in this title, in writing to the Commissioner. Such application shall include: (1) a specification as prescribed by section 112 of this title; (2) a drawing as prescribed by section 113 of this title; and (3) an oath by the applicant as prescribed by section 115 of this title. The application must be signed by the applicant and accompanied by the fee required by law.

SECTION 111—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 33 (R. S. 4888, amended (1) Mar. 3, 1915, ch. 94, § 1, 38 Stat. 958; (2) May 23, 1930, ch. 312, § 2, 46 Stat. 376).

The corresponding section of existing statute is divided into an introductory section relating to the application generally (this section) and a section on the specification (sec. 112).

The parts of the application are specified and the requirement for signature is placed in this general section so as to insure that only one signature will suffice.

R. S. 4888. Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent-Office a written description of the same, and of the manner and process of making, con-

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structing, compounding, and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor. No plant patent shall be declared invalid on the ground of noncompliance with this section if the description is made as complete as is reasonably possible.

## § 112. Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

SECTION 112—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 33 (R. S. 4888, amended (1) Mar. 3, 1915, ch. 94, § 1, 38 Stat. 958; (2) May 23, 1930, ch. 312, § 2, 46 Stat. 376).

The sentence relating to signature of the specification is omitted in view of the general requirement for a signature in section 111.

The last sentence is omitted for inclusion in the chapter relating to plant patents.

The clause relating to machines is omitted as unnecessary and the requirement for disclosing the best mode of carrying out the invention is stated as generally applicable to all types of invention (derived from title 35, U. S. C., 1946 ed., § 69, first defense).



The clause relating to the claim is made a separate paragraph to emphasize the distinction between the description and the claim or definition, and the language is modified.

A new paragraph relating to functional claims is added.

[See under section 111 for text of R. S. 4888].

## § 113. Drawings

When the nature of the case admits, the applicant shall furnish a drawing.

SECTION 113—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 34, part (R. S. 4889, amended Mar. 3, 1915, ch. 94, § 2, 38 Stat. 958).

The requirement for signature in the corresponding section of existing statute is omitted; regulations of the Patent Office can take care of any substitute. A redundant clause is omitted.

R. S. 4889. When the nature of the case admits of drawings, the applicant shall furnish one copy signed by the inventor or his attorney in fact, which shall be filed in the Patent Office; and a copy of the drawing to be furnished by the Patent Office, shall be attached to the patent as a part of the specification.

## § 114. Models, specimens

The Commissioner may require the applicant to furnish a model of convenient size to exhibit advantageously the several parts of his invention.

When the invention relates to a composition of matter, the Commissioner may require the applicant to furnish specimens or ingredients for the purpose of inspection or experiment.

SECTION 114—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 34, part (R. S. 4890 and 4891).

The change in language in the second paragraph broadens the requirement for specimens.

R. S. 4890. When the invention or discovery is of a composition of matter, the applicant, if required by the commissioner, shall furnish specimens of ingredients and of the composition, sufficient in quantity for the purpose of experiment.

R. S. 4891. In all cases which admit of representation by model, the applicant, if required by the commissioner, shall furnish a model of convenient size to exhibit advantageously the several parts of his invention or discovery.

R. S. 4930. The commissioner may dispense with models of designs when the design can be sufficiently represented by drawings or photographs.

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## § 115. Oath of applicant

The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by certificate of a diplomatic or consular officer of the United States, and such oath shall be valid if it complies with the laws of the state or country where made. When the application is made as provided in this title by a person other than the inventor, the oath may be so varied in form that it can be made by him.

SECTION 115—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 35 (R. S. 4892, amended (1) Mar. 3, 1903, ch. 1019, § 2, 32 Stat. 1225, 1226, (2) May 23, 1930, ch. 312, § 3, 46 Stat. 376).

The expression at the end of the second sentence is added to avoid application of the District of Columbia law to oaths taken outside the District.

Changes in language are made.

R. S. 4892. The applicant shall make oath that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement, or of the variety of plant, for which he solicits a patent; that he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, charge d'affaires, or consul holding commission under the Government of the United States, or before any notary public, judge, or magistrate having any official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by certificate of a diplomatic or consular officer of the United States.

## § 116. Joint inventors

When an invention is made by two or more persons jointly, they shall apply for patent jointly and each sign the application and make the required oath, except as otherwise provided in this title.

If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Commissioner, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor making the application, subject to the same rights which the omitted inventor would have had if he had been joined. The omitted inventor may subsequently join in the application.

Whenever a person is joined in an application for patent as joint inventor through error, or a joint inventor is not included in an application through error, and such error arose without any deceptive intention on his part, the Commissioner may permit the application to be amended accordingly, under such terms as he prescribes.

SECTION 116—NEW SECTION

The first paragraph is implied in the present statutes, and the part of the last paragraph relating to omission of an erroneously joined inventor is in the Patent Office rules. The remainder is new and provides for the correction of a mistake in erroneously joining a person as inventor, and for filing an application when one of several joint inventors cannot be found. This section is ancillary to section 256.

## § 117. Death or incapacity of inventor

Legal representatives of deceased inventors and of those under legal incapacity may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor.

SECTION 117—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 46 (R. S. 4896, amended (1) Feb. 28, 1899, ch. 227, 30 Stat. 915, (2) Mar. 3, 1903, ch. 1019, § 3, 32 Stat. 1225, 1226, (3) May 23, 1908, ch. 188, 35 Stat. 245).

The language has been considerably simplified.

R. S. 4896. When any person, having made any new invention or discovery for which a patent might have been granted, dies before a patent



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is granted the right of applying for and obtaining the patent shall devolve on his executor or administrator, in trust for the heirs at law of the deceased, in case he shall have died intestate; or if he shall have left a will disposing of the same, then in trust for his devisees in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him in his lifetime; and when any person having made any new invention or discovery for which a patent might have been granted becomes insane before a patent is granted the right of applying for and obtaining the patent shall devolve on his legally appointed guardian, conservator, or representative in trust for his estate in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him while sane; and when the application is made by such legal representatives the oath or affirmation required to be made shall be so varied in form that it can be made by them. The executor or administrator duly authorized under the law of any foreign country to administer upon the estate of the deceased inventor shall, in case the said inventor was not domiciled in the United States at the time of his death, have the right to apply for and obtain the patent. The authority of such foreign executor or administrator shall be proved by certificate of a diplomatic or consular officer of the United States.

The foregoing section, as to insane persons, is to cover all applications now on file in the Patent Office or which may be hereafter made.

## § 118. Filing by other than inventor

Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage; and the Commissioner may grant a patent to such inventor upon such notice to him as the Commissioner deems sufficient, and on compliance with such regulations as he prescribes.

SECTION 118—NEW SECTION

This section is new and provides for the filing of an application by another on behalf of the inventor in certain special hardship situations.

## § 119. Benefit of earlier filing date in foreign country; right of priority

An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed



an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed; but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing.

No application for patent shall be entitled to this right of priority unless a claim therefor and a certified copy of the original foreign application, specification and drawings upon which it is based are filed in the Patent Office before the patent is granted, or at such time during the pendency of the application as required by the Commissioner not earlier than six months after the filing of the application in this country. Such certification shall be made by the patent office of the foreign country in which filed and show the date of the application and of the filing of the specification and other papers. The Commissioner may require a translation of the papers filed if not in the English language and such other information as he deems necessary.

SECTION 119—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 32, second paragraph (R. S. 4887, second paragraph, amended (1) Mar. 3, 1903, ch. 1019, § 1, 32 Stat. 1225, 1226, (2) June 19, 1936, ch. 594, 49 Stat. 1529, (3) Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212).

The first paragraph is the same as the present law with changes in language. The references to designs have been removed for inclusion in another section and the opening clause has been modified to accord with actual practice and the requirements of the International Convention for the Protection of Industrial Property.

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The second paragraph is new, making an additional procedural requirement for obtaining the right of priority. Copies of the foreign papers on which the right of priority is based are required so that the record of the United States patent will be complete in this country.

[See section 4c of the Act for non-applicability of second paragraph to existing patents.]

R. S. 4887 (second paragraph). An application for patent for an invention or discovery or for a design filed in this country by any person who has previously regularly filed an application for a patent for the same invention, discovery, or design in a foreign country which, by treaty, convention, or law, affords similar privileges to citizens of the United States shall have the same force and effect as the same application would have if filed in this country on the date on which the application for patent for the same invention, discovery, or design was first filed in such foreign country: *Provided*, That the application in this country is filed within twelve months in cases within the provisions of section 4886 of the Revised Statutes, and within six months in cases of designs, from the earliest date on which any such foreign application was filed. But no patent shall be granted on any application for patent for an invention or discovery or a design which had been patented or described in a printed publication in this or any foreign country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country for more than one year prior to such filing.

### § 120. Benefit of earlier filing date in the United States

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States by the same inventor shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

SECTION 120—NEW SECTION

This section represents present law not expressed in the statute, except for the added requirement that the first application must be specifically mentioned in the second.

### § 121. Divisional applications

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Commissioner may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Commissioner to require the application to be restricted to one invention.



SECTION 121—NEW SECTION

This section enacts as law existing practice with respect to division, at the same time introducing a number of changes. Division is made discretionary with the Commissioner. The requirements of section 120 are made applicable and neither of the resulting patents can be held invalid over the other merely because of their being divided in several patents. In some cases a divisional application may be filed by the assignee.

### § 122. Confidential status of applications

Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner.

SECTION 122—NEW SECTION

This section enacts the Patent Office rule of secrecy of applications.

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# CHAPTER 12—EXAMINATION OF APPLICATION

Sec.
131. Examination of application.
132. Notice of rejection; reexamination.
133. Time for prosecuting application.
134. Appeal to the Board of Appeals.
135. Interferences.

## § 131. Examination of application

The Commissioner shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Commissioner shall issue a patent therefor.

### Section 131—Section Revised

Based on title 35, U. S. C., 1946 ed., § 36 (R. S. 4893).

The first part is revised in language and amplified. The phrase "and that the invention is sufficiently useful and important" is omitted as unnecessary, the requirements for patentability being stated in sections 101, 102 and 103.

R. S. 4893. On the filing of any such application and the payment of the fees required by law, the Commissioner of Patents shall cause an examination to be made of the alleged new invention or discovery; and, if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the commissioner shall issue a patent therefor.

## § 132. Notice of rejection; reexamination

Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

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### Section 132—Section Revised

Based on title 35, U. S. C., 1946 ed., § 51 (R. S. 4903, amended Aug. 5, 1939, ch. 452, § 1, 53 Stat. 1213).

The first paragraph of the corresponding section of existing statute is revised in language and amplified to incorporate present practice; the second paragraph of the existing statute is placed in section 135.

The last sentence relating to new matter is added but represents no departure from present practice.

R. S. 4903. Whenever, on examination, any claim for a patent is rejected, the Commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejection, together with such information and references as may be useful in judging of the propriety of renewing his application or of altering his specification; and if after receiving such notice, the applicant persists in his claim for a patent, with or without altering his specification, the Commissioner shall order a reexamination of the case.

No amendment for the first time presenting or asserting a claim which is the same as, or for substantially the same subject matter as, a claim of an issued patent may be made in any application unless such amendment is filed within one year from the date on which said patent was granted.

## § 133. Time for prosecuting application

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

### Section 133—Section Revised

Based on title 35, U. S. C., 1946 ed., § 37 (R. S. 4894, amended (1) Mar. 3, 1897, ch. 391, § 4, 29 Stat. 692, 693, (2) July 6, 1916, ch. 225, § 1, 39 Stat. 345, 347-8, (3) Mar. 2, 1927, ch. 273, § 1, 44 Stat. 1335, (4) Aug. 7, 1939, ch. 568, 53 Stat. 1264).

The opening clause of the corresponding section of existing statute is omitted as having no present day meaning or value and the last two sentences are omitted for inclusion in section 267. The notice is stated as given or mailed. Language is revised.

R. S. 4894. All applications for patents shall be completed and prepared for examination within six months after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same within six months or such shorter time, not less than thirty days or any extensions thereof, as shall be fixed by the Commissioner of Patents in

writing to the applicant, after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable: *Provided, however,* That no application shall be regarded as abandoned which has become the property of the Government of the United States and with respect to which the head of any department of the Government shall have certified to the Commissioner of Patents, within a period of three years, that the invention disclosed therein is important to the armament or defense of the United States: *Provided further,* That within ninety days, and not less than thirty days, before the expiration of any such three-year period the Commissioner of Patents shall, in writing, notify the head of the department interested in any pending application for patent, of the approaching expiration of the three-year period within which any application for patent shall have been pending.

## § 134. Appeal to the Board of Appeals

An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Appeals, having once paid the fee for such appeal.

SECTION 134—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 57 (R. S. 4909 amended (1) Mar. 2, 1927, ch. 273, § 5, 44 Stat. 1335, 1336, (2) Aug. 5, 1939, ch. 451, § 2, 53 Stat. 1212).

Reference to reissues is omitted in view of the general provision in section 251. Minor changes in language are made.

R. S. 4909. Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, may appeal from the decision of the primary examiner to the Board of Appeals, having once paid the fee for such appeal.

## § 135. Interferences

Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse



to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office.

A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

SECTION 135—SECTION REVISED

The first paragraph is based on title 35, U. S. C., 1946 ed., § 52 (R. S. 4904 amended (1) Mar. 2, 1927, ch. 273, § 4, 44 Stat. 1335, 1336, (2) Aug. 5, 1939, ch. 451, § 1, 53 Stat. 1212).

The first paragraph states the existing corresponding statute with a few changes in language. An explicit statement that the Office decision on priority constitutes a final refusal by the Office of the claims involved, is added. The last sentence is new and provides that judgment adverse to a patentee constitutes cancellation of the claims of the patent involved after the judgment has become final, the patentee has a right of appeal (sec. 141) and is given a right of review by civil action (sec. 146).

The second paragraph is based on title 35, U. S. C., 1946 ed., § 51, (R. S. 4903, amended Aug. 5, 1939, ch. 452, § 1, 53 Stat. 1213). Changes in language are made.

R. S. 4904. Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct a board of three examiners of interferences to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor.
[See under section 132 for text of R. S. 4903].

# CHAPTER 13—REVIEW OF PATENT OFFICE DECISION

Sec.
141. Appeal to Court of Customs and Patent Appeals.
142. Notice of appeal.
143. Proceedings on appeal.
144. Decision on appeal.
145. Civil action to obtain patent.
146. Civil action in case of interference.

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## § 141. Appeal to Court of Customs and Patent Appeals

An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Customs and Patent Appeals, thereby waiving his right to proceed under section 145 of this title. A party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority may appeal to the United States Court of Customs and Patent Appeals, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has filed notice of appeal according to section 142 of this title, files notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 146 of this title. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under section 146, in default of which the decision appealed from shall govern the further proceedings in the case.

SECTION 141—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 59a (R. S. 4911, amended (1) Mar. 2, 1927, ch. 273, § 8, 44 Stat. 1336, (2) Mar. 2, 1929, ch. 488S, § 2a, 45 Stat. 1476, (3) Aug. 5, 1939, ch. 451, § 3, 53 Stat. 1212).

Changes in language are made.

R. S. 4911. If any applicant is dissatisfied with the decision of the board of appeals, he may appeal to the United States Court of Customs and Patent Appeals, in which case he waives his right to proceed under section 4915 of the Revised Statutes. If any party to an interference is dissatisfied with the decision of the board of interference examiners, he may appeal to the United States Court of Customs and Patent Appeals, provided that such appeal shall be dismissed if any adverse party to such interference shall, within twenty days after the appellant shall have filed notice of appeal according to section 4912 of the Revised Statutes, file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes. Thereupon the appellant shall have thirty days thereafter within which to file a bill of equity under said section 4915, in default of which the decisions appealed from shall govern the further proceedings in the case.

## § 142. Notice of appeal

When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and shall file in the Patent Office his reasons of appeal, specifically set forth in writing, within such time after the date of the decision appealed from, not less than sixty days, as the Commissioner appoints.



