PROPOSED REVISION AND AMENDMENT OF THE PATENT LAWS

PRELIMINARY DRAFT
WITH NOTES



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FOREWORD

This preliminary draft of a proposed bill for a general revision and codification of the patent laws is issued by the subcommittee of the Committee on the Judiciary, having jurisdiction over patents and over revision of the laws, for the purpose of inviting suggestions, comments and criticisms relating to amending the patent laws. The draft presented is intended primarily to serve as a basis for the expression of opinions. Criticisms and suggestions for improvement of anything contained in the draft, and suggestions of additional proposals for consideration, as well as support for anything contained in the draft, are specially invited. All comments received before May 1, 1950, will be carefully considered for the preparation of a bill to be introduced on the subject.

While the present draft has been prepared for the Subcommittee, at its request and in accordance with its instructions, the draft is not intended to represent the Subcommittee's views and recommendations on any particular change in the patent laws. The subcommittee's views and recommendations will be formulated only after the opinions of the interested public have been received and considered.

JANUARY 10, 1950.

Jos. L. Bryson M. C.

Chairman, Subcommittee No. 4.

M851588

INTRODUCTION

The present patent laws consist of about 60 sections of the Revised Statutes of 1874, together with over 60 acts of Congress passed since that date revising various sections of the Revised Statutes or making new enactments not related to any section of the Revised Statutes. Since the sections of the Revised Statutes relating to patents were merely a compilation of the act of 1870, our present patent law which is set out in title 35 of the United States Code is essentially the act of 1870 with subsequent enactments.

The last general revision of the patent laws was the act of July 8, 1870, which was enacted as part of a program to revise and consolidate all the laws of the United States. In 1866 Congress passed a law providing for the revision and consolidation of the statutes of the United States. The commission which was appointed to perform this work prepared a preliminary draft of the part relating to patents and copyrights in 1868, and a second preliminary draft in 1869. In 1870, the statute relating to patents and copyrights as revised, simplified, arranged, and consolidated by the commission was reported to Congress, and at the same time referred to the Committee on Patents and a bill was introduced by the chairman a few days later. The object of the commission on revision of the laws was only to revise, arrange, and consolidate the statutes in force and the draft reported from the commission presumably was for this purpose only. The probable reason for referring the matter to the Committee on Patents was that during this same period there had been many suggestions for amending the patent laws in substance and it appears that the Committee on Patents studied the draft of the commission and changed it by various amendments on matters of substance. The bill thus introduced was enacted on July 8, 1870 (16 Stat. 198), and included the subjects of copyrights and trade-marks as well as patents.

When the Revised Statutes as in force on December 1, 1873, were enacted on June 22, 1874, the sections of the act of 1870 were distributed in various parts of the Revised Statutes. Certain sections were incorporated in Title 60, Patents, Trade-marks and Copyrights as sections 4883 to 4936, of Chapter I, Patents; other sections became sections 475 to 496 of Chapter 6, The Patent Office, in Title 11, Department of the Interior; a few sections were placed in other chapters, and a few sections were merged in broader provisions.

posed revision of the patent laws has the same
he last revision made in 1870. First, there is the
g, arranging, and consolidating the various acts
which have been enacted since 1874. The United
rst compiled and published in 1926, but the Code
s law but only prima facie evidence of the law.
the Judiciary, having jurisdiction over revision of
taken to revise and enact from time to time various
States Code. The recent enactment of Title 18,
al Procedure, and Title 28, Judiciary and Judicial
tes this work. The present proposed revision
f its objects the revision and enactment of Title 35,
spect of the work, the acts relating to patents are
lidated into a single enactment with revisions and
e in coordinating the various acts. In preparing
t, all the acts of Congress relating to or mentioning
e been passed since 1874 have been studied, and
ve not been specifically repealed have been used in
ion.

ct of the present draft is to present various amend-
e. In selecting the amendments the following
onsulted: (1) All the bills relating to patents which
ed in Congress since 1925, and some earlier bills,
earings and reports on these bills, (2) the reports
dvisory Board (1935), the Temporary National
ttee (1941) and the National Patent Planning
1944, 1945), (3) reports and recommendations of
as the American Bar Association, Patent, Trade-
nt Section, and (4) miscellaneous sources such as
egal periodicals, etc.

s included are of various kinds, some have had
in the past, some appear to be substantial improve-
t law, and some involve problems which the com-
investigate. In general, the amendments are so
draft that if desired they can be deleted without
mber of proposals are presented as separate addi-
d of being incorporated in the body of the draft.
amendments and proposals have been inserted in
ve merely as a starting point for discussion, these
n which the committee desires to hear expressions
items, the proposal for a single court of patent
roposal for copyright registration of designs have
uent presentation.

In this presentation of the preliminary draft of the proposed revision, the text of the existing acts are placed following the section of the revision which replaces them or to which they are most nearly related. In each instance the text of the original enactments are given and, where differences are found between them and the United States Code the enactments are followed, but references are included to the appropriate sections of the United States Code. This presentation makes the changes over existing law readily apparent and the notes also call attention to changes over existing law which are included.

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1. Establishment.
2. Seal.
3. Officers and employees.
4. Restrictions on officers and employees as to interest in patents.
5. Bond of Commissioner and other officers.
6. Duties of Commissioner.
7. Board of appeals.
8. Library.
9. Classification of patents.
10. Certified copies of records.
11. Disposition of old records.
12. Publications.
13. Exchange of copies of patents with foreign countries.
14. Copies of patents for public libraries.
15. Printing of papers filed.
16. Annual report to Congress.
17. Day for taking action falling on Sunday or holiday.
18. Agents and attorneys, rules and regulations for.
19. Agents and attorneys, suspension or exclusion from practice.
20. Patent agents and attorneys, unauthorized representation as practitioner.

CHAPTER 2. PATENTABILITY OF INVENTIONS

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22. Conditions for patentability; novelty and loss of right to patent.
23. Conditions for patentability; lack of invention.
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30. Models, specimens.
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34. Right of priority based on foreign application.
35. Date of continuing application.

pplications.
status of applications.
ertain inventions.
nce of invention.

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n of application.
jection.
osecuting application.
ie Board of Appeals.

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s.

witnesses.

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ourt of Customs and Patent Appeals.
ice of appeal.
ceedings on appeal.
ision on appeal.
to obtain patent.
in case of interference.

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e of patent.
ent to assignee.

patent.
ent.

AMENDMENT AND CORRECTION OF PATENTS

efective patents.
ct of reissue.
f invalid claims.
f correction of Patent Office mistake.
f correction of applicant's mistake.
f inventor.

OWNERSHIP, ASSIGNMENTS, AND LICENSES

ssignments.
hip.
ditions in contracts.
cense agreements.

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SECTION ANALYSIS

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clause.

ng effect.

ADDITIONAL ITEMS

or cancellation of patents.
licenses.
or minor patents.
ddition.
e or renewal fees.

UNITED STATES CODE

PROPOSED REVISION AND AMENDMENT

TITLE 35—PATENTS

CHAPTER 1. PATENT OFFICE

Sec.
1. Establishment.
2. Seal.
3. Officers and employees.
4. Restrictions on officers and employees as to interest in patents
5. Bond of Commissioner and other officers.
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8. Library.
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11. Disposition of old records.
12. Publications.
13. Exchange of copies of patents with foreign countries.
14. Copies of patents for public libraries.
15. Printing of papers filed.
16. Annual report to Congress.
17. Day for taking action falling on Sunday or holiday.
18. Agents and attorneys, rules and regulations for.
19. Agents and attorneys, suspension or exclusion from practice.
20. Patent agents and attorneys, unauthorized representation as practitioner.

§ 1. Establishment

There shall be in the Department of Commerce an office known as the Patent Office, where records, books, drawings, specifications, and other papers and things pertaining to patents and to trade-mark registrations shall be safely kept and preserved.

Present statute

Sec. 475, Revised Statutes of 1874 [35 U. S. C. 1]:

There shall be in the Department of the Interior [Commerce] an office known as the Patent-Office, where all records, books, models, drawings, specifications, and other papers and things pertaining to patents shall be safely kept and preserved.

The Patent Office was transferred from the Department of the Interior to the Department of Commerce by Executive Order No. 4175, signed March 17,

April 1, 1925, in accordance with the authority contained in the
y 14, 1903, establishing the Department of Commerce (sec. 12,
Some sections of the present law still refer to the Department

Note

d "all" is omitted since some old records are kept in the National
4 U. S. C. Chapter 8A.
rd "models" has been omitted to remove emphasis on models
no longer generally required. They are included by the word

ase "and to trade-mark registrations" is added. There is no
responding to this section in the trade-mark law. The original
Revised Statutes containing this section deals with the Patent
unctions and duties, and relates to trade-marks as well as patents.
y brought out in some of the corresponding sections of the present

rovided for the Patent Office before July 8, 1870 is the
Office, with which letters patent, certificates of trade-
ations, and papers issued from the Office shall be au-

Present statute

vised Statutes of 1874 [35 U. S. C. 3]:

retofore provided for the Patent-Office shall be the seal of the
hich letters-patent and papers issued from the Office shall be

Note

of trade-mark registrations" is added, see note under section 1

s and employees

ssioner of Patents, two assistant commissioners, and
iners-in-chief, shall be appointed by the President, by
ne advice and consent of the Senate. The assistant
rs shall perform the duties pertaining to the office of
r assigned to them by the Commissioner. The ex-
hief shall serve as members of the Board of Appeals
rform duties of a comparable nature pertaining to the
missioner assigned to them by the Commissioner. The
nmissioner, senior in appointment, shall fill the office of
er of Patents during a vacancy in that office until a
er of Patents is appointed and takes office. All other
ks, and employees authorized by law for the office shall
d by the Secretary of Commerce upon the nomination
nissioner of Patents in accordance with law.

Present statute

Sec. 476, Revised Statutes of 1874, amended (1) Feb. 15, 1916, sec. 1, ch. 22, 39 Stat. 8, (2) Feb. 14, 1927, sec. 1, ch. 139, 44 Stat. 1098, (3) Apr. 11, 1930, sec. 1, ch. 132, 46 Stat. 155 [35 U. S. C. 2]:

There shall be in the Patent Office a Commissioner of Patents, one first assistant commissioner, two assistant commissioners, and nine examiners in chief, who shall be appointed by the President, by and with the advice and consent of the Senate. The first assistant commissioner and the assistant commissioners shall perform such duties pertaining to the office of commissioner as may be assigned to them, respectively, from time to time by the Commissioner of Patents. All other officers, clerks, and employees authorized by law for the office shall be appointed by the Secretary of Commerce upon the nomination of the Commissioner of Patents, in accordance with existing law.

Note

(1) The revision of this section, increasing the number of examiners-in-chief from nine to twelve and eliminating an assistant commissioner, proposed by the bill, S. 2328, 81st Congress, which has passed the Senate, is followed.

(2) The temporary designation of an assistant commissioner as commissioner is added. This is essential to eliminate complications resulting from a vacancy in office, present applicable general statutes (5 U. S. C. 7) permitting a vacancy to be temporarily filled for not more than 30 days.

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

All officers and employees of the Patent Office shall be incapable, during the period for which they hold their appointments and one year thereafter, of applying for a patent and of acquiring, except by inheritance or bequest, any patent or any right or interest in any patent, issued or to be issued by the Office.

Present statute

Sec. 480, Revised Statutes of 1874 [35 U. S. C. 4]:

All officers and employees of the Patent-Office shall be incapable, during the period for which they hold their appointments, to acquire or take, directly or indirectly, except by inheritance or bequest, any right or interest in any patent issued by the Office.

Note

(1) The language is revised and inability to apply for a patent, included in the original language, is made explicit.

(2) The period of disability is increased to include one year after leaving the Office.

§ 5. Bond of commissioner and other officers

The Commissioner of Patents and such other officers as he designates, before entering upon their duties, shall severally give bond, with sureties, the former in the sum of $25,000, and the latter in sums prescribed by the Commissioner, conditioned for the faithful discharge of their respective duties, and that they shall render to the proper officers of the Treasury a true account of all money received by virtue of their offices.

Present statute

evised Statutes of 1874 [35 U. S. C. 5]:

issioner of Patents and the chief clerk, before entering upon their severally give bond, with sureties, to the Treasurer of the United rmer in the sum of ten thousand dollars, and the latter in the sum nd dollars, conditioned for the faithful discharge of their respective at they shall render to the proper officers of the Treasury a true money received by virtue of their offices.

Notes

mention of the office of chief clerk is omitted, the officers requiring e amounts of the bonds, to be designated by the Commissioner.
ount of the bond of the Commissioner is changed.

of commissioner

missioner of Patents, under the direction of the Secretary ce, shall superintend or perform all duties respecting the d issuing of patents directed by law; and he shall have ngs belonging to the Patent Office. He may, subject to the the Secretary of Commerce, from time to time establish egulations, not inconsistent with law, for the conduct of in the Patent Office.

Present statute

evised Statutes of 1874 [35 U. S. C. 6]:

issioner of Patents, under the direction of the Secretary of the merce], shall superintend or perform all duties respecting the grant- g of patents directed by law; and he shall have charge of all books, s, models, machines, and other things belonging to the Patent Office.

evised Statutes of 1874 [35 U. S. C. 6]:

issioner of Patents, subject to the approval of the Secretary of the merce], may from time to time establish regulations, not inconsistent the conduct of proceedings in the Patent Office.

Note

tions are combined into one with some changes in language.

l of Appeals

iners-in-chief shall be persons of competent legal knowl- scientific ability. The Commissioner of Patents, the mmissioners, and the examiners-in-chief shall constitute appeals, which, on written petition of the appellant, shall determine the validity of the adverse decisions of ex- on applications for patents and for reissues of patents. l shall be heard by at least three members of the Board the members hearing such appeal to be designated by ssioner. The Board of Appeals has sole power to grant

Present statute

Sec. 482, Revised Statutes of 1874, amended (1) Mar. 2, 1927, sec. 3, ch. 273, 44 Stat. 1335, (2) Apr. 11, 1930, sec. 2, ch. 132, 46 Stat. 155 [35 U. S. C. 7]:

The examiners in chief shall be persons of competent legal knowledge and scientific ability. The Commissioner of Patents, the first assistant commissioner, the assistant commissioners, and the examiners in chief shall constitute a board of appeals, whose duty it shall be, on written petition of the appellant, to review and determine upon the validity of the adverse decisions of examiners upon applications for patents and for reissues of patents and in interference cases. Each appeal shall be heard by at least three members of the board of appeals, the members hearing such appeal to be designated by the Commissioner. The board of appeals shall have sole power to grant rehearings.

Note

Some change in language has been made and the reference to interferences which are no longer considered by the Board of Appeals, has been deleted.

§ 8. Library

A library of scientific and other works and periodicals, both foreign and domestic, shall be maintained in the Patent Office to aid the officers in the discharge of their duties.

Present statute

Sec. 486, Revised Statutes of 1874 [35 U. S. C. 10]:

There shall be purchased for the use of the Patent-Office a library of such scientific works and periodicals, both foreign and American, as may aid the officers in the discharge of their duties, not exceeding the amount annually appropriated for that purpose.

Note

Some change in language has been made. "Purchased" is changed to "maintained" to include the existing library and keeping it up by additions. The phrase "and other" is added to include legal works. The last phrase is omitted as unnecessary.

§ 9. Classification of patents

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

Present statute

Sec. 1, Act of June 10, 1898, ch. 430, 30 Stat. 440 [35 U. S. C. 6 note]:

That for the purpose of determining with more readiness and accuracy the novelty of inventions for which applications for letters patent are or may be filed in the United States Patent Office, and to prevent the issuance of letters patent of the United States for inventions which are not new, the Commissioner of Patents is hereby authorized and directed to revise and perfect the classification, by subjects-matter, of all letters patent and printed publications in the United States Patent Office which constitute the field of search in the examination

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y of invention for which applications for patents are or may be

Note

nguage are made, but no change in the actual practice in the

ed copies of records

ssioner may furnish certified copies of specifications and atents issued by the Patent Office, and of other records ne public or to the person applying, upon payment of ncertified copies and the fee for each certification.

Present statute

appropriation act of Mar. 3, 1891, ch. 541, 26 Stat. 908, 940

copies of such drawings and specifications may be furnished by er of Patents to persons applying therefor upon payment of the uncertified copies, and twenty-five cents additional for each

Note

ther records is added. The fee for certification is omitted as it ble of fees.

ition of old records

ssioner of Patents may destroy or otherwise dispose of papers of abandoned applications which have been on an 20 years.

Present statute

Apr. 11, 1930, ch. 132, 46 Stat. 156 [35 U. S. C. 23]:

oner of Patents is authorized to annually destroy or otherwise files and papers belonging to all abandoned applications which for more than twenty years.

Note

been changed.

ations

issioner of Patents may print, or cause to be printed,

for inventions and designs, including specifications and ether with copies of the same. The headings of the patents may be multigraphed in the Patent Office for photolithography.

ates of trade-mark registrations, including statements together with copies of the same.

(c) The Official Gazette of the United States Patent Office, copies of which, and of the following publications, may be exchanged for publications desirable for the use of the Patent Office.

(d) Annual indexes of patents and patentees, and of trade-marks and registrants.

(e) Annual volumes of decisions of the Commissioner of Patents and of the United States courts in patent and trade-mark cases.

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

Present statute

Sec. 489, Revised Statutes of 1874 [35 U. S. C. 13]:

The *Commissioner of Patents may print*, or cause to be *printed*, copies of the claims of current issues, and copies of such laws, decisions, regulations, and circulars as may be necessary for the information of the public.

Sec. 301 (part), appropriation act of July 9, 1947, ch. 211, 61 Stat. 299, repeated in prior and subsequent appropriation acts [35 U. S. C. 16]:

Headings of the drawings for patented cases may be multigraphed in the Patent Office for the purpose of photolithography.

Note

Sec. 489 R. S. is amplified to include the substance of 44 U. S. C. 283 and to incorporate the provision appearing in the appropriation acts.

§ 13. Exchange of copies of patents with foreign countries

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

Present statute

Act of Jan. 14, 1915, 38 Stat. 1221 [35 U. S. C. 15]:

That the Commissioner of Patents of the United States be, and he is hereby, authorized to exchange with the Dominion of Canada, under such terms of contract as may by him be deemed practicable, printed copies of patents now in the United States Patent Office and hereafter issued by the United States.

