PATENT LAW CODIFICATION AND REVISION

WEDNESDAY, JUNE 13, 1951

HOUSE OF REPRESENTATIVES,
SUBCOMMITTEE NO. 3 OF THE COMMITTEE ON THE JUDICIARY,
Washington, D. C.

The subcommittee met at 10 a. m. pursuant to notice, the Honorable Joseph R. Bryson (subcommittee chairman) presiding, for consideration of H. R. 3760, which is as follows:

[H. R. 3760, 82d Cong., 1st sess.]

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

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

TITLE 35—PATENTS

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CHAPTER 1—PATENT OFFICE

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§ 1. Establishment

The Patent Office shall continue as an office in the Department of Commerce where records, books, drawings, specifications, and other papers and things

patents and to trade mark registrations shall be kept and pre
as otherwise provided by law.

Office shall have a seal with which letters patent, certificates of
gistrations, and papers issued from the Office shall be authenti

l employees

oner of Patents, one first assistant commissioner, two assistant
and nine examiners in chief, shall be appointed by the President,
advice and consent of the Senate. The assistant commissioners
the duties pertaining to the office of commissioner assigned to
ommissioner. The first assistant commissioner, or the assistant
enior in date of appointment in the event of a vacancy in the
ssistant commissioner, shall fill the office of Commissioner during
nt office until a Commissioner is appointed and takes office. All
clerks, and employees shall be appointed by the Secretary of
n the nomination of the Commissioner in accordance with law.

ns on officers and employees as to interest in patents

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

mmissioner and other officers

sioner and such other officers as he designates, before entering
es, shall severally give bond, with sureties, the former in the sum
the latter in sums prescribed by the Commissioner, conditioned
l discharge of their respective duties and that they shall render
fficers of the Treasury a true account of all money received by
offices.

Commissioner

sioner, under the direction of the Secretary of Commerce, shall
perform all duties required by law respecting the granting and
nts and the registration of trade marks, and he shall have charge
longing to the Patent Office. He may, subject to the approval
y of Commerce, establish regulations, not inconsistent with law,
of proceedings in the Patent Office.

ppeals

ers-in-chief shall be persons of competent legal knowledge and
ty. The Commissioner, the assistant commissioners, and the
hief shall constitute a Board of Appeals, which, on written appeal
t, shall review adverse decisions of examiners upon applications
ach appeal shall be heard by at least three members of the Board
e members hearing such appeal to be designated by the Com-
e Board of Appeals has sole power to grant rehearings.
e Commissioner considers it necessary to maintain the work of
Appeals current, he may designate any patent examiner, of the
ner grade or higher, having the requisite ability, to serve as
ef for periods not exceeding six months each. An examiner
shall be qualified to act as a member of the Board of Appeals,
one such primary examiner shall be a member of the Board of
g an appeal.

sioner shall maintain a library of scientific and other works and
h foreign and domestic, in the Patent Office to aid the officers
e of their duties.

on of patents

sioner may revise and maintain the classification by subject
ted States letters patent, and such other patents and printed
may be necessary or practicable, for the purpose of determining

with readiness and accuracy the novelty of inventions for which applications for patent are filed.

§ 10. Certified copies of records

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

§ 11. Publications

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

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

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

§ 12. Exchange of copies of patents with foreign countries

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

§ 13. Copies of patents for public libraries

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

§ 14. Annual report to Congress

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

PROCEEDINGS IN THE PATENT OFFICE

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

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

§ 22. Printing of papers filed

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

§ 23. Testimony in Patent Office cases

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

§ 24. Subpoenas, witnesses

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

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

urt whose clerk issued a subpoena may, on proof of the neglect
itness, after being duly served with such subpoena, to appear,
g, to testify, enforce obedience to the process or punish the
n other like cases. No witness shall be deemed guilty of con-
ring such subpoena unless his fees and traveling expenses in
arning from, and one day's attendance at the place of examina-
endered him at the time of the service of the subpoena; nor for
se any secret matter except upon appropriate order of the court
ubpoena.

PRACTICE BEFORE PATENT OFFICE

for agents and attorneys

ner, subject to the approval of the Secretary of Commerce, may
ons governing the recognition and conduct of agents, attorneys,
epresenting applicants or other parties before the Patent Office,
them, before being recognized as representatives of applicants
to show that they are of good moral character and reputation,
the necessary qualifications to render to applicants or other
service, advice, and assistance in the presentation or prosecu-
cations or other business before the Office.

or exclusion from practice

ner may, after notice and opportunity for a hearing, suspend
r generally or in any particular case, from further practice
Office, any person, agent, or attorney shown to be incompetent
r guilty of gross misconduct, or who does not comply with the
ished under section 31 of this title, or who shall, with intent to
mislead, or threaten any applicant or prospective applicant,
aving immediate or prospective business before the Office. The
such suspension or exclusion shall be duly recorded. The
trict Court for the District of Columbia, under such conditions
oceedings as it by its rules determines, may review the action
ner upon the petition of the person so refused recognition or
cluded.

d representation as practitioner

eing recognized to practice before the Patent Office, holds him-
s himself to be held out as so recognized, or as being qualified
secute applications for patent, shall be fined not more than
ense.

PATENT FEES

issioner shall charge the following fees:
h application for an original patent, except in design cases, $30,
aim in excess of twenty.
ach original patent, except in design cases, $30, and $1 for
ss of twenty.
es: For three years and six months, $10; for seven years, $15;
s, $30.
lication for the reissue of a patent, $30 and $1 for each claim
y over and above the number of claims of the original patent.
disclaimer, $10.
for the first time from the examiner to the Board of Appeals,
h petition for the revival of an abandoned application for a
delayed payment of the fee for issuing each patent, $10.
te of correction of applicant's mistake under section 255 of
led printed copies of specifications and drawings of patents
tents), 25 cents per copy; for design patents, 10 cents per copy;
oraries specified in section 13 of this title, $50 for patents issued
ng every assignment, agreement, or other paper not exceeding
each additional two pages or less, $1; for each additional patent
cluded in one writing, where more than one is so included, 50

11. For each certificate, $1.

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

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

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

CHAPTER 2—PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS

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DEFINITIONS

§ 100. Definitions

When used in this title unless the context otherwise indicates—

(a) The term "invention" includes discoveries.

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

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

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

PATENTABILITY OF INVENTIONS

§ 101. Inventions patentable

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof,

t therefor, subject to the conditions and requirements of this

r patentability; novelty and loss of right to patent

entitled to a patent unless—
ntion was known or used by others in this country or patented
any printed publication in this or any foreign country, before
hereof by the applicant for patent, or
ntion was patented or described in any printed publication in
eign country or in public use or on sale in this country, more
prior to the date of the application for patent in the United

bandoned the invention, or
ntion was first patented or caused to be patented by the
legal representatives or assigns in a foreign country prior
the application for patent in this country on an application
six months in design cases or twelve months in other cases be-
the application in the United States, or
ntion was described in an application for patent by another
ted States before the invention thereof by the applicant for
rst-mentioned application issued as a patent, or
himself invent the subject matter sought to be patented, or
he applicant's invention thereof the invention was in fact
ountry by another who had not abandoned it and who was
e diligence in this country in reducing it to practice or had
actice.

r patentability; non-obvious subject matter

be obtained though the invention is not identically disclosed
prior art set forth in section 102 of this title, if the differ-
ubject matter sought to be patented and that prior art such
atter as a whole would have been obvious at the time the
to a person having ordinary skill in the art to which said
ains. Patentability shall not be negatived by the manner in
was made.

de abroad

the Patent Office and in the courts, an applicant for a patent,
not establish a date of invention by reference to knowledge or
r activity with respect thereto, in a foreign country, except
ion 119 of this title. Where an invention was made by a
itary, while domiciled in the United States and serving in a
onnection with operations by or on behalf of the United States,
to the same rights of priority with respect to such invention
en made in the United States.

APPLICATION FOR PATENT

r patent

ntent shall be made by the inventor, except as otherwise pro-
in writing to the Commissioner. Such application shall in-
cation as prescribed by section 112 of this title; (2) a draw-
r section 113 of this title; and (3) an oath by the applicant
ction 115 of this title. The application must be signed by
companied by the fee required by law.

shall contain a written description of the invention, and
process of making and using it, in such full, clear, concise, and
enable any person skilled in the art to which it pertains, or
ost nearly connected, to make and use the same, and shall
de contemplated by the inventor of carrying out his invention.
shall conclude with one or more claims particularly pointing
claiming the subject matter which the applicant regards as

claim for a combination may be expressed as a means or step
pecified function without the recital of structure or acts in
d such claim shall be construed to cover the corresponding
or acts described in the specification and equivalents thereof.

§ 113. Drawings

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

§ 114. Models, specimens

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

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

§ 115. Oath of applicant

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

§ 116. Joint inventors

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

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

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

§ 117. Death or incapacity of inventor

The Commissioner may receive applications of and issue patents to legal representatives of deceased inventors and of those under legal incapacity, upon compliance with the requirements and on the same terms and conditions applicable to the inventor.

§ 118. Filing by other than inventor

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

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

An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest

h foreign application was filed; but no patent shall be granted
or for patent for an invention which had been patented or de-
ed publication in any country more than one year before the
filing of the application in this country, or which had been
sale in this country more than one year prior to such filing.
for patent shall be entitled to this right of priority unless a
at a certified copy of the original foreign application, specifica-
s upon which it is based are filed in the Patent Office before
ited, or at such time during the pendency of the application as
Commissioner, not earlier than six months after the filing of
this country. Such certification shall be made by the patent
ign country in which filed and show the date of the application
of the specification and other papers. The Commissioner may
tion of the papers filed if not in the English language and such
as he deems necessary.

arlier filing date in the United States

for patent for an invention disclosed in the manner provided
graph of section 112 of this title in an application previously
d States by the same inventor shall have the same effect, as
as though filed on the date of the prior application, if filed
ing or abandonment of or termination of proceedings on the
or any application similarly entitled to the benefit of the filing
pplication and if it contains or is amended to contain a specific
arlier filed application.

pplications

Independent and distinct inventions may be claimed in one applica-
sioner may require the application to be restricted to one of
nd the other invention or inventions may be made the subject
plications. A divisional application shall be entitled to the
g date of the original application if it complies with the require-
20 of this title. A patent issuing on an application with respect
rement for restriction under this section has been made, or on
sal as a result of such a requirement, shall not be used as a
n the Patent Office or in the courts against a divisional applica-
he original application or any patent issued on either of them,
of section 121 of this title if the divisional application is filed
ys of the patent. If a divisional application is directed solely
described and claimed in the original application as filed, the
ay dispense with signing and execution by the inventor. The
nt shall not be questioned for failure of the Commissioner to
striction to be restricted to one invention.

l status of applications

r patents shall be kept in confidence by the Patent Office and
concerning the same given without authority of the applicant or
essary to carry out the provisions of any Act of Congress or
circumstances as may be determined by the Commissioner.

EXAMINATION OF APPLICATION

n of application

ner shall cause an examination to be made of the application
new invention; and if on such examination it appears that the
tled to a patent under the law, the Commissioner shall issue

ejection; reexamination

examination, any claim for a patent is rejected, or any objec-
ent made, the Commissioner shall notify the applicant thereof,
ns for such rejection, or objection or requirement, together with
and references as may be useful in judging of the propriety
e prosecution of his application; and if after receiving such
ant persists in his claim for a patent, with or without amend-
tion shall be reexamined. No amendment shall introduce new
disclosure of the invention.

§ 133. Time for prosecuting application

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

§ 134. Appeal to the Board of Appeals

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

§ 135. Interferences

Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of three examiners of interferences whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office.

No claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may be made in any application unless such a claim is made within one year from the date on which said patent was granted.

REVIEW OF PATENT OFFICE DECISIONS

§ 141. Appeal to Court of Customs and Patent Appeals

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

§ 142. Notice of appeal

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

§ 143. Proceedings on appeal

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

§ 144. Decision on appeal

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

nation the court shall return to the Commissioner a certificate of nd decision, which shall be entered of record in the Patent Office urther proceedings in the case.

n to obtain patent

issatisfied with the decision of the Board of Appeals may, unless aken to the United States Court of Customs and Patent Appeals, ivil action against the Commissioner in the United States District strict of Columbia if commenced within such time after such de- han sixty days, as the Commissioner appoints. The court may h applicant is entitled to receive a patent for his invention, as of his claims involved in the decision of the Board of Appeals, he case may appear and such adjudication shall authorize the issue such patent on compliance with the requirements of law. of the proceedings shall be paid by the applicant.

n in case of interference

an interference dissatisfied with the decision of the board of ainers on the question of priority, may have remedy by civil ac- d within such time after such decision, not less than sixty days, n appoints or as provided in section 141 of this title, unless he has United States Court of Customs and Patent Appeals, and such g or has been decided. In such suits the record in the Patent mitted on motion of either party upon the terms and conditions ases, and the further cross-examination of the witnesses as the ithout prejudice to the right of the parties to take further testi- mony and exhibits of the record in the Patent Office when ad- e the same effect as if originally taken and produced in the suit. be instituted against the party in interest as shown by the rec- t Office at the time of the decision complained of, but any party ecome a party to the action. If there be adverse parties resid- of districts not embraced within the same state, or an adverse a foreign country, the United States District Court for the Dis- shall have jurisdiction and may issue summons against the irected to the marshal of any district in which any adverse ummons against adverse parties residing in foreign countries y publication or otherwise as the court directs. The Commis- e a necessary party but he shall be notified of the filing of the of the court in which it is filed and shall have the right to inter- of the court in favor of the right of an applicant to a patent e Commissioner to issue such patent on the filing in the Patent ed copy of the judgment and on compliance with the require-

ISSUE OF PATENT

ue of patent

ll issue within three months from the date of the payment of ch shall be paid not later than six months after written notice of allowance of the application, but the Commissioner may e if paid within one year after the six months' period for pay- tent shall issue.

tent to assignee

granted to the assignee of the inventor of record in the Patent application made and the specification sworn to by the inven- erwise provided in this title.

e issued in the name of the United States of America, under tent Office, and shall be signed by the Commissioner or have his hereon and attested by an officer of the Patent Office designated per, and shall be recorded in the Patent Office.

d term of patent

hall contain a short title of the invention and a grant to the s or assigns, for the term of seventeen years, of the right to m making, using, or selling the invention throughout the United

States, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof.

CHAPTER 3—PATENTS AND PROTECTION OF PATENT RIGHTS

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AMENDMENT AND CORRECTION OF PATENTS

§ 201. Reissue of defective patents

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

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

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

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

§ 202. Effect of reissue

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

No reissued patent shall abridge or affect the right of any person or his

ons who made, purchased or used prior to the grant of a
ented by the reissued patent, to continue the use of, or to sell
l or sold, the specific thing so made, purchased or used, if
r selling of such thing does not infringe a valid claim of the
h was in the original patent.

The judicial power conferred by this section to adjudge the
which such matter is in question may provide for the con-
use or sale of such thing made, purchased or used as specified
graph hereof, or for the manufacture, use or sale of which
tion was made before the grant of the reissue, and it may
continued practice of any process patented by the reissue,
practice of which, substantial preparation was made, prior
issue, to the extent and under such terms as the court deems
otection of investments made or business commenced before
ue.

t any deceptive intention, a claim of a patent is invalid
s shall not thereby be rendered invalid, and the patentee, his
ther of the whole or any sectional interest therein, may, on
required by law, make disclaimer of any complete claim,
extent of his interest in such patent. Such disclaimer shall
recorded in the Patent Office; and it shall thereafter be
of the original patent to the extent of the interest possessed
ing by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the
ublic any terminal part of the term, of the patent granted

correction of Patent Office mistake

ake in a patent, incurred through the fault of the Patent
sclosed by the records of the Office, the Commissioner may
of correction stating the fact and nature of such mistake,
charge, to be recorded in the records of patents. A printed
attached to each printed copy of the patent, and such certifi-
ereof as part of the original patent. Every such patent,
certificate, shall have the same effect and operation in law
ons for causes thereafter arising as if the same had been
such corrected form. The Commissioner may issue a cer-
out charge in lieu of and with like effect as a certificate of

correction of applicant's mistake

ake of a clerical or typographical nature, or of minor char-
of the fault of the Patent Office, appears in a patent and a
made that such mistake occurred in good faith, the Com-
n payment of the required fee, issue a certificate of correc-
ion does not involve such changes in the patent as would
ter or would require re-examination. Such patent, together
shall have the same effect and operation in law on the trial
ses thereafter arising as if the same had been originally
cted form.

inventor

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

r nonjoinder of joint inventors shall not invalidate a patent,
e corrected as provided in this section. The court before
is called in question may order correction of the patent on
of all parties concerned and the Commissioner shall issue a
gly.

OWNERSHIP AND ASSIGNMENT

§ 211. Ownership; assignment

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

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

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

An assignment, grant or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent Office within three months from its date, or prior to the date of such subsequent purchase or mortgage.

§ 212. Joint owners

In the absence of any agreement to the contrary, each of the joint owners of a patent may make, use or sell the patented invention without the consent of and without accounting to the other owners, but neither of the owners may grant licenses or assign his interest, or any part thereof, without the consent of the other owners or without accounting to them.

GOVERNMENT INTERESTS IN PATENTS

§ 221. Issue of patents without fees to Government employees

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

§ 222. Time for taking action in Government applications

Notwithstanding the provisions of sections 133, 145, and 151 of this title, the Commissioner may extend the time for taking any action to three years, when an application has become the property of the United States and the head of the appropriate department or agency of the Government has certified to the Commissioner that the invention disclosed therein is important to the armament or defense of the United States.

INFRINGEMENT OF PATENTS

§ 231. Infringement of patent

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

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

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

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

resence in the United States

invention in any vessel, aircraft, or vehicle of any country
lar privileges to vessels, aircraft, or vehicles of the United
e United States temporarily or accidentally shall not consti-
f any patent, if the invention is used exclusively for the needs
aft, or vehicle and is not sold in or used for the manufacture
old in or exported from the United States.

FOR INFRINGEMENT OF PATENT, AND OTHER ACTIONS

nfringement of patent

have remedy by civil action for infringement of his patent.

of validity; defenses

presumed valid. The burden of establishing invalidity of a
a party asserting it.
all be defenses to any action involving the validity or infringe-
nd shall be pleaded:
ment or absence of liability for infringement,
f the patent or any claim thereof on any ground specified in
le as a condition for patentability,
omply with any requirement of sections 112 or 201 of this title,
ct or not made a defense by this title.
ing the validity of infringement of a patent the party asserting
fringement shall give notice in the pleadings or otherwise in
erse party at least thirty days before the trial, of the country,
name of the patentee of any patent, the title, date, and page
blication to be relied upon as anticipations of the patent in suit
as in the United States Court of Claims, as showing the state
name and address of any person who may be relied upon as
or as having prior knowledge of or as having previously used
the invention of the patent in suit. In the absence of such
said matters may not be made at the trial except on such terms
ers.

rts having jurisdiction of cases under this title may grant
rdance with the principles of equity to prevent the violation
d by patent, on such terms as the court deems reasonable.

n patent valid and infringed, the court shall award the claim
nate to compensate for the infringement, but in no event less
royalty for the use made of the invention by the infringer,
est and costs as fixed by the court.
ges are not found by a jury the court shall assess them. In
urt may increase the damages up to three times the amount

volve expert testimony as an aid to the determination of dam-
ality would be reasonable under the circumstances.

s
ceptional cases may award reasonable attorney fees to the

ion on damages

also provided by law, no recovery shall be had for any infringe-
ore than six years prior to the filing of the complaint or coun-
gement in the action.

n damages; marking and notice

persons making or selling any patented article for or under
otice to the public that the same is patented, either by fixing
"patent" or the abbreviation "pat.", together with the number
hen, from the character of the article, this cannot be done, by
he package wherein one or more of them is contained, a label
otice. In the event of failure so to mark, no damages shall be

recovered by the patentee in any action for infringement, except on proof that the infringer was notified of the infringement and continued to infringe thereafter, in which event damages may be recovered only for infringement occurring after such notice. Filing of an action for infringement shall constitute such notice.

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

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

§ 249. Notice of patent suits

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

§ 250. Interfering patents

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

§ 251. False marking

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

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

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

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

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

§ 252. Nonresident patentee; service and notice

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

CHAPTER 4—PLANTS AND DESIGNS

PLANTS

Sec.
301. Patents for plants.
302. Description, claim.
303. Grant.
304. Assistance of Department of Agriculture.

DESIGNS

...ations:
...ent.
...edy for infringement of design patent.

PLANTS

...r plants

...nts, or discovers and asexually reproduces any distinct and new ...other than a tuber-propagated plant, may obtain a patent therefor, ...ditions and requirements of this title.

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

..., claim

...t shall be declared invalid for noncompliance with section 112 ...description is as complete as is reasonably possible.

...he specification shall be in formal terms to the plant shown and

...n plant patent the grant shall be of the right to exclude others ...producing the plant or selling the plant so reproduced.

... of Department of Agriculture

...may by Executive order direct the Secretary of Agriculture, in ...the requests of the Commissioner, to carry into effect the pro... ...le with respect to plants, (1) to furnish available information ...t of Agriculture, (2) to conduct through the appropriate bureau ...e Department research upon special problems, or (3) to detail ...her officers and employees of the Department.

DESIGNS

...r designs

...its any new, original, and ornamental design for an article of ...r obtain a patent therefor, subject to the conditions and require... ...e.

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

...iority

...iority provided for by section 119 of this title shall be six months ...igns.