SECTION 142—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 60 (R. S. 4912 amended (1) Mar. 2, 1927, ch. 273, § 9, 44 Stat. 1336 (2) Mar. 2, 1929, ch. 488S, § 2 (b), 45 Stat. 1476).

Changes in language are made.

R. S. 4912. When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and file in the Patent-Office, within such time as the Commissioner shall appoint, his reasons of appeal, specifically set forth in writing.

## § 143. Proceedings on appeal

The United States Court of Customs and Patent Appeals shall, before hearing such appeal, give notice of the time and place of the hearing to the Commissioner and the parties thereto. The Commissioner shall transmit to the court certified copies of all the necessary original papers and evidence in the case specified by the appellant and any additional papers and evidence specified by the appellee and in an ex parte case the Commissioner shall furnish the court with the grounds of the decision of the Patent Office, in writing, touching all the points involved by the reasons of appeal.

SECTION 143—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 61 (R. S. 4913, amended Mar. 2, 1927, ch. 273, § 10, 44 Stat. 1336).

Language is changed. The requirement that the Commissioner notify the parties is omitted and a requirement that the court notify the parties is added. The statement relating to filing the papers and testimony is made more explicit.

R. S. 4913. The court shall, before hearing such appeal, give notice to the Commissioner of the time and place of the hearing, and on receiving such notice the Commissioner shall give notice of such time and place in such manner as the court may prescribe, to all parties who appear to be interested therein. The party appealing shall lay before the court certified copies of all the original papers and evidence in the case, and the Commissioner shall furnish the court with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal.



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## § 144. Decision on appeal

The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent Office, and the decision shall be confined to the points set forth in the reasons of appeal. Upon its determination the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and govern the further proceedings in the case.

SECTION 144—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 62 (R. S. 4914).

Language is changed and the last sentence of the corresponding section of existing statute omitted as superfluous; such a sentence does not appear in the present civil action section, 35 U. S. C. [1946 ed.] 63 and in either case the validity of the patent may be questioned.

R. S. 4914. The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the commissioner, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

## § 145. Civil action to obtain patent

An applicant dissatisfied with the decision of the Board of Appeals may unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to



issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

SECTION 145—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 63 (R. S. 4915, amended (1) Mar. 2, 1927, ch. 273, § 11, 44 Stat. 1336, (2) Mar. 2, 1929, ch. 488, § 2 (b), 45 Stat. 1476, (3) Aug. 5, 1939, ch. 451, § 4, 53 Stat. 1212).

Bill in equity is changed to civil action and the section is restricted to exclude interferences which are covered by the next section. The time for filing the action is changed to the same as the time for appeal. The requirement for the applicant to file a copy of the decision in the Patent Office is omitted. Language is changed.

R. S. 4915. Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioners; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

## § 146. Civil action in case of interference

Any party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority, may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints or as provided in section 141 of this title, unless he has ap-

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pealed to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided. In such suits the record in the Patent Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent Office when admitted shall have the same effect as if originally taken and produced in the suit.

Such suit may be instituted against the party in interest as shown by the records of the Patent Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs. The Commissioner shall not be a necessary party but he shall be notified of the filing of the suit by the clerk of the court in which it is filed and shall have the right to intervene. Judgment of the court in favor of the right of an applicant to a patent shall authorize the Commissioner to issue such patent on the filing in the Patent Office of a certified copy of the judgment and on compliance with the requirements of law.

SECTION 146—SECTION REVISED

The first paragraph and parts of the second paragraph are based on title 35, U. S. C., 1946 ed., § 63 (R. S. 4915, amended (1) Mar. 2, 1927, ch. 273, § 11, 44 Stat. 1336, (2) Mar. 2, 1929, ch. 488, § 2 (b), 45 Stat. 1476, (3) Aug. 5, 1939, ch. 451, § 4, 53 Stat. 1212), limited to interferences and making some changes. The action is not restricted to applicants, but a patentee may also bring the action. The time for bringing the action is made the same as for appeals.

In the second paragraph the first sentence is new and eliminates difficulties arising from unrecorded interests.

The second sentence is based on 35 U. S. C., 1946 ed., § 72a (Mar. 3, 1927, ch. 364, 44 Stat. 1394, reenacted Oct. 31, 1951, ch. 655, § 53a, 65 Stat. 728) with changes in language.

The fourth sentence is new and prevents such suits from being filed against the Commissioner as a defendant; however, the Commissioner has the right to intervene.

Language is changed.

See under section 146 for text of R. S. 4915.

Oct. 31, 1951, ch. 655, § 53a, 65 Stat. 728. (a) Upon the filing of a complaint in the United States District Court for the District of Columbia wherein remedy is sought under section 4915 or section 4918 of the Revised Statutes, as amended (35 U. S. C., secs. 63 and 66), without seeking other remedy, if it shall appear that there is an adverse party residing in a foreign country, or adverse parties residing in a plurality of districts not embraced within the same State, the court shall have jurisdiction thereof and process shall, unless the adverse party or parties voluntarily make appearance, be issued against all of the adverse parties and served anywhere within the United States, except that process issued against parties residing in foreign countries pursuant to this section may be served by publication or otherwise as the court may direct.

(b) The provision of subsection (a) of this section shall be deemed to be in effect as of September 1, 1948.

## CHAPTER 14—ISSUE OF PATENT

Sec.
151. Time of issue of patent.
152. Issue of patent to assignee.
153. How issued.
154. Contents and term of patent.

### § 151. Time of issue of patent

The patent shall issue within three months from the date of the payment of the final fee, which shall be paid not later than six months after written notice to the applicant of allowance of the application, but the Commissioner may accept the final fee if paid within one year after the six month period for payment, and the patent shall issue.

SECTION 151—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 41 (R. S. 4885, amended (1) May 23, 1908, ch. 189, 35 Stat. 246, (2) Aug. 9, 1939, § 2, ch. 619, 53 Stat. 1293).

Language is changed.



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R. S. 4885. Every patent shall issue within a period of three months from the date of the payment of the final fee, which fee shall be paid not later than six months from the time at which the application was passed and allowed and notice thereof was sent to the applicant or his agent; and if the final fee is not paid within that period the patent shall be withheld: *Provided, however,* That the Commissioner of Patents may in his discretion receive the final fee if paid within one year after the six months' period for payment has passed and the patent shall issue.

## § 152. Issue of patent to assignee

Patents may be granted to the assignee of the inventor of record in the Patent Office, upon the application made and the specification sworn to by the inventor, except as otherwise provided in this title.

SECTION 152—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 44 (R. S. 4895).

Language is changed and the reference to reissues is omitted in view of the general provision in section 201.[8]

R. S. 4895. Patents may be granted and issued or reissued to the assignee of the inventor or discoverer; but the assignment must first be entered of record in the Patent Office. And in all cases of an application by an assignee for the issue of a patent, the application shall be made and the specification sworn to by the inventor or discoverer; and in all cases of an application for a reissue of any patent, the application must be made and the corrected specification signed by the inventor or discoverer, if he is living, unless the patent was issued and assignment made before the eighth day of July, eighteen hundred and seventy.

## § 153. How issued

Patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Commissioner or have his signature placed thereon and attested by an officer of the Patent Office designated by the Commissioner, and shall be recorded in the Patent Office.

SECTION 153—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 39 (R. S. 4883, amended (1) Feb. 18, 1888, ch. 15, 25 Stat. 40, (2) April 11, 1903, ch. 417, 32 Stat. 95, (3) Feb. 18, 1922, ch. 58, § 5, 42 Stat. 391.

The phrases referring to the attesting officers and to the recording of the patents are broadened.

[8] The Senate Report reads "251" which is the correct number.



R. S. 4883. All patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall either be signed, by the Commissioner of Patents or have his name printed thereon and attested by an Assistant Commissioner of Patents or by one of the law examiners duly designated by the commissioner, and shall be recorded, together with the specifications, in the Patent Office in books to be kept for that purpose.

## § 154. Contents and term of patent

Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the right to exclude others from making, using, or selling the invention throughout the United States, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof.

SECTION 154—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 40 (R. S. 4884, amended May 23, 1930, ch. 312, § 1, 46 Stat. 376).

The reference to plants is omitted for inclusion in another section and the reference to the title is shortened since the title is of no legal significance.

The wording of the granting clause is changed to "the right to exclude others from making, using, or selling," following language used by the Supreme Court, to render the meaning clearer.

"United States" is defined in section 100.

R. S. 4884. Every patent shall contain a short title or description of the invention or discovery, correctly indicating its nature and design, and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the exclusive right to make, use, and vend the invention or discovery (including in the case of a plant patent the exclusive right to asexually reproduce the plant) throughout the United States and the Territories thereof, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof.

## CHAPTER 15—PLANT PATENTS

Sec.
161. Patents for plants.
162. Description, claim.
163. Grant.
164. Assistance of Department of Agriculture.

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### § 161. Patents for plants

Whoever invents or discovers and asexually reproduces any distinct and new variety of plant, other than a tuber-propagated plant, may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for plants, except as otherwise provided.

SECTION 161—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 31, part (R. S. 4886, amended (1) Mar. 3, 1897, ch. 391, § 1, 29 Stat. 692, (2) May 23, 1930, ch. 312, § 1, 46 Stat. 376, (3) Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212).

The provision relating to plants in the corresponding section of existing statute is made a separate section.

[See under section 101 for text of R. S. 4886].

### § 162. Description, claim

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible.

The claim in the specification shall be in formal terms to the plant shown and described.

SECTION 162—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 33, part (R. S. 4888, amended (1) Mar. 3, 1915, ch. 94, § 1, 38 Stat. 958, (2) May 23, 1930, ch. 312, § 2, 46 Stat. 376).

The first paragraph is the provision in R. S. 4888 (see section 112). The second paragraph is not in the statute but represents the actual practice.

[See under section 112 for text of R. S. 4888].

### § 163. Grant

In the case of a plant patent the grant shall be of the right to exclude others from asexually reproducing the plant or selling or using the plant so reproduced.

SECTION 163—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 40, part (R. S. 4884, amended May 23, 1930, ch. 312, § 1, 46 Stat. 376).

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This provision is from R. S. 4884 (see section 154) amended in language.

[See under section 154 for text of R. S. 4884].

### § 164. Assistance of Department of Agriculture

The President may by Executive order direct the Secretary of Agriculture, in accordance with the requests of the Commissioner, for the purpose of carrying into effect the provisions of this title with respect to plants (1) to furnish available information of the Department of Agriculture, (2) to conduct through the appropriate bureau or division of the Department research upon special problems, or (3) to detail to the Commissioner officers and employees of the Department.

SECTION 164—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 56a (May 23, 1930, ch. 312, § 4, 46 Stat. 376).

Language is changed.

May 23, 1930, ch. 312, § 4, 46 Stat. 376. The President may by Executive order direct the Secretary of Agriculture (1) to furnish the Commissioner of Patents such available information of the Department of Agriculture, or (2) to conduct through the appropriate bureau or division of the department such research upon special problems, or (3) to detail to the Commissioner of Patents such officers and employees of the department, as the commissioner may request for the purposes of carrying this Act into effect.

## CHAPTER 16—DESIGNS

Sec.
171. Patents for designs.
172. Right of priority.
173. Term of design patent.

### § 171. Patents for designs

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

SECTION 171—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 73 (R. S. 4929, amended (1) May 9, 1902, ch. 783, 32 Stat. 193, (2) Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212; R. S. 4933).

The list of conditions specified in the corresponding section of existing statute is omitted as unnecessary in view of the general inclusion of all conditions applying to other patents. Language is changed.

R. S. 4929. Any person who has invented any new, original, and ornamental design for an article of manufacture, not known or used by others in this country before his invention thereof, and not patented or described in any printed publication in this or any foreign country before his invention thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year 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, the same as in cases of inventions or discoveries covered by section 4886, obtain a patent therefor.

R. S. 4933. All the regulations and provisions which apply to obtaining or protecting patents for inventions or discoveries not inconsistent with the provision of this title, shall apply to patents for designs.

### § 172. Right of priority

The right of priority provided for by section 119 of this title and the time specified in section 102 (d) shall be six months in the case of designs.

SECTION 172—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 32, part (R. S. 4887, amended (1) Mar. 3, 1903, ch. 1019, § 1, 32 Stat. 1225, 1226, (2) June 19, 1936, ch. 594, 49 Stat. 1529, (3) Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212).

This provision is taken from R. S. 4887 (see section 119) and made a separate section.

[See under sections 102 and 119 for text of R. S. 4887].

### § 173. Term of design patent

Patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant, in his application, elects.

SECTION 173—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 77 (R. S. 4931). Language is changed slightly.

R. S. 4931. Patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant may, in his application, elect.

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## CHAPTER 17—SECRECY OF CERTAIN INVENTIONS AND FILING APPLICATIONS IN FOREIGN COUNTRY

Sec.
181. Secrecy of certain inventions and withholding of patent.
182. Abandonment of invention for unauthorized disclosure.
183. Right of compensation.
184. Filing of application in foreign country.
185. Patent barred for filing without license.
186. Penalty.
187. Nonapplicability to certain persons.
188. Rules and regulations, delegation of power.

### § 181. Secrecy of certain inventions and withholding of patent

Whenever publication or disclosure by the grant of a patent on an invention in which the Government has a property interest might, in the opinion of the head of the interested Government agency, be detrimental to the national security, the Commissioner upon being so notified shall order that the invention be kept secret and shall withhold the grant of a patent therefor under the conditions set forth hereinafter.

Whenever the publication or disclosure of an invention by the granting of a patent, in which the Government does not have a property interest, might, in the opinion of the Commissioner, be detrimental to the national security, he shall make the application for patent in which such invention is disclosed available for inspection to the Atomic Energy Commission, the Secretary of Defense, and the chief officer of any other department or agency of the Government designated by the President as a defense agency of the United States.

Each individual to whom the application is disclosed shall sign a dated acknowledgment thereof, which acknowledgment shall be entered in the file of the application. If, in the opinion of the Atomic Energy Commission, the Secretary of a Defense Department, or the chief officer of another department or agency so desig-

nated, the publication or disclosure of the invention by the granting of a patent therefor would be detrimental to the national security, the Atomic Energy Commission, the Secretary of a Defense Department, or such other chief officer shall notify the Commissioner and the Commissioner shall order that the invention be kept secret and shall withhold the grant of a patent for such period as the national interest requires, and notify the applicant thereof. Upon proper showing by the head of the department or agency who caused the secrecy order to be issued that the examination of the application might jeopardize the national interest, the Commissioner shall thereupon maintain the application in a sealed condition and notify the applicant thereof. The owner of an application which has been placed under a secrecy order shall have a right to appeal from the order to the Secretary of Commerce under rules prescribed by him.

An invention shall not be ordered kept secret and the grant of a patent withheld for a period of more than one year. The Commissioner shall renew the order at the end thereof, or at the end of any renewal period, for additional periods of one year upon notification by the head of the department or the chief officer of the agency who caused the order to be issued that an affirmative determination has been made that the national interest continues so to require. An order in effect, or issued, during a time when the United States is at war, shall remain in effect for the duration of hostilities and one year following cessation of hostilities. An order in effect, or issued, during a national emergency declared by the President shall remain in effect for the duration of the national emergency and six months thereafter. The Commissioner may rescind any order upon notification by the heads of the departments and the chief officers of the agencies who caused the order to be issued that the publication or disclosure of the invention is no longer deemed detrimental to the national security.



SECTION 181—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 151 (Feb. 1, 1952, ch. 4, § 1, 66 Stat. 3, 4).

Language is changed.

[See section 4h of the Act for effect of repeal of prior Act corresponding to sections 181-188].

Feb. 1, 1952, ch. 4, § 1, 66 Stat. 3, 4. That whenever publication or disclosure by the grant of a patent or an invention in which the Government has a property interest might, in the opinion of the head of the interested Government agency, be detrimental to the national security, the Secretary of Commerce upon being so notified shall order that the invention be kept secret and shall withhold the grant of a patent therefor under the conditions set forth hereinafter.

