PATENTS
TRADEMARKS COPYRIGHTS
DEPARTMENTAL PRACTICE

by

RICHARD B. OWEN

of the Washington, D. C., Bar

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MAIN OFFICE
OWEN BUILDING, 620-22 F ST., N. W.
WASHINGTON, D. C.

BRANCH OFFICE
SUITE 809-10, 41 PARK ROW
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PREFACE

This treatise is intended primarily for members of the bar and others who are called upon to advise clients relative to the protection of industrial property and the safeguarding of good will. Being elementary in its scope, it is not designed as a textbook for the use of those who, themselves, are experienced in the practice of patent and trade-mark law. Neither is it written for the inventor, who, however, can derive benefit from its pages should it fall into his possession.

My object has been to place in the reader's hands something much more useful than a mere reminder of the nature and character of the service which I have rendered for many years to hundreds of attorneys throughout this continent and in many more distant places. Indeed, reference to my own facilities and methods has been limited as far as possible to such instances as where necessary information concerning procedure could not be satisfactorily imparted otherwise. It has been foremost in my mind to furnish, in a form for ready reference, the information and data necessary to enable counsel to answer the more important and frequently asked questions concerning practice with which they may not be entirely familiar. I believe members of the bar and others will find within the covers of this book much that is of interest—much that will enable them to increase the scope and value of the service which they are prepared to render their clientele.

Most counsel being inexperienced in patent and trade-mark practice do not realize its importance from the standpoint of their clients. Only too frequently both counsel and client let highly important interests go neglected. Those of us who specialize in patent and trade-mark practice frequently have those facts brought home to us. For example, there are probably as many trade-marks in use today in the United States that are not registered under the Federal Laws as there are those that have been so protected. Counsel who come into daily contact with these conditions are the ones who can, and should, remedy them for the benefit of their clients as well as the general industrial interests of the country. Doubtless you who read this have clients whose patent and trade-mark matters need attention. If this book is found helpful in the handling of such problems it will have well justified its existence.

Nearly every attorney has occasion at times to represent clients before various of the United States Departments or Bureaus in Washington, D. C. Departmental practice is full of pitfalls for the uninitiated, however, and as it differs widely from anything for which the average attorney has been trained, it appears that counsel very frequently overlook some of the most elementary considerations. A portion of this book has, therefore, been devoted to a brief review of a few of the elements involved in such practice. Attention thereto will, upon occasion, save time, money and mental distress. It is hoped that the reader will find many opportunities in his practice when he can refer to this book with profit.

RICHARD B. OWEN.

May 1, 1925.

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OUTLINE OF PROCEDURE IN PATENT CASES

(For full text on Patents, see page 6.)

The customary procedure in filing an application for patent in the United States upon any invention may be summarized as follows:

1. Obtain from the client a full disclosure of the invention. A model is satisfactory but unnecessary. Complete drawings or sketches will do nicely if accompanied by a detailed statement setting forth the construction, operation, advantages, etc., of the invention. See page 9 for further information relative to the disclosure of mechanical inventions. For designs see page 19 and for compounds page 18.

2. The foregoing disclosure should be placed in the hands of an attorney registered to practice before the United States Patent Office. If merely preliminary advice and information are desired, the disclosure need not be accompanied by a remittance. If a preliminary examination of the Patent Office Records (see page 10) is desired, a fee of $10 should accompany the disclosure. As soon as the examination is completed the results will be reported in detail.

3. If it is desired that an application for patent be prepared, collect and remit to the attorney handling the case the amount of first payment quoted by him in his report. With your instructions be sure to furnish the inventor's full name, address and citizenship. The necessary papers and drawings will then be prepared and forwarded to you for the client's approval and signature. (See page 15.)

4. After the application has been approved and signed, return it to the attorney representing you, together with the second payment of fees called for. The case will thereupon be filed into the Patent Office, the Official Filing Receipt being sent to you in due course.

5. You will be kept advised from time to time of events as they transpire while the application is pending and being prosecuted. When it is finally "allowed" the official notice will be sent to you. The final Government fee of $20 should then be forwarded by you within six months from the date of allowance, and paid into the Patent Office by the attorney handling the case. The patent will be issued in about four weeks thereafter and forwarded to you by registered mail.

OUTLINE OF PROCEDURE IN TRADE-MARK CASES

(For full text on Trade-Marks, see page 23.)

The customary procedure in filing an application for the registration of a trade-mark under the United States Statutes may be summarized as follows:

1. Obtain from the client a disclosure of the mark. (See "First Step Toward Registration," page 25.)

2. The disclosure should be forwarded to an attorney experienced in practice before the United States Patent Office, together with the required data as set forth on page 25. Unless the mark has been in use for a long time, a preliminary search of the trade-mark records of the Patent Office should always be conducted before an application for registration is filed. (See page 25.) The disclosure should, therefore, be accompanied with a remittance of $5. As soon as the examination is completed a report will be rendered as to the results thereof and the probable registrability of the mark.

3. If, after the report is received, it is desired to proceed with an application for registration, remit the first payment called for. The necessary papers and drawings will then be prepared and forwarded for the client's approval and signature. (See page 26.)

4. After the papers have been approved and signed, return them with the second payment of fees. The case will then be filed in the Patent Office and the official filing receipt forwarded to you in due course.

5. You will be kept advised from time to time relative to the progress of the case. When it is "allowed" the official notice will be sent to you. There is no final Government fee in trade-mark cases so that the certificate of registration is usually issued in due course after "allowance." As soon as received it will be forwarded to you by registered mail.

PATENT PRACTICE AND PROCEDURE

(For brief outline, see page 4.)

WHAT A PATENT IS

A patent (more properly called letters patent) is a document issued by the Government, under the seal of the Patent Office, addressed "To whom it may concern," and giving notice that the person (or persons) to whom the patent is issued is (or are) the inventor (or inventors) of the machine, compound, process or design disclosed thereby, and, having conformed to all requirements prescribed by law, is (or are) exclusively entitled to the right to "make, use and vend" the same within the United States and her territories for a period of seventeen years (except in the case of designs), at the end of which time the invention becomes public property, no extension of time being allowed except by special act of Congress. Patents for designs (see page 19 for full information) are granted for three and a half years, seven years or fourteen years, depending upon the wishes of the applicant and the amount of fees paid.

WHAT MAY BE PROTECTED

Any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement thereof, may be protected by letters patent, provided it has not been patented in a country foreign to the United States on an application filed more than twelve months before the filing of the application in this country, has not been in public use or on sale in the United States for more than two years prior to the application, and provided other requirements, not mentioned here, are not violated.

Patents are also issued to protect any new, original and ornamental design for an article of manufacture, provided the same requirements are fulfilled.

It might be pointed out here that nearly all patents cover improvements on old principles, and it is to be noted that most of the greatest inventors simply combine old elements to form a new and improved device.

WHO MAY APPLY FOR PATENTS

According to the Rules of Practice of the United States Patent Office, "a patent may be obtained by any person—upon payment of the fees required by law and other due proceedings had." Race, color, sex, age, nationality or citizenship make no difference—the benefits derived from our patent laws are open to all.

INVENTOR MUST APPLY

If the inventor is living, and is not insane or otherwise incapacitated, the application must be made by him and in his own name.

In case of the death of the true inventor before the application is filed, said application may be proceeded with by his executor or administrator; and, if the death occurs during the time intervening between the filing of the applica-

tion and the grant of the patent, the latter will issue to the executor or administrator upon proper intervention by him.

In case an inventor becomes insane, the application may be made by, and the patent issued to, his legally appointed guardian, conservator or representative.

JOINT INVENTORS

Where two or more persons collaborate, or work together, to produce a single invention, they have equal rights therein and any patent that may be granted thereon, and are known as "joint" inventors. Where, however, they each work on separate and distinct parts of the same idea, it is likely that they will develop distinct inventions, in which case they are not joint inventors, but must proceed as individuals, and file separate applications for patents.

Joint inventors are entitled to a joint patent; neither of them can separately obtain a patent for an invention jointly invented by them. The fact that one person furnishes the capital and another makes the invention does not entitle them to file an application as joint inventors. In such case the application should be made by the true inventor, who should assign an interest in the invention to the other party. They can then become joint patentees.

Employing a friend, mechanic, model maker or other person to do work for one on an idea does not, as a rule, make him a joint inventor with the originator. One has a right to employ someone else to do one's work. There are conditions, however, where such person would become a joint inventor, or even sole inventor. It is best to play safe and consult an experienced patent lawyer, laying before him all of the facts.