...sign patent

...signs may be granted for the term of three years and six months, ...rs, or for fourteen years, as the applicant, in his application,

... remedy for infringement of design patent

...g the term of a patent for a design, without license of the owner, ...atented design, or any colorable imitation thereof, to any article ...or the purpose of sale, or (2) sells or exposes for sale any article ... to which such design or colorable imitation has been applied ... the owner to the extent of his total profit, but not less than ...e in any United States district court having jurisdiction of the

...is section shall prevent, lessen, or impeach any other remedy ...of an infringed patent has under the provisions of this title, but ...e recover the profit made from the infringement.

... 21 of the Act approved July 5, 1946, (60 Stat. 435 (United States ...ec. 1071, 1946 ed.), is amended by changing "Revised Statutes ... in said section to read "35 United States Code, section 141"; by ...n 4915, Revised Statutes," appearing in said section to read "35 ...ode, sections 145 and 146"; and by changing "Revised Statutes ...twice in said section to read "35 United States Code, section 146."

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

SEC. 4. (a) This Act shall take effect on January 1, 1952, and shall apply to all applications for patent filed on or after such date and to all patents granted on such applications. It shall apply to further proceedings on applications pending on such date and to patents granted on such applications except as otherwise provided. It shall apply to unexpired patents granted prior to such date except as otherwise provided.

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

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

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

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

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

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

Revised Statutes	U. S. Code, 1946 edition	
Section:	Title	Section
475	35	1
476	35	2
477	35	3
479	35	5
480	35	4
481	35	6
482	35	7
483	35	8
485	35	10
487	35	11
488	35	12
489	35	13
493	35	78
494	35	20
495	35	17
496	35	19
4883	35	30
4884	35	40
4885	35	44
4886	35	31
4887	35	32
4888	35	33
4889	35	34
4890	35	34
4891	35	34
4892	35	35
4893	35	36
4894	35	37
4895	35	44
4896	35	46
4898	35	47

Revised Statutes Continued	U. S. Code, 1946 edition	
Section	Title	Section
4900	35	48
4900	35	49
4901	35	50
4903	35	51
4904	35	52
4905	35	53
4906	35	54
4907	35	55
4908	35	56
4909	35	57
4911	35	58
4912	35	59
4913	35	61
4914	35	62
4915	35	63
4916	35	64
4917	35	65
4918	35	66
4919	35	67
4920	35	68
4921	35	70
4922	35	71
4923	35	72
4929	35	73
4930	35	76
4931	35	77
4933	35	78
4934	35	79
4935	35	74
4936	35	75

Statutes at Large					U. S. Code, 1946 edition	
	Chapter	Section	Volume	Page	Title	Section
	143	Part [1]	22	625	35	45.
	105	1	24	387	35	74.
		2	24	388	35	75.
	15		25	40	35	39.
	541	1 part [2]	26	939	35	14.
	204		29	124	35	78.
	391	1	29	692	35	31.
		2		693	35	69.
		3		693	35	32.
		4		693	35	37.
		5		693	35	47.
		6		694	35	70.
		7		694	35	43.
				440	35	6 note.
	423	1	30	915	35	46.
	227		30	95	35	39.
	417		32	193	35	71.
	783		32	1225	35	32.
	1019	1	32	1226	35	35.
		2		1226	35	46.
		3		245	35	46.
	188		35	246	35	41.
	189		35	343	35	78.
	200	1 part [3]	35	1221	35	15.
	Pub. Res. 61.					
	94	1	38	958	35	33.
		2		959	35	34.
	22	1	39	8	35	2.
	225	1 part [4]	39	348	35	37.
	93	1 part [5]	41	305	35	78.
	94	1 part [6]	41	312	35	70.
	126	1	41	1313	35	80.
		2		1314	35	81.
		3		1314	35	82.
		4		1314	35	83.
		5		1314	35	84.
		6		1314	35	85.
		7		1314	35	86.
		8		1315	35	87.
	58					
		3	42	390	35	11.
		5		391	35	39.
		6		391	35	47.
		7		391	35	54.
		8		392	35	70.
		9		393	35	78.
	535	1	43	1268	35	88.
	67		44	1058	35	49.
	139	1	44	1098	35	2.
		2		1099	35	78.
	273	1	44	1335	35	37.
		3		1335	35	7.
		4		1336	35	52.
		5		1336	35	37.
		8		1336	35	59a.
		9		1336	35	60.
		10		1336	35	61.
		11		1336	35	63.
		12		1337	35	66.
		13		1337	35	78.
		14		1337	35	21.
			44	1394	35	72a.
	364		45	467	35	45.
	480		45	732	35	64.
	730		45	1012	35	40a.
	992	1		1013	35	40b.
		2		1013	35	40c.
		3		1013	35	40d.
		4		1014	35	40d.
	468	2b	45	1476	35	59a, 60, 63.
	132	1	46	155	35	2.
		2		155	35	7.
		3		155	35	78.
		5		156	35	22.
		6		156	35	23.
	312	1	46	376	35	31, 40.
		2		376	35	33.
		3		376	35	35.
		4		376	35	59a.
		5		376	35	32a.
		6		376	35	32b.
	314	308	47	410	35	78.
		309		410	35	78.

s at end of table.

Statutes at Large					U. S. Code, 1946 edition	
Date	Chapter	Section	Volume	Page	Title	Section
1936—June 19	94		49	1529	35	32.
1938—May 9	185		52	342	35	11a.
1939—Aug. 5	450	1	53	1212	35	31, 32, 69, 73.
		2		1212	35	31 note.
Aug. 5	451	1	53	1212	35	52.
		2		1212	35	57.
		3		1212	35	58.
		4		1212	35	63.
Aug. 5	452	1	53	1213	35	51.
Aug. 7	568		53	1264	35	37.
Aug. 9	619	2	53	1293	35	41.
		3		1293	35	78.
1941—Aug. 18	370		55	634	35	47.
1946—July 5	541	301 part [7]	60	471	35	78.
Aug. 1	726		60	778	35	70.
Aug. 8	910	[8]	60	958	35	109.
1950—Mar. 4	50		64	11	35	7.
June 15	249		64	215	35	78.

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

Present: Representatives Bryson, Ramsay, Boggs, Rogers, Crumpacker, and Bakewell.

Also present: Charles J. Zinn, law revision counsel, Committee on the Judiciary; L. James Harris, committee counsel, Committee on the Judiciary.

Mr. BRYSON. Gentlemen, the committee will come to order, and as our friend Congressman Jennings used to say, "We hate to find ourselves like an Egyptian mummy, pressed for time."

We received a telegram this morning from the Democratic whip, Hon. Percy Priest, that we would be expected to be on the floor, and the House meets at 12 o'clock. We will try to make some arrangements about it, however.

We are pleased to note the interest in this hearing; and we will proceed as expeditiously as possible.

The first witness on the schedule is our law revision counsel, Mr. Charles J. Zinn, who will now make a brief statement.

The acoustics in this room are not too good, and if some of you gentlemen have difficulty in hearing you might move up here and occupy some of the seats nearer to the front.

All right, Mr. Zinn.

STATEMENT OF CHARLES J. ZINN, LAW REVISION COUNSEL, COMMITTEE ON THE JUDICIARY

Mr. ZINN. Mr. Chairman, I will make a brief preliminary statement regarding the background and objectives of this bill. As its title indicates the bill, H. R. 3760, is intended to revise and codify the laws relating to patents and enact into law title 35 of the United States Code entitled "Patents."

By a fortunate distribution of committee functions your subcommittee is charged both with the revision of the laws and with the consideration of bills relating to patents.

part of the comprehensive program of revising and
aw all the titles of the United States Code. Up to the
out of the 50 titles of the code have been revised and
w, and the committee is now engaged in the considera-
ation of bills relating to a number of additional titles.
patent laws consist of about 60 sections of the Revised
4, together with over 60 acts of Congress passed since
ding various sections of the Revised Statutes or making
ts not related to any section of the Revised Statutes.
ctions of the Revised Statutes relating to patents were
ilation of the act of 1870, our present patent law, which
le 35 of the United States Code, is essentially the act of
equent enactments.
eral revision of the patent laws was the act of July 8,
as part of a program to revise and consolidate all the
ited States. In 1866 Congress passed a law providing
n and consolidation of the statutes of the United States,
on which was appointed to perform this work prepared
draft of the part relating to patents and copyrights in
econd preliminary draft in 1868. The following year
lating to patents and copyrights as revised, simplified,
consolidated by the Commission was reported to Con-
he same time referred to the Committee on Patents and
oduced by the chairman a few days later.
of the Commission on Revision of the Laws was only to
e, and consolidate the statutes in force and the draft
the Commission presumably was for this purpose only.
le reason for referring the matter to the Committee on
hat during this same period there had been many sug-
mending the patent laws in substance, and it appears
mittee on Patents studied the draft of the Commission
t by various amendments on matters of substance. The
oduced was enacted on July 8, 1870, 16 United States
and included the subjects of copyrights and trade-marks
ents.
Revised Statutes as in force on December 1, 1873, were
une 22, 1874, the sections of the act of 1870 were dis-
rious parts of the Revised Statutes.
years there was considerable agitation for a complete
nd codification of all the laws of the United States
he only such codification—the Revised Statutes of 1873—
enerally outmoded on all subjects.
response to widespread recognition of the need there-
r nearly 7 years' effort on the part of the Committee
on of the Laws, the Congress adopted the United States
was a codification of the existing general and permanent
United States arranged in 50 titles according to subject
which was declared to be prima facie evidence of the law.
the enormity of that code Congress decided that it should
ting period before it was enacted into positive law.
as now been subjected to such a testing period lasting 25
e program of your committee enacting the titles into law
rogress for several years.

About 2 years ago it was suggested that since this subcommittee had jurisdiction over both the revision of the laws and the subject of patents we ought to undertake the preparation of the present bill.

The work was initiated by the preparation of a preliminary draft of a Proposed Revision and Amendment of the Patent Laws, which was printed and distributed in February of last year.

The preliminary draft included a collection of a large number of proposed amendments which had come to the attention of the Congress, as well as the codification itself. The preliminary draft was widely distributed with a request for criticisms and suggestions. As a result of the comments received, the committee decided to eliminate numerous proposed changes from the bill and defer them for later consideration, and to limit the bill to the main purpose of codification and enacting title 35 into law, with the further object of making a number of minor procedural and substantially noncontroversial changes.

Numerous suggestions were received by the committee from the patent bar and the public. Taking into consideration the suggestions and criticisms and other comments which had been received by the committee, a bill was prepared and introduced in the Eighty-first Congress, H. R. 9133, dated July 17, 1950. This bill was widely distributed and again comments were received by the committee from the patent bar and others. As a result of this material, the bill was reintroduced in revised form as the bill before us, H. R. 3760.

In the preparation of the draft leading to the present bill, all acts of Congress relating to or mentioning patents which have been enacted since 1874 were collected and studied, and those acts which had not been specifically repealed were used in preparing the drafts.

The changes introduced in the bill were obtained mainly by a study of all the bills relating to patents which had been introduced in Congress since 1925, and in addition the reports of various committees making studies of the patent laws, reports and recommendations of private groups, and other miscellaneous sources.

The committee as a matter of policy for a number of years has been calling on official and unofficial experts in the field to assist the committee, and our committee has been very fortunate in receiving the assistance of various persons like Mr. P. J. Federico of the Patent Office, and Captain Robillard of the Department of Defense; and the coordinating committee of the bar has rendered invaluable service to the committee in the preparation and study of the bill, and the report which will follow.

Mr. BRYSON. Thank you. Are there any questions?

STATEMENT OF HENRY R. ASHTON, REPRESENTING THE COORDINATING COMMITTEE ON REVISION AND AMENDMENT OF THE PATENT LAWS OF THE NATIONAL COUNCIL OF PATENT LAW ASSOCIATIONS

Mr. BRYSON. Mr. Ashton, will you give the reporter your full name and address and in what capacity you now appear?

Mr. ASHTON. My name is Henry R. Ashton.

I appear in support of H. R. 3760 on behalf of the Coordinating Committee on Revision and Amendment of the Patent Laws, of which I am chairman.

You may be seated if you like, Mr. Ashton.
Thank you.
Do you have a prepared statement?
Yes, I have, of which 40 copies have been supplied to
additional copies here if anyone wishes a copy.
Do you have any preference as to whether you be
ake your complete statement before any questions are
ld you like to have questions propounded as you go

I have no objection whatsoever to having questions
ilong. However, we might expedite it a little more if
held to the end.
We do want to conserve time because we have a num-
s to be heard this morning.
Yes, sir.
And we have to be as rapid as possible; so you may

Thank you. The committee was organized February
following patent law associations, patent committees of
sociations, and industrial associations have been regu-
ted on or have otherwise participated in the work of this

l of Patent Law Asso-	District of Columbia Bar Association, Patent Section
t Law Association	Los Angeles Patent Law Association
Association, Patent Sec-	Manufacturing Chemists Association
Manufacturing Asso-	Michigan Patent Law Association
	Milwaukee Patent Law Association
he Bar of City of New	Minnesota Patent Law Association
Committee	National Association of Manufacturers
Law Association	New Jersey Patent Law Association
Law Association	New York Patent Law Association
t Law Association	Oregon Patent Law Association
t Law Association	Philadelphia Patent Law Association
Association, Patent Sec-	Pittsburgh Patent Law Association
	Rochester Patent Group
Association, Patent	St. Louis Bar Association, Patent Section
	San Francisco Patent Law Association
ent Law Association	Seattle Patent Law Association
Law Association	Toledo Patent Law Association

call, Mr. Bryson, that on May 23, 1950, on the floor of
Representatives, you formally advised the House of
ng by your committee to revise and codify the patent
lled the attention of the House to your committee's now
ommittee print, which was prepared for and was issued
mittee on January 10, 1950, and which has served as
l the work that has since been done, culminating in H. R.
er consideration. At the same time you very graciously
owing statement:

ed by the manner in which the organized patent bar has come
mmendable and constructive fashion to help Congress in under-
nidable assignment. Your instantaneous cooperation has been
t dramatic evidences of the democratic process that I have had
witnessing. With the attitude you have adopted I am confi-
all perform a painstaking, objective study of the subject that will
duce a body of laws which will serve our future as well as the
ve served our past.

And you further said with reference to the patent bar:

If you learned gentlemen feel disposed to question the diligence of your legislators in considering your patent problems, lay it not to our lack of interest but rather to your own talented disagreement.

We in the National Council of Patent Law Associations were familiar with the much too frequent inability of the patent bar to agree on various proposals to amend the patent laws. Although it may be an overstatement to refer to some of our disagreements as "talented disagreements," they were nevertheless disagreements and sometimes made it exceedingly difficult if not impossible for your committee to obtain the enactment of constructive patent legislation.

Encouraged by the experience of the Trade-Mark Coordinating Committee which worked on the Lanham Act, the officers of National Council of Patent Law Associations, whose membership includes the 19 principal patent law associations in the country, called a meeting in Washington on February 8, 1950, for the purpose of forming a coordinating committee to coordinate the views of the patent law associations, other organizations, and individuals with respect to the proposed revision and amendment of the patent laws contained in your committee print.

Nearly all of the member associations sent representatives to this first meeting, and those present voted unanimously to form the coordinating committee. A drafting committee, consisting of Giles S. Rich, of New York, and Paul A. Rose, of Washington, D. C., was appointed at the same meeting and instructed—

to prepare a revision and amendment of the patent laws based upon the committee print containing only such changes in existing laws as in the judgment of the drafting committee would meet with substantial approval of the patent profession.

A number of industrial associations then joined in the work of the coordinating committee. The committee print was subjected to thorough study by all the associations represented, and numerous reports and suggestions were sent to the drafting committee. These reports and suggestions were studied by the drafting committee which prepared a careful redraft representing its best judgment of those provisions that would meet with general approval. Seven hundred and fifty copies of this redraft were printed by our committee and distributed on April 14, 1950, to the legislative committees of the represented associations. At a second meeting of the coordinating committee held on May 9 and 10, 1950, this redraft was carefully considered section by section, was reprinted with the changes adopted at this 2-day meeting, and was then submitted to your committee. With the assistance of this redraft, H. R. 9133 was prepared by your committee and introduced in the House on July 17, 1950.

H. R. 9133 was widely distributed, our committee alone having distributed 4,000 copies to the patent profession and industry. H. R. 9133 was then subjected to close study by the legislative committees of our associations and by the associations themselves over a period of 6 months, which again submitted their reports to our drafting committee. The drafting committee not only studied these reports but also earlier bills to amend the patent law, such as the Wiley bill, S. 2518. In addition, it carefully examined the patent laws of other countries, including those of Great Britain and Canada. Based upon

tudy, the drafting committee submitted proposals for
R. 9133 to a third meeting of the coordinating com-
December 6 and 7, 1950. At this meeting H. R. 9133
and voted upon section by section, and our resulting
presented to your committee.
arly spring of this year, and I think this is of great
is draft was subjected to the most thorough and care-
a 3-day meeting here in Washington of the patent
American Bar Association, the results of which were
your committee.
number of the most able patent lawyers in the country
ed that meeting, but vigorously participated in it. As
to you, much additional work was then done by your
unsel, Mr. Zinn, and your counsel, Mr. Harris, which
he introduction on April 18, 1951, of H. R. 3760, now
ation
vas promptly distributed to the 5,428 patent lawyers
istered to practice before the Patent Office, to the in-
tions, and other interested persons. Since April 18,
0 has been carefully studied by the legislative commit-
eral associations on our committee preparatory to a
ating committee meeting held in Washington on May
ty persons representing 27 associations attended this
. 3760 was considered section by section, and the rela-
nges which were favored have been communicated to
.
o be stated that all of the reports which have come to
g committee or its drafting committee during the year
f its existence have been made available to your com-
your committee's counsel.
derstanding that one of the "talented disagreements"
ar on legislative matters prompted your committee to
portant program of revising and codifying the patent
ing your committee rendered a most valuable service
You have afforded those most interested in a sound
an opportunity to demonstrate that they also have
ge measure of agreement, when the matter involved is
tance. It is our earnest hope and belief that the Na-
of Patent Law Associations, to which our coordinating
s its origin and whose good offices it employs, will in
ady to support the work of your committee by coordi-
e that employed in helping to develop the bill now
ation.
t be said that in this instance we have worked effectively
s and with your committee. Certainly no other piece
lation has ever received such thorough consideration
alified persons over such an extended period of time.
mitted herewith a list of the approximate membership
patent-law associations which have been represented
fee or have otherwise cooperated with it. The total
these associations is nearly 5,000. I do not have avail-
r or names of the companies which are members of the
ciations which have worked with our committee. Of

the total companies represented in these associations, the small companies far outnumber the larger ones.

Several of our associations expect to present at these hearings their own reports and resolutions in support of H. R. 3760. However, I have been asked to present letters or resolutions from the other associations, copies of which are attached to my statement.

These resolutions are 18 in number. I have an extra copy of them which I can hand up to the committee. I would like to submit them, and with the chairman's permission I would like quickly to refer to two or three of them so that the committee will see exactly the character of them, if I may have that permission.

Mr. BRYSON. You may do that.

Mr. ASTROS. I would like first to call attention to the resolution of the Chicago Patent Law Association. The letter is addressed to me, and it is dated June 6, 1951. It states:

> At a board meeting of our association today we unanimously passed the following resolution:
>
> "*Resolved*, That H. R. 3760 with the changes recommended by the coordinating committee of the National Council of Patent Law Associations at its meeting on May 22, 1951, be approved as a whole."
>
> As you may know, the present bill H. R. 3760 and its predecessor H. R. 9133 have been the subject of very intensive study by the Patent Law Association of Chicago. We conducted a series of symposia last year under the direction of several subcommittees appointed to consider various sections of the bill, which symposia were well attended by members of our association. Copies of the reports of each subcommittee were printed and distributed to all members of the association, and the final reports of our legislative committee and the board of managers were also printed and distributed to all our members.
>
> Similar subcommittees were again appointed this year for consideration of H. R. 3760. The above resolution therefore may be considered as representing the results of a most careful study by our association.

Now, that is a direct statement of the type of work which was conducted by every one of these associations.

The particular resolutions which I wish to present are the resolution of the Boston Patent Law Association, in addition to the Chicago resolution which I just read, the resolution of the Cleveland Patent Law Association; the resolution of the Colorado Bar Association; the resolution of the Columbus Bar Association; the resolution of the Connecticut Patent Law Association; the resolution and letter of the Dayton Patent Law Association; the resolution of the Los Angeles Patent Law Association; the resolution of the Michigan Patent Law Association, of the Milwaukee Patent Law Association, and the Minnesota Patent Law Association.

I do not know whether Mr. Levy plans to present the resolution of the New Jersey Patent Law Association. He apparently is not here, so I present, as I am authorized to do, the New Jersey Patent Law Association's resolution.

It may be that Mr. Neave later will have the opportunity to and wish to present the resolution of the New York Patent Law Association. I might quickly refer to that at this time. It is a resolution passed by the board of governors of that association on May 24, 1951, and states:

> *Resolved*, That the president of the New York Patent Law Association, acting on behalf of its board of governors, is authorized to endorse and to testify in support of the Bryson bill, H. R. 3760; he is also similarly authorized to endorse and support the recommendations finally made by the coordinating committee as valuable suggestions for improvement in the bill which should be included in it if possible.

the resolutions of the Philadelphia Patent Law Associa-
Pittsburgh Patent Law Association; of the St. Louis
of its bar association, and the resolution of the San
ent Law Association and of the Toledo Patent Law
hich I now offer to the committee.
. They will be included in the record.
r referred to is as follows:)

THE BOSTON PATENT LAW ASSOCIATION,
Boston, Mass., June 6, 1951.

