EDITORIAL NOTES

THE NEW PATENT ACT AND THE PRESUMPTION OF VALIDITY

I

INTRODUCTION

The new Patent Act has, for the first time in the history of modern patent law,[1] expressly recognized the presumption of validity arising from the grant of a patent.[2] Although this presumption would seem to have been firmly established in the patent law,[3] there has been a growing tendency in recent cases "to ignore or pay little more than lip service" to it.[4] In order to dispel the doubts which these recent cases have injected into the patent law,[5] Congress enacted Section 282 of the new Patent Act. This section provides:

> A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it.[6]

The Committee on Patents declared that the intention of this section was to codify "the existing presumption of validity."[7] This provision considered in light of the Congressional intent presents three basic problems.

1. Whether there is an "existing" presumption of validity.
2. If there is, what effect do the other provisions of the new Act have on it?
3. Whether this provision of the new Act necessarily includes the related presumption that the Patent Office is also correct when it refuses to allow a claim.

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[1] Congress had provided in the Act of 1790, 1 STAT. 109 (1790), that a patent should be *prima facie* evidence of validity. This provision was not reenacted in the Act of 1793, 1 STAT. 318 (1793). However, after the Reorganization Act of 1836, 5 STAT. 117 (1836), which provided for the examination system but not for a presumption of validity, the courts again recognized the presumption arising from the grant of a patent. See Goodyear v. Day, 10 Fed. Cas. 677, No. 5566 (C.C.N.J. 1852).

[2] 35 U.S.C. § 282 (1952). The presumption of validity arises from the grant of a patent. R.C.A. v. Radio Engineering Laboratories, 293 U.S. 1 (1934); Faulkner v. Gibbs, 170 F.2d 34 (9th Cir. 1948), *aff'd*, 338 U.S. 267 (1949); Cover v. Chicago Eye Shield Co., 111 F.2d 854 (7th Cir. 1940).

[3] See R.C.A. v. Radio Engineering Laboratories, 293 U.S. 1 (1934); Smith v. Goodyear Dental Vulcanite Co., 93 U.S. 486 (1876); Agawam Co. v. Jordon, 7 Wall. 583 (U.S. 1868).

[4] *Hearings before Subcommittee No. 3 of the Committee on the Judiciary House of Representatives on H. R. 3760*, 82d Cong., 1st Sess. 46 (1951) (hereinafter cited as *Hearings*). See notes 25 and 26 *infra*.

[5] *Hearings, supra* note 4, at 46.

[6] 35 U.S.C. § 282 (1952).

[7] H.R. REP. No. 1923, 82d Cong., 2d Sess. 29 (1952).

The present note considers the past judicial attitudes toward the presumption of validity, as well as its related phases, and points out the factors which the courts should consider in applying the presumption under the new Act.

II

Presumptions in Infringement Suits

The first phase of the presumption arises in infringement cases, and involves the inference that, because of the settled Patent Office practice of examination of each application by experts in a particular field, coupled with a search of the pertinent prior art, the patent issued has fulfilled all the conditions prerequisite to patentability.[8] In these cases the alleged infringer raises the defense of invalidity, thereby requiring the court to decide what weight should be given to the previous determination of patentability made by the Patent Office.

A

Ex parte Proceedings

Many courts have encountered little difficulty in determining the weight or effect to be given to this prior determination by the Patent Office. They have characterized the presumption attending the issuance of a patent as being strong,[9] creating a heavy burden,[10] but not as conclusive.[11]

Added weight has been attributed to the basic presumption when the principal prior art references relied on as anticipatory were considered by the Patent Office during prosecution of the application.[12]

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[8] Paramount Industries v. Solar Products Corp., 93 F. Supp. 331 (E.D.N.Y. 1950), *aff'd*, 186 F.2d 999 (2d Cir. 1951).

[9] Park-In Theaters v. Rogers, 130 F.2d 745 (9th Cir. 1942).

[10] General Motors Corp. v. Kesling, 164 F.2d 824 (8th Cir. 1947), *cert. denied*, 333 U.S. 855 (1948); Mumm v. Decker & Sons, 301 U.S. 168 (1937).

[11] Crowell v. Baker Oil Tools, 153 F.2d 972 (9th Cir. 1946).

