REASONS

FOR

Opposition to Certain Proposed Changes

IN THE

PATENT LAWS.

Submitted to the Committees on Patents of the U. S. Senate and House of Representatives by a Committee of Inventors, Solicitors, and Attorneys.

MARCH, 1870.

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To the Hon. COMMITTEES ON PATENTS *of the*
Senate and House of Representatives of the United States:

The undersigned, a Committee appointed at a meeting of the Solicitors and Attorneys practicing before the U. S. Patent Office, to represent their interests before you in view of proposed changes in the existing patent system, beg leave to present the following considerations to your notice in reference to some of the modifications of the patent law which have been suggested by the Commissioner of Patents in his last annual report, and in the *projet* of a law which he has submitted to you.

We beg to say at the outset that we entertain for the present Commissioner of Patents unfeigned respect and regard. His uniform courtesy and urbanity, as well as the ability, industry, and promptitude with which he discharges the duties of his onerous and responsible office, have attracted our admiration; and we sincerely regret that it has not been in our power to agree with him in the views he entertains of the most proper mode of correcting the existing defects in our patent system. We have deemed it our duty to our own convictions to present to you some of the reasons which have induced us to differ from the Commissioner in regard to some of the proposed changes, and, representing as we do by far the greater proportion of the patent business of the country, we hope to secure for our representations the candid consideration of the Committees charged with the revision of the law.

The points on which we differ more or less widely with the Commissioner are those in reference to

1. Reports and Drawings.
2. Rules.
3. The Question of Abandonment.
4. Abolition of Appeals.
5. Reissues.

The importance of the interests involved in any change of the patent law need scarcely be insisted upon. The number of applications for patents has increased to twenty thousand per annum, and the pecuniary interests involved have increased in a still greater ratio; for with the growth of our manufacturing interests, it is not at all uncommon now to find establishments having from half a million to several millions of dollars capital employed; and there is scarcely a single manufacturing interest or establishment in the country to-day, that is not based upon one or more patents. Take, as an illustration, the Union Metallic Cartridge Company, which employs 300 operatives, their works covering five acres of ground, and in which they have invested half a million of cash capital, and that for the manufacture of so small an article as the copper cartridge; or the Remington Gun Factory, employing over a thousand hands, and involving a capital of at least two millions; or the Burnside Co.; the Winchester Co.; the Sharp Co.; or going westward, take the great manufacturing establishments which supply the immense West with its agricultural implements—the plows, the cultivators, the drills, and reapers, and threshers—without which the West would soon cease to be the "granary of the world," and the business of every one of which is based upon patents. Take any of these, and multiply its capital and its products by the number of similar establishments in the entire country, and an approximate

idea may then be formed of the vastness of the interests which are almost wholly based upon patents, and which the proposed legislation is to affect.

I. REPORTS AND DRAWINGS.

With reference to the proposed change in sec. 9, which abolishes the publication of the illustrated or Mechanical Reports of the Patent Office, we apprehend there will be great objection on the part of the inventors and the public generally; but if the full specifications and illustrations can be made available to the public, we think the plan a good one. At the same time we beg to suggest, that it is still an open question, whether there is not a better plan than photography for this purpose; and further, that whatever plan is adopted, it ought either to be conducted by the Office itself, or, like other contracts, be let to the lowest responsible and competent bidder.

To the change proposed in section 26, by which the Office, instead of the applicant, is to furnish the duplicate drawing, we strongly object, for several reasons: It is of course understood, that if furnished by the Office, it will be a photograph, on paper. These are far less durable than the linen tracings now furnished, and very few inventors are willing to accept of them, as they soon become mutilated and destroyed, thus rendering the patent comparatively useless, and necessitating the expense of procuring new copies. These photographs are not colored, and hence do not illustrate the invention as colored tracings do. Besides, it is impossible to conduct the rposecution of cases, especially since the adoption of the rule

by the Office refusing permission for the return of any of the papers, without having this duplicate drawing to compare with the references, and to amend by, as may be required by the action of the Office. As now practiced, this is all accomplished by the applicant's making the duplicate drawing at a trifling expense, by tracing it from the original, and retaining it in his possession until the case is passed for issue. The proposed change would add to the expense, and the drawing, when the patent issued, would be far less durable and not as good in the way of illustrating the invention. For these reasons we trust that the change will not be made.

II. RULES.

The proposed legislation embraces a provision granting to the Commissioner, without qualification or limitation, power to make rules to "regulate proceedings" in the Office.

The right to make rules, in accordance with law, to facilitate the discharge of official duties prescribed by law, necessarily inheres in every administrative officer having the control of subordinates who are to act as his agents in the execution of the law. But to incorporate in the statute an unlimited authority to prescribe rules to regulate all proceedings is, in our judgment, to clothe the Commissioner with a dangerous power. It practically confers upon him the authority to legislate in all doubtful cases not distinctly provided for by statute.

In existing statutes the Commissioner is authorized, by the 12th section of the act of 1839 and the 1st section of

the act of 1861, to make regulations respecting the taking of testimony in cases pending in the Patent Office; and by the 2d section of the act of 1861 to prescribe rules for the examiners-in-chief.

Under the authority last named, rules are now in force which amount to nothing less than legislation on one of the most delicate and difficult questions which can arise in patent cases, viz., that of abandonment.

Except in the case of two years public use prior to application for a patent, the law has left this question open, to be settled by the Courts upon a consideration of the facts of each case in which it may be raised. But by the rules referred to, which we quote in full below, it is directed that abandonment shall be presumed in certain cases where the statute is silent, and thus an important change in the law is made under the guise of prescribing rules to regulate proceedings.

The rules to which we refer are as follows:

DEPARTMENT OF THE INTERIOR,
Patent Office,
Washington, D. C., Jan. 21, 1870.