ON, Esq.,
w York, N. Y.
a meeting of the executive committee of the Boston Patent Law
une 5, 1951, it was—
at the executive committee of the Boston Patent Law Association
he passage of H. R. 3760, preferably with the proposed changes
eeting of the coordinating committee on May 22, 1951."
lly,

M. R. JENNEY, *Secretary.*

THE PATENT LAW ASSOCIATION OF CHICAGO,
June 6, 1951.

SHTON,
w York, N. Y.
ITON: At a board meeting of our association today we unani-
he following resolution:
at H. R. 3760 with the changes recommended by the coordinating
ational Council of Patent Law Associations at its meeting on
approved as a whole."
now, the present bill H. R. 3760 and its predecessor H. R. 9133
bject of very intensive study by the Patent Law Association of
nducted a series of symposia last year under the direction of
ittees appointed to consider various section of the bill, which
well attended by members of our association. Copies of the
subcommittee were printed and distributed to all members of
and the final reports of our legislative committee and the board
re also printed and distributed to all our members.
mmittees were again appointed this year for consideration of
e above resolution therefore may be considered as representing
ost careful study by our association.
y truly,

CLARENCE F. POOLE,
Representative of the Patent Law Association of Chicago.

THE B. F. GOODRICH CO.,
Akron, Ohio, May 31, 1951.

Law Association. Approval of H. R. 3760.

N, Esq.,
w York, N. Y.
RON: At its annual meeting on May 29, 1951, the Cleveland Patent
approved the following resolution:
at the Patent Law Association approves in principle the recodi-
atent laws set forth in the bill H. R. 3760 now pending in the
entatives subject to such corrections as are being made by the
mittee of the Council of Patent Law Associations."
this will give the assurance which you will wish to have for
he House Judiciary Committee, while permitting correction of
rs and ambiguities on which your committee has been working.
yours,

HAROLD S. MEYER,
Legislative Committee, the Cleveland Patent Law Association.

WHITEHEAD & VOGL,
Denver, Colo., May 25, 1951.

AMERICAN PATENT LAW ASSOCIATION,
Washington, D. C.

GENTLEMEN: The report of the Laws and Rules Committee on H. R. 3760, Eighty-second Congress was fully discussed by the patent section of the Colorado Bar Association at its meeting held on May 24, 1951, and the report was unanimously approved.

I was instructed by the meeting to advise you to this effect.

Yours very truly,

CARLE WHITEHEAD,
Secretary, Patent Section, Colorado Bar Association.

THE JEFFREY MANUFACTURING CO.,
Columbus, Ohio, June 7, 1951.

HENRY R. ASHTON, Esq.,
New York, N. Y.

DEAR SIR: The patent committee of the Columbus Bar Association, by unanimous action, recommends the passage of H. R. 3760, with those changes approved by the coordinating committee of the National Council of Patent Law Associations.

Very respectfully.

HARKER H. HITTSON,
Chairman, Patent Committee, Columbus Bar Association.

RESOLUTION UNANIMOUSLY ADOPTED AT A FULL MEETING OF THE CONNECTICUT PATENT LAW ASSOCIATION ON MAY 24, 1951

Resolved, That the advisory committee of the coordinating committee on revision and amendment of the patent laws be empowered to represent the Connecticut Patent Law Association in behalf of the support of H. R. 3760 with such appropriate changes as in the discretion of said committee seem necessary in view of the activities of the coordinating committee and such opposition as may develop from unexpected and unanticipated sources as may be necessary to accomplish acceptance of this bill by Mr. Bryson's subcommittee.

THE CONNECTICUT PATENT LAW ASSOCIATION,
THOMAS A. JOHNSON, *President.*

THE DAYTON PATENT LAW ASSOCIATION,
Dayton, Ohio, June 8, 1951.

HENRY R. ASHTON, Esq.,
New York, N. Y.

DEAR MR. ASHTON: At the regularly scheduled meeting of the Dayton Patent Law Association which was held on June 8, the recommendations of the coordinating committee with respect to proposed changes in H. R. 3760 were considered and approved in their entirety.

In other words, our association has gone on record as favoring the support of H. R. 3760 at the coming hearings, whether or not all of the changes proposed by the coordinating committee are made, but with the understanding that every effort should be made to have these changes adopted.

Yours very truly,

EDWIN S. DYBVIG, *Secretary.*

PATENT LAW ASSOCIATION OF LOS ANGELES,
June 5, 1951.

HENRY R. ASHTON, Esq.,
National Council of Patent Law Associations,
Washington, D. C.

DEAR MR. ASHTON: Our legislature committee has recommended, and I have been authorized by our board of governors to say, that:

(1) The Patent Law Association of Los Angeles supports the passage of H. R. 3760 of the Eighty-second Congress; and

t Law Association of Los Angeles approves the changes ap-
ordinating committee at its meeting in Washington on May 22,
s full authority to your committee to negotiate those changes.
yours,

LYNN L. SIKKEL.

HE BOARD OF DIRECTORS OF THE MILWAUKEE PATENT LAW AS-
SOCIATION, ADOPTED JUNE 8, 1951.

the Board of Directors of the Milwaukee Patent Law Associa-
llowing policy with respect to the Bryson bill (H. R. 3760):
slation present a united front with the other patent organiza-
before the House Committee on the Judiciary, in endorsement
H, and that Henry R. Ashton, Esq., be authorized in his dis-
rm the House committee.
of alternative legislation by our association, be for the present
t until the House develops its attitude toward the Bryson

s the Bryson bill is treated as a mere "revisor's bill," largely
and thus appears likely to pass the House substantially in its
vocacy of alternative legislation continue to be withheld.
ryson bill passes the House in substantially its present form,
alternative legislation continue to be withheld, so long as final
kely, but that we reserve the right to attempt to obtain the
enate of such amendments as our legislative committee (subject
r board of directors) may deem necessary, however keeping
s to the smallest possible number.
ryson bill be defeated in either the House or the Senate, or
nes a controversial measure with serious opposition in either
Senate, then we reserve the right to work for the introduction
islation.
ecretary be instructed to mail a copy of his resolution at once to

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THE MINNESOTA PATENT LAW ASSOCIATION,
June 7, 1951.

L OF PATENT LAW ASSOCIATIONS,
Washington, D. C.

of Mr. Francis D. Stephens, chairman of committee on patent
on.)

IRNS: At the annual meeting of the Minnesota Patent Law As-
y 17, 1951, at which time the writer took over as president
ear, the resolution was passed approving H. R. 3760, now being
ngress.
he loose ends, the writer notes that no notification of this was
; hence, this letter.
truly,

THE MINNESOTA PATENT LAW ASSOCIATION,
Ralph F. Merchant, President.

THE NEW JERSEY PATENT LAW ASSOCIATION, NEWARK, N. J.,
JUNE 1, 1951

the New Jersey Patent Law Association approves in principle
H. R. 3760 and the various sections thereof, and, moreover,
pts as its own views such modifications in H. R. 3760 as may
the coordinating committee on revision and amendment of the
National Council of Patent Law Associations; and be it
er, That spokesmen for said coordinating committee, in express-
the coordinating committee at hearings with respect to said bill,
recognized as setting forth the official views of the New Jersey
ciation; and be it

Resolved further, That the chairman of the legislation committee of the New Jersey Patent Law Association is hereby authorized to present this resolution in behalf of the New Jersey Patent Law Association.

MAURICE W. LEVY,
Chairman of the Legislation Committee, New Jersey Patent Law Association.

THE PHILADELPHIA PATENT LAW ASSOCIATION,
Philadelphia, Pa., June 8, 1951.

HENRY R. ASHTON, Esq.,
National Council of Patent Law Associations,
Washington, D. C.

DEAR MR. ASHTON: H. R. 3760, together with the amendments proposed by the coordinating committee in its most recent session, has been considered in detail by the legislative committee of this association, and in general by the board of governors. All members of both groups approve the bill as a whole. Eleven members of the legislative committee and five members of the board of governors approve it without qualification. The three remaining members of the legislative committee and the two remaining members of the board of governors, though approving the measure as a whole, express some reservations as to one or more specific points.

There has not been sufficient time to procure a vote from the entire membership of this association.

The only sections queried specifically were: As to substantive provision, sections 203, 231, and 248. As to matters of terminology, sections 100, 102, 116, and 122. Mr. Klein, chairman of the legislative committee, is writing to you with reference to these sections.

Yours very truly,

ARTHUR SYNNESTVEDT, *President.*

PITTSBURGH PLATE GLASS CO.,
Pittsburgh, Pa., June 4, 1951.

HENRY R. ASHTON, Esq.,
Chairman of Coordinating Committee,
National Council of Patent Laws Associations, New York, N. Y.

DEAR MR. ASHTON: The Patent Law Association of Pittsburgh cannot as a body act in time to pass a resolution supporting the passage of H. R. 3760.

Under the circumstances, I have polled the members of the board of managers of the association, and they have authorized me to write you this letter for use at the hearings before the subcommittee of the Judiciary Committee as showing that the governing body of this association supports the passage of H. R. 3760.

Very truly yours,

OSCAR L. SPENCER,
President, the Patent Law Association of Pittsburgh.

ST. LOUIS, MO., *June 12, 1951.*

NATIONAL COUNCIL OF PATENT LAW ASSOCIATIONS,
Washington, D. C.:

Patent section of St. Louis Bar Association approves H. R. 3760 of Eighty-second Congress but expressed strong sentiment for more direct and stronger definition of invention and suggest restudy of paragraph B of section 231 to more accurately define tortious inducement of infringement.

NEAL E. WILLIS,
Secretary, Monsanto Chemical Co.

PATENT LAW ASSOCIATION OF SAN FRANCISCO,
June 8, 1951.

Mr. HENRY R. ASHTON,
Chairman, Coordinating Committee on Revision and Amendment
of the Patent Laws, New York City, N. Y.

DEAR MR. ASHTON: The Patent Law Association of San Francisco, acting through its board of governors, endorses H. R. 3760 and urges approval and

thereof. It is hoped that the changes in H. R. 3760 suggested by
g Committee on Revision and Amendment of the Patent Laws
ated in the bill.
y yours,

PATENT LAW ASSOCIATION OF SAN FRANCISCO,
STEPHEN S. TOWNSEND, *President.*

SOLUTION OF THE TOLEDO PATENT LAW ASSOCIATION

t the Executive Committee of the Toledo Patent Law Associa-
e passage of H. R. 3760 as amended by the suggestions made and
coordinating committee of the National Council of Patent Law
d that the secretary be, and hereby is, directed to transmit copies
n to the National Council of Patent Law Associations.
a true copy of a resolution adopted by the executive committee
tent Law Association at a meeting held Thursday, May 31, 1951.

HENRY K. LEONARD, *Secretary.*

. Incidentally, those resolutions to which you have made
rently represent the larger associations in the country.
. The ones I have presented at the moment represent
irds or more of all the patent law associations in the
ding a number of the smaller associations, as you will
st of membership at the back of my statement.
Yes.
. There were included in our group all of the patent law
the country. In fact they all worked with us, so they
the large ones, and also all of the small ones.
n, I wish to thank the chairman, the other members of
e and the committee's counsel for the opportunity we
sist in this important work. It also seems appropriate
our thanks to the officers and members of the legislative
our associations and other individuals who have worked
and finally to thank Messrs. Federico, Rich, and Rose
untiring and invaluable help the work of the coordi-
tee could not have been carried on.
neeting of the coordinating committee on May 22, 1951,
nmittee was appointed to act for the coordinating com-
hearings. Several members of this advisory commit-
n to myself, are present. They will be glad to testify
questions on any part of the bill if your committee so

May I ask a question, Mr. Chairman?
. Congressman Rogers desires to propound a question.
. Yes, sir.
You made a statement, I think, on page 3 of your

. Yes, sir.
In which you said—

s in existing law as in the judgment of the drafting committee
substantial approval of the patent profession.

would infer from that that it was not unanimous as to
ns and conditions of this latest recodified law; that is
t?
. You see, Mr. Rogers, at the time that resolution was
coordinating committee at the very first meeting we

had before it your committee print which contained a number of new proposals in the law as well as codifications, and there were a number of proposals in that which everyone recognized at once would be controversial.

This group organized itself, therefore, on the basis of having a redraft made on which we thought we could get substantial agreement, and this committee included industrial associations, and so forth, and the drafting committee worked up and brought into the committee a revision leaving out the controversial matters, and which, in its judgment it felt would meet with general approval, but you must bear in mind that the whole project is primarily codification.

Mr. ROGERS. We appreciate the good work that the committee has done and, of course, we are trying to arrive at what may have been controversial matters therein.

Mr. ASHTON. Are you inquiring as to within the committee itself, on various phases of the bill?

Mr. ROGERS. Let me ask you this question: I understand the present bill, H. R. 3760, is one that has been more or less agreed upon among members of the Patent Attorneys' Associations, subject to some of the recommendations in May.

Mr. ASHTON. The coordinating committee met May 22 and adopted a list of suggestions, and they were suggestions to your committee. They were adopted by most of the associations as changes which they would like to see made in the bill. Most of them feel that the bill as a whole is a desirable bill, and they hope that these changes which are clarifying and not controversial matters in any way should be made.

It is not at all strange that there should be some suggestions for changes which would develop. Also the bill was prepared by your committee and changed in a number of respects so that it had to be thoroughly considered again.

Mr. ROGERS. Then do I understand that concerns the proposed clarifying amendments you have filed here with the clerk?

Mr. ASHTON. That is so.

Mr. ROGERS. That you have filed with the clerk of the committee?

Mr. ASHTON. That is right.

Mr. ROGERS. And as a result they will be discussed by the various members who appear here, and pointed out from time to time by those representing the committee that has gone through all of this work?

Mr. ASHTON. Well, they can be discussed by me, for example, or someone else. They are of such a character that we have not been thinking of them as requiring much discussion, because they are pretty apparent on their face.

Mr. ROGERS. That is, they are clarifying amendments?

Mr. ASHTON. That is right.

I might add that we are continuing this policy which we have had throughout of transmitting all of the suggestions that come to us to your committee counsel. I should add in that connection that suggestions of improvement in language and some substantive suggestions that should not meet with any opposition at all have been proposed, and that material is being sent to your counsel for this committee as soon as it is received by us.

Mr. ROGERS. Do I understand also that your committee has received suggestions from others than the members of the Patent Law Associations concerning the provisions of this bill?

ITON. Yes, sir. I should say we have all of these industrial
as as well in our organizations, and, of course, they repre-
ry, as I have stated, and these associations, of course, around
y have received suggestions from a very large cross section
ntry.
the association worked was this: for example, in Chicago
ved suggestions from various people, and they took all of
her and considered them in their open meetings, and then
r report and sent their representatives to our committee.
r to inquire as to the scope of the study and the suggestions
e been made we have also to reach out to these associations
l all of these meetings, and all of the material, I repeat,
ome to us has been regularly supplied to your committee.
SON. Are there any further questions?
nsel has just handed me a letter from the Michigan Patent
intion, dated June 11, in which they state that the Michigan
w Association endorses and recommends the enactment of

THE MICHIGAN PATENT LAW ASSOCIATION,
Detroit, Mich., June 11, 1951.

R. ASHTON,
an of the Coordinating Committee On Revision and Amendment of
atent Laws,
e of The National Council of Patent Law Associations, Washington,
C.

ASHTON: The Board of managers of the Michigan Patent Law
having been duly empowered to act for the association in the matter
ion and amendment of the United States patent laws, have under
11, 1951 passed the following resolution:
there is now pending in Congress a bill to revise and codify the
H. R. 3760; and
this association's patent law revision committee has studied that
predecessor and has participated in the joint study thereof with
es of other patent law associations and trade associations con-
e Coordinating Committee on Revision and Amendment of the Patent

the membership of this association in open meeting have considered
sor bill H. R. 9133 of the Eighty-first Congress and have expressed
that bill: and
the patent law revision committee has reported that H. R. 3760 with
posed by the said coordinating committee is similar in principle
and is a desirable bill: Now, therefore, be it
That the Michigan Patent Law Association endorses and recom-
e Congress the passage of H. R. 3760 preferably with the clarifying
mmended by the coordinating committee on revision and amendment
t laws; that the chairman of the said coordinating committee be
o represent this association at the congressional hearings on the
t the secretary send copies of this resolution to Michigan Senators
ntatives, to the Subcommittee No. 3 of the House Judiciary Com-
the chairman of the coordinating committee."
ied that you will take the necessary action to see that this resolution
the attention of all interested parties. It would be appreciated if
be forwarded to the undersigned of any decisions, minutes of meet-
ony or hearing reports that may be subsequently published relative
sed congressional bill, H. R. 3760.
truly yours,

GEORGE W. TALBURTT,
Secretary-Treasurer.

TON. Yes, I just received a copy of it this morning, and I
n with those papers I handed up to the committee.

Mr. BRYSON. If there are no further questions, we will call Mr. Federico at this time.

Mr. FEDERICO. Yes, sir.

(The matter above referred to is as follows:)

CHANGES IN H. R. 3760 MADE AT THE COORDINATING COMMITTEE MEETING IN WASHINGTON, MAY 22, 1951

Chapter 1, section, 1 page 2: Line 10, strike out "clerks".

Chapter 2, section 100, page 8: Line 2, after "includes" insert ", but is not limited to,".

Line 3, after "includes" insert ", but is not limited to,".

Line 4, after "machine" insert a comma and after "matter" insert a comma.

Chapter 2, section 102, page 9: Line 1, strike out "A person shall be entitled to a patent unless—" and insert "An invention shall not be patentable if—".

Line 12, change "inventor" to "applicant".

Paragraph (g): The coordinating committee was not satisfied with either the language of the Bill or the suggested changes proposed at the meeting since none of them wholly took care of the situation. The matter was left to Mr. Federico to prepare a redraft. After consultation with others Mr. Federico recommends the following paragraph which is intended to codify the existing law:

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

Chapter 2, section 103, page 9: Line 1, strike out "obtained though" and insert "refused or declared invalid when".

Line 2, strike out "in the prior art" and insert "as".

Line 3, strike out "if" and insert "unless".

Line 4, change the first "that" to "the".

Chapter 2, section 112, page 10: Line 12, after "structure" insert ", material".

Line 14, after "thereof" cancel period and insert "or whether or not known at the time the invention was made."

Chapter 2, section 116, page 12: Line 2, after "intention" insert "on the part of the omitted inventor".

Chapter 2, section 118, page 12: Line 3, after "agreed" insert "in writing" and after "invention" strike out "in writing".

Chapter 2, section 121, page 13: Line 12, after "title" insert a comma.

Line 13, after "patent" insert "on the other application."

Chapter 2, section 135, page 15: Line 12, change "No" to "Any".

Line 13, after "may" insert "not".

Line 14, strike out "is made" and insert "has been made in such application prior to the issuance of said patent or".

Chapter 2, section 141, page 15: Line 9, change "files" to "file".

Chapter 2, section 146, page 16:

Line 4, change "Commission" to "Commissioner".

Chapter 3, section 201, page 18:

Line 1, after "patent" strike out "through error".

Line 4, after "patent" insert "through error and".

Chapter 3, section 202, page 19:

Line 15, change "if" to "unless".

Line 16, strike out "does not" and change "infringe" to "infringes".

Line 19, strike out "such thing" and insert "like things".

Chapter 3, section 203, page 20:

Line 2, insert a period after "invalid" and change "and" to "A".

Line 3, strike out "the" before "patentee".

Chapter 3, section 206, page 21:

Line 8, after "intention" insert "on the part of the omitted inventor".

Chapter 3, section 211, page 21:

Line 16, change "patents" to "patent".

ection 212, page 22:

entire paragraph and substitute the following:

never two or more persons own a patent jointly, either by the issuing atent to them jointly or by reason of the assignment of an undivided in the patent or by reason of succession in title to such interest, the joint owners, in the absence of any agreement to the contrary, entitled to make, use or sell the patented invention, or license others , or assign or encumber his interest without accounting to the other ners."

ection 281, page 23:

ter "liable" insert "for infringement".

ike out "a person" and insert "another".

ection 241, page 24:

ter "patent" insert "with the right to a trial by jury except in cases ognizable only in a court of equity."

ection 242, page 23:

hange "any claim" to "the claims" and after "thereof" insert "in

hange "of" after "validity" to "or".

ection 244, page 24:

ike out "the court" and insert "damages"; after "shall" insert "be" ; "award" to "awarded".

ike out "damages".

ection 251, page 25:

fter "patented" insert "or made by a patented process".

NT OF P. J. FEDERICO, EXAMINER IN CHIEF, UNITED STATES PATENT OFFICE, WASHINGTON, D. C.

SON. Mr. Federico, will you please identify yourself for

ERICO. Mr. Chairman and gentlemen of the committee, my J. Federico. I am an Examiner in Chief in the Patent I am appearing at the request of the chairman and with of the Commissioner to give an explanation of the back- he bill, and to supply any information relating to the patent he committee might ask for.

SON. You may be seated, Mr. Federico.