EMPLOYER AND EMPLOYEE

If one works out an invention while in the employ of another, using the employer's time, materials, etc., the latter will possess what is known as a "shop right" and can manufacture the invention in his own shop, for his own purposes, without authorization from the inventor. On the other hand, the mere fact that one is employed by another does not give the employer any right whatever to any invention that one works out during one's own time, at one's own expense, and with one's own materials, assuming, of course, that there is no existing contract to the contrary.

If one is especially employed to produce a certain result of a patentable nature, (such, for example, as a new machine, process or composition of matter) the invention, of course, belongs to the employer, although the patent is obtainable only by the inventor and may then be assigned to the employer.

These are merely general rules and cannot be applied to all cases. It is advisable to go thoroughly into each individual case on its own merits.

ATTORNEYS AND PATENT PRACTICE

Inventors are at liberty to file their own applications for patents in the United States Patent Office in Washington, D. C. The process of preparing, filing and prosecuting an application, however, has gradually become quite technical and very involved. Consequently, there are comparatively few inventors capable from a legal as well as a technical standpoint of obtaining their own patents. When such course is attempted, the Patent Office is usually prompt in advising the applicant to employ the services of a skilled attorney for his own

protection. In order that applicants for patents may receive the proper legal and technical service, the Patent Office recognizes as attorneys only those who are thoroughly experienced and have met all the requirements of the regulations of the Office, and have, consequently, been "registered" or admitted to practice. Hence, it is just as necessary for the practitioner of general law to acquire the services of a competent and thoroughly experienced patent attorney to aid him in the handling of his clients' matters, as it is for an inventor to exercise similar care in the selection of his counsel.

To those members of the Bar who require the services of associate counsel in Washington to represent the interests of their clients before the United States Patent Office, I offer my co-operation. I was registered in the United States Patent Office as an attorney in 1909, my registration number being 9475. Since then I have successfully represented in patent and trade-mark matters thousands of clients and associates residing throughout the world. My large practice has naturally given me a knowledge of many arts, industries and fields of invention. Under the rules of the Patent Office, a patent attorney need not be a lawyer in order to be registered, but I feel that the fact that I am a member of the Bar and a graduate of the law school of George Washington University, enables me to protect the interests of clients and look after the affairs of my associates legally, as well as mechanically, to the fullest extent and in the most efficient manner.

CHARGES IN PATENT CASES

Fees in patent matters are necessarily based on the amount of work involved in handling an invention so as to obtain the maximum protection. In order to do this properly it is essential that many different things be given careful consideration, including the character of the invention, the degree of technical skill and knowledge necessary to handle it, the number of sheets of drawings required to illustrate it, the draftsman's charges, the length of time necessary to prepare the papers in the right way, the probable number of amendments required during the prosecution of the application, and many other similar conditions.

It is obvious, in view of the foregoing, that there is no way in which fees may be accurately quoted until after a full disclosure of the invention in question is made. If, therefore, the client is desirous of having a more or less definite estimate of the cost of obtaining a patent, before he determines finally to proceed, it is suggested that you obtain from him a full disclosure of his invention as hereinafter explained. Forward this to me and I will give it immediate and careful attention, writing you without delay as to what I can do and how much I will charge for doing it. There is no fee for this information and none for answering any preliminary questions you may wish to ask.

It is customary in my office to bend every effort toward giving the very best of service, and I make no pretense of doing work for nothing that may be worth hundreds or thousands of dollars to the client. At the same time, my fees are quoted just as low as it is possible to make them consistent with the proper service and a very nominal profit.

MINIMUM CHARGES

The minimum fees to forwarding counsel for the filing of an application for mechanical patent are $75, this amount being payable in two installments, the first of $35 and the second of $40. The first payment includes the attorney fee for preparing the application papers, the second includes the Government filing

fee of $20, the draftsman's charges and the attorney fee for ordinary prosecution of the application after same has been filed. A final Government fee of $20 in every mechanical case is payable at any time within six months after the application has been actually allowed by the Patent Office.

These minimum charges are necessarily increased in cases which are not of the simplest nature, but will provide a fair indication of the probable cost of obtaining protection on any idea that may come before you. Cases falling within the scope of the minimum charge must be not only "simple," as regards mechanical construction, so that the drawings can be made at little expense and the specification be briefly prepared, but they must also be broadly novel so that the least possible prosecution will be required, and of a nature not involving high degree of mechanical, scientific or legal skill in order to properly handle. At all times you may be assured that my charges will not be excessive nor higher than those that would probably be made by other attorneys of reputation and standing. In fact, they will usually be found to be somewhat less in the long run.

YOUR CHARGES

Bear in mind that the above minimum charges are those quoted by me to forwarding counsel. In quoting fees to clients, therefore, associates should add to my estimate such amount as they see fit to cover their expenses and services. A minimum of $25 is suggested as proper wherever my minimum charge of $75 (including Government filing fee, draftsman's charges, etc.) is entered.

Many associates request that I include their fees in my estimate of charges when reporting upon an invention. Whenever it is found more convenient to handle cases in this manner, I am willing to quote fees to associates upon such a basis. Except where specific arrangements of that nature are made, however, my fees are quoted on a net basis. This applies not only to patents, but also to all other practice referred to in this booklet.

THE DISCLOSURE

The Patent Office no longer requires that a model be filed with the application. Inasmuch as an experienced attorney can handle a case just as well without a model as he can with one, provided rough sketches and a full description are furnished, it is well to advise inventors not to go to the expense and trouble of making one unless a complete disclosure of the invention is impracticable otherwise. If a model is already made, send it to me, express prepaid, or by insured parcel post, and accompany it with a detailed statement of the mode of operation, the advantages secured over competitive devices, etc. If you wish, you may send a set of photographs of the model.

If no model is readily available, do not have one made, but send a complete set of sketches, numbering each part shown and being sure that each part is given the same number in all of the different views. Then write a description of the operation and merits of the device, referring to the different parts by number. It makes no difference how rough the sketches are—I can understand any either you or the inventor are likely to make, provided your description is complete.

For the benefit of clients and all other inventors, I publish a blank form entitled "To Record Your Invention," which can be used to advantage in preparing the disclosure. This form contains much valuable information and data. It helps to preserve in good legal shape evidence upon which the proper establishment in the future of the inventor's rights to his idea may depend. Use it. I will

gladly send you copies—one for each of your client's ideas—irrespective of whether you intend to place the work in my hands or not. One of these forms should be filled out in accordance with the instructions which accompany it, before disclosing the idea to any attorney, manufacturer or anyone else.

In working out an invention most people delay making the disclosure until all the details are complete. This is often a serious mistake and many valuable ideas have been lost by this delay. As soon as the principle is worked out and the inventor has an operative device, it is frequently advisable to forward the disclosure and file the case if the state of the prior art warrants such a course.

DETERMINING PROBABLE PATENTABILITY

"Can I patent my idea?" is usually the first important question you are called upon to answer after a client has devised a worthwhile idea. In attempting to answer it a great many things have to be given careful consideration. Each individual case presents its own peculiar problem. It is advisable to bear in mind and impress the fact upon the client that there is only one infallible method of determining whether or not the Patent Office will grant a patent upon any particular invention. That is by filing an application for patent and letting that application take its course under the guidance of a skilled and experienced patent attorney. However, the average client desires some expression of opinion as to the possibility of obtaining a patent before he is willing to file an application. There are two ways of furnishing him with more or less reliable preliminary advice. One of these ways is by obtaining an expression of opinion from one thoroughly familiar with patent practice and, because of his experience, in a position to render a reliable preliminary report. The other is by obtaining a report as to probable patentability based upon a preliminary search of the Patent Office records.

PRELIMINARY INSTRUCTIONS AND ADVICE

Upon receipt of a full disclosure of an invention, I am glad to give it prompt and careful consideration, to report whether the idea may be patented if further procedure should prove it to be new, and to advise in detail as to the best procedure, the fees involved, etc. Thus the forwarding attorney is immediately put in a position to proceed further to protect his client's interests. It should be understood that this preliminary opinion is not based on a search of the Patent Office records. In the course of my long experience and wide practice, considerably over 100,000 inventions have been submitted to my office. Hence, I am often in a position to advise at once that some particular idea cannot be patented—thus saving much time and useless expense.

I make no charge whatsoever for a preliminary report based solely upon my opinion as above set forth, and welcome an opportunity to consider a disclosure of any invention a forwarding attorney submits for examination. With my report I include an estimate of the cost of preparing and prosecuting an application for patent.

PRELIMINARY SEARCH OF THE PATENT OFFICE RECORDS

Where there is a doubt as to the probable patentability of an idea a preliminary search of the Patent Office Records can often be conducted to advantage.