GENTLEMEN: The rule which I have adopted for the guidance of the Office, in relation to withdrawn and rejected cases is as follows:

1st. Where a fee is withdrawn and the fee is returned, and no application is made for more than two years after the withdrawal, the application is to be deemed abandoned.

2d. When a case is rejected, and no action is taken by the applicant for more than two years, and meanwhile the invention goes into public use, or is patented, or is embodied in other applications, whether patented or not, the original application cannot be revived, although it may still form a good reference to the subsequent applicant.

3d. Where a case is rejected and no action is taken by the applicant for more than two years, and it does not appear that the invention has gone into public use, or been

incorporated in subsequent patents or applications, the applicant will be required, when asking further action, to file an affidavit giving reasons for the delay, and stating, that to the best of his knowledge and belief, that the invention is not in public use at the time that he seeks such further action.

Very respectfully,
Your obedient servant,
SAM'L S. FISHER,
Commissioner.

Mess. S. H. Hodges,
S. C. Fessenden, and
R. L. B. Clark,
} *Ex'rs-in-Chief.*

It will be seen that these rules are addressed to the board of examiners-in-chief, the tribunal established within the Patent Office for hearing and deciding appeals from the decisions of the primary examiners. The examiners composing this tribunal, in order that they may be independent judicial officers, hold their places directly from the President, and not from the Commissioner of Patents, who can only overrule them when their judgments come regularly before him on appeal. It is true that the law requires that the "said examiners-in-chief shall be governed in their action by the rules to be prescribed by the Commissioner of Patents," (2d sec. act of 1861,) but it has not been supposed that Congress by that language intended to give the Commissioner the power to control in advance the judgments of this board on questions of law arising in appeals coming before them for decision. The rules referred to in this section, are evidently intended to be mere regulations of the course of business, and not rules to restrict the right of applicants to come before the appeal board, and to prescribe the interpretations of law by which the board must be guided in its decisions.

The rules quoted above are also made binding on the primary examiners, and thus an application for a patent,

although ostensibly subjected to the judgment of three distinct tribunals in the Office, is really acted on by but a single will, and the provision for an appeal within the Office becomes a practical nullity. The examiner must decide as the Commissioner directs; the appeal board, also, must decide as the Commissioner directs, and from the board an appeal lies to the Commissioner in person. If, as is proposed, all appeal from the Commissioner to a superior tribunal is cut off, the Commissioner can, under the plea of making rules, concentrate in his hands all power over the grant of patents. In the hands of an unscrupulous man, such unrestricted authority would, in our judgment, be dangerous to the inventive interests of the country, and we think we are justified in asking that the power of making rules may be very carefully guarded.

III. ABANDONMENT.

This is one of the most delicate and difficult subjects that come within the purview of the patent law, and one which is less regulated by statute than almost any other. Some of the rules on this subject which now exist, or which have been recently proposed, seem imperfect and even objectionable, as we shall more particularly point out as we proceed.

And first we shall refer to the abandonment which is contemplated in the 23d section of the revision which is compounded of the 7th section of the act of 1836 and of the 7th section of the act of 1839. This is, however, done in such a way as may very possibly lead to a great change in the rule heretofore followed on this subject. The law, as thus far understood and administered, does not contem-

plate that the Patent Office shall interpose the objection of abandonment except in cases which admit of no reasonable doubt. The decision of such questions in other cases has been left to courts and juries.

But, taken in connection with the surroundings in this 23d section, we believe the examiners in the Patent Office will feel called upon to weigh deliberately every question of this kind that may present itself, and to decide it upon the mere preponderance of the testimony in each particular case. This we think should be avoided, and to that end we propose an amendment of this section so that it may read as follows:

"SEC. 23. 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 before his invention or discovery thereof, and not at the time patented or described in any printed publication in this or any foreign country, may, upon payment of the duty required by law and other due proceedings had, obtain a patent therefor, *unless* it shall appear that the invention had been in public use or on sale with the consent of the inventor (written or implied) more than two years prior to his application, or unless it shall appear from the admission of the inventor himself, or from other conclusive testimony, that the invention has been abandoned or dedicated to the public."

But a much more important branch of this subject of abandonment grows out of the delays which are of such frequent occurrence in the Patent Office, while cases are pending therein. These are now left in the most extraordinary uncertainty and confusion. The least important subdivision of this class, and that which called least for a remedy, was provided for by the act of 1861, and relates to those delays which sometimes occur after the filing of the petition and before the completion of the application.

The Commissioner of Patents now proposes to cut down this limitation of two years so that it shall be only six months. This limitation is, we think, quite too narrow. In fact, we see no reason why abandonment should be inferred any sooner after a petition has been filed in the Office, than after the inventor has put his invention into public use without filing a petition. We therefore prefer to have the two-year limitation in this case remain just as it was left by the act of 1861.

But cases very frequently present themselves wherein, after an application has been completed and been acted upon, it has been allowed to slumber for years without any further step being taken by the applicant. Sometimes applications have been withdrawn with a view of filing them anew in a modified form, and have then remained for a long time unreturned.

In all these cases, there has been no established practice, or recognized rule in relation to them. The examiners in charge, the board of appeals, the different Commissioners, and the several Judges of the Supreme Court of the District, have each followed different rules of decision, so that applications precisely alike in principle, are sometimes allowed and sometimes rejected. This state of things is wholly incompatible with a well-regulated system of patent law under any government, and especially under one like ours.

The Commissioner of Patents seems fully alive to the necessity of a remedy for this evil. But one great objection we entertain against the rules he has recently adopted for that purpose is, that they seem to us to be legislative in their character. We do not object, in the main, to the limitations he has prescribed, but we think they should be fixed by act of Congress, and not left to the changing views of future Commissioners.

But a much more important objection is founded on the

fact that the limitations fixed by him are all retroactive and inflexible. Such rules are opposed to the spirit of our institutions. Existing rights ought not to be suddenly annihilated. The parties interested should have a reasonable time within which to accommodate themselves to the changes prescribed, except in some extreme cases where long lapse of time raises a just presumption that the right in question has been abandoned.