ERICO. Mr. Zinn, in his statement, referred to the Patent 0 with subsequent enactments adding to or changing various that original act. The first patent law was enacted in the sion of the First Congress in 1790. As a matter of fact, First Congress met one of its very first items of business nsideration of patents and copyrights, and the first patent R. 10 of the First Congress.

atent laws are enacted by Congress in accordance with the of the Constitution in article I, section 8, which provides

ess shall have power * * * to promote the progress of science arts, by securing for limited times to authors and inventors the ht to their respective writings and discoveries.

ovision was unanimously adopted by the Constitutional following suggestions for Federal jurisdiction over pat- er copyrights which had been made in the Convention by ison, of Virginia, and Charles Pinckney, of South Carolina.

Each of these gentlemen proposed separate provisions relating to patents and copyrights which were merged into the general statement we now have by the Drafting Committee of the Convention, and was then adopted without any dissenting voice.

The provision merits more study than has actually been given to it, particularly in the matter of the language used.

The background shows that it was a merging of two suggestions for patents and copyrights, the balanced construction and the usage current then and later indicates that it is really two provisions written into one sentence.

The first provision would be to promote the progress of science by securing for limited times to authors the exclusive right to their writings. The word "science" in this connection, has the meaning of knowledge in general, which is one of its meanings today.

The other provision would be that Congress has the power to promote the progress of useful arts by securing for limited times to inventors the exclusive right to their discoveries. The first patent law and all patent laws up to quite a good time later were entitled "Acts to promote the progress of useful arts."

The first law which was enacted, on April 10, 1790, vested the jurisdiction to issue patents in a Board consisting of the Secretary of State, the Attorney General, and the Secretary of War. The person principally interested and the leader of the group was the Secretary of State, Thomas Jefferson, who was greatly interested in the subject matter of patent law.

Mr. BRYSON. He was a patentee himself.

Mr. FEDERICO. He was not actually a patentee, but he was the inventor of a number of different devices, most of them being gadgets. Jefferson has been called a lover of gadgets, and I think there is even a poem about it.

Mr. BRYSON. He had a few good qualities too.

Mr. FEDERICO. The law made their power absolute and also provided for the various things that would be necessary in the patent law.

While the Board, and particularly Thomas Jefferson, was quite favorable to the granting of patents, and granted them with great consideration, the other duties of the members of this Board, in view of their high offices, made it impossible for them to devote too much time to this work, and as a result of suggestions the law was changed in 1793 to make the granting of patents a clerical function. Patents were granted to anyone who applied on fulfilling the formal requirements and filing the necessary papers and fees.

This law continued on the books until 1836 when the dissatisfaction with the free granting of patents without any examination as to novelty or other matters led to the appointment of a select committee by the Senate which introduced a bill that became the new law which was enacted on July 4, 1836.

This new law contains the fundamental principles of our present patent law. It created a Patent Office with a Commissioner of Patents at the head, and examiners with the function of examining applications for patents and the power to refuse patents, which was not present in the previous law.

Then, of course, the law had a great many other provisions in it relating to details of procedure, enforcement of patents, and matters of that sort.

nts were made to this act of 1836 at various times until
law was completely revised by the Commission and the
at Mr. Zinn has referred to.
nt bill in a sense, then, is the second combined revision
laws by the Committee on the Revision of the Laws and
e in charge of patents.
ribe the bill, endeavoring to give the over-all picture of
of the bill and its provisions.
the main thing in the bill is difficult to describe, because
ould have to be compared with the Revised Statutes of
language and arrangement, and the various acts passed
organization, language, arrangement, and matters of that
nake the present bill seem comparatively simple cannot
ed without comparison with the existing statutes.
ivides the sections into four chapters. The subject of
een divided into three main topics.
hapter contains the sections of the law relating to the
e generally, its powers and duties and some ancillary
at kind.
l chapter collects the sections relating to the conditions
a patent may be obtained and the procedure in obtaining

hapter has the sections relating to patents themselves and
n of rights under patents, and matters relating to that
subject.
erally, the three chapters relate to, first, the Patent Office;
ning a patent; and third, the patent itself. Of course,
en possible to maintain this three-part division strictly,
y be a slight amount of overlapping of the three phases
t.
n to the three chapters mentioned, a further chapter col-
relating to patents for plants and to patents for designs,
ated as supplementary topics.
ization of the bill and the arrangement of the sections
many new topics relating to the patent laws which have
ough the past, or which have not been considered at the
readily find their place in the organization.
try to give a bird's-eye view of the sections themselves.
s are divided into several groups of more or less homo-
ct matter with unnumbered subheadings.
bgroup in chapter 1 relates to the Patent Office and its
establishment of the Patent Office; the seal; officers and
strictions on officers and employees as to interest in pat-
the Commissioner; duties of the Commission; the Board
nd the Patent Office Library. Very little change is in-
hese sections; there is a change in section 3 relating to a
he Commissioner when the office is vacant, filling a gap
law.
change in section 4 on the ability of Patent Office em-
ain patents.
the sections in this chapter apply to the Patent Office as
lude trade-marks, as well as patents, when they go to
l and procedural matters.

Then there is this section on classification of patents, which is one of the functions of the Patent Office; supplying certified copies of records; the listing of publications put out by the Patent Office; the exchange of copies of patents with foreign countries; copies of patents for public libraries, and the annual report to Congress.

There is very little change in these sections other than language matters, and possibly other minor changes.

The next group of sections collect some of the details relating to procedure in the Patent Office which apply generally, and have little or no changes in them.

The next group, sections 31, 32, and 33, relate to practice before the Patent Office. In them the language has been rearranged and divided into several sections.

There has been no change of substance in these sections, except in the third of this group which is a criminal provision for unauthorized practice. The language has been considerably simplified, and the maximum fine has been raised from $100 to $1,000.

In the next group of sections, relating to Patent Office fees, there have been a few readjustments in some minor fees, and one change in the fee for an appeal to the Board of Appeals.

That concludes the description of chapter 1, which, in the main, represent purely formal changes, with only a few changes over the present law.

Chapter 2 relates to patentability of inventions and grant of patents, some of the sections of which might require a little more explanation.

Referring to section 101 first, this section specifies the type of material that can be the subject matter of a patent.

The present law states that any person who has invented any new and useful art, machine, manufacture, or composition of matter, or any new or useful improvement thereof may obtain a patent.

That language has been preserved except that the word "art" which appears in the present statute has been changed to the word "process."

"Art" in this place in the present statute has a different meaning than in the phrase "useful arts" in the Constitution, and a different meaning from that of the word "art" in other places in the statutes, and it is interpreted by the courts to be synonymous with "process" or "method". The word "process" has been used to avoid the necessity of explaining every time the word "art" as used in this place means "process or method," and it does not mean the same thing as the word "art" in other places.

The definition of "process" has been added in section 100 to make it clear that process or method is meant, and also to clarify the present law as to certain types of methods as to which some doubts have been expressed, although not very substantial doubts.

Section 101 says, "subject to the conditions and requirements of this title" after stating the subject matter that can be patented. The conditions under which a patent may be obtained must follow, and section 102 selects the conditions relating to novelty.

Now, under section 101 a person may have invented a machine or a manufacture, which may include anything under the sun that is made by man, but it may not necessarily be patentable unless the conditions are fulfilled.

Section 102 in paragraphs (a), (b), and (c) repeat the conditions in the present statutes relating to novelty; if the invention was known

, or described in any printed publication, et cetera, it
nted.
a) is the present language, although the interpretation
xcludes various kinds of private knowledge not known

(d) relates to a bar to patentability when the inventor
obtained a patent in a foreign country, which repro-
a liberalizing change, in the present law.
(e) is another condition that has been expressed in a
Supreme Court that is now expressed in the statute.
f) merely emphasizes that it is the inventor who ap-
tent, and it is probably unnecessary.
g) relates to the question of priority of invention be-
ors.
102 in general may be said to describe the statutory
invention, that it must be new in the manner described.
does something attempted for the first time in our
at is to write down a condition which exists in the law
for well over 100 years, but only by decisions of the

invention which has been made and which is new in
he same thing has not been made or described before.
necessarily be patentable if the difference between this
what was before known is not considered sufficiently
t a patent.
n expressed in a large variety of ways in decisions of
in writings.
s an attempt to state it in the statute. It refers to the
een the subject matter to be patented and the prior art,
was known before; if this difference is such that the
as a whole would have been obvious at the time to a
n the art, then this new thing cannot be patented.
ge paraphrases language which has been used quite
ns of the courts, and the section was added with the
aving it expressed would be a good thing to do rather
deductible from a large number of decisions of the
ection may introduce more definiteness and have some
ct, and may prevent great departures which have ap-
cases.
s merely a section of the present law which need not

up of sections relates to the application for a patent.
the requirements of the application where only a few
have been made.
and 118 introduce a new thing in our law. Our stat-
t in requiring that only the inventor may apply for a
two sections provide for certain types of situations
e impossible for the inventor to apply, or in the case
ention one of the joint inventors has been inadvert-
or excluded; the sections provide all of the safeguards
e inventor.
the first paragraph is the provision in the present law,
requirement in the second paragraph.

Sections 120 and 121 express in the statute certain things which exist in the law today that have not been written into the statute, and in so doing make some changes in the concepts involved.

Section 122 places into the statute the secrecy of patent applications, which has existed in the Patent Office ever since any of us remember.

The next group of sections relate to the examination in the Patent Office of the application; rejection by the examiner; the right to reconsideration; the time within which an applicant must reply to actions; time for prosecuting application; appeal to the Board and interferences between rival claimants for a patent.

Very little has been changed in this group of sections except a minor revision in the interference section.

The next group of sections relates to the review of Patent Office decisions.

The act of 1836 provided for the first time for the refusal of patents by officials known as examiners. The Senators working on the bill were quite jealous of the rights of the public and provided very ample means of reviewing the action of the Patent Office. In fact, there are two types of review. The applicant may appeal to a court of appeals especially provided, or he may file suit in the district court against the Commissioner to get his right adjudicated by the court.

This group of sections makes no fundamental change in the various appeals and other review of Patent Office action, but has made a few changes in the procedure in various instances to correct some of the problems which have appeared in the past and which have appeared in bills presented and considered by the committee, particularly in section 146. These details need not be described, except to state that they are mainly procedural.

The next group of sections relate to the issuance of a patent and the time and manner of issue.

Section 154 relates to the contents of the patent and the grant. The present statute corresponding to this section states that the patent grants the exclusive right to make, use, and vend the invention. That phrase has led to considerable difficulty in understanding because the statute does not grant the right to make, use, or sell, but only the exclusive part of it, and in numerous decisions, particularly decisions of the Supreme Court, it has been stated that all the patent does is grant the right to exclude others from making, using, or selling the invention, and the language used by the Supreme Court corresponding to what the old language means has been inserted in this particular section.

That finishes chapter 2. If the time is short I might stop and resume discussion of chapter 3 later if necessary.

Mr. BRYSON. That suggestion might be best, Mr. Federico, in view of the fact that you will be here right along, and we do have a number of out-of-town witnesses here today.

Mr. FEDERICO. Yes.

Mr. BRYSON. Your analysis of the bill up to now has been excellent, and we appreciate it.

Mr. ROGERS. I want to ask him some questions later on.

Mr. BRYSON. You will be available, will you, Mr. Federico?

...ve. Yes; I will be here right along, if any questions

...r. Thank you.

...iss.

...Yes, sir.

...OF PAUL A. ROSE, WASHINGTON, D. C., CHAIRMAN OF ... AND RULES COMMITTEE OF THE AMERICAN PATENT ...CIATION

...r. Mr. Rose, will you identify yourself for the record?

...My name is Paul A. Rose, of Washington, D. C. I am ...g as chairman of the laws and rules committee of the ...tent Law Association by authority of the board of ...the association to present to the committee the recom... ...f the association with respect to H. R. 3760.

...r. All right, sir, you may proceed. You may sit down ...

...Mr. Chairman, the American Patent Law Association ...R. 3760, Eighty-second Congress, and recommends its ... amended to include the proposals contained in the ...laws and rules committee, a copy of which is attached ...

...r. That is a printed copy?

...Yes, sir; of which I have supplied 25 copies for the ...ee.

...tion has followed with interest the proceedings which ...in the drafting and introduction of H. R. 3760, begin... committee print, mentioned by Mr. Zimi and Mr. Fed... by the Judiciary Committee in January 1950, and has ...epresented on the Coordinating Committee sponsored by ...Council of Patent Law Associations to assist and advise ...Committee in the task of codifying the patent laws.

...R. 3760 was introduced, the laws and rules committee ...an Patent Law Association immediately undertook to ...detail and, after having done so, rendered a report which ...d and approved by the board of managers of the associa... ...port was then submitted to the entire membership of the ...nd each member was given the opportunity to approve ...he laws and rules committee without modification or to ...f where and in what respects this report should be ...e membership of the association has now voted by ... to adopt the report of its laws and rules committee by ...ing majority of those voting.

...mbers in the United States qualified to vote 524 returned ...

...erpolate here, Mr. Chairman, to say that we consider ...od return on the basis of past referenda that we have ... conduct of the association.

...pi 520 approved adoption of the report of the laws and ...es, either without reservation or with definitely stated ...nd 4 disapproved the report in its entirety and hence ...roved the bill. Of the 520 approvals of the report, 388

were without reservation and 132 included statements disapproving or advocating modification of 1 or more of the recommendations contained in the report.

Those recommendations of the committee, as set forth in the committee report, which evoked the greatest comment from those who voted were with respect to the sections of the bill which are listed below. The vote upon the corresponding committee recommendations in each case is also given. It will be understood that reference to the committee report for a full and complete understanding of the nature of the vote received will be necessary.

In this table which we have included in our statement, we have eliminated single suggestions from various members, where only one suggestion or disapproval was received because that would make the table too long, but have selected those which are most numerous.

I would like to read this table because it shows how few people really are in disagreement with the general feeling in favor of the bill or with our recommendations with respect to it for amendment. They are very few.

On section 1 of the bill there were 512 votes favorable, and only 8 opposed. We had a very slight clerical change in that section, and the 8 opposition votes went to the 1-year limitation on the filing of applications by examiners after leaving the office. Those eight thought that 1 year was a little too harsh.

On section 102 (g) there were 507 votes favorable to the recommended revision; 7 were opposed, and 8 proposed other changes.

On section 103 there were 510 favorable votes, and 10 opposed, but clarified their opposition with suggestions for further amendment to the section to strengthen it, rather than being disapprovals of the principle.

On section 112 there were 510 favorable and 10 opposed, but with accompanying suggestions for amendment indicating approval in principle.

On section 119 there were 515 favorable and 5 opposed with accompanying suggestions for amendment.

On section 135, 512 were favorable, and 8 were opposed with accompanying suggestions for amendment.

On section 212, the committee recommended a substitute section for section 212, and that was approved by 505 votes in favor of it, and 15 opposed who wished to retain the section as is in the bill.

On section 231 there were 501 favorable, and 19 opposed to one or more subsections or proposed clarifying amendments.

We proposed an additional section to the bill calling for publication by the Commissioner at the request of applicants for patents which may or may not thereafter mature into patents.

On that proposed additional section 474 votes were in favor of its addition, and 46 were opposed to the addition.

No other section of the bill received more than four comments or suggestions for amendments. So, I think this table illustrates that the membership of the American Patent Law Association is overwhelmingly in favor of the bill with the amendments proposed by its laws and rules committee.

The specific suggestions and comments received from the members as a result of the referendum have been omitted from this statement,

made available to the committee or its counsel upon

n. We would like to have you submit them to our counsel
ices of Government do.

We have done that in the past in working with the co-
committee and we will make those available to the counsel.
ment submitted by Mr. Rose is as follows:)

T OF THE AMERICAN PATENT LAW ASSOCIATION ON H. R. 3760

an Patent Law Association endorses H. R. 3760, Eighty-second
recommends its passage when amended to include the proposals
he report of its laws and rules committee, a copy of which is at-

tion has followed with interest the proceedings which have re-
drafting and introduction of H. R. 3760, beginning with the com-
sent by the Judiciary Committee in January 1950, and has been
ented on the coordinating committee sponsored by the National
ent Law Associations to assist and advise the Judiciary Com-
sk of codifying the patent laws.

3760) was introduced, the laws and rules committee of the
ent Law Association immediately undertook to examine it in
or having done so, rendered a report which was considered and
e board of managers of the association. This report was then
he entire membership of the association, and each member was
rtunity to approve the report of the laws and rules committee
cation or to state in detail where and in what respects this re-
changed. The membership of the association has now voted by
to adopt the report of its laws and rules committee by an over-
rity of those voting.

mbers in the United States qualified to vote 521 returned signed
s group 520 approved adoption of the report of the laws and rules
her without reservation or with definitely stated reservations,
ved the report in its entirety and hence wholly disapproved the
0 approvals of the report, 388 were without reservation and 132
ents disapproving or advocating modification of one or more of
ations contained in the report.

mendations of the committee, as set forth in the committee report,
the greatest comment from those who voted were with respect
of the bill which are listed below. The vote upon the corre-
ittee recommendations in each case is also given. It will be
reference to the committee report for a full and complete under-
nature of the vote received will be necessary.

Vote on the committee's recommendation

3760):
312 favorable, 8 opposed.
g: 507 favorable, 7 opposed to proposed change, 8 proposals for
hange.
1: 510 favorable, 10 opposed, with accompanying suggestions for
ent.
2: 510 favorable, 10 opposed, with accompanying suggestions for
ent.
): 515 favorable, 5 opposed, with accompanying suggestions for
ent.
: 512 favorable, 8 opposed, with accompanying suggestions for
ent.
: 505 favorable, 13 opposed to proposed substitute section.
: 501 favorable, 19 opposed to one or more subsections or pro-
rifying amendments.
onal section (p. 12 of report): 474 favorable, 46 opposed.
tion received more than four comments or suggestions for

The specific suggestions and comments received from the members as a result of the referendum have been omitted from this statement, but will be made available to the committee or its counsel upon request.

Respectfully submitted.

AMERICAN PATENT LAW ASSOCIATION,
By PAUL A. ROSE,
Chairman, Committee on Laws and Rules.

REPORT OF THE LAWS AND RULES COMMITTEE OF THE AMERICAN PATENT LAW ASSOCIATION ON H. R. 3760, EIGHTY-SECOND CONGRESS

DULY ADOPTED AT A MEETING OF THE COMMITTEE ON MAY 11, 1951, ATTENDED ALSO BY THE BOARD OF MANAGERS, AMERICAN PATENT LAW ASSOCIATION, WHICH APPROVED THE REPORT

Pursuant to instructions from the board of managers, the laws and rules committee has considered H. R. 3760, Eighty-second Congress, a bill to revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents," and presents herewith its report and recommendations with respect thereto.

Your committee favors passage of the bill, amended as hereinafter noted, and recommends that the association adopt as the official position of the association that it favors passage of the bill as so amended, and that the appropriate committees of the Congress be informed of such official position.

At the outset, in order that the bill be viewed in proper perspective, a brief review of the evolution of the bill is appropriate.

In considering this bill it should be borne in mind that the primary objective from the standpoint of the House committee is to restate the patent laws, which have not been examined as a whole since 1870, to improve the language and arrangement and enact as law title 35 of the United States Code, while an additional objective is to make specific changes which may be considered desirable and substantially noncontroversial.

The bill is the culmination of more than 2 years of intensive study and effort on behalf of the subcommittee of the House Judiciary Committee charged with codification of the laws and also with patent and trade-mark matters, the committee staff, the coordinating committee sponsored by the National Council of Patent Law Associations (upon which were represented most of the patent law associations and groups throughout the country, and also a number of industrial and manufacturers' associations), and others interested in the patent law.

The bill had its genesis in a committee print issued by the Judiciary Committee of the House of Representatives January 10, 1950, entitled "Proposed revision and amendment of the patent laws." This committee print, which was issued solely for purpose of discussion and comment, received wide distribution. It included a number of controversial proposals and evoked a great deal of discussion and a very large number of suggestions for revision of the various proposals presented therein. At a meeting in Washington on February 8, 1950, of the National Council of Patent Law Associations, a coordinating committee was established for the purpose of giving direction and purpose to the effort to effect a workmanlike and sound revision of the law of patents. As indicated above, a number of industrial and manufacturers' associations accepted invitations to be represented on the coordinating committee, so that it had the benefit of the counsel of a very wide cross-section of the patent bar and American business, large and small.

At the first meeting of the coordinating committee, a drafting committee was appointed to prepare a redraft of the committee print to be based on the comments and suggestions received from the associations, their members and others. The drafting committee received a very large number of suggestions and from these prepared a redraft of the committee print which was submitted to a second meeting of the coordinating committee in Washington on May 9 and 10, 1950. This redraft received very careful consideration and section-by-section action and revision and the resulting redraft was submitted to the House committee. With this redraft as a basis, a bill was prepared by the House committee staff and was introduced into the House as H. R. 9133 of the Eighty-first Congress.

H. R. 9133 was given wide distribution to the patent bar and industry and in the light of further suggestions and comments received thereon the drafting committee prepared another redraft which was presented to a third meeting of

ng committee in Washington on December 6 and 7, 1950. Again
ed thorough consideration by the coordinating committee and a
proposed bill for presentation in the Eighty-second Congress was
drafting subcommittee presented this redraft to the House com-
was made the subject of a number of conferences between com-
and representatives of the major departments of Government. As
of this effort, the draft of the present bill was finally completed
in the House of Representatives on April 18, 1951 as H. R. 3760.
troversial proposals have been eliminated from this bill.
ve discussions it will be observed that the proposals contained in
have received careful consideration by a large cross section of the
and others interested in the patent system. It therefore is the
tation of those most closely associated with this important effort
vise the patent laws, that the bill will have the general and whole-
t of the patent bar and industry, with a minimum of revisions

as been a great deal of rewriting in the interest of clarification
ion of language, the bill in large measure represents codification

st of brevity this report can and will be confined to specific
those sections that embody some important change in, or addi-
law which should be brought to the attention of the membership.