There are considerably over one and a half million United States Patents in existence. These are divided into approximately 300 main "classes," each "class"

relating to some particular general field of invention. "Classes" are in turn divided into from two or three up to over 500 "sub-classes," all patents in any one "sub-class" being more or less closely related insofar as particular construction or mechanical details are concerned. Theoretically, it should be a simple matter for an experienced man to search through pertinent sub-classes and find out whether a particular idea has ever been patented—but actually it is not as easy as the uninitiated might think.

In the first place a patent might be classifiable in any one of a number of different sub-classes, or even in different classes. Consequently, it will not always be found where one might believe to be the most likely place. Repeated hundreds or even thousands of times you will see that the troubles of a searcher begin to increase to an astonishing degree.

Then, too, these records which are open to public inspection are sometimes abused. Those unfamiliar with the routine of the Patent Office, and perhaps some who have little regard for Uncle Sam's property, occasionally remove patents of interest to them, in spite of the vigilance of attendants. In time this naturally results in incomplete classes and sub-classes and only partially accurate searches thereof.

These imperfections and inaccuracies in the classification of prior patents are remedied as fast as found, but it is utterly impossible to keep the records 100 per cent. perfect so long as the work is handled by human beings and the records are open to the public. Everyone handling the patent files makes mistakes occasionally, just as all of us do. The question of patentability is frequently one of judgment alone. Hence, too much reliance should never be placed upon a preliminary search of the Records.

Moreover, there are other things besides the existence of anticipating prior U. S. patents that might prevent one from obtaining protection on an idea—things which an ordinary search would not take into consideration. Patents granted in foreign countries, and matter published in text-books and treatises, catalogues, technical publications, advertising literature, etc., may affect the question of patentability. However, there is no practical means by which an attorney can extend his preliminary search through prior foreign patents and pertinent literature, and hence these must ordinarily be disregarded. The expense of attempting an adequate search through them would be many times greater than the cost of filing an application for patent upon an ordinary invention and letting the Patent Office dig through its Official Records and determine the fate of the case.

Neither can a preliminary search of the Patent Office Records extend through any applications for patents which may be pending. This is because of the fact that until an invention is actually patented it is not made public by the Patent Office. While an application is pending in the Office it is, naturally, maintained in absolute secrecy, and there is no way in which an attorney, not actually employed in the handling of a case, can obtain information concerning the same.

You can easily understand from these facts that a preliminary search of the Patent Office records is not as reliable and accurate as many believe. As previously stated, the only infallible method of determining whether or not the Patent Office will grant a patent on any particular invention is by filing an application and letting an experienced patent attorney prosecute it in the proper way.

If your client desires a preliminary search to be made in his case, kindly so instruct when you send the disclosure. Ordinarily, no search will be made unless,

and until, such instructions are given. I will gladly proceed and conduct a careful, thorough examination through pertinent prior United States Patents and send you, for consideration, copies of such as may be found that are, in my opinion, nearest to your client's idea and naturally affect his opportunity to obtain patent protection. With these copies at hand, together with my report, you and the inventor can decide whether to proceed further and file an application for patent.

CHARGES FOR PRELIMINARY SEARCHES

If you have a search made at all, you should have it made **Right**—otherwise it is **bound** to be a waste of time and money. The minimum charge is $10—and this may be considered as covering the cost in, perhaps, the majority of cases. In some cases, however, to make a thorough search through possibly dozens of "sub-classes" in which an anticipating patent might be found requires three or four days' time. Where an attorney charges only $10 for a search in such a case, just how thorough or painstaking can he afford to be? Where it seems necessary to spend additional time and make a more extensive examination in order to properly safeguard a client's interests I wish to feel free to do so. In such cases a reasonable additional charge is entered for the search and report, it being based entirely upon the time and work involved.

Your instructions to make a search through prior United States patents should be accompanied by a remittance of $10.

It should be noted that in the case of preliminary searches of the records the charges which I make to you are net and no portion thereof is refundable to you as forwarding attorney. You should, therefore, add to my charges such amount as you might deem proper in connection with each search in order to cover your work and time.

MY REPORT

Whether you wish merely my preliminary instructions and advice (without charge) concerning an idea, or whether you instruct me to conduct a thorough preliminary search of the Records, I will make as full and accurate a report to you as I can under the circumstances. There are frequently other considerations besides mere patentability which determine the advisability of spending money on an invention. For example, an idea might be susceptible of being protected by means of a patent and yet be so thoroughly impractical from the commercial standpoint that spending time and money on it would be gross waste. My experience and training frequently enable me to "weed out" such an invention and thereby save a great deal.

Again, there are often times when what appears to be a wonderfully clever and probably valuable idea is, unfortunately, of doubtful patentability. Should an application for patent be filed? Is it to the interest of the client to take a chance?

Occasionally it happens that a really valuable idea cannot be patented for one reason or another, but the client is in a position to make money out of it if there are any means by which he can get protection, even for a limited time. Is there any other way of protecting his interests?

My report answers these questions and many others as they develop. It takes into consideration not only patentability, but also practicability, probable ability of the client to make protection of real value to him, and numerous other

similar things which **should be,** but seldom **are,** given the careful consideration which they deserve.

As previously stated, my report also contains an estimate of the exact cost of the case. It will tell you just how much money the client will have to pay under ordinary conditions before he receives the patent—how much the application will cost—the amount of the first payment, etc.

TO SAVE TIME

Very frequently in patent matters circumstances develop which make it most urgent that an application be filed in the Patent Office at the earliest possible moment—and it is always advisable to avoid unnecessary delay. Under such circumstances I advise that the sketches, drawings or model be accompanied with a remittance of $25 or more, and a statement calling attention to the desirability of pushing the case rapidly. It will then be given immediate and special attention and, unless the idea appears not to be covered by the patent laws, the application papers will immediately be prepared and forwarded for your client's approval and signature.

On the other hand, if the idea should, in my opinion, be not of a patentable nature, I will notify you to that effect and refund all fees (unless a preliminary search through prior U. S. patents has been made in order to protect the client's interests, in which case the cost of the search will be deducted and the balance refunded.)

PREPARATION OF APPLICATION

Assuming that my report has proved favorable, that it has been decided to secure a patent and you have remitted the first payment of fees or more, the next step is to take up the preparation of the application. This is a much larger and more important task than any inexperienced person may imagine, and is one which should be attempted only by the most thoroughly experienced patent lawyer.

THE APPLICATION PAPERS

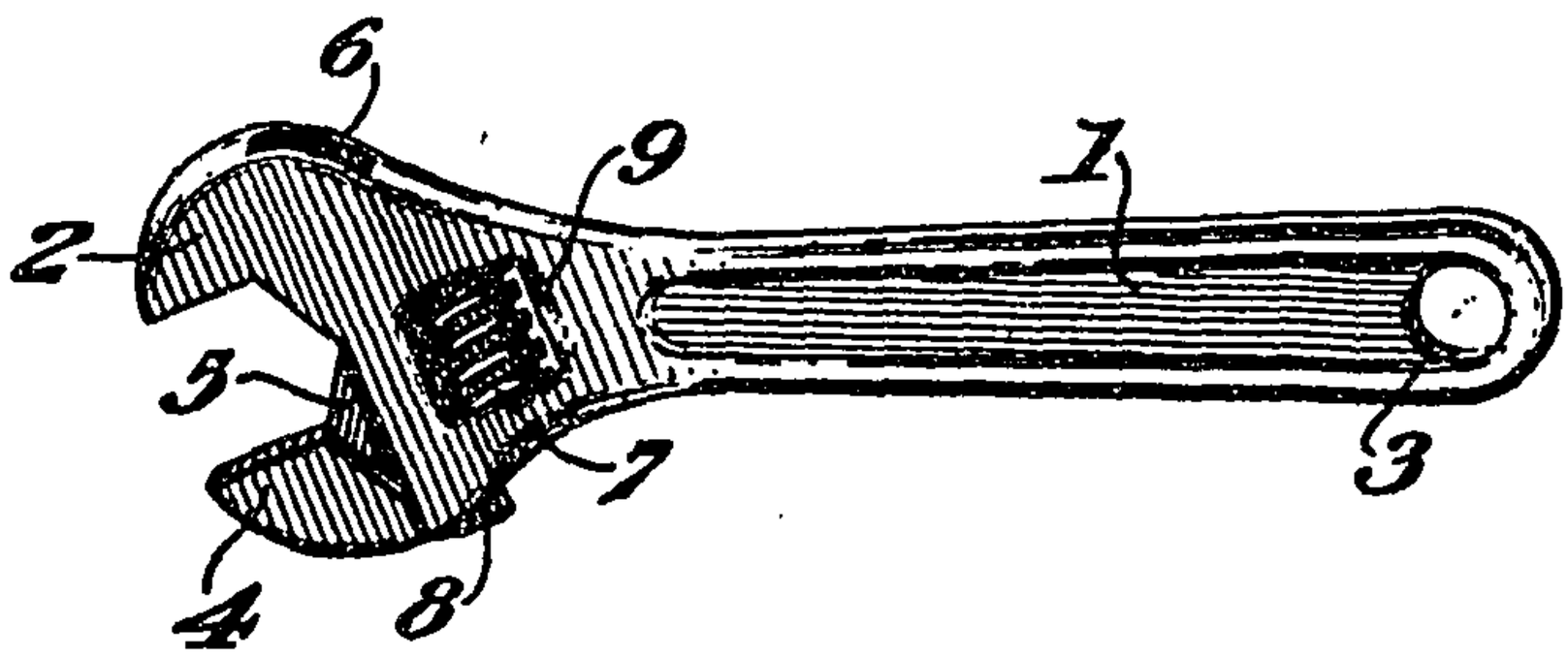
The application papers consist of a "Petition" addressed to the Commissioner of Patents, and asking that letters patent be issued to the petitioner; a "Specification," which is a complete description of the construction and mode of operation of the invention, if the latter be a machine or a disclosure of the process or compound if the invention be a process or a composition of matter, and, finally, an "Oath" stating simply that the applicant believes himself to be "the original, first, and sole inventor of the device described and claimed in the annexed specification." Other requirements are also inserted.