Whenever the publication or disclosure of an invention by the granting of a patent, in which the Government does not have a property interest, might, in the opinion of the Secretary of Commerce, be detrimental to the national security, he shall make the application for patent in which such invention is disclosed available for inspection to the Atomic Energy Commission, the Secretary of Defense, and the chief officer of any other department or agency of the Government designated by the President as a defense agency of the United States.

Each individual to whom the application is disclosed shall sign a dated acknowledgment thereof, which acknowledgment shall be entered in the file of the application. If, in the opinion of the Atomic Energy Commission, the Secretary of a Defense Department, or the chief officer of another department or agency so designated, the publication or disclosure of the invention by the granting of a patent therefor would be detrimental to the national security, the Atomic Energy Commission, the Secretary of a Defense Department, or such other chief officer shall notify the Secretary of Commerce and the Secretary of Commerce shall order that the invention be kept secret and shall withhold the grant of a patent for such period as the national interest requires, and notify the applicant thereof. Upon proper showing by the head of the department or agency who caused the secrecy order to be issued that the examination of the application might jeopardize the national interest, the Secretary of Commerce shall thereupon maintain the application in a sealed condition and notify the applicant thereof. The owner of an application which has been placed under a secrecy order shall have a right to appeal from the order to the Secretary of Commerce under rules prescribed by him.

An invention shall not be ordered kept secret and the grant of a patent withheld for a period of not more than one year. The Secretary of Commerce shall renew the order at the end thereof, or at the end of any renewal period, for additional periods of one year upon notification by the head of the department or the chief officer of the agency who caused the order to be issued that an affirmative determination has been made that the national interest continues so to require. An order in effect, or issued, during a time when the United States is at war, shall remain in effect for the duration of hostilities and one year following cessation of hostilities. An order in effect, or issued, during a national emergency declared by the President shall remain in effect for the duration of the national emergency and six months thereafter. The Secretary of Commerce may rescind any order upon notification by the heads of the departments and the chief officers of the agencies who caused the order to be issued that the publication or disclosure of the invention is no longer deemed detrimental to the national security.

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## § 182. Abandonment of invention for unauthorized disclosure

The invention disclosed in an application for patent subject to an order made pursuant to section 181 of this title may be held abandoned upon its being established by the Commissioner that in violation of said order the invention has been published or disclosed or that an application for a patent therefor has been filed in a foreign country by the inventor, his successors, assigns, or legal representatives, or anyone in privity with him or them, without the consent of the Commissioner. The abandonment shall be held to have occurred as of the time of violation. The consent of the Commissioner shall not be given without the concurrence of the heads of the departments and the chief officers of the agencies who caused the order to be issued. A holding of abandonment shall constitute forfeiture by the applicant, his successors, assigns, or legal representatives, or anyone in privity with him or them, of all claims against the United States based upon such invention.

SECTION 182—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 152 (Feb. 1, 1952, ch. 4, § 2, 66 Stat. 4).

Language is changed.

Feb. 1, 1952, ch. 4, § 2, 66 Stat. 4. The invention disclosed in an application for patent subject to an order made pursuant to section 1 hereof may be held abandoned upon its being established by the Secretary of Commerce that in violation of said order the invention has been published or disclosed or that an application for a patent therefor has been filed in a foreign country by the inventor, his successors, assigns, or legal representatives, or anyone in privity with him or them, without the consent of the Secretary of Commerce. The abandonment shall be held to have occurred as of the time of violation. The consent of the Secretary of Commerce shall not be given without the concurrence of the heads of the departments and the chief officers of the agencies who caused the order to be issued. A holding of abandonment shall constitute forfeiture by the applicant, his successors, assigns, or legal representatives, or anyone in privity with him or them, of all claims against the United States based upon such invention.

## § 183. Right to compensation

An applicant, his successors, assigns, or legal representatives, whose patent is withheld as herein provided, shall have the right, beginning at the date the applicant is



notified that, except for such order, his application is otherwise in condition for allowance, or February 1, 1952, whichever is later, and ending six years after a patent is issued thereon, to apply to the head of any department or agency who caused the order to be issued for compensation for the damage caused by the order of secrecy and/or for the use of the invention by the Government, resulting from his disclosure. The right to compensation for use shall begin on the date of the first use of the invention by the Government. The head of the department or agency is authorized, upon the presentation of a claim, to enter into an agreement with the applicant, his successors, assigns, or legal representatives, in full settlement for the damage and/or use. This settlement agreement shall be conclusive for all purposes not withstanding any other provision of law to the contrary. If full settlement of the claim cannot be effected, the head of the department or agency may award and pay to such applicant, his successors, assigns, or legal representatives, a sum not exceeding 75 per centum of the sum which the head of the department or agency considers just compensation for the damage and/or use. A claimant may bring suit against the United States in the Court of Claims or in the District Court of the United States for the district in which such claimant is a resident for an amount which when added to the award shall constitute just compensation for the damage and/or use of the invention by the Government. The owner of any patent issued upon an application that was subject to a secrecy order issued pursuant to section 181 of this title, who did not apply for compensation as above provided, shall have the right, after the date of issuance of such patent, to bring suit in the Court of Claims for just compensation for the damage caused by reason of the order of secrecy and/or use by the Government of the invention resulting from his disclosure. The right to compensation for use shall begin on the date of the first use of the invention by the Government. In a suit under the provisions of this section the United States may

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avail itself of all defenses it may plead in an action under section 1498 of title 28. This section shall not confer a right of action on anyone or his successors, assigns, or legal representatives who, while in the full-time employment or service of the United States, discovered, invented, or developed the invention on which the claim is based.

SECTION 183—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 153 (Feb. 1, 1952, ch. 4, § 3, 66 Stat. 4, 5).

Language is changed.

Feb. 1, 1952, ch. 4, § 3, 66 Stat. 4, 5. An applicant, his successors, assigns, or legal representatives, whose patent is withheld as herein provided, shall have the right, beginning at the date the applicant is notified that, except for such order, his application is otherwise in condition for allowance, or the effective date of this Act, whichever is later, and ending six years after a patent is issued thereon, to apply to the head of any department or agency who caused the order to be issued for compensation for the damage caused by the order of secrecy and/or for the use of the invention by the Government resulting from his disclosure. The right to compensation for use shall begin on the date of the first use of the invention by the Government. The head of the department or agency is authorized, upon the presentation of claim, to enter into an agreement with the applicant, his successors, assigns, or legal representatives, in full settlement for the damage and/or use. This settlement agreement shall be conclusive for all purposes notwithstanding any other provision of law to the contrary. If full settlement of the claim cannot be effected, the head of the department or agency may award and pay to such applicant, his successors, assigns, or legal representatives, a sum not exceeding 75 per centum of the sum which the head of the department or agency considers just compensation for the damage and/or use. A claimant may bring suit against the United States in the Court of Claims or in the District Court of the United States for the district in which such claimant is a resident for an amount which when added to the award shall constitute just compensation for the damage and/or use of the invention by the Government. The owner of any patent issued upon an application that was subject to a secrecy order issued pursuant to section 1 hereof, who did not apply for compensation as above provided, shall have the right, after the date of issuance of such patent, to bring suit in the Court of Claims for just compensation for the damage caused by reason of the order of secrecy and/or use by the Government of the invention resulting from his disclosure. The right to compensation for use shall begin on the date of the first use of the invention by the Government. In a suit under the provisions of this section, and in negotiations concerning settlement of a claim, the United States may avail itself of all defenses it may plead in an action under title 28, United States Code, section 1498, as amended. This section shall not confer a right of action on anyone or his successors, assigns, or legal representatives who, while in the full-time employment or service of the United States, discovered, invented, or developed the invention on which the claim is based.



## § 184. Filing of application in foreign country

Except when authorized by a license obtained from the Commissioner a person shall not file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States an application for patent or for the registration of a utility model, industrial design, or model in respect of an invention made in this country. A license shall not be granted with respect to an invention subject to an order issued by the Commissioner pursuant to section 181 of this title without the concurrence of the head of the departments and the chief officers of the agencies who caused the order to be issued. The license may be granted retroactively where an application has been inadvertently filed abroad and the application does not disclose an invention within the scope of section 181 of this title.

The term "application" when used in this chapter includes applications and any modifications, amendments, or supplements thereto, or divisions thereof.

SECTION 184—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 154 (Feb. 1, 1952, ch. 4, § 4, 66 Stat. 5).

Language is changed.

Feb. 1, 1952, ch. 4, § 4, 66 Stat. 5. Except when authorized by a license obtained from the Secretary of Commerce a person shall not file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States an application for patent or for the registration of a utility model, industrial design, or model in respect of an invention made in this country. A license shall not be granted with respect to an invention subject to an order issued by the Secretary of Commerce pursuant to section 1 hereof without the concurrence of the head of the departments and the chief officers of the agencies who caused the order to be issued. The license may be granted retroactively where an application has been inadvertently filed abroad and the application does not disclose an invention within the categories prescribed under section 1 hereof.

The term "application" when used in this Act includes applications and any modifications, amendments, or supplements thereto, or divisions thereof.

## § 185. Patent barred for filing without license

Notwithstanding any other provisions of law any person, and his successors, assigns, or legal representatives, shall not receive a United States patent for an invention if that person, or his successors, assigns, or

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legal representatives shall, without procuring the license prescribed in section 184 of this title, have made, or consented to or assisted another's making, application in a foreign country for a patent or for the registration of a utility model, industrial design, or model in respect of the invention. A United States patent issued to such person, his successors, assigns, or legal representatives shall be invalid.

SECTION 185—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 155 (Feb. 1, 1952, ch. 4, § 5, 66 Stat. 5).
Language is changed.

Feb. 1, 1952, ch. 4, § 5, 66 Stat. 5. Notwithstanding any other provisions of law any person, and his successors, assigns, or legal representatives, shall not receive a United States patent for an invention if that person, or his successors, assigns, or legal representatives shall, without procuring the license prescribed in section 4 hereof, have made, or consented to or assisted another's making, application in a foreign country for a patent or for the registration of a utility model, industrial design, or model in respect of the invention. A United States patent issued to such person, his successors, assigns, or legal representatives shall be invalid.

## § 186. Penalty

Whoever, during the period or periods of time an invention has been ordered to be kept secret and the grant of a patent thereon withheld pursuant to section 181 of this title, shall, with knowledge of such order and without due authorization, willfully publish or disclose or authorize or cause to be published or disclosed the invention, or material information with respect thereto, or whoever, in violation of the provisions of section 184 of this title, shall file or cause or authorize to be filed in any foreign country an application for patent or for the registration of a utility model, industrial design, or model in respect of any invention made in the United States, shall, upon conviction, be fined not more than $10,000 or imprisoned for not more than two years, or both.

SECTION 186—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 156 (Feb. 1, 1952, ch. 4, § 6, 66 Stat. 5, 6).
Language is changed.



Feb. 1, 1952, ch. 4, § 6, 66 Stat. 5, 6. Whoever, during the period or periods of time an invention has been ordered to be kept secret and the grant of a patent thereon withheld pursuant to section 1 hereof, shall, with knowledge of such order and without due authorization, willfully publish or disclose or authorize or cause to be published or disclosed the invention, or material information with respect thereto, or whoever, in violation of the provisions of section 4 hereof, shall file or cause or authorize to be filed in any foreign country an application for patent or for the registration of a utility model, industrial design, or model in respect of any invention made in the United States, shall, upon conviction, be fined not more than $10,000 or imprisoned for not more than two years, or both.

## § 187. Nonapplicability to certain persons

The prohibitions and penalties of this chapter shall not apply to any officer or agent of the United States acting within the scope of his authority, nor to any person acting upon his written instructions or permission.

SECTION 187—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 157 (Feb. 1, 1952, ch. 4, § 7, 66 Stat. 6).
Language is changed.

Feb. 1, 1952, ch. 4, § 7, 66 Stat. 6. The prohibitions and penalties of this Act shall not apply to any officer or agent of the United States acting within the scope of his authority, nor to any person acting upon his written instructions or permission.

## § 188. Rules and regulations, delegation of power

The Atomic Energy Commission, the Secretary of a defense department, the chief officer of any other department or agency of the Government designated by the President as a defense agency of the United States, and the Secretary of Commerce, may separately issue rules and regulations to enable the respective departments or agency to carry out the provisions of this chapter, and may delegate any power conferred by this chapter.

SECTION 188—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 158 (Feb. 1, 1952, ch. 4, § 8, 66 Stat. 6).
Language is changed.

Feb. 1, 1952, ch. 4, § 8, 66 Stat. 6. The Atomic Energy Commission, the Secretary of a defense department, the chief officer of any other department or agency of the Government designated by the President as a defense agency of the United States, and the Secretary of Commerce, may separately issue rules and regulations to enable the respective department or agency to carry out the provisions of this Act, and may delegate any power conferred by this Act.

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## CHAPTER 25—AMENDMENT AND CORRECTION OF PATENTS

Sec.
251. Reissue of defective patents.
252. Effect of reissue.
253. Disclaimer.
254. Certificate of correction of Patent Office mistake.
255. Certificate of correction of applicant's mistake.
256. Misjoinder of inventor.

### § 251. Reissue of defective patents

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Commissioner may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissue patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

SECTION 251—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 64 (R. S. 4916, amended May 24, 1928, ch. 730, 45 Stat. 732).



The sentences of the corresponding section of existing statute are rearranged and divided into two sections with some changes in language. The clause at the end of the present statute is omitted as obsolete.

The third paragraph incorporates by reference the requirements of other applications, and adds a new provision relating to application for reissue being made in certain cases by the assignee.

A two year period of limitation on applying for broadened reissues is added, codifying the present rule of decision with a fixed period.

R. S. 4916. Whenever any patent is wholly or partly inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a patent for the same invention, and in accordance with the corrected specification, to be reissued to the patentee or to his assigns or legal representatives, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the reissued patent, but in so far as the claims of the original and reissued patents are identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent to the extent that its claims are identical with the original patent shall constitute a continuation thereof and have effect continuously from the date of the original patent. The commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters-patent. The specifications and claims in every such case shall be subject to revision and restriction in the same manner as original applications are. Every patent so reissued, together with the corrected specifications, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; but no new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid.

### § 252. Effect of reissue

The surrender of the original patent shall take effect upon the issue of the reissued patent, and every reissued patent shall have the same effect and operation in law, on the trial of actions for causes thereafter arising, as if the same had been originally granted in such amended form, but in so far as the claims of the original and reissued patents are identical, such surrender shall not

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affect any action then pending nor abate any cause of action then existing, and the reissued patent, to the extent that its claims are identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent.

No reissued patent shall abridge or affect the right of any person or his successors in business who made, purchased or used prior to the grant of a reissue anything patented by the reissued patent, to continue the use of, or to sell to others to be used or sold, the specific thing so made, purchased or used, unless the making, using or selling of such thing infringes a valid claim of the reissued patent which was in the original patent. The court before which such matter is in question may provide for the continued manufacture, use or sale of the thing made, purchased or used as specified, or for the manufacture, use or sale of which substantial preparation was made before the grant of the reissue, and it may also provide for the continued practice of any process patented by the reissue, practiced, or for the practice of which substantial preparation was made, prior to the grant of the reissue, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before the grant of the reissue.

SECTION 252—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 64 (R. S. 4916, amended May 24, 1928, ch. 730, 45 Stat. 732).

The first paragraph follows the present section with some rearrangement in language. The second paragraph adds new provisions for the protection of intervening rights, the court is given discretion to protect legitimate activities which would be adversely affected by the grant of a reissue and things made before the grant of the reissue are not subject to the reissue unless a claim of the original patent which is repeated in the reissue is infringed.

[See under section 251 for text of R. S. 4916].



## § 253. Disclaimer

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, and recorded in the Patent Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

SECTION 253—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 65 (R. S. 4917).

Language is changed and substantive changes are introduced; (1) only a claim as a whole may be disclaimed, and (2) the provision regarding delay is omitted. See preliminary general description of bill.

See section 288.

The second paragraph is new and provides for the disclaiming or dedication of an entire patent, or any terminal part of the term, for example, a patentee may disclaim the last three years of the term of his patent.