It was for this reason that the act of 1861, which required an application to be completed within two years after the filing of the petition, declares that all pending applications shall be regarded and treated as though such petition had been filed at the date of the passage of that act. The law did not prejudicially affect any pending case.

In order to apply the same principle to the changes now contemplated, we propose the following amendment of the existing law:

SECTION 31.—COMPLETION, PROSECUTION, AND ABANDONMENT OF CASES.

Erase section 31, and insert as follows:

First. Every application for a patent must be prepared for examination within two years after the filing of the petition therein.

Second. When any application has been, or shall hereafter be withdrawn from the Office, with a view of filing the same anew, such new application must be filed within two years after such withdrawal.

Third. Whenever there has been, or shall hereafter be a rejection of an application, or other action had by the Office thereon, the applicant must prepare his case for further action within two years thereafter.

In default of a compliance with either of the above rules the invention then sought to be patented shall be regarded as abandoned to the public, subject, however, to the following conditions and qualifications, to wit:

1st. The Commissioner of Patents may enlarge the time prescribed in any of the foregoing cases, provided

application for such enlargement be made before the time thus fixed shall have elapsed, and satisfactory reasons given therefor.

2d. When the withdrawal above contemplated has heretofore been made, there shall be allowed not less than six months, after the passage of this act, within which to file the new application, except as hereinafter otherwise provided.

3d. When the rejection or decision has been heretofore made, the applicant shall have not less than six months, after the passage of this act, within which to prepare his case for further official action by filing a new application, or otherwise, according to circumstances, except as hereinafter provided.

4th. Nothing herein contained is intended to prevent or change the effect of an *actual abandonment* of any invention, but only to prescribe the rules of abandonment by mere lapse of time.

And in all cases, a lapse of five years subsequent to any withdrawal, and before filing a new application, or the lapse of ten years subsequent to any rejection or other action by the Office, and before the preparation of the case for the further official action, shall be conclusive evidence of an intention to abandon the invention to the public.

Provided, however, that if, after a withdrawal, a new application shall have been filed prior to the first day of January, 1870: or, if after a rejection, or other official action, the case shall have been prepared for such further action prior to the said first day of January, mere lapse of time shall be no ground of objection to the granting of the patent, or to its validity when granted.

We believe the above amendment would effectually provide for all the cases now in the Office, and although some of them may appear very liberal, it is better to err on that side than on its opposite. No mischievous precedent will thereby be established, inasmuch as the Office will soon be cleared of the few cases that will be found patentable under these rules, and the door will be effectually closed against the mischiefs and uncertainties of the future, coming from these sources.

But as the rules above proposed, would authorize the granting of some patents which have been lying many years in the Office, a hardship might be wrought to many who in the mean time may, with honest intent, have purchased or constructed the thing sought to be patented. To prevent this, we propose an amendment of section 36, of the revision, so that it shall read as follows:

"SEC. 36. Every person who may have purchased or constructed any newly-invented or discovered machine or other patentable article, *prior to the date of a patent therefor*, shall have the right to use, and vend to others to be used, the specific thing so made or purchased without liability therefor, except in cases where a knowledge of the invention shall have been obtained surreptitiously, or where the subject matter of such patent shall have been constructed or obtained with a view to defraud or injure the original and first inventor thereof. But this right so to use the thing patented shall not extend to the continued use of an art or process in which any person may have engaged before the said date of the patent, and shall only enable him to complete the specific operation or undertaking in which he shall have previously engaged."

IV. ABOLITION OF APPEALS.

The change proposed in reference to appeals, is most radical and sweeping. It a is change which, like most of the proposed changes in the law, tends to *limit and restrict the rights and remedies, now secured by law, to inventors*; but this is more sweeping and vital than any of the other proposed changes.

The right of appeal from the decision of the Commissioner to *a judicial tribunal*, was carefully provided for in the act of 1836, which was the basis of our present "Amer-

ican system," so highly and justly praised by the Commissioner in his recent report. That right of appeal was still further extended by the act of 1839; and as the acts of 1836–'7–'9, were all framed by Commissioner Ellsworth, who may be justly styled the father of the American system, and than whom no man was better qualified to judge of the necessities of the case, it is to be presumed there was good and sufficient reason for bestowing the right. If there was good reason for this right of appeal then, when the number of applications was but a few hundred per annum, and the Commissioner could give his personal attention to each case, how much more is it necessary now, when the number of applications has increased to twenty thousand a year, not one in a hundred of which he ever sees, except to sign his name to a blank filled out by some clerk; and when, too, the pecuniary interests involved are a thousand fold what they were then. And why is the abolition of this right of appeal proposed? The Commissioner in his report has devoted considerable space to this subject; and as he has made it the leading subject, so far as changes in the law are concerned, it is to be presumed that he has assigned the very strongest reasons he could adduce for the change. Let us see what they are.

First. He says "it is believed that Congress meant to repeal it," but at the same time he admits that the Attorney General holds that the appeal fee is still payable from the Patent fund. The latter part of the statement is a full answer to the former, for the Attorney General would hardly hold that the fee was payable when the appeal itself was intended by the law to be abolished; especially as the law referred to, did repeal the former schedule of fees, and establish another in which the appeal fee was not mentioned, while the appeal itself was not referred

to. We do not know to whom the Commissioner refers as believing it was intended to repeal that provision; for surely, the Attorney General did not so believe, not a single inventor or Patent solicitor so believes, nor has the Commissioner always so held; for he has himself recommended such appeals, and, until quite recently, acknowledged their legality and binding force upon him.

Second. He says three appeals are already provided for. This is not strictly correct. The second hearing before the examiner is not an appeal to a higher tribunal at all, it is simply a re-examination, either with or without an amendment of the specification and claims, as provided for in the 7th sec. of the original act of 1836.