In the case of Topliff vs. Topliff (145 U. S., 156) the United States Supreme Court stated:

> "The specifications and claims of a patent, particularly if the invention be at all complicated, constitute one of the most difficult legal instruments to draw with accuracy, and in view of the fact that valuable inventions are often placed in the hands of inexperienced persons to prepare such specifications and claims, it is no matter of surprise that the latter frequently fail to describe with requisite certainty the exact invention of the patentee, and err either in claiming that which the patentee had not in fact invented, or in omitting some element which was a valuable or essential part of his actual invention."

The strength and value of the patent when procured depends very largely upon the skillful preparation of this paper. The description of the invention and the claims hereafter menticned, must be full, clear, concise and must be set forth in technical and legal terminology in, broadly speaking, certain accepted forms required by Patent Office practice and prescribed by usage, modified, however, to a large degree in each case by the character of the invention under consideration. It usually requires the services of a mechanical expert and an experienced attorney to skillfully draft this paper.

This portion of the application concludes with one or more "claims," which are summaries of the points of novelty of the invention disclosed by the specification, said claims also following certain fixed forms. If they are broad and in general terms, the patentee will be well protected, and will be the possessor of a worth while patent; but if, on the other hand, the claims are limited in scope, if they recite a multiplicity of exactly stated and unimportant elements, or if they are bad in any one of a number of other ways, the chances of success are small, the patent will be full of loop-holes of which infringers will be prompt to take advantage, the inventor will not have received all he is entitled to, nor all he has paid for, and, if the claims are very limited, it is more than likely that he will have obtained a patent not worth the paper upon which it is printed.



To understand this more clearly, observe the cut of a well-known form of wrench, which, let us assume, is your client's invention and which he wants to patent. This consists of a handle 1, terminating at one end of the fixed jaw 2, and having at the other end an aperture 3, by which the tool can be hung up. An adjustable jaw 4, has an extension 5, slidable in the way, or bearing 6. Adjustment is obtained by means of a milled worm nut, 7, which is geared to teeth 8, on the extension 5, the nut being mounted within an aperture 9, with its axis journaled in opposite walls of the aperture. Several very broad "claims" and a good many very limited ones, can be drawn to this device. For purposes of illustration, however, I will go to the two extremes, claim 1 being extraordinarily broad and claim 2 extremely narrow.

1. A tool having a handle, and means adapted to engage a nut.

2. A tool having a straight handle formed with an aperture at one end, a fixed jaw at the other end, a second jaw opposing the fixed jaw, an extension on said second jaw slidable through said handle near the end provided with the fixed jaw, teeth on said extension, a milled worm nut journaled in an aperture in said handle and engaging the teeth of said extension, whereby the second jaw may be adjusted with respect to the first jaw by the turning of said nut.

Can you imagine a nut wrench of any type that would not be covered by claim 1? A patent, containing this claim would be basic, and no one else could manufacture any kind, shape or size wrench out of any material with any desired adjustment or none at all, without first buying this patent or arranging to pay the patentee a royalty. Anyone manufacturing any wrench at all, whether it looked like this or was entirely different, would infringe this claim. The patentee could sue him for infringement, collect damages and enjoin him from further infringement. The inventor would have a loop-hole proof patent, assuming, of course, that the claim were patentable.

Now assume that one obtained a patent containing only claim 2. He would be limited strictly to the exact construction shown in the illustration and set forth in the claim. Any departure therefrom would produce a device different from the invention claimed and there would, therefore, be no infringement. If someone else made the wrench with a curved handle, or with two fixed jaws, or two adjustable jaws, or one adjustable jaw with a different means of adjustment, if they placed the worm nut on the outside instead of in the aperture, or if they made any one of a number of other little changes, they would not infringe the patentee's rights in any way. He could not stop them, could not collect royalties, and, of course, could not sell his patent because no one would pay money for something they could already manufacture without let or hindrance. The patent would be worthless.

Of course, there are many other claims, more limited than claim 1 and broader than claim 2, that a skillful attorney would insert in this application. Whether or not they would be worth while depends entirely upon how broad they might be. The strength and weakness of a patent lie in the specification and claims; the strength and weakness of the specification and claims lie in the hands of the attorney handling the case.

SIGNING THE PAPERS

After completing the task of drawing up the application, the papers and prints of the drawings are forwarded to you for your review and approval, and execution by the client. If, after receiving the application, it is found that there are slight corrections to be made, either in the specification or in the drawings, do not return them to me unsigned, and, above all, do not write the changes in the papers. Indicate them fully upon a separate sheet of paper, have the application signed and return it to me. I can then prepare and file an "amendment" with the papers, so that the changes may be properly incorporated therein; otherwise the work will have to be entirely rewritten at more or less delay, with the dangers incident thereto, and expense. Have the papers executed in every case as follows: On the first page the applicant's name should be signed to the "Petition" upon a line set apart and marked for that purpose. Then, on the last page he should sign near the very top to the "specification." I recommend that this signature be witnessed by two persons, who should place their names on the lines set apart for them. Finally, before a notary public or other officer having a seal, have the client sign the oath and the officer sign his name and official character on the line provided for that purpose and impress his seal on each page of the application papers, including the typewritten pages.

Be sure the client signs his full name just as it is typewritten in the papers.

In returning the papers to me remit the second payment of fees, as per quotation in case.

FILING THE APPLICATION

As soon as the application is returned, accompanied by the necessary fees, I file it in the Patent Office. A few days later the Office sends me a receipt acknowledging the amount of the fee and assigning a serial number to the case. This receipt I immediately forward to you.

PROSECUTION OF THE APPLICATION

As soon as the case is filed in the Patent Office, it is assigned to one of many Examining Divisions, where it is turned over to an Examiner, in whose charge it ordinarily remains until the patent is allowed. The Examiner makes an extensive search through prior patents, both United States patents and those granted by foreign nations. He then writes a letter to the attorney, calling attention to any informalities that may be present in the application, pointing out typographical errors, etc., and generally, rejecting the claims, or the broadest thereof, which have been presented, giving his reasons for so doing. The claims rejected by him in the first action are nearly always the best and most desirable ones from a protective standpoint, the more limited and less valuable ones usually being allowed. This gives rise to a practice which is very prevalent among some attorneys, particularly those whose fees are contingent upon getting a patent, of cancelling the best, but rejected, claims and taking out the patent containing only the limited ones allowed in the first action. Such practice assures them of their fees, for they have certainly secured a "patent," although it is unworthy the name.

To get good claims allowed the case must be "amended," that is, the wording of the claims must be changed so as to overcome the Examiner's objections, other claims must be drawn and substituted for the old ones, an argument must be prepared and presented to prove to him that the inventor is entitled to better protection, or he must be talked to personally and persuaded that his stand is untenable. Many little things can be done by a capable attorney to aid his client's cause. He must insist on everything he believes his client entitled to, take nothing worthless, fight his way tooth and nail, and not permit the patent to issue until he knows he can do nothing more to better the protection granted.



