

REISSUED PATENTS AND INTERVENING RIGHTS

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EVERY business man in seeking to avoid suits for infringement of patent rights will, if he is well advised, ask his attorney whether any dominant patents exist which might interfere with his proposed course of conduct. In all fairness he should be able to demand an answer that is reasonably conclusive, but under the present system no such reply can be given.

One of the important factors which preclude a definite answer is that an existing patent which his proposed operations do not infringe may under some circumstances be reissued, *after* operations have been begun, to contain claims which would make the continuance of those operations apparently illegal. The attorney may study the claims that the inventor now makes, but nothing short of divine wisdom can tell what invention he may claim by reissue in the future. Accordingly, the attorney hesitates to advise the business man to proceed; for at any moment a reissue may swoop down and bring with it a suit for injunction.

No reissued patent can validly cover anything other than the original invention.¹ It might at first sight appear easy, therefore, for the attorney to examine any original patent, determine what the invention is, and then decide whether his client's proposed operations involve the use of that invention. But the matter is not so simple. Every inventor must necessarily include within his patent a great many things which he did not invent, in order to clarify the background and operation of his invention. It may be difficult for the reader to determine to what extent these are included directly or by inference in the wording of the grant. It was to avoid this very ambiguity that the Supreme Court, in the first important patent case to come before it,² declared that unless the inventor expressly stated in his patent the limits of his monopoly, so that the public could have a warning of what it might do without infringement, the patent would be void. But, if it is difficult for an inventor accurately to draft a claim which properly delimits his invention, it is still more difficult for another to search out in a patent the precise limits of that invention.

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1. Note 8, *infra*.

2. *Evans v. Eaton*, 7 Wheat. 356 (U. S. 1822).

The definition of "invention" has caused no end of trouble. Much has been said about the distinction between the idea of an invention and the invention itself, suggesting that the idea is nebulous and valueless whereas the invention is physical, concrete, and therefore significant. It is true that, except in the class of inventions called processes, the inventor generally constructs a device to embody the idea, but he may equally well file an application for patent before any device has been built. From the legal point of view, it makes little difference which course he takes. The inventor's contribution is not the physical device, for that is merely a mechanical working out of his idea; it is rather the inspiring concept which makes it possible to build the physical device.³ In the strictest sense the reduction of the idea (invention) to practice is not so much a completion of the invention as a demonstration of its practicability. Without the possibility of the latter, however, there is no patentable invention (and therefore no "invention" in the legal sense), for the idea alone contains no solution to a problem.

New ideas, although not divisible in the same sense in which a plot of land is divisible, have the special relation of greater and smaller. The idea of a device *X* made of a particular metal *Y*, for example, is less general than the idea of the device *X* made of a metal of any kind whatsoever. The former is ordinarily referred to as a more specific idea. It does not follow from the fact that the patentee invented the former that he also invented the latter idea. In fact, very frequently he did not. In such a case the realization that other metals could be employed is a distinctly new and separate invention.

The distinct and separate character of these two ideas is indicated by the fact that frequently the concept of making the device of metal was long known before the specific idea of using the metal *Y* was conceived, or, that of two inventors, one conceived the idea of making the device *X* of metal and the other, knowing of this, conceived of using the metal *Y*. In such case, if it be assumed that a real invention was involved, it is clear that each of these inventors is entitled to a separate patent. The one patentee cannot specifically claim use of the metal *Y* because he never thought of it, and the other patentee is not entitled to the broad idea of making the device of metal because that idea is the contribution of another inventor.

The broad idea, then, is not an inherent part of the specific. They constitute separate inventions. The patenting of one of these is no evidence that the patentee is entitled to the other. If the inventor is permitted to reissue from the narrow concept to the broad, with no sup-

3. *Blandy v. Griffith*, Fed. Cas. No. 1529 (C. C. S. D. Ohio 1869).

porting evidence from the original patent that he is the inventor of the broad, he is permitted to reissue his patent for a different invention, contrary to the statute.

Such reissues, clearly unwarranted, might be disposed of in every case as covering an invention presumably not invented by the patentee, without the necessity of a more specific defense. For to justify a reissue, it must be clear *from the original patent* that the patentee invented the new subject-matter.⁴ In the described case the broad idea is just as clearly a new idea so far as the original patent is concerned; it is just as surely "new matter" (expressly prohibited by the statute),⁵ as an alternative construction would be if introduced for the first time in the reissue. In fact it is the suggestion of a great many alternative constructions and a claiming of them all.

More perplexing are reissues which expand the concept in one respect but disguise the expansion by placing an additional limitation upon the concept in another respect. For example, after patenting the idea of device *X* made of metal *Y* the patentee may seek to claim by reissue the idea of device *X* made of metal *Y* or *Z* and run by electric motor. The electric motor narrows the concept; for now only devices run by an electric motor are included, whereas formerly the devices might have been run by any means whatsoever. Yet the change to "made of metal *Y* or *Z*" is nevertheless a broadening, just as it was in the previous case. Possibly the limitation may be more significant than the broadening (although the reverse is more often the case, for the limitation is usually trivial and may be made simply to mislead Patent Office and court); but to call the reissue narrowed in a case involving the use of metal *Z* is to turn one's back on the fact that at least in the feature relevant to the case the conception of the invention has been broadened.

Two great and obvious evils arise from the granting of broadened reissues: (1) the temptation to an inventor to claim in a reissue something akin to his invention, but which he did not really invent, and (2) the injustice to persons who, prior to the grant of the reissue, began a course of conduct which they would not have begun had they known of the impending reissue, and who are obliged to suffer pecuniary loss through a discontinuance of that course of conduct.⁶

Although the evils and abuses involved in the granting and enforce-

4. *Parker & Whipple Co. v. Yale Clock Co.*, 123 U. S. 87 (1887); *Penn Electric Switch Co. v. Luthe Hardware Co.*, 63 F. (2d) 842 (C. C. A. 8th, 1933).