That which he calls the second appeal from the examiner to the examiners-in-chief, is really the first appeal, for which the applicant is now, by section 1, of act of 1866, required to pay an additional fee of $10. Originally the applicant could appeal direct to the Commissioner from the examiner, without paying any fee. Prior to the act of 1861, the Commissioner, without any special authority of law, had, in 1857, already established an appeal board composed of three of the most experienced examiners, to whom cases were referred without any fee; and from them the case was carried, also without any fee, to the Commissioner in person, who either reversed or affirmed their decision or report, as he saw fit. An appeal lay, by act of 1836, to a special board, for which board, section 11, of the act of 1839, substituted the Chief Justice of the United States Court for the District of Columbia, and by act of 1852, like jurisdiction of appeals was extended to the Associate Justices of said Court; this change being made, simply because of the age and infirmity of the then Chief Justice Cranch. The only change effected by the act of 1861, was to legalize the board of examiners-in-

chief, which had previously existed without any positive authority of law, and to recognise them and the primary examiners as "independent judicial officers," by requiring the appeal to be taken from the examiners to the board, then from the board to the Commissioner, and requiring *an additional fee of* $20 *for this last appeal;* the appeal from the Commissioner to the Judges, being left as it was fixed by the acts of 1839 and 1852.

It will thus be seen that there are really but two appeals in the office, first, from the primary examiner to the examiners-in-chief, second, from the examiners-in-chief to the Commissioner, and that to each of these a separate fee has been added. We have now the same number of appeals by law that we had prior to 1861, *with the addition of two appeal fees.* This idea of the Commissioner's, about the number of appeals, moreover, is based upon the supposition that the primary examiners, and the board of examiners-in-chief, are "independent judicial officers" as described by his honor, Judge Dunlop, in the case of Snowden *vs.* Pierce in 1861, Law's Digest, p. 312, secs. 6,7, 8, 9. If they are not independent tribunals, then the idea of an appeal is a mere farce. What the practice is will appear hereafter.

Third. The Commissioner further alleges that there is no "propriety" in this summary appeal from an *executive* to a *judicial* tribunal; and that, at any rate, it is not allowed in the case of other bureaus. To this we reply, that his most distinguished predecessor, Commissioner Ellsworth, the father of our "American system," thought that there was great propriety in it; and that Congress evidently coincided in that view, inasmuch as they embodied it in the law; and further, that with all the subsequent changes in the law in other respects, that feature has not only been carefully retained, but has been enlarged by subsequent

acts, at different sessions. We submit, therefore, that this charge of impropriety is not justified.

On the contrary, speaking with the experience of many years, and under many different Commissioners, we give it as our deliberate judgment, not only that there is propriety in it, but also that there is an absolute necessity for it.

The statement that such an appeal is not allowed from other bureaus has several answers:

1. The idea conveyed that there is *no* appeal in the other bureaus is not correct; as in all cases there is first an appeal from the clerk, chief, or head of division, having the matter in charge, to the Commissioner or head of the bureau, and then an appeal from this latter to the Secretary or head of Department to which the bureau belongs; and both of these appeals (though without special authority of law) *exist in practice*, and that, too, *without the payment of any appeal fee*. In the Patent Office no such appeal to the Secretary exists.

2. There is an obvious reason why this appeal should exist in the case of the Patent Office, even if it did not exist in the other bureaus. The questions to be decided, and the duties to be performed are entirely distinct and different in their character from those of any of the other bureaus. In the latter, the duties are almost wholly and simply clerical. In them almost any person who can write a good hand and possesses ordinary business qualifications can perform the duties. Not so in the Patent Office, as every one knows. There, the duties are of a most comprehensive and extraordinary character, extending over and ranging through the boundless fields of human knowledge—the entire range of the arts and sciences.

This difference in the character of the duties to be performed is clearly shown by the Commissioner in his report,

where, under the head of "Qualifications of Examiners," he has set forth the importance and the difficulty of procuring competent men for these positions.

On this subject, his predecessor, Commissioner Foote, in his report for 1868, p. 3, uses this language:

"An examiner's decision involves nice questions of law, of science, and of mechanics. The more recondite principles upon which depend the practical success of processes and machinery must be familiar to him. Large amounts of property often depend, directly or indirectly, upon his action. The ability and acquirements necessary to the proper discharge of his duties must be of a high order—scarcely less than those we expect in a judge in the higher courts of law."

(See also the report of Commissioner Mason, for 1855, vol. 1, pp. 4, 5, and 6.)

It was for this very reason, of the difference in the character of the questions to be decided, and of the duties to be performed—which decisions and duties always involve more or less legal questions, often the construction of the law itself, as applicable to the facts of a particular case; it was this reason, we say, that induced Congress to provide specially for this appeal from an executive to a judicial tribunal, and in which we contend there is an obvious "propriety."

3. Again: in most of the Departments there is a law officer—a solicitor—to whom all legal or doubtful questions are referred. No such officer is provided for the Patent Office; and as there are questions of law, as well as of fact, in patent cases, there is great propriety in having them determined by a judicial tribunal.

4. There is still another reason: Of all rights in property, that of patents is most intangible, the easiest infringed upon, and necessarily the most subject to litigation. It is not like a house or piece of land—like a coat or other

personal property, that the owner may hold by possession. A resort to the courts is his only remedy; and inasmuch as large interests are frequently involved in the validity of a patent, and it is desirable for the encouragement, growth, and permanency of the manufacturing interests of the country that patents, which are their basis, should be rendered as free from invalidating defects as possible; for that reason, also, it is specially desirable, and highly proper, that they should be subjected to the examination of, and be passed upon by a judicial mind. Hence it was, that the original acts of 1790 and of 1793, made the Attorney General—the law officer of the General Government—one of the board to grant patents, and he so continued up to 1836, when the present system was adopted.