CHAPTER 1

deals with the establishment and organization of the Patent
and conduct of attorneys and Patent Office fees.
isles for the continued issue of patents in the event of a vacancy
ommissioner, thus correcting a deficiency in the present law. In
mmended that "clerks," be canceled as superfluous and to agree
d employees" in section 4.
nds the restrictions of the filing of applications by former em-
Patent Office to a period of 1 year from the severance of their
tead of during their term of employment as now provided.
ins the authority of the Commissioner to utilize primary exam-
rd of Appeals for limited periods in order to keep the work of the

vides that when the last day for taking any action in the Patent
turday, as well as on Sunday or a holiday within the District of
ction may be taken on the next secular or business day. The
rday is in keeping with the close of the Patent Office on that

udes in the provision for reissue applications a fee of $1 for each
f 20 over and above the number of claims in the original patent.
e with the additional fee for excess claims in original applica-
ion also raises the appeal fee from $15 to $25.
e recommends approval of chapter I, subject to correction of

CHAPTER 2

deals with definitions, patentability, the application and its
ais and issue of the patent.
n the definition of "process", 100 b. positively recognized that
be patentable and represents a desirable clarification of the
ffice practice in this regard.
ragraph (d) makes a desirable change from existing law in
sue of a corresponding foreign patent before the issue of the
ent in those cases where the United States application is filed
ntion, but before issue of the foreign patent.
disapproves paragraph (g) because it may be interpreted to
t reduction to practice an anticipation of an issued patent, and
the following language be substituted in lieu thereof:

the applicant's invention thereof the invention was in fact
ther who in this country was using reasonable diligence in
practice or had reduced it to practice, provided such other
doned, suppressed or concealed the invention, and had exer-
e in putting it into use or in otherwise making knowledge
ble to the public."

Section 103 is a statutory declaration of the requisites for invention over prior art and is considered of importance in the statutory declaration of the requirement relative to the skill of the art at the time the invention was made, thereby accentuating that the invention must be viewed in the light of the state of the art as it existed at the time of the invention, rather than in retrospect after the disclosure thereof. The last sentence of this section is of particular importance as it will have a salutory influence by expressing congressional disapproval of the inclination of many courts since the Cuno case to judge an invention not upon its merits but upon collateral considerations such as the manner or route by which it was achieved.

Section 112 in the last paragraph recognizes the validity of combination claims wherein the novelty is expressed in functional terms and while offsetting the much criticized theory of the Halliburton case is advisedly drafted so as not to extend to the point of permitting the use of single means claims.

Section 115 provides for modification of the oath when made by other than the inventor, this being necessary in view of sections 116 and 118.

Section 116 liberalizes the treatment of applications of joint inventors by permitting the addition as well as the deletion of a nonjoined or misjoined inventor and represents a realistic treatment of the many problems arising in the handling of joint inventions.

Section 118 is a new provision providing for the filing by a person in interest when the inventor cannot be found or will not or cannot sign the application and the filing of an application is necessary to prevent loss of rights, such as the running of a public use or the like. The rights of the inventor are safeguarded by providing that the patent will issue to him so that the section will not invite indiscriminate filing by others than the inventor and the Commissioner of Patents will not be required to decide any questions as to the title or rights of an alleged assignee or other person in interest.

Section 119 contains a new provision in the requirement that the right of priority of a first filed foreign application may be obtained only if a certified copy of the foreign application is filed during the pendency of the United States application. This is in keeping with the requirements of most foreign patent laws and is of importance in providing a complete record in the Patent Office from which interested parties can determine the true date to which a patent is entitled without being put to the necessity of independently obtaining from a foreign country a copy of a claimed priority application which in many cases is found to be unavailable to him. In line 10 it is recommended that "such" be changed to "the first" to make it clear that the priority of only the first filed foreign application may be claimed.

Section 120 codifies the present practice relative to the right to the filing date of an earlier application for common subject matter in a continuation application.

Section 121 gives statutory expression to division practice and specifically forbids the use of either the original or the division as a reference against the other, dispenses with signing of a true division and provides that a patent will not be questioned for failure of the Commissioner to require division.

Section 135 provides for the automatic cancellation of the claims involved from a losing patent in an interference. The second paragraph is intended to express no change from the existing law.

Sections 145 and 146 change the time for filing a civil action (old R. S. 4915) to conform to the time for appeal to the CCPA.

Section 146 also enables a losing patentee in an interference to file a civil action, and eliminates the old troubles with respect to unrecorded assignees.

Section 154 provides for stating the patent grant in terms of the right to exclude and in this respect is more accurate and realistic in language than existing law.

Your committee recommends approval of chapter 2, subject to the suggested revision of section 102g and the correction of section 119.

CHAPTER 3

This chapter deals with amendment and reissue of patents, intervening rights, assignment, Government interests in patents, infringement and remedies for infringement.

Section 201 represents a liberalization of the reissue practice, providing specifically for broadened reissues and in view thereof places a definite limit of 2 years on the time within which application may be made for a broadened reissue.

the second and third paragraphs would enact into the law a
tervening rights arising before grant of the reissue, and the
reof, and includes protection of the investments of those who
antial preparation for manufacture which would not infringe
original patent which is also included in the reissue. This last
it possible to determine the question of intervening rights by
reissue alone as no claim of the original patent not included in
be considered.

nitiates disclaiming of part of a claim and omits the penalty of
whole patent for delay in disclaiming and in the second para-
a new thought in providing for a disclaimer of the entire or any
the term of a patent. This last provision should be of value in
ions of double patenting.

vides for correction of applicant's mistake and fills a long-felt
et. A fee of $10 is provided for a certificate of correction in

ovides for deletion or addition of a misjoined or nonjoined
ase of an issued patent and provides that a patent cannot be
inadvertent misjoinder or nonjoinder. These are salutory
law since there is no valid reason why a patent should not be
e as an application in this regard.

cludes a specific declaration that patents are personal props.
mended that "applications for patent" be inserted after "pat-
the first paragraph. In the third paragraph, last line "patents"
r.

new provision in providing that joint owners either must join
or license or account to each other in the absence of an agree-
rary. The committee disapproves this section because it is
attempt to restrict the rights of joint owners in that manner
difficulties and evils than arise under existing law, and recom-
following language of section 212 of H. R. 9133, Eighty-first
ituted:

two or more persons own a patent jointly, either by the issuing
to them jointly or by reason of the assignment of an undivided
e patent or by reason of succession in title to such interest,
oint owners, in the absence of any agreement to the contrary,
led to make, use or sell the patented invention, or license
ers or assign or encumber his interest without accounting to
t owners."

ates to infringement and contributory infringement. Para-
one who actively induces infringement liable as an infringer.
ines contributory infringement and returns this doctrine to
the patent law, while safeguarding the right to make and vend
and articles of commerce in the normal course of business.
ognizes legitimate exercises of the patent right which have
lled or condemned in recent decisions and it is hoped that a
aration in this respect will restore this doctrine to its proper

cts into law treaty provisions governing the freedom from
nt of the use of inventions in ships and vehicles engaged in
.

he first paragraph includes a positive declaration of the pre-
ity and places the burden of proving invalidity on the party
iew of the growing tendency in the recent past for courts to
le more than lip service to the doctrine of presumption of
ed that this positive declaration by the Congress will be of
gthening the patent system. The third paragraph extends the
irement to references to be relied upon in district courts as
of the art and is calculated to correct an abuse, which has
of the right to introduce without notice surprise references
"showing the state of the art." Provision is made for the
ers within the discretion of the court even in the absence of
.

aragraph, subparagraph (2), line 1. It is recommended that
" be changed to read "the claims thereof in suit" as invalidity
uit should not be a defense. In the third paragraph, line 1,
."

Section 246 clarifies the application of the statute of limitations in the case of counterclaims.

Section 247 clarifies the dates from which recovery may be had in cases where notice is and is not given by marking and in the last sentence realistically makes filing of an action notice of infringement.

Section 248 is companion to section 201 and eliminates any necessity to disclaim invalid claims to save the remainder of the patent.

Section 251 provides a maximum penalty of $500 for false or fraudulent marking and extends the same to improper marking "patent pending" or "patent applied for."

Section 252 provides for designation by patentees resident outside the United States of a domestic representative for the acceptance of service, as in trade-mark cases, and for service by publication in the absence of such designation.

Your committee recommends approval of chapter 3, subject to the suggested revision of sections 211, 212, and 242.

CHAPTER 4

This chapter deals with patents for plants and designs and is merely a re-enactment of existing law in this regard, this bill not purporting to make any revision with respect to these subjects, except section 305 which clarifies and extends infringement of plant patents to include selling.

Your committee recommends approval of chapter 4.

The bill includes four terminal sections, numbered 2, 3, 4, and 5, of formal character which appear on page 28 and which relate to amendments of existing statutes, applicability and savings provisions and repeal of existing statutes.

Your committee recommends approval of sections 2, 3, 4, and 5.

There appears to be a possible duplication of numbering between sections 102-114 and unrepealed sections of present title 35 of the code, but it is assumed that this conflict will be corrected.

PROPOSED ADDITIONAL SECTION

It is believed by your committee that one of the original proposals which received widespread support and was included in the first redrafts and in H. R. 9133, but which was eliminated from the redrafts at the coordinating committee meeting in December 1950, by a close vote, should be added to the bill by way of amendment. This is the section authorizing the publication of applications at applicants' request and expense. In H. R. 9133, the section was the second paragraph of section 121 and read as follows:

> "Pending applications for patents may be printed and published by the Commissioner, at the request and at the expense of the applicant or owner. Such publication shall have the same effect as an issued patent for the purposes of section 102 (e) of this title."

This proposal would extend the present practice of printing abstracts but goes further in recognizing the right to carry the date back to the filing date for purposes of anticipation. If this proposal were adopted the application would be printed in full and classified for search purposes.

Your committee recommends approval of this proposal and that it be added to the pending bill.

Respectfully submitted.

Committee on Laws and Rules, Paul A. Rose, Chairman, James E. Archer, George C. Arvedson, Stephen Czerstvik, Maurice A. Crews, Laurence B. Dodds, Elwood Hansmann, Ford W. Harris, C. Willard Hayes, Joseph G. Jackson, Harry W. Lindsey, Jr., Alexander C. Neave, N. Douglas Parker, Jr., Rowland V. Patrick, Andrew H. Schmeltz, Samuel R. Smith, Richard K. Stevens, Richard Whiting, J. Russell Wilson.

Mr. BRYSON. Are there any questions?

Mr. ROGERS. Do I understand that these recommended changes are the same as those referred to here by Mr. Ashton and the previous witness?

Mr. ROSE. Mr. Rogers, some of them are, and some of them are not. There is no great variance between them. The coordinating committee made more suggestions for change than we did.

respect, in our proposed substitute for section 212, dealing
unting by joint inventors to one another in the licensing or
patent, the recommendations in the American Patent Law
on report are identical with those of the coordinating com-
The only other matter of real substance or change where
ted an amendment, as I recall now, was in section 102 (g).
stions of the coordinating committee and of our committee
ngthage, but they are aimed at the same result. So that I
could say that we are in substantial agreement as to the
of our recommendations with the coordinating committee.
in acting on the bill the laws and rules committee of the
Patent Law Association and its board of managers, and
embership voting on it, was not bound by the action of the
ng committee. In fact, our action was taken prior to the
ng committee meeting, so that we did not have at that time
nefit of all of the discussion which went on at that time.
ers. What I was getting at is this: As I understand it, you
he American Patent Law Association as a group, and their
lations are set forth in your statement here. Did not your
constitute a part of the coordinating committee?
. Yes, sir.
ers. And you are in substantial agreement with them, but
fact that you adopted this before the coordinating com-
made its final report you were not able to get together on
Was there any substantial difference between your com-
the coordinating committee?
e. The only substantial difference between our committee
the coordinating committee's recommendations is that we
mended the addition of the publication section. The co-
committee thoroughly considered that question and voted
addition of such a section. On that proposal our mem-
as the table there will show, 474 in favor of the addition
cation section and 46 opposed.
ON. So more of your own members voted against that pro-
oted against any of the others?
Yes; more voted against it than against any of the oth-
46 votes opposed to the additional section was twice as
as there were against any other proposal or section in the

dd here for the benefit of the committee that the Ameri-
Law Association is a thoroughly national group in that
members who are spread all over the country and cover
he States of the Union as well as the District of Columbia
e members of the various committees of the association
not only from Washington, where I happen to be from,
nbership includes, or my particular committee includes,
m various sections of the country, including Los Angeles,
Chicago, and so forth.
s. Is this association a part of the American Bar Asso-
that a separate group?
It is not a part of the American Bar Association, but
l with the American Bar Association, as I understand it.

Mr. ROGERS. The American Bar Association does have a patent section?

Mr. ROSE. Yes, sir.

Mr. ROGERS. As do most States?

Mr. ROSE. Yes, sir.

Mr. ROGERS. Many of the members in your association may be in the other associations; that is, individual members may be members of the State patent section of the American Bar Association and your association?

Mr. ROSE. As a matter of fact, Mr. Rogers, I think over half of our members are members of the American Bar Association—that is, the patent section—and the reverse is also true, that a great number of the members of the various patent law associations throughout the country, local groups, and State groups are also members of the association.

Mr. ROGERS. Thank you.

Mr. BRYSON. All right; thank you very much, sir.

STATEMENT OF GEORGE E. FOLK, ADVISER TO THE COMMITTEE ON PATENTS OF THE NATIONAL ASSOCIATION OF MANUFACTURERS

Mr. BRYSON. Now, we have Mr. George E. Folk as the next witness. I believe Mr. Folk has lately had an operation on his eyes, and he has asked that someone read his statement for him.

Mr. FOLK. Yes, sir.

Mr. BRYSON. Mr. Folk, will you identify yourself for the record?

Mr. FOLK. Mr. Chairman and members of the committee, the information you ask for is contained in the first paragraph of the statement which I filed and will be read to you by Mr. Fred Foulk, so that you will get the information.

Mr. BRYSON. All right.

Mr. FOULK (reading):

Mr. Chairman and members of the committee, my name is George E. Folk. I am adviser to the committee on patents of the National Association of Manufacturers, and I am speaking today for that association, a voluntary organization of more than 16,000 manufacturers, 83 percent of whose members have less than 500 employees each.

The NAM favors this bill, although it has several recommendations, mostly of minor importance, which it would like to see incorporated in the bill.

The committee on patents of the National Association of Manufacturers consists of approximately 150 members representing all classes of industry; the large size, the medium size, and the small companies. I am submitting herewith a list of the membership of the committee which states the names of the members and the companies they represent.

To my own knowledge the National Association of Manufacturers for many years has given continued and intensive study to our patent system with the view of improving it wherever possible. It has recognized the importance of inventions and patents in our economy. In 1938, at the time the Temporary National Economic Committee began its investigations, I was retained by the NAM as a consultant with respect to the investigations of the TNEC relating to patents. When the final report of the TNEC was submitted, I was requested to make an analysis and evaluation of the record insofar as it pertained to patents. This report was published in book form in 1942 under the title of "Patents and Industrial Progress" and was given wide distribution.

I continued my relationship as consultant to the NAM committee on patents, and that relationship still exists.

In 1942 our committee on patents undertook to make a survey and suggest constructive reforms that should be inaugurated in the patent system. In other words, the committee desired to take an affirmative stand which would reflect

…to advance proposals for corrective legislation on patents. With …letter was sent to all of the members of the association's committ… for suggestions with respect to improving the patent system and the …ions on any other items that should be given consideration." The …gratifying, and some fifty odd suggestions were submitted for …

…tions covered every phase of our patent system. As a result th… …made by our committee for improving the patent system and the …approved by the NAM board of directors. This report was given …nd was distributed to the members of the association in April 1943. …study of the patent system by our committee fully prepared it to …the National Patent Planning Commission, which was at the …studying the subject. This National Patent Planning Commis… …nted by President Roosevelt. It consisted of five eminent men …search, industry, labor, agriculture, and the general public. We …lanning Commission and were in a position to answer its inquiries …ses of the system and also at the request of the Commission sub… …report on some nine items in which the Commission manifested …

…e continued during the subsequent years its consideration of …ms, especially the reports of the Government appointed agencies …e Studies and recommendations on the subject. These agencies …

…iency Advisory Board, which had made a report in 1935. (This …made an exhibit at the hearings of the TNEC.) …mporary National Economic Committee. …ational Patent Planning Commission.

…ndations made by these agencies were classified by our com… …sting of (a) desirable legislation; (b) legislation which was …disadvantageous, depending on the form in which it was ena… …undesirable legislation. The report of our committee on this …ublished and distributed to the entire membership of the asso… …1944.

…April 20, 1945, President Truman requested Secretary of Com… …to undertake a study of the operation and effectiveness of the …l to submit recommendations respecting legislative proposals. …appointed by Secretary Wallace submitted for consideration an …ng several hundred questions bearing on the patent system. …careful consideration by our committee and a reply thereto was …retary Wallace's committee on December 21, 1945, in pamphlet …omments on the Agenda of the Secretary of Commerce's Patent …ee."

…e continued its interest and study of proposals for revision of …m and under date of June 18, 1946, made a review which was …hlet form entitled "A Review of Proposals for Revision of the …atent System." This pamphlet and the afore mentioned one re… …ribution.

…intensive study of the patent system and anticipating possible …te codification and revision of the patent system, our committee …and submitted to the NAM board of directors a comprehensive …Recommendations on Proposals for Statutory Revision of the …This report was approved by the board of directors of the …

…duction of the Wiley bill, S. 2548 of the Eighty first Congress, …ppointed a special subcommittee to consider this bill and its …were given serious and extensive consideration.

…e at various times considered and passed upon a large number …rtaining to patents and research. As an example of the more …we called attention to the National Science Foundation bill, …w into law; the atomic energy bill, which was also enacted into …r defining damages and profits in infringement suits, which was …into law.

…h, 1950, Representative Joseph R. Bryson, chairman of Sub… …of the House Judiciary Committee, submitted a committee print …e Committee on the Judiciary of the House of Representatives, …of the committee print; Mr. Bryson stated:

…ented is intended primarily to serve as a basis for the expres… …Criticisms and suggestions for improvement of anything con…

…tained in this draft, and suggestions of additional proposals for consideration, as well as support for anything contained in the draft, are especially invited. All comments received before May 1, 1950, will be carefully considered for the preparation of a bill to be introduced on the subject."

Upon the submission of this committee print, our committee on patents appointed a special subcommittee to consider it, since its importance was fully appreciated. This subcommittee consisted of some 25 members and was divided into 5 groups. To each group were assigned those specific portions of the print in which the members of that group were particularly interested and upon which they were well informed. These groups made their report to the full subcommittee, which in turn made its report to the full committee on patents.

The committee print embodied practically every suggestion for the revision of the patent laws that had been made during the previous 20 years. Practically all of these suggestions had previously been given consideration by our committee on patents. Thus we were prepared to submit constructive suggestions with respect to the committee print, as had been requested.

The committee on patents of the National Association of Manufacturers was invited to send a representative to the coordinating committee which was formed by various patent bar associations throughout the country and some of the leading trade associations. We accepted the invitation but reserved the right of independent action, and it is in line with such reservation that we submit this statement.

In July 1950 Mr. Bryson introduced into the House a bill for codification and revision of the patent laws; H. R. 9133 of the Eighty first Congress. Our special subcommittee appointed to consider the committee print also considered this bill and reported it to our full committee. After this report a questionnaire was sent to all the members of our committee on patents asking them to express any views that they might have on the bill.

It is unnecessary now to point out the exhaustive study of the bill made by the above mentioned coordinating committee, inasmuch as that committee has already summarized its own activities.

No action was taken by Mr. Bryson's committee in the House of Representatives on H. R. 9133, but on April 18, 1951, a somewhat modified bill, H. R. 3760, was introduced by Mr. Bryson. The subcommittee appointed by our committee first studied the new bill, then later, in a 2 day session, May 15 and 16, our full committee gave a detailed consideration to the bill section by section. As a result of this intensive study certain changes in the bill were recommended by our full committee.

Subsequent to this meeting we attended a meeting of the above mentioned coordinating committee. Some of our recommended changes were, in substance, approved by that committee, and we earnestly hope that they will be deemed acceptable to your committee.

H. R. 3760 contains numerous sections which consist merely of a codification and clarification of existing law without any substantive changes. The bill also contains sections which delete from present law certain obsolete provisions which obviously should not be carried over. Both such sections of the bill meet with our full approval. There remain certain other sections which we feel can be improved and we herewith submit such proposed changes for your consideration.

H. R. 3760

Section 100. Definitions: It is proposed that paragraph (b) be changed to read:

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

Section 101. Inventions patentable: It is proposed to substitute the word "art" for the word "process" in this section and throughout the bill wherever appropriate.

The term "art" is broader than the term "process," and no good reason is seen for the limitation contained in the bill.

Section 102. Conditions for patentability; novelty and loss of right to patent: While this section was approved, it was felt that the language of paragraph (g) thereof might be better. The substitute language proposed by the coordinating committee seems to effectuate this. That language reads:

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

dates of conception and reduction to practice of the invention, but reasonable diligence of one who was first to conceive and last to practice, from a time prior to conception by the other."

Disclaimer: As an improvement in language it is recommended that of the second line of period be inserted after the word "invalid" words "and the" be changed to "A."