R. S. 4917. Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it.

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## § 254. Certificate of correction of Patent Office mistake

Whenever a mistake in a patent, incurred through the fault of the Patent Office, is clearly disclosed by the records of the Office, the Commissioner may issue a certificate of correction stating the fact and nature of such mistake, under seal, without charge, to be recorded in the records of patents. A printed copy thereof shall be attached to each printed copy of the patent, and such certificate shall be considered as part of the original patent. Every such patent, together with such certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form. The Commissioner may issue a corrected patent without charge in lieu of and with like effect as a certificate of correction.

SECTION 254—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 88 (Mar. 4, 1925, ch. 535, § 1, 43 Stat. 1268).

The last sentence of the present section is omitted as obsolete. A sentence is added similar to a provision in the corresponding section in the trade-mark law, 15 U. S. C., 1946 ed., § 1057 (f), and provides that the Commissioner may issue a corrected patent instead of a certificate of correction.

Mar. 4, 1925, ch. 535, § 1, 43 Stat. 1268. That whenever a mistake in a patent or a trade-mark registration, incurred through the fault of the Patent Office, is clearly disclosed by the records or files of the office, a certificate, stating the fact and nature of such mistake, signed by the Commissioner of Patents and sealed with the seal of the Patent Office, may be issued, without charge, and recorded in the records of patents or trade-marks, and a printed copy thereof attached to each printed copy of the patent or trade-mark registration, and such certificate shall thereafter be considered as part of the original, and every patent or trade-mark registration, together with such certificate, shall have the same effect and operation in law on the trial of all actions for causes thereafter arising as if the same had been originally issued in such corrected form. All such certificates heretofore issued in accordance with the rules of the Patent Office and the patents or trade-mark registrations to which they are attached shall have the same force and effect as if such certificates had been specifically authorized by statute.

## § 255. Certificate of correction of applicant's mistake

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault



of the Patent Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Commissioner may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require re-examination. Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form.

SECTION 255—NEW SECTION

This section providing for the correction of minor clerical errors made by the applicant, is new and follows a similar provision in the trade-mark law, 15 U. S. C., 1946 ed., § 1057 (g).

## § 256. Misjoinder of inventor

Whenever a patent is issued on the application of persons as joint inventors and it appears that one of such persons was not in fact a joint inventor, and that he was included as a joint inventor by error and without any deceptive intention, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate deleting the name of the erroneously joined person from the patent.

Whenever a patent is issued and it appears that a person was a joint inventor, but was omitted by error and without deceptive intention on his part, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate adding his name to the patent as a joint inventor.

The misjoinder or nonjoinder of joint inventors shall not invalidate a patent, if such error can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Commissioner shall issue a certificate accordingly.

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SECTION 256—NEW SECTION

This section is new and is companion to section 116.

The first two paragraphs provide for the correction of the inadvertent joining or nonjoining of a person as a joint inventor. The third paragraph provides that a patent shall not be invalid for such cause, and also provides that a court may order correction of a patent; the two sentences of this paragraph are independent.

## CHAPTER 26—OWNERSHIP AND ASSIGNMENT

Sec.
261. Ownership; assignment.
262. Joint owners.

### § 261. Ownership; assignment

Subject to the provisions of this title, patents shall have the attributes of personal property.

Applications for patent, patents, or any interest therein, shall be assignable in law by an instrument in writing. The applicant, patentee, or his assigns or legal representatives may in like manner grant and convey an exclusive right under his application for patent, or patents, to the whole or any specified part of the United States.

A certificate of acknowledgment under the hand and official seal of a person authorized to administer oaths within the United States, or, in a foreign country, of a diplomatic or consular officer of the United States or an officer authorized to administer oaths whose authority is proved by a certificate of a diplomatic or consular officer of the United States, shall be prima facie evidence of the execution of an assignment, grant or conveyance of a patent or application for patent.

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 its date or prior to the date of such subsequent purchase or mortgage.



SECTION 261—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 47 (R. S. 4898, amended (1) Mar. 3, 1897, ch. 391, § 5, 29 Stat. 93, (2) Feb. 18, 1922, ch. 58, § 6, 42 Stat. 391, (3) Aug. 18, 1941, ch. 370, 55 Stat. 634).

The first paragraph is new but is declaratory only. The second paragraph is the same as in the corresponding section of existing statute. The third paragraph is from the existing statute, a specific reference to another statute is omitted. The fourth paragraph is the same as the existing statute but language has been changed.

R. S. 4898. Every application for patent or patent or any interest therein shall be assignable in law by an instrument in writing, and the applicant or patentee or his assigns or legal representatives may, in like manner, grant and convey an exclusive right under his application for patent or 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 or prior to such subsequent purchase or mortgage.

If any such assignment, grant, or conveyance of any application for patent or patent shall be acknowledged before any notary public of the several States or Territories or the District of Columbia, or any commissioner of any court of the United States for any district or Territory, or before any secretary of legation or consular officer authorized to administer oaths or perform notarial acts under section 1750 of the Revised Statutes (U. S. C., title 22, sec. 131) the certificate of such acknowledgment, under the hand and official seal of such notary or other officer, shall be prima facie evidence of the execution of such assignment, grant or conveyance.

### § 262. Joint owners

In the absence of any agreement to the contrary, each of the joint owners of a patent may make, use or sell the patented invention without the consent of and without accounting to the other owners.

SECTION 262—NEW SECTION

This section states a condition in existing law not expressed in the existing statutes.

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## CHAPTER 27—GOVERNMENT INTERESTS IN PATENTS

Sec.
266. Issue of patents without fees to Government employees.
267. Time for taking action in Government applications.

### § 266. Issue of patent without fees to Government employees

The Commissioner may grant, subject to the provisions of this title, to any officer, enlisted man, or employee of the Government, except officers and employees of the Patent Office, a patent without the payment of fees, when the head of a department or agency certifies the invention is used or likely to be used in the public interest and the applicant in his application states that the invention described therein, if patented, may be manufactured and used by or for the Government for governmental purposes without the payment to him of any royalty thereon, which stipulation shall be included in the patent.

SECTION 266—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 45 (Mar. 3, 1883, ch. 143, 22 Stat. 625, amended April 30, 1928, ch. 460, 45 Stat. 467).

Changes in language are made. The omission of the specific reference to 35 U. S. C., 1946 ed., § 31, (R. S. 4886) broadens the section so as to include design patents.

Mar. 3, 1883, ch. 143, 22 Stat. 625 as amended April 30, 1928, ch. 460, 45 Stat. 467. The Commissioner of Patents is authorized to grant, subject to existing law, to any officer, enlisted man, or employee of the Government, except officers and employees of the Patent Office, a patent for any invention of the classes mentioned in section 4886 of the Revised Statutes, without the payment of any fee when the head of the department or independent bureau certifies such invention is used or liable to be used in the public interest: *Provided*, That the applicant in his application shall state that the invention described therein, if patented, may be manufactured and used by or for the Government for governmental purposes without the payment to him of any royalty thereon, which stipulation shall be included in the patent.

### § 267. Time for taking action in Government applications

Notwithstanding the provisions of sections 133 and 151 of this title, the Commissioner may extend the time for taking any action to three years, when an application has become the property of the United States and the head of the appropriate department or agency of the Government has certified to the Commissioner that the invention disclosed therein is important to the armament or defense of the United States.



SECTION 267—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 37 (R. S. 4894, amended (1) Mar. 3, 1897, ch. 391, § 4, 29 Stat. 692, 693, (2) July 6, 1916, ch. 225, § 1, 39 Stat. 345, 347-8, (3) Mar. 2, 1927, ch. 273, § 1, 44 Stat. 1335, (4) Aug. 7, 1939, ch. 568, 53 Stat. 1264).

This provision, which appears as the last two sentences of the corresponding section of the present statute (see note to section 133) is made a separate section and rewritten in simpler form.

[See under section 133 for text of R. S. 4894].

## CHAPTER 28—INFRINGEMENT OF PATENTS

Sec.
271. Infringement of patent.
272. Temporary presence in the United States.

### § 271. Infringement of patent

(a) Except as otherwise provided in this title, whoever without authority makes, uses or sells any patented invention, within the United States during the term of the patent therefor, infringes the patent.

(b) Whoever actively induces infringement of a patent shall be liable as an infringer.

(c) Whoever sells a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.

(d) No patent owner otherwise entitled to relief for infringement or contributory infringement of a patent shall be denied relief or deemed guilty of misuse or illegal extension of the patent right by reason of his having

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done one or more of the following: (1) derived revenue from acts which if performed by another without his consent would constitute contributory infringement of the patent; (2) licensed or authorized another to perform acts which if performed without his consent would constitute contributory infringement of the patent; (3) sought to enforce his patent rights against infringement or contributory infringement.

SECTION 271—NEW SECTION

The first paragraph of this section is declaratory only, defining infringement.

Paragraphs (b) and (c) define and limit contributory infringement of a patent and paragraph (d) is ancillary to these paragraphs, see preliminary general description of bill. One who actively induces infringement as by aiding and abetting the same is liable as an infringer, and so is one who sells a component part of a patented invention or material or apparatus for use therein knowing the same to be especially made or especially adapted for use in the infringement of the patent except in the case of a staple article or commodity of commerce having other uses. A patentee is not deemed to have misused his patent solely by reason of doing anything authorized by the section.

### § 272. Temporary presence in the United States

The use of any invention in any vessel, aircraft or vehicle of any country which affords similar privileges to vessels, aircraft or vehicles of the United States, entering the United States temporarily or accidentally, shall not constitute infringement of any patent, if the invention is used exclusively for the needs of the vessel, aircraft or vehicle and is not sold in or used for the manufacture of anything to be sold in or exported from the United States.

SECTION 272—NEW SECTION

This section follows the requirement of the International Convention for the Protection of Industrial Property, to which the United States is a party, and also codifies the holding of the Supreme Court that use of a patented invention on board a foreign ship does not infringe a patent.



## CHAPTER 29—REMEDIES FOR INFRINGEMENT OF PATENT, AND OTHER ACTIONS

Sec.
281. Remedy for infringement of patent.
282. Presumption of validity; defenses.
283. Injunction.
284. Damages.
285. Attorney fees.
286. Time limitation on damages.
287. Limitation on damages; marking and notice.
288. Action for infringement of a patent containing an invalid claim.
289. Additional remedy for infringement of design patent.
290. Notice of patent suits.
291. Interfering patents.
292. False marking..
293. Nonresident patentee, service and notice.

### § 281. Remedy for infringement of patent

A patentee shall have remedy by civil action for infringement of his patent.

SECTION 281—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § § 67 and 70, part (R. S. 4919; R. S. 4921, amended (1) Mar. 3, 1897, ch. 391, § 6, 29 Stat. 694, (2) Feb. 18, 1922, ch. 58, § 8, 42 Stat. 392, (3) Aug. 1, 1946, ch. 726, § 1, 60 Stat. 778).

The corresponding two sections of existing law are divided among sections 281, 283, 284, 285, 286 and 289 with some changes in language. Section 241 [9] serves as an introduction or preamble to the following sections, the modern term civil action is used, there would be, of course, a right to a jury trial when no injunction is sought.

R. S. 4919. Damages for the infringement of any patent may be recovered by action on the case, in the name of the party interested, either as patentee, assignee, or grantee. And whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment thereon for any sum above the amount found by the verdict as the actual damages sustained, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs.

R. S. 4921. The several courts vested with jurisdiction of cases arising under the patent laws shall have power to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable; and upon a judgment being rendered in any case for an infringement

[9] The Senate Report states 281 which is the correct number.

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the complainant shall be entitled to recover general damages which shall be due compensation for making, using, or selling the invention, not less than a reasonable royalty therefor, together with such costs, and interest, as may be fixed by the court. The court may in its discretion award reasonable attorney's fees to the prevailing party upon the entry of judgment on any patent case.

The court is authorized to receive expert or opinion evidence upon which to determine in conjunction with any other evidence in the record, due compensation for making, using, or selling the invention, and such expert or opinion evidence is declared to be competent and admissible subject to the general rules of evidence applicable thereto.

The court shall assess said damages, or cause the same to be assessed, under its direction and shall have the same power to increase the assessed damages, in its discretion, as is given to increase the damages found by verdicts in actions in the nature of actions of trespass upon the case; but recovery shall not be had for any infringement committed more than six years prior to the filing of the complaint in the action. And it shall be the duty of the clerks of such courts within one month after the filing of any action, suit, or proceeding arising under the patent laws to give notice thereof in writing to the Commissioner of Patents, setting forth in order so far as known the names and addresses of the litigants, names of the inventors, and the designating number or numbers of the patent or patents upon which the action, suit, or proceeding has been brought, and in the event any other patent or patents be subsequently included in the action, suit, or proceeding by amendment, answer, cross bill, or other pleading, the clerk shall give like notice thereof to the Commissioner of Patents, and within one month after the decision is rendered or a judgment issued the clerk of the court shall give notice thereof to the Commissioner of Patents, and it shall be the duty of the Commissioner of Patents on receipt of such notice forthwith to endorse the same upon the file wrapper of the said patent or patents, and to incorporate the same as a part of the contents of said file or file wrapper.

This Act shall take effect upon approval and shall apply to pending causes of action in which the taking of the testimony has not been concluded: *Provided, however,* That pending causes of action in which the taking of the testimony has been concluded are to be governed by the statute in force at the time of approval of this Act if such statute had not been amended.

## § 282. Presumption of validity; defenses

A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it.

The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

(1) Noninfringement, absence of liability for infringement, or unenforceability,

(2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability,



(3) Invalidity of the patent or any claim in suit for failure to comply with any requirement of section 112 or 251 of this title,

(4) Any other fact or act made a defense by this title.

In actions involving the validity or infringement of a patent the party asserting invalidity or noninfringement shall give notice in the pleadings or otherwise in writing to the adverse party at least thirty days before the trial, of the country, number, date, and name of the patentee of any patent, the title, date, and page numbers of any publication to be relied upon as anticipation of the patent in suit or, except in actions in the United States Court of Claims, as showing the state of the art, and the name and address of any person who may be relied upon as the prior inventor or as having prior knowledge of or as having previously used or offered for sale the invention of the patent in suit. In the absence of such notice proof of the said matters may not be made at the trial except on such terms as the court requires.

### Section 282—Section Revised

Derived from title 35, U. S. C., 1946 ed., § 69, (R. S. 4920, amended (1) Mar. 3, 1897, ch. 391, § 2, 29 Stat. 692, (2) Aug. 5, 1939, ch. 450, § I, 53 Stat. 1212).

The first paragraph declares the existing presumption of validity of patents.

The five defenses named in R. S. 4920 are omitted and replaced by a broader paragraph specifying defenses in general terms.

The third paragraph, relating to notice of prior patents, publications and uses, is based on part of the last paragraph of R. S. 4920 which was superseded by the Federal Rules of Civil Procedure but which is reinstated with modifications.

[As passed by the House, item (1) read "Noninfringement or absence of liability for infringement," which was amended by the Senate].

R. S. 4920. In any action for infringement the defendant may plead the general issue, and, having given notice in writing to the plaintiff or his attorney thirty days before, may prove on trial any one or more of the following special matters:

First. That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect; or,

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Second. That he had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; or,

Third. That it has been patented or described in some printed publication prior to his supposed invention or discovery thereof, or more than one year prior to his application for a patent therefor; or,

Fourth. That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; or,

Fifth. That it had been in public use or on sale in this country for more than one year before his application for a patent, or had been abandoned to the public.

And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of the patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented or to have had the prior knowledge of the thing patented, and where and by whom it had been used; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defenses may be pleaded in any suit in equity for relief against an alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect.

## § 283. Injunction

The several courts having jurisdiction of cases under this title may grant injunctions in accordance with the principles of equity to prevent the violation of any right secured by patent, on such terms as the court deems reasonable.

SECTION 283—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 70, part (R. S. 4921, amended (1) Mar. 3, 1897, ch. 391, § 6, 29 Stat. 694, (2) Feb. 18, 1922, ch. 58, § 8, 42 Stat. 392, (3) Aug. 1, 1946, ch. 726, § 1, 60 Stat. 778).