Fourth. The Commissioner argues that as the appeal may be taken to either of the four judges, they may, or have decided differently on the same question. This, if an argument at all, is an argument not against appeals, but rather against the details of the present system of appeals. It may be a reason why the law should be changed in that particular, but not why the appeal itself should be abolished.

The same argument would apply as a reason why there should be no appeals to the various circuit and district courts, both State and Federal; for, is there not the same possibility that judges in the various circuits and districts may decide differently on the same question? Indeed, is there not even more probability that judges in separate districts or courts would do so, than that the different judges of the same court would do so? It is just as much of an argument against appeals to the Commissioner, for the record will show full as many, if not more, conflicting decisions made by them than have ever been made by the different judges.

We apprehend, however, that here, as in all other judicial decisions, each case is decided upon its own merits and the facts of the particular case; and that, therefore, before we can justly assert that the various decisions do conflict, we must know just what were the facts and circumstances of the various cases.

Fifth. He asserts that the payment of the judges by fees tends to increase appeals.

This, like the former, is an objection to the system or plan, and is no argument against the right or justice of the appeal itself. Inasmuch as the judge receives the same fee, whichever way he decides, it must be remotely, if at all, that it has any such tendency.

The same objection might be urged against the appeals to the board, and also to himself; for the more favorable decisions, the more appeals there will be likely to be, according to this theory.

If it be said that in their case the fees do not go to them personally, we reply, that they are personally interested in making the accumulation of the patent fund as large as possible, especially the Commissioner, who has the disposition of it.

For ourselves, however,we put aside all such arguments or insinuations, come from whatever source they may. We prefer to believe that all these tribunals, from the primary examiners to the judges, are actuated by higher, nobler, and more just motives; that they make their decisions because they believe them to be just and right, and strictly in accordance with the law and the facts of the cases.

Sixth. The Commissioner urges that the tendency of such jurisdiction is to extend itself. In our experience during years of practice, we have not found it so.

The jurisdiction claimed and exercised by the judges

now, is precisely the same that it has been ever since the creation of the law. It may be that in some particular case, a judge has exceeded his authority, or made a decision which the law did not authorize; but that the court claims to possess any more extended jurisdiction now than heretofore, we do not understand. It is the authority of the Commissioner—the "one man power"—that we find possessing this "tendency to extend its jurisdiction," and that, in a very marked degree. As proof of this, we now find the Commissioner claiming and exercising jurisdiction on questions which the statute itself gave to the courts, and not to him, and which Chief Justice Cranch expressly decided, years ago, the Commissioner had no right to pass upon. Nay, more, we now, for the first time in the history of the Patent Office, find the Commissioner denying the jurisdiction of the judges on questions of law and fact, on which he assumed to decide without authority of law, and refusing to obey their decisions when rendered. Again, we find this tendency to an extension of the jurisdiction of the Commissioner in the attempt to *legislate and change the legal rights of inventors*, under the guise of making rules for the Office; also in making rules *retroactive*, and *in making rules to apply to special cases.* Again, we find it in his instructing the examiners and the board that they must be governed by his decisions, and not by those of the judges or the courts; thus, in effect, not only giving to the law a construction directly opposite to that put upon it by his predecessors, the judges and the courts, but also dictating, in advance, what the decisions of the examiners and the board shall be in certain cases! And still more do we find this in the very effort now made to induce Congress to *abolish all appeal*, and to give to him unqualified authority to make any and all rules he chooses, *without limitation of any kind*, a right never before asked for, much less granted, to any head of a bu-

reau. No person of character or standing, so far as we know, ever pretended that the judge was the head of the Office, or that he has a right to pass upon any questions but those passed upon by the Commissioner in his decision, and specially set forth by the applicant in his reasons for appeal, as provided by the statute. We do claim, however, that the judges, on appeal, have the right to pass upon all questions passed upon by the Commissioner in his decisions, and that the decision of the judge is binding on the Commissioner, and that, in deciding upon the merits of a case which the Commissioner may have rejected because of some special rule made by him, it is perfectly legitimate and proper for the judge to decide as to whether such rule is or is not in violation of the statute. Otherwise, it would only be necessary for the Commissioner, in order to deprive an inventor of all his rights, to make a rule that would cut him off, contrary to law, and then deny the jurisdiction of the judge to decide on the legality of the rule, and thus shut the inventor out from any remedy by appeal! Such is the precise case referred to by the Commissioner when he alleges that new matter was introduced. *The board decided there was no new matter. The Commissioner then made a new rule*, that the applicant should not claim a feature not shown in the original drawing, *although fully and clearly described in his original specification!* This rule the judge decided was a violation of the statute, which gives to an inventor the right to cover in a reissue *whatever was clearly in his original invention.* So, too, in another of the cases referred to as having laid dormant for eight years, the Commissioner omits the important fact that *the applicant was induced to incur the delay by the improper rejection of his case by the Office, thereby leading him to believe that his invention was not patentable, the Office now admitting that he was entitled to a patent then, but holding that his delay to prosecute it, although induced by the Office, is*

now a bar to his right to a patent! The statute makes no such limitations; and the courts have held just the reverse.

Seventh. The practical working of the appeal system, instead of producing the bad results claimed by him, has given general satisfaction; and we apprehend that the greatest difficulty connected with it, has arisen from the disposition on the part of the Patent Office to antagonize itself against the decisions of the judges on appeal, and the recent denial of their jurisdiction on questions of law, and consequent refusal to be governed by their decisions, as required by the statute. There is no one question on which inventors are so uniformly agreed, or on which they feel more interest than on this right of appeal.