Sec. 9, proviso in, Act of Feb. 18, 1922, ch. 58, 42 Stat. 393 [35 U. S. C. 78, part]:

The Commissioner of Patents may exchange copies of United States patents for those of foreign countries.

Note

The first act applies to Canada only, the second to any country; these are consolidated in one section and specific reference to one country is not necessary.

§ 14. Copies of patents for public libraries

The Commissioner of Patents may supply printed copies of specifications and drawings of patents to public libraries in the United States which he may approve and which shall maintain such copies for the use of the public, at the rate for each year's issue established for this purpose.

Present statute

4934 of the Revised Statutes introduced by Act of February 18, 88, 42 Stat. 389, 393 [35 U. S. C. 78]:

he Commissioner of Patents may supply public libraries of the th such copies as published, for $50 per annum.

Note

ow in the schedule of fees is made a separate section and the ged to incorporate the object of S. 1739, 81st Congress, passed

g of papers filed

ssioner may require papers filed in the Patent Office to typewritten.

Present statute

sed Statutes of 1874 [35 U. S. C. 12]:

oner of Patents may require all papers filed in the Patent-Office, legibly, and clearly written, to be printed at the cost of the .

Note

is changed and "or typewritten" is added after "printed."

l report to Congress

issioner of Patents shall lay before Congress annually ng a statement of moneys received and expended, erning the work of the Office, and such other informa- dition of the Office as may be useful to Congress or the

Present statute

sed Statutes of 1874 [35 U. S. C. 20]:

ioner of Patents shall lay before Congress, in the month of dy, a report, giving a detailed statement of all moneys received opies of records or drawings, or from any other source whatever; ment of all expenditures for contingent and miscellaneous ex- all patents which were granted during the preceding year, desig- oper heads the subjects of such patents; an alphabetical list of , with their places of residence; a list of all patents which have uring the year; and such other information of the condition of e as may be useful to Congress or the public.

Note

as been shortened. The lists referred to, and which are omitted l section, are the indexes provided for in section 12 (d). The l. The report contemplated by Sec. 494 has been discontinued authority of 44 U. S. C. 212.

taking action falling on Sunday or holiday

day, or the last day, for taking any action or paying United States Patent Office falls on Sunday, or on a

holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding secular or business day.

Present statute

Sec. 14, Act of Mar. 2, 1927, ch. 273, 44 Stat. 1337 [35 U. S. C. 21]:

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

Note

"Fixed by statute" is omitted as unnecessary.

§ 18. Agents and attorneys, rules and regulations for

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

Present statute

See after section 19.

§ 19. Agents and attorneys, suspension or exclusion from practice

The Commissioner of Patents may, after notice and opportunity for a hearing, suspend or exclude, either generally or in any particular case, from further practice before the Patent Office any person, agent, or attorney shown to be incompetent or disreputable, or guilty of gross misconduct, or who refuses to comply with the rules and regulations established under section 18 of this title, or who shall, with intent to defraud in any manner, deceive, mislead, or threaten any applicant or prospective applicant, or other person having immediate or prospective business before the Office. The reasons for any such suspension or exclusion shall be duly recorded. The action of the Commissioner may be reviewed upon the petition of the person so refused recognition or so suspended or excluded by the United States District Court for the District of Columbia under such conditions and upon such proceedings as the said court may by its rules determine.

Present statute

ised Statutes of 1874, amended Feb. 18, 1922, sec. 3, ch. 58, 42 S. C. 11]:

sioner of Patents, subject to the approval of the Secretary of y prescribe rules and regulations governing the recognition of rs, or other persons representing applicants or other parties before may require of such persons, agents, or attorneys, before being presentatives of applicants or other persons, that they shall show f good moral character and in good repute, are possessed of the fications to enable them to render to applicants or other persons e, and are likewise competent to advise and assist applicants or n the presentation or prosecution of their applications or other the Office. The Commissioner of Patents may, after notice and a hearing, suspend or exclude, either generally or in any particu- further practice before his office any person, agent, or attorney competent or disreputable, or guilty of gross misconduct, or who ly with the said rules and regulations, or who shall, with intent ny manner, deceive, mislead, or threaten any applicant or pros- t, or other person having immediate or prospective business before ord, circular, letter, or by advertising. The reasons for any such xclusion shall be duly recorded. The action of the commissioner ed upon the petition of the person so refused recognition or so cluded by the district court of the United States for the District der such conditions and upon such proceedings as the said court s determine.

Note

tatute is divided into two sections and, in the second section, the rd, circular, letter, or by advertising", is omitted as unnecessary o misinterpretation.

t agents and attorneys, unauthorized representation practitioner

not being recognized to practice, or having withdrawn or d or excluded from practice, before the Patent Office, out or permits himself to be held out as authorized to plicants for patent in their business before the Patent e fined not more than $500.

Present statute

, 1938, ch. 188, 52 Stat. 342 [35 U. S. C. 11a]:

lawful for any person who has not been duly recognized to prac- United States Patent Office in accordance with the provisions of the Revised Statutes and the rules of the Patent Office to hold knowingly permit himself to be held out as a patent solicitor, r patent attorney, or otherwise in any manner hold himself out, or indirectly, as authorized to represent applicants for patent in before the Patent Office, and it shall be unlawful for any person the authority of section 487 of the Revised Statutes been dis- ded from practice before the Patent Office, and has not been old himself out in any manner whatever as entitled to represent s in the transaction of business before the Patent Office or any f; and any offense against the foregoing provision shall be a nd be punished by a fine of not less than $50 and not exceeding

Note

has been simplified.

CHAPTER 2. PATENTABILITY OF INVENTIONS

Sec.
21. Inventions patentable.
22. Conditions for patentability; novelty and loss of right to patent.
23. Conditions for patentability; lack of invention.
24. Undisclosed prior knowledge or use.
25. Limitation on proof of date of invention.
26. Invention made abroad.

§ 21. Inventions patentable

Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor upon making application for a patent, subject to the conditions and requirements of this title.

Discoveries, as well as inventions, may be patented, if the discovery can be expressed in terms of or embodied in a new and useful art, machine, manufacture or composition of matter, or improvement thereof, and the term invention when used in this title includes such discovery.

Present statute

Sec. 4886, Revised Statutes of 1874, amended (1) Mar. 3, 1897, sec. 1, ch. 391, 29 Stat. 692, (2) May 23, 1930, sec. 1, ch. 312, 46 Stat. 376, (3) Aug. 5, 1939, sec. 1, ch. 450, 53 Stat. 1212 [35 U. S. C. 31]:

Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor.

Note

(1) Sec. 4886 is split into two sections, section 21 relating to the subject matter for which patents may be obtained, and section 22 relating to the conditions under which a patent may be obtained.

(2) The first paragraph of section 21 follows the exact wording of R. S. 4886 as to the subject matter for patents, except that reference to plant patents has been omitted for incorporation in section 89.

(3) The second paragraph of section 21 is added to emphasize the fact that discoveries can be patented in certain instances, and to lay a basis for avoiding

vention or discovery" and the like throughout the remainder of

tions for patentability. Novelty and loss of right to ent

ion shall not be considered new or capable of being

vention was known or used by others in this country, or described in any printed publication in this or any for- before the invention thereof by the applicant for patent,

vention was patented or described in any printed pub- is or any foreign country or in public use or on public ountry, more than one year prior to the date of the appli- tent in the United States, or if

ention is proved to have been abandoned, or if

vention was first patented or caused to be patented by or his legal representatives or assigns in a foreign country late of the application for patent in this country.

Present statute

vised Statutes of 1874; text is given following section 21.

st paragraph), Revised Statutes of 1874, amended (1) Mar. 3, 1897, 29 Stat. 692, 693, (2) Mar. 3, 1903, sec. 1, ch. 1 019, 32 Stat. 1225, 19, 1936, ch. 594, 49 Stat. 1529 [35 U. S. C. 32]:

herwise entitled thereto shall be debarred from receiving a patent n or discovery, nor shall any patent be declared invalid by reason een first patented or caused to be patented by the inventor or his atives or assigns in a foreign country, unless the application for tent was filed more than twelve months, in cases within the pro- n 4886 of the Revised Statutes, and six months in cases of designs, g of the application in this country, in which case no patent shall his country.

Note

ditions for patentability are paragraphed and lettered. Para- and (c) are the same as the corresponding provisions in R. S. rst clause of paragraph (a) is qualified by Section 24 and "public" ed before sale in paragraph (b).

h (d) is a revision of the first paragraph of R. S. 4887. Substan- e introduced, see H. R. 9388, 76th Congress, hearings May 1940, , 79th Congress.

tions for patentability, lack of invention

nay not be obtained though the invention is not identi- d or described in the material specified in section 22 of he differences between the subject matter sought to be l said material are such that the subject matter as a be obvious to an ordinary person skilled in the art.

Patentability as to this condition shall be determined by the nature of the contribution to the advancement of the art, and not by the nature of the mental processes by which such contribution may have been accomplished.

Note

There is no provision corresponding to the first paragraph explicitly stated in the present statutes, but the refusal of patents by the Patent Office, and the holding of patents invalid by the courts, on the ground of lack of invention has been followed since at least as early as 1850. This paragraph is added for two reasons, first, a specific statement in the statute might have some stabilizing effect, and second, it serves as a basis for the addition of a provision defining or setting a standard of invention if such addition were considered desirable or necessary.

The second paragraph brings up recent proposals relating to an objective standard of invention, see 79th Congress, H. R. 3694; 80th Congress, H. R. 4061 and 5428, hearings, May 1948; 81st Congress, H. R. 4798, hearings, June, 1949.

§ 24. Undisclosed prior knowledge or use

Whenever it appears that an applicant for patent, at the time of making his application, believed himself to be the original and first inventor of the thing patented, the same shall not be refused, or if granted, held to be void, solely on account of the invention having been known or used by some other person, before his invention thereof (without having been patented or described in a printed publication or in public use or on sale, as specified in section 22a and b of this title), unless

(a) it was disclosed or used in the United States by such other person in such manner that it had become available to the public, or described in a printed publication, before the date of the application for patent, or

(b) it was described in a patent granted on an application filed in the United States before the invention thereof by the aforementioned applicant, or

(c) it was patented in the United States.

Present statute

Sec. 4923, Revised Statutes of 1874 [35 U. S. C. 72]:

Whenever it appears that a patentee, at the time of making his application for the patent, believed himself to be the original and first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country, before this invention or discovery thereof, if it had not been patented or described in a printed publication.

Note

Section 4923 is probably wholly unnecessary in view of sections 22a and 26. The above section is practically entirely new and enacts rules announced by the

in Milburn *v.* Davis-Bournonville, 270 U. S. 390 and other

ation on proof of date of invention

ngs in the Patent Office and the courts an applicant for entee may not establish, or if established, shall not be , a date of making his invention earlier than two years te of his application for patent in the United States.

Note

s new to the law and proposes a new principle of limitations with ions of priority of invention. See 72d Congress, H. R. 7237, 10156, hearings March 1932, H. R. 11019, reported May 3, 1932, , and 73d Congress, H. R. 6012.

tion made abroad

ngs in the Patent Office and in the courts, an applicant or a patentee, may not establish a date of invention by knowledge or use thereof, or other activity with respect oreign country, other than the filing in a foreign country tion for a patent for the same invention which is en- the same force and effect as if filed in the United States n which it was filed in such foreign country.

Present statute

act of Aug. 8, 1946, ch. 910, 60 Stat. 943 [35 U. S. C. 109]:

gs in the Patent Office and in the courts of the United States an patent for an invention, discovery, or a design, or a patentee, mitted to establish the date of invention or discovery by reference use thereof, or other activity with respect thereto, in a country United States, other than the filing in a foreign country of an a patent for the same invention, discovery, or design which, in n and subject to the provisions of section 4887 of the Revised ended, or in accordance with and subject to the provisions of itled to have the same force and effect as it would have had if ed States on the date on which it was filed in such foreign country.

Note

s been changed.

CHAPTER 3. APPLICATION FOR PATENT

Sec.
27. Application for patent.
28. Specification.
29. Drawings.
30. Models, specimens.
31. Oath of applicant.
32. Joint inventors.
33. Death or insanity of inventor.
34. Right of priority based on foreign application.
35. Date of continuing application.
36. Divisional applications.
37. Confidential status of applications.
38. Secrecy of certain inventions.
39. Filing evidence of invention.

§ 27. Application for patent

Application for patent shall be made in writing to the Commissioner of Patents. Such application shall include: (1) a specification as prescribed by section 28 of this title; (2) a drawing as prescribed by section 29 of this title; (3) an oath by the applicant as prescribed by section 31 of this title. The application must be signed by the applicant and accompanied by the fee required by law.

Present statute

Sec. 4888, Revised Statutes of 1874, amended (1) Mar. 3, 1915, sec. 1, ch. 94, 38 Stat. 958, (2) May 23, 1930, sec. 2, ch. 312, 46 Stat. 376 [35 U. S. C. 33]:

Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has comtemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor. No plant patent shall be declared invalid on the ground of noncompliance with this section if the description is made as complete as is reasonably possible.

Note

(1) R. S. 4888 is divided into an introductory section relating to the application generally (this section), and a section on the specification (section 28).

(2) The requirement for signature is placed in this general section so as to insure that only one signature will suffice.

ion

on shall contain a written description of the inven-
manner and process of making, constructing, com-
sing it, in such full, clear, concise, and exact terms
person skilled in the art or science to which it apper-
ich it is most nearly connected, to make, construct,
use the same, and shall set forth the best mode
ventor of carrying out his invention.
on shall conclude with a claim particularly pointing
y claiming the subject matter which the applicant
vention, determining the scope of the invention.
aim may be presented.

Present statute

d Statutes of 1874, amended (1) Mar. 3, 1915, sec. 1, ch. 94,
Iay 23, 1930, sec. 2, ch. 312, 46 Stat. 376 [35 U. S. C. 33].
7.

Note

relating to signature of the specification is omitted in view
rement for a signature in section 27.
ence is omitted for inclusion in the chapter relating to plant

ating to machines is omitted as unnecessary and the require-
ode of carrying out the invention is stated as generally appli-
f inventions (see R. S. 4921, first defense).
elating to the claim is made a separate paragraph and the

ure of the case admits of drawings, the applicant
copy signed by the inventor or his attorney in fact,
king his application.

Present statute

d Statutes of 1874, amended Mar. 3, 1915, sec. 2, ch. 94, 38
. S. C. 34]:

of the case admits of drawings, the applicant shall furnish
the inventor or his attorney in fact, which shall be filed in
and a copy of the drawing to be furnished by the Patent
ched to the patent as a part of the specification.

Note

ge effects no change in practice, the omitted clause is redun-

pecimens

ure of the case admits of representation by model,
r 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 substance or composition of matter, the Commissioner may require the applicant to furnish specimens or ingredients for the purpose of inspection or experiment.

Present statute

Sec. 4891, Revised Statutes of 1874 [35 U. S. C. 34]:

In all cases which admit of representation by model, the applicant, if required by the Commissioner, shall furnish a model of convenient size to exhibit advantageously the several parts of his invention or discovery.

Sec. 4890, Revised Statutes of 1874 [35 U. S. C. 34]:

When the invention or discovery is of a composition of matter, the applicant, if required by the Commissioner, shall furnish specimens of ingredients and of the composition, sufficient in quantity for the purpose of experiment.

Note

(1) The two old sections are combined in one section.
(2) The change in language in the second paragraph broadens the requirement.

§ 31. Oath of applicant

The applicant shall make oath that he believes himself to be the original and first inventor of the art, machine, manufacture, composition, or improvement, for which he solicits a patent and that he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular officer of the United States authorized to administer oaths, or before any notary public, judge, or magistrate 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 shall be valid if it complies with the laws of the state or country where made.

The Commissioner of Patents may require the submission under oath of statements of facts relevant to the patentability of the invention or to the examination or other proceedings in the Patent Office.

Present statute

Sec. 4892, Revised Statutes of 1874, amended (1) Mar. 3, 1903, sec. 2, ch. 1019, 32 Stat. 1225, 1226, (2) May 23, 1930, sec. 3, ch. 312, 46 Stat. 376 [35 U. S. C. 35]:

The applicant shall make oath that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement, or of the variety of plant, for which he solicits a patent; that he does not know and does not believe that the same was ever before known

tate of what country he is a citizen. Such oath may be made ithin the United States authorized by law to administer oaths, ant resides in a foreign country, before any minister, charge l holding commission under the Government of the United y notary public, judge, or magistrate having any official seal dminister oaths in the foreign country in which the applicant ority shall be proved by certificate of a diplomatic or consular l States.

Note

on at the end of the first paragraph is added to avoid applica- of Columbia law to oaths taken outside the District.
is added to bring out the fact that the Commissioner requires her statements under oath.

entors

ntion is made by two or more persons jointly, they atent jointly and each sign the application and make ı, except as otherwise provided in this title.
joint inventors refuses to join in the application for reabouts cannot be ascertained after diligent inquiry, ıay be made by the other inventor on behalf of him- mentioned inventor, and a patent may be granted making the application or his assigns, on proof satis- Commissioner and notification to the joint inventor fused to join, the patent to be held in trust as to the mitted inventor. The omitted inventor may join ı when found, and the Commissioner may refuse to unless any dispute between the joint inventors is mitted inventor joins in the application.
erson was joined in an application for patent as joint r, or a joint inventor was not included in an applica- d such error arose through inadvertence or mistake fraudulent or deceptive intention, the Commissioner application to be amended, under such terms and may prescribe.

Note

ph represents present law, and the part of the last paragraph n of an erroneously joined inventor is in the Patent Office der is new. This section is ancillary to Section 63.

insanity of inventor

rson who has made an invention for which a patent dies before applying for a patent, his executor or ıy apply for and obtain the patent, in trust for the ıe deceased, in case he shall have died intestate, or if t a will disposing of the same, then in trust for the itled thereto, on the same terms and conditions

applicable to the inventor. If there be neither executor nor administrator, then the application may be made by the heirs of the deceased inventor.

When any person who has made an invention for which a patent may be granted becomes insane before applying for a patent, his legally appointed guardian, conservator, or representative may apply for and obtain the patent, in trust for his estate, on the same terms and conditions applicable to the inventor.

Proof of the authority of the person applying in place of the inventor shall be filed (in the case of a foreign executor or administrator or other above authorized representative, such authority to be proved by certificate of a diplomatic or consular officer of the United States), and the oath or affirmation required to be made shall be so varied in form that it can be made by him.