[12] R.C.A. v. Radio Engineering Laboratories, 293 U.S. 1 (1934); Lewyt Corp. v. Health-Mor, Inc., 181 F.2d 855 (7th Cir. 1950), *cert. denied*, 340 U.S. 823 (1950).

The presumption is still valid even though one of the alleged prior art references was not considered by the examiner. Paramount Industries v. Solar Products Corp., 93 F. Supp. 331 (E.D.N.Y. 1950); Condensor Corp. of Am. v. Micamold Radio Corp., 54 F. Supp. 327 (E.D.N.Y. 1944). *Contra:* American Wood Products Corp. v. Crane Co., 29 F. Supp. 807 (N.D. Ohio 1937) (by implication). However, where "some" of the pertinent prior art references were not considered before issuance, the presumption is weakened, Kilgore Mfg. Co. v. Triumph Explosives, Inc., 37 F. Supp. 766 (D. Md. 1941), greatly weakened, Gomez v. Granat Bros., 177 F.2d 266 (9th Cir. 1949) (none of the alleged anticipating references were considered by the Patent Office), or destroyed, Reynolds v. Emaus, 87 F. Supp. 451 (W.D. Mich. 1949); Cutler Mail Chute Co. v. Capital Mail Chute Corp., 118 F.2d 63 (2d Cir. 1941), *cert. denied*, 313 U.S. 580 (1941) (by implication), depending upon the number and pertinency of the prior art references the examiner failed to consider. Babson Bros. Co. v. Perfection Mfg. Corp., 86 F. Supp. 754 (D. Minn. 1949).

Where the applicant had appealed to the Patent Office Board of Appeals in order to obtain claims to certain subject matter, it has been held that the presumption is greatly strengthened [13] but only with respect to the prior art considered by the Board of Appeals,[14] and in any event is not conclusive.[15]

The effect of the presumption outlined above has been variously described as requiring the party claiming invalidity to overcome the presumption by preponderating evidence,[16] clear proof,[17] or that every reasonable doubt should be resolved in favor of the patent,[18] depending upon how much of the pertinent prior art the Patent Office failed to consider. However, regardless of the variety of language used, it is clear that

> Through all the verbal variances . . . runs this common core of thought and truth, that one otherwise an infringer who assails the validity of a patent fair upon its face bears a heavy burden of persuasion, and fails unless his evidence has more than a dubious preponderance.[19]

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Inter parte Proceedings

Where the patent was involved in an adversary proceeding such as an interference [20] before its issuance, and is the basis for an infringe-

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If the examiner has considered the same or similar subject matter contained in other patents, although the particular patent urged as anticipating did not receive his attention, the presumption is unimpaired. Babson Bros. Co. v. Perfection Mfg. Corp., 86 F. Supp. 754 (D. Minn. 1949). In cases where no similar or same subject matter was before the examiner during the prosecution of the application, as evidenced by the file wrapper, the courts have generally held that there is no presumption that the subject matter of the other references was considered by the examiner and held to be not pertinent. Nordell v. International Filter Co., 119 F.2d 948 (7th Cir. 1941); Tempco Products, Inc. v. Timpken Detroit Axle Co., 110 F.2d 307 (6th Cir. 1940); Robinson Aviation, Inc. v. Barry Co., 95 U.S.P.Q. 78 (D.C. Mass. 1952). *Contra:* Adler Sign Letter Co. v. Wagner Sign Service, Inc., 112 F.2d 264 (7th Cir. 1940) (apparently overruled by the Nordell case).

[13] Modern Products Supply Co. v. Drachenberg, 152 F.2d 203 (6th Cir. 1945); Hall v. Montgomery Ward & Co., 57 F. Supp. 430 (N.D. W. Va. 1944).

[14] Mathews Conveyor Co. v. Palmer-Bee Co., 135 F.2d 73 (6th Cir. 1943).

[15] Hall v. Montgomery Ward & Co., 57 F. Supp. 430 (N.D. W. Va. 1944).

[16] McMichael & Wildman Mfg. Co. v. Stafford, 105 Fed. 380 (C.C.N.D.N.Y. 1900).