Ownership; assignment: Our committee proposed for the fourth this section the corresponding paragraph of the committee print as follows:

signment, grant, or conveyance shall be void as against any subse- chaser or mortgagee for a valuable consideration, without notice, rchase or mortgage is recorded in the Patent Office within three om its date, or prior to the recordation in the Patent Office of the mentioned assignment, grant, or conveyance, unless the said first- assignment, grant, or conveyance is recorded in the Patent Office ee months from its date, or prior to such subsequent purchase or

ne] change would protect the right of the original assignee even not record within 3 months provided that the subsequent assignee ded in the Patent Office within 3 months or prior to the recordation Office of the first-mentioned assignee.

Joint owners: This section makes a substantial change in the with respect to the right of joint owners. Our committee dis- nch changes and desired that the section be amended to set forth law. The coordinating committee took the same position and a change which in substance is the same as that recommended by

Damages: While this section was approved by our committee it on that an endeavor should be made to clarify the section with nages. This can be done by the slight changes recommended by g committee, which are as follows: Line 1, strike out "the Court"; damages"; after "shall" insert "be" and change "award" to line 2, strike out "damages":

Interfering patents: Our committee suggested the amendment of in accordance with the language of the existing R. S. 4918. The mended would read as follows:

erson interested in any one of the interfering patents or in the f the invention claimed under either of them, may have relief owner of another by civil action, and the court may adjudge the f the validity of any of the interfering patents, in whole or in provisions of the second paragraph of section 146 of this title to actions brought under this section."

I would like to state that at that meeting in May, a month mittee passed a resolution unanimously instructing me changes we have suggested, but not to insist on them if ce would jeopardize the passage of the bill. In other consider the bill as a whole a desirable one.

N. Yes.

There is only one change I would like to especially call on to, and that is in sections 100 and 101, changing the "process." I think if that is changed in the patent law live to regret it. In the first place "art" and "process" nymous, and especially with the definition which follows hood of getting a false impression of what a new process. I hope it will be given serious consideration, but as I said ant to jeopardize the passage of this bill.

s. I think the words "useful process" and "art" are not in any particular and have two distinct meanings.

Yes, some of the courts have held quite properly, as Mr. ated out, that "process" has been held by the court to he term "art," in new machine and composition of matter.

That is true, but there are arts which are not processes, and I am afraid that there may be something cut out of the present statute, especially when it comes to the question of what new use consists of. You will find that definition includes new use, process, machine manufacture, or composition of matter. Now, composition of matter under new use is not a process necessarily. The new use of a machine may not be a process. It is simply a new use, and if it is not obvious to one skilled in the art, and otherwise complies with the requirements of the title, there is no reason why it should be limited in the way I think the definition does limit it.

Mr. ROGERS. Are you satisfied with the definition as set forth in section 231 dealing with infringement of patents as recodified there?

Mr. FOLK. That is all right.

Mr. BRYSON. I notice you did not make any recommendation for any changes on that.

Mr. FOLK. Yes.

Mr. ROGERS. Have you compared your recommendation with that of the coordinating committee?

Mr. FOLK. Yes. I attended all of the sessions of the coordinating committee and am perfectly familiar with them. In general we agree, although there are a few exceptions. Most of them are of minor importance, just a question of choice of language largely. Of course, we are going to live with this statute for many years, or others are. I think this is my last appearance before any committee of Congress.

Mr. BRYSON. We hope not, Mr. Folk. How long have you been a student of patent law, Mr. Folk?

Mr. FOLK. I will say that in 1898 I went into the Patent Office as an examiner. I examined patent applications for a couple of years. I was then promoted to the Interference Division, and for the next 5 years I wrote opinions on priority questions that came up in interferences, which were then appealable to the court of appeals in the District.

Then I engaged in the independent practice of law in Chicago for 10 years. At the end of 10 years I was asked by the American Telephone & Telegraph Co. to take charge of some of the litigation they had pending with regard to electronics. I saw that there was so much to be done that I entered into their employment in June of 1915, and continued with them until April 1937, when I reached retiring age.

I then took up this work with the National Association of Manufacturers. They asked me to do so, and I agreed to do so for 3 months, thinking that the hearings of the Temporary National Economic Committee would be concluded at the end of 3 months. I am still with the NAM after 13 years.

Mr. BRYSON. So that you have been actively engaged in patent work for more than 50 years.

Mr. FOLK. Yes, more than 50 years—53 years to be exact.

Mr. BRYSON. Longer than many members here have been living.

I would like to have the record show that I was delighted to find in talking to Mr. Folk that he is a native of our State.

We are very glad to have you here, Mr. Folk.

Mr. ROGERS. You do feel that the definition as given in this section 231 is sufficient protection to the manufacturers on infringement as defined in this bill?

There was no particular objection to that from our com-
hink that is all right.
Mr. Chairman, unless counsel of the committee already
lo here I would like to get more examples of how this
guage from "art" to "useful process" affects the situation.
merely commented on it very briefly. I should be glad
additional memorandum on the subject if you wish.
Personally I would like to have it.
would be very glad to do it.
Yes, if you will, supplement your statement on that.
know that industry as a whole is opposed to the change.
why the bar association is not. I am a member of the
ent Law Association and the American Bar Association.
If you will supply us with a memorandum on that we
it very much. Thank you.
Thank you for your courtesy.
randum requested is as follows:)

STATEMENT RE SECTIONS 100 AND 101 OF H. R. 3760 SUBMITTED BY
S, ADVISER TO THE COMMITTEE ON PATENTS OF THE NATIONAL
MANUFACTURERS

record with the objectives sought to be accomplished by the
ons 100 and 101 of H. R. 3760. That is, that it should be made
ses may be patentable as such, and that a new use of an old
so be patentable. This is in accordance with decisions of the
We feel, however, that the language of these two sections, in-
g the subject beclouds it, and may lead to the necessity of the
ving interpretations to the changed language.
tutes, Revised Statutes 4886 (35 U. S. C. 31), state that: "Any
nvented or discovered any new and useful art, machine, manu-
osition of matter or any new and useful improvement thereof
n complying with certain requirements of law obtain a patent
101 substitutes the word "art" for the word "process," so that
: "Whoever invents or discovers any new and useful process,
ture or composition of matter, or any new and useful improve-
y obtain a patent therefor, subject to the conditions and re-
s title."
lines the new term "process" as follows: "The term 'process'
and a new use of a known process, machine, manufacture,
atter or material." It is to be feared that this definition of
nding a new use, may possibly lead to a construction whereby
annot be classified as either a process, machine, manufacture,
atter or material, it is not within the class of patentable sub-
a possible construction would not apply if the term "art" is
he term "art" has a much broader significance than has the

of the term "process" for "art" did not occur in the commit-
it occur in any of the preliminary redrafts sponsored by the
mittee. Nor did it occur in H. R. 9133. It makes its belated
R. 3760.
hat the term "art" was originally intended as a catch-all to
ible subject matter what could not be definitely included under
manufacture, or composition of matter, but which was still
ortunate that this term "art" gave the court an opportunity,
that processes came within the scope of the term "art," and
f certain old inventions likewise came within the scope of the

terpretation of the word "art" is found in an able and well-
Robinson on Patents (sec. 164).
of 1793, section 1, provides for patents by any persons who
discovered any useful art, manufacture, engine, machine, or
rovement therein * * *." This act was in effect until the

act of 1836 which provided, in section 6, for applications for patent by persons "having discovered or invented any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter. * * *."

The act of 1870 substituted language which is now found in Section 4886 of the Revised Statutes above referred to, retaining, however, the term "art."

Thus, in all previous patent acts the term "art" is found as one of the classes of patentable subject matter. The courts have construed the term as covering a process, and even that the new use of a machine may involve a process.

It is hardly necessary to review the leading decisions of the Supreme Court on the subject of what is included in the term "art." We should not, however, lose any advantage from the often reiterated statements by the Court on this subject. This advantage may be lost if the statute drops the word "art" and substitutes therefor a new term "process," with a new definition thereof.

It would seem preferable if in section 101 of H. R. 3760, in the first line thereof, the familiar term "art" be substituted for the new term "process." The section would then read: "Whoever invents or discovers any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereof may obtain a patent therefor, subject to the conditions and requirements of this title."

Then, to clarify the statutes to comply with holdings of the Supreme Court, or what is not inconsistent with such holdings, it is suggested that the term "art" be defined in section 100 so that paragraph (b) thereof be changed to read substantially as follows: "The term 'art' includes a method or process and a new use of a known process, machine, manufacture, or composition of matter."

We feel that this subject is of sufficient importance to warrant a careful scrutiny before making the changes indicated in sections 100 and 101.

STATEMENT OF JENNINGS BAILEY, JR., CHAIRMAN OF SECTION OF PATENT, TRADE-MARK, AND COPYRIGHT LAW, AMERICAN BAR ASSOCIATION

Mr. BRYSON. Mr. Jennings Bailey, Jr., chairman of the section of patent, trade-mark, and copyright law, American Bar Association.

Mr. BAILEY. Yes, sir.

Mr. BRYSON. Please identify yourself for the record.

Mr. BAILEY. Jennings Bailey, Jr., Washington, D. C.—I am chairman of the section of patent, trade-mark, and copyright law of the American Bar Association.

Mr. BRYSON. You may be seated, if you like.

Mr. BAILEY. Mr. Chairman, the American Bar Association is composed of a number of sections in addition to the association as a whole.

The various sections, however, are no more qualified to speak for the whole association than this committee is qualified to speak for the whole Congress. Nothing is final action of the association until it is approved by the house of delegates of the association. That house of delegates meets twice a year, and as a result we have to have a section meeting, and then we have to get approval by the house of delegates, and the work of the association in some ways is rather slow in getting complete approval.

We had a special meeting of the section of patent, trade-mark, and copyright law in Washington not long ago, at which this matter was thoroughly discussed for 3 days, and, as Mr. Ashton said, many prominent patent attorneys were present at that meeting.

I cannot express to this committee the position taken by the section at that meeting because there has been no opportunity to present that action to the house of delegates, and I am only authorized to speak as to such matters as have been approved by the house of delegates. However, there have been a number of past actions of the

pproving in principle a number of changes in substance
bill. As to the other changes that are made in the bill,
ow, as to substantial changes there has been no oppo
American Bar Association, and the bulk of the bill
ents codification in language of the present law. If the
e do not bother the association asking them to approve
no trouble about most of this bill. We have gone along
coordinating committee made a number of suggestions
n language which clarified the meaning of various sec
rably, and a considerable number of those changes, in
them, have been adopted and appear in the present
ill.

n also go so far as to say that at the patent section meet
there was no enormous opposition to the principle of
this bill, although there was naturally some opposi
li discussion as to language.

tent section of the American Bar Association would not
a perfect bill, because there are a number of changes
een advocated in the past by the association, and which
ie committee at some later date to have included in the

some of them are unquestionably quite controversial.
whole, is certainly a step in the right direction, and
hat half a loaf is better than none. I think we can say
t most parts of it, at least, have been endorsed by the
r Association or merely represent the present law.

e briefly to refer to a few specific changes in the law
ciation has approved. First, section 3 of the bill, the
wing an Assistant Commissioner to act in the absence
ssioner, or in the case of disability.

allowing a single signature to patent applications in
old practice under which we had to have applications
e different places.

3 and 206 insofar as they contain the principle by which
ho has been improperly included in the application with
t intent may be eliminated without invalidating the
the issued patent.

; the second paragraph which requires an applicant
fits under the international convention to file a certified
reign application in the Patent Office.

and the reissue section insofar as allowing the divisional
lications to be signed by the assignee but not requiring
by the inventor himself.

which allows a patentee who has lost in the Patent
some choice of remedies on appeal, namely, that he can
he Court of Customs and Patent Appeals or to the dis
nd the same section which allows a proceeding in the dis
be brought against the record owners in the Patent

defining the intervening right in the event of the reissue.
nd section 203 insofar as it revokes a present rule that if
valid the whole patent is invalid, or requiring the appli
disclaimer.

Mr. Chairman, those are the substantial changes which the patent section of the bar association has approved.

As to specific changes in language which have been suggested to the coordinating committee, and most of them have been adopted, I would not want to burden the record with them here.

Mr. BRYSON. Did your section sit in with the coordinating committee?

Mr. BAILEY. Yes; we had one or two representatives at every meeting of the coordinating committee, and they gave careful consideration to everything we had to say.

Mr. ROGERS. Mr. Chairman.

Mr. BRYSON. Mr. Rogers.

Mr. ROGERS. Do I understand the things you have outlined have been approved by your committee and were also approved by the house of delegates of the bar association?

Mr. BAILEY. Everything I stated has been approved either by the house of delegates or in an earlier procedure by some other body of the American Bar Association.

Mr. BRYSON. Thank you very much.

STATEMENT OF CECIL C. KENT, FETHERSTONHAUGH & KENT, WINNIPEG, CANADA

Mr. BRYSON. We have a distinguished visitor here from Canada, Mr. Cecil Kent. Mr. Kent, will you come around and will you identify yourself for the record?

Mr. KENT. Yes. My name is Cecil Kent, Winnipeg, Canada, and I would like the opportunity of speaking to Mr. Bryson's bill on my own behalf as a patent attorney and as a reader and student of the philosophy of patent law.

Mr. BRYSON. Do you have a prepared statement?

Mr. KENT. Yes, I have, Mr. Bryson.

Mr. Chairman and gentlemen, I greatly appreciate this opportunity to testify on behalf of Mr. Bryson's bill H. R. 3760. As a Canadian patent attorney registered to practice before your Patent Office, I represent a number of Canadian manufacturers and private inventors who have applications pending in this country. That is because our economy is very closely related to yours. And our Canadian patent law is also very similar in a general way.

Now, this bill is significant in that if it becomes statute law in anything like its present form, I understand it will represent the first major revision in the United States patent laws in nearly 80 years. And if it becomes statute law it will, in my opinion, provide a vitally needed stimulus to free creative enterprise. Society and its technology has gone through profound changes in the last 80 years, profounder possibly than in the preceding 350 or more years. It has been a period of great industrial expansion and your Patent Act, to a useful extent has, I believe, assisted that expansion. The last 20 years, however, have seen a very pronounced modification of the previous expansion—a modification that is in favor of increasing security and protection for the individual in society, but of course at the cost of increasing taxation and governmental control. It is not my intention to criticize this trend, but simply to suggest that it tends to stifle creative or inventive ingenuity, for it is necessity which is the mother

n, and any measure which can be enacted which will offset
caused by too much protection and by too much time spent
out forms, and so forth, should be encouraged. When
rogress is arrested for any reason it is seldom merely
is more often in some way or other thrown into reverse
ing processes, including human society, never stand still,
lvances or declines in terms of the over-all pattern accord-
we have been able to observe scientifically and historically.
two important respects, Mr. Bryson's bill, in my opinion,
way toward a more mature and scientific way of thinking
nts in our present-day industrial society. One of these
e concept of invention. The other which is the last para-
ection 112, concerns the use of functional clauses in patent.
mething on which I have already had a good deal to say in
ritings and before meetings of patent attorneys in this
d Canada. So it is to these subjects—concept of invention
nal claiming—that I would like to address the main por-
testimony. After that I would like to be allowed to pro-
endment to the section of the bill covering design patent,

ect matter of my testimony therefore falls into these head-
Concept of invention," (2) "Functional definition in patent
d (3) "Scope of protection for design patents."
g about invention, I would like to do so as a patent attorney
e a patent-attorney (18 or so years ago) as a result of some
ude for inventing myself. I was also interested in descrip-
g, psychology, and logic, and so, although I have never
nything to speak of myself, I have made many patentable
nts for clients as well as thinking up a number of ideas of
ntable kind. Most significant perhaps to my testimony this
that in all the inventions I have made or worked upon for
personal history of its evolution has always held a fasci-
me. Besides reading extensively on the subject I have
number of my ideas to considerable introspective analysis
find their germinal points.
ult of all this I have formed certain ideas about the so-called
act. Or rather, it would be more proper to say, I have
ntly confirmed what I am continually finding out are the
cientists, psychologists, and so forth, namely that words
ntion," "creation," and so forth, have become surrounded
normous enveloping cocoon of metaphysical hocus-pocus.
lly, the simplest explanation of the whole phenomenon of
nvention is that change is going on constantly and unceas-
ywhere, all the time, in ourselves and the external world.
of these changes are very slow. So we do not notice their
adualism. We only notice, from time to time the accumu-
lts of a period of slow persistent change. And when one
a scientist, first feels the effect of a series of imperceptible
some aspect of nature and remarks on it the layman may
hardly a change worth considering, while other scientists
that it is a highly significant change which has taken place,
hly penetrating observation or set of observations which
. So with inventing, when it comes to making practical
ofality of many little changes, new practices, and so forth,

assiduously observed and absorbed by a given investor, and society grabs at that use, I think that invetor should be given a patent if it is possible to do so, and moreover that such a patent should be made somehow or other to stick, and not simply be a governmentally sanctified fraudulent piece of paper.

Now I take it that the intent of the definitions covered by section 100 in Mr. Bryson's bill and the conditions for patentability covered by section 103 have been drafted in the hope of eliciting reactions from the court which are more benevolently disposed toward patented ideas which may ordinarily appear slight, unspectacular, and not especially remarkable to the judicial kind of mind. If that is the purpose of the section I can well agree that as presently worded they may represent the best compromise at this time.

If sections 100 and 103 are embodied in a new patent statute, it seems to me they should have the desirable effect of directing your courts to the newer, more mature orientation which is commencing to prevail toward free but protected creative enterprise in our modern industrial society. With these sections made law and with assiduous public education by way of good magazine articles by members of the patent profession and the inventive public, I can see a future of more harmonious cooperation between that small but immensely valuable creative body in society and the much larger consuming body. Up to now, I should not say that on the whole the relationship has been too good.

Mankind is by nature predatory and the numerically small, perceptive, and sensitive advanced elements of society who we call creative, such as artists and inventors—and it is surprising how many inventors have been artists: Samuel Morse, Fredric Ives, Louis Daguerre, Leonardo da Vinci, and so forth—they have been easy victims. Added to this is the fact that one purpose of the courts is to interpret the inchoate will of society in the main, and thus the problem is admittedly a thorny one. Independently of all this we have the added consideration that courts are probably seldom innately orientated toward art and invention to any experiential extent. Judicial minds, or at any rate those which aspire to the bench, are more concerned with synthesis—sameness finding—while the inventor is more concerned with analysis in the hope of difference finding. Synthesizing ability must be possessed by judges in high degree to discover those principles of sameness in principle which dwell in apparent differences. It is very necessary that judges be able to notice those features of similarity, or sameness, in each new issue that comes up before them so they can apply the nearest law with a minimum of change and bring the problem within its scope. But this same tendency to look for the similarity of pattern is probably at the crux of their difficulty in appreciating a patented invention or an invention sought to be patented. For the inventor, by contrast, is concerned with detecting the differences which dwell in apparent similarities. I do not wish to imply exact polarity or oppositeness between synthesis and analysis. These abilities of course are mixed in all of us. I only wish to emphasize that in over-all terms, inventive activity, creative activity, probably involves more analysis than synthesis if the actual mental steps could be analyzed, while with judicial reasoning processes the tendency is the other way. In a word,

introduces change (improvements) on the level of fact
nnts deny it is an improvement on the level of language.
f the outstanding examples of destructive sameness finding
nces. I commend you to the observations of Mr. Justice
the Supreme Court case of *Great Atlantic & Pacific Tea
Super-Market Equipment Corporation*, of December
at opinion the granting of a number of minor patents of
commercial utility but low inventive novelty (all more
rs old, incidentally) was most strongly condemned; and
ike to draw attention to what I think may be an oversight
ng this sort of familiar disparagement of small inventions
patents by the courts and others. It is this:

't been for a host of minor patents issuing week in, week
g up coral islands of technologic know-how, this one
h gets it in the neck by the Supreme Court might either
n invented, or else might quite conceivably be considered
arkable but fanciful contrivance of an ingenious psycho-
no practical utility in a patentless society. I think you-
e that our society would be very different but for the in-
e patent system. I am not urging that the patent system
unqualified boon to mankind. I am simply suggesting that
d have been different and most people, I believe, take it
that it would be less technologically advanced.

, the slight patents of today so often contemptuously dis-
trifles," "gadgets" are really the cumulative result of
earlier and equally slight inventions. A tremendous
ll we see around us today in our material culture had its
Patent Office.

ade money—only a very little made money, but a great
, insofar as it was good copy, for magazine editors
rs, and so forth, found its way into the general knowledge
technically minded, some of whom used it to make further
entions, and so on. Our accumulated creative know-how
day is the end result of this continuous, dynamic process.
Mr. Bryson's bill introduces a newer and more beneficent
inventing, it may be rewarding to try to understand not
ing is, but what the class of persons we call inventors, the
wing the activity we must call inventing (for want of a
). I incline to agree with C. Spearman, a psychologist
I shall refer to presently, that essentially what we do
ed in the so-called creative act is to take two or more
different ideas or objects known to us and observe their
s when put together or tested together in various ways.
what significant and different happenings take place
ir being together in various quantities, positions, or when
respect to each other in different ways or at different
s some primitive ancestor of ours, by placing a stick and
ther a certain way, and rotating the stick, was able to
result we call fire in a new way. Almost certainly he
rching for a way to produce fire. It is far more likely
overy was an accidental one, stumbled upon during play,
imitive inventions.

oint is that we tend to notice what happens when two or
are put together in a novel manner or when we subject

two or more abstract ideas to a mental relationship analysis. And we ask, "What possibilities have these happenings?" Then, as possibilities emerge, we construct, either in our minds or on paper or with materials, structural refinements which will help these happenings to occur again more efficiently and with more regular predictability. Those again we analyze and accept or reject in increasing profusion until we reach what we choose to consider a conclusion.

