have had to go forward with proof on the question of efficiency; but having dispelled, or at least weakened, the presumption of validity in plaintiff's patent, defendant should have been relieved of this burden. Failure of the court to treat in greater detail the basis for its holding that (1) there was a new result, and that (2) the burden of proving invalidity remains with the defendant, permits plaintiff to obtain a monopoly on an old combination without ever having to distinguish it over the prior art.

It is submitted that the presumption of validity attaching to the issuance of a patent would be given stronger recognition and be subject to less abuse if the courts in applying the presumption would distinguish more clearly the situations in which such presumption has been weakened or should be completely disregarded. C. S. P.

PATENT ACT OF 1952—REISSUES.—Plaintiff brought action for infringement of Reissue Patent 23,167 for a shoulder pad, which issued in November, 1949 and was based on an application filed May 25, 1949 for reissue of Patent No. 2,465,100 issued March 2, 1949. The reissue contained the claims of the original patent, a group of added claims of similar scope, and a third group of differing scope. Of the latter group, some omitted the "voids" recited in the original claims, while others added "snap elements" not originally recited. Claims 13-20, comprising the broader and narrower added claims, were alleged to be infringed. *Held,* complaint dismissed; the reissue was invalid as to all claims. *Riley v. Broadway-Hale Stores, Inc.,* 114 F. Supp. 884, 98 U.S.P.Q. 433 (S.D. Cal. 1953).

To determine the validity of plaintiff's reissue, the court had first to decide whether the Patent Act of 1952, 66 STAT. 792 (1952), was applicable, and if so, whether it made a change in the existing law.

As stated in Section 4(a), the Patent Act applies to all unexpired patents except as otherwise provided. 66 STAT. 815 (1952). Sections 4(b) through 4(h) specify particular exceptions, none of which were deemed relevant. Apparently, neither of the parties felt that Section 5 of the Act, which operates to protect rights existing under prior law from abolition by the Act, would be of avail. The court did not consider this section, but held that since Congress had taken pains to set forth the specific exceptions of Section 4, no other exceptions were intended unless they were to be found in individual sections of the Act. Accordingly, the reissue sections of the Act, 35 U.S.C.A. §§ 251, 252 (Supp. 1953), which do not provide otherwise, would apply to the instant reissue.

Reissue provisions were originally incorporated in the patent statutes to avoid the common law rule that if one claim of a patent was invalid, the whole patent was void. *Ensten v. Simon Ascher & Co.,* 282 U.S. 445 (1931). 35 U.S.C.A. § 253 (Supp. 1953) provides that, absent deceptive intention, the invalidity of one claim of a patent will not affect the validity of other claims. Claims in a reissue carried forward from the original patent should not be held invalid if they were originally valid. *Foxboro Co. v. Taylor Instrument Companies,* 157 F.2d 226 (2d Cir. 1946), *cert. denied,* 329 U.S. 800 (1947). Since under 35 U.S.C.A. § 252 (Supp. 1953) a reissue patent has the same

operation and effect in law as if originally granted in its amended form, except where such operation or effect would affect those with intervening rights, the provisions of § 253 would appear to apply to reissues as well as to original patents. Accordingly, it is suggested that the court in the instant case erred in holding the entire reissue void unless the original claims were originally invalid and none of the added claims were properly obtainable by reissue.

Prior to the passage of the 1952 Act, reissues were granted under REV. STAT. § 4916 (1875). This statute did not specifically permit broadened reissues, but the courts have generally held that they were not excluded where other conditions were met. *Miller v. Bridgeport Brass Co.,* 104 U.S. 350 (1881).

Comparing the requirements of the new and old statutes, several differences in language are noted. Whereas the prior law provided for correction of patents "If the error has arisen by inadvertence, accident, or mistake," REV. STAT. § 4916 (1875), the present Act merely requires "error without any deceptive intention"; 35 U.S.C.A. § 251 (Supp. 1953). In the instant case, the court held that these provisions were synonymous, thereby retaining the requirement for inadvertence, accident, or mistake and the vast body of judicial interpretation of these terms.