Present statute

Sec. 4896, Revised Statutes of 1874, amended (1) Feb. 28, 1899, ch. 227, 30 Stat. 915, (2) Mar. 3, 1903, sec. 3, ch. 1019, 32 Stat. 1225, 1226–7, (3) May 23, 1908, ch. 188, 35 Stat. 245 [35 U. S. C. 46]:

When any person, having made any new invention or discovery for which a patent might have been granted, dies before a patent is granted the right of applying for and obtaining the patent shall devolve on his executor or administrator, in trust for the heirs at law of the deceased, in case he shall have died intestate; or if he shall have left a will disposing of the same, then in trust for his devisees in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him in his lifetime; and when any person having made any new invention or discovery for which a patent might have been granted becomes insane before a patent is granted the right of applying for and obtaining the patent shall devolve on his legally appointed guardian, conservator, or representative in trust for his estate in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him while sane; and when the application is made by such legal representatives the oath or affirmation required to be made shall be so varied in form that it can be made by them. The executor or administrator duly authorized under the law of any foreign country to administer upon the estate of the deceased inventor shall, in case the said inventor was not domiciled in the United States at the time of his death, have the right to apply for and obtain the patent. The authority of such foreign executor or administrator shall be proved by certificate of a diplomatic or consular officer of the United States.

The foregoing section, as to insane persons, is to cover all applications now on file in the Patent Office or which may be hereafter made.

Note

(1) Some changes in language are made and the various provisions of the original statute are rearranged and restricted to death or insanity before applying for patent.

(2) A provision relating to heirs is added.

§ 34. Right of priority based on foreign application

An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same

reign country which, by treaty, convention, or law, rivileges in the case of applications filed in the to citizens of the United States, shall have the same as the same application would have if filed in this ate on which the application for patent for the same t filed in such foreign country, provided the applica- try is filed within twelve months from the earliest y such foreign application was filed. But no patent n any application for patent for an invention which ed or described in a printed publication in this or ry more than one year before the date of the actual ication in this country, or which had been in public this country for more than one year prior to such

or patent shall be entitled to the right of priority n application as provided for by the preceding para- im for such right of priority and a copy of the origi- cation (with the specification and drawings if any) based, certified as correct by the patent office of the filed (which certificate shall also show the date of nd of the filing of the specification and other papers rom), are filed in the Patent Office before the patent ore such time during the pendency of the application, six months after the filing of the application in this be required by the Commissioner. The Commis- ire a translation of the papers filed if not in the and such other information as he may deem

Present statute

paragraph, Revised Statutes of 1874, amended (1) Mar. 3. 9, 32 Stat. 1225, 1226, (2) June 19, 1936, ch. 594, 49 Stat, 39, sec. 1, ch. 450, 53 Stat. 1212 [35 U. S. C. 32]:

r patent for an invention or discovery or for a design filed in person who has previously regularly filed an application for e invention, discovery, or design in a foreign country which, n, or law, affords similar privileges to citizens of the United e same force and effect as the same application would have if on the date on which the application for patent for the same , or design was first filed in such foreign country: *Provided*, in this country is filed within twelve months in cases within ction 4886 of the Revised Statutes, and within six months from the earliest date on which any such foreign application patent shall be granted on any application for patent for an ery or a design which had been patented or described in a in this or any foreign country more than one year before the ling of the application in this country, or which had been in e in this country for more than one year prior to such filing.

Note

(1) The first paragraph is the same as the present law with changes in language. The references to designs have been removed for inclusion in another section and the opening clause has been modified to accord with actual practice and the requirements of the International Convention for the Protection of Industrial Property.

(2) A paragraph is added making an additional requirement for obtaining the right of priority.

§ 35. Date of continuing application

An application for patent for an invention disclosed in the manner required by section 28 of this title in an application previously filed in the United States by the same inventor shall have the same effect as though filed on the date of the prior application, if the later application is filed before the prior application is patented or abandoned, or proceedings thereon terminated, and if the applicant claims the benefit of the filing date of the prior application in said later application. The term of the patent granted on said later application shall not extend beyond the date of expiration of the patent if any, which may be granted on the earlier application.

Note

This section represents present law except for two added conditions, the requirement that the benefit of the first application must be claimed in the second, and the curtailment of the term of the patent granted on the second application when it issues later than a patent on the first application.

§ 36. Divisional applications

If two or more independent or distinct inventions are claimed in one application, the Commissioner may in his discretion require the application to be restricted to one of the inventions; and the other invention or inventions may be made the subject of one or more divisional applications. A divisional application shall be entitled to the benefit of the filing date of the original application if it complies with the requirements of section 35 of this title, and in such event shall also be subject to the restriction in term specified in section 35 of this title. If two or more patents are issued in consequence of a requirement for restriction under this section, no claim of any of said patents may be held invalid solely by reason of its inclusion in a separate patent. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, signing and execution by the inventor may be dispensed with.

Note

This section enacts the law with respect to division, at the same time introducing a number of changes. Division is made discretionary with the Commissioner, hence there will be no appeal to the court. The requirements and

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on 35 are made applicable. Neither of the resulting patents
d over the other merely because of their being divided in
n some cases a divisional application may be filed by the
ting to a limited extent prior legislative proposals: 72d
H. R. 7237, H. R. 10152, hearings March 1932, H. R. 11018,
32, H. Report 1202; 73d Congress, H. R. 6011; 76th Congress,
R. 9386, hearings May 1940; 77th Congress, H. R. 3212.

tial status of applications

or patents shall be kept in confidence by the Patent
ormation concerning the same given without author-
ant or owner unless necessary to carry out the pro-
any other law or in such special circumstances as
ed by the Commissioner.

cations for patents may be printed and published
oner, at the request and at the expense of the appli-
When so published, such applications shall have the
issued patent for the purposes of section 24 of this

Note

ph enacts the Patent Office rule of secrecy of applications.
ph is new.

f certain inventions

the publication or disclosure of an invention by the
tent, within categories prescribed by the President
nion of the Commissioner of Patents, be detrimental
ecurity, he shall make the application for patent in
ntion is disclosed available for inspection to the
Commission, the Secretary of the Army, the Secre-
y, the Secretary of the Air Force, and the chief
er department or agency of the Government desig-
sident as a defense agency of the United States. If
f such department or agency, the publication or
h invention by the granting of a patent therefor
ental to the national security, the Commissioner of
ing so notified, shall order that such invention be
nall withhold the grant of a patent therefor for such
as the national interest requires. The owner of a
n which has been placed under such a secrecy order
to appeal from such order to such department or
such rules as may be prescribed by the President.
ll be ordered kept secret and the grant of a patent

withheld for a period of more than one year in any one order but the Commissioner of Patents shall renew any such order at the end thereof, or at the end of any renewal period, for additional periods of one year upon notification by the head of the department or the chief officer of the agency who caused the order to be issued that an affirmative determination has been made that the national interest continues so to require, excepting, however, that any such order in effect, or issued, during a time when the United States is at war, shall be and remain in effect for the duration of the war unless sooner specifically rescinded. The Commissioner of Patents is authorized to rescind any order upon notification by the heads of all departments and the chief officers of all agencies who caused the order to be issued that the publication or disclosure of the invention is no longer deemed to be detrimental to the national security.

(b) The invention disclosed in an application for patent subject to an order made pursuant to paragraph (a) hereof shall be held abandoned upon its being established before or by the Commissioner of Patents that in violation of said order said invention has been published or disclosed or that an application for a patent therefor has been filed in a foreign country by the inventor, his successors, assigns, or legal representatives, or anyone in privity with him or them, without the consent or approval of the Commissioner of Patents, and such abandonment shall be held to have occurred as of the time of such violation. In no case shall the consent or approval of the Commissioner of Patents be given without the concurrence of the heads of all departments and the chief officers of all agencies who caused the order to be issued. Any such holding of abandonment shall constitute forfeiture by the applicant, his successors, assigns, or legal representatives, or anyone in privity with him or them, of all claims against the United States based upon such invention.

(c) Any applicant, his successors, assigns, or legal representatives, whose patent is withheld as herein provided, shall, if the order of the Commissioner of Patents above referred to shall have been faithfully obeyed, have the right, during a period beginning at the date the applicant is notified that, except for such order, his application is otherwise in condition for allowance, or beginning at the effective date of this Act, whichever is later, and ending two years after the date a patent is issued on such application, to apply for compensation based upon the use, if any, of the invention by the Government, such right to compensation to begin from the date of the first use of the invention by the Government. The head of any department or agency who caused the order to be issued is authorized, if any such claim is presented within the periods above specified, to enter into an agreement

nt, his successors, assigns, or legal representatives,
and compromise for such use, if any, and any such
nent entered into shall be final and conclusive for all
standing any other provision of law to the contrary.
se and settlement of any such claim cannot be
of any department or agency who caused the order
, in his discretion, administratively award and pay
, his successors, assigns, or legal representatives, a
g 75 per centum of the maximum sum if any, which
he head of such department or agency would consti-
compensation for such use, if any. Within two
ce of the patent, any claimant who fails to secure an
y to him shall have the right to bring suit against
s in the Court of Claims for such amount which,
ch award, if any, shall constitute fair and just com-
use, if any, of the invention by the Government.
patent issued upon an application that was subject
issued pursuant to paragraph (a) hereof, and who
the order, who did not apply for compensation as
hall have the right, within two years after the date
h patent, to bring suit in the Court of Claims for
pensation for the use by the Government of the
n, such right to compensation to begin at the first
In any suit under the provisions of this section,
ations looking toward settlement and compromise
, the United States may avail itself of any and all
y be pleaded in an action for infringement. No
er the Act shall be paid for use by the Government
nade while the inventor thereof was employed by

shall file or cause or authorize to be filed in any
n application for patent or for the registration of
ndustrial design, or model in respect of any inven-
United States prior to ninety days after filing in the
application covering such invention except when
case by a license obtained from the Commissioner
such rules and regulations as he shall prescribe.
all be granted with respect to any invention which
er of a subsisting order issued by the Commissioner
nt to paragraph (a) hereof without the concurrence
l departments or the chief officers of all agencies
rder to be issued.

(e) Any person and the successors, assigns, or legal representatives of any such person, shall be debarred from receiving a United States patent for an invention if such person, or such successors, assigns, or legal representatives shall, without procuring the authorization prescribed in paragraph (d) hereof, have made, or consented to or assisted another's making, application in a foreign country for a patent or for the registration of a utility model, industrial design, or model in respect of such invention where authorization for such application is required by the provisions of paragraph (d) hereof, and any such United States patent actually issued to any such person, his successors, assigns, or legal representatives so debarred or becoming debarred shall be invalid.

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

(g) The Atomic Energy Commission, the Secretary of the Army, the Secretary of the Navy, the Secretary of the Air Force, the chief officer of any other department or agency of the Government designated by the President as a defense agency of the United States, and the Commissioner of Patents, may separately issue such rules and regulations as may be necessary and proper to enable the respective department or agency to carry out the provisions of this section, and in addition are authorized, under such rules and regulations as each may prescribe, to delegate and provide for the redelegation within their respective departments or agencies of any power or authority conferred by this section to such responsible officers, boards, agents, or persons as each may designate or appoint.

(h) The prohibitions and penalties of this section shall not apply to any officer or agent of the United States acting within the scope of his authority.

Present statute

ch. 95, 40 Stat. 394, amended (1) July 1, 1940, ch. 501,
1, 1941, ch. 393, 55 Stat. 657, (3) June 16, 1942, ch. 415,

2] Whenever the publication or disclosure of an invention
ent might, in the opinion of the Commissioner of Patents,
ublic safety or defense he may order that the invention
hold the grant of a patent for such period or periods as
nal interest requires: *Provided*, That the invention dis-
n for said patent may be held abandoned upon it being
the Commissioner that in violation of said order said
lished or disclosed or that an application for a patent
in a foreign country by the inventor or his assigns or
ithout the consent or approval of the Commissioner of

hose patent is withheld as herein provided and who faith-
f the Commissioner of Patents above referred to shall
the Government of the United States for its use, he shall,
ly receives a patent, have the right to sue for compensa-
ims, such right to compensation to begin from the date
tion by the Government: *Provided*, That the Secretary
of the Navy or the chief officer of any established de-
ed States, as the case may be, is authorized to enter into
said applicant in full settlement and compromise for the
by reason of the order of secrecy, and for the use of the
nment.
take effect on approval and, together with the provisions
, 1941 (Public Law 239, Seventy-seventh Congress, first
remain in force during the time when the United States

2a] No person shall file or cause or authorize to be filed in
application for patent or for the registration of a utility
, or model in respect of any invention made in the United
thorized in each case by a license obtained from the
s under such rules and regulations as he shall prescribe.
2b] Notwithstanding the provisions of sections 4886 and
tutes (35 U. S. C., secs. 31 and 32), any person and the
gal representatives of any such person shall be debarred
States patent for an invention if such person, or such
gal representatives shall, without procuring the authori-
ction 3 hereof, have made or consented to or assisted
ation in a foreign country for a patent or for the registra-
dustrial design, or model in respect of such invention where
pplication is required by the provisions of section 3, and
patent actually issued to any such person, successors,
sentatives so debarred or becoming debarred shall be

42c] Whoever, during the period or periods of time an
ered to be kept secret and the grant of a patent thereon
he Act approved July 1, 1940 (Public, Numbered 700,
third session, ch. 501), shall, with knowledge of such
uthorization, willfully publish or disclose or authorize or
r disclosed such invention, or any material information
r whoever, in violation of the provisions of section 3
se or authorize to be filed in any foreign country an
r for the registration of a utility model, industrial design,
ny invention made in the United States, shall, upon con-
ore than $10,000 or imprisoned for not more than two

2d] If any provision of this Act or of any section thereof
ch provision to any person or circumstances shall be held
of the Act and of such section and application of such

provision to persons or circumstances other than those as to which it is held invalid shall not be affected thereby.

SEC. 7. [35 U. S. C. 42e] As used in this Act—

The term "person" includes any individual, trustee, corporation, partnership, association, firm, or any other combination of individuals.

The term "application" includes applications, and any modifications, amendments, or supplements thereto or continuances thereof.

SEC. 8. [35 U. S. C. 42f] The prohibitions and penalties of this Act shall not apply to any officer or agent of the United States acting within the scope of his authority.

Note

This section follows, with some changes in language, recent legislative proposals: 80th Congress, S. 1726, H. R. 4420; 81st Congress, S. 2557, H. R. 6389.

§ 39. Filing evidence of invention

The Commissioner of Patents may accept for deposit and custody descriptions and drawings for subsequent use as evidence of the existence of the papers on the date deposited, under such regulations as he may prescribe. Such deposits may be destroyed after a period, not less than one year, determined by the Commissioner.

Note

This section is new. For similar legislative proposals see 69th Congress, H. R. 10207; 79th Congress, H. R. 6118, S. 1248, hearings Dec. 1945, reported Jan. 29, 1946, S. Report 908; 80th Congress, H. R. 6988, S. 493, hearings, May 1947, reported, S. Report 395; 81st Congress, H. R. 1711, S. 868, reported, S. Report 675, passed Senate, Aug. 9, 1949.

CHAPTER 4. EXAMINATION OF APPLICATION

Sec.
40. Examination of application.
41. Notice of rejection.
42. Time for prosecuting application.
43. Appeal to the Board of Appeals.

§ 40. Examination of application

The Commissioner shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is justly entitled to a patent under the law, and that the invention is sufficiently useful and important, the Commissioner shall issue a patent therefor as provided in chapter 7 of this title.

Present statute

Sec. 4893, Revised Statutes of 1874 [35 U. S. C. 36]:

On the filing of any such application and the payment of the fees required by law, the Commissioner of Patents shall cause an examination to be made of the alleged new invention or discovery; and, if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the commissioner shall issue a patent therefor.

Note

The first part is revised in language and amplified.

§ 41. Notice of rejection

Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof, stating briefly the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amending his specification, the application shall be reexamined.

Present statute

Sec. 4903, Revised Statutes of 1874, amended Aug. 5, 1939, sec. 1, ch. 452, 53 Stat. 1213 [35 U. S. C. 51]:

Whenever, on examination, any claim for a patent is rejected, the commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejection, together with such information and references as may be useful in judging of the propriety of renewing his application or of altering his specification; and if after receiving such notice, the applicant persists in his claim for a patent,

g his specifications, the commissioner shall order a reex-

he first time presenting or asserting a claim which is the tially the same subject matter as, a claim of an issued n any application unless such amendment is filed within on which said patent was granted.

Note

revised in language and amplified; the second paragraph in Section 44.

secuting application

ne applicant to prosecute the application within shorter time, not less than thirty days or any as shall be fixed by the Commissioner and the hereof in writing) after any action therein, of ave been given or mailed to the applicant, the regarded as abandoned by the parties thereto, the satisfaction of the Commissioner of Patents unavoidable.

Present statute

atutes of 1874, amended (1) Mar. 3, 1897, sec. 4, ch. 391, ly 6, 1916, sec. 1, ch. 225, 39 Stat. 345, 347–8, (3) Mar. 2, 4 Stat. 1335, (4) Aug. 7, 1939, ch. 568, 53 Stat. 1264 [35

atents shall be completed and prepared for examination the filing of the application, and in default thereof, or upon to prosecute the same within six months or such shorter y days or any extensions thereof, as shall be fixed by the ts in writing to the applicant after any action therein, of been given to the applicant, they shall be regarded as ies thereto, unless it be shown to the satisfaction of the nts that such delay was unavoidable. No application andoned which has become the property of the Govern- es and with respect to which the head of any department have certified to the Commissioner of Patents, within a hat the invention disclosed therein is important to the f the United States. Within ninety days, and not less e the expiration of any such three-year period the Com- all, in writing, notify the head of the department inter- plication for patent, of the approaching expiration of the n which any application for patent shall have been

Note

s omitted as having no present day meaning or value. are omitted for inclusion in Section 69. The notice is

e Board of Appeals

a patent, any of whose claims have been twice al from the decision of the primary examiner eals, having once paid the fee for such appeal.

Present statute

Sec. 4909, Revised Statutes of 1874, amended (1) Mar. 2, 1927, sec. 5, ch. 273, 44 Stat. 1335, 1336, (2) Aug. 5, 1939, sec. 2, ch. 451, 53 Stat. 1212 [35 U. S. C. 57]:

Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, may appeal from the decision of the primary examiner to the Board of Appeals, having once paid the fee for such appeal.

Note

Reference to reissues is omitted in view of the general provision in Section 58.

