APPENDIX

EXECUTIVE OFFICE OF THE P
BUREAU OF
Washington, D.

HON. EMANUEL CELLER,
Chairman, Judiciary Committee,
House of Representatives, Washington 25, D. C.

MY DEAR MR. CHAIRMAN: Reference is made to H. R. 3760
codify the laws relating to patents and the Patent Office, a
title 35 of the United States Code entitled "Patents," whic
your committee.

An examination of this bill indicates that it vests directly
of Patents most of the functions relating to patents. In
with, and would partially nullify, Reorganization Plan N
became effective May 24, 1950. This plan transferred to th
merce all functions then vested in other officers and agencie
except those vested in hearing examiners, the Inland Wat
and the Civil Aeronautics Board. It also authorized the
for the performance of any of his functions by any officer,
of the Department. As a result of this reorganization plan,
are now legally vested in the Secretary of Commerce but a
Commissioner of Patents by delegation by the Secretary.

Reorganization Plan No. 5 of 1950 is one of a series of
which have become effective within the last 2 years transf
of nearly all subordinate officers and agencies to the Secr
six civil departments. A similar transfer has been effecte
Law 73, 81st Cong.) with respect to a seventh department
State. These transfers have been made to carry out two
tions for improving departmental administration which
Commission on Organization of the Executive Branch, t
Report on General Management of the Executive Branch, he
"*Recommendation No. 1*.—Under the President, the he
must hold full responsibility for the conduct of their depart
be a clear line of authority reaching down through every s
superior" (p. 34).

"*Recommendation No. 20*.—We recommend that the dep
"*Recommendation No. 20*.—We recommend that the dep
be given authority to determine the organization within his
These recommendations embody fundamental principles
istration which have been worked out through years of e
ment and industry and have been widely applied in large bu
By vesting all functions directly in the head of the depart
gation by him, these plans eliminate question as to the aut
bility of the department heads for the effective administ
of his department. At the same time, these plans enable t
to make adjustments in the internal organization of his dep
the delegations of the functions legally vested in him.

In each case the head of the department initially re
While in each case the head of the department initially re
ferred functions to the officers who had previously possesse
changes in delegations have already been made to gear the
administration of defense activities. In the case of the S
administration plan made it possible for the
merce, the reorganization plan made it possible for the
from the existing bureaus a number of units and activiti
up the National Production Administration to handle def
assigned to the Department. Though the reorganization plan

reference to a defense emergency and became effective a month
sion of Korea, they have proved a valuable tool in organizing the
of the defense program.
change and new problems arise, these reorganization plans will
te the adaptation of departmental organization to the new re-
owever, if the bills adopted by the Congress to enact titles of the
ite law vest the functions in subordinate officers, this possibility
ocked and the purpose of the reorganization plans destroyed.
asons, it is very important that new legislation, and especially
ng entire titles of the code, adhere to the pattern established
anization plans of vesting functions in the heads of departments
bureau chiefs and other subordinate officers. This principle has
ved by the Congress in case of certain departments, particularly
s of State, Post Office, and Agriculture, and now applies to the
rtments. In this connection it should be noted that the Congress
is principle in the numerous regulatory laws administered by the
Agriculture as well as those relating to its operating programs.
I should urge that your committee revise H. R. 3760 to vest the
he Secretary of Commerce rather than the Commissioner of

yours,

ELMER B. STAATS, *Acting Director.*

THE SECRETARY OF COMMERCE,
Washington, June 20, 1951.

BRYSON,
Subcommittee No. 3, Committee on the Judiciary,
of Representatives, Washington, D. C.

AIRMAN: This letter is in further reply to your communication
1, requesting the comments of the Department concerning H. R.
revise and codify the laws relating to patents and the Patent
act into law title 35 of the United States Code entitled "Patents."
nacted, would codify the patent laws, enact title 35 of the United
o law, and make certain revisions in existing patent laws. The
Commerce is fully in accord with the purpose of H. R. 3760 but
y to object to the use of language inconsistent with the provisions
on Plan No. 5 of 1950.
1950, the President transmitted to the Congress Reorganization
50, which vested in the Secretary of Commerce the responsibility
nance of all other offices of the Department and all functions of
l employees (with exceptions not here relevant) of such Depart-
ons unfavorable to the plan failed to pass either House and the
ective March 24, 1950.
before the Committee on Expenditures in the Executive Depart-
use of Representatives, the Secretary of Commerce stated that—
idea of the plan is to make the Secretary of Commerce respon-
well as in theory for the operations of the Department which he
t reservation, I am convinced sincerely that this plan is entirely
of both theory and practical operation."
ony before the committee at that time the Secretary dealt at
d went into considerable detail concerning the functions of the
nd the effect of the passage of the plan on the location and
hose functions. He stated:
tention of changing the present procedure or the present powers
ommissioner or the Patent Office, and I have already announced
authorizing the Commissioner and the Patent Office to continue
ir functions in accordance with their present statutory powers."
al order carrying out this announced policy was promulgated
en the plan went into effect.
H. R. 3760 in its present form without providing for the vesting
described therein in the Secretary of Commerce would effect a
f Reorganization Plan No. 5, and we are opposed to any such
ngly, it seems appropriate that provision be made in the proposed
continuing the amendment made by this plan.

It appears that amendment of H. R. 3760 to provide for the performance of the functions by the Secretary of Commerce would be the procedure which would be the most satisfactory, since the resulting bill would clearly set forth the officer of the Government with primary responsibility. We will be glad to work with the staff of the committee in the task of making appropriate amendments to the bill for this purpose.

As an alternative, but less direct and therefore less desirable, method of accomplishing this purpose we suggest the addition to the bill of a section reading somewhat as follows:

"SEC. —. For the purposes of Reorganization Plan No. 5 of 1950, this Act shall be deemed to have been enacted prior to the effective date of such plan.".

Language similar to that here proposed was adopted by the Congress in enacting the Social Security Act Amendments of 1950 (Public Law 734, 81st Cong.).

Apart from the problems arising with regard to Reorganization No. 5 the Department believes that the selection of the statutes to be included in the title, and the changes in the language required by the arrangement and the omission of obsolete material have been in general, very well carried out in the bill.

In addition to the codification the bill also proposes to make various changes of substance in the patent laws. Since most if not all of the changes introduced are of a minor character or are of a procedural nature and substantially noncontroversial, or, are such that general unanimity of opinion can be easily obtained, the Department has no objection to the changes proposed.

If we can be of further assistance in this matter in any way, including technical assistance by experts in our Department, please call on us.

We are advised by the Bureau of the Budget that it would interpose no objection to the submission of this report.

Sincerely yours,

D. W. RENTZEL,
Acting Secretary of Commerce.

THE NATIONAL EDITORIAL ASSOCIATION,
Washington D. C., June 25, 1951.

Representative JOSEPH R. BRYSON,
House Office Building, Washington, D. C.

DEAR MR. BRYSON: It is our understanding that subcommittee No. 3, of which you are chairman, has just completed a series of hearings with respect to H. R. 3760. The proposed omission of the following, "by word, circular, letter, or by advertising" provokes some concern on the part of our newspapers. There have been so many attempts to curtail advertising with respect to Patent Office that we are frankly suspicious that this omission could be construed as granting the Commissioner of Patents additional control over advertising by patent attorneys or agents.

The National Editorial Association is a trade organization representing approximately 6,000 newspapers published largely in small towns, some weekly, some semiweekly, and several hundred dailies, and having distribution in every State of the Union. The South Carolina Press Association is one of our affiliated groups. So long as advertising conforms to established principles of truth and decency and its effect is not contrary to the public welfare, we are committed to defend its use against all further restrictions.

I am sure that the publishers of your State and other areas represented by our membership will appreciate your thoughtful consideration in clarifying H. R. 3760 to the extent that the Patent Office cannot possibly interpret any section of the bill as giving it arbitrary control over advertising.

Very truly yours,

ED M. ANDERSON,
Chairman, Legislative Committee,
National Editorial Association.

A. PAUL CONNOR,
ATTORNEY AND COUNSELLOR AT LAW,
Baltimore 17, Md., May 14, 1951.

ising ethics.

ON,
Congress,
ashington, D. C.

MAN: I suggest that you look into the following phase in patent
is that some patent attorneys expend some $5,000 a month in
n periodicals. The same attorneys employ learners to make up
, but get the full fee for the work, leaving the impression with
they are getting the personal service of the members mentioned
concern.

he Commissioner of Patents would be glad to furnish data on
ent practice. It would seem consistent with good practice to
ture for paid commercial advertising by patent attorneys to
t normal rates (no discounts or rebates). And put this in the
e enforceable.

truly,

A. PAUL CONNOR.

KANE & KOONS,
Washington, D. C., June 15, 1951.

Esq.,
Counsel, House Judiciary Committee,
Representatives, Washington, D. C.

In our brief conversation of yesterday, I gave you a reference
941, of the Reports of the American Bar Association (1936),
t Mr. Howson, of Philadelphia, recommended the amendment
11, of the United States Code (R. S. 487), by striking out from
e thereof the words "by word, circular, letter, or advertising."
f that reference will further show that Mr. Howson explained
of those words in the statute had been construed "by some" as
ference that some advertising by patent attorneys is proper,
atute then and now stands, there is a question as to whether
ssioner has the power to prohibit registered patent attorneys
except when done with misleading intent.

of the committee on ethics and grievances of the American
the section of patent, trade-mark, and copyright law (1939),
at Conway P. Coe, when he was Commissioner of Patents,
as preventing him from prohibiting advertising. The follow-
rom that report:

tly a conference was held at Chicago on February 19, 1939,
greed that the most desirable action would be the Commis-
ion of a rule prohibiting the practice but that, irrespective of
posed he might be, he would not take such action unless the
clarified by amendment, as it is his view that under it he does
rity to do so. He has been advised that the following portion
e present act: 'or who shall with intent to defraud in any
nislead, or threaten any applicant or prospective applicant
ving immediate or prospective business before the Office by
er, or by advertising' are words which limit the broad dis-
which the statute apparently intends to vest in him."

made to volume 65, Reports of the American Bar Associa-
170 et seq. On page 471 it appears that the section of patent,
pyright law reported to the American Bar Association in

er of Patents alone has power to discipline registrants who
d it is asserted that the power given him by statute (R. S.
is insufficient to enable him to forbid all advertising because
by mentioning advertising, impliedly authorizes it."

upon recommended to the bar association—for the purpose
e result of enlarging the Commissioner's power in order to
or him to forbid advertising—the enactment of a statute
om the law the words "or who shall, with the intent to defraud

in any manner, deceive, mislead, or threaten any applicant or prospective applicant or other person having immediate or prospective business before the Office by word, circular, letter, or by advertising."

I have deemed it advisable to give you these further references because you apparently had not been advised that the patent law section of the American Bar Association has for more than 15 years been attempting to have the word "advertising" deleted from the statute. By writing this letter I do not intend to foreclose my right to file the written statement which we discussed yesterday. This letter is intended merely as something which you may use in your discussion of the matter in the executive session next week.

Thanking you for your courtesies in this matter, I am

Very truly yours,

AL. PHILIP KANE.

POPULAR SCIENCE PUBLISHING CO.,
New York, N. Y., July 9, 1951.

Mr. JOSEPH R. BRYSON,
Chairman, Subcommittee No. 3, Committee on the Judiciary,
House of Representatives, Washington, D. C.

DEAR MR. BRYSON: Thank you for your very courteous letter of July 6 regarding the status of that part of H. R. 3760 in which we are interested.

In addition to any other material that has been submitted to you and your associates in relation to section 32, I would like to take a moment of your time to incorporate in this letter the statement that as publisher of one of the largest circulation magazines in the country (more than a million every month) of interest to inventors, we have, over the years, received a negligible number of complaints from inventors about the patent attorneys using our columns. In fact, our present editor tells me that since September 1948 we have had no complaints whatsoever from our readers about patent attorneys.

So I hope that whatever form the bill you are now working on takes it will preserve the rights of patent attorneys to effectively tell inventive Americans that their services are available.

With best regards, I am,

Cordially yours,

GODFREY HAMMOND, *Publisher.*

NEW ORLEANS, LA., *May 9, 1951.*

Hon. JOSEPH R. BRYSON,
House of Representatives,
Washington, D. C.

DEAR SIR: I have recently completed reading your bill H. R. 3760 that is to revise and codify the laws relating to patents and the Patent Office.

I respectfully make the following comments and suggested amendment to your bill after having had over 20 years' personal experience in patent matters, working for both patent attorneys and inventors.

I sincerely believe there is a large number of people like myself who are now doing a certain kind of patent work that will become illegal to perform should your bill as it is now written become a law.

I am speaking of those of us who are now employed by patent attorneys from time to time to write their specifications, claims, and amendments, and then return the same to them for prosecution in the United States Patent Office. I have been employed for this type of work when the local attorney is busy or when he desires the benefit of my years of experience as a mechanical engineer with invention development experience. I am, of course, always paid by the job. Another hardship, your bill as it now stands will be on the engineer who assists the development of an invention for a person of very limited means and is then employed to make a patent drawing, write the specifications and claims. The work is then given to the inventor for whatever disposal he sees fit.

No one wants to see the inventor protected and the legal profession preserved more than I do, but I feel that there is a certain type of worker, as described in the last paragraph, that is more and more being placed in an impossible position. Therefore, I suggest that the following be added to chapter 1, section 31, of your bill: Patent Office; practice before Patent Office; regulations for agents and attorneys.

That the Commissioner of Patents shall issue a certificate of
rite patent specifications, claims, and amendments to anyone
t written proof from a registered patent attorney or agent that
ng application for certificate has been employed by them con-
ears or part time for 5 years; that the certificate shall state if
alified just to write specifications, or the claims, or the amend-
ree, and if they are qualified to write the same for chemical,
echanical inventions; that a charge of $10 shall be made for

gested, addition does not in any way whatsoever suggest, approve
nt a person other than as now licensed be permitted to practice
t Office. In fact, I would even make it a crime for the tele-
s to list people whose ads in the yellow section suggest they
neys. (Some people still do this in spite of all the laws and
well knows of the fact.)
sir, a large number of people are misled about inventions
the report they receive on searches, yet, anyone in Washing-
advertise they make patent searches and send any kind of a
it. They can work for an attorney and still only half do the
found out for months, and there is no restrictions put on this
people required to show they are qualified to make a patent
ing so.
ter often overlooked is the fact there is practically no school
the country where one can go and take a course in patent law.
ll give serious consideration to the above matter and be able
n of amendment to your bill that will permit others like myself
rform certain useful services to inventors and patent attorneys
ls. Services, I respectfully repeat, are not desired by us to be
ctice of patent law. I am sure that neither you or the Com-
ents have any desire to force me out of work, yet, what can
ur bill be passed? Patent attorneys here in the South do not
ve enough work to keep one busy, and I for one cannot afford
to make a connection with a patent attorney in another city.
ruction in patent law is given in this area.
ny ability in patent work given by a registered patent attorney
iner in the Patent Office is not taken as proof enough under
or me to be granted an agent's license, and I know from experi-
ot pass an examination for the same without first taking a
law. This latter is not because I do not know everyday pro-
e I am not up on the finer points of the subject.
have the pleasure of hearing from you regarding this matter.
ours,

J. OWEN EVANS.

1821 TWENTY-FIRST AVENUE, LONG ISLAND CITY, N. Y.
May 15, 1951.

RYSON,
ubcommittee on Patents Trade-Marks, and Copyrights,
Representatives, Washington 25, D. C.

ON: As a member of the patent bar for the past 9 years, pre-
ne I was an examiner in the United States Patent Office for 11
en deeply interested in H. R. 3760 which you recently intro-
u for sending me a copy of your bill.
r the provisions of your bill and believe that it will do much to
gthen the patent law. However, I should like to recommend
al clause be added in order to clarify the application of section

his section was not meant to apply to applications which were
ffective date of the act, nor to patents which have been or will
applications. Although section 4 of chapter 4 was probably
t such applications from the provisions of section 4 of chapter
ch exemption should be made more explicit, and several mem-
bar with whom I have discussed this matter agree with me.
mend that a section, somewhat as follows, be added to the bill:
le 35, as enacted by section 1 hereof, shall not apply to appli-
to the date on which this Act shall take effect, nor to patents

issued or to be issued on such applications, but the law previously in effect, namely Revised Statutes 480 (U. S. C., title 35, sec. 4, 1946 ed.) shall apply to such patents and applications."

I should like to make another recommendation. All patent examiners are qualified as engineers. The provisions of the above section of the bill would greatly reduce their ability to get employment as research and development engineers, since their employers would be placed at a great disadvantage in respect to inventions which such employees might make within 1 year after they left the Patent Office. To give sufficient notice to examiners who are contemplating employment as engineers, it is recommended that the provisions of the above section should not be made effective as to applications which are filed within 1 year after the date of enactment of the act. To incorporate such a provision, a section, such as the following, might be added, in place of the above-proposed section:

"Section 4 of title 35, as enacted by section 1 hereof, shall not apply to applications filed prior to one year from the date on which this Act shall take effect, nor to patents issued or to be issued on such applications, but the law previously in effect, namely Revised Statutes 480 (U. S. C., title 35, sec. 4, 1946 ed.) shall apply to such patents and applications."

Thank you for your consideration of this matter.

Respectfully yours,

BENJAMIN FOX.

NEWARK 2, N. J., *May 24, 1951.*

In re H. R. 3760.

COMMITTEE ON THE JUDICIARY,
House of Representatives,
Washington, D. C.
(Attention: Mr. Bryson.)

DEAR MR. BRYSON: I respectfully express the opinion that section 33 of the above entitled bill is not broad enough. The words, "holds himself out," to me mean that for a person to fall within the condemnation of that section, there must be a direct active representation. It is my thought that this section should be expanded by the insertion before the word "holds" in line 2 thereof the following: "renders services in the preparation or prosecution of applications for a patent before the Patent Office, or offers to render services in the preparation or prosecution of applications for a patent before the Patent Office,".

Thus, if this amendment is added, without any "holding out," or any representations of any kind, the mere fact of the rendition of these services without a representation of qualifications will constitute an offense.

Would it not also be desirable to provide in this section some mechanism for enforcement of the penal provisions such as a statement where the complaint shall be made, i. e., where the acts were performed, and that the United States district attorney for the particular area shall be empowered to initiate the prosecution as well as any interested citizen.

Very respectfully yours,

NORMAN N. POPPER.

RADIO PATENTS CORP.,
New York 16, N. Y., June 20, 1951.

Hon. JOSEPH R. BRYSON,
Member, Judiciary Committee, House of Representatives,
Washington, D. C.