In answer to the suggestions made by the Commissioner as to what he anticipates may be said in reply to his reasons for abolishing the appeals, we would say that, if we were always sure of having the very best man that could be found for Commissioner, there would be force in the suggestion; but the office of Commissioner of Patents is a political one: and is filled, if not by a politician, at least by political influence. Hence it is unstable, liable to frequent change, with every administration, if not oftener. It is well known that men sometimes take the position temporarily, as a means of increasing their business in the future, giving up, for the time being, far more lucrative positions to take it, for that, or some other personal reason; and that some have been appointed to the position who were never admitted to the bar. While we agree with him that the Commissioner *ought* to be as competent as other heads of bureaus to decide the questions that arise, unfortunately he is not always found to be so; and even if he were, that would not be a perfect security, unless, indeed, the dogma of "infallibility" is claimed as applicable to them, to which we hardly think the public is ready to assent, as yet.

To tell an inventor that an appeal from an unjust decision of the Patent Office is provided for by bill in equity, is simply adding insult to injury; for it is a remedy that no poor inventor would ever think of availing himself of. For him to do so, would simply be to repeat the story of *Jarndyce vs Jarndyce*, and to rob himself of what little means he might have left, after completing his invention, as well as all hope of reward for his invention in this world, if not in that to come. During the thirty years since the creation of that remedy, there have not been a half dozen cases under it, out of the one hundred and odd thousand applications filed.

It may be that the primary examiners are as competent as the judges to decide upon the cases appealed; but Congress did not think so, or it would not have provided for an appeal, either to the board, to the Commisioner, or to the judge; and it is clear that inventors do not so think, or they would not pay the fees required for the privilege of appealing.

The force of the Commissioner's argument, that the appeal delays the determination of cases, may be judged of by his suggestion, that parties may avail themselves of an appeal by a bill in equity, especially when it is perfectly understood by the legal fraternity, that once get a party in a chancery suit, and you have him tied up for the next five years at least, and longer, if the funds hold out! His last suggestion that the removal from the Patent Office, of the papers and models, is an objection, is one in which we fully agree with him; but the cure suggested by him of cutting off the appeal entirely, we consider infinitely worse than the disease. In our opinion a much simpler and better remedy can be had.

Having thus gone over all his reasons for the proposed abolition of appeals, we have but one other to notice on this branch of the subject; and that is, his suggestion ac-

companying his proposed bill in the hands of the committee. After proposing to cancel all the sections relating to appeals, being sections 47, 48, 49, 50, and part of 51, of the codification of the Patent laws, he then adds this remarkable recommendation:

"If any part of this appeal business is retained, it should be limited by inserting as follows:"

"Upon questions of novelty, patentability of the subject matter, or priority of invention."

In other words, he gravely recommends that if any appeal be allowed, the judge should be limited to deciding the questions in mechanics and facts simply, but that the question of abandonment, and all similar questions involving a construction of the law, shall be confined solely to him! The judge may decide upon the question as to whether John Smith's hair-pin is the same as Jack Rogers', or which of them invented it first; as, also, whether putting two crooks in it, instead of one, renders it patentable; but when it comes to *legal questions—construction of the statutes—whether or not the rules made by the Commissioner are in accordance with, or a violation of, the statute; whether, under the law, the applicant has or has not forfeited his right to a patent by delay or abandonment—these and all similar legal questions the judge must* NOT *decide!* A more palpable case of putting the cart before the horse, we do not think can be found in modern times. Such a proposition hardly admits of serious argument. We also beg leave to suggest, that the Commissioner is mistaken in supposing "that the most respectable solicitors, especially those having the largest business before the Office," agree with him in the desire to have the appeal abolished; for while the meeting which appointed this committee was composed of solicitors representing at least three-fourths, if not more, of the entire business of the Office, we know of but a single individual

who endorses his recommendation, and he belongs to the class of "contingent fee" agents so graphically described by his honor on page 9 of his report, *and who had recently lost a case on appeal!* To conclude this branch of the subject, it is only necessary to call attention to the immensity of the interests involved, directly or indirectly, in the subject of patents; and then to consider for a moment what would be the result of the proposed change in this branch of the laws. As previously stated, and as shown by a copy of certain recent rules embodied in another place, the independent judicial status or character of the primary examiners has been destroyed, and also that of the board of examiners-in-chief, so that to-day there is but *one will, one mind in the office, and that the Commissioner's.* Not content with what has already been accomplished in that respect, you are now asked to so change the law as effectually to wipe out the board of examiners-in-chief, by reducing them to the position of mere clerks, to report to him, instead of deciding on cases, as now provided by law! Not only this, you are asked to give the Commissioner *unlimited authority to make such rules as he pleases,* whereby he may still further reduce and control the primary examiners and the board, and *to cut off all appeal from his decisions, and thus to make him absolute and supreme dictator in all matters relating to patents!* Let that be done, and imagine an unscrupulous man occupying the position of Commissioner, and we think no further argument will be required to convince any one of the true character and effect of the proposed changes. To use the words of a former Commissioner in his report to Congress—"all our republican notions of propriety revolt at the idea of making the substantial rights of property of any citizen depend upon the mere discretion of an executive officer. Such a system seems rather Asiatic than Anglo-Saxon in its type and origin." How the Commissioner can

say, as he does in the conclusion of his report, that "no class of our citizens has done more for the glory and substantial prosperity of the nation than the mechanics and inventors of the United States, and that they have never been favored children," and at the same time can seriously propose to so change the laws as to limit still more their rights and remedies, and to place their entire rights and interests at the disposal or mercy of any one man, possessing absolute power over them, is to us beyond comprehension!

Another and most important consideration is this—that if an error be committed in granting a patent, it harms no one, as the courts have full power to declare it void in whole or in part, on the petition of any one interested; but if a patent be improperly or wrongfully denied, there is no remedy. Even though the inventor may see others appropriating the invention which has cost him years of thought and toil, he, having no patent, cannot get into court to have his rights adjudicated. The wrong, in such a case, is irreparable.

V. REISSUES.

The points relating to reissues are stated in the following words in the proposed amendments:

1. *New section:* "No invention *not claimed* in the original shall be embraced in a reissue which has been in public use or on sale for more than two years prior to filing the reissue application."