"Inadvertence" has been applied to various types of errors. It has been construed as including drafting or accepting claims not commensurate with the invention, *M. & B. Mfg. Co. v. Munk,* 6 F. Supp. 203 (E.D.N.Y. 1934); as meaning the antithesis of fraudulent intent, *National Nut Co. v. Sontag Chain Stores Co.,* 107 F.2d 318 (9th Cir. 1939); and as applying only to errors which a court of chancery would correct, *Sontag Chain Stores Co. v. National Nut Co. of California,* 310 U.S. 281 (1940); *H. W. Roos Co. v. McMillan,* 64 F.2d 568 (6th Cir. 1933). It has also been construed as excluding errors of judgment. *Miller v. Bridgeport Brass Co., supra.*

Here, the plaintiff had alleged errors comprising failure to secure claims commensurate with the invention and failure to draft an adequate specification, due to ignorance of the technicalities of claim drafting. Though plaintiff had been represented by counsel, this alone would not have been sufficient to negative inadvertence. *M. & B. Mfg. Co. v. Munk, supra.* But the court found that claims similar to the broadened claims had been cancelled in the original patent application. This has uniformly been held to negative inadvertence. *Dobson v. Lees,* 137 U.S. 258 (1890); *Yale Lock Mfg. Co. v. Berkshire National Bank,* 135 U.S. 342 (1890). The latter rule, while generally applied, has been criticized as highly technical, and the courts have been urged to apply it with caution, since, if a valid objection, it is presumed that it would be made by the Patent Office. *Florence-Mayo Nuway Co. v. Hardy,* 168 F.2d 778 (4th Cir. 1948). In deciding whether claims to the same subject matter have been cancelled, a pertinent question is whether or not the references that defeated the abandoned claim would defeat the reissue. *Florence-Mayo Nuway Co. v. Hardy, supra.* Recently the Patent Office has held that where the reissue claims were intermediate in scope between the original patent claims and claims cancelled in the original patent application, the reissue claims were not barred by the cancellation. Ex

parte *Allwein,* 99 U.S.P.Q. 177 (Pat. Off. Bd. of App. 1953). The court made no attempt to compare the claims on this basis, but merely equated them on the basis that they each omitted the limitation "voids" recited in the claims of the patent. The Patent Office did not reject the broad claims on this ground, and their decision should not be reviewed unless mainfestly in error. See *Sturtevant v. Ooms,* 62 F. Supp. 731 (D.D.C. 1945), *aff'd.,* 157 F.2d 706 (D.C. Cir. 1946); *Sbicca-Del Mac, Inc. v. Milius Shoe Co.,* 145 F.2d 389 (8th Cir. 1944).

Assuming, arguendo, that broad claims 13-16 were invalid, it would appear that specific claims 17-20 should be tested by a more liberal rule, since it has been held that reissue is the proper procedure for adding elements to the claims of a patent. *Altoona Theater v. Tri-Ergon Corp.,* 294 U.S. 477 (1935); *rehearing denied,* 294 U.S. 734 (1935). Further, it has been held that where the applicant merely seeks narrowed claims, the Patent Office decision will not be reviewed. *Fehr v. Activated Sludge, Inc.,* 84 F.2d 948 (7th Cir. 1936). The court in the instant case, however, held flatly that "these claims were nowhere mentioned in the original patent." It is not clear what showing the court would require; had the claims themselves been in the original, no reissue would have been necessary, while, as to the drawing and specification of the original, they clearly disclosed the added "snap elements" in question.

The present statute, 35 U.S.C.A. § 251 (Supp. 1953), permits reissue for "the invention disclosed in the original patent." Although the court held that these words were synonymous with "the same invention" specified in REV. STAT. § 4916 (1875), no case has been found squarely in support of the proposition that only the elements of the original claims may be claimed in the reissue. While *U.S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp.,* 315 U.S. 668 (1942), cited by the court, contains language which might indicate that elements cannot be added to or omitted from a claim by reissue, it should be noted that the changes sought to be made in that case were based on experiments conducted after the original application was filed. It is therefore submitted that the rule set forth therein should be confined to cases presenting the same facts. It would appear that the result of such a holding applied broadly would be the entire negation of the reissue sections of the Act.

In conclusion, it is submitted that the court, in construing the reissue sections of the 1952 Patent Act, took an unduly harsh position in equating the statutory language to the stricter doctrines promulgated by the courts under the prior statutes, not only in specifically holding both the broad and narrow claims invalid, but particularly in holding the entire reissue invalid by reason of defects noted in only a portion of the claims. Since only claims 13-20 were alleged to be infringed, the same result could have been reached without striking down the entire patent. Unless this case is confined closely to its facts, the reissue patentee will derive little benefit from the presumption of validity codified in 35 U.S.C.A. § 282 (Supp. 1953) since it is difficult to envisage a reissue not subject to some of the objections raised by the court, any of which would apparently be fatal to the old claims as well as the new. J. W. E.