CHAPTER 5. INTERFERENCES

Sec.
44. Interferences
45. Testimony
46. Subpoenas, witnesses

§ 44. 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 may be determined by a board of three examiners of interferences or in a civil action filed as prescribed in section 52 of this title. The judgment of the Patent Office adverse to the claim of an applicant shall constitute a final refusal of a patent by the Patent Office and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. Judgment adverse to a patentee when final shall constitute cancellation of the claims involved from the patent.

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

Present statute

Sec. 4904, Revised Statutes of 1874, amended (1) Mar. 2, 1927, sec. 4, ch. 273, 44 Stat. 1335, 1336, (2) Aug. 5, 1939, sec. 1, ch. 451, 53 Stat. 1212 [35 U. S. C. 52]:

Whenever an application is made for a patent which, in the opinion of the commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct a board of three examiners of interferences to proceed to determine the question of priority of invention. And the commissioner may issue a patent to the party who is adjudged the prior inventor.

Notes

The second paragraph is transposed from R. S. 4903 (see section 41) as being more appropriate under interferences.

The section is revised to provide that the interference may be tried either in the Patent Office or in the courts. Final decision adverse to a patentee constitutes cancellation of the claims involved. For legislative proposals relating to interferences see, 69th Congress, H. R. 9217; 73d Congress, H. R. 9697; 78th Congress, H. R. 3264, hearings, February 1944.

ony

ssioner of Patents may establish rules for taking affi-
ositions, or for the taking of testimony before an officer
Office, required in cases pending in the Patent Office,
avits and depositions may be taken before any officer
law to take depositions to be used in the courts of the
or of the State where the officer resides.

Present statute

ised Statutes of 1874 [35 U. S. C. 53]:

oner of Patents may establish rules for taking affidavits and
ed in cases pending in the Patent Office, and such affidavits and
e taken before any officer authorized by law to take depositions
courts of the United States, or of the State where the officer

Note

ded relative to taking testimony before an officer of the Patent

nas, witnesses

f any court of the United States, for any district or
ein testimony is to be taken for use in any contested
n the Patent Office, shall, upon the application of any
issue a subpoena for any witness residing or being
strict or Territory, commanding him to appear and
an officer in such district or Territory authorized to
ns and affidavits at the time and place stated. No
be required to attend at any place more than one
from the place where the subpoena is served upon him;
ions of the Federal Rules of Civil Procedure relating
e of subpoenas duces tecum shall apply to contested
tent Office.
ss subpoenaed and in attendance shall be allowed the
witnesses attending the courts of the United States.
ny witness, after being duly served with such subpoena,
uses to appear, or after appearing refuses to testify,
court whose clerk issued the subpoena may, on proof of
r refusal, enforce obedience to the process, or punish
ce, as in other like cases. But no witness shall be
of contempt for disobeying such subpoena, unless his
ing expenses in going to, returning from, and one day's
the place of examination, are paid or tendered him at
e service of the subpoena; nor for refusing to disclose
ntion or discovery made or owned by himself.

Present statute

Sec. 4906, Revised Statutes of 1874, amended Feb. 18, 1922, sec. 7, ch. 58, 42 Stat. 389, 391–2 [35 U. S. C. 54]:

The clerk of any court of the United States, for any district or Territory wherein testimony is to be taken for use in any contested case pending in the Patent Office, shall, upon the application of any party thereto, or of his agent or attorney, issue a subpoena for any witness residing or being within such district or Territory, commanding him to appear and testify before any officer in such district or Territory authorized to take depositions and affidavits at any time and place in the subpoena stated. But no witness shall be required to attend at any place more than forty miles from the place where the subpoena is served upon him; and the provisions of section 869 of the Revised Statutes relating to the issuance of subpoenas duces tecum shall apply to contested cases in the Patent Office.

Sec. 4907, Revised Statutes of 1874 [35 U. S. C. 55]:

Every witness duly subpoenaed and in attendance shall be allowed the same fees as are allowed to witnesses attending the courts of the United States.

Sec. 4908, Revised Statutes of 1874 [35 U. S. C. 56]:

Whenever any witness, after being duly served with such subpoena, neglects or refuses to appear, or after appearing refuses to testify, the judge of the court whose clerk issued the subpoena may, on proof of such neglect or refusal, enforce obedience to the process, or punish the disobedience, as in other like cases. But no witness shall be deemed guilty of contempt for disobeying such subpoena, unless his fees and traveling expenses in going to, returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret invention or discovery made or owned by himself.

Note

Three sections are combined with some changes in language. Reference to a repealed statute in the first paragraph is replaced by reference to the rules of civil procedure and thirty miles has been changed to one hundred miles.

CHAPTER 6. REVIEW OF PATENT OFFICE DECISIONS

Sec.
47. Appeal to Court of Customs and Patent Appeals.
48. Same. Notice of appeal.
49. Same. Proceedings on appeal.
50. Same. Decision on appeal.
51. Civil action to obtain patent.
52. Civil action in case of interference.

§ 47. Appeal to Court of Customs and Patent Appeals

An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Customs and Patent Appeals, in which case he waives his right to proceed under section 51 of this title. A party to an interference dissatisfied with the decision of the board of interference examiners may appeal to the United States Court of Customs and Patent Appeals.

Present statute

Sec. 4911, Revised Statutes of 1874, amended (1) Mar. 2, 1927, sec. 8, ch. 273, 44 Stat. 1336, (2) Mar. 2, 1929, sec. 2a, ch. 488, 45 Stat. 1476, (3) Aug. 5, 1939, sec. 3, ch. 451, 53 Stat. 1212 [35 U. S. C. 59a]:

If any applicant is dissatisfied with the decision of the board of appeals, he may appeal to the United States Court of Customs and Patent Appeals, in which case he waives his right to proceed under section 4915 of the Revised Statutes. If any party to an interference is dissatisfied with the decision of the board of interference examiners, he may appeal to the United States Court of Customs and Patent Appeals: *Provided*, That such appeal shall be dismissed if any adverse party to such interference shall, within twenty days after the appellant shall have filed notice of appeal according to section 4912 of the Revised Statutes, file notice with the Commissioner of Patents that he elects to have all further proceedings, conducted as provided in section 4915 of the Revised Statutes. Thereupon the appellant shall have thirty days thereafter within which to file a bill of equity under said section 4915, in default of which the decisions appealed from shall govern the further proceedings in the case.

Note

The proviso is omitted in view of the proposed change in the time of electing a civil action.

§ 48. Same. Notice of appeal

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

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Present statute

ed Statutes of 1874, amended (1) Feb. 9, 1893, sec. 9, ch. 74, Mar. 2, 1927, sec. 9, ch. 273, 44 Stat. 1336, (3) Mar. 2, 1929, Stat. 1476 [35 U. S. C. 60]:

is taken to the United States Court of Customs and Patent lant shall give notice thereof to the commissioner, and file in within such time as the commissioner shall appoint, his reasons lly set forth in writing.

Note

Proceedings on appeal

all, before hearing such appeal, give notice to the f the time and place of the hearing, and the Com- thereupon give notice thereof in such manner as the , to the parties thereto. The party appealing court certified copies of all the necessary original ence in the case, and the Commissioner shall furnish he grounds of his decision, fully set forth in writing points involved by the reasons of appeal.

Present statute

ed Statutes of 1874, amended Mar. 2, 1927, sec. 10, ch. 273, . S. C. 61]:

before hearing such appeal, give notice to the commissioner ace of the hearing, and on receiving such notice the commis- tice of such time and place in such manner as the court may ties who appear to be interested therein. The party appealing court certified copies of all the original papers and evidence e commissioner shall furnish the court with the grounds of set forth in writing touching all the points involved by the

Note

ged.

Decision of appeal

n petition, shall hear and determine such appeal produced before the Patent Office, at such early ime as the court may appoint; and the decision shall he points set forth in the reasons of appeal. After the court shall return to the Commissioner a cer- roceedings and decision, which shall be entered of atent Office and govern the further proceedings in

Present statute

d Statutes of 1874 [35 U. S. C. 62]:

tition, shall hear and determine such appeal, and revise the om in a summary way, on the evidence produced before the

commissioner, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

Note

Language is changed and the last sentence omitted.

§ 51. Civil action to obtain patent

An applicant dissatisfied with a decision of the Board of Appeals, may, unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action, if filed within sixty days after such decision. The court having cognizance thereof may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved, as the facts in the case may appear. Such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the judgment and otherwise complying with the requirements of law. A copy of the complaint shall be served on the Commissioner and all the expenses of the proceedings shall be paid by the applicant, whether or not the final decision is in his favor.

Present statute

Sec. 4915, Revised Statutes of 1874, amended (1) Feb. 9, 1893, sec. 9, ch. 74, 27 Stat. 436, (2) Mar. 2, 1927, sec. 11, ch. 273, 44 Stat. 1336, (3) Mar. 2, 1929, sec. 2b, ch. 488, 45 Stat. 1476, (4) Aug. 5, 1939, sec. 4, ch. 451, 53 Stat. 1212 [35 U. S. C. 63]:

Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

Note

y is changed to civil action and the section is restricted to exclude which are covered by the next section. The time for filing the ced to sixty days, the same as the time now allowed for appeal.

action in case of interference

o an interference declared in accordance with section 44 upon whom the burden of proof rests as determined by Office may have the question of priority of invention by civil action brought against the other party or parties ference at such stage in the proceedings and within the y the Commissioner of Patents. The party upon whom f proof rests may file notice within the time fixed by the er that he elects to have the question of priority deter- vil action whereupon the other party or parties shall file within the time prescribed, and upon failure to file such ase shall be decided by default.

action may be filed against the party or parties in interest the records of the Patent Office, but any party in interest a party to the action and the Court may transfer the nore appropriate jurisdiction. If there be adverse parties plurality of districts not embraced within the same state, e party residing in a foreign country, the United States rt for the District of Columbia shall have jurisdiction. ssioner of Patents shall not be a necessary party but he fied of the filing of the action by the clerk of the court in led and shall have the right to intervene in the action.

Present statute

evised Statutes of 1874 [35 U. S. C. 63]. See following section 51.
3, 1927, ch. 364, 44 Stat. 1394 [35 U. S. C. 72a]:

of the Judicial Code be, and the same is hereby, amended by the following:
on the filing of a bill in the Supreme Court of the District of wherein remedy is sought under section 4915 or section 4918 of d Statutes, without seeking other remedy, if it shall appear that n adverse party residing in a foreign country, or adverse parties a plurality of districts not embraced within the same State, the l have jurisdiction thereof and writs shall, unless the adverse arties voluntarily make appearance, be issued against all of the rties with the force and effect and in the manner set forth in this ovided that writs issued against parties residing in foreign coun- ant to this section may be served by publication or otherwise as shall direct.'''

Note

follows section 44 relating to interferences and changes the char- l action in the case of interferences to an original proceeding instead a previous Patent Office proceeding.

CHAPTER 7. ISSUE OF PATENT

Sec.
53. Time of issue of patent.
54. Issue of patent to assignee.
55. How issued.
56. Contents of patent.
57. Term of patent.

§ 53. Time of issue of patent

The patent shall issue within three months from the date of the payment of the final fee, which fee shall be paid not later than six months from the time at which the application was allowed and notice thereof was sent to the applicant; and if the final fee is not paid within that period the patent shall be withheld. The Commissioner of Patents may in his discretion receive the final fee if paid within one year after the six months' period for payment has passed and the patent shall issue.

Present statute

Sec. 4885, Revised Statutes of 1874, amended (1) May 23, 1908, ch. 189, 35 Stat. 246, (2) Aug. 9, 1939, sec. 2, ch. 619, 53 Stat. 1293 [35 U. S. C. 41]:

Every patent shall issue within a period of three months from the date of the payment of the final fee, which fee shall be paid not later than six months from the time at which the application was passed and allowed and notice thereof was sent to the applicant or his agent; and if the final fee is not paid within that period the patent shall be withheld: *Provided, however*, That the Commissioner of Patents may in his discretion receive the final fee if paid within one year after the six months' period for payment has passed and the patent shall issue.

Note

Language is changed.

§ 54. Issue of patent to assignee

Patents may be granted to the assignee of the inventor but the assignment must first be entered of record in the Patent Office, and the application shall be made and the specification sworn to by the inventor, except as otherwise provided in this title.

Present statute

Sec. 4895, Revised Statutes of 1874 [35 U. S. C. 44]:

Patents may be granted and issued or reissued to the assignee of the inventor or discoverer; but the assignment must first be entered of record in the Patent Office. And in all cases of an application by an assignee for the issue of a patent, the application shall be made and the specification sworn to by the inventor or discoverer; and in all cases of an application for a reissue of any patent, the application must be made and the corrected specification signed by the inventor or discoverer, if he is living, unless the patent was issued and assignment made before the eighth day of July, eighteen hundred and seventy.

Note

ed and the reference to reissues is omitted in view of the gen-
ion 58.

d

l be issued in the name of the United States of Amer-
l of the Patent Office, and shall either be signed by
or have his signature placed thereon and attested
he Patent Office designated by the Commissioner,
ded in the Patent Office.

Present statute

l Statutes of 1874, amended (1) Feb. 18, 1888, ch. 15, 25
1902, ch. 417, 32 Stat. 95, (3) Feb. 18, 1922, sec. 5, ch. 58,
. C. 39]:

e issued in the name of the United States of America, under
t Office, and shall either be signed by the Commissioner of
ame printed thereon and attested by an Assistant Commis-
by one of the law examiners duly designated by the commis-
recorded, together with the specifications, in the Patent
kept for that purpose.

Note

ng to the attesting officers and to the recording of the patents

of patent

shall contain a short title of the invention and a
ntee, his heirs or assigns, for the term thereof, of the
make, use, and vend the invention throughout the
the territories thereof, referring to the specification
thereof. A copy of the specification and drawings
o the patent and be a part thereof.

Present statute

l Statutes of 1874, amended May 23, 1930, sec. 1, ch. 312,
. C. 40]:

ll contain a short title or description of the invention or
ndicating its nature and design, and a grant to the patentee,
or the term of seventeen years, of the exclusive right to make
vention or discovery (including in the case of a plant patent
to asexually reproduce the plant) throughout the United
ories thereof, referring to the specification for the particulars
he specification and drawings shall be annexed to the patent
f.

Note

plants is omitted for inclusion in another section and the
is shortened since the title is of no legal significance. The
specified in the next section.

§ 57. Term of patent

The term of a patent shall begin with the issuance thereof and shall terminate, except as otherwise provided, at a date not more than twenty years (plus such further time to compensate for delays during the pendency of the application not chargeable to the applicant as may be determined by the Commissioner) from the date of filing of the application in the United States or the date of filing of the earliest application in the United States the filing date of which is claimed; but in no case shall the term of any patent be more than seventeen years.

Note

This section is new and follows previous legislative proposals; see 72d Congress, H. R. 10153, hearings March 1932, H. R. 11016, reported May 3, 1932, H. Report 1200; 73d Congress, H. R. 5554; 74th Congress, H. R. 4986; 76th Congress, S. 2688, hearings July, 1939, reported July 11, 1939, S. Report 747, passed Senate Apr. 26, 1940; 77th Congress, H. R. 3211, S. 892; 79th Congress, H. R. 2631, hearings May and June 1945.

CHAPTER 8. AMENDMENT AND CORRECTION OF PATENTS

Sec.
58. Reissue of defective patents.
59. Same. Effect of reissue.
60. Disclaimer of invalid claims.
61. Certificate of correction of Patent Office mistake.
62. Certificate of correction of applicant's mistake.
63. Misjoinder of inventor.

§ 58. Reissue of defective patents

Whenever any patent is deemed wholly or partly inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming more than he had a right to claim in the patent, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, cause a patent for the same invention, and in accordance with an amended specification, to be reissued to the patentee or to his assigns or legal representatives, for the unexpired part of the term of the original patent. No new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except each by the other, and the specification in every such case shall be subject to revision and restriction in the same manner as original applications. The Commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters patent.

Application for reissue of a patent shall be made in the same manner as applications for patent and the provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, but application for reissue may be made and sworn to by the assignee of the entire interest if the reissue serves only to diminish the scope of the claims of the patent.

Present statute

Sec. 4916, Revised Statutes of 1874, amended May 24, 1928, ch. 730, 45 Stat. 732 [35 U. S. C. 64]:

Whenever any patent is wholly or partly inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any

or deceptive intention, the commissioner shall, on the surrender of
and the payment of the duty required by law, cause a patent for
nvention, and in accordance with the corrected specification, to be
the patentee or to his assigns or legal representatives, for the unex-
of the term of the original patent. Such surrender shall take effect
sue of the reissued patent, but in so far as the claims of the original
d patents are identical, such surrender shall not affect any action
g nor abate any cause of action then existing, and the reissued patent
t that its claims are identical with the original patent shall constitute
ion thereof and have effect continuously from the date of the original
ne commissioner may, in his discretion, cause several patents to be
istinct and separate parts of the thing patented, upon demand of the
nd upon payment of the required fee for a reissue for each of such
ters patent. The specifications and claims in every such case shall
o revision and restriction in the same manner as original applications
patent so reissued, together with the corrected specifications, shall
me effect and operation in law, on the trial of all actions for causes
rising, as if the same had been originally filed in such corrected form;
matter shall be introduced into the specification, nor in case of a
tent shall the model or drawings be amended, except each by the
when there is neither model nor drawing, amendments may be made
satisfactory to the commissioner that such new matter or amendment
of the original invention, and was omitted from the specification by
e, accident, or mistake, as aforesaid.

Note

entences of the present statute are rearranged and divided into two

changes in language are made and the clause at the end of the present
itted as obsolete.

econd paragraph incorporates the requirements of other applications
provision relating to application for reissue in certain cases by the
This latter follows to a limited extent previous legislative proposals:
ss, S. 3358, H. R. 7237, H. R. 10152, hearings, March 1932, H. R.
ted May 3, 1932, H. Report 1202; 73d Congress, H. R. 6011; 76th
. R. 8444 and 9386, hearings May 1940; 77th Congress, H. R. 3212.

ne. Effect of reissue

render of the original patent shall take effect upon the
e reissued patent, and every patent so reissued, together
amended specification, shall have the same effect and
in law, on the trial of all actions for causes thereafter
if the same had been originally granted in such amended
in so far as the claims of the original and reissued patents
al, such surrender shall not affect any action then pending
any cause of action then existing, and the reissued patent
ent that its claims are identical with the original patent
itute a continuation thereof and have effect continuously
date of the original patent. No reissue shall abridge or
affect the right of any person to continue any manufacture,
commenced before the grant of the reissue which did not
an infringement of the original patent, nor shall the further
re, use or sale by him or his agents or successors in business,

or the use or sale of products resulting from such manufacture or use, constitute an infringement of the reissued patent, nor shall any such reissue abridge or otherwise affect any right of the patentee of any patent granted before the grant of the reissue, or his agents or licensees who derived their rights from him prior to the grant of the reissue, to the extent that they shall not be amenable to any action for infringement of the reissue by virtue of making, using, or selling the invention of such intervening patent unless such making, using or selling would also constitute an infringement of the original patent.