This section is the same as the provision which opens R. S. 4921 with minor changes in language.

[See under section 281 for text of R. S. 4921].

## § 284. Damages

Upon finding for the claimant the court shall award the claimant damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court.

When the damages are not found by a jury, the court shall assess them. In either event the court may increase the damages up to three times the amount found or assessed.



The court may receive expert testimony as an aid to the determination of damages or of what royalty would be reasonable under the circumstances.

SECTION 284—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § § 67 and 70, part (R. S. 4919; R. S. 4921, amended (1) Mar. 3, 1897, ch. 391, § 6, 29 Stat. 694, (2) Feb. 18, 1922, ch. 58, § 8, 42 Stat. 392, (3) Aug. 1, 1946, ch. 726, § 1, 60 Stat. 778).

This section consolidates the provisions relating to damages in R. S. 4919 and 4921, with some changes in language.

[As passed by the House the opening clause read "Upon adjudging a patent valid and infringed," which was amended by the Senate].

[See under section 281 for text of R. S. 4919 and 4921].

## § 285. Attorney fees

The court in exceptional cases may award reasonable attorney fees to the prevailing party.

SECTION 285—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 70, part (R. S. 4921, amended (1) Mar. 3, 1897, ch. 391, § 6, 29 Stat. 694, (2) Feb. 18, 1922, ch. 58, § 8, 42 Stat. 392, (3) Aug. 1, 1946, ch. 726, § 1, 60 Stat. 778).

This section is substantially the same as the corresponding provision in R. S. 4921; "in exceptional cases" has been added as expressing the intention of the present statute as shown by its legislative history and as interpreted by the courts.

[See under section 281 for text of R. S. 4921].

## § 286. Time limitation on damages

Except as otherwise provided by law, no recovery shall be had for any infringement committed more than six years prior to the filing of the complaint or counterclaim for infringement in the action.

In the case of claims against the United States Government for use of a patented invention, the period before bringing suit, up to six years, between the date of receipt of a written claim for compensation by the department or agency of the Government having authority to settle such claim, and the date of mailing by the Government

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of a notice to the claimant that his claim has been denied shall not be counted as part of the period referred to in the preceding paragraph.

SECTION 286—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 70, part (R. S. 4921, amended (1) Mar. 3, 1897, ch. 391, § 6, 29 Stat. 694, (2) Feb. 18, 1922, ch. 58, § 8, 42 Stat. 392, (3) Aug. 1, 1946, ch. 726, § 1, 60 Stat. 778).

The first paragraph is the same as the provision in R. S. 4921 with minor changes in language, with the added provision relating to the date for counterclaims for infringement.

The second paragraph is new and relates to extending the period of limitations with respect to suits in the Court of Claims in certain instances when administrative consideration is pending.

[See under section 281 for text of R. S. 4921].

## § 287. Limitation on damages; marking and notice

Patentees, and persons making or selling any patented article for or under them, may give notice to the public that the same is patented, either by fixing thereon the word "patent" or the abbreviation "pat.", together with the number of the patent, or when, from the character of the article, this can not be done, by fixing to it, or to the package wherein one or more of them is contained, a label containing a like notice. In the event of failure so to mark, no damages shall be recovered by the patentee in any action for infringement, except on proof that the infringer was notified of the infringement and continued to infringe thereafter, in which event damages may be recovered only for infringement occurring after such notice. Filing of an action for infringement shall constitute such notice.

SECTION 287—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 49 (R. S. 4900, amended Feb. 7, 1927, ch. 67, 44 Stat. 1058):

Language is changed. The proviso in the corresponding section of existing statute is omitted as being temporary in character and now obsolete.



R. S. 4900. It shall be the duty of all patentees and their assigns and legal representatives, and of all persons making or vending any patented article for or under them, to give sufficient notice to the public that the same is patented; either by fixing thereon the word "patent," together with the number of the patent, or when, from the character of the article, this can not be done, by fixing to it, or to the package wherein one or more of them is inclosed, a label containing the like notice: *Provided, however*, That with respect to any patent issued prior to April 1, 1927, it shall be sufficient to give such notice in the form following, viz: *"Patented,"* together with the day and year the patent was granted; and in any suit for infringement by the party failing so to mark, no damages shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement and continued, after such notice, to make, use, or vend the article so patented.

## § 288. Action for infringement of a patent containing an invalid claim

Whenever, without deceptive intention, a claim of a patent is invalid, an action may be maintained for the infringement of a claim of the patent which may be valid. The patentee shall recover no costs unless a disclaimer of the invalid claim has been entered at the Patent Office before the commencement of the suit.

SECTION 288—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 71 (R. S. 4922).

The necessity for a disclaimer to recover on valid claims is eliminated. See section 253.

Language is changed.

R. S. 4922. Whenever, through inadvertence, accident, or mistake and without any willful default or intent to defraud or mislead the public, a patentee has, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof, which was bona fide his own, if it is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right, notwithstanding the specifications may embrace more than that of which the patentee was the first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff no costs shall be recovered unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit. But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer.

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## § 289. Additional remedy for infringement of design patent

Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit, but not less than $250, recoverable in any United States district court having jurisdiction of the parties.

Nothing in this section shall prevent, lessen, or impeach any other remedy which an owner of an infringed patent has under the provisions of this title, but he shall not twice recover the profit made from the infringement.

SECTION 289—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., §§ 74, 75 (Feb. 4, 1887, ch. 105, §§ 1, 2, 24 Stat. 387, 388).

Language is changed.

Feb. 4, 1887, ch. 105, §§ 1 and 2, 24 Stat. 387. Hereafter, during the term of letters patent for a design, it shall be unlawful for any person other than the owner of said letters patent, without the license of such owner, to apply the design secured by such letters patent, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or to sell or expose for sale any article of manufacture to which such design or colorable imitation shall, without the license of the owner, have been applied, knowing that the same has been so applied. Any person violating the provisions, or either of them, of this section, shall be liable in the amount of two hundred and fifty dollars; and in case the total profit made by him from the manufacture or sale, as aforesaid, of the article or articles to which the design, or colorable imitation thereof, has been applied, exceeds the sum of two hundred and fifty dollars, he shall be further liable for the excess of such profit over and above the sum of two hundred and fifty dollars; and the full amount of such liability may be recovered by the owner of the letters patent, to his own use, in any circuit court of the United States having jurisdiction of the parties, either by action at law or upon a bill in equity for an injunction to restrain such infringement.

Sec. 2. That nothing in this Act contained shall prevent, lessen, impeach or avoid any remedy at law or in equity which any owner of letters patent for a design, aggrieved by the infringement of the same might have had if this act had not been passed; but such owner shall not twice recover the profit made from the infringement.



## § 290. Notice of patent suits

The clerks of the courts of the United States, within one month after the filing of an action under this title shall give notice thereof in writing to the Commissioner, setting forth so far as known the names and addresses of the parties, name of the inventor, and the designating number of the patent upon which the action has been brought. If any other patent is subsequently included in the action he shall give like notice thereof. Within one month after the decision is rendered or a judgment issued the clerk of the court shall give notice thereof to the Commissioner. The Commissioner shall, on receipt of such notices, enter the same in the file of such patent.

SECTION 290—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 70, part (R. S. 4921, amended (1) Mar. 3, 1897, ch. 391, § 6, 29 Stat. 694, (2) Feb. 18, 1922, ch. 58, § 8, 42 Stat. 392, (3) Aug. 1, 1946, ch. 726, § 1, 60 Stat. 778).

This is the last sentence of R. S. 4921, third paragraph, with minor changes in language.

[See under section 281 for text of R. S. 4921].

## § 291. Interfering patents

The owner of an interfering patent may have relief against the owner of another by civil action, and the court may adjudge the question of the validity of any of the interfering patents, in whole or in part. The provisions of the second paragraph of section 146 of this title shall apply to actions brought under this section.

SECTION 291—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 66 (R. S. 4918, amended Mar. 2, 1927, ch. 273, § 12, 44 Stat. 1337).

Language is changed.

R. S. 4918. Whenever there are interfering patents, any person interested in any one of them, or in the working of the invention claimed under either of them, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either or both of the patents void in whole or in part, upon any

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ground or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the right of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment.

## § 292. False marking

(a) Whoever, without the consent of the patentee, marks upon, or affixes to, or uses in advertising in connection with anything made, used, or sold by him, the name or any imitation of the name of the patentee, the patent number, or the words "patent," "patentee," or the like, with the intent of counterfeiting or imitating the mark of the patentee, or of deceiving the public and inducing them to believe that the thing was made or sold by or with the consent of the patentee; or

Whoever marks upon, or affixes to, or uses in advertising in connection with any unpatented article, the word "patent" or any word or number importing that the same is patented, for the purpose of deceiving the public; or

Whoever marks upon, or affixes to, or uses in advertising in connection with any article, the words "patent applied for," "patent pending," or any word importing that an application for patent has been made, when no application for patent has been made, or if made, is not pending, for the purpose of deceiving the public—

Shall be fined not more than $500 for every such offense.

(b) Any person may sue for the penalty, in which event one-half shall go to the person suing and the other to the use of the United States.

SECTION 292—SECTION REVISED

Based on title 35, U. S. C., 1946 ed., § 50 (R. S. 4901).

This is a criminal provision. The first two paragraphs of the corresponding section of existing statute are consolidated, a new paragraph relating to false marking of "patent applied for" is added, and false advertising is included in all the offenses. The miuimum fine, which has been interpreted by the courts as a maximum, is replaced by a higher maximum. The informer action is included as additional to an ordinary criminal action.



R. S. 4901. Every person who, in any manner, marks upon anything made, used, or sold by him for which he has not obtained a patent, the name or any imitation of the name of any person who has obtained a patent therefor without the consent of such patentee, or his assigns or legal representatives; or

Who, in any manner, marks upon or affixes to any such patented article the word "patent" or "patentee," or the words "letters patent" or any word of like import, with intent to imitate or counterfeit the mark or device of the patentee, without having the license or consent of such patentee or his assigns or legal representatives; or

Who, in any manner, marks upon or affixes to any unpatented article the word "patent," or any word importing that the same is patented, for the purpose of deceiving the public, shall be liable, for every such offense, to a penalty of not less than $100, with costs; one-half of said penalty to the person who shall sue for the same, and the other to the use of the United States, to be recovered by suit in any district court of the United States within whose jurisdiction such offense may have been committed.

## § 293. Nonresident patentee; service and notice

Every patentee not residing in the United States may file in the Patent Office a written designation stating the name and address of a person residing within the United States on whom may be served process or notice of proceedings affecting the patent or rights thereunder. If the person designated cannot be found at the address given in the last designation, or if no person has been designated, the United States District Court for the District of Columbia shall have jurisdiction and summons shall be served by publication or otherwise as the court directs. The court shall have the same jurisdiction to take any action respecting the patent or rights thereunder that it would have if the patentee were personally within the jurisdiction of the court.

SECTION 293—NEW SECTION

This section provides for service on non-resident patentees.

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# Additional Sections of Patent Act of 1952

AMENDMENT OF SEC. 21 OF TRADE-MARK ACT OF 1946

Sec. 2. Section 21 of the Act approved July 5, 1946, 60 Stat. 435, (United States Code, title 15, sec. 1071, 1946 ed.) is amended by striking out "Revised Statutes 4911" and inserting "35 United States Code, section 141"; by striking out "section 4915, Revised Statutes" and inserting "35 United States Code, sections 145 and 146"; and by striking out "Revised Statutes 4915" appearing twice in said section and inserting "35 United States Code, section 146."

Following is the text of sec. 21 of the Trade-Mark Act of 1946 with the parts stricken out enclosed in brackets and the insertions in italics:

Any applicant for registration of a mark, party to an interference proceeding, party to an opposition proceeding, party to an application to register as a lawful concurrent user, party to a cancelation proceeding, or any registrant who has filed an affidavit as provided in section 8, who is dissatisfied with the decision of the Commissioner may appeal to the United States Court of Customs and Patent Appeals or may proceed under [section 4915, Revised Statutes] *35 United States Code, sections 145 and 146*, as in the case of applicants for patents, under the same conditions, rules, and procedure as are prescribed in the case of patent appeals or proceedings so far as they are applicable: *Provided*, That any party who is satisfied with the decision of the Commissioner shall, upon the filing of an appeal to the Court of Customs and Patent Appeals by any dissatisfied party, have the right to elect to have all further proceedings under [Revised Statutes 4915] *35 United States Code, section 146*, by election as provided in [Revised Statutes 4911] *35 United States Code, section 141*. The Commissioner of Patents shall not be a necessary party to an inter partes proceeding under [Revised Statutes 4915] *35 United States Code, section 146*, but he shall be notified of the filing of the bill by the clerk of the court in which it is filed and the Commissioner shall have the right to intervene in the action.

SEVERABILITY CLAUSE.

Sec. 3. If any provision of Title 35, as enacted by section 1 hereof, is declared unconstitutional or is held invalid, the validity of the remainder of this title shall not be affected.



Severability clauses found in two patent acts (Act of May 23, 1930, ch. 312, sec. 6, 46 Stat. 376 and Act of Feb. 1, 1952, ch. 4, sec. 9, 66 Stat. 6) are merged in this general clause.

TIME OF TAKING EFFECT.

Sec. 4. (a) This Act shall take effect on January 1, 1953 and shall apply to all applications for patent filed on or after such date and to all patents granted on such applications. It shall apply to further proceedings on applications pending on such date and to patents granted on such applications except as otherwise provided. It shall apply to unexpired patents granted prior to such date except as otherwise provided.

(b) Section 102 (d) of Title 35, as enacted by section 1 hereof, shall not apply to existing patents and pending applications, but the law previously in effect, namely the first paragraph of R. S. 4887 (U. S. Code, title 35, sec. 32, first paragraph, 1946 ed.), shall apply to such patents and applications.

(c) Section 119, second paragraph, of Title 35 as enacted by section 1 hereof shall not apply to existing patents.

(d) The period of one year specified in section 102 (b) of Title 35 as enacted by section 1 hereof shall not apply in the case of applications filed before August 5, 1940, and patents granted on such applications, and with respect to such applications and patents, said period is two years instead of one year.

(e) Nothing contained in Title 35, as enacted by section 1 hereof, shall operate to nullify any judicial finding prior to the effective date of this Act on the validity of any patent by a court of competent jurisdiction.

(f) Nothing in Title 35, as enacted by section 1 hereof, shall affect any provision of the Atomic Energy Act of 1946 (Aug. 1, 1946, ch. 724, 60 Stat. 755).

(g) The period of one year specified in section 4 of Title 35 as enacted by section 1 hereof shall not apply in the case of applications filed before the effective date of this Act.

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(h) The repeal of sections 1-9, 11, 12 of the Act of Congress approved February 1, 1952 (ch. 4, 66 Stat. 3), shall not affect any rights or liabilities existing on the date of approval of this Act. An order of secrecy issued under or in effect under the repealed Act and in effect on the date of approval of this Act, shall be considered as issued under this Act, and any claims arising under the repealed Act or subject to presentation and determination pursuant thereto and unsettled as of the effective date of this Act, may be presented and determined pursuant to the provisions of this Act.

Paragraph (b) of this section preserves the saving clause of the act changing two years to one year, Act of Aug. 5, 1939, ch. 450, sec. 2, 53 Stat. 1212.

Paragraph (f) of this section renders unnecessary a more special similar provision in the Act of Feb. 1, 1952, ch. 4, sec. 11, 66 Stat. 6.

REPEAL OF PRIOR STATUTES

Sec. 5: The sections or parts thereof of the Revised Statutes or Statutes at Large enumerated in the following schedule are hereby repealed. Any rights or liabilities now existing under such sections or parts thereof shall not be affected by this repeal.

The schedule of acts repealed is omitted, the acts listed are included in the table of patent laws.



# Laws Not Included In Title 35

A number of laws were not included in new Title 35 for the reason that they are temporary in nature or for some other reason. The texts of these laws are given. Some of these laws were included in old Title 35; they are not now in Title 35 and may be assigned to some other unenacted title.