[17] Mohr & Sons v. Alliance Securities Co., 14 F.2d 799 (9th Cir. 1926); F. E. Meyers Co. v. Goulds Pumps, Inc., 91 F. Supp. 475 (W.D.N.Y. 1950). In both these cases all the alleged anticipating references were considered during the Patent Office prosecution.

[18] Williams Mfg. Co. v. United Shoe Mach. Corp., 121 F.2d 273 (6th Cir. 1941), *aff'd*, 316 U.S. 364 (1941); Cooper v. Westchester County, 85 F. Supp. 589 (S.D.N.Y. 1949). In both these cases "most" of the prior art references alleged as anticipating were considered by the Patent Office.

[19] R.C.A. v. Radio Engineering Laboratories, 293 U.S. 1, 8 (1934).

[20] See Williams Mfg. Co. v. United Shoe Mach. Corp., 121 F.2d 273, 277 (6th Cir. 1941), *aff'd*, 316 U.S. 364 (1941).

ment suit, the effect of the greater presumption [21] arising from this proceeding must be analyzed by determining what pertinent references were considered in the interference, and whether these same references are alleged to anticipate the patent in the defense to an infringement suit.[22] The "greater" presumption in these cases is not, however, solely the result of determining the pertinent prior art references considered by the Patent Office. Additional weight is also attached because of the adversary proceeding per se.[23] The latter added weight is based on the intense scrutiny to which the patent applications are subjected during the interference proceeding.[24]

III

Conflicting Attitudes in Infringement Suits

Although as a general rule the courts have recognized and applied the presumption in infringement cases in accordance with factors outlined above, there has been a growing tendency in recent cases to doubt the logic of its application,[25] with the result that some courts require the *patentee* to prove the validity of his patent by a preponderance of evidence.[26] One court in rejecting the presumption stated that

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[21] Hildreth v. Mastoras, 257 U.S. 27 (1921); Reynolds v. Whitin Mach. Works, 167 F.2d 78 (4th Cir. 1948), *cert. denied,* 334 U.S. 844 (1948).

[22] Reynolds v. Whitin Mach. Works, 167 F.2d 78 (4th Cir. 1948), *cert. denied,* 334 U.S. 844 (1948); Spring-Air Co. v. Ragains, 96 F. Supp. 79 (W.D. Mich. 1951); Godfrey L. Cabot, Inc. v. Huber Corp., 35 F. Supp. 373 (N.D. Tex. 1940). In all these cases the court qualifies the added presumption created because of the interference proceedings by such phrases as "in which certain prior art patents were considered."

[23] Baker—Cammack Hosiery Mills, Inc. v. Davis Co., 181 F.2d 550, 564 (4th Cir. 1950); Farval Corp. v. Republic Steel Corp., 82 F. Supp. 31 (N.D. Ohio 1948). See also Hemmel Bros. Co. v. Serrick Corp., 122 F.2d 740 (7th Cir. 1941), where it was held that if the award of priority was solely the result of a concession the presumption is not strengthened.

[24] R.C.A. v. Radio Engineering Laboratories, 293 U.S. 1 (1934); Baker—Cammack Hosiery Mills, Inc. v. Davis Co., 181 F.2d 550, 564 (4th Cir. 1950). The effect of this added weight depends upon whether the parties to the infringement suit are the same as the parties to the previous interference proceeding. See R.C.A. v. Radio Engineering Laboratories, 293 U.S. 1 (1934), citing Rousso v. First Nat. Bank in Detroit, 37 F.2d 281, 283-284 (6th Cir. 1930). See Excel Auto Radiator Co. v. Bishop & Babcock Mfg. Co., 167 F.2d 962 (6th Cir. 1948).

[25] "How strong this presumption of validity may be is debatable, in view of the multiplicity of patents being issued." Graham Paper Co. v. International Paper Co., 46 F.2d 881, 885 (8th Cir. 1931). "The presumption of validity of administrative grant has been in recent years almost reduced to nullity in patent cases." Jacuzzi Bros., Inc. v. Berkeley Pump Co., 191 F.2d 632, 634, 635 (9th Cir. 1951).