Viewed in this step-by-step way it would appear that in terms of quality there is little difference between a so-called great invention and a small invention, although in terms of quantity—or the actual number of individual steps—there can be a very big difference. And, of course, each step in a long and complicated succession of individual steps would involve the additional mental process we call by such names as judgment, reasoning ability, and so forth.

So my belief is that so-called inventive ability is mainly a matter of how much background knowledge a person has soaked up and can forge himself to usefully recall—this plus a "set" or orientation toward the idea or concept of change rather than the concept of stability and unchangeability. There is quite an extensive literature on the nature of creative thinking which I believe this committee might read with considerable profit toward clarifying this matter of inventive genius. Here is a short list:

1. Your Creative Power, by Alex F. Osborn (of the well-known advertising firm of Batten, Barton, Durstine & Osborn).
2. How To Think Creatively, by Ellis D. Hutchinson.
3. Productive Thinking, by Max Wertheimer.
4. Creative Mind, by C. Spearman.
5. The Art of Thinking, by Ernest Dimnet.
6. Invention and the Unconscious, by J. M. Montmasson.
7. An Anatomy of Inspiration, by F. E. M. Harding.
8. The Psychology of the Inventor, by Joseph Rossman.
9. The Creative Adult, by Hughes Mearns.
10. The Art of Thought, by Graham Wallas.

I would also draw to your attention the following articles:

The Relation of the Scientific Hunch to Research, Platt Journal of Chemical Education, page 1969, October 1931.

Articles in Journal of the Patent Office Society of January 1945, June 1948, January 1950, and February 1951, by C. C. Kefauver.

Even a cursory reading of a few of the above titles will, I think, convince any of you who had any residual doubt, that the attitude toward creative or imaginative activities of the mind, by scientists—psychologists, anthropologists, etc., is not the metaphysical one which some judges appear to have. Neither is it the almost completely negative one which other judges exhibit.

I should perhaps remind you that the idea of inventive genius—that something beyond newness and usefulness—was unknown in the United States until 1850, and then it only came to be a factor in decisions following the leading case of *Hotchkiss* v. *Greenwood*, and not by any legislative enactment on the subject. But that decision provided a precedent which could effectively demolish and patent—Alexander Bell's telephone patent, Marconi's wireless patent—anything. Let's take for example the invention of the Diesel engine by Mr. Rudolf Diesel. If an uncharitably disposed supreme court—

preme Court or the Supreme Court of Canada or its equiv-
England; for example) should have got its hands on the
ent it could easily have denied "inventive genius" to the
on which constituted the invention by asserting something
First, that the idea of compressing air to the point where
gnite a charge of fuel was noninventive since everyone who
sed a bicycle pump knew that air heats up when compressed.
that the amount of fuel mixed with a given volume of air
y a matter of critical percentages well within the experi-
ll of a chemist who, by a merely routine set of tests could
rmine the conditions of optimum combustibility.
, as to the forced injection of the fuel, the courts might have
at could be more obvious than that? Things like hypo-
inges have long been known for injecting liquid charges by
cylinder means." Well, that is just a suggestion as to how
sely valuable Diesel patents might have been invalidated
assure you that such arguments could be applied to every
nt which has ever issued without exception. My brothers
ent profession will, of course, remind me of the powerful
se law which prohibits the building up of a mosaic of
g structures to defeat an invention or a patent. That is
hat I am concerned to show here is that every big invention
nly a quantity, a plurality of small inventions. If I can
satisfying you of that, then I think it would not be difficult
yourselves that an invention embodying only one or two
t any rate only a few steps should, if valuable in its results,
entitled to a valid patent as one involving a long chain of

a set of aphorisms:
hat mankind can do is to rearrange what he finds in the

tifically speaking we do not "invent."
an only reorganize known structures and thereby produce
ths.
new relations can produce new results.
the essential prerequisite to making a practical, successful
as in solving any scientific, legal, business, or any practical
s to ask oneself the right questions. That sounds easy but,
is often insuperably difficult. It is in the formulation of
y right set of questions that the creative act really lies,
be a piece of predominantly creative synthesis or a piece of
ntly creative analysis we are working on. For you cannot
cise answer to a vague question. But that's what most of
ost of our time doing—and, of course, we get vague answers.
ful inventors get vague inventions—unsuccessful, impra-
ations. But when we ask precise questions, the answer is
at hand. It appears often as if by magic, and it's so easy
thing or solution "obvious" after its accomplishment. It
is obvious. But we fail generally to realize where the real
—in the formulation of the problem—before its structural
uld be arrived at.
r Newton's third law of motion for example. (Not a patent-
tion, but a good example.) It states: "To every action there

is an equal and opposite reaction." Well, in a sense it's the very last word in obviousness. Not only mankind, but every moving organism in nature "knows" it, in the sense that it makes use of the law constantly—the squirrel when it jumps from branch to branch, for instance. But Sir Isaac Newton, with our human faculty for language making, asked an ingenious question. The question was: "Can it be that for every action there is an equal and opposite reaction?" Having asked it, it was easy to establish by experiments that such was indeed the case. He probably put to himself numerous preliminary questions of course. But the affirmative proof of the final question is a cornerstone of Newtonian physics, and was revolutionary in its consequences. The formulation of a progressive set of consistently precise questions (even though we are generally not consciously aware of doing so), is, I believe, of the essence of scientific discovery and invention.

Gentlemen, you will understand that I speak predominantly for the small manufacturer and the private inventor. I am not interested in the great corporations, for whom I should imagine the patent system in its present state is all too well suited. It is well suited to the circumstances of the great corporations because of the technical complexity of patent law and the high cost of litigation arising out of that complexity. Furthermore, it is becoming increasingly the case that it is only the wealthy corporations which can produce ideas likely to lead to valid patents. This is because they have vast research facilities. The small manufacturer and the private inventor, on the other hand, are greatly handicapped. They are handicapped in no less than three ways. First, by only being able to draw on a personal background of knowledge or that of a limited staff, and experiment with meager facilities so that there is less likelihood of the development of any worth-while patentable invention. Second, any patent obtained is less likely to be held valid through its probable greater simplicity or obviousness. Third, the economic disadvantage suffered by the small business resulting in lack of advertising and distributing power, capital equipment, etc.

I would like to advert to my earlier reference to a society without a patent system—without a system for rewarding technical innovators. I am aware that some antagonists of the patent system are fond of saying that society would be much as it is had no patent system been instituted. Very obviously it is impossible to prove or disprove such assertions. I only suggest that such a proposition is as unlikely to be the case as it would be if the idea of the joint stock company—shareholding corporation—had not been thought of. But even if it be admitted all that has been invented and commercially adopted would have been invented and adopted in a patentless society—even if this be admitted, please consider all the vast wealth of ideas, suggestions, and so forth, contained in the printed publications or patents not adopted commercially. Only a very small percentage of things patented get taken up commercially. There is a tremendous waste just as there is in nature. But yet, because of the patent-office publication system it is by no means a complete waste on a more mature view. For most of the so-called unsuccessful patents contain, in one way or another, valuable leads to those who come after. Because we have a patent system, in your country and in mine, inventors were encouraged

heir inventions in exchange for getting a patent and the
which went with it. Without a patent system what incen-
iere be for this army of inventors to publish their ideas so
a thousand learning selectively from the others might
conomically valuable invention. The 700 to 1,000 patents
h have been issuing week in and week out, year in and
the past 50 years or so, are repeatedly scrutinized by
ers for the popular-science press, which alone has a
today of nearly 1,000,000 copies. Those inventive in-
ose technologic coral-island builders, with all their insane
nly published ideas, when taken collectively, are every bit
the so-called inventive genius. Without them he couldn't
s he is hailed to be. Just as Andre Malraux says in his
History of Art that the only inspiration for a work of
recedent work of art, so the only inspiration for an inven-
recedent invention. And that seems to me to point up the
y in the reasoning of people like Mr. Justice Douglas in
of the ostensibly slight invention. Such searing denun-
either independent creative enterprise no end when you
extent to which it is given publicity." I said just now
ssal mortality in the world of invention. Yet up to now
ed (albeit to an attenuated extent). But like a species
ortality can commence to run against survival. This
n conditions become too precarious to make life worth
are in danger of this happening in the patent system.
s. Mr. Kent, I am not sure that you understand the situa-
we were advised this morning by special notice that the
under debate in the House now would require our presence

Yes.

s. It is now 12:15, and the members will have to report

Mr. Chairman, so that the present witness will not have
I suggest that his entire statement be incorporated in the

s. Yes, we will be pleased to have your entire statement
If you would like to do that you may do so.

I would like to, Mr. Bryson.

ce of Mr. Kent's statement is as follows:)

e high mortality rate among patents has probably been no higher
greater than the cost of mistakes written off to the average expe-
untered every day in business and in life generally. The only bad
s the false promise of validity which the otherwise commercially
ates gets taken in by. That is bad. And it has most eloquently
Ford W. Harris, in the Journal of the Patent Office Society, No.
December 5, 1950. I would like to read some extracts from this

He has little interest in whether or not these new things were the
flash of genius or the result of long and expensive research and
t. The benefit to the public does not, in any degree, depend upon
w things were produced. Moreover, the public is the ultimate
e value of the advance. Unless the new thing is substantially
seful, the public will not use it. Our troubles started years ago
ic Works v. *Brady* (107 U. S. 149, 27 L. Ed. 438), which held "It
e intention of the patent laws to grant a monopoly for every
ice, every shadow of a shade of an idea." This statement was
Thompson v. *Boisselier* (114 U. S. 1, 29 L. Ed. 76); *Western*

Electric Co. v. *Rochester Tel. Co.* (115 Fed. 41), and other cases over the years culminating in *Cuno Engineering Corp.* v. *Automatic D. Corp.* (314 U.S. 84, 86 L. Ed. 69), in which it was said, that 'the new device, however useful it may be, must reveal the flash of creative genius, not merely the skill of the calling.' The Cuno case related to the cigarette lighter now found in substantially every automobile, and the words 'however useful' appearing in the Supreme Court's opinion tacitly recognized that this device was very useful. So far as the benefit to the public was concerned, of course, made no difference whether or not the new thing was the result of a flash of genius, and the public has certainly benefited by the new lighter to a very great extent. There is no very logical basis for the objection to patents on trivial inventions; that is, inventions that are merely small contributions to the art. If the step in the art is of no value to the public, the public will not use the invention and the patent is a harmless nullity. If the public finds a trivial invention useful in any degree, it will pay for the use of it to an amount proportional to its demonstrated utility, and it is no more than fair that it should do so. On the other hand, the value of any step in the art is very hard to predict in advance. After the patent has tested the degree of public acceptance may fix the value.

"Established industries move in small steps and not by dashes of genius, and progress by such small steps should be encouraged by patents. It is hard to understand the courts' abhorrence for such small steps. However, if we agree that there should be some clear to the degree of utility, it is entirely unnecessary for the Patent Office to use the device of invention to establish and maintain it. The Patent Office is fully empowered by R. S. 4888, 35 U. S. C. 36, to screen out and refuse to issue trivial patents. Thus, under this statute, the Commissioner is empowered to refuse to issue a patent on any invention if he considers it is not sufficiently useful and important to merit a patent. This is exactly what the average rejection for lack of invention over the prior art means. The examiner tacitly admits that the application has made a step in the art but holds that the step was not of sufficient extent to merit a patent. Now it is entirely fitting and desirable that the Patent Office should retain this power. An examiner is the sole bargaining agent for the people of the United States in negotiating with applicants for patent. Every application is an offer by the applicant to allow full particulars as to his invention to be made public in return for the allowance of certain claims presented in the application, and the prosecution of the average application proceeds by a series of offers by the applicant as to claims he is willing to accept as his price for the bargain.

"It is obviously proper for the Commissioner, through his deputy, to refuse to make a poor bargain for his principal, the public. It is strange that, if the Commissioner refuses to make what he thinks is a poor bargain, we are now able to go to the courts and ask them to make such a bargain. If any person offers to buy anything else from a Government agency and the agency refuses to make the bargain, he cannot take the matter to any court. Obviously, it is my opinion, the Patent Office should abandon rejections for lack of invention over the prior art but retain and exercise its right to reject claims on the ground that in the opinion of the examiner, the invention claimed is not sufficiently useful and important to merit a patent. I also think that such a rejection should be reviewable by the Board of Appeals, but should not be appealable to any court. In other words, I think if the Patent Office decides it does not think it should make the proposed bargain, that should settle the matter.

"The applicant would be only negatively injured by such a refusal to grant a patent. His invention has been maintained in secrecy during the pendency of his application and if his application is rejected no disclosure is made to the public. He is exactly where he was before he made his application. He has failed to make a bargain and therefore, there is no contract to rescind or reform.

"Practically there is very little harm resulting from the examiner's holding behind this device of invention except that arising from waste of time in arguments over the rejection for lack of invention which are upon a highly physical plane; metaphysics in this, and other cases, being merely one person talking about something he does not understand, and cannot prove, to another person who does not understand him and cannot disprove what he says.

harm, however, is done by the courts under this fiction. An ap
as made an advance in the art and convinced the Patent Office that
ce is sufficiently useful and important to merit a patent. A bar-
been made, the applicant's price has been paid by the publicizing
vention and he has obtained a patent containing some claims. (But,
anding this bargain, if the patent is involved in litigation) the
pply considers de novo a question already decided by the Patent
l if the court decides that the patent was invalid due to lack of
over the prior art, it is simply holding that the Patent Office made
rgain. It rescinds the bargain, takes away the patentee's rights
r to a mistake in judgment by the Patent Office, the applicant not
fault in any way. Of necessity, it allows the public, whose agent,
ssioner, made the bargain, to retain all the advantages arising
bargain, since the applicant's invention has been fully disclosed to
. The inventor has lost due to a triple play of the legislative to
nistrative to the judicial departments of the Government. Con-
nised to give him a patent if he conformed to certain statutes, the
ffice checked to see that he so conformed, and the courts nullified
deal."

records old and new are being scanned by searchers by the hun-
ny year in and year out, the purpose of which can roughly be put
eadings:

ehalf of inventors who believe they may have a new idea.

ngineers, etc., in search of ideas.

cience publishers who publish collectively around 4 million copies
nor per month, as I have already stated.

ttorneys searching to find anticipations to defeat patents already

rm of searching, in my opinion, is wrong. And my contention is
hat I take to be that of Harris, whom I have just quoted, although
ly in line.

ion is this: That the great body of technical know-how in the
Patent Office, should remain available to public study as it is now,
uld no longer be citable as prior art, unless, it is under 25 years old,
uld no longer be possible to support the refusal of a patent solely
tion of any printed material published more than 25 years ago.
recognize that I would allow the repatenting (subject to some
hich could, I think, only be satisfactorily effected by study) of
h was a practical, modernized version of a patent, publication,
n 25 years old, provided of course that any public use of the pub-
er patented idea had also been abandoned for more than 25 years,
that such repatenting would not be permitted until the modernized
ctually on the market, and then only for terms varying, I should
o 5 years at the discretion of the Patent Office. Intention to
patent would have to be made, say 8 months ahead of a contractual
g date, and a bond of indemnity for nonperformance might have
Intention to apply for repatent would also have to be well and
blished to the trade so that the regrant could be opposed on pro-
of of user or publication within the last 25 years.

e proposals I have just sketched would stand up to the rigorous
panel of experts seriously considering them remains to be seen.
am surprised how well they have stood up to the objections which
ne in a desultory way during the years since I first formulated
You see, it is as Mr. Harris, whom I have been quoting, said,
e has little interest in whether a new thing is a result of a flash
ow the new things were produced. I don't think the public either
e new thing was originally produced. As a matter of fact, I think
Samuel Johnson said about story-writing is very applicable to
at if it's good it's not new, and if it's new it's no good. And this
n of newness, what does it mean anyway? To whom should an
ew? Why should an invention have to be new in the fictitious sense
orn knowledge" on both the scientific and the popular levels?
e of more benefit to the public if the word "new" in the patent
"information currently" or recently made available to the public
nufactured form"?

of terminating once and for all the Patent Office citation of what
anticipations would permit the regrant of patents for short

terms under conditions which would insure that the public would get the bene-
fit of the invention. At the present time there are many patents which have
long since entered the public domain, A small percentage were once profitable
commercially. Others were patented before the market was ripe for their
commercial exploitation. Anyhow, whatever their history, my proposal would
insure that such old patents if regranted, would be new as usable experience
to the contemporary generation. It is one of the standard arguments for the
grant of limited patent monopolies in the first place that: (a) nothing is taken
away from the public which it formerly enjoyed and (b) that the monopoly
is given to the public after a limited period for enjoyment of reward. But the
crucial fact is, and remember I am speaking more particularly of the inventions
of small manufacturers and private individuals, not the big developments of
great corporations so much that if a patented invention is not taken up com-
mercially during its lifetime it won't get taken up after it has expired for the
reason that no nursing period protection can be obtained upon it again. Con-
sequently the public doesn't get the benefit of it anyway. Every patent attorney,
I am sure, has had the experience of clients coming into their office with an
idea; often in a field they are wholly familiar with and declaring that a search
is quite unnecessary because they know that nothing like it has appeared before.
Accordingly they want to patent it and commercialize it forthwith. The patent
attorney, however, points out that it often happens that a search shows an idea
to have been anticipated years before even when that idea has been made by
someone who has been in the trade all his life. So reluctantly your client agrees
to a search, and you make it. You find what you half expected to find, namely,
that the thing has been done before, much to the disgust of your client who in-
variably, according to my experience, wishes it right out of his mind forthwith.
Who is the loser? The public, surely, is the biggest aggregate loser in these cases.

Then there are those inventions on which it has only been possible to get weak patents, subsequently pirated by powerful competitors, thus forcing infant industries out of business during the nursing period. The pirates secure the improvement on the nonverbal level of fact because the courts have decided it is an improvement on the level of verbal fiction. In this case the public gets the improvement all right, but I want to ask you, gentlemen, was it along such swashbuckling lines as these that the "progress of useful arts" was supposed to be fostered? Is that what your founding fathers intended when they wrote those words into the Constitution? The public only got the improvements because the manufacturer mistakenly believed he was protected. If he had known how impotent the patent system really was, the public would probably have remained without it, just as, for example, the public would probably have remained without the time and temper saving cashier's counter in self service grocery stores, which was the subject matter of Turnham's patent No. 2,242,408, held invalid by the Supreme Court last December when the owner of the patent tried to stop the A & P Tea Co. from using it without permission. Now it is here, it will no doubt stay. But I do suggest that it is highly likely that this valuable invention would never have seen the light of commercial usage had the inventor known what a fraudulent grant the present kind of patent so often is.

Mr. Chairman and gentlemen, I think you will agree that we need to encourage free creative enterprise among small manufacturers and private inventors. If that is so, a patent system is needed in which inventors and small business men can put their trust. Otherwise they will tend to keep inventions secret. In examining my copy of Patent Claims by Ridsdale Ellis published in 1940, I notice a publisher's reference to another book by the same author entitled "Patent Assignments and Licenses, Including Trade Secrets." In reference to trade secret law the reference included this pregnant remark:

> "The various stringent rules laid down recently by the Supreme Court with regard to the requirements for a patentable invention are bringing to the fore, in a way never presented before, the advisability of operating inventions as secret processes instead of securing a patent which may be held invalid by the Court later."

Now we don't want to go back to the medieval practice of trade secrecy. Those of you who are familiar with the situation in the Atomic Energy Commission are well aware of the extent to which the leading scientists of this country are irked by the secrecy regulations under which they have to work. Compel manufacturers to adopt measures of secrecy as their only recourse against competition, and a chaotic condition would quickly arise.