EXTENSIONS OF TIME (BOYKIN ACT)

Public Law 690, 79th Congress, chapter 910, 2nd session, (H. R. 5223) Approved August 8, 1946; 60 Stat. 940. An act to extend temporarily the time for filing applications for patents, for taking action in the United States Patent Office with respect thereto, for preventing proof of acts abroad with respect to the making of an invention, and for other purposes. (Boykin Act).

Sec. 1. The rights of priority provided by section 4887 of the Revised Statutes (U. S. C., title 35, sec. 32), as amended [now 35 U. S. C. 119], for the filing of applications for patent for inventions, discoveries, and designs, which rights had not expired on the 8th day of September 1939, or which rights have arisen since the 8th day of September 1939, shall be, and the same are hereby extended until the expiration of a period of twelve months from the passage of this Act in favor of the citizens of the United States and of citizens or subjects of all countries which have extended, or which now extend or which within said period of twelve months shall extend substantially reciprocal privileges to citizens of the United States, and such extension shall apply to applications upon which patents have been granted, as well as to applications now pending or filed within the period specified herein: *Provided*, That no such extension shall apply to any patent unless a request in writing was made therefor during the pendency of the application for such patent in the United States Patent Office, or within twelve months after the passage of this Act, which request must be accompanied by (1) a copy of the original foreign application, certified to by the patent office of the country in which it was filed, but if the original foreign application has been destroyed, other evidence pertaining thereto may be accepted; (2) a sworn translation of the same if it is not in the English language; and (3) if the foreign application was not made by the inventor himself, an affidavit by the applicant or patentee stating that such application was filed for his benefit or on his behalf and that such procedure is in accordance with the procedure in the foreign country: *Provided further*, That no patent granted or validated by reason

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*A medium of expression and exchange of thought for advancing and improving the patent system; a forum for the presentation and discussion of legal and technical subjects relating to the useful arts; a means for disseminating a wider knowledge of the workings and advantages of the patent system; a periodical for bringing about a more uniform practice of patent law and through which all interested in developing the patent system may work to a common end.*


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## The First United States Patent

The only official record of most of the United States patents issued from 1790 to 1836 consists of entries on index lists which had been reported by the Secretary of State to Congress and which had been published by Congress.[1] Additional information concerning the patents in the latter part of this period is available from restored records and from private publications, but information concerning the patents in the early part of this period is very meager.

The earliest United States patent of which more has been available in the form of official documents or copies of official documents than the entry in the index is the fourth one issued. This is dated Jan. 29, 1791 and was granted to Francis Bailey (misspelled Baily on the list) for "punches for types, etc. etc" as listed in the index. The Patent Office has a facsimile reproduction of the original grant and copies reduced in size have been reproduced for sale. The copy is reproduced in the Journal of the Patent Office Society for November 1918, Volume 1, opposite page 97, and for July 1936, page 70. At the time of this patent the specification and drawings did not form a part of the grant but were retained in the Office of the Secretary of State for reference purposes. Consequently, the patent grant referred to is the entire patent document.

The first patent issued under the Patent Act of 1790 is listed in the index as granted to Samuel Hopkins on

[1] The first of these lists is dated February, 1805; the complete title on the title page is "Letter from the Secretary of State accompanied with a list of the names of persons who have invented any new and useful art, machine, manufacture or composition of matter, or any improvement thereon, and to whom patents have issued for the same, from the office of the Department of State, with the dates and general objects of such patents, in pursuance of a resolution of the House of the 23d ultimo." For accounts of patent documents before 1836, the fire of 1836 which destroyed all Patent Office records, and the steps taken to restore the records, see Karl B. Lutz, Evolution of Patent Documents, 19 J.P.O.S. 390; B. M. Federico, The Patent Office Fire of 1836, 19 J.P.O.S. 804; P. J. Federico, The Patent Office in 1837, 19 J.P.O.S. 954.



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that was commented upon in the Court's decision on petition for rehearing. In 1909 the Circuit Court of Appeals of the First Circuit considered the validity of the doctrine of constructive reduction to practice as a "rule of the Patent Office" in *Automatic Weighing Machine* v. *Pneumatic Scale Corporation,* 1909 C. D. 498. The Court quoted, briefly, principles from many of the authorities we have noticed, and rationalized as follows:

> From these established and seemingly contradictory principles of the patent law, first, that an invention in order to be patentable must be reduced to practice, and, second, that, under the statute, reduction to practice is not essential either before or after the grant of a patent, then it follows that there must be some stage of an invention when it must be presumed as a matter of law that the inventor has reduced his invention to practice; and that stage is presumed to have been reached when he has done all he is required to do to obtain a valid patent, namely, when he has filed a complete and allowable application; and hence the Patent Office had adopted the rule that the filing of such an application is constructive reduction to practice, and the Federal Courts have adopted the rule that such an application is conclusive evidence that the patentee made his invention, that is, reduced his invention to practice, at least as early as that date.
>
> The cases which hold that a rejected application is not sufficient to establish priority of invention under the statutes have no bearing on the question of the legal effect of a complete and allowable application which will result or has resulted in the granting of a patent. These cases simply enforce the rule that an invention must be perfected and adapted to use in order to prove prior invention or prior use. . .

This ends the period of inception and introduction of the doctrine. A new phase ensued in which many decisions dealt with many subsidiary questions, chiefly arising out of the questions, what is a complete and allowable application?, and what date is the application entitled to as its filing date? Consideration of this phase is the topic of another section.



# The Patent Codification Act

By J. V. Martin *

The stated purpose of the Patent Codification Act of 1952, which became effective on January 1, 1953, is to revise, codify and enact into law Title 35 of the United States Code.

Although remarkably brief, new Title 35 covers a wide field, and its clarity of expression is such that we will be able to find answers to many questions of law by an examination of the related section itself. However, there exists a very real danger of jumping to erroneous conclusions, because many questions inevitably will arise as to whether a given section of new Title 35 constitutes no more than a simplification or clarification of the language of prior statutes, involves merely the elimination of obsolete and redundant statutory provisions, is simply a statutory expression of settled judicial doctrines, or whether it constitutes a substantive change in the law.

I shall not attempt to predict the decisions of the Courts, nor to review Title 35 as a whole. I shall endeavor briefly to outline the legislative history of the Act (which is at the moment of utmost interest, since the Courts have scarcely begun their task of determining legislative intent), and to review the most interesting of the Court decisions to date having to do with the applicability of new Title 35 and wherein it differs from the law prior to its enactment.

## 1. Legislative History of the Patent Codification Act.

Prior to the enactment of the Patent Codification Act, our statutory patent law was essentially the Act of July 8, 1870, as amended and supplemented by subsequent enactments.

As a result of President Roosevelt's messages to Con-

* Of Vinson, Elkins, Weems & Searls, Houston, Texas.

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gress of January and April 1938, our patent system and laws were subjected to an unprecedented investigation, attack and defense. The defense prevailed, and that is why we have the Patent Codification Act of 1952 in its present form.

Evidence of the battle between the attackers and defenders is quite apparent in the transcript of the hearings and report of the Temporary National Economic Commitee (January-July 1939) and in the transcript of hearings on various contemporary and subsequent Bills introduced in the House and Senate.

For some time, we will find it necessary to examine a number of legislative documents in our efforts to find answers to many questions of law arising under new Title 35. Of these, it seems to me the following will be consulted most often, particularly the House and Senate Reports and the Revision Notes of these Reports.

On January 10, 1950, the House Committee published its preliminary draft of the "Proposed Revision and Amendment of the Patent Laws." This was widely distributed for the purpose of obtaining suggestions and criticisms. It contained a number of sections urged by the attackers, which sections do not appear in the Patent Codification Act. In submitting this preliminary draft, Chairman Bryson made it clear that it was not intended to represent the Committee's views and recommendations on any particular change in the patent laws.

On July 17, 1950, H.R. 9133 was introduced in the House of Representatives. This Bill was introduced after the House Committee on Patents had considered many suggestions and criticisms with respect to the preliminary draft, and it too was widely distributed and comments thereon were considered.

On April 18, 1951 H.R. 3760 was introduced in the House of Representatives and hearings were held thereon. This Bill was a revised form of H.R. 9133. The transcript of the hearings on H.R. 3760 contained very helpful information.



On May 12, 1952 H.R. 7794 was introduced in the House of Representatives, as a result of the hearings on H.R. 3760. This H.R. 7794 is the Bill on which the Patent Codification Act was enacted, after it had been amended by the Senate.

On May 12, 1952 Report 1923 was submitted by the Committee on the Judiciary, House of Representatives, to accompany H.R. 7794.

On May 20, 1952 H.R. 7794 was introduced in the Senate, with the Senate Amendments.

On June 27, 1952 Report No. 1979 was submitted by the Committee on the Judiciary, United States Senate, to accompany H.R. 7794.

See also the Commentary on New Title 35, U. S. Code "Patents" by Charles J. Zinn, the House Judiciary Committee's Law Revision Counsel (United States Code, Congressional and Administrative News, 82nd Congress, Second Session 1952).

### 2. Decisions of the Courts as to Whether New Title 35 is Applicable to a Given Patent or Proceeding.

Whether, and to what extent, new Title 35 is applicable to a particular patent or a particular proceeding must be determined first. And the answers to most questions of applicability may be found in Sections 4 and 5 of the Act.

Where the patent issued on an application filed on or after January 1, 1953 the Act applies (Sec. 4a) to the application and the patent.

But where the patent issued on a patent application filed before January 1, 1953, the Act may or may not apply, depending upon the particular question involved, because while the Act applies to further proceedings on patent applications pending on January 1, 1953 and to patents granted on such patent applications, and to all unexpired patents granted prior to January 1, 1953, it applies "except as otherwise provided" (Sec. 4a). And so it is necessary to determine whether such a patent

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application or patent comes within any of the exceptions to the application of the Act.

The exceptions recited in paragraphs 4(b), (c), (d), (f), (g), and (h) of the Act are clearly defined and will arise infrequently.[1] The exception stated in paragraph 4(e) of the Act will be frequently invoked because it provides that nothing in Title 35 shall operate to nullify any judicial finding prior to January 1, 1953 on the validity of any patent by a Court of competent jurisdiction.

Section 5 of the Act will no doubt call for many judicial constructions and interpretations because, referring to the repealed sections and parts of the Revised Statutes or Statutes at Large, it states "any rights or liabilities now existing under such sections or parts shall not be affected by this repeal." This obviously means that the Act is not retroactive, but it is believed that many problems will be encountered in the application of Sec. 5.

Many questions as to the applicability of the Act will arise in actions for infringement of patents granted prior to January 1, 1953, and the rule of thumb to bear in mind is that the Act must be applied in accordance with Sec. 4a, but its application is subject not only to the exceptions of Sections 4(b) through 4(h), but also to existing rights and liabilities under Sec. 5.

The Circuit Courts of Appeals have had before them a number of patent infringement actions in which the judgments of the District Courts were entered prior to January 1, 1953 when the Act went into effect, and in these cases it was held that the Act was not applicable on the appeal. It will be apparent from these decisions that the rule is the same whether the District Court declared the patent valid or invalid. The Fifth Circuit Court of Appeals in the *Texas Miller* case,[2] and the

[1] 4(b) and (c) relate to foreign applications and patents; 4(d) to patent applications filed before August 5, 1940; 4(f) to the Atomic Energy Act; 4(g) to officers and employees of the Patent Office; and 4(h) to the Invention Secrecy Act.

[2] A list of all authorities cited herein is appended hereto.



Sixth Circuit Court of Appeals in the *General Motors* case cited Section 5 of the Act. The First Circuit Court of Appeals in the *Carlson & Sullivan* case and the Third Circuit Court of Appeals in the *Stanley Works* case cited Section 4(e) of the Act. In the *Smith* case, the Seventh Circuit Court of Appeals had before it the question of applicability of the Act in view of Section 4(e) but did not decide the question.

However, where the judgment of the District Court is entered after January 1, 1953, the Act governs the appeal, even though the trial was held prior to January 1, 1953. It was so held by the Third Circuit Court of Appeals in the *United Mattress* case. In considering the opinion of the Court in this case, it will, of course, be remembered that while the Act governs the appeals in such cases, its application is subject to the exceptions set forth in the paragraphs of Section 4 other than 4(e), and to the existing rights and liabilities of Section 5. The decision in this *United Mattress* case should be considered with the earlier decision of the Michigan District Court in the *Gagnier* case, *infra*.

The applicability of the Act in the District Court to patent infringement actions has been considered in a number of cases.

Judge Jones of the Northern District of Ohio, in the *Diebold* case, held that the application of the Act to pending infringement suits and infringement suits instituted after January 1, 1953, must depend not only on the particular section of the Act invoked but also upon whether the facts giving rise to a new claim or defense under the Act occurred after January 1, 1953. In the *Diebold* case, he explained that in the *Dazians'* case he had granted defendant leave to file a counterclaim under Section 271 for contributory infringement because the alleged infringement was based at least in part on facts arising after January 1, 1953. In the *Diebold* case, he held that Section 253 could not be applied because the disclaimer was filed under the old statute and the principle of due process prohibited a retroactive application of the new statute to invalidate plaintiff's patent.

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In the *Lyons* case, the New Jersey District Court said that it did not reach the question whether under the new Patent Code the product involved was patentable because the effective date of the Patent Code post dated both the patent and the filing of the suit. The Court apparently ignored Sec. 4 of the Act which provides that the Act shall apply to all unexpired patents granted prior to January 1, 1953 except as otherwise provided, and the fact that Sec. 103 is not an exception.

In the *Gagnier* case, the Michigan District Court held that it was not the intention of Congress to make the Act entirely retroactive, citing the *General Motors* case, and pointing out that this *Gagnier* case was heard before the Act went into effect and the decision was delayed only because of the filing of briefs. This decision in this case is in conflict with the later decision of the Third Circuit Court of Appeals in the *United Mattress* case, supra, but the reluctance of the Court to base its decision on the new statute after the case was tried under the old statute is understandable.

In the *Joseph Bancroft* case, Plaintiff contended that it was entitled to the filing date of a Swiss application. The New Jersey District Court held that since the patent in suit was issued prior to January 1, 1953, RS-4887 applied, and not Secs. 102(d), 119 and 172. The Court did not say so; but the applicable exception appears in Section 4(b) of the Act.

In the *Riley* case, the California District Court held that Sections 251 and 252 applied to the Reissue patent in suit because no exception is contained in either of these Sections, and neither of these Sections is referred to in Section 4 of the Act. The Court held that Section 4(a) of the Act provides that the Act applies to unexpired patents granted prior to January 1, 1953, except as otherwise provided; and that Congress, having made the seven specific exceptions set forth in (b) to (h) inclusive of Section 4 of the Act, it was clear that those are the only exceptions intended to be made, unless an exception should specifically appear in any other section. The Court thereupon granted a summary judgment dismissing the complaint on the ground that the reissue was void. Without referring specifically to Section 5 of the Act, the Court held that the language of Section 251 does not change the sense or substance of the meaning of its predecessor RS-4916.



The first *New Wrinkle* case in the Court of Appeals of the District of Columbia and the *In Re Harding* in the Court of Customs and Patent Appeals, established, respectively, that the Act applies to proceedings under RS-4915 and to appeals from the Board of Appeals, because these are "further proceedings on applications pending" on January 1, 1953. See also *In Re Arbeit*. However, Section 121 of the Act is inapplicable where applicant's prior patent on which his application is rejected issued prior to January 1, 1953. It was so held in *In Re Eisler*.

### 3. Decisions of the Courts as to Wherein New Title 35 Differs from the Law Prior to the Enactment Thereof.

The question of invalidity of a patent for want of invention arises in nearly all patent infringement suits. It is, therefore, not surprising that most of the opinions of the Courts have been expressed with respect to Section 103, with an occasional reference to Sections 100, 101 and 282.