[26] Philip A. Hunt Co. v. Mallinckrodt Chemical Works, 72 F. Supp. 865 (E.D.N.Y. 1947), *aff'd,* 177 F.2d 583 (2d Cir. 1949); Hueter v. Sears, Roebuck & Co., 91 U.S.P.Q. 238 (N.D. Ohio 1951). In Myers v. Beall Pipe & Tank Corp., 90 F. Supp. 265, 268 (D. Ore. 1948), it was stated: "The writer has heretofore pointed out that it was passing strange that the presumption of validity, which formerly was accorded the grant by the Patent Office, one of the oldest and most firmly founded of the administrative bodies, is treated by the

the presumption was "incapable of sustaining anything more substantial than the memory of earlier social and economic concepts." [27] Other courts have admitted that this tendency toward abolition exists, but have, nevertheless, applied the presumption on the ground that the intent of Congress is that the patent be presumed valid until the contrary was established.[28] The courts which reject or merely render lip service to the presumption base their action on two facts: (1) the Patent Office has in recent years issued an enormous number of patents,[29] and (2) many courts, including the Supreme Court, have given the presumption no effect in recent cases.[30] The conclusion seems to be that the Patent Office has "misused its authority so that the courts will no longer entertain the presumption." [31] Evidently what is meant by "misused authority" is that the Patent Office has accepted a lower standard of invention to fulfill the requirements of patentability than the courts require in upholding the validity of a patent once it is being tested in the courts.[32]

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appellate courts as evanescent as a cloud. Therefore, in consideration of this patent, the court has treated it as though the burden was upon the patentee to establish validity. In no other way can the trial courts, under the present winds of doctrine, find whether a patent is strongly rooted enough so that it will not be uprooted. This is in strong contrast with other agencies, which can do no wrong."

[27] Philip A. Hunt Co. v. Mallinckrodt Chemical Works, 72 F. Supp. 865, 869 (E.D.N.Y. 1947), *aff'd*, 177 F.2d 583 (2d Cir. 1949).

[28] Fischer v. Karl, 6 F.R.D. 268 (E.D.N.Y. 1946).

[29] "The case is made troublesome because of the many patents in evidence, which together constitute a glaring example of issuing patents for the merest shade or shadow of inventive advancement." Graham Paper Co. v. International Paper Co., 446 F.2d 881, 885 (8th Cir. 1931). See also National Popsicle Corp. v. Alaskan Frozen Products, Inc., 30 U.S.P.Q. 131 (E.D.N.Y. 1936); Baker & Co. v. Fischer, 52 F. Supp. 910 (D.N.J. 1943).

[30] Philip A. Hunt Co. v. Mallinckrodt Chemical Works, 72 F. Supp. 865 (E.D.N.Y. 1947), *aff'd*, 177 F.2d 583 (2d. Cir. 1949).

"In considering the question of the validity of the patents in suit, the court cannot disregard the fact that the decisions of the Supreme Court of the United States in recent years clearly indicate a trend toward a higher standard of invention." Spring-Air Co. v. Ragains, 96 F. Supp. 79, 81 (W.D. Mich. 1951). See also Foxboro Co. v. Taylor Instrument Co., 157 F.2d 226, 234 (2d Cir. 1946), *cert. denied*, 329 U.S. 800 (1947). See Note, [1950] WIS. L. REV. 556.

[31] Ginsberg v. Railway Express Agency, Inc., 72 F. Supp. 43, 44 (S.D.N.Y. 1947) where it was stated: "It may now well be said that no presumption whatever arises from the grant of patent."

[32] See Magnaflux Corp. v. Coe, 139 F.2d 531, 532 (D.C. Cir. 1943). See also the dissenting opinion of Justice Black in Goodyear Co. v. Ray-O-Vac Co., 321 U. S. 275, 279-280 (1944). But see Mr. Justice Jackson dissenting in Jungerson v. Ostby & Barton Co., 335 U.S. 560 (1949) where he states: "It would not be difficult to cite many instances of patents that have been granted, improperly I think, and without adequate tests of invention by the Patent Office. But I doubt that the remedy for such Patent Office passion for granting patents is an equally strong passion in this Court for striking them down so that the only patent that is valid is one which this Court has not been able to get its hands on." *Id.* at 572.

Some writers have expressed the opinion that the Supreme Court has not raised the standard of invention. Balluff, *Do Recent Supreme Court Opinions Raise the Standard of Invention?* 34 J. PAT. OFF. SOC'Y 847 (1952).