Present statute

Sec. 4916, Revised Statutes of 1874, amended May 24, 1928, ch. 730, 45 Stat. 732 [35 U. S. C. 64]. See following section 58.

Note

A provision for the protection of intervening rights is added. This follows in form similar provisions in the Boykin Act, secs. 1, 4, Act of Aug. 8, 1946, ch. 910, 60 Stat. 940, and is broader than prior legislative proposals; 72d Congress, H. R. 10924; 73d Congress, H. R. 3526.

§ 60. Disclaimer of invalid claim

Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a claim of a patent is invalid, the patent shall be valid as to the remaining claims, and the patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of the invalid claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, and recorded in the Patent Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the disclaimant and by those claiming under him after the record thereof.

Present statute

Sec. 4917, Revised Statutes of 1874 [35 U. S. C. 65]:

Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it.

Note

ge is changed and substantive changes are introduced, (1) only a claim e may be disclaimed, and (2) the provision regarding delay is omitted. slative proposals, with modifications, are followed: 72d Congress, S. R. 7245, hearings March 1932, H. R. 11010, reported May 3, 1932, t 1196; 76th Congress, H. R. 9384, hearings May 1940; 77th Congress, 90, H. R. 5258, reported H. Report 990, passed House Aug. 4, 1941; ress, S. 2518, H. R. 6436. See Section 85.

ertificate of correction of Patent Office mistake

ever a mistake in a patent, incurred through the fault of nt Office, is clearly disclosed by the records or files of the certificate stating the fact and nature of such mistake, signed Commissioner and sealed with the seal of the Patent Office, ssued, without charge, and recorded in the records of patents, rinted copy thereof attached to each printed copy of the nd such certificate shall thereafter be considered as part of nal patent, and every such patent, together with such certifi- ll have the same effect and operation in law on the trial of ns for causes thereafter arising as if the same had been orig- ued in such corrected form. In the discretion of the Com- r, a reissued patent may be issued without charge in lieu of ate of correction.

Present statute

Act of Mar. 4, 1925, ch. 535, 43 Stat. 1268 [35 U. S. C. 88]:

er a mistake in a patent, incurred through the fault of the Patent learly disclosed by the records or files of the office, a certificate stating d nature of such mistake, signed by the Commissioner of Patents and h the seal of the Patent Office, may be issued, without charge, and n the records of patents, and a printed copy thereof attached to each py of the patent, and such certificate shall thereafter be considered as e original, and every patent, together with such certificate, shall have ffect and operation in law on the trial of all actions for causes thereafter if the same had been originally issued in such corrected form. All icates issued prior to March 4, 1925, in accordance with the rules of Office and the patent to which they are attached shall have the same effect as if such certificates had been specifically authorized by statute

Note

sentence of the present statute is omitted as obsolete. A sentence is ilar to a provision in the corresponding section in the trade-mark law, 1057 (f).

ertificate of correction of applicant's mistake

ver a mistake of a clerical or typographical nature, or of aracter, which was not the fault of the Patent Office, appears nt and a showing has been made that such mistake occurred aith, the Commissioner is authorized to issue a certificate of n, provided that the correction does not involve such

changes in the patent as would require re-examination, and every such patent, together with such certificate, shall have the same effect and operation in law on the trial of all actions for causes thereafter arising as if the same had been originally issued in such corrected form.

Note

This section is new and follows a similar provision in the trade-mark law, 15 U. S. C. 1057 (g).

§ 63. Misjoinder of inventor

Whenever a patent has been issued on the application of two or more persons as joint inventors and it appears that one of such persons was not in fact a joint inventor and had no part of an inventive nature in the making of the invention, and that he was included as a joint inventor by inadvertence or mistake and without any fraudulent or deceptive intention, the Commissioner may, on application of all the parties and the assignee if any, with proof of the facts and such other requirements as may be imposed, issue a certificate deleting the name of the erroneously joined person from the patent as a joint inventor.

Whenever a patent has been issued on the application of a person as a sole inventor, or on the application of two or more persons as joint inventors, and it appears that an additional person was in fact a joint inventor with the applicant or applicants and should have been included as a joint inventor, but was not included through inadvertence or mistake and without any fraudulent or deceptive intention, the Commissioner may, on application of all the parties and the assignee if any, with proof of the facts and such other requirements as may be imposed, issue a certificate adding the name of the erroneously omitted person to the patent as a joint inventor.

No patent shall be held invalid merely because of misjoinder or nonjoinder of a joint inventor if such error can be corrected in the manner specified in this section and the court before which such matter may be called in question may order correction of the patent on notice and hearing of all parties concerned.

Note

This section is new and is companion to section 32. For prior legislative proposals on the same subject see: 69th Congress, H. R. 7562; 70th Congress, H. R. 8745; 71st Congress, S. 4753; 72d Congress, S. 3358, H. R. 7237, H. R. 10154, hearings March 1932, H. R. 11017, reported May 3, 1932, H. Report 1201; 73d Congress, H. R. 6001; 74th Congress, H. R. 4985, hearings, May 1935, reported June 22, 1935; 76th Congress, H. R. 9386; 77th Congress, H. R. 3212.

CHAPTER 9. OWNERSHIP, ASSIGNMENTS, AND LICENSES

Sec.

64. Ownership, assignment.
65. Joint owners.
66. Licenses, conditions in contracts.
67. Recording license agreements.

§ 64. Ownership, assignment

Subject to the provisions of this title, patents shall be protected as and have the applicable rights of other property, and the rules of law applicable to the ownership and devolution of personal property generally shall apply to patents as they apply to other intangible property.

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

If any such assignment, grant, or conveyance of any application for patent or patent shall be acknowledged before any notary public of the several States or Territories or the District of Columbia, or any commissioner of any court of the United States for any district or Territory, or before any secretary of legation or consular officer authorized by law to administer oaths or perform notarial acts, the certificate of such acknowledgment, under the hand and official seal of such notary or other officer, shall be prima facie evidence of the execution of such assignment, grant or conveyance.

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

If any such assignment, grant or conveyance is not recorded in the Patent Office within three months from its date, no suit for infringement may be brought by either party during the period the instrument remains unrecorded nor may any recovery be had for any infringement occurring during said period.

atentee" used in this title includes not only the
m the patent was issued but also the successors in
tee.

Present statute

d Statutes of 1874, amended (1) Mar. 3, 1897, sec. 5, ch. 391,
eb. 18, 1922, sec. 6, ch. 58, 42 Stat. 391, (3) Aug. 18, 1941,
4 [35 U. S. C. 47]:

for patent or patent or any interest therein shall be assignable
ent in writing, and the applicant or patentee or his assigns or
s may in like manner grant and convey an exclusive right
n for patent or patent to the whole or any specified part of
An assignment, grant, or conveyance shall be void as against
rchaser or mortgagee for a valuable consideration, without
corded in the Patent Office within three months from the date
uch subsequent purchase or mortgage.
nment, grant, or conveyance of any application for patent
knowledged before any notary public of the several States or
istrict of Columbia, or any commissioner of any court of the
y district or Territory, or before any secretary of legation or
horized to administer oaths or perform notarial acts under
Revised Statutes the certificate of such acknowledgment,
official seal of such notary or other officer, shall be prima
e execution of such assignment, grant, or conveyance.

Note

ph is new but effects no change. The second paragraph is the
nt statute. The third paragraph is the same as in the present
ic reference to another statute is omitted and "by law" sub-
h paragraph changes the present statute to require the second
ecorded before it can defeat the first, following H. R. 3957,
e fifth paragraph follows H. R. 3756, 79th Congress, which
f Representatives Apr. 1, 1946.

ners

or more persons own a patent jointly, either by the
tent to them jointly or by reason of the assignment
interest in the patent or by reason of succession in
rest, each of the joint owners, in the absence of any
contrary, shall be entitled to make, use or sell the
on for his own benefit without accounting to the
rs, subject to any contract or agreement, but neither
ay grant licenses or assign his interest or any part
the consent of the other owners, or without pro-
ounting to the other joint owners.

Note

this section states existing law but the last clause effects a
n requiring consent or an accounting between joint owners in
nment or license.

§ 66. Licenses, conditions in contracts

(a) A patentee may grant licenses permitting making, using or selling the patented invention, in so far as his exclusive right is concerned, to the extent and subject to such conditions relating to such making, using or selling of the patented invention or to the patent as he may choose, subject to the provisions of this title.

(b) Any condition of any contract for license to make, use or sell a patented invention, or for the sale or lease of a patented article, or relating to any such license, sale or lease, shall be void to the extent that it (1) requires the licensee, purchaser, or lessee to acquire from the licensor, vendor or lessor or his nominees any articles other than the patented article, or (2) prohibits the licensee, purchaser or lessee from using any article not supplied by, or any process not belonging to, the licensor, vendor or lessor, or restricts the right of the licensee, purchaser or lessee to use any such article or process or (3) requires the licensee, purchaser or lessee to assign or otherwise give control of any invention made by or owned by him to the licensor, vendor or lessor.

(c) In any action for infringement of a patent it shall be a defense to prove that at the time of the infringement there was in force a contract, containing a condition declared void by this section, made by or with the consent of the plaintiff.

(d) A condition of a contract shall not be void by reason of paragraph (b) (1) and (2) if at the time of making the contract the licensor, vendor or lessor was willing to grant the license or sell or lease the article on reasonable terms without any such condition and the licensee, purchaser or lessee is entitled under the contract upon reasonable notice to relieve himself of his liability to observe the condition and substitute therefor a reasonable specified alternative condition.

(e) This section shall not render void any contract or condition with respect to sales agency or exclusive sales agency, or for the supply of parts, which would be valid without this section.

Note

This section brings up the subject of valid and invalid conditions in license agreements. The first paragraph is declaratory of a broad right to grant licenses. The second paragraph (except clause 3 which is new) is an expansion of section 3 of the Clayton Act (15 U. S. C. 14) to apply the licenses as well as to sales or leases and follows decisions of the courts in holding such conditions invalid. The third paragraph states the penalty which has been applied by the courts. The fourth and fifth paragraphs qualify part of the second paragraph.

§ 67. Recording license agreements

(a) Every license under a patent or application for patent and every agreement with respect to the same shall be in writing and shall

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ed in the Patent Office within three months from the execu-
eof as provided by this section. Nothing in this section
ire the recording of any license or agreement to which the
tates is a party, or which is made solely for the benefit of
d States, nor shall this section apply to licenses, contracts,
els as may be created or implied by law or may arise from
ct or relationship of the parties.

true and complete copy of the instruments referred to in
(a) shall be recorded, except that where a uniform type of
t, license, or other instrument is employed, the recording
thereof, together with a statement setting forth the names
parties to any such uniform type of instrument, may be
in lieu of each separate instrument, and an abstract of any
t required to be recorded by the provisions of paragraph (a),
he date thereof, the nature of the instrument, the names of
rties involved therein, the patents or applications involved
d thereby, and the nature and scope of any conditions other
usively pecuniary, may be recorded in lieu thereof, under
and regulations as may be prescribed by the Commissioner
s, subject to the filing of a complete copy within three months
date that demand for the same is made by the Commissioner
s; upon failure to file such complete copy within the time
the instrument shall be deemed not recorded under para-
hereof.

y party to any instrument specified in paragraphs (a) and
f may record the same. Where the parties to any such
t are residents of the United States only, the grantor or
hall be liable for the recording of the same; where the
such an instrument are residents of the United States and
of a foreign country, the residents of the United States
able for the recording of the same.

enses and agreements recorded under this section shall not
to public examination and inspection unless requested by
recording the same, but shall be made available for ex-
, copying, and inspection only by duly authorized officers
ited States Government for governmental purposes only.

lure to record any instrument required to be recorded by
s (a) of this section, with the intent to conceal any ma-
n thereof, shall subject the violator to a penalty of not
n $500 for each such offense, and not more than $25 for
for the continuance thereof, which shall accrue to the
tates and may be recovered in a civil action brought by
d States.

(f) If any instrument required to be recorded by this section is not recorded as provided herein, no suit based on the agreement or any default or violation thereof may be maintained during the period the agreement remains unrecorded nor may any recovery be had for any default or violation of the agreement during such period.

Note

This section brings up the question of recording license agreements and follows in part H. R. 3756, 79th Congress, which passed the House of Representatives April 1, 1946, and in part H. R. 2632, 79th Congress. Other legislative proposals for recording license agreements are: 74th Congress, H. R. 4523, hearings February, December 1935; 77th Congress, S. 2491 and 2730, hearings April 1942, H. R. 7713; 78th Congress, H. R. 109, H. R. 1371, H. R. 3874; 79th Congress, H. R. 97, H. R. 3462, S. 2482; 80th Congress, S. 72.

CHAPTER 10. GOVERNMENT INTERESTS IN PATENTS

Sec.
68. Issue of patents without fees to government officers for inventions used in public service.
69. Time for taking action in government applications.
70. Inventions of government employees.
71. Use of government-owned patents.

§ 68. Issue of patents without fees to government officers for inventions used in public service

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

Present statute

Act of Mar. 3, 1883, ch. 143, 22 Stat. 625, amended April 30, 1928, ch. 460, 45 Stat. 467 [35 U. S. C. 45]:

The Commissioner of Patents is authorized to grant, subject to existing law, to any officer, enlisted man, or employee of the Government, except officers and employees of the Patent Office, a patent for any invention of the classes mentioned in section 4886 of the Revised Statutes, without the payment of any fee when the head of the department or independent bureau certifies such invention is used or liable to be used in the public interest: *Provided*, That the applicant in his application shall state that the invention described therein, if patented, may be manufactured and used by or for the Government for governmental purposes without the payment to him of any royalty thereon, which stipulation shall be included in the patent.

Note

Several changes in language are made; the omission of the specific reference to R. S. 4886 broadens the section so as to include design patents.

§ 69. Time for taking action in Government applications.

Notwithstanding the provisions of sections 42, 51 and 53 of this title, the Commissioner may extend the time for taking action to three years, in the case of any application which has become the property of the Government of the United States and with respect to which the head of the appropriate department or agency of the Government has certified to the Commissioner that the invention dis-

ein is important to the armament, defense, or security of States.

Present statute

section 42.

Note

sion, which appears as the last two sentences of R. S. 4894 (see sec- ade a separate section and rewritten in simpler form.

entions of Government employees

sident may prescribe regulations governing the ownership ent rights to inventions made by officers and employees of nment during the course of or in consequence of their it.

Note

cular provision is not actually necessary, but it is included to bring ct.

of Government-owned patents

sident may prescribe regulations governing the licensing lisposition of any patent owned by or on behalf of the ates. Licenses shall be nonexclusive, royalty free, and onditions, unless otherwise necessary to best serve the rest.

Note

on is included to bring up the subject. The most recent legislative H. R. 5940, 79th Congress, hearings, June 1946.

CHAPTER 11. INFRINGEMENT OF PATENTS

Sec.
72. Infringement of patent.
73. Experimental use.
74. Use on board ships.
75. Purchase from inventor before patent.
76. Use by the government.
77. Adjustment of royalties in case of government use.

§ 72. Infringement of patent

Any person who makes, uses or sells any patented machine, manufacture, composition of matter or improvement, or uses any patented process or improvement, within the territory of the United States and its Territories during the term of the patent therefor without authority, and any person who intentionally aids and abets any such unauthorized making, using or selling, infringes the patent and shall be liable to a civil action for infringement, except as otherwise provided in this title.

Note

The first part of this section is declaratory only, defining infringement. The second part defines contributory infringement in broad terms, recent legislative proposals on contributory infringement are: 80th Congress, H. R. 5988, hearings May 1948; 81st Congress, S. 2518, H. R. 3866, hearings May, June 1949, H. R. 6436.

§ 73. Experimental use of invention

The making or using of a patented invention solely for the purpose of research or experiment, or for instruction, in connection with the patented invention, and not for sale or for the making of anything for sale, shall not constitute infringement, without prejudice to the rights of the patentee against anyone who makes for sale or sells the patented invention which may be subsequently used for such non-infringing use.

Note

This section proposes to codify the holding of a number of courts that experimental use of a patented invention is not infringement of the patent.

§ 74. Temporary presence in the United States

No patent shall prevent the use of any invention in any ship, vessel, aircraft or land vehicle of any other country entering the territory of the United States temporarily or accidentally, and such use shall not constitute infringement of any patent, provided such

s used exclusively for the needs of the ship, vessel, aircraft
nicle and is not sold in or used for the manufacture of any-
e sold in or exported from the United States.

Note

n held by the Supreme Court that use of a patented invention on
ign ship does not infringe a patent. This section codifies this prin-
lows the requirement of the International Convention for the Pro-
dustrial Property.

chase from inventor before patent

erson who purchases from the inventor or his assigns, or
knowledge and consent constructs any newly invented
r other patentable article, prior to the grant of a patent,
ls or uses one so constructed, shall have the right to use,
to others to be used, the specific thing so made or pur-
hout liability therefor.

Present statute

Revised Statutes of 1874 [35 U. S. C. 48]:

son who purchases of the inventor, or discoverer, or with his knowl-
sent constructs any newly invented or discovered machine, or other
rticle, prior to the application by the inventor or discoverer for a
ho sells or uses one so constructed, shall have the right to use, and
ers to be used, the specific thing so made or purchased, without
efor.

Note

the application for patent" is changed to "prior to the grant of a

by the government

ernment of the United States may make or use any patented
at any time for governmental purposes and any person
by the government may make and use such patented in-
governmental purposes or for sale for governmental pur-
the patentee shall be entitled to receive a reasonable com-
for any such making, using or selling. Authorization or
the government may be given by or under the authority
of any government department or agency, either before or
naking, using or selling, and may be given to any person
not he is authorized by the patentee to make, use or sell
on.

pensation due the patentee may be made upon such terms
agreed upon by the patentee and the department or agency
r as may be determined by suit in the Court of Claims, or
in sections 38 or 77 of this title in cases coming within
ons. The United States shall be entitled to avail itself of

any defense that may be raised by a defendant in an action for patent infringement and, in addition, shall not be liable if the invention has been fully recorded by or tried by or on behalf of any government department or agency before the invention thereof by the patentee or the inventor from whom he derives title.