DEAR SIR: My attention has been called to your proposed bill, H. R. 3760, revising the patent laws. I believe there should be included therein a clause protecting inventors or inventions made abroad. We have a number of associates abroad, such as the General Electric Co., Ltd., and I might cite the following example:

Scientists would be working in the laboratory on a new development—perhaps a very important contribution and invention. In the laboratory there may be two or three assistants. While they keep careful records of their experiments and developments, they do not file an application until they have completed their experiments and determined best results; or, if a provisional application is filed, it gives a general outline without details.

t should leave the employ of the laboratory or should by chance end something about this development and this information is hand, this publication would be beyond the control of the inventor. n proceeds as quickly as possible to file a provisional application lf in England. Within the year he files in the United States, vention date. The uncontrolled publication of some of the infor- validate his American application and patent as far as the dis- ned due to this publication.

hand, if his actual date of filing his application in the United wed to be equivalent to or the same as the convention date, he desired protection. Therefore, I recommend that the actual date United States under a convention date should be the convention ublications are concerned describing work done by the inventor esent law does not protect an inventor in such situations where yond his control. On the other hand, an American inventor is l under similar situations. Therefore, it is unfair and in due may lose valuable rights abroad if the foreign countries should this unfair situation here.

page 9, paragraph 102, the present bill provides that the inven- published more than 12 months prior to the filing of the appli- ited States. This should be limited to state that it must not be ers or as the discovery of others, other than the inventor. The have the right to patent protection provided he files his applica- onths of his publication anywhere and then providing he files an ation equivalent to such foreign application under the convention

give this due consideration, as situations are constantly arising nfair to inventors, especially those residing abroad.

yours,

RADIO PATENTS CORP.,
WILLIAM DUBILIER, *President.*

PATENT EQUITY ASSOCIATION, INC.,
New York, N. Y., June 18, 1951.

ELLER,
presentatives,
Washington, D. C.

directed by the board of directors of the Patent Equity As- ending you herewith 10 copies of a resolution of the board in R. 3760, Eighty-second Congress, first session, for the use of your committee.

yours,

T. IRVING POTTER, *President.*

RESOLUTION

. R. 3760, Eighty-second Congress, first session, a bill to revise ws relating to patents, and so forth, the board of directors of ssociation, Inc., hereby resolves as follows:

lences much careful thought.

ons of the bill are, for the most part, sound and constructive. ndorsed, except for section 102 (e), which should be eliminat- 2, which should be clarified if retained.

(e) would perpetuate various anomalous results that have court decisions, e. g., the following results:

ventor invents a new window screen and sells a few to try et. An early customer then invents a lock particularly adapt- screen—and hurries to the Patent Office with an application arily discloses the screen in order to show how the lock works. inventor is honest, and his application claims only the lock, n. The first inventor then files an application on his screen ar permitted by section 102 (b), and obtains his patent. Later nventor's patent issues on the lock. Years later, after both e dead, the first inventor's screen patent is invalidated by the issued lock patent which made no claim whatever to the

screen. Thus, the first inventor's screen patent is invalidated on the first inventor's own invention, even though the first inventor filed within the year permitted by section 102 (b), and even though no one other than the first inventor ever even claimed to have invented the screen! This remarkable doctrine stems from *Alexander Milburn* v. *Davis-Bournonville* (270 U. S. 390). In that case, the two applications were filed only 5 weeks apart, and only one of the applicants claimed to be the inventor of the invention which the court struck down.

(11) Under section 102 (e) information which is not available to the public when an inventor files his application becomes prior art against his patent ex post facto—through an earlier filed application subsequently issuing as a patent. And in view of section 103, the earlier filed application does not even have to disclose the invention; instead, it is added, ex post facto, to other things to synthesize the invention—and by hindsight at that.

5. Section 212 is new to the law, and it probably will make things worse instead of better. If retained, it should be clarified. As worded, it is not at all clear whether a joint inventor who grants a license has to both obtain the consent of the other inventor and account to him or only either (a) obtain consent or (b) account.

6. The president of Patent Equity Association, Inc., is directed to forward 10 copies of this resolution to the Committee on the Judiciary, House of Representatives.

BOARD OF DIRECTORS, PATENT EQUITY ASSOCIATION, INC.

THE B. F. GOODRICH CO.,
Akron, Ohio, June 1, 1951.

COUNSEL, JUDICIARY COMMITTEE, SUBCOMMITTEE NO. 3,
House of Representatives, Washington, D. C.

SIRS: I have been informed of the work of the coordinating committee sponsored by the Council of Patent Law Associations in reviewing drafts of the proposals for recodification of the patent laws, and in particular in proposing corrections in the bill H. R. 3760, on which hearings are scheduled to commence on June 13.

I approve of the proposals made by the coordinating committee, but believe that they may not have gone as far as is desirable in clarifying the most important of all the sections of the bill, which is section 102. As it stands, this section, defining what is patentable, suffers from some faults in draftsmanship, including use of words without antecedents, use of different words to designate the same thing, use of special words of art without definition, and a somewhat illogical and confusing arrangement.

I am sure that you are as deeply concerned as any of the many people more directly interested in the patent laws in having the recodification state the law with the greatest clarity, and I consequently invite your most careful consideration of the following additions and changes, which are intended to be and are believed to be codification of existing law, with no changes in effect from what was intended in section 102, and the immediately adjacent sections as introduced before the Congress:

100. *Definitions.*—Add the following subparagraph:

"(e) The word 'applicant' includes not only an inventor but also joint inventors, and personal representatives and assignees when entitled to take action in connection with applications for patent."

101. *Inventions patentable.*—In line 1, after "any" insert "invention which is a."

101–A. *Date of invention* (new section to be inserted between 101 and 102).—"An invention shall be deemed to be made when conceived by and actually reduced to practice by or on behalf of the inventor or constructively reduced to practice by the filing of an application for patent, provided that an asserted prior invention or prior knowledge, use, or publication, may be overcome by proof of reasonable diligence in adapting and perfecting the invention from a time just before the earliest activity of the rival inventor or the earliest date of knowledge use or publication, and continuing until the reduction to practice."

102. *Conditions for patentability: novelty and loss of right to patent.*—Rewrite the section as follows: "An applicant shall not be entitled to a patent for an invention if the inventor or inventors named in the application for patent

lves invent it, nor if the invention has been abandoned, nor if
wing prior art exists:
invention was known or used by others in this country, or pat-
scribed in any printed publication in this or any foreign country,
invention was made by the named inventors; or
invention was patented or described in any printed publication
any foreign country or in public use or on sale in this country,
1 year before the date of the application for patent in the
tes; or
invention was described by another in an application for patent
United States before the invention was made by the named in-
d issued as a patent; or
invention was first patented or caused to be patented by the
r his legal representatives or assigns in a foreign country before
the application for patent in this country on an application filed
6 months in design cases or 12 months in other cases before the
application in the United States; or
invention was, in fact, made in this country by another, who had
ned it, before it was made by the named inventors.
o the foregoing, I would like to comment on proposals to amend
lacing the word "abandoned" by the phrase "abandoned, sup-
ealed." I would like to urge most emphatically that this not be
words "suppressed or concealed" have been used by judges to
rtain acts as being tantamount to abandonment, but, if imported
e, would have far greater and entirely unintended effects in
ntors who follow the normal practice of developing their inven-

I wish to commend those who have devoted so many hours to
ll, for the excellent results, and to urge that it be approved with
s as may be needed to make it say exactly what it is intended

y yours,

HAROLD S. MEYER,
Patent Counsel.

JENNINGS & CARTER,
Birmingham, Ala., May 8, 1951.

BRYSON,
Congress,
Washington, D. C.

RSON: I am writing to you to give you my wholehearted support
50, a bill to codify the patent laws of the United States.
lly studied this bill, and I sincerely believe that it is far better
statutes. I note with particular interest section 103 in which the
ubject matter is made the test of patentability, and I believe that
mproves the situation. In my opinion, the Supreme Court has by
ions taken a long step toward ruining our patent system, and I
s bill, if enacted into law, will aid in curing some of the judicial
about the purpose, scope, and beneficial results of our patent

ot know if it would be practical, it occurs to me if the bill could
rt of preamble a statement of the sense of Congress to set forth
act that this might have some beneficial effect on its construction
Court. It is amazing indeed to all who are familiar with the
ow you are, that patents are treated so differently from copy-
h stem from the same clause of the Constitution. The only answer
s that while judges do not invent they do write books. It must
is reaction which prompts them to treat the two classes of prop-
ly.
tention to the obvious error in the use of the word "of" instead
242 (4). Other than this formal change, I have no suggestions
ainly wish to congratulate you on a fine job. Let us hope that the
ause I for one sincerely believe that it will be to the best interest
or this to become law.
lly,

JENNINGS & CARTER,
By HUGH P. CARTER.

GRAND RAPIDS, MICH., *May 8, 1951.*

Hon. J. R. BRYSON,
House of Representatives, Washington, D. C.

DEAR SIR: I have a copy of the bill H. R. 3760, which was introduced by you and referred to Committee on Judiciary.

At the present time the last sentence of section 103 that "Patentability shall not be negatived by the manner in which the invention was made" is an important matter which unquestionably should be in the bill. In addition, and perhaps supplementing it, it is believed that the matter of looking at or considering invention and patentability should be done objectively and not subjectively. When considered objectively, the test is, What did the invention do? When considered subjectively, which is the way most theorists and impractical men want to do the job, it is based upon the mental attitude of the individual, the judge, or the Patent Office examiner. Even the best-qualified cannot do justice when affirming or denying patentability subjectively.

Some years ago, I believe in the first term of President Roosevelt, a committee was appointed which made a report recommending the objective method.

I do not know where it could be introduced into the statute, but additionally I believe that it should be put into the statute appropriately the thought that a valid patent is property and not a monopoly. A valid patent must have as a basis creation of something new which did not exist before. Analogous to the building up of valuable property by hydraulic dredging, for example, to fill in swampland along a river, lake, bay, or the like, such property when created should belong to the creator. There is no question ever raised as to monopoly when real estate is created. But somehow through false propaganda it is the belief of many—and in the many are several of the judges who pass upon patents—that an owner of a patent is to be treated as any other monopolist. This is based upon the fact that the owner of a patent has a right to exclude others from practice of his invention. Seemingly this right to exclude in the case of patent property is considered a monopoly, with all the odium which goes with the name; but right of all other property, either real or personal, to exclude others—in other words, to monopolize it—is perfectly right and justified but not in the case of one who creates through invention valuable patent property, which is no more an odious monopoly than a farmer who owns 80 acres of land is, to all people except Communists and their helpers, a monopolist because of his right of exclusion, lasting forever to exclude others from his farm.

Yours very truly,

FRANK E. LIVERANCE, JR.,
Associated With Laurence, Woodhams, Mills & Price.

TOLEDO, OHIO, *May 9 1951.*

In re H. R. 3760, a bill to recodify the patent laws, April 18, 1951, referred to the Committee on the Judiciary.

Hon. JOSEPH R. BRYSON,
Chairman of the House Committee on Patents,
Washington, D. C.

SIR: There is appreciated the supply of copy of the above, which forwarding is understood as submitted for comment from here.

Page 9, section 102 (a), line 1, before "known" it is suggested there be inserted "publicly"; otherwise, it would seem that one having the know-how could keep such indefinitely from the public and thereby failing to promote the useful arts purpose of the patent laws. Unless "publicly" be inserted as above proposed, the secret operator who does not choose to let the public have the know-how after 17 years, or at any time, is thus enabled to stand in the way of protecting the one who is willing to take out a patent for the property-right term, thereafter leaving such open to all.

Under this section, is it not proper to identify Patent Office-published Abstracts of Applications of no anticipation standing prior to such publication, regardless of how long prior thereto filing may have occurred.

Section 103, delete all but the last sentence. This term "Obvious" opens the door for destroying all patent-invention property. The requirements of a patent applicant are that the disclosure made shall be "Obvious"; i. e., in such explicit detail that anyone who is skilled in the art, by perusing thereof, may carry through the invention at the time. The obvious support required to obtain the property right is by this proposed enactment blasted into a nullity.

ion 202, second paragraph, line 3, change "grant" to "filing."
new claim developed for the reissue should have property right
only from the grant of the reissue deed, to which date the infringer
ity. Quite frequently a patentee notes that a later issued patent
contains claims which the earlier patentee may rightly make as
. Surely it is not the purpose of Congress to reward the second
of the property-right award in the reissue. Filing date of orig-
e like status as continuation (sec. 120) and divisional (sec. 121),
terferant and all others, active prior to reissue new claim grant,
nt status.
is H. R. 3760 is approved as desirable, and more so than Eighty-
H. R. 9133.
ally,

GEORGE M. KIRK.

SHEPHERD & CAMPBELL,
Washington, May 15, 1951.

THE JUDICIARY,
Representatives, Washington, D. C.

This is in reference to H. R. 3760, a bill to revise and codify the
patents.
gest the following modification be made in the bill by adding
d 103b to read as follows:
of patentability shall be deemed to have been established when
e application achieves a new and useful result, which no single
capable of producing and which result goes beyond mere in-
ce of workmanship.
of patentability shall also be deemed to have been established
sembly and relationship of parts accomplishes an old result in
re facile economical and efficient way and especially where a
n time or labor by the user results."
r urging this modification are as follows:
s proposed in the bill, leaves the grant or refusal of a patent
whim of the Patent Office examiners. What one examiner would
vious" another might deem to rise to the dignity of invention.
rable to lay down some positive rule rather than a negative one,

would plant an orchard and prune and spray and cultivate the
e early years of growth if Tom, Dick, and Harry could appro-
when the orchard came into bearing, so no creator of a new
the very great initial expense of putting a new device on the
ding up a demand for it if the business pirate can then step in,
from his device, and cut his market to pieces.
nax grown great largely because of the hundreds of thousands
ess built up through the activities of the American inventor, and
l be resolved in his favor.
known devices are just as good as his, then let the infringer stick
y are not as good, to the extent that the purchasing public con-
ds the new article, then that should be sufficient to show that
ng has been done.
ne in mind that the patent examiner looks at patent applications
cted by the applicant's work, and the tendency is strong to dis-
ave of the hand that which might represent many days of work
tion and the expenditure of large sums of money.
dency exists has repeatedly been recognized by the courts, and
l and experienced the judge, the more likely is he to recognize

Co. v. Brown & Co. (121 Fed. 547):
sees a thing already embodied in mechanical form gives little
that first saw it in imagination, but the difference is just the
en what is common observation and what constitutes the act of
e is the eye of inventive genius; the other of the looker on after

Tooth Crown Co. v. Richmond (30 Fed. 775):
ult, after the fact, to show by argument how simple the accom-
and by aggregating all the failures of others to point out the
oad to success. This is the wisdom after the event that often
n, and levels it to the plane of mere mechanical skill."

Mr. Justice Grier, one of the ablest patent jurists this country has ever had, in *Livingston v. Jones* and *Adams v. Jones* (1st Fischer 520 and 531), said that the patentee of the earlier patents "came so near the patented device or machine that they might have discovered it if they had only thought of it."

In *Stickles v. Gloucester Manufacturing Co.* (1st Fischer 234), Mr. Justice Grier said:

"But it is not an unusual case, even among learned engineers, to see a thing after it is done, which never occurred to their minds before. I am disposed to distrust that wisdom which succeeds the event.

Respectfully submitted.

FRANK G. CAMPBELL.

LAFAYETTE, IND., *May 22, 1951.*

Re H. R. 3760, patent codification.

Hon. JOSEPH R. BRYSON,
Chairman, Patents Subcommittee, Judiciary Committee,
House Office Building, Washington, D. C.

DEAR CHAIRMAN BRYSON: As a member of the American Patent Law Association, I have voted in support of recommendations of the APLA committee in regard to patent codification.

It is important to minimize controversy, not only in your committee hearings but also in the functioning of the patent system. The APLA committee's recommendations that the courts maintain a hands-off policy as regards disputes amongst joint patent owners by prolonging the established rule that a joint owner can grant licenses exemplifies this desiderata of minimizing litigation by relatively unambiguous, though sometimes unjust rules.

The likelihood of patent litigation could be greatly reduced, and the cost of what patent litigation did occur, could be significantly lowered, by eliminating the obsolete public-use defense. Under modern conditions, any public use of significance is described in printed publications. It should be the public policy to encourage the publication of anything susceptible to public-use interpretation instead of promoting what is judicially classified as "public use" but which for practical purposes is substantially secret. Since starting your patent-codification work several years ago, you probably have not encountered significant opposition to what should be your guiding principle that the infringer with unlimited funds should be given no advantage for invalidating a patent not available to a cautious businessman studying the advisability of investing large sums in a patent.

For the same reasons, literature search standards should be imposed upon the printed publications invalidating a patent. Foreign newspapers, nonanalogous textbooks, fantastic fiction, etc., so remote from a businesslike literature search, should not benefit the infringer.

Accordingly, I urge that sections 102 (a) and (b) be revised. I have underlined the essence of my proposal:

(*a*) The invention was, in this or any foreign country, before the invention thereof by the applicant for patent, patented or described in *any printed publication discoverable by professional literature searchers using the diligence appropriate to evaluating the wisdom of purchasing a patent*, or

(*b*) The invention was, in this or any foreign country, more than 1 year prior to the date of the application for patent in the United States, patented or described in *any printed publication discoverable by professional literature searchers using the diligence appropriate to evaluating the wisdom of purchasing a patent.*

My suggestions could probably be incorporated in the bill without arousing controversy among the patent bar. If, however, substantially these same proposals have been urged, thoroughly investigated, and vigorously opposed by significant segments of patent specialists, it might be more expedient for your committee to ignore my belated recommendations. Accordingly, I am submitting these comments to you, while encouraging you, through my vote in support of the recommendations of the APLA committee, to pass the recodification without extensive changes in H. R. 3760.

Respectfully,

JOHN EWBANK.

NEW YORK, N. Y., *June 21, 1951.*

ill H. R. 3760.

R. BRYSON,
Office Building, Washington 25, D. C.

BRYSON: This bill contains some very troublesome clauses which well considered in their implications before the bill is enacted. In orm, the bill represents the complete destruction of the patent system, and the implications of the bill correctly.

o make this clear to you I will explain it very briefly:

rsh attitude of the courts toward patents threatens to destroy the research by giving developed inventions, by court action, to the first is willing to seize them for profit.

fortunate severity has driven research organizations to contemplate ment of the patent system and the institution of a policy of secrecy. le self-defense.

ph 102G of the patent bill goes beyond this right of secrecy, permits ch organization to keep its inventions secret and then makes those tions an anticipation for any similar patent granted to an inventor g to publish his invention under the provisions of the patent law. ent, inventions kept secret do not anticipate those which are made the patent system. This paragraph adds to the prior art every hich has been secreted in all the research organizations and will patent system by making the patents of such precarious nature as ess.

earch organizations which contribute their funds to the development g of the Nation are entitled to protection, but that protection should just enforcement of patents against infringers.

ruly yours,

JOHN L. SEYMOUR.

CHICAGO, *May 18, 1951.*

0 (Bryson) Patents.

IARY COMMITTEE,
ffice Building, Washington, D. C.

: Section 103 (p. 9) is considered objectionable as tending further e question of what constitutes patentable invention.

mended that the section be (*a*) deleted, (*b*) amended to read as

CONDITIONS OF PATENTABILITY.—A patent may be obtained provided is not identically described or disclosed in the prior art set forth of this title, and provided that the differences between the subject t to be patented and said prior art are such that the subject matter uld not be reproduced without modification of the prior art as it time the invention was made."

ction 103 purports to codify (without clarifying) a theory of case responsible for a great deal of confusion in the administration of , i. e., What is mechanical skill?

itutes "mechanical skill" is a purely subjective question, and like s practically indeterminate and not susceptable of ultimate

as printed would perpetrate a source of confusion.

fully,

CALLARD LIVINGSTON.

JUNE 25, 1951.

. BRYSON,
and Members of House Judiciary Subcommittee No. 3,
ouse Office Building, Washington, D. C.