The Supreme Court majority opinions since 1937,[33] where the issue was the validity of a patent, have not affirmatively attributed any weight to the presumption arising from the grant of a patent.[34] This absence of Supreme Court recognition, primarily the result of a higher judicial standard of invention, has led some writers to conclude that the presumption no longer exists.[35]

IV

Suits to Compel the Issuance of a Patent

The presumption of validity is in essence a recognition that presumably the Patent Office has performed its functions according to law.[36] Another presumption applicable in patent law is based upon this same recognition. This presumption is one of administrative correctness,[37] and is applied by the courts in suits to compel the allowance of a claim.[38] The presumption of validity has the effect of requiring the party claiming invalidity to sustain the burden of proving invalidity, whereas the presumption of administrative correctness, in a suit to compel the issuance of a patent,[39] requires the applicant to sustain the burden of proof. However, both presumptions arise from the same basis, *i.e.*, a decision of the Patent Office, and therefore are corollary presumptions.[40]

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[33] The case of Mumm v. Decker & Sons, 301 U.S. 168, 171 (1937), is the last case which affirmatively recognizes the presumption of validity.

[34] However, it has received some recognition by dissenting justices. See Justice Black dissenting in Williams Mfg. Co. v. United Shoe Mach. Co., 316 U.S. 364, 392 (1942) where it was stated concerning the opinion of the "court below" (which recognized the presumption of validity) that "in the absence of a statutory prescription to the contrary, I see no reason for extending the presumption of validity arising from the mere issuance of a patent beyond the narrow compass indicated by . . . the *Radio Corporation* case (293 U.S. 1 (1931))."

[35] See Note [1950] Wis. L. Rev. 556. See also Glascock & Stringham, Patent Law—Substantive Aspects § 3183 (1943).

[36] Mumm v. Decker & Sons, 301 U.S. 168 (1937).

[37] National Lead Co. v. Kingsland, 74 F. Supp. 985 (D.D.C. 1948).

[38] Rev. Stat. § 4915 (1875), 35 U.S.C. § 63 (1946), states, "Whenever a patent on application is refused by the Board of Appeals . . ., the applicant . . . may have remedy by bill in equity, . . ." (35 U.S.C. § 146 (1952) does not represent a substantial change in this aspect).

[39] Another phase of the presumption not discussed here in detail is the weight which the Court of Customs and Patent Appeals attributes to the Commissioner's decision. That court will not generally reverse the findings of the board of intereference examiners unless it is manifestly wrong. Land v. Kasemann, 34 C.C.P.A. (Patents 1191, 162 F.2d 498, 74 U.S.P.Q. 176 (1947). In general that court attributes similar weight to Patent Office decisions. See Application of Kinderman, 37 C.C.P.A. (Patents) 800, 178 F.2d 937, 84 U.S.P.Q. 242 (1949); Dreyer v. Haffcke, 30 C.C.P.A. (Patents) 1278, 137 F.2d 116, 58 U.S.P.Q. 545 (1943); In re Stacy, 30 C.C.P.A. (Patents) 972, 135 F.2d 232, 57 U.S.P.Q. 307 (1943).

[40] Magnaflux Corp. v. Coe, 139 F.2d 531, 532 (D.C. Cir. 1943), where it was stated, "In a suit to obtain a patent the presumption of administrative . . . correctness runs against the rejected claims, while in an infringement suit the presumption of administrative correctness runs in favor of the issued patent."

A

Ex parte Proceedings

Since the statute which allows a suit against the Commissioner of Patents requires an exhaustion of administrative remedies before suit against the Commissioner can be brought,[41] all cases under this statute have had at least two determinations on the issue of patentability, one by the examiner and one by the Board of Appeals. The effect of the presumption in the older cases of this type was that every reasonable doubt as to whether invention existed should be resolved in favor of the applicant.[42] However, in more recent years the courts have considered the Patent Office decision of great weight [43] and have declared that the old rule is a Patent Office guide for deciding the issue of patentability and has no application in the courts.[44] The effect of the presumption in the more recent cases is to resolve all reasonable doubts in favor of the administrative decision,[45] with the result that the Commissioner's decision must be affirmed if it is reasonable,[46] rational,[47] or if his findings are not erroneous.[48] This change from the reasoning of the older cases can probably be attributed to the recent tendency to raise the judicial standard of invention.[49]

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Inter parte Proceedings

Where the application was involved in an interference in the Patent Office and the applicant was denied priority,[50] the courts have given the presumption of administrative correctness the effect of requiring

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[41] See note 38 *supra*.