Note

Section 1498 of Title 28, U. S. Code, provides for suit in the Court of Claims for compensation for use of a patented invention by or for the United States. The present section, which is not intended to replace 28 U. S. C. 1498, in the first paragraph defines the right of the United States to use any patented invention in positive terms, rather than negatively as is now the case. The second paragraph adds the special defense for the Government previously proposed: 76th Congress, H. R. 6877, hearings June 1939, H. R. 8445, 9199 and 9367, hearings March, June 1940, S. 2600; 80th Congress, S. 1340; H. R. 3929, hearings February and April 1948; 81st Congress, S. 1046, H. R. 2965.

§ 77. Adjustment of royalties in case of government use

(a) Whenever an invention, either patented or unpatented, shall be manufactured, used, sold, or otherwise disposed of for the United States, with license from the patentee or anyone having the right to grant licenses thereunder, and such license includes provisions for the payment of royalties or like charges believed to be unreasonable or excessive by the head of the department or agency of the Government which has ordered such manufacture, use, sale, or other disposition, the head of the department or agency of the Government concerned, in behalf of such agency and the Government as a whole, shall give written notice of such fact to all known parties having a beneficial interest in such royalty or like charge, whether as payors or payees thereof. Within a reasonable time after the effective date of such notice, and in no event in less than thirty days, the head of the department or agency of the Government issuing such notice shall by order, directed to all parties to whom notice shall have been given, or who shall be found to have an interest in such proceeding, fix and specify such rates or amounts, if any, of such royalties or like charges as he shall determine are fair and just, taking into account all defenses available to a defendant in a patent infringement action and such other conditions as may be determined to be appropriate by reason of governmental procurement as contrasted with nongovernmental procurement, and shall authorize the payment thereof, if any be allowed, by any payor to any payee on account of such manufacture, use, sale, or other disposition. Any party to whom such notice is given, if he so requests within thirty days from and after the effective date of such notice, may, at such time as may be fixed by the head of such department or agency, present in writing

facts or circumstances which may, in his opinion,
pon the rates or amounts of such royalties or like
o be determined, fixed, and specified in view of the
aid, and any order fixing and specifying the rates
ch royalties or like charges, if any, shall be issued
ch department or agency within a reasonable time
tation. After the effective date of the notice, any
y the notice may continue to collect royalties or
ble by or for the United States on account of such
sale, or other disposition of the invention, but all
charges shall be segregated and safely kept by such
ot, until issuance of the order herein provided, be
ayee of such royalties or like charges. After issuance
payor thereunder, unless otherwise directed in the
nue to collect royalties or other charges as afore-
pay over to any payee affected by the order any
ther charges in any amount or at a rate in excess
specified by the order and shall refund any such
ed States in such manner as directed by the order
royalty or like charge shall not have any remedy
-off, or other legal action against the payor for the
additional royalties or like charges foreclosed by
damages for breach of contract or otherwise, but
and exclusive remedy, except as to the recovery
ed and specified in said order, shall be as provided
ereof. The notice and order provided for herein
the last known address of all parties to whom
directed and such notice shall be effective upon
ys after the mailing thereof, whichever date is

entitled to receive such royalties or like charges,
rieved by any order issued pursuant to paragraph
stitute suit against the United States in the Court
ne district courts of the United States insofar as
have concurrent jurisdiction with the Court of
such sum, if any, as when added to the royalties
ed and specified in such order shall constitute fair
tion to such party for the manufacture, use, sale,
n for the United States of the invention or inven-
rview of the order, taking into consideration all
s set forth for the determination of such royalties
ereof. In any such suit the United States may
and all defenses, general and special, that might

be pleaded by a defendant in an action for patent infringement, or any other defense, general or special, which might preclude the right of such party to claim, or which might limit the rate or amount of, a royalty or other like charge.

(c) The head of any department or agency of the Government which has ordered the manufacture, use, sale, or other disposition of an invention, whether patented or unpatented, and whether or not an order has been issued in connection therewith pursuant to paragraph (a) hereof, is authorized and empowered to enter into an agreement, before suit against the United States has been instituted, with the owner of, or a party entitled to receive a royalty or like charge under such invention, in full settlement and compromise of any claim against the United States accruing to such owner or party under the provisions of this section or any other law by reason of such manufacture, use, sale, or other disposition, and for compensation to be paid to such owner or party based upon future manufacture, use, sale, or other disposition of said invention. The head of any department or agency of the Government which has entered into an agreement under the provisions of this section is authorized and empowered to enter into supplemental agreements modifying, amending, or revoking such agreement as the equities of changed circumstances may warrant, any other law to the contrary notwithstanding.

(d) Whenever a reduction in the rates or amounts of royalties of like charges is effected by order, pursuant to paragraph (a) hereof, or by compromise or settlement, pursuant to paragraph (c) hereof, such reduction shall inure to the benefit of the Government either by way of a corresponding reduction in the contract price to be paid directly or indirectly for such manufacture, use, sale, or other disposition of such invention, or by way of refund to the Treasury of the United States by the payor of such royalties or like charges insofar as the same may have been foreclosed from payment thereof to the payee.

(e) The head of the department or agency of the Government concerned is further authorized, in his discretion and under such rules and regulations as he may prescribe, to delegate and provide for the delegation of any power and authority conferred by this section to such qualified and responsible officers, boards, agents, or persons as he may designate or appoint.

(f) This section shall apply to all royalties or like charges directly or indirectly charged or chargeable to the United States for any supplies, equipment, or materials to be delivered to or for the Government from and after the effective date of the notice provided for in paragraph (a) hereof and shall also apply to all royalties or like

rged or chargeable directly or indirectly to the United
upplies, equipment or materials delivered to or for the
prior to the date of such notice insofar as such royalties
ges have not been paid to the payee thereof prior to the
e of such notice.
ead of each department or agency of the Government
uch rules and regulations and require such information
ecessary and proper to carry out the provisions of this
e provisions of section 10 (1) of an Act approved July 2,
t. 787), as amended, and title XIII of Public Law 507,
enth Congress, shall be applicable to the payor and payee
ty or like charge for an invention, whether patented or
manufactured, used, sold, or otherwise disposed of for
States, and the term "defense contract" as used in said
an and include an agreement for the payment of royalty
e regardless of the date of such agreement, under or by
ich any royalty or like charge is directly or indirectly
Government or included within the contract price for
d to or manufactured for the Government.

Present statute

, 1942, ch. 634, 56 Stat. 1013 [35 U. S. C. 89–96]:

o aid in the successful prosecution of the War, whenever an in-
r patented or unpatented, shall be manufactured, used, sold, or
sed of for the United States, with license from the owner thereof
g the right to grant licenses thereunder, and such license includes
e payment of royalties the rates or amounts of which are believed
ble or excessive by the head of the department or agency of the
ich has ordered such manufacture, use, sale, or other disposition,
department or agency of the Government concerned shall give
f such fact to the licensor and to the licensee. Within a reason-
the effective date of said notice, in no event less than ten days,
department or agency of the Government concerned, shall by
ecify such rates or amounts of royalties, if any, as he shall de-
and just, taking into account the conditions of wartime produc-
authorize the payment thereof by the licensee to the licensor on
manufacture, use, sale, or other disposition: *Provided, however,*
ee or licensor, if he so requests within ten days from and after
te of said notice, may within thirty days from the date of such
in writing or in person any facts or circumstances which may,
ave a bearing upon the rates or amounts of royalties, if any, to
ixed and specified as aforesaid, and any order fixing and specify-
d amounts of royalties shall be issued within a reasonable time
ntation. Such licensee shall not after the effective date of said
e licensor, nor charge directly or indirectly to the United States
, in excess of that specified in said order on account of such man-
le, or other disposition. The licensor shall not have any remedy
set-off, or other legal action against the licensee for the payment
al royalty remaining unpaid, or damages for breach of contract
ut such licensor's sole and exclusive remedy, except as to the
lties fixed in said order, shall be as provided in section 2 hereof.
s provided herein shall be mailed to the last known address of

the licensor and licensee and shall be effective upon receipt or five days after the mailing thereof, whichever date is the earlier.

SEC. 2. Any licensor aggrieved by any order issued pursuant to section 1 hereof, fixing and specifying the maximum rates or amounts of royalties under a license issued by him, may institute suit against the United States in the Court of Claims, or in the District Courts of the United States insofar as such courts may have concurrent jurisdiction with the Court of Claims, to recover such sum, if any, as, when added to the royalties fixed and specified in such order, shall constitute fair and just compensation to the licensor for the manufacture, use, sale, or other disposition of the licensed invention for the United States, taking into account the conditions of wartime production. In any such suit the United States may avail itself of any and all defenses, general or special, that might be pleaded by a defendant in an action for infringement as set forth in title sixty of the Revised Statutes, or otherwise.

SEC. 3. The head of any department or agency of the Government which has ordered the manufacture, use, sale, or other disposition of an invention, whether patented or unpatented, and whether or not an order has been issued in connection therewith pursuant to section 1 hereof, is authorized and empowered to enter into an agreement, before suit against the United States has been instituted, with the owner or licensor of such invention, in full settlement and compromise of any claim against the United States accruing to such owner or licensor under the provisions of this Act, or any other law by reason of such manufacture, use, sale, or other disposition, and for compensation to be paid such owner or licensor based upon future manufacture, use, sale, or other disposition of said invention.

SEC. 4. Whenever a reduction in the rates or amounts of royalties is effected by order, pursuant to section 1 hereof, or by compromise or settlement, pursuant to section 3 hereof, such reduction shall inure to the benefit of the Government by way of a corresponding reduction in the contract price to be paid directly or indirectly for such manufacture, use, sale, or other disposition of such invention, or by way of refund if already paid to the licensee.

SEC. 5. The head of the department or agency of the Government concerned is further authorized, in his discretion and under such rules and regulations as he may prescribe, to delegate and provide for the delegation of any power and authority conferred by this Act to such qualified and responsible officers, boards, agents, or persons as he may designate or appoint.

SEC. 6. For the purposes of this Act, the manufacture, use, sale, or other disposition of an invention, whether patented or unpatented, by a contractor, a subcontractor, or any person, firm, or corporation for the Government and with the authorization or consent of the Government shall be construed as manufacture, use, sale, or other disposition for the United States and for the purposes of the Act of June 25, 1910, as amended (40 Stat. 705; 35 U. S. C. 68), the use or manufacture of an invention described in and covered by a patent of the United States by a contractor, a subcontractor, or any person, firm, or corporation for the Government and with the authorization or consent of the Government, shall be construed as use or manufacture for the United States.

SEC. 7. This Act shall apply to all royalties directly or indirectly charged or chargeable to the United States for any supplies, equipment, or materials to be delivered to or for the Government from and after the effective date of the notice provided for in section 1 hereof. This Act shall also apply to all royalties charged or chargeable directly or indirectly to the United States for supplies, equipment, or materials already delivered to or for the Government which royalties have not been paid to the licensor prior to the effective date of the notice provided for in section 1 hereof. Sections 1 and 2 of this Act shall remain in force only during the continuance of the present war and for six months after the termination thereof, except that as to rights accrued or liabilities incurred prior to termination thereof, the provisions of this Act shall be treated as remaining in force and effect for the purpose of settling, sustaining, qualifying, or defeating any suit or claim hereunder.

SEC. 8. The head of each department or agency of the Government may issue such rules and regulations and require such information as may be necessary and proper to carry out the provisions of this Act. The provisions of section 10 (1) of an Act approved July 2, 1926 (44 Stat. 787), as amended, and Title XIII of Public Law 507, Seventy-seventh Congress, shall be applicable to the

or licensee of an invention, whether patented or unpatented, used, sold, or otherwise disposed of for the United States, and the contract" as used in said Act shall mean and include an agreement of royalty, regardless of the date of such agreement, under which royalty is directly or indirectly paid by the Government in the contract price for property sold to or manufactured for t.

ng herein contained shall be deemed to preclude the applicability of Public Law 528, Seventy-seventh Congress, as the same may hereafter amended so far as the same may be applicable.

Note

ollows the present act and the bills H. R. 2477 and S. 956, 81st a few changes.

CHAPTER 12. REMEDIES FOR INFRINGEMENT OF PATENT, AND OTHER ACTIONS

Sec.
78. Remedies for infringement of patent.
79. Defenses, presumption of validity.
80. Injunction.
81. Damages.
82. Attorneys fees.
83. Limitation on damages, time.
84. Limitation on damages, marking and notice.
85. Suit for infringement when a claim may be invalid.
86. Notice of patent suits.
87. Interfering patents.
88. False marking.

§ 78. Remedies for infringement of patent

Any patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, shall have remedy for violation of any right secured by patent by a civil action for infringement.

Present statutes

Sec. 4919, Revised Statutes of 1874 [35 U. S. C. 67]:

Damages for the infringement of any patent may be recovered by action on the case, in the name of the party interested, either as patentee, assignee, or grantee. And whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment thereon for any sum above the amount found by the verdict as the actual damages sustained, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs.

Sec. 4921, Revised Statutes of 1874, amended (1) Mar. 3, 1897, sec. 6, ch. 391, 29 Stat. 694, (2) Feb. 18, 1922, sec. 8, ch. 58, 42 Stat. 392, (3) Aug. 4, 1946, sec. 1, ch. 726, 60 Stat. 778 [35 U. S. C. 70]:

The several courts vested with jurisdiction of cases arising under the patent laws shall have power to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable; and upon a judgment being rendered in any case for an infringement the complainant shall be entitled to recover general damages which shall be due compensation for making, using, or selling the invention, not less than a reasonable royalty therefor, together with such costs, and interest, as may be fixed by the court. The court may in its discretion award reasonable attorney's fees to the prevailing party upon the entry of judgment on any patent case.

The court is authorized to receive expert or opinion evidence upon which to determine in conjunction with any other evidence in the record, due compensation for making, using, or selling the invention, and such expert or opinion evidence is declared to be competent and admissible subject to the general rules of evidence applicable thereto.

The court shall assess said damages, or cause the same to be assessed, under its direction and shall have the same power to increase the assessed damages, in its

ven to increase the damages found by verdicts in actions in the
of trespass upon the case; but recovery shall not be had for any
mitted more than six years prior to the filing of the complaint
nd it shall be the duty of the clerks of such courts within one
ling of any action, suit, or proceeding arising under the patent
ce thereof in writing to the Commissioner of Patents, setting
ar as known the names and addresses of the litigants, names of
l the designating number or numbers of the patent or patents
tion, suit, or proceeding has been brought, and in the event any
tents be subsequently included in the action, suit, or proceeding
nswer, cross bill, or other pleading, the clerk shall give like notice
mmissioner of Patents, and within one month after the decision
udgment issued the clerk of the court shall give notice thereof
ner of Patents, and it shall be the duty of the Commissioner of
of such notice forthwith to endorse the same upon the file wrap-
tent or patents, and to incorporate the same as a part of the
le or file wrapper.
take effect upon approval and shall apply to pending causes of
he taking of the testimony has not been concluded: *Provided*,
ding causes of action in which the taking of the testimony has
e to be governed by the statute in force at the time of approval
ich statute had not been amended.

Notes

and 4921 deal with suits for infringement of patents, damages,
natters of that kind. These sections need much revision in
f the changes in court proceedings since they were first adopted.
with actions at law on the case, and section 4921 with suits in
vith other matters. Since there is now only one form of action,
need consolidation. In doing so the sections have been split
different sections, 80, 81, 82, 83, and 86.
ction serves as an introduction or preamble to the following

provision in the Act of Aug. 1, 1946, is omitted as its effect is

s; presumption of validity

on for infringement the defendant, in addition to
ngement or liability for infringement may plead as a
lidity of the patent or any claim thereof on any ground
pter 2 as a condition for patentability, or for failure
the requirement of section 28 of this title for a com-
n of the invention; or any fact or act made a defense

ll be presumed to be valid unless and until it has been
the final judgment of a court of competent jurisdiction
appeal is or can be taken and the burden of establish-
y convincing proof shall rest on any person asserting
e patent.

Present statute

Sec. 4920, Revised Statutes of 1874, amended (1) Mar. 3, 1897, sec. 2, ch. 391, 29 Stat. 692, (2) Aug. 5, 1939, sec. 1, ch. 450, 53 Stat. 1212 [35 U. S. C. 69]:

In any action for infringement the defendant may plead the general issue, and, having given notice in writing to the plaintiff or his attorney thirty days before, may prove on trial any one or more of the following special matters:

First. That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect; or,

Second. That he had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; or,

Third. That it has been patented or described in some printed publication prior to his supposed invention or discovery thereof, or more than one year prior to his application for a patent therefor; or,

Fourth. That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; or,

Fifth. That it had been in public use or on sale in this country for more than one year before his application for a patent, or had been abandoned to the public.

And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of the patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented or to have had the prior knowledge of the thing patented, and where and by whom it had been used; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defenses may be pleaded in any suit in equity for relief against an alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect.

Note

Sec. 4920 has been superseded in part by the Federal Rules of Civil Procedure, see notes under Rule 8. This section is omitted and replaced by a brief paragraph specifying the defenses to infringement suits. The second paragraph specifies the presumption of validity of patents.

§ 80. Injunction

The several courts vested with jurisdiction of cases arising under this title shall have power to grant injunctions to prevent the violation of any right secured by patent, according to the course and principles of courts of equity, on such terms as the court may deem reasonable.

Present statute

See under section 78.

Note

This section is substantially the same as the provision which opens R. S. 4921.

§ 81. Damages

Upon a verdict or judgment being rendered in any action for infringement the complainant shall be entitled to recover damages, or general damages which shall be due compensation for making, using, or selling the invention, not less than a reasonable royalty therefor, together with such costs, and interest, as may be fixed by the court.

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found by a jury, the court shall assess said damages, or
ne to be assessed, under its direction and the court is
o receive expert or opinion evidence upon which to
conjunction with any other evidence in the record, due
for making, using, or selling the invention, and such
ion evidence is declared to be competent and admissible
e general rules of evidence applicable thereto.
a verdict or judgment is rendered for the plaintiff, the
nter judgment, according to the circumstances of the
sum above the amount found as damages, not exceeding
uch amount, together with the costs.

Present statute

tion 78.