By referring again to the example of the wrench, suppose when the Examiner makes his search he finds a prior patent on a wrench of the type illustrated on this page. This constitutes what is called a good "reference." It is clear that claim 1 is so very broad as to include the construction of this supposed reference. The client, therefore, would not be entitled to this claim and the Examiner would accordingly "reject" it. On the other hand, claim 2, being limited to the exact structure, does not conflict with the construction shown to be old by the reference. Claim 2 would, therefore, probably be immediately "allowed" by the Examiner.

It now becomes necessary for the attorney to "amend" the application. If he is working for his fees, alone, and to save time and expense in handling the

case, he will cancel claim 1 and permit the patent to be granted containing only the worthless claim 2. Such a patent would be valueless. The patentee would have no protection and would have simply thrown away his money. It is obvious that claims can be drawn, much broader than claim 2, that do not conflict with the "reference." A conscientious attorney would, therefore, cancel claim 1, but substitute for it another reading somewhat as follows:

1. A tool comprising a handle, and means for engaging a nut, said nut engaging means being adjustable to different sizes of nuts.

This is a very broad claim—it would grant a valuable monoply—but it does not conflict with the "reference" because the latter is not "adjustable to different sizes of nuts." It is obviously allowable over the reference.

Sometimes cases must be "amended" four or five times or more before the Examiner will allow everything to which the client is entitled. In such cases it takes time to obtain the right protection, but it should be made an invariable rule not to permit a patent to be issued until one has obtained all the protection one can get for one's client—the amount of my time spent on the case is a secondary consideration.

From this example you can better understand the necessity of carefully selecting a competent patent attorney to represent you. An attorney must be conscientious, able and faithful to his trust, or he cannot hope to obtain a patent containing the broadest claims—and all of them—to which the applicant may be entitled.

THE ALLOWANCE

After the case has been duly prosecuted it is "allowed." This simply means that the Patent Office acknowledges that the invention is patentable and that a patent will be granted thereon as soon as the last requirement, the final Government fee, has been complied with. This is embodied in an Official Notice of Allowance which is sent to the attorney. I forward this notice to you immediately.

THE ISSUE

The final Government fee of $20 must be paid at any time within six months after the date of the Notice of Allowance, or else the case will become "forfeited." This fee should be sent to me and I will pay it into the Patent Office. The patent is then prepared and sent to me, I forwarding it to you as soon as received.

PROCESS PATENTS

Any new method of manufacturing a device, or of compounding a composition, should be protected at once, if it saves labor, consumes less or cheaper material, or requires less time than the old ways. I procure such protection at the same rates as are charged for mechanical patents.

Procedure in process cases is about the same as when the invention is a purely mechanical one. Send a full disclosure for consideration and a report as to probable patentability, cost, etc. Naturally this disclosure will comprise a full description of the new process, its advantages, results obtained, and so on. Where a new machine, or special apparatus, is necessary to the carrying out of the various steps of the process, or vital to its success, sketches, a model, or full description of same should also be sent so that the process itself can be better understood.

It sometimes happens that a process can best be protected by patenting any mechanical means employed to carry it out. Conversely, it is often the case that a mechanical invention can be better monopolized by patenting the process which it accomplishes—the work it does—should such be new and subject to the patent laws. (This does not refer to a mere function of a machine, which is not patentable subject matter.) Likewise the article produced by the process can, if new, be patented.

After receiving the disclosure I can better advise you upon these various phases of any particular case. There is, of course, no charge for preliminary advice.

COMPOUND PATENTS

Patents may be obtained upon new medical compounds, leather dressings, cosmetics, hair tonics and dyes, metal alloys, paving compositions, cements, soaps, explosives, fertilizers, disinfectants, insecticides, preservatives, veterinary remedies, paints, cleaning, polishing and sweeping compounds and the like, where invention is involved in making up the compound.

An intimate knowledge of chemistry and pharmacy is often required in the efficient handling of applications involving compounds. In fact, speaking generally from the attorney's standpoint, there is no field of invention more difficult to handle, none requiring greater skill and experience, than that involving problems of chemistry arising in the preparation and prosecution of cases on compositions of matter, etc. Statements made by clients and claims advanced by them are frequently questioned by the Examiner having charge of a case in the Patent Office, and are difficult of proof by the attorney.

The minimum cost to forwarding counsel of a compound patent and the several payments are as follows:

FIRST PAYMENT (retainer, sent with instructions to prepare papers)..... $35
SECOND PAYMENT (first Government fee, and attorney fee for prosecuting application, sent when papers are signed and returned for filing).... 45

MINIMUM COST TO FILE AND PROSECUTE APPLICATION..... $80

The usual final Government fee of $20 is payable within six months after the allowance of the application.

Send the first payment with a statement of the ingredients used; the proportions, thereof, either by weight or by measure; the method of mixing or compounding same, and the object accomplished or use to which the invention is to be put.

In a few cases of this character a drawing will be required which usually costs $10 per sheet extra. If such a case arises, I always advise to that effect before proceeding with the application.

To properly protect most compounds, including medicines, hair tonics and similar preparations, it is urgently advised that a trade-mark be registered in addition to the filing of the patent application. Many preparations now on the market are protected in no other way than by a trade-mark, but it is sometimes advisable to file an application for patent in addition to this.

DESIGN PATENTS

Design patents are issued for any ornamental article of manufacture, such as jewelry, statuary, furniture, lace and rug designs, vases, glassware, "fancy work," engravers' designs, and any similar article of an artistic nature. Such patents may often be obtained when a mechanical patent may not, and, being similar in nature to the latter, frequently bring in satisfactory financial returns.

This form of protection may be secured for varying lengths of time, the Government fee changing to conform with the time for which the patent is issued. For a patent limited to three and a half years the Government fee is $10, for one of seven years' duration, $15, and for one running fourteen years, $30.

The application can be filed for the minimum fee, with the right reserved to make an additional payment before the allowance of the case, thus obtaining protection for one of the longer terms. This is usually the best course to pursue.

The minimum fees to forwarding counsel are payable as follows:

FIRST PAYMENT (attorney fee ($20) and cost of simple sheet of drawing ($5) $25

SECOND PAYMENT (the Government fee—payable when papers are returned for filing).....Varies

There is no second Government fee in design cases, the above being the total cost.

PROCEDURE IN DESIGN CASES

The proper method of procedure in design applications is practically the same as in mechanical cases. First, send a disclosure of the idea in the form of drawings, sketches or a model. Upon receipt of this I can advise as to the probable patentability of the invention if it is new, etc. A preliminary search through prior United States Patents can be conducted if desired. In this connection see "Preliminary Search of the Patent Office Records," page 10 of this booklet.

If my report is favorable you can then remit the first payment and I will prepare the papers and send them to you for the client's approval and signature. Upon their return to me with the second payment, the case will be promptly filed in the Patent Office.

TIME REQUIRED TO OBTAIN PATENT

When applicants are not familiar with Patent Office practice and the method of prosecuting cases to obtain the proper protection, they are very apt to blame their attorneys for the time required to obtain patents when, as a matter of fact, the attorney may have been doing his level best. Everyone who files an application is, naturally, in the biggest kind of a hurry to obtain his patent, and makes that fact known to his attorney at frequent intervals and in no uncertain terms. This puts a conscientious attorney in a difficult position. If he rushes the case to please his client he is almost certain to sacrifice some protection—possibly all. On the other hand, if he takes the time necessary to obtain all the protection to which his client is entitled, he displeases his client, and, sometimes, sees the case taken out of his hands and placed with some other attorney. As protection is the whole object of a patent, I have made it a rule to conscientiously endeavor

to get that protection whenever possible, no matter how much time might be required. I advise that you carefully select an attorney and then let that attorney exercise his own judgment in prosecuting the case. If he has given you an estimate of the cost of handling the case before filing the application (as I invariably do when so requested) you can usually depend on him to dispose of it as quickly as he can properly do so, for the more time he takes the less profit he makes from the transaction.

It is impossible to say exactly how long a time will be required to obtain a patent. It depends somewhat upon the invention and a great deal upon to what division in the Patent Office it is assigned. Some divisions are six or seven months behind in their work. In such divisions it is frequently impossible to obtain a patent in less than two years. These are exceptional, however. Other divisions are not so far in arrears. A case assigned to one of these can usually be completed much sooner. The average case, properly prosecuted, will require a number of months' time from the date of filing to the date of allowance. This is allowing for the filing of from two to four "amendments."

Do not misunderstand me. Although I am not an advocate of speed, I am able to render very prompt service; although I endeavor to obtain protection first, last and all the time, nevertheless my system of handling cases is such that I am able to produce results as quickly as can anyone else. If you want speed I can give it to you just as I have to others, but please remember that I will not sacrifice protection—possibiy the invention—for the sake of saving a little time.