[42] *In re* Coykendall, 29 F.2d 868 (D.C. Cir. 1928). Under this rule the presumption of administrative correctness was practically non-existent.

[43] Schering Corp. v. Marzall, 101 F. Supp. 571 (D.D.C. 1951), where it was stated, "great weight must attach to the decision of the Patent Office, especially if the two tribunals of that office concur."

[44] National Lead Co. v. Kingsland, 74 F. Supp. 985 (D.D.C. 1948).

[45] General Motors Corp. v. Coe, 120 F.2d 736 (D.C. Cir. 1941).

[46] Besser v. Ooms, 154 F.2d 17 (D.C. Cir. 1946).

[47] Abbott v. Coe, 109 F.2d 449 (D.C. Cir. 1939).

[48] Hoover Co. v. Coe, 325 U.S. 79, 87, (1945).

[49] *Compare* Besser v. Ooms, 154 F.2d 17 (D.C. Cir. 1946), citing Cuno Corp. v. Automatic Devices Corp., 314 U.S. 84, 91 (1941), *with In re* Coykendall, 29 F.2d 868 (D.C. Cir. 1928); *In re* Henry, 6 F.2d 699 (D.C. Cir. 1925); Application of Wilson, 258 Fed. 976, 977 (D.C. Cir. 1919) and cases cited. See especially the dissenting opinion of Judge Edgerton in Carbide & Carbon Chemicals Corp. v. Coe, 102 F.2d 236, 242, 244 n. 3 and related text (D.C. Cir. 1938).

[50] Rev. Stat. § 4915 (1875), 35 U.S.C. § 63 (1946) states ". . . whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant . . . may have remedy by bill in equity." (35 U.S.C. § 146 (1952) expressly limits such actions to "questions of priority"). Thus there must be an exhaustion of administrative remedies before a suit under this statute can be brought.

evidence which carries a "thorough conviction to the mind" [51] in order to merit the reversal of the Patent Office decision.

It is therefore apparent that the presumption is of greater effect when the claims were involved in an interference proceeding than it is when the Board of Appeals refuses to allow a claim. The reason for this difference is that the interference proceeding is an adversary proceeding [52] entailing intense scrutiny of the claims,[53] whereas an appeal to the Board of Appeals is generally considered an *ex parte* proceeding.[54]

V

The Presumptions of Validity and of Administrative Correctness: A Comparison

The presumption as applied in suits to compel the issuance of a patent is apparently of greater weight than it is in infringement suits, the Patent Office proceedings being similar. Although the difference between resolving all doubts in favor of the Patent Office decision [55] and requiring clear proof [56] that the prior art is anticipatory may be "gradations of difference so subtle" that they are not "susceptible of pursuit without leading us into a land of shadows," [57] such distinctions have been recognized.[58] Various reasons have been given for this difference, but the essence of these distinctions has been stated to be:

> The frequency with which the Supreme Court, notwithstanding the presumption, has overruled the Patent Office on the issue of invention in infringement suits [59] indicates that the Patent

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[51] R.C.A. v. Radio Engineering Laboratories, Inc., 293 U.S. 1 (1934). There would appear to be little doubt that this is the effect of the presumption in interference cases. Morgan v. Daniels, 153 U.S. 120 (1894); Sanford v. Kepner, 195 F.2d 387 (3d Cir. 1952), *aff'd*, 344 U.S. 13 (1952); Ericson v. Jorgensen, 180 F.2d 180 (8th Cir. 1950).

[52] See Morgan v. Daniels, 153 U.S. 120 (1894).

[53] R.C.A. v. Radio Engineering Laboratories, 293 U.S. 1 (1934).

[54] Williams Mfg. Co. v. United Shoe Mach. Corp., 121 F.2d 273, 277 (6th Cir. 1941), *aff'd*, 316 U.S. 364 (1942).