I have two clients in western Canada—chemists—who have invented chemical means for removing skins from potatoes, which has been sanctioned by the pure-

ents of both Canada and the United States. Operating their in-
tly, they are supplying peeled potatoes to a number of large con-
airlines, railroads, etc. Without consultation with patent attor-
hently based on their appraisal of the worthlessness of the patent
gh their reading of newspapers and professional journals, they de-
patent but to keep their process secret. Only just recently have
rtunity of interceding, I hope successfully, before they are barred
nd 2-year provisions of the United States and Canada, respectively,
at they at least apply for patents before it is too late. If only in
pendency of a new patent law and a better deal for inventors, and
that they can at least withdraw their applications and thereby try
eir secrecy later on if they still prefer to do so.

ll understand the position of these inventors. They so well exem-
mma in which the small-business man finds himself. The big
as those three distinctive advantages:

uch greater possibility of making inventions which will rise to
ts required for patentable validity by the courts through greater
facilities;

e money to prosecute infringement violence, and to defend them-
ainst any infringement they desire to embark upon.

omic advantage, that is to say, mightier distribution systems,
g resources, and manufacturing assets.

he only feasible amelioration of this imbalance in favor of the
facturer and private inventor would appear to be valid patents
rovements, equally with the big corporation. In this connection,
r courts have said a number of times that the Constitution did not
getting protection on every slight improvement. Well, of course,
t by "slight improvements" depends on time and circumstance.

ur founding fathers did not contemplate the modern industrial
could hardly be expected to any more than we can be expected to
ociety 150 years ahead from now. But, contemplating the constitu-
as suggested by Mr. Carl B. Lutz in his article in the Journal of
ffice Society for February 1950, one is struck by the suitability of
used, to our rather technically refined patent needs of today. As
clause reads:

ongress shall have power * * * To promote the progress of
d useful arts by securing for limited times to authors and inven-
exclusive right to their respective writings and discoveries."

len of Mr. Lutz' clarification of this clause: That there has been a
ds, or a wrong coupling up of the word "science" with the words
nd "discoveries." It is his contention by contrast, that the terms
be coupled up fall into two groups. The first group is the words
thors," and "writings." The second group is useful arts, inventors,
es. Mr. Lutz would therefore have the clause read as follows,
ent rights are concerned:

ngress shall have power * * * to promote the progress of
s, by securing for limited times to inventors the exclusive rights
iscoveries.

ly, so far as contributions in the more exalted field of science are
clause would read:

ongress shall have power * * * to promote the progress of
y securing for limited times to authors the exclusive rights to
ings.

n the point of social practicability, that is what may well have
. If so, it seems to have been lost sight of, although a persuasive
strictures of Mr. Justice Douglas in the A. & P. case which I have
eady.

ty we have two forms of registration. One is compulsory regis-
rifice whereby the State may know what is being done by whom
line, and that compliance has been made to certain requirements.
n of registration is elective registration. In this case the regis-
luntary submission to authority, abrogation of certain freedoms,
advantages (in the case of inventions, secrecy) may gain other
d rights after examination of his right to them. In a good elective
ystem, such as that governing trade-marks and copyright, this
s the continuous need for anxiety and vigilance. There is a spirit
y to these forms of registration which breeds a feeling of security

and freedom to operate. Such a feeling of freedom is utterly lacking in the patent system.

Careful meditation upon the definitions in section 100 and the conditions for patentability in section 103 of Mr. Bryson's bill, as now amended, read in comparison with the present patent statute gives one a feeling of cautious optimism. If the present bill goes through, a somewhat more benevolent attitude may be accorded by your courts toward patents on inventions which are refinements of earlier crudities even though ostensibly slight.

Creative imagination is the faculty of conjuring past experiences, distorting them, and fitting or relating them in new and often fantastic ways. In our aggressive, extroverted, but anxiety-ridden society, it is too often looked upon as a kind of suspect ability, is a somewhat frowned on activity, and something that should not be too much encouraged. So called efficiency seems to require its all but complete suppression. But the point I am leading to is this: The inventor, although a man of creative imagination—an artist—is also, to the extent that he has developed a successful invention, or a number of successful inventions, a person who has exercised other leavening influences to modify his primitive imagination. These influences we hold in high esteem in our society.

We call them by such names as energy, superior reasoning ability, resourcefulness, persistency, and confidence. But, more than anything else perhaps, the commercially successful inventor has combined creative imagination with reasoning power and high discriminatory ability. He is a disciplined personality, a person who has shown himself able to bridle this dangerous, somewhat disreputable faculty called creative imagination. He is a cool, collected, integrated person who has passed the test of a very exacting, capricious, consuming public. Why should his position, under these circumstances, be more precarious than that of an artist or an author holding copyright in a picture, play, or book? Why should he be discriminated against more than, say, a manufacturer who, by nothing more than the making and selling of a common article, has been able to build up a valuable good will and preference for his make of the article through the virtually unassailable monopoly ownership of a more or less ordinary symbol or design—that thing which we call a trade-mark?

Let us try and talk less nonsense about patents, including that which first distorts and then implies contemporary validity to outworn statements such as used by some proponents of the patent system. I refer particularly to the well-known story about Commissioner Ellsworth, who in 1844 (as quoted in The Story of the American Patent System—U. S. Department of Commerce, 1940) reported:

> "The advancement of the arts, from year to year, taxes our credulity and seems to presage the arrival of that period when human improvement must end."

This is usually changed to a reference to "A Commissioner of Patents who, around 1835, gave up his job because he believed just about everything had been invented."

The facts are that since 1844 more than 2 million patents have been issued in the United States alone, and just about everything has been invented in the crude, out-of-date patent-system sense of the word (or at least in the Supreme Court sense of the word). According to the formula of prior-art searching which examiners must follow, there is literally nothing the examiner cannot find an anticipation for or is justified in getting enthusiastic about. But if we face the fact that we live in an age when older basic ideas are being refined for more highly discriminating needs, then we can entertain the idea of patents on acceptable re-created ideas. There should be less emphasis today upon the spectacular thrust into the unknown as the only true requisite of the patent grant. The "flash of genius" doctrine is really nothing more than a concealed way of asserting that the only thing entitled to a patent is that which evokes the gasp of amazement and the state of emotional bedazzlement. The courts will have to take increasing notice of smaller and smaller differences. I said just now that one of the attributes of today's successful inventor is a highly developed discriminative ability or critical insight. The reason this is so necessary today is because the vast and confusing accretion of knowledge we possess can be as much of a handicap as an asset. Today, an important factor in successful inventing is knowing what to reject among our mountainous pile of technical knowhow, and out of the vast number of false leads the ability to pick the right one—in other words the ability to see the wood in spite of the trees.

Copying, imitating, and acting from habit are basic patterns of behavior of high survival value up to a point. They come unconsciously, naturally and easily.

resist these tendencies requires discipline and effort, but the doing so, to the creative mind, is this: That wandering away of habit and convention can bring rich rewards in terms of . The inventor finds, for example, that there is often nothing than an obvious fact. He also finds sometimes that the most e turns out the best possible. On the indulgence of fantasy con- y improbable suggests or leads to the practically possible.

lude this first section of my testimony with the most earnest rit of progress which characterizes sections 100 and 103 of your suffer no contraction. The reference to obviousness, "ordinary ularly the reference to "subject matter as a whole" are vital to opinion. The last reference particularly implies what modern sciences have long taken to be axiomatic in nature that "the han the sum of the parts." The primitive practice of anatomiz- discover "the manner in which the invention was made" must he discard, as your section 103 now explicitly states in words s those used in the recommendations of the United States Patent tee in his report to the President of June 1943. We need our must not be allowed to become an extinct species, for their ltify initiative everywhere and waste the creative capital of lt is most necessary to find such ways of preserving it as offer e face of other deadening influences like the big corporation, ce, and paternalism generally. And I should think there would ltution to fight communism than a liberalized patent system g of a single competent court of appeal. As Dr. James Bryant of Harvard University, recently said in warning against too on of research: "We of the mid-twentieth century have been o a considerable degree because of the momentum accumulated amateur and the lone inventor." Let us not lose that momen- ber, apart from all material reward, a patent is a "symbol of ch can bring satisfaction even when it brings no cash dividends. patentee" has been able to derive valuable self-esteem and con- title, by virtue of which he has been able, symbolically, to with "great inventors." This is a human tendency which we re, somewhat in our make-up, and should not be laughed off r those in authority. I have dealt with the need for satisfying need for more symbolic rewards, honors, citations, etc., in my "Patents Pe-Pending," but I have said enough on the topic of will pass on now to "Functional claiming."

FUNCTIONAL CLAIMING

e to discuss the third paragraph of section 112 of Mr. Bryson's

t in a claim for a combination may be expressed as a means erforming a specified function without the recital of structure pport thereof, and such claims shall be construed to cover the structure, material, or acts described in the specification and ereof."

In my opinion, very much needed in a revised patent statute y's industrial society. However, I find it a little difficult to d reason for the expression "element," or the expression "com- my remarks on invention per se, you may recognize that I ation, in the final analysis, as a combination of at least two anything that can be defined as a "thing," from the commonest what we define as material (string, paper, etc.) consists of at identifiable parts. Thus, for example, a nail consists of a , a hairpin consists of two prongs and a connecting portion, ever has been a binding definition of a combination in a patent , in patent cases, have generally relied upon ad hoc definitions, would very respectfully submit the following as an amendment ph of section 112:

r an invention may be expressed in terms of the means or by the structure of the invention for performing its specified out reciting the structure beyond what is deemed necessary for n, and such claim shall be construed to cover the structure or equivalents thereof described in the specifications for specified function."

It was in the celebrated case of O'Reilly versus Morse in 1852 that functional definitions in patent claims were first denounced. Since then the patentable invention has been predominantly defined in terms of what it *is* rather than what it *does*. The reason for the suppression of functional claims of the early kind was obvious enough. They tended to embrace everything for a similar purpose hetheir tenttlike expanse. They were often crude and greedy definitions, and they probably deserved to be thrown out. Furthermore, there was not much objection to their prohibition because in the latter half of the Nineteenth century mechanisms were slow in diversifying compared to the present rapid rate of structural innovation. So over a long period there was rough agreement as to what a given term or noun stood for. For example, a given part was either a wheel or not a wheel. But nowadays with the great number of new shapes, to all of which a comparatively short list of standard names must be applied, the doctrine of structural claiming versus functional claiming is in need of some semantic analysis, if only because there are instances in which a structural claim has illegitimately appropriated territory which a functional claim could not appropriate because functionally different. That's something which the prohibition against function apparently didn't anticipate.

The engineering arts have a somewhat meagre vocabulary in comparison with the vocabularies of architecture, biology, etc. This is doubtless because those subjects are much older in origin. Two hundred years ago there was no machinery worth speaking of. All the same, subjects like architecture and biology, equally with mechanics, deal with three-dimensional configurations, some of which have very useful parallels with engineering practice. A number of terms from other sciences have crept into engineering, but on the whole it is still a somewhat impoverished vocabulary by comparison, and accordingly I have been working for some years on a technical dictionary which I believe will enrich our technical vocabularies by a system of reference to structural synonyms from fields like architecture, biology, zoology, botany, etc.

One difficulty about claiming an invention in terms of the names of structural components is that there is increasing disagreement as to whether a part is or is not what you have chosen to call it. Thus, for example, I once had an instance of an open wire screen which was made to reciprocate or move back and forth in its own plane, and while thus moving would function as a solid barrier. I therefore called it a barrier, which I thought was structural enough anyway. However, the term was refused because it was only "temporarily" a barrier—only a barrier while it was moving. The expression, although a noun, was therefore rejected as functional. I only achieved a satisfactory solution by urging the reasonableness of calling it what it behaved like.

As the great anthropologist Bronislaw Malinowski said:

"The meaning of a word must be gathered, not from a passive contemplation of this word, but from an analysis of its function with reference to a given culture."

In my most recent article for the Journal of the Patent Office Society of February 1951, I have, I think, demonstrated that even unlikely looking stationary objects, can be claimed almost wholly functionally, and with as much specificity or narrowness of detail as can be done by structural claiming. In fact, I think logicians would agree that the functional form of claim, they call it "teleological definition," is the most perfect way to define a given structure with deductive inevitability. And it has the advantage of clearness of meaning. This greater clearness of meaning arises from the fact that a common, already existing word (noun) cannot bring a definite understanding about unknown structures, and every invention involves some unknown or new structure naturally. The drawings and the specifications of the new patent describe the new structure admittedly, but how much territory is to be reasonably considered as the equivalent of what is pictured and described? Well, the result is that when a potential competitor trying to determine how closely he may approach a patent and how far he must keep away, with many present-day claims, often ends up far less certain as to what he may and may not safely do, than he would if he had a dynamic and predominantly functional definition to read. Specifically he has to decide how much inventive territory is fenced in by the common existing nouns used, but applied to a new use.

Now, by contrast, when you analyze a functional claim which speaks about what the invention does, and sets forth the way it works, far greater understanding may be expected. No two people can ever possibly agree exactly on what anything is. But they can agree pretty well as a rule on what a thing

what it does can be tested by seeing if do it, while what it is ted. John Doe, for example, may say, "This is a wheel, because ymmetrical, rotatable, and rimmed" but Jack Smith may say, eel because it's too wide to be properly called a wheel; it is a Jack Jones comes along and says: "It is neither a wheel nor a alley, because its rim is cambered." So the argument may go because with the small stock of mechanical nouns we have to any different actual shapes, everyone has a different picture in as each one of you conjures up a different picture in his mind e word "kettle" and ask you to visualize same. The picture you o resist eradication, and to the extent it does so, blocks mental ward the views of the other fellow. It's in ways like these that started—because of differences in interpretation. I know of no citing where "lsness" is a required practice to the extent that if liming. And in my article in last February's Journal, I have ction of the Patent Act and a clause of a standard licensing his kind of form to illustrate its absurdity.

I will see, from what I've just said, how the structural form of rage the most sterile sort of arguments—"'tis—'tisn't" argu them. The examiner or the courts can say that such-and-such roperly speaking" what you have called it. If you reply on the ffect all you have said is that is *so* what you have called it. o launch into an exposition of general Semantics in this testi- ou to my articles for that. All I want to suggest here is that sitely unimportant *what* you *call* a thing so long as you make and functional meanings clear. That is the only effective way g so far as I am concerned—and by functional, actional, be- ns you can do just that—you can communicate more effectively. a person persists in describing a thing to a practical man, say nery, in terms of what it is, that listener will almost certainly l ask "What is it for?". If a description in terms of use is still he will then say, "Let's have a look at it," or "Let's see it in s only trying to get behind the smoke screen of words to the rea- eality. Language itself progresses from the primitive naming rational way of talking, and every child repeats this linguistic elopment. A child first asks, "What is it?" When a little "What is it for?" Then, only when it has developed fairly oning power does it ask, "How does it work?"

iming is highly desirable in my opinion because it will enable tand the scope of the patent they are examining. Even when, necessary, particularly in a narrow patent, the claim must be iculous use of functional language, still it will be a lot clearer al jargon now used, and which, without doubt, has been most sometimes on behalf of big corporations to breed uncertainty, ubt as to whether it's safe to ignore their patents. To that claiming has played into the hands of big business, and func- will tend to terminate it. Functional language has a vital r from which we feel satisfied we know what is meant, because, tile, and other sensory levels—concretely experiencing levels, milarly constituted. We have all felt, seen, and so forth, much performed basically the same bodily operations, and so forth. rp distinction to the case on abstract reasoning levels, which s. There, the experience of the educated man and the relatively differ, widely, introducing widely different verbal meanings. opher, George Santayana, has said:

osophically studied, is akin to the deepest metaphysics, because constitution of speech, if reveals the constitution of thought of those categories by which we conceive the world."

as we define patented inventions predominantly in terms of ainly are, in my opinion, conceiving the things of the world covered by patents, in a fictitious way. It is a way which n of disagreement because of the individually different pre- all of us have about concrete objects, especially when applied a new combination, as they invariably are in patents.

lysis, if you only want to know what it "is" that has been e claims at all? The drawings illustrate the invention. The ns its construction. The only real need for claims should be

to define what you cannot always see—the actual useful operation the invention performs, and how it does so, in order that you can enclose this operation and manner of performance against infringement." Only when defining constructs without reference to utility should a structural approach be used, as in the case of design patents. The form of claim you employ in design patents bears out my point. You simply say: "What I claim as my invention is the ornamental design for a so-and-so substantially as shown." It's left to the courts to decide what variations trespass on the patent. But when a thing has another attribute—its essential attribute—that of utility—over a design patent, it seems folly not to anchor your method of definition to that essential attribute—especially as I have already said, when the full significance cannot always be observed from a passive perusal and is only revealed when the thing is actually built and tested.

Lastly, in relation to functional claims, I put forward the suggestion that every patent should have at least one carefully drafted functional claim if only for insertion in the abridgements which appear in the week's Official Gazette of issued patents. I'm sure everyone will agree most of these abridgements are virtually meaningless at the present time. They simply show one view from the drawings greatly reduced in size, and one claim, which, being structural, seldom gives any useful information. Of course, better even than this would be a required drawing and an operationally descriptive summary particularly for the Gazette. But a clear functional claim should be nearly, if not quite, as good in most cases, as I visualize such claims.

DESIGN PATENTS

I would next like to discuss section 311 of the bill which relates to patents on designs. As you all know, the successful manufacturer and the successful inventor today seldom loses sight of this vital aspect of modern merchandising. It is design alone that sometimes puts one product out in front in the race for sales leadership, and it's through design that successful inventors often succeed in selling their ideas. Now, most people think that industrial design simply means eye-appeal, or "streamlining," but actually it is a great deal more than that. Some of the considerations involved in successful industrial designing come under such headings as greater comfort, improvement in balance, for example; and it has been amply proved that workers will take much more care of an expensive machine too which is smooth and well-organized as to its component parts than one that looks like a Rube Goldberg contraption.

I have said in an article on the subject that a well-designed industrial product is one that "looks like what it is, only more so." For instance, a heavy-duty implement like a truck or a bulldozer should be designed to enhance its appearance of strength. If the article is a piece of scientific equipment like a camera or a radio, then the look of scientific precision should be emphasized. Nor is it always a question of pleasing appearance. For example, I can cite a piece of mining machinery which was very dangerous if not handled with respect, and it had been deliberately "industrially designed" to make it look like what it was, for the greater safety of its users. Its formidable appearance was not entirely intrinsic to the machine; nevertheless, it had a look of greater functional fitness than any of its competitors.

Now your section 311 reads like this:

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

But from what I have said I think you will recognize that modern industrial design is more than a matter of mere ornament. In a machine tool, for example, it is well within the industrial designer's field to arrange the controls, their location, how they feel during use, and so forth. Even how the machine or article sounds during operation can be important.

In the article I've just mentioned I referred to an after-shave bottle I had. The neck had a long thread, instead of the usual short, single turn thread. The screw cap was a heavy, black plastic disc. The result was that you could spin it on and spin it off like a wheel. That was a pleasing sensation, and also more practical than a single turn thread which requires a twist of the wrists, sometimes resulting in dropping the bottle if the hands are wet. Good industrial design then can mean such things as a clean snap to a lever, a long smooth push to a controller button, a good grip in a saw, a nice whip to a rod—anything in fact that gives a breath of life to the lifeless, and provides that "pick me up and

al. I therefore define good industrial design as greater product

, I would like to suggest a definition of design to be included in bill substantially in accordance with what I have suggested to the ate of Canada which is also working on a new industrial design a. It is this:

, the expression 'design' means features of shape, pattern, ornaon, location of parts, or relationship of materials, colors, surface- combination of the foregoing, which, in a finished article, appeal dged by the senses, and other than as a useful invention under, ditionally thereto, and does not include any features of shape, pat- t, location of parts or relationship of material, colors, surface- r combination of the foregoing, which are dictated solely by the the article was made to perform."

gestion in connection with the design provisions of your bill, is der the inclusion of a claim or claims for industrial design patents ef form now used. As you know, the standard form of claim now patents is: The ornamental design, for a so-and-so (naming the) or the like, substantially as shown.

the important place that industrial design occupies in modern ld entitle industrial design patents to a more careful form of that. I would, therefore, recommend a claim or claims along egular utility-patent claims, except that such claims would be ther words structural, of necessity, since considerations of utility luded from design patents. I mean that you could not sensibly nal claim or claims for subject matter which had sensory appeal ral claims would, therefore, be the proper form to use in these

son for a claim or claims for design patents will, I think, be ut a definition of any sort the intending competitor is bound to s to how close he may come and how far he must stay away. y industrial designs which contain a structural idea of consider- originality, and infringement should not be allowed by the merest urse, I admit that you would have to use names for the things or urations in your structural claim or claims in design cases, but t pretty accurately by the names chosen, could be defined in the mewhat as I have described on pages 130 and 131 of my article ry's Journal of the Patent Office Society. There is not much uctural terms in a claim when clearly defined, even in patents

, I have recently designed a bed having these design features: ends with side curtains between them. It may or may not have top which can be drawn across or left rolled or drawn back olce, so that a complete enclosure or just a surrounding curtain ained. Now clearly, this idea had its origin in the big, four-poster ghteenth century. But my proposal is a very light and airy of those gloomy affairs, and could, I believe, be successfully e of the more exclusive furniture houses.

design patent which I shall obtain upon the idea will be highly the extent of protection I shall have upon the obvious variations hers after seeing it. Sufficient protection I can obtain perhaps everal design patents to cover the most likely modifications. My refore is that close variations of novel designs should be protect- of one patent having provision for a brief specification and a laims as in utility patents.

design-example I have just given serves to indicate my reason sion "or additionally thereto" in my proposed definition of a see, a bed like this with side curtains and an optional draw-top, oping like a roof, could be argued as subject matter for a utility rtains and top with their characteristics of enclosure and mova- inly things that function to some useful extent. Yet improved dly any place in my mind when thinking up the proposal. My aesthetic or sensory novelty, and it developed concurrently with angle I thought might fit in with it. So my definition of design to annul those utility patents which can be had for designs ental utility. After all, some might think this bed is better, an d in a sense more "useful" to them than an open bed. There

are many instances of a similar kind, and so this is something which I suggest be carefully kept in mind, although I am aware of those decisions in which the coexistence of a utility patent and a design patent have been held not mutually fatal as applied to the present patent statute.

This ends my testimony. Thank you, Mr. Chairman and gentlemen.

Mr. BRYSON. You understand we are especially anxious to give you every opportunity since you are here from our neighboring country up there.

We will stand in adjournment until tomorrow, Thursday, at 2 o'clock. The hearing is tentatively set for tomorrow at 2 o'clock. We will close now to definitely meet at 10 o'clock Friday morning, but if possible we will proceed tomorrow afternoon at 2 o'clock, and we will again meet on Friday.

Mr. ASHTON. When is it likely to be known definitely whether you will sit tomorrow afternoon?

Mr. BRYSON. Mr. Harris will try to keep in touch with the House.

(Thereupon, at 12:15 p. m., the subcommittee adjourned until tomorrow, Thursday, June 14, 1951, at 2 p. m.)

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