#### *Section 282 Presumption of Validity*

While it is true that prior to the Patent Codification Act the Courts had repeatedly held that a patent is presumed to be valid and that the burden of establishing invalidity rests upon the party asserting it, it is equally true that some doubt existed at the bar as to whether the bench often stated the rule and thereupon completely ignored it. It was, therefore, hoped that the inclusion of this rule in the statute itself (Sec. 282) might be an additional reminder that a patentee plaintiff is under



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no burden to establish validity. What effect, if any, this Section 282 will have remains to be seen.

The Sixth Circuit Court of Appeals in the *General Motors* case, and the Michigan District Court in the *Gagnier* case, held that Section 282 does not change the law. The Third Circuit Court of Appeals in the *United Mattress* case cited Section 282 as the applicable law. The New York District Court in the *Stewart* case held that the statutory presumption of validity under Section 282 was not sufficient to support a motion for a preliminary injunction where the patent had not been adjudicated or acquiesced in, and Defendant alleged prior art.

*Sections 100, 101 and 103 Patentability of Inventions*

As the Supreme Court said long ago in *MacClain* v. *Ortmayer*, 141 U. S. 427, the word "invention" cannot be defined. The Congress did not attempt to define it in the Patent Codification Act, other than to provide (Sec. 1000) that "The term 'invention' means invention or discovery;" to recite a test in the first sentence of Section 103; and to exclude the test recited in the second sentence of Section 103.

The legislative intent to restate the law in the first sentence of Section 103, and to effect a substantive change in the law by excluding the test recited in the second sentence, has not been fully considered by the Courts. The opinions of the Courts indicate that some confusion has arisen by reason of the fact that the body of the House and Senate Reports refers to Section 103 *as a whole*, and the statement there made may be construed as meaning that Section 103 simply restates the existing law. The Revision notes however, which form a part of the Reports, comment upon the first and second sentences separately, and the fact that a substantive change by the second sentence was intended is apparent. In view of the importance of this, I shall quote Section 103, the Reports, the Revision Notes, and the commentary by the House Committee's law revision counsel.



Section 103 is as follows:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in Section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The House and Senate Reports and the Revision Notes forming a part thereof are the same. In the body of the Report is the following general statement in which no distinction is made between the first and second sentences of Section 103.

> Section 103, for the first time in our statute, provides a condition which exists in the law and has existed for more than 100 years, but only by reason of decisions of the Courts. An invention which has been made, and which is new in the sense that the same thing has not been made before, may still not be patentable if the difference between the new thing and what was known before is not considered sufficiently great to warrant a patent. That has been expressed in a large variety of ways in decisions of the Courts and in writings. Section 103 states this requirement in the title. It refers to the difference between the subject matter sought to be patented and the prior art, meaning what was known before as described in Section 102. If this difference is such that the subject matter as a whole would have been obvious at the time to a person skilled in the art, then the subject matter cannot be patented.
>
> That provision paraphrases language which has often been used in decisions of the Courts, and the section is added to the statute for uniformity and definiteness. This section should have a stabilizing effect and minimize great departures which have appeared in some cases.

In the Revision Notes the first and second sentences of Section 103 are distinguished as follows:

> There is no provision corresponding to the first sentence explicitly stated in the present statutes, but the refusal of patents by the Patent Office, and the holding of patents invalid by the Courts, on the ground of lack of invention or lack of patentable novelty has been followed since at least as early as 1850. This paragraph is added with the view that an explicit state-

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ment in the statute may have some stabilizing effect, and also to serve as a basis for the addition at a later time of some criteria which may be worked out.

The second sentence of this section providing that patentability shall not be negatived by the manner in which the invention was made, that is, it is immaterial whether it resulted from long toil and experimentation or from a flash of genius.

In the commentary by Mr. Zinn, the House Committee's law Revision counsel, the following statement is made:

Section 103 is a restatement of the rule invalidating patents for lack of invention or lack of patentable novelty which has long been recognized by the Courts and other authorities but has not before been spelled out in the statute.

The second sentence of this section providing that patentability shall not be negatived by the manner in which the invention was made eliminates the 'flash of genius' concept that has been considered as an essential element of patentability since the Cuno case. In that case (Cuno Engineering Corp. v. Automatic Devices Corp., 314 U. S. 84, 62 S. Ct. 37, 86 L. Ed. 58) the Supreme Court held that 'the new device, however useful it may be, must reveal the flash of creative genius, not merely the skill of the calling'. The patentability of an invention resulting from arduous experimentation will not be negatived solely because it does not meet that concept.

It will be apparent from the documents just quoted that the "obvious" test included by the first sentence of Section 103 was not intended to have the same meaning as the "flash of genius" test excluded by the second sentence. It would, therefore, appear that Section 103 should be construed to mean that if the differences between the patented subject matter and the prior art are such that the subject matter would have been obvious to one skilled in the art at the time the alleged invention was made, the patent is invalid, but it is not necessary that the patented invention be the result of a "flash of genius."

The application of Section 103 will involve countless problems, but it is believed that Congress has taken a step in the right direction by condemning the "flash of genius" rule, at least insofar as that rule may be interpreted as requiring mental processes *too far above* the mental processes of one skilled in the art.



It is to be remembered, of course, that if the subject matter involved would have been obvious to one skilled in the art at the time the alleged invention was made, it is unpatentable by reason of the first sentence of Section 103, and, in that event, there is no reason to consider the second sentence. This may explain many of the decisions to which I shall refer. But it does not explain those decisions in which the flash of genius rule has been applied notwithstanding the exclusion thereof by the second sentence.

Shortly before the enactment of the Patent Codification Act, the Courts were not in full agreement as to the "flash of genius" rule of the *Cuno* case. The rule was applied by the Court of Appeals of the District of Columbia in the *Standard Oil Development* case, but in the *Robertson* case, Judge Hutcheson of the Fifth Circuit Court of Appeals said:

It is true that the combination must represent something more than the ordinary skill of the average mechanic, but speaking prosaically rather than poetically, it is not true, as is sometimes claimed, that patents to be valid must be the result of, must embody, flashes of genius.

Since the enactment of the Act, there have been a number of decisions as to the "flash of genius" rule, but the only opinion revealing a clear understanding of the difference between the first and second sentences of Section 103 is that of Michigan Judge Picard in the *Gagnier* case. In that case, Judge Picard stated that the second sentence was new and that it rejected the flash of genius rule of the *Cuno* case. The Third Circuit Court of Appeals in the *United Mattress* case also indicated its understanding of this matter but said that it did not find it necessary to decide what, if anything, was left of that much discussed criterion of patentability.

Other decisions relating to the flash of genius rule, include the *Newburgh* case in which the New Jersey District Court held the patent in suit invalid "by the

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tests of the Patent Code and applicable cases" citing the *Cuno* case. Apparently the Court considered the body of the House Report and not the Revision Notes which reveal that the purpose of the second sentence of Section 103 is to eliminate the flash of genius rule of the *Cuno* case.

The opinions of the Ninth Circuit Court of Appeals in the *Pacific* case and the *Kwikset* case,[3] indicate that that Court is of the opinion that the *Cuno* case did not change the law existing prior thereto, that the Patent Codification Act does not define invention, and that the courts must follow the guidepost established by them.

In the second *New Wrinkle* case, the Court of Appeals of the District of Columbia indicated that doubt may exist as to the flash of genius rule, citing Senator Wiley's statement to Senator Saltonstall that the Bill on which the new Title 35 was enacted was simply a restatement of the patent laws.

In a number of the decisions, the Courts have made rather broad and general statements to the effect that there is little if any change in the law as to what constitutes invention. And these cases make it crystal clear that the rule of the *A & P* case is still in full force and effect.

In the *Thys* case, the California District Court held that Congress did not intend to lower the standard of invention.

The First Circuit Court of Appeals in the *Carlson and Sullivan* case did not pass upon the question as to what change in the law was effected, but indicated that it was doubtful that Congress intended any change at all.

The Sixth Circuit Court of Appeals in the *General Motors* case held that the Act did not provide any new test of patentability insofar as the case before it was concerned. In this case, the attorney for appellee argued that the *A & P* case had been modified by the Patent Codification Act, but the Court held that the principle

[3] See Editor's note 100 USPQ 289: "Previous opinion, 98 USPQ 206, has been withdrawn by the court."



stated in the *A & P* case is not modified by the new Act but continues to be the law and was controlling in that case.

In the *O'Keefe* case, the Court of Customs and Patent Appeals held that the Act neither raised nor lowered the standard of invention.

In the *Stanley Works* case, the Third Circuit Court of Appeals held that Section 103 is merely a codification of existing case law.

In the *Joseph Bancroft* case, the New Jersey District Court held that Congress did not intend to formulate a new standard of invention by Sec. 103, and that the Act had done no more than adopt the test of so-called obviousness.

In the *Channel Master* case, the New York District Court held that Sections 101 and 102 do not purport to change the law, and that Section 103 is merely a codification of the basic requirement that the subject matter of a patent must have invention and patentable novelty which the section expresses in terms of "obviousness."

As I have heretofore indicated, it seems to me that the opinions embodying the general statements referred to are sound if based upon the first sentence of Section 103, but the opinions are open to question if construed as applying to the Act as a whole, and particularly the second sentence of Section 103.

### *Sections 111 and 112 Application For Patent*

These sections have to do with the requirements as to the specification and claims of a patent.

In the *General Motors* case, the Sixth Circuit Court of Appeals held with respect to the first and second paragraphs of Section 112 that the same exact requirements were specified by repealed R.S. 4888.

The third paragraph of Section 112 has to do with functional statements in claims, and it is this paragraph which has received the attention of the Courts and the Patent Office.

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This third paragraph does not purport to establish any right to functional claims generally. It expressly applies to combination claims and specifically to functional statements with respect to an element of such claims. And as will appear from the decisions, a patent containing a combination claim reciting the function of an element must meet the requirements as to the specification set forth in the first paragraph and as to the claim set forth in the second paragraph of Section 112.

In his Commentary, Mr. Zinn, the House Committee's law revision counsel, pointed out that the third paragraph offsets the theory of the *Halliburton* case but does not go so far as to permit the use of a single means claims.

In the *S. D. Warren* case, counsel for appellant argued that the claims in suit were functional and that such claims had been held invalid by the Supreme Court for that reason, citing the *Halliburton* case. The Third Circuit Court of Appeals held that the functional claims doctrine forbade a statement of function or result at the precise point of novelty, citing the *Halliburton* case, and that the claims in suit were not functional. Although the Court cited Section 112, its decision is apparently not based thereon. The Court did not refer to Mr. Zinn's Commentary.

In the *Arbeit* case, the Court of Customs and Patent Appeals reviewed the authorities including the *General Electric* case and said that the quoted statements therein were peculiarly apropos to the case under consideration. The Court said it was unnecessary for the Court to attempt a complete construction of Section 112. It based its decision on the ground that the last paragraph of Section 112 must not be construed in a manner inconsistent with the first and second paragraphs, and that the descriptions given in the specification of the patent in suit were no more definite than the functional statements in the claims.



Section 112 was very carefully considered in *Ex Parte Ball* by an augmented Board of Appeals of the Patent Office. The arguments were heard by Commissioner Watson and seven Examiners in Chief. The Board held that the claim must point out with particularity and be distinct, but it may express an element as a means for performing a function without the recital of structure, assuming of course, that the specification fully describes the structure. This *Ex Parte Ball* case was referred to by the Court of Customs and Patent Appeals in the case of *In Re Schutt*.

In *Ex Parte Hitchins*, the Patent Office Board of Appeals held that a new use of an old machine could not be defined by a claim under Section 100 because that section defines processes as permissibly including new uses of old machines, without nullifying the requirements of the second paragraph of Section 112.

### *Section 271 Infringement of Patents*

The Revision Notes state that paragraphs (b) and (c) of this section define and limit contributory infringement.

There was much disagreement as to the necessity for and the wisdom of including these provisions. The House Report states:

> Considerable doubt and confusion as to the scope of contributory infringement has resulted from a number of decisions of the Courts in recent years. The purpose of this section is to codify in statutory form principles of contributory infringement and at the same time eliminate this doubt and confusion.

Whether this object will be accomplished remains to be seen. I think it very unlikely that these provisions will eliminate any doubt or confusion.

Although I do not so interpret his opinion, it is quite possible that Judge Picard's opinion in the *Gagnier* case may be interpreted as holding that where the element of a combination supplied by a contributory infringer is unpatented (he declared the patent thereon invalid) then, for that reason, the element should be considered

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a staple article of commerce capable of a non-infringing use; and that whether the combination claim defines the element specifically is to be considered in determining whether there has been a contributory infringement.

*Section 284 Damages*

This section provides that upon finding for the claimant, the Court *shall* award the claimant damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the Court.

In the *Laskowitz* case, the California District Court held that this provision was mandatory; that the awarding of punitive damages was discretionary; and that the profits of the infringer may be the measure.

*Section 285 Attorney's Fees*

I'm sure you have little interest in this section, but I may note that while it states that the Court may award attorney's fees "in exceptional cases," and these words were added to R.S. 4921, the award of attorney's fees is still within the Trial Court's discretion. It was so held in *The Texas Company* case.

*Section 287 Marking and Notice*

Whatever doubt may have existed, prior to the enactment of this section, as to whether proof of notice of infringement before the filing of an action was necessary where the patented article had not been marked patented, it is now clear that the filing of an action constitutes notice of infringement.

However, it is still necessary to allege and prove that the Defendant committed an act of infringement prior to the filing of the Complaint, for the reasons stated in the *Rohm and Haas* case.



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# Validity of Doctrine that a Full Exclusive License is in Fact an Assignment

By Ridsdale Ellis

## Introduction

The case of *Waterman* v. *Mackenzie*, 138 US 252, 34 L ed 923, 11 S Ct 334, 1891 CD 320, decided in 1891, is chiefly responsible for the doctrine that a full and exclusive license is in fact an assignment. Study of the whole situation, including a review of a large number of decisions handed down during the past hundred years, suggests strongly that the doctrine stands on insecure ground and should be abandoned or greatly restricted in the scope of its application.

It is interesting to note, in the first place, that in the *Waterman* case the transfer before the court was held to be a license and not an assignment. Hence, so far as the facts in that case were concerned, the doctrine was pure dicta. Mr. Justice Gray did, however, cite an earlier case, decided in 1846, *Wilson* v. *Rousseau*, 4 How 646, 11 L ed 1141, in which the above doctrine had been laid down and applied.

What appears to be an erroneous attitude of the Supreme Court in these two cases seems to have arisen in part because the language used in the 1836 and later acts down to the 1952 Act to define the rights granted to a patentee is substantially the same as that ordinarily used to define the rights given by exclusive licenses. Thus Sec. 5 of the 1836 Act defines the rights granted to a patentee as "the full and exclusive right and liberty of making, using, and vending to others to be used, the said invention or discovery." That wording could have been copied practically verbatim from any one of hundreds of exclusive licenses.

The erroneous attitude seems to have also been due in part to the failure of the court to appreciate that the broad fundamental practical difference between an assignment and a license is that the former gives the transferee the right to sue for infringement, while the

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# The New Patent Statute:

# Congress Revitalizes the Patent System

by Karl B. Lutz • of the Pennsylvania Bar (Pittsburgh)

The problem of our patent policy has been the subject of more than one article in the *Journal* in recent years. Many of the patent lawyers who wrote for our readers expressed strong disagreement with the patent philosophy of recent Supreme Court decisions and urged a revision of the statute. Last summer, Congress voted such a revision. Below, Mr. Lutz examines this new legislation, which went into effect January 1.

Congress has once again used its power to legislate concerning patents. On July 4, 1952, it passed the Patent Act of 1952, which was approved by the President and became effective on January 1, 1953. This statute contains provisions which seem certain to revitalize the U. S. patent system.

The new patent statute was drafted primarily as a part of the general plan of revising the U. S. Code and enacting it into law. It is well to remember that the United States Code as originally compiled and published in 1926 was not enacted as law, but was only prima facie evidence of the law. By a fortunate distribution of committee functions, a subcommittee of the House Committee on the Judiciary, charged with revision of the entire United States Code, was also charged with consideration of bills relating to patents. This subcommittee, under Joseph L. Bryson, decided to codify the patent statutes and to incorporate in the new statute some provisions to improve and strengthen the law of patents.