Note

attempts to consolidate the provisions relating to damages in
4921.

ney's fees

may in its discretion award reasonable attorney's fees
l cases, to the prevailing party upon the entry of judg-

Present statute

tion 78.

Note

in exceptional cases" have been added to the provision in R. S.
ut the intention in the original enactment of this clause, and the
by the courts.

ation on damages; time

ry shall be had for any infringement committed more
s prior to the filing of the complaint in the action.

Present statute

tion 78.

Note

ical with the provision in R. S. 4921.

ation on damages, marking and notice

e the duty of all patentees and their assigns and legal
es, and of all persons making or vending any patented
under them, to give sufficient notice to the public that
patented; either by fixing thereon the word "patent,"
the number of the patent, or when, from the character
, this can not be done, by fixing to it, or to the package
or more of them is included, a label containing the like

notice, and in any suit for infringement by the party failing so to mark, or in any suit for infringement of a patent under which no articles have been manufactured or sold (marked as above required), no damages shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement and continued to infringe after such notice.

Present statute

Sec. 4900, Revised Statutes of 1874, amended Feb. 7, 1927, ch. 67, 44 Stat. 1058 [35 U. S. C. 49]:

It shall be the duty of all patentees and their assigns and legal representatives, and of all persons making or vending any patented article for or under them, to give sufficient notice to the public that the same is patented; either by fixing thereon the word "patent," together with the number of the patent, or when, from the character of the article, this can not be done, by fixing to it, or to the package wherein one or more of them is inclosed, a label containing the like notice: *Provided, however*, That with respect to any patent issued prior to April 1, 1927, it shall be sufficient to give such notice in the form following; viz: "Patented," together with the day and year the patent was granted; and in any suit for infringement by the party failing so to mark, no damages shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement and continued, after such notice, to make, use, or vend the article so patented.

Note

The proviso is omitted as being temporary in character and no longer of any import. A clause is added requiring actual notice in cases of no manufacture by the patentee.

§ 85. Suit for infringement when a claim may be invalid

Whenever, through inadvertence, accident, or mistake and without any willful default or intent to defraud or mislead the public, any claim of a patent is invalid, the patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, may maintain an action for the infringement of any claim of the patent which may be valid, notwithstanding the invalid claim. But in every such case in which a judgment or decree shall be rendered for the plaintiff no costs shall be recovered unless a proper disclaimer of the invalid claim has been entered at the Patent Office before the commencement of the suit.

Present statute

Sec. 4922, Revised Statutes of 1874 [35 U. S. C. 71]:

Whenever, through inadvertence, accident, or mistake and without any willful default or intent to defraud or mislead the public, a patentee has, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof, which was bona fide his own, if it is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right, notwithstanding the specifications may embrace more than that of which the

first inventor or discoverer. But in every such case in which a ee shall be rendered for the plaintiff no costs shall be recovered disclaimer has been entered at the Patent Office before the com- e suit. But no patentee shall be entitled to the benefits of this unreasonably neglected or delayed to enter a disclaimer.

Note

f delay in disclaiming is eliminated and disclaimers are confined entire claim, see section 60.

of patent suits

he duty of the clerks of the courts of the United States nth after the filing of any action, suit, or proceeding he patent laws, to give notice thereof in writing to the of Patents, setting forth in order so far as known the dresses of the parties, names of the inventors, and the mber or numbers of the patent or patents upon which it, or proceeding has been brought, and in the event ent or patents be subsequently included in the action, ding by amendment, answer, cross bill, or other plead- shall give like notice thereof to the Commissioner of within one month after the decision is rendered or a ed the clerk of the court shall give notice thereof to oner of Patents, and it shall be the duty of the Com- atents, on receipt of such notice forthwith to endorse the file wrapper of the said patent or patents, and to e same as a part of the contents of said file or file

Present statute

ion 78.

Note

t sentence of R. S. 4921.

ring patents

here are interfering patents, including for the purpose patents so related that the invention claimed in one be made, used or sold without infringing the other patentee may have relief against the interfering patentee , and the court may adjudge the question of infringe- validity of either or both of the patents.

Present statute

ised Statutes of 1874, amended Mar. 2, 1927, sec. 12, ch. 273, U. S. C. 66]:

e are interfering patents, any person interested in any one of orking of the invention claimed under either of them, may have interfering patentee, and all parties interested under him, by ainst the owners of the interfering patent; and the court, on

notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either or both of the patents void in whole or in part, upon any ground, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the right of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment.

Note

The present statute would be of no value with the changes in interferences of sections 44 and 52 and has been broadened to include the situation of dominant and subordinate patents.

§ 88. False marking

Whoever without the consent of the patentee, marks upon, or affixes to or uses in advertising associated with, anything made, used, or sold by him for which he has not obtained a patent, the name or any imitation of the name of the patentee, or the words "patent," "patentee" or the like with the intent of counterfeiting or imitating the mark of the patentee, or of deceiving the public and inducing them to believe that the thing was made or sold by or with the consent of the patentee; or

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

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

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

Present statute

Sec. 4901, Revised Statutes of 1874 [35 U. S. C. 50]:

Every person who, in any manner, marks upon anything made, used, or sold by him for which he has not obtained a patent, the name or any imitation of the name of any person who has obtained a patent therefor without the consent of such patentee, or his assigns or legal representatives; or

Who, in any manner, marks upon or affixes to any such patented article the word "patent" or "patentee," or the words "letters patent" or any word of like import, with intent to imitate or counterfeit the mark or device of the patentee, without having the license or consent of such patentee or his assigns or legal representatives; or

Who, in any manner, marks upon or affixes to any unpatented article the word "patent," or any word importing that the same is patented, for the purpose of deceiving the public, shall be liable, for every such offense, to a penalty of not less than $100, with costs; one-half of said penalty to the person who shall sue for the same, and the other to the use of the United States, to be recovered by suit in any district court of the United States within whose jurisdiction such offense may have been committed.

Note

paragraphs of the present statute are consolidated, a new para-
false marking of "patent applied for" is added and false advertis-
n all the offenses. The archaic informer action is eliminated and
ne is replaced by a maximum.

CHAPTER 13. PLANTS

Sec.
89. Patents for plants.
90. Description, claim.
91. Grant.
92. Assistance of Department of Agriculture.

§ 89. Patents for plants

Any person who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, may obtain a patent therefor, subject to the conditions and requirements of this title.

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

Present statute

See under section 21.

Note

The provision in R. S. 4886 (see section 21) is made a separate section.

§ 90. Description, claim

No plant patent shall be declared invalid on the ground of non-compliance with section 28 of this title if the description is made as complete as is reasonably possible.

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

Present statute

See under section 28.

Note

The first paragraph is the provision in R. S. 4888 (see section 28). The second paragraph is not in the statute but represents the actual practice.

§ 91. Grant

In the case of a plant patent the grant shall be of the exclusive right to asexually reproduce the plant.

Present statute

See under section 56.

Note

This provision is from R. S. 4884 (see section 56) but in making it a separate section its interpretation is clarified.

tance of Department of Agriculture

ident may by Executive order direct the Secretary of (1) to furnish the Commissioner of Patents such available of the Department of Agriculture, or (2) to conduct appropriate bureau or division of the department such on special problems, or (3) to detail to the Commissioner such officers and employees of the department, as the er may request for the purposes of carrying into effect n of this title relating to plants.

Present statute

f May 23, 1930, ch. 312, 46 Stat. 376 [35 U. S. C. 56a]:

ent may by Executive order direct the Secretary of Agriculture the Commissioner of Patents such available information of the f Agriculture, or (2) to conduct through the appropriate bureau the department such research upon special problems, or (3) to Commissioner of Patents such officers and employees of the depart- commissioner may request for the purposes of carrying this Act

Note

CHAPTER 14. DESIGNS

Sec.
93. Patents for designs.
94. Specification.
95. Right of priority.
96. Term.
97. Additional remedy for infringement.

§ 93. Patents for designs

Any person who has invented or designed any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

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

Present statutes

Sec. 4929, Revised Statutes of 1874, amended (1) May 9, 1902, ch. 783, 32 Stat. 193, (2) Aug. 5, 1939, sec. 1, ch. 450, 53 Stat. 1212 [35 U. S. C. 73, first paragraph]:

Any person who has invented any new, original, and ornamental design for an article of manufacture, not known or used by others in this country before his invention thereof, and not patented or described in any printed publication in this or any foreign country before his invention thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law and other due proceedings had, the same as in cases of inventions or discoveries covered by section 4886, obtain a patent therefor.

Sec. 4933, Revised Statutes of 1874 [35 U. S. C. 73, second paragraph]:

All the regulations and provisions which apply to obtaining or protecting patents for inventions or discoveries not inconsistent with the provisions of this title, shall apply to patents for designs.

Note

The list of conditions is omitted as unnecessary in view of the general inclusion of all conditions applying to other patents. Language is changed.

§ 94. Specification

The specification and claim of a design patent shall be in formal terms, referring to the drawing.

Note

This section is new in the statute, but represents the actual practice.

t of priority

od for the right of priority provided for by section 34 shall be six months in the case of designs.

Present statute

ection 34.

Note

ion is taken from R. S. 4887, second paragraph (see section 34) eparate section.

n of design patent

or designs may be granted for the term of three years and or for seven years, or for fourteen years, as the applicant application, elect.

Present statute

1, Revised Statutes of 1874 [35 U. S. C. 77]:

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

Note

tional remedy for infringement of design patent

he term of a patent for a design, it shall be unlawful for other than the owner of said patent, without the license ner, to apply the design secured by such patent, or any nitation thereof, to any article of manufacture for the ale, or to sell or expose for sale any article of manufacture ch design or colorable imitation shall, without the license r, have been applied. Any person violating the provisions, them, of this section, shall be liable in the amount of $250; the total profit made by him from the manufacture or resaid, of the article or articles to which the design, or nitation thereof, has been applied, exceeds the sum of all be further liable for the excess of such profit over and um of $250. And the full amount of such liability may d by the owner of the patent, to his own use, by civil ny district court of the United States having jurisdiction es.

in this section shall prevent, lessen, impeach, or avoid remedy which any owner of a patent, aggrieved by the t of the same, may have under the provisions of this ch owner shall not twice recover the profit made from the t.

Present statute

Act of Feb. 4, 1887, secs. 1 and 2, ch. 105, 24 Stat. 387, 388 [35 U. S. C. 74, 75]:

SECTION 1. During the term of letters patent for a design, it shall be unlawful for any person other than the owner of said letters patent, without the license of such owner, to apply the design secured by such letters patent, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or to sell or expose for sale any article of manufacture to which such design or colorable imitation shall, without the license of the owner, have been applied, knowing that the same has been so applied. Any person violating the provisions, or either of them, of this section, shall be liable in the amount of $250; and in case the total profit made by him from the manufacture or sale, as aforesaid, of the article or articles to which the design, or colorable imitation thereof, has been applied, exceeds the sum of $250, he shall be further liable for the excess of such profit over and above the sum of $250. And the full amount of such liability may be recovered by the owner of the letters patent, to his own use, in any circuit court of the United States having jurisdiction of the parties, either by action at law or upon a bill in equity for an injunction to restrain such infringement.

SEC. 2. That nothing in this act contained shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any owner of letters patent for a design, aggrieved by the infringement of the same, might have had if this act had not been passed; but such owner shall not twice recover the profit made from the infringement.

Note

A few verbal changes have been made.

CHAPTER 15. PATENT OFFICE FEES

Sec.
98. Patent fees.
99. Payment of patent fees; return of excess payments.

§ 98. Patent fees

The following shall be the rates for patent fees:

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

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

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

(d) On every application for the reissue of a patent, $30.

(e) On filing each disclaimer, $10.

(f) On an appeal for the first time from the primary examiners to the Board of Appeals, $25.

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

(h) For certificate of correction of applicant's under section 62, $10.

(i) For deposit of documents for custody in accordance with section 39, $1.

(j) For uncertified printed copies of specifications and drawings of patents (except design patents), 25 cents per copy; for design patents, 10 cents per copy; special rate for libraries specified in section 14 of this title, $50 for patents issued in one year.

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

(l) For each certificate, $1.

(m) For copies of records, publications, or services furnished by the Patent Office, not specified above, for which a charge may be made, such reasonable charge for the same as may be established.

Present statutes

Sec. 4934 of the Revised Statutes of 1874, amended (1) May 27, 1908, sec. 1, part, ch. 200, 35 Stat. 317, 343; (2) June 25, 1910, sec. 2, ch. 414, 35 Stat. 843; (3) Feb. 18, 1922, sec. 9, ch. 58, 42 Stat. 389, 393; (4) Feb. 14, 1927, sec. 2, ch.

. 1098, 1099; (5) Mar. 2, 1927, sec. 13, ch. 273, 44 Stat. 1335, 1337; 1930, sec. 3, ch. 132, 46 Stat. 155; (7) June 30, 1932, secs. 308, 309, Stat. 382, 410; (8) Aug. 9, 1939, sec. 3, ch. 619, 53 Stat. 1293 [35 :

wing shall be the rates for patent fees:
each original application for a patent, except in design cases, $30,
ach claim in excess of twenty.
g each original patent, except in design cases, $30, and $1 for each
ess of twenty.
cases: For three years and six months, $10; for seven years, $15;
years, $30.
application for the reissue of a patent, $30.
each disclaimer, $10.
peal for the first time from the primary examiners to the Board of
5.
appeal from the examiner of interferences to the Board of Appeals,

rtified printed copies of specifications and drawings of patents, 10
py: *Provided*, That the Commissioner of Patents may supply public
the United States with such copies as published, for $50 per annum:
rther, That the Commissioner of Patents may exchange copies of
es patents for those of foreign countries.
s of records made by the Patent Office, excluding printed copies,
r hundred words.
certificate, 50 cents.
ding every assignment, agreement, power of attorney, or other paper
ng six pages, $3; for each additional two pages or less, $1; for each
atent or application included or involved in one writing, where more
so included or involved, 50 cents additional.
s of drawings, the reasonable cost of making them.
each petition for the revival of an abandoned application for a patent
elayed payment of the fee for issuing each patent, $10.

(part), appropriation act of July 5, 1946, ch. 541, 60 Stat. 446, 471
78]:

Provided, That hereafter on July 1, 1946, and thereafter 25 cents
all be charged for uncertified copies of specifications and drawings of
1 10 cents per copy for design patents and certificates of trade-mark

Note

tems are rearranged in a few instances and are lettered for convenient

bsolete fee for appeal from the examiners of interferences to the Board
s omitted.
ee for appeal to the Board of Appeals is changed from $15 to $25 in
with the bill, S. 2433, which passed the Senate October 17, 1949.
provisos have been transferred to separate sections, secs. 13 and 14.
ee for a certificate is changed from 50 cents to $1 to correspond to
e in the trade-mark statute.
new items, (h) and (i) are added to go with sections 39 and 62.
nnibus item to take care of miscellaneous minor fees is added; in
, two items in the present schedule are omitted.

ment of patent fees; return of excess amounts

nt fees shall be paid to the Commissioner of Patents, who
sit the same in the Treasury of the United States in such
the Secretary of the Treasury shall direct, and the commis-

sioner is authorized to pay back any sum or sums of money paid to him by any person by mistake or in excess of the fee required by law.

Present statute

Sec. 1 (part), deficiency appropriation act of March 6, 1920, ch. 94, 41 Stat. 503; 512 [35 U. S. C. 79]:

Hereafter all patent fees shall be paid to the Commissioner of Patents, who shall deposit the same in the Treasury of the United States in such manner as the Secretary of the Treasury shall direct, and said commissioner is authorized to pay back any sum or sums of money paid to him by any person by mistake or in excess of the fee required by law.

(NOTE.—This enactment appears to supersede secs. 4935, 4936 of the Revised Statutes of 1874 which deal with the same subject.)

Note

The original enactment, from which the U. S. C. differs, is followed with slight change.

CHAPTER 16. MISCELLANEOUS PROVISIONS

Sec.
100. Separability clause.
101. Repeal.
102. Time of taking effect.

§ 100. Separability clause

If any provision of this title is declared unconstitutional or the application thereof to any person or circumstance held invalid, the validity of the remainder of this title or the application of such provision to other persons or circumstances shall not be affected.

Present statutes

Sec. 6, Act of May 23, 1930, ch. 312, 46 Stat. 376 [35 U. S. C. 326]):

If any provision of this Act is declared unconstitutional or the application thereof to any person or circumstance is held invalid, the validity of the remainder of the Act and the application thereof to other persons or circumstances shall not be affected thereby.

Sec. 1 (adding sec 6 to Act of July 1, 1940, ch. 501, 54 Stat. 710, Act of Aug. 21, 1941, ch. 393, 55 Stat. 697 [35 U. S. C. 42d]:

If any provision of this Act or of any section thereof or the application of such provision to any person or circumstances shall be held invalid, the remainder of the Act and of such section and application of such provision to persons or circumstances other than those as to which it is held invalid shall not be affected thereby.

Sec. 10, Act of Oct. 31, 1942, ch. 634, 56 Stat. 1013:

If any provision of this Act or the application of any provision to any person or circumstance shall be held invalid, or if any provision of this Act shall be inoperative by its terms, the validity or applicability of the remainder of the Act shall not be affected thereby.

Note

Separability clauses appear in the three different patent acts. Only one such clause is included herein and is worded so that it applies to any provision in the entire law.

§ 101. Repeal of prior acts

The following acts or parts of acts are hereby repealed:

[Table of acts to be repealed to be inserted.]

§ 102. Time of taking effect

(a) This title shall take effect on _____ 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.

n 25 of this title shall not apply to existing patents and pending before the effective date and to patents granted cations.

34 of this title, second paragraph, shall not apply to nts.

ns 35 and 36 of this title, insofar as they change the of existing law shall not apply to existing patents. tence of section 36 of this title shall apply to existing e option of the patentee but in such event the restriction also apply.

der of secrecy heretofore issued, and subsisting on the pproval of this act, shall be considered as an order issued section 38 of this title and shall continue in force and period of one year from the effective date of this act rescinded as provided herein. Any claim arising under hich section 38 of this title is amendatory and unsettled ctive date of this act may be presented and determined he provisions of section 38 hereof.

s 44 and 52 of this title shall not apply to interferences the Patent Office before the effective date and, with ch interferences, the laws in force prior to the effective pply as though not repealed, unless all parties to the gree otherwise.

n 57 of this title shall not apply to existing patents but patents granted on applications pending on the effective that the period of pendency prior to the effective date ncluded in the 20-year period specified therein.

n 64 of this title, insofar as it changes existing law, shall instruments executed before the effective date and re- three months from the effective date.