[55] National Lead Co. v. Kingsland, 74 F. Supp. 985 (D.D.C. 1948).

[56] Hall v. Montgomery Ward & Co., 57 F. Supp. 430 (N.D. W. Va. 1944).

[57] See R.C.A. v. Radio Engineering Laboratories, Inc., 293 U.S. 1, 10 (1934).

[58] Magnaflux Corp. v. Coe, 139 F.2d 531 (D.C. Cir. 1943). See dissenting opinion of Judge Edgerton in Carbide & Carbon Chemicals Corp. v. Coe, 102 F.2d 236, 245-246 (D.C. Cir. 1938).

[59] Footnote renumbered from Magnaflux Corp. v. Coe, 139 F.2d 531 (D.C. Cir. 1943). "Statistics from 1933 to 1938 are collected in a dissenting opinion in Carbide & Carbon Chemical Corp. v. Coe, 69 App. D.C. 372, 378, 381, Note 10, 102 F.2d 236, 242, 245. Cf., e.g. Marconi Wireless Telegraph Co. of Am. v. United States, 320 U.S. 1, . . ."

See also Caille v. Kingsland, 73 F. Supp. 921 (D.D.C. 1947), where the court, in footnote 4, lists additional decisions of the Supreme Court illustrative of this attitude. More recent cases are: Crest Specialty v. Trager, 341 U.S.

> Office standards of invention in the past have been too low. It is the more important that the presumption that the Patent Office is right when it rejects a claim for lack of invention be given the full weight to which it is entitled under the law. To interpret the presumption narrowly would prevent the Patent Office from raising its standards of invention to the present legal level.[60]

The conflicting and changing attitudes [61] of the courts in recognizing the presumption, in determining its weight, and in applying it to the two phases discussed, have as a common basis one reason. This reason is the supposed efforts of the Supreme Court to raise the standard of invention.[62]

This test of invention is the very reason why the Supreme Court has not in recent years given any recognition to the presumption of validity.[63] By approving such a test, the Court has generally been precluded from giving any effect to this presumption, since the Patent Office has not applied such a test in determining invention.[64] Therefore, many patents which reach the Supreme Court, where the issue is validity, will fail to meet this exacting requirement, and the Court will be precluded from giving any effect to the presumption that all other requirements of patentability have been fulfilled.[65] This would seem to leave the presumptions as to all requirements of patentability, except that of invention, unimpaired.

VI

The Effect of the New Patent Act

As pointed out above, the intent of Congress in codifying the presumption of validity was to declare the "existing presumption of validity." [66] The first problem which this intent raises is in connection with the presumption that invention exists, since there seems to have

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912 (1951); Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147 (1950); Graver Tank & Mfg. Co. v. Linde Air Products Co., 336 U.S. 271 (1949); Mandel Bros., Inc. v. Wallace, 335 U.S. 291 (1948); Haliburton Oil Well Cementing Co. v. Walker, 329 U.S. 1 (1946).

[60] Magnaflux Corp. v. Coe, 139 F.2d 531, 532 (D.C. Cir. 1943).

[61] The changes of judicial attitude can be generalized as follows: (1) Doubts as to the existence of a presumption of validity in infringement cases, (2) The reversal of the attitude toward the Commissioner's decision in *ex parte* suits to compel the issuance of a patent, (3) The difference between the effects of the presumption of validity and the presumption of administrative correctness where the Patent Office proceedings were similar.

[62] See note 32 *supra*.

[63] See note 59 *supra*, and related text.

[64] See note 30 *supra*.

[65] Regardless of the fact that all other conditions of patentability have been complied with, the requirement of a "flash of genius" made unnecessary any Supreme Court recognition of the fact that these conditions had been met.

[66] H.R. Rep. No. 1923, 82d Cong., 2d Sess. 29 (1952).

been no *definite* judicial attitude against recognizing any of the other segments of the presumption.