This is written to answer certain questions which have arisen rela- ony of the witness. Parenthetically let it be noted while witness subjective test (now comprising sec. 103) to contrast same with yet witness would let subjective test remain but also would include

INDEX OF SUPPLEMENTAL LETTER

I. Exact reading of full text of section 103 urged by witness. No change in wording of first paragraph now constituting section 103.

II. Objective test and meaning of an application to example. "Objective" definition from Webster.

III. Advantages of objective test to following: Patent Office, inventor, patent solicitors, judges, Federal court, and public.

IV. Objections to subjective test: Indefiniteness, speculation—double mental imaging.

V. Assurance courts will follow objective or any test enacted into law by Congress.

VI. "Independently of and apart from . * * *."

VII. Answer to two contentions disapproving objective test.

VIII. The Supreme Court in decision prior to writ of certiorari never held patent claim void for lack of patentable invention except where no new functional relationship was established. * * * Objective test harmonizes the cases.

IX. Rebuttal of allegation that courts have not applied the objective test. * * * On contrary courts have applied same and spoken in terms of functions and specifically approved George L. Roberts statement of the objective test.

X. Conclusion.

I. EXACT READING OF FULL TEXT OF SECTION 103 PROPOSED

Witness desires section 103 of H. R. 3760 to read:

"SEC. 103. CONDITIONS FOR PATENTABILITY; NONOBVIOUS SUBJECT-MATTER AND NEW FUNCTIONAL RELATIONSHIP.—A patent may not be obtained though the invention is not indentically disclosed or described in the prior art set forth in section 102 of this title, if the differences between the subject-matter sought to be patented and that prior art are such that the subject-matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject-matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

"Independently of and apart from the above, a patent may be obtained for an invention and patentable novelty shall be found therefor, whenever there is established a new functional relationship between any of the factors which are required for rendering an invention in the industrial art practically operative."

With the section thus worded, not a single change has been made in the first paragraph now constituting section 103. The added second paragraph constitutes the objective test (new functional relation) which witness requests to be added to the section. The first paragraph allows to the applicant the obvious or nonobvious test of patentability. The second paragraph allows to the applicant the objective or new functional relationship test and renders more certain the patent grant when it is established that there are new functional relations existing between the cooperating factors and such establishing shall render patentable novelty finding mandatory.

II. OBJECTIVE TEST—MEANING OF AND APPLICATION TO EXAMPLES

"Objective": (Webster's New International Dictionary).

Noun: "That which is objective or external to the mind."

Adjective: "Emphasizing or expressing the nature of reality as it is apart from self-consciousness; treating events or phenomena as external rather than as affected by one's reflections or feelings; expressing facts without distortion from one's personal feelings or prejudice."

Witness gave example of an invention comprising a screw-driver tool being inserted in the chuck of a brace and bit type which enabled the operators to work with much greater efficiency. Is the functional relationship of the screw-driver tool to the chuck of the brace old? This is a direct question of fact external to "feelings" of examiner or judge. It is not a question of whether it appeals to him as obvious or not—obviousness is addressed to his "feelings" and is essentially subjective. The answer to the question is that the same functional relationship is found between the chuck of the brace and the bit as between the chuck and the screw-driver tool. The chuck of the brace gives rotary motion and pressure downward just as it does when the screw-driver tool is substituted for the bit. Therefore, patentability should be denied.

rb wire gives the affirmative of the application of the objective test. lonal relation of holding the barb at 90 degrees to the carrier wire by a ormed by two wraps of the wire of the barb was new. And the Su- urt held the patent valid.

III. ADVANTAGES OF OBJECTIVE TEST TO FOLLOWING

entor: May know with far greater certainty whether his contribution e awarded a patent and if a patent is allowed whether it probably will nable in court, and this before he spends years of his life and great oney in its development and marketing. At present, he may be met urt decision stating with no greater logical basis, than "We think the is obvious to those skilled in the art."

tent Office: The objective test affords so excellent a criterion for a finition of a patentable invention that burden of Patent Office will be ghtened.

icitor: Serves as a measure or criterion in advising as to patentable nd also in his constructive work of preparing specification and claims applications.

ges of Federal courts: Supplies a criterion defined from judicial to aid them to sound and consistent judgment in patent cases.

blic: Public in adopting machines or inventions can know whether nging or not with far greater certainty. This means less litigation. tion of the objective test has advantage of a two-volume text illustra- ation, and application to adjudicated cases.

IONS TO SUBJECTIVE TEST, I. E., OBVIOUSNESS, WHICH IS THE TEST OF SECTION 103 AS PRESENTLY SET FORTH

teness: What is obvious to one man is not obvious to another. After ght how to solve a problem, of course it is "obvious." Surely, such is able criterion to test whether a contribution is patentable. Yet this is committee is asked to enact into law as the only measure of patentability. witness would let section 103 remain as is but would add the objective

e: Inventor files patent application. Examiner replies rejecting claims tating "In view of prior art cited references, it is obvious to those the art to do what applicant proposes." How is the Solicitor to an- ational basis such contention which amounts to nothing more than anyone skilled in the art could overcome the problem you faced." examiner know that—it is only opinion. All are entitled to opinions. nay reply "Patents you have cited are all old and no one member has e problem—same has awaited solution by applicant and so it could ious after so many years."

ng finally patent is allowed:

nt is happy and with it induces friends to subscribe funds for devel- nd marketing. After say eight years, a rival sees the inventor is od and he infringes, and after expensive court contest of two or more ourt says "we believe the invention is obvious," or as sometimes within the skill of the art" or "does not rise to the dignity of an or "is only mechanical skill"—all subjective answers. Surely one has been led into losing years of his life and his own money and that nds, cannot find much incentive in a patent system based upon a test in logical basis.

tion: In applying "obviousness" test, one speculates upon whether the lp is obvious or not obvious to those skilled in the art—a double men- ption or imaginitug.

ne must imagine one possessed of the skill of those in a prior art, and nd, he must imagine whether such a one would deem the invention He must reach the conclusion in his feelings (being a subjective bout obviousness after he has been taught the solution by the inventor tribution he is judging—meantime trying to keep such instruction out d. Surely this adds up to a real mental gymnastic trick.

indefiniteness and speculation is avoided by the objective test.

V. ASSURANCE COURTS WILL FOLLOW OBJECTIVE OR ANY TEST ENACTED INTO LAW BY CONGRESS

No one can give such assurance, it is respectfully submitted.

To escape the utter confusion depicted by Justice Jackson when he states " * * * that the only patent that is valid is one which this court has not been able to get its hands on" (80 U. S. P. Q. p. 36). It is to be devoutly expected that the courts will welcome a reliable test founded on logic and derived from judicial authority.

Also, we may still trust that stare decisis will contribute to uniformity of judicial determination when a criterion is presented which harmonizes the Supreme Court decisions prior to requirment for writ of certiorari.

VI. "INDEPENDENTLY OF, AND APART FROM * * *"

Inserted to make objective test separate from subjective test in first paragraph. Thus, an invention which does not have a new functional relationship may still be adjudged patentable if deemed nonobvious. An invention which has new functional relationship as set forth in second paragraph cannot be held nonpatentable because deemed to be obvious, since it fulfills the requirement of the restrictive objective test which is "independent of and apart from * * * *"

VII. ANSWER TO TWO CONTENTIONS DISAPPROVING OBJECTIVE TEST

First, in substance, "not sure that objective test is the solution." No other test was suggested deemed to be better. It is submitted that so long as the objective test offers a great improvement over the subjective test and is the only one proposed derived from judicial authority and is the only one having a published text book fully setting forth and applying the test, then such objection is outweighed.

Second, in substance, "The proposal would require the Patent Office to grant a patent and presumably the courts to sustain it if it involved any new functional relationship however minor or insignificant it might be." No example of any such minor or insignificant invention was given. Would the barb wire case be of such "minor" or "insignificant" character? Here we have a subjective approach in the question of what is "minor" or "insignificant." Assuming there is such: It is submitted that any new functional relationship which such objector may be fearing would be one which would produce a result which could readily be obtained by a nonequivalent device. However, this may be the increased advantages of the objective over the subjective test, it is submitted, well warrants its inclusion as suggested herein.

Moreover, it is submitted, it is precisely where the change is small as in the barb wire case that the inventor needs the approximation to a criterion for precise definition of a patentable invention as afforded by the objective test proposed, and thus inventions of the inherent order of the barb wire case will be protected.

VIII. THE SUPREME COURT IN DECISION PRIOR TO WRIT OF CERTIORARI NEVER HELD PATENT CLAIM VOID FOR LACK OF PATENTABLE INVENTION EXCEPT WHERE NO NEW FUNCTIONAL RELATIONSHIP WAS ESTABLISHED. * * * OBJECTIVE TEST HARMONIZES THE CASES

The following paragraph supplies an assurance drawn from the history of the Supreme Court patent determinations which constitutes a most unique endorsement of said test.

"In view of the fact that not a century has elapsed since the Federal courts began to consider questions arising under patents for invention, and that in every branch of law, much time and long experience are ordinarily required for the determination of principles which are to settle its uniform administration; it may be regarded as remarkable, not to say marvelous: that the Supreme Court has never yet decided a patent claim to be void for lack of patentable invention in its subject matter, except where no new functional relationship was established by or between the things claimed. It is true that the reason from time to time assigned for denying patentability to the various alleged inventions involved in the 131 cases cited as belonging to this category, have not been explicitly stated in the judicial opinions rendered thereon, to be grounded upon the absence of any new functional relationship in the subject matter claimed: but it is manifest

analysis that the entire series of such cases may be satisfactorily
l harmonized by the application of such a test. They were all de-
a period of 75 years, 1850–1925; and they serve to show how suc-
onservative attitude of the Supreme Court has been in preserving
genuine inventors, notwithstanding the difficulties attending the
n of the new from the old. * * *" (Patentability and Patent
, page 170.)

OF ALLEGATION THAT COURTS HAVE NOT APPLIED THE OBJECTIVE TEST—
Y COURTS HAVE APPLIED SAME AND SPOKEN IN TERMS OF FUNCTIONS
ICALLY APPROVED GEORGE L. ROBERTS' STATEMENT OF THE OBJECTIVE

v Court in these cases look at "duty" or "office" or "function"
nents or factors perform in an invention and compares them with
nctors of prior devices rather than ask, Is this "obvious"? (Italics
ss otherwise indicated.)
he Court in cases cited and extracted below has expressly analyzed
s between elements of prior art and invention before the Court
the term "*functions*" in so doing.
he District Court in *Submarine Signal Corp.* v. *General Radio Co.*
Mass. July 20, 1926) states that the test of invention is objective,
subjective test as impractical and states (citing with approval)
t has considered the unpublished notes of George L. Roberts, Esq.
bar. It is interesting to note parenthetically that, in this case,
plaintiff was represented by the eminent law firm of which three
members on the coordinating committee formulating the present
bers or associates. The objective test was good law then and it
t is good law now and should be included in the present bill.
arine Signal Corp. case will be quoted first, since it is so directly

Signal Corp. v. *General Radio Co. et al.* (D. C. Mass., July 20,
d 178) (courts and other tribunals have adopted and cited this
roval in many cases):
dants rely principally upon the Berggraf device as showing an
f the plaintiff's invention. They adopt the conventional method of
ention, by contending that a person skilled in the art, having this
nd, could produce the plaintiff's apparatus by certain changes.
ould be 'obvious' insert ours). This contention shows the unsatis-
e of the 'skilled mechanic' criterion of invention.
invention may be either subjective or objective. We may deter-
he novelty of an idea or the novelty of the result of this idea. The
npractical. Psychology is not yet so exact a science as to allow
and arrange in order of importance the ideas of the human brain.
ssist us to substitute for the brain of the patentee, whose idea we
, the brain of that *imaginary* person of the patent law, the skilled
he test is still that of the relative importance of ideas.
Roberts, Esq., of the Suffolk bar, has considered this subject in an
reatise which I have been privileged to study. He shows that the
nvention is the novelty of the result, and that this result must be
comparing it with the machines, processes or methods known be-
t is an objective one. If the result of an idea is a machine or proc-
a new function or *an old function* arrived at by new means, the
f the idea is patentable. In *an exhaustive* survey of all the cases
question of patentable novelty in the Supreme Court of the United
the earliest times down to 1915, Mr. Roberts has shown that the
gested is consistent with them all, with three exceptions, which he
omalous."
speaks most clearly and positively in favor of the objective test.
ective test has thus been made a part of the law by judicial deci-
uld it not now be embodied in the statutory law?
ford. *Union Paper Bag Machine Co.* v. *Murphy* (97 U. S. 120, 125
)):
ning the question of infringement, the Court or jury, as the case
ot to judge about similarities or differences by the names of things,
k at the machines or their several devices or elements *in the light*
ds, or what office or *function they perform*, and *how they perform*

it, and to find that one thing is substantially the same as another, if it performs substantially the same *function* in substantially the same way to obtain the same result, always bearing in mind that devices in a patented machine are different in the sense of the patent law when they perform different *functions* or in a different way, or produce a substantially different result."

(How well these words fit the analysis given relative the barb wire fence and the brace and bit-screw driver illustration given by witness.)

The above language of Supreme Court in testing for patentable novelty in determining infringement was applied in *Hiller Audio Corporation* v. *General Radio Co.* (26 F. (2d) 475, 479 D. C. 1928).

"Notwithstanding the slight mechanical difference in construction, the two devices perform the same *function* in the *same way*, and accomplish substantially identical results. The two cores in the defendant's impedance coupler are the mechanical equivalents of the single core in plaintiff's unit."

"* * * The testimony shows that the iron portion of the core structure between the coils of the defendant's unit *function* as a magnetic path * * *."

N. B.—How Court is comparing function of element by element, is not speculating whether it is "obvious" or whether it is "only mechanical skill." Who knows, the boundaries of these subjective terms? No one, it seems clear.

Judge Brewster endorsed the obective test explained above by Judge Lowell in this manner:

"I also derive assistance from the learned opinion of Judge Lowell in *Submarine Signal Corp.* v. *General Radio Co.* ((D. C.) 14 F. 2d 178, 181), wherein he points out that the "true test of invention is the novelty of the result, and that this result must be criticized by comparing it with the machines, or processes, or methods known before. *The test is an objective one.* If the result of an idea is a machine or process involving a new *function*, or an *old function* arrived at by *new means*, the embodiment of the idea is patentable."

The court proceeds comparing and using term "functions."

Wright v. *Yuengling* (155 U. S. 57, 53):

"Wright's only invention, then, was in the combination of the cylindrical guide with the trough shown in the Farrar patent. Did this accomplish a new and valuable result it is quite possible that a patent therefor might have been sustained, but we do not find this to be the case. The cylindrical guide performs the *same functions* as in the prior patents: the trough in which the connecting rod works in the Farrar patent, is practically the same as in the Wright patent, and the combination is a mere aggregation of their respective *functions*, if the combination of the trough and cylindrical guide of the Wright patent gives greater lightness and strength to the frame than the combination of the trough and the flat guides of the Farrar patent, it is a mere matter of degree, a carrying forward of an old idea, a result, perhaps, somewhat more perfect than had theretofore been attained, but not rising to the dignity of invention. * * *"

Reckendorfer v. *Faber* (92 U. S. 347, 358):

After comparing duty of lead and the eraser of a pencil, the court stated:

"* * * There is no relation between the instruments in the performance of their several *functions*, and no reciprocal action, no parts used in common."

Richards v. *Chase Elevator Co.* (158 U. S. 299, 302, 303, (1894)):

"* * * So long as each element performs some old and well-known *function*, the result is not a patentable combination, but an aggregation of elements. * * *"

"Not a new *function* or result is suggested by the combination in question. * * *".

Grinnell Washing Machine Co. v. *Johnson Co.* (247 U. S. 426, 433, (1917)):

"In *Specialty Mfg. Co.* v. *Fenton Metallic Mfg. Co.* (174 U. S. 492, 498), the rule was again tersely stated:

"Where a combination of old devices produces a new result, such combination is doubtless patentable; but, where the combination is not only of old elements but of old results, and *no new function* is evolved from such combination, it falls within the rulings of this Court in *Hailes* v. *Van Wormer* (20 Wall. 353, 368), etc. (citing cases).

"Applying the rule thus authoritatively settled by this Court, we think no invention is shown in assembling these old elements for the purposes declared. No *new function* is 'evolved from this combination'; the new result, so far as one is achieved, is only that which arises from the well-known operation of each one of the elements."

Lincoln Engineering Co. v. *Stewart-Warner Corp.* (303 U. S. 545, 549 (1937)):

"* * * The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different *function* or operation

retofore performed or produced by them is not patentable inven-
e improvement of one part of an old combination gives no right
mprovement in combination with other old parts which perform no
in the combination. Though the respondent so concedes, it urges
nbination of the Butler patent, the headed nipple performs a new
function from that which it has heretofore performed, in other
in that, when the coupler is withdrawn from the nipple, at the
asing operation, the rounded head of the nipple "cocks" the jaws
for the next operation. * * * Moreover, the argument is un-
e old art includes instances where the head of a nipple or fitting
nilar *function* when the chuck is disengaged from it."
iris Secundum, section 55, p. 275, Copyright 1951, states that:
etimes resorted to in distinguishing between inventiveness and
cal skill is whether some new result is brought about by new
new arrangement of old ones (40). *The latter is an objective*
easured by it, *invention is involved* if the result of an idea is a
g involving a *new function* (42) or an old function arrived at by

emplifies the use of the objective test in dealing with the *functions*
s even to 1937. The referring to *functions* shows that the Court
subjectively.
committee would not knowingly take away what basis we have
g of the objective test. By not including the proposed paragraph,
in effect, it is submitted, would be taking away from inventors
they now have in applying the subjective test. Even when new
tionships are established at present, the courts are under no
old patentable novelty exists. This is why the proposal includes
feature so that, after an inventor has spent years developing and
patented invention, he will not have his rights lost to an infringer
simply stating "we *think* the invention is within the skill of the
ivalent.

X. CONCLUSION

ility and with all earnestness, the witness most sincerely petitions
to include the objective test as set forth herein. It is the key to
confusion which now besets the patent system.
Patent Planning Commission, Charles F. Kettering, chairman, in
recommended "that patentability shall be determined objectively
committee was referred to the text of Mr. Roberts by the witness
he test of Mr. Roberts' text which was recommended.
y Committee is the real national-defense committee, because you
power to recommend the test for patentable novelty which is a
d from judicial authority, the only test proposed that has been
nally. Our workmen need the best of machines to enable them
housandfold more goods than rivals abroad to maintain our eco-
soldiers need equipment to make them the equal of a thousandfold
preserve our liberties. Our very existence as a nation is in large
ent upon a sound patent system.
objective test in section 103 (H. R. 3760), it is submitted, will
wholesome incentive to the patent system and thereby help main-
an way of life economically and militarily.
f irrefutable logic, it is submitted that the objective test should
he present bill.
n relative to the above arises which the committee or any member
e desires to have answered, the witness will appreciate the oppor-
g the answer.
y and respectfully submitted.

G. WRIGHT ARNOLD.

WASHINGTON, D. C., *June 18, 1951.*

BRYSON,
Subcommittee on Patents, House Judiciary Committee,
gton, D. C.

probably recall that I appeared before your committee last week
the patent committee of the Bar Association of the District of
ress the approval of said association with respect to H. R. 3760,
rticularly by the proposed amendments of the coordinating com-

mittee of the National Council of Patent Law Associations, which amendments had been presented to your staff and dated May 22, 1951.