65 of this title, insofar as it changes existing law, shall transactions entered into before the effective date.

66 of this title shall not apply to render void any specific condition therein entered into before the effective date n made.

n 67 of this title shall apply to licenses executed prior to date if they are still in effect on said date but the time such licenses shall be three months from the effective

riod of one year specified in section 22 of this title shall the case of applications filed before August 5, 1940, and ed on such applications, and with respect to such applica- tents, said period is two years instead of one year.

(m) No variety of plant which has been introduced to the public prior to May 23, 1930, shall be subject to patent.

(n) Nothing contained in this title shall operate to nullify any judicial finding on the validity of any patent by a court of competent jurisdiction.

(o) Nothing is this title shall affect any provision of the Atomic Energy Act of 1946 (Aug. 1, 1946, ch. 724, 60 Stat. 755).

Note

Transitory provisions relating to various sections, and a few other provisions, are collected in one place. Paragraph (l) is the transitory provision in the Act of Aug. 5, 1939, sec. 2, ch. 450, 53 Stat. 1212. Paragraph (m) is the transitory provision in the Act of May 23, 1930, sec. 5, ch. 312, 46 Stat. 376 (35 U. S. C. 32a).

ADDITIONAL ITEMS

1. Revocation or cancellation of patents.
2. Compulsory licenses.
3. Short term or minor patents.
4. Patents of addition.
5. Maintenance or renewal fees.

1. Revocation or Cancellation of Patents

§ 1. Revocation on motion of Patent Office

The Patent Office may reconsider the grant of a patent and, on notice to the patentee sent within one year from the date of the patent and after opportunity for hearing, may cancel any claim of the patent.

If any person notifies the Patent Office of any patents or printed publications not cited during the prosecution of an application for patent which may affect the validity of the patent and the Patent Office shall consider such material if received in sufficient time for reconsideration of the grant of the patent provided in this section.

§ 2. Revocation on petition of interested person

Any person interested may petition the Commissioner, within one year from the grant of a patent, to cancel the patent or any claim thereof on the ground:

(a) That the invention is not new or patentable in accordance with the requirements of chapter 2; or

(b) That the specification does not comply with the requirements of section 28.

§ 3. Revocation on motion of the Attorney General

The Attorney General may apply to the Patent Office to cancel a patent on the ground of fraud or misrepresentation in obtaining the patent.

If in any action brought by the United States under the antitrust laws the defendant maintains that the actions complained of were a valid exercise of rights under a patent, the Attorney General may apply to the Patent Office to cancel the patents on any of the grounds specified in section 2, but the validity of the patent may not be raised in said action.

during suit involving patent

which the validity of a patent may be considered
court may require the party raising the issue of
tent to proceed to seek revocation of the patent
Office, within such time as the court may designate.
in such proceeding shall consider any evidence in
may be certified to it as well as any evidence pro-
Upon failure to initiate proceedings within the
party in default may not question the validity of
action.

ts for petition

r cancellation must be in writing and verified; it
rounds upon which it is based and include a state-
to be relied upon, and (except in a proceeding
reof) be accompanied by the fee required.

hearing

of any petition for cancellation the Commissioner
atentee and any person having an interest in the
been recorded in the Patent Office, and afford
ies an opportunity for the presentation of evidence

the Patent Office shall be by the Commissioner
the Board of Appeals, as the Commissioner may
for cancellation is made out, the Commissioner
ims or any specified claim of the patent cancelled.

the Patent Office may be reviewed, at the instance
party, by appeal or by civil action as provided in
tions for patents and interferences, but any review
tion 4 shall be in the court having jurisdiction of

patentee

st of the patentee, in cases under sections 1 and 2,
eral shall provide counsel to represent and appear
nd to conduct the proceedings on his behalf.

Notes

he proposal often made that applications for patent be
tent is granted to give the public an opportunity to submit

material to the Patent Office bearing on patentability; administration would be simpler if this were done after the grant instead of before.

Sections 2 and 9 follow a recommendation of the National Patent Planning Commission (1941). Section 4 is also based on a recommendation of the National Patent Planning Commission.

Section 3, in the first paragraph, substitutes an action in the Patent Office for the present original action by the Attorney General to cancel a patent for fraud. The second paragraph raises the question of whether the validity of a patent should be considered in an antitrust suit by the Government.

2. Compulsory Licenses

1. Grounds for compulsory license

Any person may apply to the Commissioner of Patents for the grant of a license under a particular patent at any time after the expiration of three years from the grant of the patent, under any of the following circumstances:

(a) If the patented invention is not being worked in the United States on a commercial scale without reasonable justification.

(b) If the demand for the patented invention in the United States is not being met to an adequate extent without reasonable justification or is being met to a substantial extent by importation.

(c) If by reason of conditions attached by the patentee to licenses under the patent, or to the purchase, lease or use of the patented article or process, the manufacture, use or sale of materials not protected by the patent is unreasonably restrained or if the patent has been used to unreasonably restrain trade beyond the actual rights conferred by the patent.

(d) If the decree of a court in an action by the United States under the anti-trust laws has declared that the patent shall be available for licensing to any applicant on reasonable terms.

(e) If the use of the patented invention is necessary for public health or public safety.

(f) That the applicant for license is the patentee of an invention of an improvement on the patented invention which cannot be worked without utilizing the patented invention, provided that the improvement is a substantial and important contribution to the art and the applicant for license is willing and able to grant to the patentee and his licensees a license to use his improvement on reasonable terms.

In determining the existence of reasonable justification under paragraphs (a) and (b) there shall be considered, among other factors, the efforts of, and measures taken by, the patentee and whether sufficient time has elapsed since the date of the patent to work the invention or supply the market, considering the nature of the invention and the resources of the patentee.

notice and hearing

on for license must be in writing and verified, it must grounds upon which it is based and include a statement to be relied upon and of the nature and terms of the ed. Upon the filing of any petition for license and the the prescribed fee the Commissioner shall notify the any person having an interest in the patent which has d in the Patent Office and afford all interested parties ity for the presentation of evidence and for a hearing.

license

missioner finds that the circumstances recited in section t and a case for the grant of a license is made out, and the public interest that a license should be granted, he he grant of an appropriate license and, in default of mong the parties to the terms and conditions of the nay also fix such terms and conditions in the order. f the Commissioner granting a license under this act, omes final, shall operate as a license executed by the l all other necessary parties.

on of the Commissioner may be reviewed at the instance ved party by appeal or by civil action as provided in the ferences.

Notes

ngs up the controversial subject of compulsory licensing of patents. of section 1 recites the customary ground for grant of a compulsory h (a) and (b) would apply in the case of foreign owned United when the invention was not being manufactured in the United raph (c) is a possible remedy in the case of abuse of patents. relates to the existing power exercised by the courts in civil anti- Paragraph (e) follows a recomn endation of the National Patent nission (1943). Paragraph (f) is commonly found in laws of other ere have been numerous legislative proposals for compulsory country.

3. Short Term or Minor Patents

cant for a patent for a material object in the fields of bject matter specified in section 21 may request a patent five years. Such patent shall be subject to the following

ne claim may be present.

atent shall be granted without consideration of the cified in section 23 except to a small degree, and the

patent shall likewise not be held invalid for failure to satisfy such condition, but such patent shall not be entitled to any scope or range of equivalents beyond the specific thing disclosed and claimed except to a small degree.

(c) The final fee for issuing such patent shall be one third the final fee for other patents.

Note

This item brings up the subject of whether a second class of short term or minor patents should be provided for, but the differentiation between the two classes and also their relationship would need development.

4. Patents of Addition

Whenever an application is made for a patent for an improvement on an invention for which the applicant has previously applied for or obtained a patent, or when an application for patent for an improvement is owned by the same person who owns the prior application or patent, the Commissioner may at the request of the applicant issue the patent for the improvement as a patent of addition. A patent of addition shall not be granted until after the grant of the main patent, and the term of a patent of addition shall expire on the same date as the main patent. A patent of addition shall not be refused nor held invalid solely on the ground that the subject matter thereof may not be considered to involve invention, within the meaning of section 23, over the invention of the main patent, provided the subject matter claimed in a patent of addition is included within the scope of a claim of the main patent.

Note

This proposal is intended to bring up the subject of patents of addition which are found in the laws of many countries.

5. Maintenance of Renewal Fees

1. During the period of the duration of a patent there shall be paid a first maintenance fee prior to the expiration of the fifth year from the date of the patent and a second maintenance fee prior to the expiration of the tenth year from the date of the patent, but said fees may be paid within six months after the expiration of the fifth or tenth years, respectively, upon payment of the additional fee prescribed. Notice of the requirement for the payment of the maintenance fees shall be attached to or embodied in the patent. Failure to pay the maintenance fees shall result in the termination or lapsing of the exclusive right conferred by the patent at the end of the fifth year or at the end of the tenth year as the case may be.

nts for designs shall be granted for the term of fifteen
oject to the payment of maintenance fees as in the case of
ents.

following shall be the maintenance fees:

st maintenance fee, payable before the expiration of the
year of the patent, $50, and $25 in the case of design patents;

cond maintenance fee, payable before the expiration of the
year of the patent, $75, and $25 in the case of design
ts;

yed payment of a maintenance fee up to six months, for
th or fraction thereof, $10, and $5 in the case of design

Note

osal follows H. R. 3700, 80th Congress, which is a modification of a
ation of the Science Advisory Board, 1935, and brings up the subject
l fees intended to eliminate from being in force patents in which
are no longer interested.

APPENDIX

TABLE OF PATENT LAWS, 1874–1949*

(A) REVISED STATUTES OF 1874

R. S. Sec.	Draft Sec.
440	Repealed Mar. 3, 1933
475	1
476	3
477	Repealed Mar. 3, 1933
478	2
479	5
480	4
481	6
482	7
483	6
484–5	Repealed Mar. 3, 1933
486	8
487	18, 19
488	15
489	12
490	Repealed Mar. 3, 1933
493	98
494	16
495	Obsolete
496	Obsolete
892	Repealed June 25, 1948, and replaced by 28 U. S. C. 1744
893	Repealed June 25, 1948, and replaced by 28 U. S. C. 1746
894	Repealed June 25, 1948, and replaced by 28 U. S. C. 1746
973	Repealed June 25, 1948, and replaced by 28 U. S. C. 1928
4883	55
4884	56, 91
4885	53
4886	21, 22, 89
4887	22, 34, 95
4888	27, 28, 90
4889	29
4890	30
4891	30
4892	31
4893	40
4894	42, 69
4895	54
4896	33
4897	Repealed Aug. 9, 1939
4898	64
4899	75
4900	84
4901	88
4902	Repealed June 25, 1910
4903	41, 44
4904	44
4905	45
4906	46
4907	46
4908	46
4909	43
4910	Repealed Mar. 2, 1927
4911	47
4912	48
4913	49
4914	50
4915	51, 52
4916	58, 59
4917	60
4918	87
4919	78, 81
4920	79
4921	78, 80–83, 86
4922	85
4923	24
4924–8	Repealed Mar. 3, 1933
4929	93
4930	Omitted
4931	96
4932	Repealed Mar. 3, 1933
4933	93
4934	13, 14, 68
4935	99
4936	99

(B) STATUTES AT LARGE

Date	Chapter	Section	Volume	Page	Draft Section
Mar. 3, 1883	143	(Part)	22	625	68.
Feb. 4, 1887	105	1, 2	24	387	97.
Feb. 18, 1888	15		25	40	55.
Mar. 3, 1891	541	1 (part)	26	939	10.
Feb. 9, 1893	74	9	27	436	48, 51, 52.
Jan. 12, 1895	23	73 (part)	28	619	(Printing, 44 U. S. C. 283–4, not affected by draft.)
May 9, 1896	204		29	124	98.
Mar. 3, 1897	391	1	29	692	21, 22.
		2		692	79.
		3		693	22.
		4		693	42.
		5		693	64.
		6		694	78, 80–83, 86.
		7		694	Omitted.

*Does not include private laws, appropriation acts, some temporary laws, and some laws relating to courts and jurisdiction now in title 28.

ABLE OF PATENT LAWS, 1874–1949—Continued

(B) STATUTES AT LARGE—Continued

	Chapter	Section	Volume	Page	Draft Section
	423	1	30	440	93.
	227		30	915	33.
	417		32	95	55.
	783		32	193	93.
	1019	1	32	1225	22, 34, 95.
		2		1226	31.
		3		1226	33.
		4		1227	Amends R. S. 4902.
	188		35	245	33.
	189		35	246	53.
	200	1 (part)	35	343	98.
	414	1	36	843	Repeals R. S. 4902.
		2		843	98.
	423		36	851	Repealed June 25, 1928, and replaced by 28 U. S. C. 1498.
	Pub. Res. 61		38	1221	13.
	94	1	38	958	27, 28.
		2		959	29.
	22	1	39	8	Amends R. S. 476.
		2		9	2.
		3		9	Amends R. S. 440.
	225	1 (part)	39	348	42.
	95		40	394	38.
	114		40	705	Amends Act of June 25, 1910, repealed June 25, 1928, and replaced by 28 U. S. C. 1498.
	93	1 (part)	41	235	98.
	94	1 (part)	41	512	99.
	126	1–8	41	1313	Obsolete.
	58	1	42	389	Amends R. S. 477.
		2		389	Amends R. S. 440.
		3		390	18, 19.
		4		391	Amends Act of Jan. 12, 1895.
		5		391	55.
		6		391	64.
		7		391	46.
		8		392	78, 80–83, 86.
		9		393	13, 14, 98.
	230		43	942	Omitted.
	535	1	43	1268	61.
		2		1269	Amends R. S. 892.
	67		44	1058	84.
	139	1	44	1098	2.
		2		1099	98.
	273	1	44	1335	42.
		2		1335	Amends R. S. 4897.
		3		1335	7.
		4		1336	44.
		5		1336	43.
		6		1336	Repeals R. S. 4910.
		7		1336	Repeals Sec. 9, Act of Feb. 9, 1893.

TABLE OF PATENT LAWS, 1874–1949—Continued

(B) STATUTES AT LARGE—Continued

Date	Chapter	Section	Volume	Page	Draft Section
Mar. 2, 1927	273	8	44	1336	47.
		9		1336	48.
		10		1336	49.
		11		1336	51, 52.
		12		1337	87.
		13		1337	98.
		14		1337	17.
Mar. 3, 1927	364		44	1394	52.
Apr. 30, 1928	460		45	467	68.
May 24, 1928	730		45	732	58, 59.
May 31, 1928	992	1–4	45	1012	Obsolete.
Mar. 2, 1929	488	2	45	1476	47, 48, 51, 52.
Apr. 21, 1930	132	1	46	155	3.
		2		155	7.
		3		155	98.
		5		156	Omitted as repealed or superseded by Act of June 26, 1934, sec. 6, ch. 756, 48 Stat. 1228 (31 U. S. C. 725e).
		6		156	11.
May 23, 1930	312	1	46	376	21, 22, 27, 28, 56, 89, 91.
		2		376	90.
		3		376	31.
		4		376	92.
		5		376	102 (m).
		6		376	100.
June 30, 1932	314	308	47	410	98.
		309		410	98.
Mar. 3, 1933	202	1	47	1428	Repeals R. S. 440, 477, 484, 485, 490, 491, 492, 4924–4928, 4932.
June 19, 1936	94		49	1529	22, 34, 95.
May 9, 1938	188		52	342	20.
Aug. 5, 1939	450	1	53	1212	21, 22, 34, 79, 92, 95.
		2		1212	102 (l).
Aug. 5, 1939	451	1	53	1212	44.
		2		1212	43.
		3		1212	47.
		4		1212	51, 52.
Aug. 5, 1939	452	1	53	1213	41.
Aug. 7, 1939	568		53	1264	42.
Aug. 9, 1939	619	1	53	1293	Repeals R. S. 4897.
		2		1293	53.
		3		1293	98.
July 1, 1940	501	1	54	710	38.
July 2, 1940	515		54	724	19 U. S. C. 1337a, not affected by draft.
Aug. 18, 1941	370		55	634	64.
Aug. 21, 1941	393		55	657	38.
June 16, 1942	415		56	370	38.
Oct. 31, 1942	634		56	1013	77.
July 5, 1946	541	301 (part)	60	471	98.
Aug. 1, 1946	724	11	60	768	Atomic Energy Act, not affected by draft.
Aug. 1, 1946	726	1	60	778	78, 80–83, 86.
Aug. 7, 1946	775		60	873	Expired.

TABLE OF PATENT LAWS, 1874–1949—Continued

(B) STATUTES AT LARGE—Continued

Date	Chapter	Section	Volume	Page	Draft Section
	910	1–15	60	940	Not included or affected by draft; part of sec. 9 included in sec. 26.
	302		61	413	Not included or affected.
	511		61	794	Not included or affected.
	646		62	869	Title 28, Judicial Code and Judiciary, repeals Act of June 25, 1910, amended July 1, 1918, and R. S. 892, 893, 894, and 973, and replaces by 28 U. S. C. 1498, 1744, 1745, 1746, 1928. Not included or affected.
	139				Amends 28 U. S. C. 1498, 1744, 1746; repeals 28 U. S. C. 1745.

UNITED STATES CODE, TITLE 35

Draft Sec.	35 U. S. C. Sec.	Draft Sec.	35 U. S. C. Sec.	Draft Sec.
1	40	56, 91	62	50
3	40a	Obsolete	63	51, 52
2	40b	Obsolete	64	58, 59
4	40c	Obsolete	65	60
5	40d	Obsolete	66	87
6	41	53	67	78
7	42	38	69	79
8	42a	38	70	78, 80–83, 86
18, 19	42b	38	71	85
20	42c	38	72	24
15	42d	38, 102	72a	52
12	42e	38	73	93
10	42f	38	74	97
13	43	Omitted	75	97
12	44	54	76	Omitted
Obsolete	45	68	77	96
Omitted	46	33	78	13, 14, 98
Obsolete	47	64	79	99
16	48	75	80–87	Obsolete
17	49	84	88	61
Obsolete	50	88	89	77
11	51	41	90	77
21, 22, 89	52	44	91	77
22, 34, 95	53	45	92	77
102	54	46	93	77
100	55	46	94	77
27, 28, 90	56	46	95	77
29, 30	56a	92	96	77
31	57	43	101–114	Not included or affected by draft, part of 109 in sec. 26
40	59a	47		
42, 69	60	48		
55	61	49		