In solving this problem Section 282 must be considered in the light of Section 103 of the new Act. The latter section provides in part:

> Patentability shall not be negatived by the manner in which the invention was made.[67]

The declared intent of this section is that:

> . . . it is immaterial whether it (invention) resulted from long toil and experimentation or from a *flash of genius* [Italics added].[68]

Thus, the reasoning of the courts in diminishing the effect of the presumption is no longer valid. However, this does not answer the question of what the "existing" presumption of *invention* is. If the term "existing" is taken literally there is no existing presumption of *invention,* since the Supreme Court has in effect negatived any such presumption. But to say that it was not the intent of Congress to recognize such a presumption is to ignore the express words of the Act.[69] The codified presumption of validity must be taken to include a presumption of invention, since the Act states that a "Patent shall be presumed valid" and invention is one of the requirements of validity.

VII

Conclusion

If the courts are to carry out the Congressional intent of the new Patent Act, *i.e.,* to add stability to the patent system,[70] their previous attitudes toward the presumption of validity and the presumption of administrative correctness must be reappraised. Many factors must be taken into consideration in the application of these presumptions, but the main factors may be generalized as follows:

1. If the public is to obtain the benefits of a disclosure of technical developments in the useful arts, the inventor must remain confident that the consideration for such a disclosure is not of nebulous value.[71]

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[67] 35 U.S.C. § 103 (1952).

[68] H.R. Rep. No. 1923, 82d Cong., 2d Sess. 18 (1952).

[69] "In view of the growing tendency in the recent past for courts to ignore or pay little more than lip service to the doctrine of the presumption of validity, it is hoped that this positive declaration by Congress will be of real value in strengthening the Patent System." *Hearings, supra* note 4, at 46. See notes 25, 26 *supra.*

[70] See note 68 *supra.*

[71] *Hearings, supra* note 4, at 64.

2. No one factor in the patent law can do more to foster confidence in the patent system than a logical and effective application of the presumption of validity.[72]
3. When Congress codified the presumption of validity and declared that it was to have the "existing" effect, this must be taken to mean "existing" after the other provisions of the new Act have been considered.[73]
4. The judicial recognition and application of the presumption of validity outlined in part II of this article should be taken as a basic guide in determining what weight should be attributed to the codified presumption in infringement cases.
5. The presumption of validity and the presumption of administrative correctness are basically the same and should have equality in effect, provided the proceedings in the Patent Office are similar.[74]

H. F. HAMANN.

THE FEDERAL LOBBYING ACT: A RECONSIDERATION

I

INTRODUCTION

Prior to the enactment of the Federal Regulation of Lobbying Act of 1946[1] there was no federal law of general application relating to lobbying activities. The Lobbying Act was adopted as Title III of

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[72] Such an application of the presumption of validity is the first step which can be taken by the courts to carry out the Congressional mandate embodied in the new Act.

It should be remembered that the courts have not considered the presumption of validity as conclusive. See notes 11, 15, 46-48 and 51, *supra*. Therefore it would seem that Congress, by codifying the "existing" presumption of validity, did not intend to approve the broad language used in Williams Mfg. Co. v. United Shoe Mach. Corp., 121 F.2d 273 (6th Cir. 1941), *aff'd*, 316 U.S. 364 (1942). This conclusion, *i.e.*, that the presumption of validity is not final, is sustained by the fact that Section 282 of the new Act also sets out certain defenses to an action for infringement. 35 U.S.C. § 282(1)(2)(3)(4) (1952).

[73] If the term "existing" is taken literally then the court in Myers v. Beall Pipe & Tank Corp., 90 F. Supp. 265 (D. Ore. 1948), for example, could continue to require that the patentee prove the validity of his patent in spite of the provision to the contrary. Section 103 must be considered with Section 282 if this result is to be avoided, since Section 103 expressly negatives the very reason on which the change of attitude is based.

[74] The equality in effect, however, should make a distinction in cases in which the patent had previously been involved in an interference, between cases where the issue of "patentability" was actively contested during these proceedings, Goodwin v. Borg—Warner Corp., 157 F.2d 267 (6th Cir. 1946), *cert. denied*, 335 U.S. 911 (1949), and where it was not, International Steel Wool Corp. v. Williams Co., 137 F.2d 342 (6th Cir. 1943) (holding that Morgan v. Daniels, a case under REV. STAT. § 4915 (1875), 35 U.S.C. § 63 (1946), did not apply to an infringement action since the issue was patentability and not priority).

[1] 60 STAT. 839, 2 U.S.C. §§ 261-270 (1946).