Having attended these hearings, I would like to suggest individually and on my own responsibility, as a member of the bar of the District of Columbia and as a practicing patent lawyer, four further amendments which seem to me to be desirable and which probably may compose the differences between the present language of the bill and some points urged by several of the witnesses. These proposed amendments are as follows:

1. In section 100 of the bill, subsection (a), I would revise to read as follows:

"(a) The term 'invention' includes, but is not limited to, discoveries made in the useful arts."

Also in section 101 of the bill, line 1, after "discovers" insert ", in the useful arts,".

My contribution in the above-revised sentences resides in the words "in the useful arts." This definitely limits inventions and discoveries in the manner defined in article 1, section 8, clause 8 of the Constitution of the United States. Patents for inventions and discoveries, according to the balanced phraseology of this portion of the Constitution, are limited to the useful arts, and it is my contention that the implementing law should recite this fact. In accordance with this balanced writing, science (or general knowledge) was never intended to be subject matter of patents but the subject matter of copyrights, and no previous implementing law passed by the Congress has ever included science as patentable subject matter. It should, therefore, as said above, be definitely stated in the present bill that the inventions and discoveries are those made in the useful arts.

2. I am in agreement with the statement made or given to your committee by Mr. G. Wright Arnold of Seattle, Wash.; and, therefore, suggest that at the end of section 103 of the pending bill that the following paragraph be added for the reasons that he has urged:

"Whenever there is established a new functional relationship between any of the factors which are required for rendering an invention in the *useful arts* practically operative, patentable novelty shall be found."

3. With respect to the discussion before your committee concerning section 231, I have the following suggestions to make which I believe will compose the differences which were emphasized in the discussion between Congressman Rogers, Mr. Fugate of the Department of Justice, and Mr. Rich. Consequently, I suggest that subsection (c) of section 231 be rewritten as follows:

"(c) Whoever sells a component of a patented machine, manufacture, combination, or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention especially made or especially adapted for use in an infringement of such patent and not a staple article or commodity of commerce suitable for substantial noninfringing use, and who has knowledge at or prior to said sale that said component material or apparatus is to be used in a manner that will result in an infringement of such patent, shall be liable for infringement as a contributory infringer."

4. My other and last suggestion has to do with subsection (d) of section 231 and consists merely of inserting the word "solely" after the word "done" in line 4 of said subsection (d). All witnesses seem to agree that neither any nor all of the three acts by a patent owner, as mentioned in subsection (d), should or would constitute a misuse of the patent, if only these three conditions are present, or any one of them, and consequently relief should not be denied nor should there be any guilt of misuse or of illegal extension of the patent right. Thus, the inclusion of the word "solely" at the place indicated in subsection (d) and the rewriting of subsection (c), as above suggested, should remove all objections raised by Mr. Fugate.

I know that your correspondence on this matter has been very large, and I hope that the above does not overburden you, but I sincerely offer the above suggestions with the recommendation that they be incorporated in the present bill.

Respectfully submitted.

EDW. R. WALTON, Jr.

PHILADELPHIA, PA., *June 18, 1951.*

50
I R. BRYSON,
an, Subcommittee No. 3,
ted States House of Representatives,
Washington, D. C.

I appreciate the opportunity you have given me during the hearings
50 to file a statement. I have been a student of the patent system
years, having been an examiner in the Patent Office from 1923 to
private practice as a patent attorney since 1935, representing large
orporations as well as individual inventors. I have thus had an
to observe the workings of our patent system inside the Patent
l as in industry.

ike to state that I am heartily in favor of the enactment of H. R.
ge your committee to give it favorable action and also to take into
ideration the suggestions presented by the coordinating committee
t Law Association. I attended all the hearings and have been im-
he remarkable unanimity of agreement of representatives and in-
all over the country in favor of this bill.

ust one matter I should like to mention which is not in H. R. 3760,
en suggested during the hearings to insert a provision for permitting
Office to publish patent applications which would merely serve as
or disclosures of technical information without having the status
However, it was proposed to make such published applications
f their filing date. I regard this suggestion as being highly unde-
se it may be very harmful to inventors. It would be possible to file
in the Patent Office containing a great deal of speculative technical
ch might vaguely refer to possible desired improvements or results
ng any technical or factual basis. Such applications could be kept
several years and then finally published so as to prevent a bona fide
n getting a patent because such publication would be effective not
ication date but from its filing date in the Patent Office. During all
application was pending, it would not be available to the public
ent Office processes all applications in secrecy. Such hidden dis-
etly slumbering in the Patent Office for years would bring panic
upon bona fide inventors working on their own who might spend
and money in developing an invention without any inkling of such
and then suddenly find themselves cut off from any chance of
ent by a published application suddenly issued by the Patent Office
going back perhaps 4 or 5 years. Accordingly such proposal would
mental to inventors.

re, such proposal would pervert the function of the Patent Office
olished to grant patents and not to function as a publication agency
be unreliable or questionable technical information which may be
ked, highly speculative, and never examined rigorously for its tech-
ency and reliability. Under the proposal the Patent Office would
at mass of technical data which has not been subjected to any
tion and would thus give additional imprimatur to technical infor-
may be incorrect, misleading, and worthless. Certainly industry
welfare will not be promoted by such proposal which at best would
icious secret technical booby trap to be sprung upon bona fide honest
hose who would deprive them of their hard-won inventions.

eed H. R. 3760 as a whole is a much-needed step in the right direc-
badly in need of codification and clarification of our patent laws
plete overhauling has been done since 1870. Our patent system
lly and effectively for the little inventor as well as the big corpora-
ng a powerful incentive to the inventor to make inventions and to
an to invest capital in new enterprises. From these joint incentives
obtained tremendous benefits which it would otherwise never get.
ve have achieved during the past century a remarkable technical
made previously in all of human history. Our patent system has
mainspring of our entire industrial development. It has spurred
dual inventor and the businessman to apply their brains, energy,
to give us our technology and standard of living which are foremost
orld.

ars, however, there has been a serious decline in the number of
de in our country, although our population and economy has

been steadily growing. In spite of the greatly increased expenditures by Government and industry on research work the number of inventions made annually as measured by the patents granted each year has steadily declined at an alarming rate. I believe one of the causes of this decline can be attributed to the confusion and uncertainty of our patent laws as shown by the decisions of the courts in patent cases. As a result the incentive to invent has been greatly diminished.

The number of individual inventors working on their own has steadily declined so that as a result today most of the research and inventing is done only by corporations and large research organizations. The businessman today hesitates very much in backing an inventor because of the state of uncertainty of our patents and the very unfavorable attitude of the courts, especially the Supreme Court, in enforcing patents. Today our Federal judges look for every possible technicality and excuse to invalidate a patent and they seem to overlook the social benefits which the public derives from benefits so wisely provided for in our Constitution. I therefore believe that H. R. 3760 is a step in the right direction and should help to eliminate some of the existing confusion and uncertainty.

We are involved today in a world struggle which may subject our economic and political philosophy possibly to the ultimate test of survival against the completely hostile and destructive philosophy of communism. Today we seem to be outnumbered by the total population dominated by Communist philosophy. Fortunately, our superior technology, I am sure, will enable us to preserve our social system which stands for the dignity and freedom of the individual. However, we must make certain that we maintain our technical superiority and this can be done only by encouraging and developing new inventions. This can be accomplished effectively as we have done in the past by offering adequate incentives and rewards to inventors and business to develop inventions and put them to work for us.

The individual inventor must be encouraged and rewarded more than ever before if we are to win our fight against communism. I refer you to my book, The Psychology of the Inventor, to indicate further the vital role of the individual inventor in our economy and some of the pitfalls which he encounters which we should help remove.

The inventor is our greatest and most vital national resource. He was a vital agent in building our present industrial economy in a region void of any technical facilities when the colonists settled here. He deserves to be honored and duly rewarded for his creative work which enriches the public welfare. The inventor should be recognized as a citizen of great importance because he is a public benefactor. He should therefore be given an opportunity to obtain his due reward through his patents by making sure that proper respect and adequate legal consideration is given to his patent property.

President Franklin D. Roosevelt said:

"Patents are the keys to our technology; technology is the key to production; production is the key to victory." (TNEC hearings, pt. 1, p. 2, 1942.)

The Supreme Court has aptly summed up the vital function of the inventor by saying in *U. S. v. Dubilier Condenser Corp.* (289 U. S. 178):

"An inventor deprives the public of nothing which it enjoyed before his discovery, but gives something of value to the community by adding to the sum of human knowledge."

In a recent editorial in Chemistry and Engineering News, June 11, 1951, the following very important statement is made:

"Research palaces and superduper production facilities are meaningless unless adequately staffed with highly skilled scientists and technologists. Completely outnumbered reputationwise by those behind the iron curtain, our one chance of survival is the continuation of our superiority in fundamental and applied research and vast production of literally thousands and thousands of items vital to both our civilian economy and modern warfare. The fast-approaching bottleneck of too few scientists and technologists can well be the most efficient secret weapon possessed by Stalin and the Politburo. If the present trend is not shortly reversed, our leadership in science and technology will disappear and will be supplanted by Russian domination in science and technology for we can be dead sure that Russia is straining every effort to overcome our present lead. Once our technical superiority is lost our political liberty will be gone."

Dr. James B. Conant, president of Harvard University, recently stated at the dedication of the new laboratories of the du Pont Co. the following:

"The typical inventor was essentially an empiricist. Indeed, we used sometimes to speak of the cut-and-try methods of experimentation as Edisonian

Therefore, as theory developed in physics and chemistry and pene-
ito practice, as the degree of empiricism was reduced in one area after
the inventor was bound to disappear. Today the typical lone inventor
ghteenth and nineteenth centuries has all but disappeared. In his place
idtwentieth century came the industrial research laboratory and de-
ts of development engineering.

second point is that the revolutionary advances in theoretical science
de very largely by amateurs. And clearly almost all the great advances
try until this century were made by the independent inventor. These
e passed. They have no intellectual descendants. Will their twentieth
equivalents—the professional scientist, the applied-science laboratory,
neering group—be able to carry on? Some of you may be inclined to
this question. Why, of course, you will say. Look at what has happened
st 30 years. You yourself have just spoken of the startling advances
l chemistry. Look at the electrical industry; the new way of advancing
ure and applied, is far better than the old. Perhaps; but I submit it
on to draw definite conclusions. There is such a thing as momentum
affairs as well as in physics. And I submit that we of the mid-
century have been moving forward to a considerable degree because
mentum accumulated in the days of the amateur and the lone inventor.
nts, there is sufficient doubt about the ability of the new ways to be
d for the old for us to examine the problem with some care."

e that one of the best ways to insure the continued and increased
of inventions is to make sure our patent system is in a healthy state.
0 will help toward that end, but we need more action and I urge
Bryson, to have your committee investigate other phases of our patent
th a view to possible legislation so as to make sure inventions will be
at an adequate rate to maintain our technological superiority to in-
urvival over communism.

ore suggest that your committee hold hearings to investigate the
subjects which I believe urgently need legislative action:

1. REFORM OF PATENT OFFICE PROCEDURE

nt Office is one of the most efficient and oldest administrative agencies
ernment. It has done a remarkably fine job under the present statutes
nsufficient personnel and facilities. The present Rules of Procedure
letely revised in 1949 and are a tremendous improvement over the old
wever, the Patent Office necessarily must operate within the confines
ent patent statutes and accordingly has not been able to make much
orms in procedure. We have today a highly complex and involved
n the Patent Office full of hazards and pitfalls for the inventor. Our
nt-claim structure has grown to a gigantic monstrosity, full of
al and semantic absurdities. This is costing inventors endless grief,
nd loss of patent rights. The prosecution should be simplified to
sent-day high cost of prosecuting patent applications. The Patent
needs better facilities for literature and prior art searches.
ent interference procedure in the Patent Office involving conflicting
he same invention is extremely technical, complex, and expensive.
lure should be thoroughly overhauled.

2. PATENT LITIGATION REFORM

igation has become extremely expensive and hazardous in the Federal
st Federal judges frankly don't like to handle patent cases because
he necessary technical background. Justice Frankfurter has said,
, "Judges must overcome their scientific incompetence as best they
rconi v. U. S. (320 U. S. 1).) Your committee should give consid-
he establishment of special patent courts for adjudicating patents.

3. STIMULATING INVENTIONS

should study the question of stimulating and fostering new inventions
best accomplish this through the patent system or perhaps through
neans such as through grants-in-aid of inventors to help inventors
entions, to patent them and to enforce them so as to get their due

Consideration should also be given to the problems of small business investing in new inventions and how we can stimulate and encourage businessmen to spend money on research and developing inventions so as to ensure adequate incentives and reasonable returns from such efforts and investment? Due consideration should be given to the tax problems involved in such investments, granting of priorities for materials and manpower, etc., so as to further the public interest.

If we are to prevail over the evil forces conspiring against our free-enterprise system and individual liberty, we must turn to the inventor to rescue us. The inventor has liberated us from physical slavery, from a filthy precarious animal existence to the possibility of living a full and rich life. He has freed us from the adverse forces of our physical environment so that we are no longer slaves to natural forces. The inventor has given us our physical environment in which the dignity of the human individual can rise to its utmost heights. Today the inventor can also save us from loss of our individual liberty and freedom and our American way of life by giving us the physical implements to fight and overcome our enemies. The inventor is our most precious asset and savior against the serfdom of communism. We must do everything possible to encourage and help him or we will surely perish.

Respectfully,

JOSEPH ROSSMAN.

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123 SOUTH BROAD STREET, PHILADELPHIA, PA.,
June 22, 1951.

Re H. R. 3760.

HON. JOSEPH R. BRYSON,
House Office Building,
Washington, D. C.

DEAR MR. BRYSON: The suggestion made during the hearings on this bill to amend section 122 (confidential status of applications) to include the second paragraph of section 121 of former H. R. 9133 (or its equivalent), if adopted and enacted into law, would, I believe, so emasculate our patent system as to virtually destroy its vitalizing force in our economy.

My views in this respect are more fully set forth in the attached counterpart of a letter which I wrote to a member of the coordinating committee when H. R. 9133 was before it for consideration. It is my understanding that the coordinating committee voted against this provision for the publication of patent applications in large part on the basis of the views expressed in my letter, and it is for this reason that I feel certain that you and the other members of your subcommittee would prefer to have these views before it for consideration.

In addition, I should like to point out that, to the best of my knowledge, in all instances where the pros and cons were fully developed before a vote was taken, the members of all groups considering this provision have voted it down. Obviously, a vote taken on a matter as to which no issue is presented, or on which only the pro side is presented, is rather meaningless. The thought here is that you might wish to determine rather exactly how the vote was taken on this matter in the case of group representation before your subcommittee.

From the nature of the attached you will no doubt conclude that I am in the employ as patent counsel of a small company, which is true. I have not employed company stationery simply because I wish to bring out that the views expressed are my own.

If is my sincere hope that this letter and the attached will receive your most careful consideration.

I am enclosing extra copies so that you may distribute them among the members of your subcommittee if you wish.

Yours very truly,

HUGO A. KEMMAN.

Re H. R. 9133—Codification of the patent laws.

DECEMBER 1, 1950.

DEAR ANDY: I have given the second paragraph of section 121 of H. R. 9133 some further study, and I believe that it might be quite properly labeled the section to prevent competitors from getting patents. In this connection you will recall the often-told story about the company that published material (upon which it could not do a great deal of research in view of more pressing projects)

aper in a small town in the South which was more or less isolated country. In this way it obtained publications which were quite effec- en, but which could be used to anticipate any patents which a com- ght obtain in fields which the company wished to hold open for its le entry at a later date.

now, no research program is ever capable of even beginning to exhaust ossibilities in a field. The way to hold open that portion of the field not be immediately explored is to make all manner of suggestions ether responsible or irresponsible, and obtain publication thereof that this will anticipate the other fellow's patent.

culty, of course, is in obtaining publication, particularly of material ted by factual data. One method is that referred to above. Another ich has been resorted to is the taking out of a patent in a foreign ich employs the registration system, such as France. In both in- wever, many patents have nevertheless issued because it was always get such publication under the nose of the examiner. Then too, both publication had a very serious drawback in that they provided a with the current thinking of the company making the publication, petitor got wise to what was going on. So we come along with the agraph of section 121 which is really made to order. There will no ny difficulty in getting the publication under the nose of the examiner l have been examining the very application being published, and no longer be any danger of providing one's competitor with one's nking, for the whole subject matter may be kept in secret for from re or more years by merely keeping the application pending in the ce. No idea that doesn't click is worth much after this period, so blic will gain nothing from its publication.

, we must not overlook the fact that this provides a very effective aking a competitor's morale in the development of new ideas, and in w competitors from entering the field. In warfare it is well recognized reatest morale breaker for the enemy is to let him complete a vast ore you blow it to pieces for him. He, of course, has been operating istaken idea that his activities would not be noticed by the other side, s a competitor (or a potential competitor) operates in developing a So after a competitor spends large sums of money in developing a new in bringing out a new product, with the belief that he has the field by way of patents, all that need be done is to expose the proper card, e proper patent application, to effectively anticipate everything which e. If the timing is right, the application may be published before the s patents issue, thus preventing their grant. The interference pro- uld help in ascertaining what applications a competitor has pending. now, any publication is effective as a reference, irrespective of the irresponsible material it may contain. Furthermore, in accordance t decisions, a mere suggestion is sufficient to anticipate. So we have very nicely set up for those companies who, while paying lip service, the patent system to be a disconcertingly restrictive nuisance. Many are so large that they do not need a patent system for purposes of ness. Some have arrangements whereby they exchange new ideas ng themselves. Their patent departments are maintained largely for urposes and for the purposes of attracting competent research men ow have a preference for seeing their contributions reach the public a of patents. On the whole, however, such companies would be far f the whole patent system were abolished, or in lieu thereof, the patents very greatly restricted so as to make the patent system in- In widespread business operations, the dangers of patent infringement troublesome, particularly when a company wishes to expand even

s that if the second paragraph of section 121 is enacted into law, it the beginning of the end of our patent system as a vitalizing force omy. I will not question its constitutionality, but it certainly nullifies the fathers of the Constitution had in mind.

no doubt know, the present practice in many foreign countries is before a patent issues the specification must be conformed to the minating all excess matter. My foreign associates have just given ling of such countries and they are England, Switzerland, Germany,

Holland, Sweden, Norway, Denmark, Finland, and possibly Japan, which is expected to follow its previous practice in this respect. Such practice was undoubtedly adopted to do away with the many broad irresponsible statements that foreign patents used to contain. In fact there was a time when such statements in foreign patents were so irresponsible that this became recognized by the United States Patent Office in decisions refusing to rely upon such statements as anticipations. You no doubt will recall certain decisions of this kind.

It seems to me that we should try to benefit by the experience of others in connection with such statements and not insist on learning the hard way.

I could say much more in speaking against the second paragraph of section 121, but I believe the above will give you some things to think about.

Yours very truly,

HUGO A. KEMMAN.

DENVER, COLO., *June 20, 1951.*

SUBCOMMITTEE NO. 3, JUDICIARY COMMITTEE,
House of Representatives,
Washington, D. C.:

Patent-codification bill. Proposals to publish patent applications reflect perversion of constitutional intent in and seek return of caveats long discarded as unsuited to American economic philosophy. Original committee-print proposal has been repeatedly considered and defeated by patent coordinating committee and individual groups. Proposals are inimical to individual inventors and small businesses and can benefit only large corporations who would neither seek nor require patents to maintain their dominance. Government defense agencies should if necessary be accorded a personal defense unavailable to general public.