2. *New clause in existing section:* * * * "but no new matter shall be introduced into the specification, nor shall the drawings nor model be amended except each by the other."

The defects in patents which call for a reissue, are almost universally *in the claim*, which from inadvertence, accident, or mistake, has been made too narrow or limited to be commensurate with the real breadth and scope of the invention. Other defects are generally of a minor character and subordinate to this.

Time and experience are often both necessary to develop the full practical value of an invention; and those features which at first were deemed of great importance grow less and less so as years go by; whilst, on the contrary, other features, upon which the inventor laid but little stress, have sometimes proven to be the only real things of value embraced in the patent. Instances of this sort are within the memory of all practitioners.

The fact that an applicant for a patent may have presented a modest claim, should not be a ground for refusing him that to which he is entitled, when he discovers his error and asks for his rights; nor should the fact that in his original application he claimed immodestly every specific unit, combination, or arrangement of which the case was susceptible, confer upon him a better right, on asking a reissue. Yet, under the proposed new section, every applicant, by way of saving his rights, would feel driven to tax to the utmost his own and his attorney's ingenuity in so presenting his case, in his original application, that not an item of his invention, however slight, should fail to be covered by his original claim. This would multiply the labor of the office immensely, in the matter of examining; lead to unavoidable rejections of a large proportion of the claims which would not otherwise be presented, and produce, it would seem, more trouble than the new provision seeks to remedy.

Again: the patentee has not always at hand the means of discovering whether or not a portion of his invention, not covered by his claim, has, throughout the whole length and

breadth of our vast territory, been for over two years "*in public use or on sale*" by somebody, perhaps two thousand miles away, or in some obscure village or hamlet. This provision would be practically, in most cases, equal to a bar against making application for a reissue after two years from the date of the patent; for every patentee, by way of prudence, would endeavor to apply within that period for his reissue, lest the ghost of a two-years' use or sale of an unclaimed feature, should be conjured up from some dark corner of the land.

Nor could he provide against this in any other way, as the proposed provision says nothing of use or sale with the inventor's knowledge or consent.

The necessity for reissue might not in fact become apparent until eight or ten or more years had passed away, and yet, by this provision, the patentee's rights would be gone, because (though unknown to him) a stranger had been for years using his invention. Where an invention is in advance of the age, it sometimes takes years to educate the Patent Office and the people up to an appreciation of it.

If the invention (as, for instance, in a machine) be such that the machine must be made and sold as an entirety, then this proposed section would be in effect a limitation of the right of reissue to two years, for the patentee could not sell the patented article without selling also that *unclaimed* feature which may afterwards turn out to be the main or only thing really worthy of protection.

Again: suppose his patent is for a single process, but he afterwards discovers that from his not having been fully apprised of the antecedent state of the art, he had unnecessarily included in his single claim, a step in the process which improperly served to narrow and limit it.

He may not for years discover this error, and his consequent right to a broader protection, nor be aware of such public use; shall he, then, for no fault of his own, lose all protection forever for his real invention?

His rights should be saved, as they now are, by law, and this is not inconsistent with saving also the rights of those who may have used prior to the reissue.

If the word "original," in the proposed amendment, means *original patent*, then the objection is greater still; for the patent may have been improperly shorn of half its claims, or of its most important ones, by the insistment of the examiner, by an imperfect misapprehension of the references by the applicant; by the error or carelessness or incapacity of the attorney; or by the urgent need of getting the patent issued without delay, prompting to the acceptance of what is allowed him, rather than to run the course of a series of appeals. It is well known that to draw a perfect claim, requires practiced skill and is no easy matter, and it is equally well known that large numbers of patent papers and claims are drawn by solicitors of very brief and limited experience, whilst many hundreds, if not thousands, are by way of economy, prepared by the applicants themselves, in a very crude and imperfect way. The foreign applicant, particularly, would suffer severely from the proposed rule, having but slight opportunity thoroughly to comprehend the references which might be cited, or the precise view of his case entertained by the Office.

The proposed rule would visit all alike, skilled or unskilled, distant or near, native or foreign, with consequences amounting almost to a punishment for failing to obtain, in the original patent, all that the Patent Office ought to have given.

But if, where a patented invention has publicly been used or put on sale two years, nothing can be claimed after two years, in a reissue, which was not claimed in the original patent, then why not ask at once a provision that no reissues shall in any case be granted after two years? For, by the proposed provision (2) above, those inventions only which should prove meritorious enough to come into use

would come under the operation of the provision, whilst those which should prove of no account whatever, and should never be made or sold at all, would be proper subjects for reissue and expansion for their whole life of seventeen years.

As to "New Matter" and "Amendments," as proposed:

1. If the first member of the sentence means that *under no conditions whatever* shall new matter be set forth in the specification, although the model or drawings shall actually contain such subject-matter, then this provision would work manifest injustice, for it would prevent the correction of errors (the express object of reissues) and preclude the insertion of legitimate matter which by accident, inadvertence, or mistake had been omitted.

2. It would confine all alterations of the text to the correction of minor errors of punctuation, orthography, or the paraphrasing of sentences, and dressing them in better garb.

3. The amendment of models or drawings *only by each other*, without the aid of the specification, seems an unnecessary restriction. For, if it be supposed that the actual invention is more likely to be truthfully shown in them than in the specification, I think the supposition erroneous.

Cases will differ, but, as a rule, there is an equal, if not greater, probability that the description drawn by the inventor, (or if drawn by the attorney, *read*, *signed*, and *sworn to* by the inventor,) shall tell the truth as to what the invention or construction is, as that a model-maker or draughtsman should be infallible.

Models are frequently defective or rude when first presented to the Office; the drawings made from them are likely to repeat their defects; yet the description may be full, and more exact than either, and carefully and pur-

posely made so, from the fact that the model is a poor one. The model or drawing may also be mutilated, altered, or destroyed.