MARKING "PATENTED" AND "PATENT APPLIED FOR"

When an invention which has been patented is manufactured and placed upon the market it must be marked "Patented" and the date of the patent and, if possible, the number thereof should follow. Unless this statutory requirement is complied with the patentee will be deprived of his right of action against an infringer until after actual legal notice has been given and he is allowed due and reasonable time to act accordingly.

As soon as an application for a patent is filed the applicant has the right to manufacture and sell his invention under the mark "Patent Pending" or "Patent Applied For," unless, by so doing, he would infringe the rights of some prior patentee. This serves as a warning that steps have been taken to protect the device in question, and thus would-be infringers are prevented from entering into competition.

In order to use this mark, applications are often filed when it is rather doubtful if a patent will ever be issued, the case being kept pending from year to year by the attorney. Many valuable ideas are guarded in this manner. If interested, write me for further particulars.

ASSIGNMENTS

No one but the first and true inventor can secure a patent. When others wish to obtain the right to an invention it must be assigned to them by the inventor through an instrument in writing. The latter must be recorded in the Patent Office within three months from the date thereof, or prior to any subsequent purchase or mortgage, or it will be invalid as against such subsequent purchaser or mortgagee who has no notice of the prior sale.

Where the inventor obtains the necessary application fees from another person in return for an interest in the patent rights, they are not joint inventors, and therefore cannot together apply for a patent. The true inventor must apply and then assign an interest to the other party.

When instructing me to prepare an assignment, the full name of the assignor and assignee should be sent together with their places of residence, the amount of interest conveyed and the consideration or amount paid for such interest, if it be desired that the latter appear in the assignment.

The total cost of an assignment of ordinary length is $5, which includes the Government fee for recording it, provided the latter does not amount to more than $2.

There is one thing which should here be considered, but which is almost invariably misunderstood by inventors and only too frequently overlooked by attorneys. If you owned a 100-acre farm and sold 50 acres, could you gather the crops from, rent, or prevent the purchaser from using the half so sold? Certainly not. Neither could you collect half of his profit. You would have absolutely nothing more to do with the half interest sold from your original whole. It is exactly the same way with a patent. If you absolutely sell an undivided interest, no matter how small or how large, you have nothing more to do with it. The buyer can promote his interest independently of the seller and need not account to the latter to the extent of a single cent he might earn.

If an applicant or patentee wants to sell, say, a half interest, with the idea that he and the buyer of the interest shall co-operate, divide profits between both, etc.; in other words, if they are entering into partnership relations, a special contract must be drawn clearly defining the agreement as well as making the transfer in title. The cost of such an agreement is usually $10, including the Government fee for recording it.

Another way of arriving at practically the same result is by making the assignment to a trustee, who will hold title for the parties in interest under conditions specified in the agreement. This form of contract also usually costs $10.

INFRINGEMENT AND GENERAL COURT PRACTICE

Being a graduate lawyer and a member of the bar, I am prepared to represent interests in court at any time. Although I specialize in patent and trade-mark practice, I will accept any other cases that I can handle to the proper advantage.

I am prepared also to act as associate counsel in all matters involving infringement and validity of patents, infringement of trade-marks, unfair competition, etc.

PATENT AND TRADE-MARK SERVICE ON ANNUAL BASIS

It is advantageous in many cases that clients be kept constantly advised of developments in the United States Patent Office concerning the arts or industries in which they and their competitors are most interested. I am prepared to render an efficient service to associates that will enable them to keep their clients promptly informed of matters of interest. The details of this service necessarily vary in each instance, but it includes furnishing a copy of each patent granted each week in lines in which they are interested, watching trade-mark registrations for infringements of clients' rights, furnishing copies of registrations granted to competitors, etc. In this manner a manufacturer may be kept fully informed at a comparatively small expense, of all improvements and other developments that occur in his line.

The fees for this service are dependent upon the time involved, the nature, extent and activity of the art, etc. A quotation will be gladly furnished for any client upon receipt of information concerning the service to be rendered.

TRADE-MARK PRACTICE AND PROCEDURE

(For brief outline see page 5.)

TRADE-MARKS DEFINED

A trade-mark may be defined as a distinctive name, mark, sign, word or words, design, symbol, emblem or device, applied or affixed to the product, goods or merchandise of the owner for the purpose of distinguishing same from the products, goods or merchandise of others, or of authenticating the origin or ownership of the goods in connection with which it is used. It is a tangible representation of intangible good will, is inseparable therefrom, and, hence, may and frequently does become of tremendous value.

ADVANTAGES OF FEDERAL REGISTRATION

The basic trade-mark law of the United States is the statute of February 20, 1905. This has been amended by the acts of May 4, 1906; March 2, 1907; February 18, 1909; February 15, 1911, and March 19, 1920.

The advantages gained through registration of trade-marks under the Federal Laws are many, chief among them being:

1. Registration supplies prima facie evidence of ownership. The burden of proof lies with him who questions the registrant's rights.
2. Registration is a substitute for years of continued use at common law.
3. Registration under Federal laws carries with it the right to sue for infringement in a Federal court. It does away with the possible necessity of litigation in a plurality of State courts.
4. Federal courts are given express authority to restrain and prevent infringements of a registered mark, and to award exemplary as well as actual damages to the injured party, provided, however, that the exemplary damages shall not exceed three times the amount of actual damages found.
5. A registrant may lay claim to all profits derived by an infringer from his illegal transactions, as well as all packages, etc., in the possession of the infringer and showing the unlawful mark.
6. Registration in the United States enables the owner of a trade-mark to easily effect registration in foreign countries, under the laws of many of which registration at home is a condition precedent.
7. The registrant under the Federal laws is enabled to prevent admission into the United States of foreign goods, products or merchandise of the same class bearing the same or a conflicting mark.
8. A registrant is entitled to the benefits of the International Convention for the Protection of Industrial Property, including the rights of priority for filing applications for the protection of trade-marks in all the countries belonging to the Convention—now numbering 38.
9. If an application for registration has been filed in a foreign country which by law, treaty or convention, grants similar rights to citizens of the United States, an application in this country is given the same force and effect as if filed on the date of the first foreign application, provided it is filed in the United States Patent Office within four months from the date of said foreign application.

TERM OF REGISTRATION

Registration of a trade-mark under the Federal laws is ordinarily for a term of twenty years. Where, however, registration has previously been effected in a foreign country, the United States registration ceases to be in force as of the date on which the foreign registration terminates, provided such period does not exceed twenty years.

Upon expiration a registration may be, and should be, renewed for another term upon the payment of a new registration fee.

WHAT MAY, AND MAY NOT, BE REGISTERED

Under the Act of 1905, any trade-mark may be registered under the Federal Laws except those which fall within the following limitations:

1. No mark may be registered which consists of, or comprises, immoral or scandalous matter.

2. No mark may be registered which consists of, or comprises, the flag or coat of arms or other insignia of the United States, or any simulation thereof, or of any State or municipality, or of any foreign nation, or of any design or picture that has been, or may hereafter be, adopted by any fraternal society as its emblem, unless it is shown to the satisfaction of the Commissioner of Patents that the mark was adopted and used as a trade-mark by the applicant or applicant's predecessors from whom title is derived, prior to the date of its adoption by such fraternal society as its emblem. The use of the insignia of the Red Cross is specifically prohibited.

3. No mark may be registered which is identical with a registered or known trade-mark owned and in use by another for merchandise of the same descriptive properties, or which so nearly resembles such a mark as to be likely to cause confusion or mistake in the minds of the public, or to deceive purchasers.

4. No mark may be registered which consists merely in the name of an individual, firm, corporation, or association, not written, printed, impressed, or woven in some particular or distinctive manner or in association with a portrait of the individual, but this does not prevent the registration of a trade-mark otherwise registrable because of its being the name of the applicant or a portion thereof.

5. No mark may be registered which is descriptive of the goods with which it is used, or of the character or quality of such goods, or which is merely a geographical name or term.

6. No mark may be registered which is a portrait of a living individual except by the written consent of such individual.

7. No mark may be registered which is used in an unlawful business, or upon any article injurious in itself, or which is used with the design of deceiving the public in the purchase of merchandise, or which has been abandoned.

ACT OF 1920

Under the law as amended by the act of March 19, 1920, any trade-mark may be registered except those falling within the scope of paragraphs 1, 2 and 3, above, provided it has been in exclusive use for at least one year. The attention of all clients should be directed to this fact, as there are thousands and thousands of trade-marks in use in the United States which could not be registered under the 1905 act, but may be so protected under the 1920 amendment. For the benefit of the owner, the public, and other members of the trade (who might otherwise easily become innocent infringers) all such marks should be registered.