Very respectfully,

MAURICE W. LEVY.

GOVERNMENT PATENTS BOARD,
OFFICE OF THE CHAIRMAN,
Washington, D. C., June 18, 1951.

Hon. EMANUEL CELLER,
House of Representatives,
Washington 25, D. C.

DEAR MR. CELLER: In response to your request of May 24 for an expression of views on the proposed legislation, H. R. 3760, I would submit the following statement as an indication of my views as Chairman of the Government Patents Board, in which the Board concurred at its meeting on June 4.

The Government Patents Board and this Office were established by Executive Order 10096, issued by the President on January 23, 1950, to provide for a uniform patent policy for the Government with respect to inventions made by Government employees and for the administration of such policy.

The only provision of H. R. 3760 with which the activities of this Office and the Board are likely to be concerned is section 212. If this section is to be included substantially as proposed, it is suggested that the section be amended (1) in lines 3–4 by deleting the words "but neither of the owners" and substituting "and any owner"; (2) in line 5 by deleting the words "or without accounting" and substituting "provided he accounts"; and (3) in line 6, before the period, by inserting the words "for any material consideration therefor."

While the above amendments would be preferred if the section is to be included substantially as proposed, there would be no objection to the reinstatement of the similarly numbered section 212 in H. R. 9133, Eighty-first Congress.

I am advised that the Bureau of the Budget would interpose no objection to the submission of this report to the Congress for its consideration. If I can be of further assistance to you in this matter please call upon me.

Sincerely yours,

ARCHIE M. PALMER, *Chairman.*

C. E. NIEHOFF & CO., AUTOMOTIVE PRODUCTS,
Chicago, Ill., June 6, 1951.

H. R. 3760,
NCEY W. REED,
of Representatives,
ress of the United States Washington, D. C.

RESSMAN REED: May I direct your attention to the above bill, H. R. 22, section 231, parts B, C, and D referring to infringement of patents. inion this brings up a controversial matter which has been previous- to and we are again objecting to it as we did in the original bill, H. R. Eightieth Congress, and also in the bill H. R. 3866, of the Eighty-first both of which were discussed with your Judicial Committee in ars.

section 231, parts B, C, and D, headed "Infringement of patents," n issue which looms as a very serious factor to us. We are engaged ufacture of replacement parts for the maintenance of automobiles, es, tractors, and so forth, and it is only a relatively few years ago ad to defend successfully a number of suits brought by General ch were carried to the court of appeals, in which the same issue of npatented parts for replacement to a distributor, such as used on of today, was determined.

reme Court refused General Motors a hearing, thus sustaining a ppeal. If General Motors had succeeded in their appeal, it may have giving the car manufacturers a complete monopoly on replacement ch unpatented parts, resulting therefore in an unreasonable level of motoring public.

at that time, that it was emphatically demonstrated through the II period, that these large concerns were unable to supply the needed rs, trucks, busses, farm implements, and so forth, and it was the nufacturer that helped to supply their needs. Actually, this bill our business very seriously for the future.

e the comments made by J. Carter Fort, of the Association of American mphatically set forth the seriousness of this bill, section 231, parts B, the maintenance of railroad transportation, in objecting to bill H. R. shown on pages 82 and 83 under Serial No. 2f, subcommittee hearings ttieth Congress. It is our belief, therefore, that this is a contro- ter which has been previously objected to and we are, therefore, his to you as a member of the Judicial Committee for your considera- same matter which is now appearing in the new bill.

you for your kind attention, that you may give this problem, we

rely yours,

C. E. NIEHOFF.

DEPARTMENT OF JUSTICE,
OFFICE OF THE DEPUTY ATTORNEY GENERAL,
Washington, July 3, 1951.

EL CELLER,
n, Committee on the Judiciary,
se of Representatives, Washington, D. C.

MR. CHAIRMAN: I enclose an extension of the testimony of Mr. Wilbur his Department, relative to H. R. 3760, a bill to revise and codify the

e testified before Subcommittee No. 3 of your committee on June 15, he did not permit a completion of his statement. Mr. Bryson, chair- committee No. 3, stated at the conclusion of the oral hearings that ould remain open for additional statements.

rtment as stated in our letter to you of June 13, 1951, is particularly to the possible effect of section 231 of the proposed bill in limiting on of the patent misuse doctrine. The rule that a patentee who has patents may not recover in a suit for direct or contributory infringe- he opinion of the Department, a salutary principle which is important rement of the antitrust laws.

sincerely,

PEYTON FORD,
Deputy Attorney General.

EXTENSION OF TESTIMONY OF MR. WILBUR L. FUGATE, ANTITRUST DIVISION, DEPARTMENT OF JUSTICE

Section 231 of H. R. 3760 is substantially the same as H. R. 3866 of the Eighty-first Congress, first session, and particular reference is made to the statement of the Department of Justice upon that bill (hearings before Subcommittee No. 4 of the Committee on the Judiciary, House of Representatives, Eighty-first Congress, first session, on H. R. 3866, May 25 and June 3, 1949, Serial No. IV, pp. 50-60, 63-64, 75-79).

Subsection (d) of section 231 is particularly objectionable in the opinion of the Department since, although couched in general terms, its effect is to permit a patentee to sell unpatented parts for a patented device or combination and at the same time prohibit his competitors, by suit for contributory infringement, from selling such unpatented materials in competition with him. Mr. Giles Rich, of the New York Patent Bar Association, who aided in drafting this section, has testified that subsection (d) (1) was designed to overrule the Barber Asphalt case (*Barber Asphalt Co.* v. *La Fera Grecco Contracting Co.* (116 F. 2d 21, C. A. 3, 1940)); that (d) (2) was designed to overrule the Mercoid cases; and that (d) (3) was designed to overrule the Stroco case (*Stroco Products, Inc.* v. *Mallenbach* (67 U. S. P. Q. 168, D. C., S. D. Calif., 1944)). The proponents of this section of the bill, accordingly, did not so much wish to clarify the law as to change it.

In the first Mercoid case (*Mercoid Corp.* v. *Mid-Continent Investment Co.*, 320 U. S. 661 (1944)), the Supreme Court (unanimous on this issue) applied the misuse doctrine to a case involving contributory infringement and held that where there was a conflict between the two, the misuse doctrine must prevail. The misuse doctrine, in this connection, is that a patentee may not extend the monopoly of his patent by attempting, by means thereof, to control competition in unpatented articles. The practice by a patentee of granting a license to those who buy unpatented articles from him and suing for contributory infringement those who do not buy from him comes within this rule as laid down by the Supreme Court. The Stroco case is merely an illustration of the rule. The courts with few exceptions, have applied the Mercoid cases as holding that there can be no recovery for contributory infringement if the patentee has misused his patents, but that without such misuse the patentee may recover for contributory infringement. The cases of *Florence-Mayo Nursay Co.* v. *Hardy* (168 F. 2d 778, C. A. 4, 1948) and *Harris* v. *National Machine Works* (171 F. 2d 85 (C. A. 10, 1948)), far from disregarding the Mercoid case as suggested by Mr. Rich, both refer to and follow it. The case of *Henry* v. *A. B. Dick* (224 U. S. 1), overruled in *Motion Picture Co.* v. *Universal Film Co.* (243 U. S. 502), was cited in the Florence-Mayo case merely for a statement as to what constitutes contributory infringement. The Court of Appeals of the Fourth Circuit still regarded this statement as good law in the absence of any misuse of the patents there involved. On pages 78 and 79 of the hearings on H. R. 3866 (81st Cong.) previously referred to, the Department of Justice listed 1948 and 1949 cases (to the date of the hearings) showing that there is no confusion in the law at present with respect to contributory infringement. This list supplemented a list of earlier cases set forth at pages 77 and 78 of the hearings on a similar bill (H. R. 5988) introduced in the Eightieth Congress. A list of subsequent cases decided from 1949 to 1951 is submitted as an appendix to this statement.

To summarize, the Department of Justice objects to section 231 since its effect might be to carve out an area in which the antitrust laws would not operate; Acts which are a misuse of patents, particularly the expansion of the patent to cover unpatented articles might no longer be a misuse. The proponents of the bill indicate that such a result is contemplated in the language of section 231. The courts are not confused as to the Mercoid doctrine and the Department opposes making an exception to the misuse doctrine under the guise of clarifying the law.

APPENDIX

(Prepared by the Department of Justice)

1949–51 FEDERAL CASES CONSTRUING THE MERCOID CASES

1. Cases discussing the effect of the Mercoid case on the contributory infringement doctrine.

Jordan v. *Hemphill Co.* (180 F. 2d 457, 461 (C. A. 4, 1950)), Judge Dobie:

(3) We are not impressed by the statement in defendant's brief that charges of contributory infringement are obsolete. What Mr. Justice Douglas said in

rporation v. *Mid-Continent Investment Co.* (320 U. S. 661, 669), was:
of this decision, together with those which have preceded it, is to
ntially the doctrine of contributory infringement. What residuum
we need not stop to consider."
views on that subject were very clearly expressed by Chief Judge
Florence Mayo Nuway Co. v. *Hardy* (168 F. 2d 788, 785): "There is
he contrary in the decision in *Mercoid Corporation* v. *Mid-Continent*
Co. (320 U. S. 661, 64 S. Ct. 268, 88 L. Ed. 376). That case merely
salutary rule that a combination patent may not be used to protect an
part from competition. Nothing of that sort is involved here. What
nts are doing is manufacturing and selling machinery with the
purpose and intent that it shall be used in a combination which will
he case is one where plantiff is using his patent not to monopolize the
t is not patented but to prevent defendants from aiding others to
nt is patented. A clearer case of contributory infringement could not
gined than that presented by this record."
Co. v. *Humble Oil & Refining Co.* (186 F. 2d 365, 368 (C. A. 5, 1951)),
ison:
rinciple applied in all of these cases is that no patentee can license or
ense upon a condition that the licensee will, in the use of the un-
terials, use only such material as it purchased from the patentee, nor
mplish or endeavor to accomplish this end by a course of business
issuance of licenses.
ciple was first stated in its simplest form in a contributory infringe-
connection with the granting of a restricted license, and it was for a
ed to be applicable only to cases of contributory infringement. It was
g. Co. v. *Barber* (302 U. S. 458), that methods of obtaining a monopoly
by a license upon condition, were first recognized. There, in a suit
ntributory infringer, the court held that the patent could be abused
tively when, by a deliberate plan or scheme, the patentee withholds
rder to bring about the same results, as to competition, which he could
anting a written license with a condition that the patented method
only with materials purchased from the patentee.
lt of that case and the line of cases following, declaring that the
t to stop contributory infringement is evidence of misuse, including
he *Mercoid Corp* v. *Mid-Continent Investment Co.* (320 U. S. 661), the
ontributory infringement has been greatly narrowed, if not completely
all cases where the holder of a combination or process patent is also
ndard or unpatented material.
volving misuse of patents, trade-marks, and copyrights, in which the
s are cited.
Radio Co. v. *Hazeltine Research, Inc.* (339 U. S. 827, 832 (June 5,
ce Minton:
h is condemned as against public policy by the "tie-in" cases is the
the monopoly of the patent to create another monopoly or restraint
on, a restraint not countenanced by the patent grant. See, e. g.,
. v. *Mid-Continent Investment Co.* (320 U. S. 661, 665–666); * * *
ofsky (9 F. R. D. 299, 81 U. S. P. Q. 442 (D. C. N. J., 1949).
ghting, Inc. v. *Versen* (10 F. R. D. 507, 87 U. S. P. Q. 204 (D. C. N. J.,

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GENERAL SERVICES ADMINISTRATION,
Washington, June 25, 1951.

R. BRYSON,
n, Subcommittee No. 3, Committee on the Judiciary,
se of Representatives, Washington, D. C.

BRYSON: This is in reply to your letter of April 30, 1951, which re-
omments of this Administration on H. R. 3760, entitled "A bill to
dify the laws relating to patents and the Patent Office, and to enact
35 of the United States Code entitled 'Patents'."
as been studied carefully to determine whether it might affect the
interests of this Administration. Since it appears that none of
of this Administration are directly affected by this bill we have
to make at this time.

We have been advised by the Bureau of the Budget that there is no objection to the submission of this report to your committee.

Sincerely yours,

JESS LARSON, *Administrator.*

MINNEAPOLIS, MINN., *May 14, 1951.*

Hon. JOSEPH R. BRYSON,
House Office Building,
Washington, D. C.

DEAR MR. BRYSON: I have read and studied with great interest the bill to revise and codify the law relating to patents and the Patent Office. I have been connected with patents and patent procedure since 1905, for some 7 years as an assistant examiner in the Patent Office, and since that time as a practicing lawyer. I think, therefore, I know something about some of the weaknesses which all patent lawyers recognize in the patent laws as they exist at the present time.

I am happy to be able to advise you that I consider that you have done a distinctly outstanding job in drawing up and presenting this measure. If it can be passed with very little, if any, amendments, it will, I believe, do a great deal to stem the tide of opposition both judicial, and in industry, to our patent system.

I don't believe one has to be a patent lawyer to recognize the value to this country of its patent system. Just to illustrate, back in 1895 a patent was secured for a means of regulating hot-air furnaces, which, through operation of a thermostat, turned on and off the drafts of a coal-burning furnace. Certain brave souls who owned that patent and had $1,000 in capital organized and began doing business as Minneapolis Heat Regulator Co. That organization with that small beginning, which unquestionably grew out of the procurement of the above-named patent, has grown into the great Minneapolis Honeywell Co., one of the large and very useful manufacturing corporations of this country. In my own experience I could name quite a few other advances in our industry which were made possible through the procuring of United States patents.

To me the patent system has always seemed one of the most democratic features of a free society. It amounts to a system in which the little man may conceivably think up something upon which he will secure a very substantial reward.

It has been true, by judicial interpretation permitted by the patent law as it now exists, that the patent system has become so circumscribed that first a patent lawyer must hesitate to advise a client that anything has possibility of being patented, and second that where patents have been obtained there is extreme likelihood that they will be found invalid and worthless. So I want to express my personal appreciation of the effort being made through your bill above identified to get an improved and more satisfactory patent law which will still hold out to the inventor the possibility of his obtaining a reward through securing a patent.

It is to be hoped that your bill, either as it is or with very small amendments, may be speedily passed into law. I realize that there may be opposition to the bill and there may be delay, but I am firm in the conviction that if this bill can become law, it will advance the entire American economy.

Yours truly,

F. A. WHITELEY.

CLEVELAND, *June 12, 1951.*

Re H. R. 3760.

MR. JOSEPH R. BRYSON,
House Office Building, Washington, D. C.

DEAR MR. BRYSON: Thank you for your letter of May 24 telling me that hearings on H. R. 3706 will be held on June 13. I should like very much to be there, but this will be impossible and so I will write my impressions, and ask that you include them in the record of the hearings for whatever they may be worth.

Much of the act makes no substantial changes in existing law, and therefore requires no comment other than the rather general proposal that it might cause less confusion to let the present law stand in such respects, so that whatever judicial interpretation has already been made of these sections will continue

without raising any suggestion that Congress, by repealing a section stituting another, had meant to give a slightly different effect.
k this applies pretty generally to sections 1 to 42, 104, 111, 113, 114, 117, 121, 122, 131, 132, 133, 141 to 146, 151 to 154, as far as 201 to 205, 250, 252, 301 to 304, 311 to 314.
ng with section 100, there is a definite attempt to clear up one of the most g and confusing aspects of patent law, namely: To provide some guide- determining what is patentable invention.
fficulty in the past seems to have arisen from the fact that the Constitu- well as subsequent legislation, has always used broad and vague words ing to invention and has left its specific application up to the judgment atent Office and the courts. These worked out various formulas, some ilder being the "flash of genius" proposition and Thurman Arnold's to say that what would be an invention if worked out by an individual in a garret, would not if worked out in the research laboratory of a ion.
afraid that some parts of sections 100 et sequitur, are subject to the ticism, for example: Section 100 (a) provides that "invention" shall "discovery." Now, discovery is nearly as broad and vague a word as , including as it does, geographical discovery and it would seem likely use in this connection would lead, on the one hand, to claims that use achines or equipment in new environments, where it has not theretofore ognized that it could be used, or changes or material, amount to dis- and, on the other hand, to a series of decisions by the courts that this, the other thing is not a "discovery."
100 (b) that "process" includes "method" does not help alleviate the which now is experienced with "process" and "method" claims, be- practical interchangeability of these two words has been recognized for e, while the main difficulty arises from two forms of attack on process or f claims: (1) that they amount merely to reciting the function of an s and (2) that they amount merely to selecting steps from several old

ference to a new use of a known process, etc., it is believed, is somewhat sly included in this clause. Certainly process does not necessarily (or perly) include machines or compositions of matter. Also the words, manufacture" probably were meant to be separated by a comma, or ant to imply that a thing made on a machine is "manufactured" by way aing away the etymology of the word "manufacture," namely: made by urely there is something wrong in the way this clause is written.
100 (d): Merely a grammatical error, in that no one has "title to the

101: Again merely grammatical. The first complete word in the should be "thereon," not "thereof."
102 seems to be merely restatement of R. S. 4886, but broken down ubheads.
103: The last sentence of this section is very good and it was much s it will obviate one of the types of wild decisions above-mentioned. sentence, however, opens the door to all the type of rejections in which iner takes an old patent which has some remote resemblance to an of an application and insists it would have been obvious to anybody he changes which the applicant has made.
many years of experience with patents, I have reached the conclusion annot safely leave it to any examiner or any judge to determine how nge one can make without getting away from what somebody can ous."
n look at any of the now admittedly important inventions and you k of any of them and find patents and disclosures of some parts of the a thing always looks so much easier after you know how it is done oes before. Hence, any invitation to the examining corps to stand wn opinion of what is "obvious" is going to perpetuate the uncertainty so long characterized patent practice.
I agree that an invention should not be predicated on something really obvious. I feel that any attempt to write into the law a pro- this kind must somehow, to be effective, exclude the determination of usness of a change by someone who already has the benefit of the disclosure.