Shall the Patent Office, in such case, throw away the *best* evidence of what the invention really was and is, and accept the *worst?*

Undoubtedly frauds have sometimes been perpetrated in obtaining reissues, as well as original patents, and specifications have at times been strained too far, but not perhaps further than models or drawings. Nor do frauds occur in reissues in a greater percentage of cases than in all branches of public or private business, whilst the very critical scrutiny and rigid pruning which the examiners are at this day accustomed to give to reissue applications are such that there seems no necessity, in this respect, for disturbing the law as it now stands.

To materially alter or abrogate a system which, like that relating to reissues, has been in force over thirty years, and which is well understood by the army of inventors throughout the land, and in which the practice is well settled; in which, also, there exist the same reasons for its continuance, as those which prompted its original enactment, and in which *the people have not petitioned for a change*, would be, it seems to us, in every point of view, not only unnecessary but unwise.

In view of the keen scrutiny at this day given to reissue applications, not only whilst pending before the Patent Office, but also in the courts, more danger is to be feared from the proposed changes than any that can well be imagined from leaving the law as it is.

When the mass of inventors, and people interested in the progress and protection of inventions, earnestly ask a revolution of the existing system in regard to reissues, will it not then be a more fitting time to consider what changes are really needed in the law?

If Congress should fix a period, or periods, after the grant of a patent, (say five and ten years respectively,) at which a patentee or assignee should pay into the Patent Office a small additional fee by way of keeping his patent alive, and enact that on the failure to make such payment his patent should lapse or expire, most if not all the supposed objections against granting reissues, at any time during the life of the patent, would disappear.

For, with such an amendment, it is believed that a large number of those patents which prove to have no great value in themselves, would be permitted to expire, and would no longer stand in anybody's way.

To make these periodical payments too many and frequent, as in Belgium and France, would be annoying; but if one or two be established, it is believed it will work well and satisfactorily to all, and be an improvement on the existing law.

A well-digested system of patent law, which in all its main features, has stood the test (with but few modifications) of over thirty-five years, and has taken its root in the appreciation of, and met the approval of those most intimately concerned, (the inventors,) had better be touched with care. Too great and varied interests are involved, reaching in money value to hundreds of millions, and stretching in every direction into almost every workshop in the country, to warrant the risk of injuring them. Foreign systems seem to be gravitating towards ours, as being superior to theirs.

Radical changes which break up long-established and well-working laws, should, we respectfully submit, be made only upon paramount necessity, or for urgent reasons, and after full consideration. Fixation of law, even if there be minor defects, is better for any people than too frequent modifications. Constant trimming may damage or destroy the tree. Every change is not progress.

With these observations we beg leave respectfully to submit the following sections as embodying such of the foregoing views as have not been reduced to form of sections of a bill:

Section 10—Appeal Board.

We propose to leave that section as it is. As it now stands, the law makes it the duty of the board of appeal to *determine*—that is, *decide* upon the question appealed.

The change proposed by the Commissioner deprives the board entirely of its character as an appellate tribunal, and reduces them to the position of mere clerks, *to report their views to the Commissioner who alone is to decide.* By this change the applicant would *be required by law to pay an appeal fee*, and go through the farce of an appeal, and yet the tribunal to which he is thus *required by law to appeal cannot decide anything!*

Section 19—Giving Authority to make Rules.

"The Commissioner may, from time to time, establish such rules for the regulation of the business in the Patent Office as may be required to give effect to the provisions of the law."

We do not think any provision of the kind is required—that he has such authority now by virtue of his office; but if any such authority is given, we think it should be limited so as to prevent *legislating*, under the guise of making rules, *as has been done heretofore.*

Section 26.

This we propose to have remain as it was originally.

Section 36.—Saving Rights of Purchasers prior to Issue of Patent.

Every person who may have purchased or constructed any newly invented or discovered machine, or other patentable article, prior to date of the patent therfor, shall have

the right to use, and vend to others to be used, the specific thing so made or purchased without liability therefor; except in cases where a knowledge of the invention shall have been obtained surreptitiously, or where the newly invented machine, or other article, shall have been constructed or obtained with a view to defraud or injure the original and first inventor thereof; but this right shall not extend to the use of *a process* further than to permit the completion of any speific process that may have been commenced prior to the date of such patent.

SECTION 37.—APPEAL TO A JUDICIAL TRIBUNAL.

Cancel, as proposed by the Commissioner, and substitute the following:

"There shall be appointed by the President, by and with the advice and consent of the Senate, a person who shall be selected with special reference to his knowledge of patent law, and of the principles of mechanics, to be called ————, and whose term of office shall be —— years, with a salary of ———— dollars per annum, to whom all appeals shall be taken from the decision of the examiners-in-chief, on payment of the fee now required for an appeal to the Commissioner of Patents. The jurisdiction of said judge shall extend to all cases in which a patent is or may be refused, and shall include all questions involved in the decisions below; and his decision shall be final and binding upon the Patent Office in all its branches: *Provided, however*, That as to such matters as shall involve a construction of the law, the applicant on the one hand, and the Commissioner of Patents on the other, shall have the right to appeal to the United States Supreme Court.

"In all cases of interference, the appeal shall be taken directly from the decision of the primary examiner to the said judge."

NEW SECTION.—PERIODICAL TAX ON PATENTS.

On all patents hereafter granted there shall be paid to the credit of the Patent Office fund the following tax, viz: at the termination of five years from the date of the patent, the

sum of $10; and at the end of ten years from the date of the patent, the further sum of $25; and in default of the payment of either of the sums aforesaid, the said patent shall be forfeited, and the invention so patented shall thereby become public property.

JAS. M. BLANCHARD,
Chairman.

W. C. DODGE, *Secretary.*

J. J. HALSTEAD,
CHARLES MASON,
CHAS. F. STANSBURY,
Committee.