FIRST STEP TOWARD REGISTRATION

Although the law is fairly clear as to what marks may be registered, the application of the law to particular cases is not always easy, even for one skilled in this practice. It is recommended, therefore, that in each case a disclosure of the mark be obtained and forwarded for a definite opinion. This will be gladly rendered without charge except where a preliminary examination through prior registrations is desired in order to answer the questions raised by paragraph 3, supra.

If the trade-mark is in use, the best disclosure is a copy of the label, tag, name plate, or container, showing it exactly as used in commerce. If the mark has not actually been used, the disclosure may be a sketch of the proposed design, name, etc., which it is desired to adopt, or merely a statement or description thereof.

INFORMATION NECESSARY

The above disclosure should be accompanied by the following information in order that an application for registration may be properly prepared:

(a) Name and address of owner of mark. If owner is a corporation, give State in which incorporated and name and title of officer who will execute application papers for registration. If a firm, give names of all members thereof, and name of him who will sign papers.

(b) State nature of merchandise in connection with which the mark is used.

(c) State date, or approximate date, when mark was first adopted and used in interstate commerce.

(d) State the manner in which the mark is applied or affixed to the merchandise.

(e) State whether the mark is used in interstate or foreign commerce, or with Indian tribes.

(f) State whether the mark is registered in any country foreign to the United States. If so, in what country, or countries, and date when so registered or when registration was applied for.

PRELIMINARY SEARCH

Copies of all trade-marks that have been registered are classified and open to inspection. In order to determine whether or not a mark falls within the restriction imposed by paragraph 3, supra (page 24), or has been previously registered for the same class of merchandise, a search through prior registrations in such class may be conducted. Although the results of such a search are not

final, it is nevertheless advisable in most cases that it be made. It is particularly advantageous where a new mark is about to be, or has been adopted.

My charge for a preliminary search on each trade-mark is $5, this being my net fee. Where a search is desired this fee should be remitted with the above-mentioned disclosure and data. It will be promptly conducted and a full report rendered as quickly as possible.

PREPARATION AND FILING OF APPLICATION

Upon receipt of instructions, accompanied by the first payment of fees as called for, the necessary application papers for registration will be prepared. These, together with a photographic print of the official drawing as prepared for filing in the Patent Office, will be promptly forwarded for the client's approval and signature.

These papers are to be returned after execution and should be accompanied by six duplicates of the mark as used if the copies have not been previously sent. The balance of fees called for should also be remitted.

The application will thereupon be promptly filed into the Patent Office and the Government receipt forwarded to you by me as soon as received.

PROSECUTION, ALLOWANCE AND ISSUE

An application for the registration of a trade-mark must usually be prosecuted before an examiner in the Patent Office in a manner similar to patent applications. In due course, if the application is found unobjectionable, it is allowed and a certificate of registration issued. This certificate I will promptly send to you by registered mail.

COST OF REGISTRATION

The minimum charge to forwarding counsel for registering a trade-mark is as follows:

Attorney fee for preparing, filing and prosecuting application for registration	$25.00
Government fee	10.00
For official drawing	5.00
Total	$40.00

The Government fee is payable upon the filing of the application, and never varies. Where the handling of the application presents conditions not of the simplest nature the attorney fee is increased to compensate therefor. The exact charge, however, is quoted in advance upon request. The cost of the drawing may be increased in some cases where the mark is complicated or unusually ornate.

OPPOSITIONS

When an application filed under the act of 1905 is found to be allowable, the mark is published in an issue of the Gazette of the United States Patent Office. Any person who believes he would be damaged by the registration of the mark may, within thirty days, file a notice of opposition thereto. The Examiner of Trade-Mark Interferences then takes jurisdiction of the case and directs the procedure, which follows equity practice as closely as possible.

Only a small percentage of applications are opposed. Hence the customary fees do not include opposition proceedings. This is highly specialized work, must be expertly handled, and fees are necessarily quoted to conform with the conditions in each case.

Applications filed under the act of 1920 are not subject to opposition.

CANCELLATIONS

An application for the cancellation of a registered trade-mark may be filed at any time by any person who deems himself to be injured by such registration. The Examiner of Trade-Mark Interferences takes jurisdiction and directs procedure which closely follows equity practice. The registrant must defend his right to the mark.

If it appear from the evidence that (1) the registrant was not entitled to the use of the mark at the date of his application for registeration thereof, or (2) that the mark is not used by the registrant, or (3) that the mark has been abandoned, the registration will be cancelled.

Cancellation proceedings may be brought against registrants under the act of 1920 as well as those under the basic law of 1905.

Fees in cancellation cases must necessarily be quoted in each case to conform with the conditions therein.

INTERFERENCES

If an application is filed for the registration of a trade-mark which is substantially identical with a mark used on merchandise of the same class for which application for registration has been made by another, or for which a certificate of registration has been issued to another, an interference proceeding may be instituted by the Patent Office to determine the rightful owner of the mark. Testimony is taken by the parties designed to support their respective claims, a hearing is had before the Examiner of Trade-Mark Interferences, and judgment rendered in accordance with the facts.

Skilled service is necessary in interference matters. The fees are dependent on the time involved and other conditions varying in each case.

INFRINGEMENT

Suits involving the infringement of registered trade-marks come under the jurisdiction of Federal District Courts and the Supreme Court of the District of Columbia. The Patent Office is not concerned. I offer my services as counsel or associate counsel in all infringement matters.

REGISTRATION IN FOREIGN COUNTRIES.

The importance of registering valuable trade-marks in every foreign country into which goods are being shipped, or may be shipped in the future, cannot be emphasized too strongly for the protection of one's clients. It is business insurance of the highest order—insurance which costs comparatively little per year to take out, but the lack of which may prove tremendously expensive as well as embarrassing. The laws of many countries, especally those of South America, permit trade-mark pirates to thrive, and many a United States manufacturer has lost his foreign market as a result.

Whereas in the United States the right to a trade-mark is acquired by its adoption and maintained by its use, registration being obtainable only thereafter,

that is not true in the vast majority of other countries, wherein registration is either conclusive evidence of ownership or else becomes conclusive after a limited time if the registration is not contested. Hence, in most foreign countries, any person may register any trade-mark which has not already been registered in that country by someone else. He becomes the owner whether or not he ever uses the mark.

These conditions offer many profitable opportunities to "pirates," who sometimes are merely individuals acting for themselves with an eye to the future, and sometimes are representatives of competitors who are quick to adopt this inexpensive and deadly means of keeping high quality, well-advertised goods out of the market. It seems as though the United States market is closely watched abroad for new marks which can be so pirated. The United States Department of Commerce, through its representatives and its Commerce Reports, has frequently warned our manufacturers and exporters against these conditions. It is a situation which should be brought aggressively to the attention of every client who ships to foreign countries or whose business may ever extend abroad. If he does not protect his interests promptly he may, at any time, find himself in one or more of the following predicaments:

1. In countries where registration is conclusive proof of ownership, he must either refrain from using his own mark or else purchase the right to use it from the registrants—usually a very expensive alternative. In many countries his goods will be confiscated upon arrival because they infringe a mark which is rightfully his own! In nearly all he will be liable for damages to the registrant.

2. In those countries where registration is not conclusive evidence of ownership he can protect or regain his rights only through long drawn out and expensive litigation before some perhaps none too friendly tribunal.

3. The only other alternative is to adopt an entirely new mark for use in those countries in which he cannot use the original one. That means total loss of prestige and good will built around a mark which it may have taken years of time and many, many dollars to establish.

For the benefit and protection of the growing export trade of this country, as well as the good of those directly concerned, these conditions should be brought to the attention of all whose interests warrant.

I am able, through connections extending into every country having trade-mark laws, to serve the interests of clients in any country. I will be glad to quote fees, requirements and conditions involved in any country, or group of countries, upon request.

PRINTS AND LABELS

The copyright statutes provide for the registration of prints and labels, these terms being nearly synonymous, the distinction lying in the fact that labels are usually regarded as being applied directly to the manufactured article or to the container of the same, while prints are not used directly upon the article itself, but in some manner related thereto, such for instance, as in advertising. Because of the close relationship between copyright registration of prints and labels and the registration of trade-marks, jurisdiction over prints and labels is given to the Patent Office rather than to the Copyright Office.