How effective would Columbus' egg trick have been if he had first stood it on end and then asked the people whether it could be done? I would suggest some limitation, such as a provision to the effect that where a patent or other disclosure has been in existence for a substantial period of time without having made any recorded impression upon the field to which it applies, it shall not be available as a reference against a new invention merely by saying that to make changes in it would be obvious.
Section 112: The last paragraph should be very useful in obviating purely technical arguments on whether or not a claim is functional.
Section 115 apparently does not permit an applicant to affirm instead of swear to facts. Possibly there is some general provision, but it strikes me as lacking. There is one other point which occasionally arises which might well be included in this section. In Ohio, the law permits the attorney preparing and filing certain papers in court to take the oath or acknowledgment of the party he represents. This, of course, varies from the general rule that the attorney should not act as notary in a case where he appears as counsel.
It would seem, however, that little is gained in a patent application by insisting on another person acting as notary. The applicant generally reads his specifications, looks at the claims and says, "These are too technical for me and sound like the same thing over again. I'll take your word for it," and signs it. In this situation, the presence of a third person makes little difference. If the notary is an outsider, he doesn't understand the specifications or claims any better than the applicant, and if he is the attorney's secretary, it is practically the same as if the attorney, himself, acted as notary, so the net result of following the conventional practice is merely that every once in a while it is a nuisance to find a notary when and where you want him.
It would seem like a very opportune time and place to provide that the attorney may act as notary on papers to be filed in the Patent Office, at least in those States which permit him to act in swearing his clients in conjunction with litigation.
Sections 116 and 118, I believe, are a distinct step forward as there have been instances in which inventions have been lost by arbitrary refusals to sign or by people getting out of contact, particularly just at the end of a period which raises a statutory bar.
Section 121: In general, this seems to be a useful section, but the reference to the use of a parent or divisional case against another is a bit ambiguous, particularly in the mention of section 103. Would it not be better to specify clearly that neither a parent nor divisional case could be used as a reference against the other for any purpose?
As to section 134, it seems at the present time that appeal to the Board of Appeals has ceased to have any utility, as the Board of Appeals, apparently, has adopted the policy of never reversing the examiner. Thus, appeal to the Board has degenerated merely into an expensive formality before appealing to the Court of Customs or the Patent Appeals or to action under R. S. 4915. It is even worse than that, in that it gives the Patent Office Solicitor an opportunity to tell the court that there have been two concurring decisions in the Patent Office against the applicant, and particularly with some of the newer judges, this argument seems to be somewhat impressive.
Of course, if the judge would stop and think, he would realize that no case can come before him unless the Patent Office has concurred throughout in denying the applicant a patent; but quite obviously, some of the judges do not reason this far.
In other words, the Board of Appeals, while going through the motions of holding a hearing, is, in effect, refusing to hear, and thus harms every applicant whose case goes up on appeal by costing time and money and by providing a plausible-sounding, yet prejudicial argument against him.
As to section 135, the sentence providing that a judgment adverse to a patentee shall constitute a cancellation of his claims involved in the interference, may, in some specific cases, work out to absolute injustice, particularly where the Patent Office dissolves the interference on some technical ground from which there is no appeal to the courts, as for instance, on inability to make the counts. In such situations, the patentee would have no basis for an equity suit against the Commissioner because he already has what claims are in his patent. On the other hand, these claims would be negatived by this provision for automatic cancellation.
Section 206 would in a few instances, be beneficial.

n 211: The first sentence seems to imply that in some degree, patents personal property. This is certainly contrary to the general conception he holdings of the courts up to this point.

rse, if they are not to be considered property, that fact should be clearly s it would furnish a basis for the refusal to return them on personal tax returns. On the other hand, if we follow the presently accepted his sentence should be revised so as not to cast any doubt upon the fact are property.

k that section 212 would be a distinct advantage where two joint owners nt or application decide that they have come to the parting of the ways. section 222, this seems calculated to create a new kind of long-pending on evil. If the Government wants to keep something secret as a matfense, of course that should be allowed; but it should not be able to drag lications by extending the time for action to 3 years—that is six times individual would be allowed on the same identical article—solely beapplication belongs to the Government.

oted that this section requires no showing that there is any need for an application secret, but merely that it is owned by the Government something to do with defense or armament.

pecific example of what I mean, I understand that the present .30-caliber ns designed by Winchester Repeating Arms Co. Had it been designed rdnance Department of the Army, patent applications on it could be t for possibly 15 or 20 years under the provision of section 222; while, the corporation does not get this advantage but must answer every 6 nd so will get whatever patents it gets within a matter of 3 or 4 years. s nothing secret about the carbine in that a great many men handled very good gunsmith, gunner's mate, or anybody else having to do with understands the mechanism thoroughly anyway. So, had it been deAnny, why should its patent protection be drawn out as this section would permit?

the provisions of section 231, indicating clearly that contributory in- t is infringement, and certainly there is nothing out of the way about 2.

s 241 and 242 would seem to cut down on purely technical defenses, stion whether they will be effective for this purpose. Sections 243 to to be reasonable.

section 247, I think the second to last sentence should be revised to lear that this would apply only to a patentee manufacturing and not is product. As it reads now, I believe it might be applied to a patentee been unable to manufacture and thus has failed to mark any product tice and might be used in such an instance to let an infringer escape onsibility for part of his infringement.

248 does not distinguish between a claim of which the patentee had to invalidity and one to which he did not, but which may subsequently valid. In other words, it penalizes him for bringing suit for the first ny claims which may be held invalid, and there certainly are plenty il claims.

251: It is refreshing to see some attempt to bring any violation of the w into the criminal category. Certainly, one who steals another's l property is as much a thief as one who steals his tangible property, omes somewhat sickening at times, to see how often he gets away with off with insignificant damages. While this little fine does not apply to ent, it might, at least, be an entering wedge toward providing some hment for larceny of ideas.

one to some length in discussing details of the bill, not with the inboring you to death, but because I feel it really has much of merit needs a little tinkering up in spots and I rather hope that it will get it e favorably considered.

ertainly is need for something that will inspire people with confidence inventions are really going to be protected, as they surely do not feel now.

mber of patented inventions is still a long way below what it was 20 (53,473 in 1932—only 20,140 so far in 1951) and at least a million ideas short of what should be available if we had maintained the increasing rate of development which had existed for nearly a hunprior to the early thirties.

It is impossible, of course, to guess what the missing million inventions would have meant in increased wealth and convenience had they been made, but you can be sure that it really would have been something.

Sincerely yours,

HARVEY R. HAWGOOD.

SOANS, GLAISTER & ANDERSON,
Chicago, June 25, 1951.

Mr. ROBERT C. WATSON,
Watson, Cole, Grindle & Watson,
Washington, D. C.

DEAR BOB: Thanks very much for your letter of June 21, 1951. I have not time to express my appreciation at this time the way I would like to do so as I am just leaving for New York. However, I am sending you with this letter two copies of the material, which will be more convenient for you than to refer to my previous correspondence.

Sincerely yours,

C. A. SOANS.

(Mr. Soans' letter and the following material enclosed therewith is published at the request of Mr. Watson.)

SECTION 102 (G) (AS NOW WORDED OR AS PROPOSED TO BE AMENDED BY THE LAWS AND RULES COMMITTEE OF THE AIPLA)

This paragraph, as compared with paragraph 102 (c), creates a different standard of diligence as between the applicant and the defendant. The defendant's prior invention as a reference to an issued patent is not available as a defense, either if he had abandoned the invention or suppressed it or concealed it. Also, he must have exercised diligence in putting it into use (presumably public use) or in otherwise making knowledge thereof available to the public.

This is quite in accord with my ideas on the subject. In fact, I think that it includes some of my original language. However, when we come to the patentee, we find that an entirely different standard of conduct is used. All he has to do is to show that he has not abandoned the invention. In fact, the burden of proof is upon the defendant to show that the patentee has abandoned the invention, an impossible task in most cases, if the patentee has been sufficiently shrewd.

Under this section, if the patentee has the status of first inventor, there is no way that he can lose that status, unless abandonment is proved. It makes no difference whether he has neglected or delayed to inform the public of the invention after his reduction to practice. It makes no difference if he has concealed the invention or suppressed it. He can do either of those things without abandoning it. Furthermore, it changes the law in that a defense under the Metallizing case is no longer available. He can use the invention in secret for profit commercially for years, and under this section 102, as now written, he can get his patent, provided that there is no public use or sale more than 12 months prior to his filing date. Do we want this?

Then again, under the *Gillman* v. *Stern*, doctrine, there is nothing to prevent that patentee from suing a concern which, believing that the invention was unpatentable, or for any other reason, decided not to apply for a patent, but adopted the invention for commercial use in secret. I wish someone would tell me how I am to advise my clients when they ask me whether it is safe for them to keep the process secret while they are using it in commercial production.

Under this section as it stands, a person could reinvent the secret Coco-Cola process, assuming that they have such a process, obtain a patent on it and on the face of it, they could enjoin the Coco-Cola Co. from using the process which they have used commercially in secret for 50 years or more. Of course, I agree with you that no court in the land would so enjoin the Coco-Cola Co., but under the bill as written, they could be enjoined.

In connection with my criticism of section 102 (g), as now worded, I would like to throw into the hopper a proposed draft which, so far as I can see now, would remove my fear about advising my clients that they have the right to continue the commercial use of a secret process which later may be reinvented and patented by another person. The APLA amendment to 102 (g) does not restore this common-law right.

ified in sending you this proposed redraft because I have spent a
f time on this particular section, and several other persons have
with me.

SECTION 115

out at the March meeting at the Shoreham, section 115 does not cor-
section 102, and the way it is written, it merely encourages false
the case of an applicant who, a few days before he files his applica-
s that somebody in a foreign country made the invention before
did.

SECTION 151

n fails to establish any ground for the 1-year extension of the
he final fee. Under this section, it is not necessary to show any
or mistake. It seems to arbitrarily extend the 6-month payment
riod of 18 months. That is one way of lengthening the patent term
that is what is wanted.

SECTION 201

derstanding that the old 2-year limitation for broadening a patent
on the 2-year publication rule, and that when the statute was
2 years to 1 year, there was an inferential change in the 2-year
adening by reissue. This paragraph of the bill, therefore, is not in
he existing law as I understand it.
e, if the unwritten 1-year rule is changed to a statutory 2-year
ay be an inference that diligence in applying for reissue is no
ry. The statute should be made clear, in my opinion, that whether
to be narrowed or broadened by reissue, diligence should be

SECTION 202

paragraph seems to me is entirely too broad in that it says "the
." It seems to me that the intervening user should have the right
changes in "the specific thing" as in the normal course of business
a person skilled in the art.

SECTION 206

ion there is far too much emphasis placed upon the necessity of
he patent by the Commissioner.
out at the Shoreham meeting, 95 percent of the cases arising
ction would be cases of misjoinder, i. e., where the patent con-
ames than those of the actual inventor or inventors, or where
aims of the patent were joint inventions and other claims were

objection to permitting a court to ignore the extra name or names
What harm is done to any one so long as all of the patent is
gle interest, which is the case in 95 percent of our practice. Under
I and others construe it, a court cannot merely ignore the mis-
st send it back to the Patent Office or, at any rate, some positive
e taken by the owner of the patent in order to enable him to
ent. But suppose the trial is suspended, the patent goes back to
ce to be corrected, and when the trial is resumed the court sus-
t as corrected. What happens then if the court of appeals says
ct court made a mistake, because as they construe the claims
e, in view of the prior art, it was a joint invention. Where does
ntentee? It seems to me that this procedure of having to go back
ffice in a case like this is useless, cumbersome, and dangerous.
articular feeling on the question of nonjoinder because that, I
y different situation which justifies a much more elaborate and
re particularly in view of the fact that an oath is required.

SECTION 212

lines of this section are susceptible of two interpretations. Under
ien, a license or assignment can be made with an accounting,
e consent of the other coowner. Under the other interpretation,
er grant may not be made unless the two conditions exist, i. e.,

the consent of the other coowner must be given, and also the grantor is required to account to the other coowner. However, except for this ambiguity of language, I would be willing to accept either interpretation, although I believe that consent should not be required provided that we have an accounting in all cases, the same as in the case of any other property owned by a partnership.

My real objection to this paragraph is that it makes no attempt to correct the terrible injustice which may be perpetrated upon an uninformed patentee. I refer to the notorious practice of inducing a patentee to sell say 1 percent of his interest in the patent, which enables the owner of the interest to manufacture to any extent without accounting to the patentee for the profits made out of the invention. The proposed bill does nothing to correct this situation, but, I believe, makes it worse in that the patentee, after having sold a tiny fraction of his patent to the nonaccounting manufacturer, could not thereafter sell any other part of his patent or license anyone else to use the patent without the consent of the 1-percent owner, or without accounting to the 1-percent owner.

I cannot see the slightest reason why a patent owned by two persons should not be subject to precisely the same rules as any other property owned by two persons jointly or in partnership. When one member of a partnership deals in the partnership property, he has to account to the other joint owner or copartner. To perpetuate a different rule in the case of a patent right, it seems to me tends to intensify the belief that a patent is not property, whereas it is the contention of patent lawyers generally that a patent is property.

SECTION 231

Paragraph (b) of this title says that one who actively induces infringement is liable as an infringer, whereas paragraph (c) of this title specifies an act which renders the doer liable as a contributory infringer.

The liability for contributory infringement is not defined in section 231, nor in section 241, nor does section 244 deal with contributory infringement. Is there any distinction intended?

Is it the intention of section 231, as a whole, that the liability of the contributory infringer, or shall we say the supplier, shall be liable as a joint tort feasor, and, hence, liable for the entire recovery which can be collected by the patentee under section 244. Some of us who have given thought to this question are of the opinion that the damages recoverable from a contributory infringer should be prorated or limited in some way in accordance with the character of his contribution, or possibly to the profit which he makes out of the parts or other facilities which he supplies to the direct infringer.

Also it is felt by some of us that there should be no recovery from a supplier except in respect of facilities supplied after actual notice received from the patentee.

Paragraph (c) is believed to be inaptly drawn. As it is written, the word "knowingly" qualifies the word "sells." Of course, when a man sells a thing he knows that he sells it. Obviously, the word "knowingly" is intended to qualify something else later in the paragraph. The question is whether the word "knowingly" is intended to apply to the words "shall be made or shall be adapted for use in an infringement of such patent." I will treat the paragraph with that interpretation.

Here again the scales are heavily weighted against the struggling manufacturer who has invested his entire small capital in a small business of manufacturing a single item. Let us assume that the item is a machine which includes a casting made of a metal chromium alloy, which castings are produced only by one or two foundries in the United States. Obviously, those castings are made in accordance with special patterns or blueprints furnished by the little manufacturer to the foundry.

Let us assume that this small manufacturer has made a prudent investigation of the prior art, and his counsel has advised him either that a certain patent is invalid or that it is not infringed by his machine. However, the owner of this patent, when he realizes that the small manufacturer is competing with him, forthwith notifies these two foundries that if they furnish this special casting to the alleged direct infringer, the foundry will be held liable for damages. This foundry thereupon calls upon the little manufacturer to furnish a cash bond to indemnify the foundry against all damages which may be assessed against the foundry for their contributory infringement. The little manufacturer having invested all of his capital in his business, which is just about beginning to break even, is unable to furnish the bond, as a result of which the foundry refuses to fill

for the castings. And the same thing happens with the only other ich is in a position to make these castings for the little manufacturer. It is that without the expenditure of 1 cent for litigation, the owner nt has, in effect, obtained an injunction against the little manufac- s thus put out of business because of the patent which he was advised ringed by his machine. Perhaps you will say that the little manu- e file a declaratory-judgment suit against the patentee. That may remember that he is out of business, he cannot make any machines, ource of income to pay his lawyers and to keep his business running pendency of the litigation which may run along for 3 or 4 years. t that he has filed a declaratory-judgment suit does not require the supply him with castings. Why should they run the chance of ted to heavy damages, especially if they have other customers clamor- ngs?

easons stated, I am against paragraph (c). It seems to me that b) is all we need. I think that it will take care of 95 percent of in which there is a real need for a right of action against the sup- the remaining 5 percent of the cases, the patentee ought to be satis- right to sue the direct infringer.

agraph (d), however, desirable it may be from the standpoint of ts inclusion amounts to a request to Congress for a law which will t of spanking the Supreme Court of the United States for its attitude misuse of patents. And, in this connection, we must not forget that Court in deciding these cases has ostensibly reformulated or reex- principles of equity jurisprudence which have been well established r many years, but, according to the Supreme Court, have not been onnection with patent rights. The wisdom of asking for such legis- time it seems to me is open to grave question. It is, in fact, a f war concerning a very delicate question. It is a change in the y stands, which is controversial in the sense that the patent bar e of the question and the Supreme Court is on the other side of and I cannot see any reason why Congress would want to stick its his issue at this time.

any invention shall be patentable unless:

* * * * * * *

er person is entitled to a date of invention prior to that of appli- te of invention upon which any person is entitled to rely shall be n which such person, having a full conception of the invention, pon said invention in the United States and, with such diligence able under all the circumstances of his case, continued such work ed the invention to practice in the United States or filed an applica- ed States patent disclosing said invention: *Provided*, That any e entitled to the benefit of another person's activities in working tion the conception of which was derived from the former person: t a person who is shown to have failed to take steps to inform the invention until a date which is an unreasonably long time after to practice or filing of his application, shall not be entitled to a ion prior to the date when such steps were taken by him. Such of example, may be taken by reasonably presenting and prosecut- r said invention in said application, or putting the invention into on sale in the United States, or publishing the same in a printed the United States: *Provided, nevertheless*, That no patent shall in respect of any use of the patented invention by another person ors in business, if such other person used said invention in the for profit before the date of invention of the applicant."

last proviso is to protect anyone who commenced an unpublished e of the invention if he were to be sued for infringement of a obtained under the rule stated in *Gillman* v. *Stern* (114 F. 2d 28).

wing new paragraph:

at or anyone with his consent at any time, more than 12 months ng of the application for patent in the United States, had secretly ion for profit and not primarily for experimental purposes.

new paragraph recognizes *Metallizing Engineering Co.* v. *Kenyon* F. 2d 516), and is set up in a new paragraph because paragraph solely to priority of invention by another person and does not nt's own use for profit.

459 DOGWOOD LANE,
Plandome, N. Y., June 1, 1951.

JOSEPH R. BRYSON, M. C.,
Chairman, Subcommittee 4, Committee on the Judiciary,
House of Representatives, Washington, D. C.

DEAR SIR: Thank you very much for sending me a copy of H. R. 3760.

I have reviewed this bill and find it an improvement over its predecessors. There are several points, however, to which I would like to direct your attention.

Section 4, restricting the rights of employees of the Patent Office upon termination of employment: I have never encountered a case of abuse of position by Patent Office employees leaving the Office and am unable to see a basis justifying deprivation of their right to establish a date of invention in the year following termination of their employment.

Section 121: The language of this section, which prevents use of a parent application as a reference against a divisional application, appears to be too broad and I believe might hamper proper functioning of the Patent Office. According to the language of the section, the parent application or patent issuing thereon may not be used against the divisional application regardless of what type of claims are presented in each. It would appear to me that the restriction should apply only against the claims subjected to a requirement for division or their equivalents. Further, reference to section 103 seems ill-advised. Section 103 relates to improvements which would have been obvious at the time the invention was made. Since the divisional or parent case could not go back of the invention date in any event, it could not be used "for the purposes of section 103." I would suggest the section be amended as follows:

Line 10, after the word "against," insert: "the claims subjected to the requirement, when presented."

Line 11, change the word "against" to "in."

Line 12, delete "for the purposes of section 103 of this title."

Section 242, subsection (2), line 1: I believe the expression "any claim" should be "the infringed claims."

In the line following subsection 4, the word "of" (first occurrence) should be "or."

Section 314: While this section seems to follow the present law, there is serious doubt in my mind that a minimum recovery is proper. There is no minimum specified for ordinary patent infringement. The minimum liability provision is like the copyright provision in form but not in substance. Liability in a copyright case depends upon proof of copying but in a design patent case a second inventor entirely innocent of copying would be forced to pay at least $250 even though no real damage were found.

Page 28: I find the appearance of sections 2, 3, 4, and 5 on this page very puzzling. Where is section 1? Of what chapter are they sections?

Very truly yours,

GEORGE B. CAMPBELL.

CHICAGO, ILL., *June 13, 1951.*

Re H. R. 3760, especially section 103.

SUBCOMMITTEE ON PATENTS, COMMITTEE ON THE JUDICIARY,
House of Representatives, Washington, D. C.