In preparing its first preliminary draft in 1950 this committee studied all existing patent statutes, and in considering amendments of substance consulted the following sources:

> (1) All the bills relating to patents which have been introduced in Congress since 1925, and some earlier bills, together with any hearings and reports on these bills; (2) the reports of the Science Advisory Board (1935), the Temporary National Economic Committee (1941) and the National Patent Planning Commission (1943, 1944, 1945; (3) reports and recommendations of private groups such as the American Bar Association, Patent, Trade-mark and Copyright Section; and (4) miscellaneous sources such as books, articles in legal periodicals, etc.[1]

This preliminary draft was widely circulated to invite criticism and discussion by government employees, by patent lawyers and by representatives of industry. As the result of this thorough discussion of successive drafts over several years, the language of this act was considerably improved and the more controversial provisions were removed. The bill was successfully guided through Congress by Congressman Bryson and Senator Alexander Wiley.

In this new law Congress has legislated for the first time on certain phases of patents, and it has codified some doctrines of patent law that were developed in the courts by "common law" processes. To understand the full impact of the new statute it is important to keep in mind a few basic facts.

### Patent System Stems from Constitution

The entire U. S. patent system stems from the constitutional clause which gives Congress power to provide for the granting of patents. Operating under this grant of power Congress has passed various patent statutes, setting up the procedural part of the patent system. But important areas of patent law, relating to questions of novelty and infringement, were left to the courts for development by "common law" processes. In using this power, the federal courts for over a hundred years took a liberal attitude toward patents. They believed that the purpose of the Constitution was to foster and protect invention, and their decisions carried out that purpose.

But since 1930 the U. S. Supreme Court has taken a less benevolent attitude toward patents. It has reversed precedents of long standing; it has destroyed well-established doctrines of the common law of patents; it has taken a harsh attitude toward most of the patents that have come before it.[2] This destructive attitude of the

1. Proposed Revision and Amendment of the Patent Laws, Preliminary Draft with Notes, Committee Print, Committee on the Judiciary, House of Representatives, Government Printing Office, 1950, page vi.

2. For a more complete development of this theme, see "Are the Courts Carrying Out Constitutional Public Policy on Patents?", *Journal of the Patent Office Society*, (October, 1952) page 766.



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Supreme Court has naturally been reflected to some extent in the decisions of the lower courts.

Congress, being cognizant of this changed attitude of the courts, has inserted in the new act some provisions which codify the "common law" of patents as it existed prior to the recent apostasy from the benevolent policy of the Constitution. These provisions are worthy of some short attention.

Since the entire federal patent system stems from the constitutional clause on patents, any basic treatment of patent law must start with this clause. In recent years some members of the United States Supreme Court have misread the patent clause as permitting patents only for such startling innovations as "push back the frontiers of chemistry, physics and the like" and "make a distinctive contribution to scientific knowledge".[3] Actually the word "science" does not belong in the patent clause of the Constitution, and the House Committee Report[4] on the new law correctly explains that the Constitution provides for the granting of patents "to promote the progress of *useful arts*".[5] This interpretation is borne out by the first patents issued by the Federal Government, which were for such devices as "A Method for Forming Punches To Impress Marks on Metal", and "An Improved Machine for Roving and Spinning Cotton". Such inventions relate to the "useful arts" (in modern language "practical arts") but do not "push back the frontiers of science".

### Common Law of Patents Partly Codified

As stated above, Congress has, until the present statute, left the important question of "novelty" entirely to the conrts. This question, sometimes called the "standard of invention", involves the decision as to "how much" novelty a device must have in order to qualify as a patentable invention. At an early date the courts decided that the mere fact that the device had *some* novelty was not enough. It was more difficult to decide *how much* novelty is necessary. In general the courts have held that this is a question of fact to be determined in each individual case. But they have evolved certain helpful rules, such as the rule requiring more than "mechanical skill". This rule has been codified in the new act by stating that the device is not patentable if it "would have been obvious at the time the invention was made to a person having ordinary skill in the art".[6]

The courts also developed certain "objective tests", which are rules of thumb to help determine the presence or absence of invention. These "tests" include the following:

1. Did the invention fill a long-felt want? If the best brains in a particular field have failed for years to solve a pressing problem, and someone comes forward with a solution which is recognized at once as the answer, is not this some evidence of invention? The United States Supreme Court has answered "yes".[7]

2. Did the inventor take the last step necessary to make a practical reality out of what others had unsuccessfully groped for? The Supreme Court has said that this is some evidence of invention.[8]

3. Was the new device immediately adopted by everyone and widely used commercially? This also has been recognized by the Supreme Court as some evidence of invention.[9]

Space does not permit discussion of all the different "objective tests" of this kind that have been applied by the courts. Of course, no one of these tests is necessarily conclusive, and they must all give way in the face of a statutory bar, such as prior use, prior publication or prior patenting. The new act does not expressly codify these objective tests, but it leaves them available for use as evidence that an invention "would not have been obvious".

Not long ago the United States Supreme Court seemed to raise an impossibly high standard of invention, on the theory that an invention can result only from a "flash of creative genius".[10] The new act flatly rejects this view by declaring that "patentability shall not be negatived by the manner in which the invention was made".[11] By inference, this clause requires the courts to apply the well-known "objective tests" mentioned above.

The new law says "A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it."[12] This approximates another doctrine of the "common law" of patents that has been more breached than honored in recent years. By reaffirming it in this statute in its strongest version, Congress obviously intended that patents should not be lightly held invalid.

The new statute contains a more accurate statement of the rights conveyed by a patent than any previous act. The old statute said that the patent conveys the "exclusive right to make, use and vend the invention". This language seemed to convey a positive right to do the things enumerated regardless of any prior basic patent, and was often so interpreted by those unskilled in patent law.[13] The new act more correctly states that the patent conveys "the right to exclude others from making, using, or selling the invention".[14] This language permits the inventor to exclude others from his invention, but, if his invention is merely an improvement on a prior basic invention, it warns him that the basic inventor may exclude him from the

3. Concurring opinion of Mr. Justice Douglas and Mr. Justice Black in *Great A. & P. Tea Co. v. Supermarket Co.*, 71 S. Ct. 127.

4. 82d Congress. House Report No. 1923, to accompany H.R. 7794, page 6.

5. For a full explanation of this interpretation see "Patents & Science, a clarification of the Patent Clause of the U. S. Constitution", 18 Geo. Wash. L. Rev. 50 (1949).

6. Section 103.

7. *Goodyear v. Ray-O-Vac*, 321 U.S. 275 (1944).

8. *Washburn Mfg. Co. v. Beat 'em All Barbed Wire Co.*, 143 U.S. 275 (1892).

9. *Minerals Separation Co. v. Hyde*, 242 U.S. 261 (1916).

10. *Cuno Engineering v. Automatic*, 314 U.S. 89, 91.

11. Section 103, last sentence.

12. Section 282, first paragraph.

13. This statement in the old statute was admirably suitable for use in booklets issued by some of the few remaining advertising patent practitioners. The bare words of the old statute, as quoted in the booklets, often misled their prospective clients into believing a patent would give them a positive right to use their own inventions. But how could anyone criticize the advertiser for mere quotation from the statute?

14. Section 154.



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entire field covered by the basic patent.

Prior to this new act the patent statutes made no attempt to cover the question of infringement, leaving it entirely to the courts. In passing on this question the courts developed certain rules of thumb as to the "amount of nearness" to the patented invention that must be present before the court will hold an accused device to be an infringement of the patent. The new act makes no effort to codify the "common law" rules relating to "direct infringement", except to state broadly that whoever uses the patented invention without authority infringes the patent.[15]

In cases of patent infringement it was sometimes found that the "direct infringer" was either financially irresponsible, or was difficult to reach. In such cases the courts resorted to the doctrine of joint tortfeasors to hold as "contributory infringers" those who aided or abetted an infringement. In some of the old cases the courts perhaps went too far in applying this doctrine to help inventors. But in recent years the courts have reacted against these too-lenient cases, and have not only failed to penalize one who would formerly have been held as a "contributory infringer", but have also penalized the patent owner for "misuse" of his patent. This doctrine of "misuse" had recently been carried so far as to actually discourage certain types of invention.

The new statute[16] does not go to the extreme lengths in helping the inventor that some of the old cases on contributory infringement did, but it definitely codifies this doctrine in language that includes a large part of the field covered by the old cases. It also gives the patent owner relief from the doctrine of "misuse" in certain defined areas. Furthermore, the new law does not enact the misuse doctrine, and therefore does not prevent the courts from receding still further from the extreme to which this doctrine has been carried.

This section on "contributory infringement" and "misuse" is probably the most controversial part of the new act, and must be interpreted by the courts. But it is to be hoped that they will carry out the apparent congressional intent of restoring at least part of the doctrine of "contributory infringement", and of restricting the doctrine of "misuse".[17]

Another feature of the new act that is more liberal toward inventors relates to invalid patent claims. A patent usually contains more than one claim, and these claims are looked upon as stating the metes and bounds of the invention. Quite often a claim may be believed to be valid when the patent is granted, but later someone may discover that the claim is invalid over newly discovered prior art which is found as the result of a more exhaustive search. An old rule of patent law said that one such invalid claim would render the entire patent invalid. This doctrine was an historical holdover from the old English rule that any false statement in a patent was an attempt to mislead the Crown, and therefore rendered the entire patent invalid.

The harsh results of this rule had been partially softened by a court-developed doctrine which permitted an invalid claim to be "disclaimed". But even this court doctrine required that the "disclaimer" be filed within a certain period, not too well-defined, and resulted in considerable uncertainty and even hardship. The new statute substantially corrects this situation by stating that "whenever, without any deceptive intention, a claim of a patent is invalid, the remaining claims shall not thereby be rendered invalid".[18] A small remnant of the old rule, however, is still kept to discourage retention in a patent of clearly invalid claims. This is done by providing that, in a suit for infringement, no costs may be recovered by the patentee "unless a disclaimer of the invalid claim has been entered at the Patent Office before the commencement of the suit."[19]

It is generally agreed both here and in other countries, that an inventor is entitled to a greater field of protection than the specific thing illustrated in his patent. One of the time-honored ways of doing this is to claim an element of the device by reference to its "function", *i. e.*, what it does. In recent years some courts have been overly critical of these functional statements,[20] and one section of the new law provides that a claim shall not be held invalid on the sole ground that it contains a functional statement.[21]

Situations arise in which the inventor refuses to sign a patent application, or cannot be found at the time. The new act provides that in such cases a person who can show sufficient proprietary interest in the invention may "make application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties".[22]

Sometimes when a patent applica-



**Karl B. Lutz** practices law in Pittsburgh. He received his A.B. from Bethany College and his LL. B. from George Washington University. He has been a member of the Association since 1930.

15. Section 271(a). Making and selling are included in the statutory clause but are omitted in the above statement for purposes of simplification.
16. Section 271 (b), (c) and (d).
17. The doctrine of "contributory infringement" should receive more basic study and discussion than it has in the past, in order to arrive at solutions which encourage invention without imposing undue burdens on commerce. For a study of this type see, "Rational Limits of Contributory Infringement", by Louis Robertson, 33 *Journal of the Patent Office Society* 857 (December, 1951).
18. Section 253.
19. Section 288.
20. *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1, 92 L. ed. 3, 67 S. Ct. 6.
21. Section 112, Par. 3.
22. Section 118.



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tion is filed, an honest mistake of judgment is made as to whether a particular individual is, or is not, a joint inventor. Previous to this new act such a mistake usually constituted a fatal error that rendered the patent invalid. The new act permits the correction in a patent of a bona fide mistake in joining, or failing to join, a person as an inventor.[23] Other provisions permit adding or withdrawing inventors while the application is still pending in the Patent Office.[24]

The sections of the new statute discussed above by no means exhaust the list of liberalizing changes made by the 1952 Patent Act. But they cover what are thought to be the more important ones, and they amply demonstrate that the new law lives up to its title, which is

> An Act to *revise* and codify the laws relating to patents and the Patent Office, and to enact into law Title 35 of the United States Code entitled "Patents". [Italics added.]

Congress is to be congratulated[25] upon the fact that in thus revising and codifying the laws of patents it has again understood and carried out the public policy embodied in the patent clause of the Constitution. It has kept within the broad limitations expressed in the Constitution, and it has been liberal with inventors and inventions in using its power[26]

> To promote the progress of . . . useful arts by securing for limited times to . . . inventors the exclusive right to their . . . discoveries.

In fact, it is quite possible that the generally favorable attitude of Congress will be even more beneficial than all of the specific liberalizing changes discussed above. The fact that the 1952 Patent Act was passed by unanimous consent shows that Congress is in complete agreement with the conclusion that a strong patent system should be maintained in this country, and that the best public policy on patents is the liberal policy expressed in the Constitution.

23. Section 256.
24. Sections 116 and 118.
25. In September, 1952, the Section of Patent, Trade-Mark and Copyright Law of the American Bar Association adopted the following resolution:
"*RESOLVED*, That this Section goes on record as desiring to commend the Congress of the United States for revitalizing the patent system as an encouragement of invention in all fields, by enactment of the Patent Act of 1952, and to express appreciation especially to the members of the committees and sub-committees headed by Congressmen Celler and Bryson and Senators McCarran and Wiley".
26. U. S. Constitution, Article 1, Sec. 8, Language pertaining to copyright omitted.

# Omaha and Richmond

# Will Be Hosts to Regional Meetings

■ The Missouri Valley Regional Meeting of the American Bar Association will be held in Omaha, Nebraska, on April 30-May 2 under the general chairmanship of Clarence A. Davis, of Lincoln. The delegates will be welcomed by Governor Crosby of Nebraska, Laurens Williams, of Omaha, President of the Nebraska State Bar Association and W. W. Wenstrand, President of the Omaha Bar Association. Workshop programs will be held by the Sections of Real Property, Probate and Trust Law; Mineral Law; Insurance Law; Taxation; and the Junior Bar Conference. The workshop held by the Mineral Law Section, under the direction of Ray S. Fellows, of Tulsa, will feature outstanding lawyers familiar with the legal aspects of the oil and gas industry and should prove of great interest in view of the recent development of this industry in the Middle West. Harry B. Coffee, President of the Omaha Livestock Exchange, will speak at the dinner on April 30 and the Chairman of the Committee on Communist Tactics, Strategy and Objectives will speak at the luncheon on May 1. In addition plans call for a trial technique demonstration presided over by Joseph W. Henderson, of Philadelphia, and including on the panel Clifford W. Gardner, of Minneapolis, and Judge Gustavus A. Loevinger, of St. Paul. Another event of interest is the World Affairs Assembly introduced by President Storey, with Robert G. Simmons, Chief Justice of the Nebraska Supreme Court, and Frank E. Holman, of Seattle, as speakers. A tour of Boys Town, a tea and fashion show for the ladies and the Junior Bar Conference dance will be just a part of the entertainment provided by the committee. Reservations may be obtained by writing to Clarence A. Davis, Sharp Building, Lincoln, Nebraska.

From May 4 through 6 the Blue and Gray Regional Meeting will be held in Richmond, Virginia. Governor Battle of Virginia, Fred G. Greear, of Norton, President of The Virginia State Bar Association, Drummond Ayres, of Accomac, President of the Virginia State Bar and Melvin Wallinger, President of the Richmond Bar Association, will welcome the delegates. Workshops in taxation problems, real estate, probate and trust law, administrative law and trial tactics will be held. Speakers at the general session on May 5 will include Willis Smith, United States Senator from North Carolina, and Harry F. Byrd, United States Senator from Virginia. A reception given by the Richmond and Virginia bar associations and one held by the Bar Association of the District of Columbia, as well as the Junior Bar Conference dance, will be additional highlights. The general chairman, Charles S. Rhyne, 730 Jackson Place, Washington 6, D. C., reports that, while plans are as yet incomplete, various sightseeing tours to historic sites, including Williamsburg and Jamestown, will be arranged.

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