The total cost to forwarding counsel of securing the registration of a print or label is $20. This includes the Government fee. Send me ten copies of the print or label to be registered, and a first payment of $10 together with the name and address of the client. If the client is a corporation, state the name of the jurisdiction under which incorporated and the name of the officer, or officers, who will execute the application papers, together with his official title. If the client is a partnership, state the names of all of the parties and the name of that member of the firm who will execute the application papers. The papers will then be prepared and forwarded for signing. The balance of the fees is payable when the application is returned to me to be filed.

Prints and labels to be copyrighted must first be published with the copyright notice thereon as follows: "Copyrighted, 192...., by ....." The ten specimens sent to me should bear this notice.

COPYRIGHTS

Any citizen of the United States or any resident thereof, who is the author, inventor, designer, or proprietor of any book, map, chart, dramatic or musical composition, engraving, cut, print, photograph, painting, drawing, chromo, statue, statuary, or of models or designs intended to be perfected as works of fine art, may secure protection for the same by means of a copyright.

The duration or term of the protection afforded by a copyright is 28 years, and this may be extended for a further period of 28 years.

Under the present Copyright Law protection cannot be secured until the time of publication, doing away with the provisions of the older law whereby registration might be had before publication. The notice of copyright must, therefore, be inserted before the right is actually obtained. The form now required by law is:

"Copyrighted, 192...., by....."

PROCEDURE

Send two copies of the work to be copyrighted, or, in the case of a painting, statue, or the like, two photographs or copies thereof, accompanying this with the full name and address of the claimant; the name of the author, composer, or artist, in case he is a different person from the claimant; the title of the work; the price thereof; the exact date of publication; and, in the case of printed matter, state the date upon which the printing of the text was completed, and when the binding was finished. I will then prepare the necessary affidavit and forward it to you for your client's approval and signature.

COST OF COPYRIGHTS

The total cost to forwarding counsel of a copyright through my office is only $10—this including my fee and the Government fee.

These rights may be assigned just as patent rights are. Such assignments should invariably be recorded in the usual manner. My charge for attending to the preparation and recording of such transfers is $10, including a recording fee not to exceed $2.00.

There are many peculiar problems involved in copyright practice and procedure which space does not permit my setting forth. I shall be glad, however, to advise in connection with any special copyright matters which may develop in the course of your practice.

DEPARTMENTAL PRACTICE

There are but few attorneys at law in the United States who do not have occasion, sooner or later, frequently or infrequently, to represent clients before one or another of the Government departments, bureaus, or offices located in the Nation's Capital. In fact, there is a constant stream of lawyers flowing to and from Washington. In a great number of cases long journeys are uselessly made to this city. It is impossible in a treatise of the present nature to fully cover the intricacies of departmental practice. I'll not attempt it. But observation of the following series of notes and hints touching upon some of the elementary considerations will be found worth while by practitioners not thoroughly versed in this work:

First, bear in mind that either I personally, or some member of my staff, am here to serve you in conjunction with any Washington matters that may develop in your practice. With the exception of matters coming before the United States Patent Office, however, I solicit only cases involving a substantial fee.

In dealing with Uncle Sam much "red tape" is necessarily encountered. It can be more easily cut with smiling patience and persistence than in any other manner.

Try to find out before coming to Washington who it is you must see to accomplish the desired object. By so doing much time and possibly a useless trip will be saved.

Arrange an appointment in advance with the proper official. In some instances this is required by rules or regulations—especially in the Internal Revenue Bureau. It will always avoid your arrival when the man you want is out of town.

Don't approach a departmental matter in an antagonistic mood. Almost invariably the proper official will give your matter courteous consideration. Otherwise resort may be had to legal measures.

Provide yourself with a proper power of attorney from your client. You may be asked for it at any time, and in many cases it is required.

In order to practice before any of the following departments or bureaus you must be formally admitted to their bars in accordance with their regulations:

1. Department of the Interior.
2. Treasury Department.
3. Post Office Department.
4. Patent Office.
5. General Accounting Office.

According to present advices any attorney in good standing in the courts of his own jurisdiction may represent clients before the following departments, bureaus and commissions which keep no register of attorneys:

1. Department of Agriculture.
2. Department of Commerce.
3. Department of Justice.
4. Department of Labor.
5. Department of the Navy.
6. Department of State.
7. Department of War.
8. Alien Property Custodian.
9. Civil Service Commission.
10. Copyright Office.

11. Employees' Compensation Commission.
12. Federal Power Commission.
13. Federal Trade Commission.
14. Interstate Commerce Commission.
15. Railroad Administration.
16. Shipping Board.
17. Tariff Commission.
18. Veterans' Bureau.

Many departments and bureaus have elaborate rules of practice and regulations. A working knowledge of these will save many a heartache. In most instances they are published in pamphlet form and may be had by mail on request.

Attorneys prosecuting claims before the Government must usually take the "oath of allegiance." See Sections 3478, 3479, and 1757 of the Revised Statutes.

In many instances, the fees that an attorney may charge a client in handling a claim before a Government tribunal is fixed by law. It is well to step carefully as a violation may mean a heavy fine, or imprisonment, or both. For example, an attorney can charge only $3 for assisting a client to prepare and execute the papers in a claim before the Bureau of War Risk Insurance. There is a possible fine of $500, or imprisonment at hard labor for two years, or both, awaiting the attorney who considers his time more valuable.

The record is of prime importance. See that it is complete and that oral understandings are reduced to writing and filed in the record.

Specifically request that all correspondence be addressed to you as attorney. Otherwise a double correspondence may result in delays.

YOUR WASHINGTON HEADQUARTERS

While in Washington make your headquarters in my offices if you find it convenient to do so. Mail privileges, the use of a conference room, my library, and other conveniences are at your disposal without charge. Stenographic and telephone service are yours at cost. However, time spent with you on your work by me or members of my staff must, of course, be charged for.

Hotel and other accommodations in Washington may be arranged for through my office if you will advise me in advance of your requirements.

IMPORTANT NOTES

Terms—My fees are invariably quoted on a most conservative basis. For this reason, as well as because of the large number of small charges that would otherwise be involved, I cannot ordinarily carry accounts on my books. Fees should be remitted as called for.

Remittances—Remittances should be made by certified check, draft, cashier's check, or money order, especially where Government fees that must be promptly paid are involved. Uncertified personal checks will be accepted subject to collection.

Correspondence—Important mail such as that enclosing remittances or including disclosures of inventions, or other valuable papers, should be registered.

Counsel are expected to conduct all the correspondence in behalf of clients. A double correspondence will not ordinarily be conducted from this office. I will not correspond direct with clients in any event except with the permission of forwarding counsel.

WHAT IS ASSOCIATE PRACTICE?

To avoid misunderstanding as to the division of fees, I have found it necessary to strictly adhere to certain fundamental principles as follows:

1. Associate cases are those forwarded to me by other counsel in behalf of their clients.
2. Cases in which forwarding counsel are also the principals are not regarded as associate cases.
3. If a client writes direct to me and engages my services, fees in such case cannot thereafter be divided with other counsel under any conditions, and the latter must look to the client for his compensation.
4. Counsel desiring to employ my service should, therefore, write to me themselves and not merely furnish my name and address to the client.
5. It frequently happens that the client endeavors to retain my services direct in connection with subsequent matters. Such employment will not be accepted, unless with the approval of the associate, or where the client's own interests appear to demand.

AN INVITATION

Preliminary advice and information in connection with all matters falling within the scope of my practice will be gladly furnished. You are invited to write me freely with the understanding that you will not be placed under any obligation not previously agreed upon.

SCHEDULE OF CHARGES

The following charges are made to associates for the services specified. In each instance Government charges are included.

Applications for patents—minimum in mechanical and process cases	$75.00
Applications for patents—minimum in compound cases	80.00
Applications for patents—minimum in design cases:	
3½ years	35.00
7 years	40.00
14 years	55.00
Applications for registration of trade-marks—minimum	40.00
Applications for registration of prints or labels—minimum	20.00
Applications for copyrights	10.00
Assignments, for preparing and recording	$5.00—$10.00
Copies of patents, uncertified—per copy	.25
Copies of patents, certified—per copy	1.50
Copies of Patent Office records, manuscript, for every 100 words or fraction thereof, uncertified	.25
If certified, additional	1.00
Copies, photographic, of drawings in cases not filed, per copy	.25
Copies, photographic, of drawings in cases after filing	.50
If certified, additional	1.00
Recording assignments, agreements, etc., of 300 words or under	2.50
Of over 300 and under 1,000 words	3.50
For each additional 1,000 words or fraction thereof	1.50
Searches of Patent Records, minimum	10.00
Searches of Titles, minimum	5.00
Searches of Trade-mark Records—minimum	5.00
Title, Official Abstracts of, minimum	7.50

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