GENTLEMEN: There is a tremendous need for the bill H. R. 3760 is intended to be. For the sake of inventive progress and justice, let us not muff the opportunity by passing the bill before it is in the best condition reasonably possible for revitalizing the patent system.

Most of all, this necessitates for section 103, the definition of "patentable invention," a wording which is neither too liberal to patents (lest it be ignored) nor too weak (lest it fail to help even if followed): The phrase "would have been" is too weak. Its intention may be good but the words alone invite deciding what "would have been" obvious after the prior-art references had been put side by side. Almost any inventive idea could be induced into the mind of a good mechanic by carefully selecting the right prior patents, placing them in front of him and saying; "What do these two patents together suggest to you?" The test should be: Would the invention have occurred to him without such direction of his thoughts?

Accordingly, if the phrase "would have been" is retained, I urge that the qualification doubtless intended be added. The inserted phrase could be, for example, "without guidance by preselection and juxtaposition of the prior art."

n the other hand, "obvious" is so generous to patents that if it is followed literally. In that event, it will lose all strength by sity of departing from it and the consequent lack of statutory f where the line should be drawn. For example of excessive ose a prior patent indicates that a certain ingredient should be atch is at a temperature at which rapid precipitation will occur, ed 200°, depending on degree of acidity. It is not obvious from that with one particular acidity the temperature should be 178°, is no intention to grant a second patent limited to this tempera- hemist could easily determine by experiment.

rt": This phrase does not say what is meant. "If a prior patent industry controls ink supply by a photocell and an amplifier, ditter would not be within the skill of the ordinary printer, but justify granting a patent. Some skill of other arts must also surpassed before invention is present.

ng I can think of at present is the following:

subject matter as a whole would have naturally occurred at he invention was made to a person having only ordinary skill hich said subject matter relates if he had knowledge of said ior arts readily available to persons in that field [words in erred] but had no guidance by its preselection, and said subject been worked out by such person with such ordinary technical ould have been expected to call upon."

nments are enclosed, separately written up for different sections. rge that before reporting the bill, efforts be made to overcome s or may be sound.

truly,

LOUIS ROBERTSON.

CONTRIBUTORY INFRINGEMENT—SECTION 231

hat an article I have prepared will appear in the July issue the Patent Office Society. It is too long to justify inclusion ce a copy has already been sent to Mr. Federico.

e, I will merely say that subsections (b) to (d) of section tly improved before passage.

MISJOINDER—SECTIONS 116 AND 208

s applicant of an extra person, i. e., one in addition to the ns to be entirely harmless in all instances except when he roperly gain by it; and in these instances the possible in- ent is often no discouragement to him but only penalizes the innocent.

better to provide simply: "The naming of an extra person ntentee shall be disregarded, except that courts may refuse f of such person his apparent rights as copatentee and, if he ted himself to be named, his rights by assignment. The strike his name, if satisfied that no claim would be

JOINT OWNERS—SECTION 212

10-percent owner need not account to a 90-percent owner is is no adequate excuse for writing into the statute an unjust not necessarily the law in all States. There is no excuse at system blamed for unjustness, even if it is to be the law tion. The alleged but fallacious purpose of warning the ig- mplished by an express denial of a change, such as: duty or absence of duty to account to the other owners this act."

uld be to legislate away the old doctrine completely, but courts to render justice. For example: "with a duty to owners on such basis and subject to such exceptions as the t."

TWO-YEAR REISSUE RULE—SECTION 251

The 2-year limit on broadened reissues is unjust. The more basic an invention, the less likely an inventor is to learn within 2 years that his patent cheats him of the protection to which he is entitled. To such extent as the time limit is justified on any fallacious theory of unfairness in letting the inventor cover later inventions he had not thought of, the time limit should date from his original patent and should apply in original applications long pending. The only additional equities against reissues are protected as intervening rights.

Nevertheless, if the theory must be applied selectively against reissues, it can be done in a less unfair way by canceling the present last paragraph of section 251 and instead adding to the last paragraph of section 262 the following:

"In the case of any reissue patent enlarging the scope of the claims of the original patent, especially if applied for more than 2 years after the grant of the original patent, the principles of intervening rights set forth in this paragraph may be extended to protect investments of time or resources in invention, patenting, or development, even without the preparation specified in this paragraph."

NEW YORK, N. Y., June 26, 1951.

Re H. R. 3760.

JOSEPH R. BRYSON, M. C.,
House Office Building, Washington, D. C.

SIR: In answer to your letter of some while ago asking for comments on this bill I suggest the following amendments:

(1) Section 42, after "law" at end of section, insert: "or for service not rendered." This is particularly aimed at the return of a Board of Appeals fee when an examiner gets cold feet and does not transmit an appeal.

(2) Section 103, end of first sentence, insert: "An applicant's own statement in his application may not be used against him in interpreting prior art." If, within a composition or machine, applicant states he may use an element A or B, and previously A has been similarly used, prior art rather than applicant's application should be relied on to teach the equivalence of A and B if the skilled person does not already know it."

(3) Section 112, after second paragraph, insert: "But no claim shall be declared invalid for lack of distinctness or for undue breadth when the description clearly discloses the subject matter of the claim and the claim is as definite as is reasonably possible without arbitrary limitations."

This is in line with the recognition in plant patents (sec. 302) that the patent system need not rest on mere words. Justices Burton and Jackson hold this position in a dissent, *Funk Bro.* v. *Kalo* (333 U. S. 127). It should be remembered that the broad claim always expires and the patentee takes from the public only the use of independently made later inventions and he gives a perpetual disclosure of the invention.

(4) Section 132 in next to the last line insert the sentence: "The applicant shall have the right to amend any claim as often as new reasons for rejection are presented." This is an attempt to force the examiner to give thorough actions at the outset, but if the Patent Office makes an error at any stage applicant can be assured of an opportunity to alter his claim without need for a personal interview with the examiner. As the statute and rules of practice now stand, the distant applicant is at a disadvantage.

Broad valid claims help not only the inventor but progress as a whole. Each patent is a challenge to a subsequent inventor, and the broader a claim to be avoided, the more radical must be the line of attack.

As a former research chemist one of my jobs was to see how to avoid patents. The narrow claims did not cause me to learn nearly as much as the broad ones.

At present, especially with chemical inventions, I frequently advise a client to keep his invention secret rather than risk meager patent-system protection of a new process that will possibly be mostly a suggestion to another chemist who may have greater facilities for further study. I have lost fees by such advice but I have gained the confidence of many clients.

I personally intend to work only in the chemical field where the chances of keeping the invention secret are good. Of course there are risks, but nothing seems to be more risky than trying to predict how a court will treat a patent claim under the present statutes. Even when the decision is in favor of the

Supreme Court is capable of reasoning in a manner I simply cannot
Justice Douglas' dissent in *Graver Tank* v. *Linde Air* (636 O. G. 1),
20, 1950).
very truly,

F. R. JENKINS.

UNITED STATES COURT, EASTERN DISTRICT OF NEW YORK,
Brooklyn, N. Y., June 20, 1951.

3760"
EL CELLER,
se Office Building,
Washington, D. C.

NIE: Some thoughts concerning this bill have occurred to me which
to pass on to you if I may.
erned mainly with the plight into which patents have fallen when
run the hazard of litigation. Fundamentally the difficulty in the
from the fact that the term "invention" is not defined in the statute
been any affirmative legal definition.
rally, in respect to patent litigation and the difficulties encountered
wrestling with the problem of invention, let me refer to the opinion
rankfurter in *Marconi* v. *United States* (320 U. S. 61), and to the
dge Learned Hand in *Parke-Davis Co.* v. *Mulford Co.* (189 Fed. 95,
ifficulty apparently was very carefully considered by the National
ning Commission which was appointed by President Roosevelt on
1941. In its report filed in 1943, it is said:
mission, therefore, recommends the enactment of a declaration of
tentability shall be determined objectively by the nature of the con-
he advancement of the art, and not subjectively by the nature of
y which the invention may have been accomplished."
e that I was invited to deliver before the American Chemical So-
ork section, I took the position that the most satisfactory test of
ust that suggested in the foregoing report. The contribution that
nakes to the art, which is presently in need of improvement or de-
fords effective and definite evidence: no satisfactory subjective
can be employed as a rule of decision. One cannot take an X-ray

er matter: Courts have lightly treated the so-called presumption
hich is supposed to attach to the grant of a patent. Such a pre-
ld be made real and not merely figmentary if in the proposed
ovision were made for adversary proceedings. Such proceedings
e form, either before issuance of the patent but after publication of
is in the Patent Office Gazette, of opposition, or of cancellation
fter the patent issued. The effect of such a provision would be
e patent reaches the court for adjudication it could no longer be
e result of merely ex parte consideration.
ought is in reference to the misuse of patents. Under present
ourts, following a direction of the Supreme Court, will refuse to
o one who has misused his patent unless he can show desistance
use prior to the creation of issues in the case. But there is no
ourts to void a patent for such misuse. That might well be the sub-
essional consideration.
o find in section 231, subdivision (d), the provision relating to con-
ngement. This provision if adopted will meet the hiatus in the
d out by Mr. Justice Black in *Mercoid Corp.* v. *Mid-Continent In-*
t'al. (320 U. S. 661).
ersonal regards, I am
y yours,

CLARENCE G. GALSTON.

CINCINNATI, OHIO, *June 13, 1951.*

BRYSON,
Washington, D. C.

YSON: I take this occasion to express my disapproval of the above-
together with various proposed amendments and suggestions
rious meetings of patent law associations and the like. Essen-

tially my objection is directed to the attempt to accomplish, incident to codification, the inclusion of controversial aspects into the fundamental law of patents. It is my personal opinion, that patent laws should be codified without any change in substance or subject matter. Thereafter, any additions or deletions that may be proposed by any person or group of persons, may be considered seriatim. Any other handling of the matter will necessarily result in delay in codification, since it is my personal observation that there is no unanimity amongst patent lawyers as to the desirability of the proposed changes in the patent laws.

In making the foregoing observation as to the lack of unanimity, my impression is that there are more patent lawyers who are opposed to the indicated changes in patent law than there are those who approve thereof. I am not unmindful of the fact that the apparent approval of H. R. 3760 by various patent law associations and the like, would appear to indicate the converse of my observation. My observation is predicated upon the fact that at a meeting of the Cincinnati Patent Law Association on June 12, 1951, we considered the referred to H. R. 3760, together with the proposed changes and amendments referred to. After discussion, consideration was given to the question of whether the Cincinnati Patent Law Association should pass a resolution endorsing H. R. 3760, together with the proposed amendments. A motion was made and carried that the entire matter be tabled. The vote was overwhelmingly for tabling the matter. Consequently, I consider that as indicative of disapproval by the majority of the group of patent lawyers there assembled, of inclusion of such proposed changes of patent law in the codification of the current patent laws.

In voicing my objections to the proposed changes in patent law as incorporated in H. R. 3760, I do so as an individual and my reference to the action by the Cincinnati Patent Law Association must be understood as reflecting the background upon which I express my foregoing impressions. Incidentally, the Cincinnati Patent Law Association at that meeting, specifically desired to avoid going on record as an organization opposing H. R. 3760, inasmuch as by so doing it would be opposing the more or less concerted effort on the part of other patent law associations, to further the amendment of patent laws incident to codification thereof.

In view of all of the foregoing, I sincerely recommend that the effort of your committee undertake solely, codification of the current laws on patents and that there be excluded from the product of your committee any changes that any person, group of persons or interests, may now wish to incorporate in the codification of patent laws.

Very truly yours,

FRANK ZUGELTER.

BAR ASSOCIATION OF THE CITY OF NEW YORK—REPORT OF PATENT LAW COMMITTEE ON BRYSON BILL, H. R. 3760, CODIFICATION AND REVISION OF PATENT LAWS

This committee has studied the Bryson bill, H. R. 3760, and believes that if passed by the Congress, the patent laws will be materially improved.

This committee recognizes the difficulty of getting entire agreement among lawyers not only as to the contents of such legislation but also as to its form. It believes that if no changes were made in the proposed bill it would still be a substantial improvement over the existing law. Nevertheless the committee feels that the bill could be improved if the following changes were made:

Chapter 2, section 103, page 9: In line 2, substitute "as" for "in the prior art" and change the word "that" which is the third word in the fourth line to "the." The purpose of this is to make it clear that all prior art is here meant and not merely the prior art referred to in section 102 which is limited to anticipatory art.

In the fifth line substitute "was" for "would have been."

The reason for this is to avoid the subjunctive form and to emphasize that the criterion of obviousness is to be determined as of the time the invention was made.

Chapter 2, section 121, page 13: In the third line substitute a period for the semicolon, and the word "If" for "and."

In the fourth line substitute "are" for "may be"; strike out the period and insert "directed solely to subject matter described and claimed in the original application as filed"; in the same line substitute "they" for "A divisional."

In line 5 strike out "application."

In line 6 substitute "they comply" for "it complies."

In line 12 insert a period after "title" and strike out "if."

Strike out all of lines 13 and 14.

5 strike out "and claimed in the original application as filed." In
ne substitute "The" and "the."
10, after "execution" insert "of such divisional applications."
mittee finds the thirteenth line of the section ambiguous. This sec-
ended to prevent the citation of a patent as a reference where division-
ed by the Commissioner and there was copendency with the applica-
issued patent. This particular situation requires definition, which
l language accomplishes.
2, section 135, second paragraph, page 15: In line 1 substitute "Any"

Insert "not" after "may."
t line 3 and substitute the following: "application unless a claim
tially the same subject matter was made in such application prior
nce of said patent or within 1 year from the date on which said
granted."
se of this provision is to make sure that the 1-year period will not
ecome who had previously had claims to substantially the same
ter, making those claims even after such period. No such limitation
d by the paragraph as originally drafted.
, section 202, page 19: Starting in the fifth line of the second para-
itute "unless" for "if," and at the end of the line insert "would
ed."
strike out "does not infringe a valid claim of the reissued patent-
n."
r clarification and to get rid of double negative.
ond line of the third paragraph substitute "like things" for "such

make it clear that the court may allow replicas to be made of the
gs referred to in the second paragraph.
, section 211, page 21: In the first and second lines strike out "appli-
" and substitute "attributes."
, section 212, page 22: Strike out entire paragraph and substitute
g:
r two or more persons own a patent jointly, either by the issuing of
to them jointly or by reason of the assignment of an undivided
he patent or by reason of succession in title to such interest, each
owners, in the absence of any agreement to the contrary, shall be
ake, use, or sell the patented invention, or license others so to do,
eficumber his interest without accounting to the other joint owners."
mittee believes that the existing law should be codified and not

, section 231, page 23: In the second line of page 23 strike out
ory" and substitute "an."
rd and fourth lines strike out "for infringement or contributory
of a patent" and substitute "under paragraphs (a), (b), and (c)

and 10 strike out "contributory."
strike out "or contributory infringement."
ributory infringement is a form of infringement and the use of
es not appear anywhere else in the bill, it seems preferable to
f the acts mentioned in this section as infringement.
, section 252, page 26: The committee has not had sufficient time to
law as to whether jurisdiction could properly be obtained of a non-
entee served by publication. It believes that it would be preferable
end of the paragraph the following:
e of the grant of a patent hereafter shall constitute an irrevocable
sued as provided in this section and appointment of the Commis-
tents as agent of the patentee to receive service of process under

line should be changed by striking out "and summons shall be
blication or otherwise as the" and the words "court directs" should
en out in the ninth line.
y submitted.

her Blum, Dean S. Edmonds, James M. Heilman, Giles S. Rich,
Ralph M. Watson, John C. Blair, Cyrus S. Hapgood, Wilfred D.
Keith, James B. L. Orme, Dana M. Raymond, William R. Carlisle,
Francis X. Fallon, Jr., Walter H. Free, Oscar W. Jeffery, Ernest S.
Meyers; Alexander C. Neavy, chairman.

51.

STATEMENT OF R. S. OLD

With particular reference to section 206 of this bill, and also with reference to sections 116 and 118, it is believed that the present statutory requirements as to the true inventor or inventors being stated in a patent application when originally filed, should be retained, and that the change of a joint application to a sole application, or the removal or addition of an inventor to an application on an allegation of inadvertence, should not be permitted.

If in fact an invention has been made, it should be possible with reasonable effort and within a reasonable length of time to determine who is the true inventor, at the time the patent application is originally prepared and filed. Experience has often shown that when a comparatively large number of persons are alleged to be joint inventors, the fact is that no invention has really been made. If each has simply made a small individual separate contribution from his knowledge of the art, there is not joint invention.

There is nothing new in the proposal of section 206 of the present bill; it has been submitted to Congress on a number of occasions. In the hearings before the House Committee on Patents, May 9-10, 1940, on H. R. 9386 (76th Cong., 3d sess.), as to plural applicants, I pointed out a number of considerations which should receive attention on this problem.

If an application in which there are half a dozen or more joint applicants becomes involved in interference proceedings in the Patent Office, when the opposing party prepares to cross-examine the various joint applicants, he will, if this proposal becomes law, be faced with the possibility that only one of the plurality of joint applicants will eventually be brought forth as the true sole inventor, which considerably complicates and increases the work required to prepare for the interference testimony.

Similarly, in an equity suit in court between interfering patents, or even in an ordinary infringement suit, uncertainty as to who will eventually be brought forth as the true inventor, materially increases the difficulty of preparing for trial.

If a provision of this kind of section 206 is to be enacted at all, it should specify a maximum number of joint inventors who would be entitled to its benefit, say six joint applicants as a maximum.

If the proposed section 206 becomes law, it may be anticipated that applications filed on behalf of large organizations, private or governmental, will be filed in the names of a multiplicity of alleged joint applicants, some of whom have in fact engaged in only administrative activities and cannot be considered to be joint inventors even by great charity and imagination. It has been only the exaction of the existing requirement to state correctly in the original application when filed the name of the true inventor, which has in the past discouraged the addition of the names of alleged joint applicants who were known in fact not to be joint inventors, but who desired for personal laudatory purposes to have the record show that they were inventors.

Probably the most serious practical objection to the present proposal to allow the joining as applicant of persons who are in truth not inventors, is the discouragement and loss of interest in the making of inventions which will inevitably be experienced by inventors, with resultant decreased inventive contributions. Unless a person has had personal contacts in a research or a development organization, or group, he is likely to have little realization of the sense of fundamental injustice with which creative workers regard every effort to recognize as coauthor or coinventor a person who in fact contributes but the routine efforts of the timekeeper and slave driver.

The Constitution authorizes the grant of patents to inventors for their respective discoveries. There is no constitutional provision for granting a patent which sets forth as inventor, the employer, the financial backer, or the boss, of the true inventor. This concept of inventorship was inherent in the particular appreciation of intellectual and spiritual values, and the right of the creative worker in his creation, which was inherent in the genesis of American institutions and Government, and is part of our heritage. It provided for recognizing and rewarding the intellectual creative worker as an originator for his creation contributed to society.

There is no power conferred by the Constitution on any one to declare that a person is the inventor, who in fact is not the inventor.

From the beginning of the American patent system, repeated assaults have been attempted on this concept of the status of the inventor and the creative worker, from every approach. The creative worker constitutes numerically a

centage in any population group, and the large majority who are
d are continually casting an appraising and nonunderstanding
wards as the creative worker may obtain. The entrepreneur has
ght to be vicariously recognized as an inventor when he was not,
ps that his chance of lasting fame would be thereby materially
e workman who has simply sawed and bolted as directed, has also
ion as the inventor. It is commonplace in patent practice to find
who is to put up a few dollars to finance development of a com-
, wants to be considered the inventor and to be a joint applicant,
only when told that no valid patent can be so issued. The essen-
character of the American patent system is the recognition of
or as such regardless of his financial position. Entrepreneur
d to its own kind of recognition.

ection to the proposed provision of section 206 is that it is likely
imply an entering wedge to entirely destroy the American con-
ship, and to permit the filing of patent applications in the first
lleged employer, or assignee, thus converting the patent system
system of property rights. There have always been those who
this kind of a patent system. In some foreign countries, as in
is view has been approximated, and they have a wholly different
should be the applicant; the person or corporation who has
an invention or even the returning traveler from foreign lands
e another man's idea, old in a foreign land, but new in Great
ply for an original patent. It is not believed that the record
he British system has been as prolific in worth-while inventions
system. Corporations as such are certainly incapable of cre-
ntorship is a personal activity.
at a man's brain children are his own in a very real sense, may
ndamental concept among most peoples, and a part of natural

n, the public is entitled to know who is the true inventor, and not
person that claims the title to the invention.
uch as section 206 becomes law, the determination of the num-
for a patent may be expected to become a fishing expedition,
solve all doubts in favor of putting in every one who might in
idered to be an inventor, instead of trying to ascertain the real
e invention was made.
testimony before committees of Congress over a period of years,
ustrial corporation it is not unusual to get 50 research workers
, all of whom had had something to do with a project, one of
as to be covered by a patent application, for the purpose of
should be set forth in the application as the applicant and in-
e decided that all 50 were joint inventors and should be joint
sumption would be that a true invention had not been made.
Government research laboratories the effect of including as
ants the names of persons who are not true inventors often
s on the morale of the research personnel out of all propor-
nce to the Government of getting a patent application on the
r even issued. When an individual workers has on his own
and completed a meritorious invention, the tendency in such
is for the group chief, the section chief, and the division chief
joint applicants with the true inventor. Government patent
e to keep this down to including only one boss, or even naming
tor alone, as long as he is fortified by the present requirement
posed provision of section 206 is enacted, he will no longer
the addition of a plurality of administrators as applicants
become the usual thing, regardless of what may be the true
ship.
ct of what in research organizations is called the conflict
e mind and the administrative mind, which conflict must be

a Government section chief has insisted that his name should
pplicant to an application for patent on an invention which,
y one sole inventor in his section, the result has often been
tor became absolutely sterile, did not try to make further
did make an invention refrained from reporting it to patent

In an extreme case, a Government section chief, upon return from an extended European trip, found that entirely during his absence a man in his section had conceived and completed a meritorious invention. The section chief insisted that his name should appear in the patent application as a joint applicant. Under administrative duress, the true inventor felt himself forced to comply, but never again during a subsequent long tenure of office made a single invention. This instance is not unusual.

The following comments are submitted as to specific sections of the bill:

Section 8—Library: In the Department of Commerce appropriation there should be a separate item for the purchase of scientific and legal books and periodicals for the Patent Office Library, as there always was prior to 1932. Under the present practice of lumping such purchases for the library in with many other contingent expenses, the funds actually available for the purchase of books and periodicals are insufficient. This and various other points regarding the Scientific Library of the Patent Office have been covered in my statement before the House Committee on Patents, hearings on general revision of the patent laws, January 25–28, February 16, 17, 1932, Seventy-second Congress, first session, pages 262–277, and in statements in subsequent hearings. Most of the comments contained in that statement are still applicable.

Section 9—Classification: Reference is made to my statement before the House Committee on Patents, May 23, 1939, on H. R. 3605, Seventy-sixth Congress, first session; to the statement by Richard Spencer on February 17, 1932, before that committee, Seventy-second Congress, first session; and to the report of the Hoover Committee on Patent Office Procedure, April 15, 1926, mentioned at page 85 of the January–February 1932 hearings before the House Committee on Patents. Most of these comments are still applicable. At the end of section 9 it would be well to add a provision somewhat as follows: "and arrange to call to the attention of examiners by the preparation of bibliographical reference lists and otherwise references to books and articles in current periodicals of interest to the staff of the Patent Office in the performance of their duties."

The calling to the attention of examiners of current literature pertinent to their respective technical fields, is a necessary part of the duty of examining applications, imposed on the Commissioner by section 4893, Revised Statutes (U. S. C., title 35, sec. 36), section 131 of this bill. It is probable that the Classification Division is as a practical matter the only part of the Patent Office capable of doing this work. From approximately 1900 to 1912, this kind of work was done by the Classification Division. Particularly at the present time, examiners do not have available 4 or 5 hours a week to look for new literature in their field as it appears, and unless someone else brings it to their attention, they lose touch with the progress of the art.

Section 11—Publications: The following items are suggested for addition to the list of publications of the Patent Office.

"It shall be the duty of the Commissioner to cause to be compiled and printed periodically, compilations of brief illustrated abstracts of all United States patents issued during a given period, in readily understandable language."

The publication of such abstracts or digests would do much to increase the usefulness of the patent system to promote the progress of science and the useful arts, and to make patent literature a much more accessible and assimilable part of technical literature in general. The British Patent Office has for many years prepared and published volumes of such abstracts, and they have been very useful. It is understood that the procedure in the British Patent Office was for the assistant examiner in charge of an application, at the time he made his final review of an application before allowance, and when the interference search was made, to dictate the abstract to a stenographer, while he had the invention clearly in mind anyway, so that very little additional work has been involved. Compilations of such abstracts over a given period constitute a good review of the progress of a given art during that period. In many technical fields in recent years, there has been an increased tendency to publish annual reviews of the progress in that field, but in general such reviews do not attempt to cover the patents in the field.

"It shall be the duty of the Commissioner to keep in print and on sale at the regular price for patents, the specifications and drawings of patent applications which have been hertofore printed by the Alien Property Custodian."

During the last war, the Alien Property Custodian printed the specifications and drawings of some thousands of patent applications which had been vested by him and had not matured into patents, to make them accessible to the public. The procedural details of printing and distributing such printed APC specifi-

en care of by the Patent Office, which was reimbursed by APC. ecifications are now orphans, and not usually kept in print, stitute references. The Patent Office should assume responsi- them available. The expense involved would be comparatively

ations for patents may be printed and published by the Com- request and at the expense of the applicant or owner. Such have the same effect as an issued patent for the purposes of this title."

was the second paragraph of section 121 of H. R. 9133 (81st et with considerable approval. It is understood that it was ie redrafts of the coordinating committee meeting in December te, and its advantages are believed to be apparent, and to have pply discussed by others.

copies of patents with foreign countries. Attention is called no printed copies of Russian patents have been received by Patent Office since 1927. It would probably be cheaper to ssian patents, which are far less numerous than United States, xchange. It is understood that the Russian Government has se order for quite a number of copies of every United States ed.

tents for public libraries. It is suggested that consideration ing in line 2, after "in the United States", the words "and elieved that if any library in Toronto or Montreal, or other da other than Ottawa, desires to have a set of United States y should be extended the same privileges as are extended to Jnited States. Such United States patents in Montreal or used by many United States citizens and corporations who tive in those Canadian cities, and the very close industrial anada and the United States will justify this courtesy. There of United States patents in the Canadian Patent Office at has a gap in 1911–12.

language of section 13 and related section 41–a–9, it appears e intent that a public library may obtain the patents issued te of $50 a year for previous years as well as the current uthority of the Commissioner to so supply patents to public y rather than permissive. If the authority is not directory, ovision should be made for review of a refusal by the Com- patents to public libraries at this rate. Attention is called is present bill of the act of June 15, 1950, Public Law 549, ibraries securing at the special rate, patents for preceding hat the report on the present bill should bring out that the n 13 shall include the furnishing to libraries of patents for

ieved that the requirement of the present law should be re- d United States patent can issue on a United States appli- reign patent application, if the United States application is vention, that is more than 12 months after the first foreign oreign application matures into a foreign patent before the issues. This has had a salutary effect in getting foreigners d States promptly if they are going to file at all, if this led many foreigners are so dilatory that they will file in the fter the convention period has expired, and will impose on atent Office an increased search burden including search rresponding foreign patent has issued. Foreign applicants fficiently difficult burden on the United States Patent Office, hat burden.

tion made abroad: The last sentence of this section appears somewhat indefinite as to just what classes of persons are ts. It seems probable that this second sentence should be the United States who are serving in he Armed Forces of oad. Most any citizen of any country can claim domicile in d can claim that he has been serving in a foreign country ehalf of the United States, and a difficult question is pre-

of applicant: The following is suggested to be added at

"In Canada, the oath may be made under his seal of office before a notary public authorized by the laws of the Dominion of Canada or any Province or governmental division thereof to administer oaths as if such notary public were acting within the United States, without diplomatic or consular certificate of authority being necessary."

Experience shows that the official functions of Canadian notaries are carried out with as great decorum and rigor and dependability as those of notaries within the United States. Canadian inventors file many applications in the United States, and an appreciable number of United States citizens living in Canada execute United States patent applications in Canada. It is believed that the official seal of a Canadian notary is sufficient attestation of his authority. The legal system of Canada is much more closely assimilated to that of the United States than is true for any other country. The suggested provision would relieve applicants executing applications in Canada from an unnecessary burden.

Section 116—Joint inventors, section 118, filing by other than inventor: These have been discussed in detail at the beginning of this statement.

The following section is submitted for consideration, probably to be inserted following section 119.

"Any patent application claiming the priority of a foreign application which has become abandoned, or upon which a United States patent has not issued within 4 years from the date of the earliest foreign application on which priority is claimed, shall become open to public inspection; and in the discretion of the Commissioner may be printed in form similar to the form of a regular patent."

A provision of this kind was in force in Great Britain for many years. It is the intent of the patent laws that the disclosures filed in the Patent Office and the applications upon which examiners expend much time and energy, shall become available to the public. Foreign applicants often impose upon and abuse the United States Patent Office and the American taxpayer, by filing applications in the United States, not with good faith and intent to prosecute the application in good faith in the effort to have a patent issued, but just to get the benefit of the official search of the United States examiner which is much better than that of the Patent Office of his own country, or just to have an application pending in case of a possible interference, and with the intention of probably abandoning the application if he does not get just the claims he wants, or the interference does not develop, and with no real intent that a United States patent shall ever issue. Some foreigners file applications in the United States and execute the application oath after they have received an action by the Patent Office in their own country citing a knock-out reference which they hope the United States examiner will not find, and consider the oath a meaningless formality. If a foreign inventor imposes his application on the United States Patent Office, it is only a fair bargain that he shall give the United States public the benefit of access to his disclosure after 4 years, or after abandonment, and if the disclosure has particular value it should be printed. The present practice of permitting foreigner applicants to file and prosecute applications and then abandon them without making them public, is unfair to the American taxpayer and contrary to the spirit of the patent system.

Section 120—Benefit of earlier filing date in the United States: The phrase "termination of proceedings on" in line 6 is believed to be vague and likely to cause difficulty in interpretation. This phrase is probably unnecessary to accomplish the desired intent.

It is believed that the broad provisions of this section make it apparent that, as commented under section 154, the term of a patent should not extend longer than 20 years from the earliest United States filing date whose benefit is claimed. If this limitation is not imposed, an endless chain of continuing applications can be created, carrying effective filing date far back, which has been one of the criticisms of the United States patent system heard for years, particularly before the Temporary National Economic Committee. Also, the practice of filing a carelessly prepared application, getting criticism and references thereon, refiling, and perhaps re-refiling, trying to make the examiner do the work of properly preparing the application, should be discouraged by limiting the term of a patent so obtained.

A proposed new section, as to provisional caveats, probably to follow section 122, is suggested for consideration.

Section 122a—Provisional caveat: Any person who has invented or discovered any new and useful art, machinery, manufacture or composition of matter, or any new and useful improvements thereof, and desires further time to

may, on payment of the fees required by law, file in the Patent
l cavent setting forth a written description of the same and of
characteristics and the manner and process of making, con-
nding and using it, and praying protection until he shall have
ntion. Such person may within 2 years of the date of filing
avcat, file in the Patent Office a complete application for patent
section 111 of this title, and the application so filed shall have
date of filing such provisional cavent for all subject matter
in such provisional cavent. Such provisional cavent shall
oath in the same manner as is provided for an application
by section 115.

new about cavents, or provisional patent applications. They
in the United States in the Patent Act of July 4, 1836, section
8, 1870, section 40, and in section 4902 of the Revised Statutes
t of March 3, 1903. They were abolished by the act of June 25,
which are not clear, but probably involved the difficulty of
ce searches among cavents. A provisional cavent can be
quiring that the person filing the cavent be notified by the
regular application to conflicting subject matter is filed. The
iggested omits such interference searches.

at present there is a well-defined demand for a secret Govern-
here, for a nominal fee, inventors may simply provisionally
their inventions, without having any plan that the disclosure
uld be examined for patentable novelty, or ever become a
ttorneys have for years held themselves ready to receive and
files, disclosures of inventions sent in by inventors, and it
od that a considerable number of such disclosures have been
ing. It is believed to be apparent that if such a repository is
it should be under Government control. The Government in
e National Inventors Council, one of whose functions was to
ory to which inventors could send disclosures of inventions
ul in the national defense. Various bills relating to the Office
ices of the Department of Commerce have provided for ex-
of such a Government repository for disclosures of inventions.
at if any repository for filing such disclosures is to be provided
of Commerce, it should be in the Patent Office.

ent law has for a long time provided for the filing of provi-
, the benefit of whose filing date could be used in the later
lication, as to matter actually disclosed in the provisional ap-
have been in effect in Canada for a long time.

fidential status of applications: It is believed that the pres-
secrecy by the Rules of Practice is sufficient, and that in his
d be possible for the Commissioner in suitable cases and with
to make applications accessible to persons outside the Patent
at the end of section 122 as now drafted "or in such special
ay be determined by the Commissioner," begs the whole ques-
issioner is to exercise discretion, this provision of law is not
existing rule is sufficient. One of the proposals to combat
rations, before the House Committee on Patents, particularly
January, February, March, 1932, has been to open to public
lications which have been on file for 3 years, or other term.
by the chairman of the Patents Committee that he believed
oner already had that power without specific legislation, but
urged that specific authority of law was desirable as to such
ments particularly as to the probability of stirring up inter-
itted against the proposal. However, if there is to be statu-
e power of the Commissioner in this matter, it should be en-
nsideration of these 1932 and later proposals to use opening
public inspection as a means to combat dilatory prosecution.
t is believed that in line 3, following "law", the words "and
fficiently useful and important" which appear in the present
5 U. S. C. 36) and have been there for a long while, should
nts cannot avoid a de minimis rule, wholly separate from all
aw.

tents and term of patent: It is suggested that consideration
in line 2 after "seventeen years," the words "or twenty years

from the date of the earliest United States application the benefit of whose filing date is claimed, whichever term is shorter".

This has been discussed above under section 120. Some controls must be imposed against a chain of continuing applications, carrying the effective filing date way back. This practice has long been a serious criticism of the patent system, frequently expressed.

A new section is submitted for consideration as to citing references in files of issued patents, probably to follow section 154, as follows: (154–(a)):

"Whenever after the issue of a patent, an officer or employee of the Patent Office shall find a reference to a patent or publication which he considers would have been a pertinent reference for the Patent Office to cite during the prosecution of the application resulting in such patent, he shall prepare and place in the patented application file of such patent a statement citing such reference and pointing out how it is applicable to such issued patent.

"Whenever after the issue of a patent, any person other than an officer or employee of the Patent Office shall find a reference to a patent or publication which he considers would have been a pertinent reference for the Patent Office to cite during the prosecution of the application resulting in such patent, such person may execute and file in the Patent Office an affidavit citing such reference and pointing out how it is applicable to such issued patent. The Commissioner shall cause such affidavit to be placed in the patented application file of such patent, unless he considers that the so-cited reference is wholly impertinent to the subject matter of the patent."

This is a much simplified way of approaching the problem which has been in view in bills proposed in the past to publish patents for opposition. It is probable that the Commissioner already has power to do this without legislation, but he has never done so and it is doubtful if he will do so without statutory direction. After a patent issues, the public, in appraising the position which it occupies in the art, is entitled to the benefit of all pertinent references, including those previously existing but not found until after the patent issues. Certainly the public should be informed of every pertinent reference found by the staff of the Patent Office after a patent issues, to keep from the public information in the possession of the Patent Office which affects the scope or validity of an issued patent, is contrary to the orderly administration of justice. It not infrequently happens, not long after an assistant examiner has allowed an application and it has issued, that he find a reference which he would have cited if previously found, and he may note such reference on his own copy of such patent, but it is not in the patented file in the record room. This provision does not have in view any specific search for such references to issued patents, by the Patent Office, but simply the references found incidentally in the course of regular work. If a person outside the Patent Office finds a pertinent reference, and wishes it to appear in the patented file, the public is certainly entitled to that information.

Section 206—Misjoinder of inventor: This has been discussed in some detail at the beginning of this statement.

Section 249—Notice of patent suits: The following changes are suggested:

Line 5 after "patent" insert "or application."

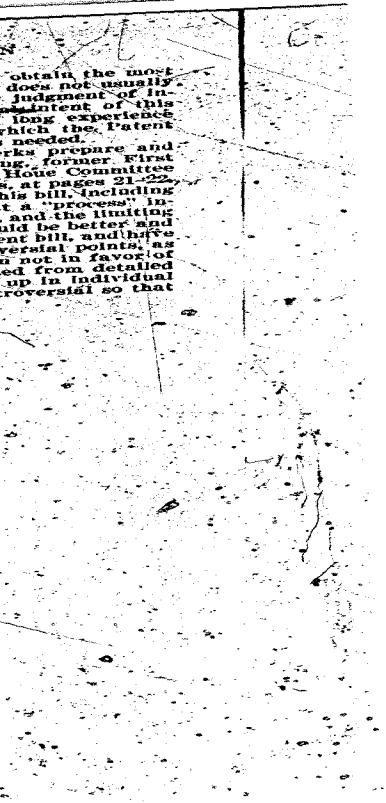
In line 8, after "judgment" insert "or the action or proceeding is stricken from the calendar."

At the end of the section, add:

"The clerk shall also include in such notice a brief statement of the nature of the action or proceeding; and if the pleadings state one or more specific provisions of law under which such action or proceeding is brought, shall identify such provisions. Within one month after notice of an appeal or other appellate procedure is filed in a court of original jurisdiction or in an appellate court, the clerk of each such court shall give notice thereof to the Commissioner."

Also add at the end: "This section shall apply to courts of appellate jurisdiction as well as to courts of original jurisdiction."

Experience over a period of years with the existing provision (the last sentence of R. S. 4921, 35 U. S. C. 70), has been that the notices sent to the Patent Office by clerks of United States courts are often insufficient to give a person examining the notice in the patented file of the patent in which he is interested, any intelligent idea of the nature of the action which has been commenced, or its status, or if there has been judgment; what the effect of the judgment is. The notice usually does not state, if there has been judgment, whether there was an opinion, or whether it was by consent. The person interested may find it neces-


obtain the most
does not usually
judgment of in-
ntent of this
long experience
hich the Patent
needed.
rks prepare and
ng, former First
House Committee
s, at pages 21-22,
his bill, including
t a "process" in-
and the limiting
uld be better and
ent bill, and have
versial points, as
not in favor of
ed from detailed
up in individual
roversial so that