5. Note 8, *infra*.

6. Rephrasing the first of the two evils in terms of injustice, we may say that it consists in the injustice to the public which results from its being obliged to pay tribute to an inventor for something he did not invent.

ment of reissued patents are more pronounced in broadened reissues, even reissues which do not strictly fall within that class may involve similar unhappy consequences. This is illustrated by the case of a reissue which makes claims narrower than they were in the original and so safeguards an invention which was not formerly effectively protected. The original patent, on file before the grant of the reissue, purports to cover an "invention" broadly. Within the bounds of that "broader" invention are a number—often a very great number—of specific embodiments which the patentee might have patented; that is, apart from any question of the validity of the possible reissues, there are a number of included "inventions" which the patentee, so far as the searching attorney knows, may seek to protect by reissue. Must the attorney, perhaps aware of the invalidity of every claim of the patent, nevertheless by some feat of clairvoyance hazard a conclusion as to which of the possible specific but unclaimed inventions happened to be in the patentee's mind? Or must he by dint of an extended and laborious search (requiring of course, a proportionate bill for services) try to discover just which inventions, in the mass of possible inventions included in the broad claim, are in truth patentable and advise his eager client to keep hands off?

The same dilemma presents itself in the case of a vague claim. No one can tell just what the patentee meant to patent; and if his right to obtain and to enforce a reissue be rigidly maintained, he will in effect be protected during the interval as to any patentable device—and, probably, in view of the exigencies of the situation, as to any other devices not obviously unpatentable—which might conceivably be suggested by the vague claim, for, not knowing which the patentee meant to claim, the interested party must avoid them all. Moreover, there is in these cases a grave danger, although not so great as in cases of broadened reissues, that the inventor did not really invent what he claims in his reissue. As lawyer Webster, over a hundred years ago, said in this connection, "If he swears it, who can deny it?"⁷

Courts might have interpreted the reissue statute⁸ in such a way that broadened reissues would have been impossible. It clearly invites such an interpretation in providing that a reissue may be granted only if the original patent "is wholly or partly inoperative or invalid, by reason of a defective or insufficient specification, *or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new . . .*"⁹ This part of the statute, except for the words

7. *Grant v. Raymond*, 6 Pet. 218, 231 (U. S. 1832).

8. 16 STAT. 205 (1870), 35 U. S. C. § 64 (1926).

9. Italics added.

"wholly or partly," has not been altered appreciably since 1836. The italicized words above expressly permit narrowed reissues; but there is no corresponding clause to permit broadened reissues. In view of the fact that broadened reissues are more extreme in character than narrowed reissues, it is probable that the legislature, if it had intended to permit broadened reissues, would have expressly said so.

THE HISTORY OF BROADENED REISSUES

Early History: Period of the Inventor's Supremacy

The original patent statutes made no provision for the reissue of a patent. But the granting of patents was placed in the hands of one Dr. Thornton,¹⁰ who seems to have been rather a law unto himself; and some time before 1824 he adopted, on his own responsibility, the practice of accepting the surrender of patents and issuing new ones, sometimes without further fee. The policy of reissuing patents was first passed upon by the Supreme Court in 1832¹¹ in considering a patent for a hat-making machine issued to Joseph Grant in 1821 and reissued in 1825. Apparently the patent had previously come before a Connecticut court, but the decision does not seem to be reported. The instant case arose in New York, and the lower court's opinion contains the following eulogy of the invention:

"This machine is one of wonderful ingenuity, and has been of vast advantage to the public; and it is gratifying to learn, that its worthy and indefatigable inventor has been thus far successful in the recovery of exemplary damages for the violation of his just rights."¹²

The reason for asking for a reissue of the Grant patent does not appear. Even after the reissue, some of the grounds of defense were that the patent was too vague and lacking in specific instruction, that it was for a principle which is not patentable and not for a machine, and that there had been prior public use. Whatever the ostensible ground of reissue, however, Mr. Webster's argument before the Supreme Court is illuminating:

10. Dr. Thornton was Superintendent of the Patent Office and, because of the small number of applications for patents, was able to give personal attention to every application. In 1816 and for a decade thereafter, there were only two other persons in the Patent Office, William Elliot, clerk, and Benjamin (later replaced by Robert W.) Fenwick, messenger. Their combined salaries in 1816 amounted to \$1,972. A REGISTER OF OFFICERS AND AGENTS, CIVIL, MILITARY, AND NAVAL, IN THE SERVICE OF THE UNITED STATES (1816) 5, and subsequent issues of the same publication.

11. *Grant v. Raymond*, *supra* note 7.

12. *Grant & Townsend v. —*, Fed. Cas. No. 5701, at 985 (C. C. S. D. N. Y. 1829).

"A man builds an expensive factory, puts in costly machinery, not patented, not described in any specification; he expends much money; by and by, he is sued for violating a patent, and he finds that since he built, an old patent has come out with a new specification. A hearing, of which he knew nothing, has been had before the secretary, and a new patent has issued, and he is called on to stop his factory. Now this supposed case is the very case before the court. The defendants erected their works in 1823, 1824. They knew of the plaintiff's patent of August 11, 1821, but it did not describe any machinery used by them. But in 1825 he surrendered his first patent, took out another, with a specification *describing their machinery*, and sued them. Under the direction of the court he has recovered a verdict of three thousand two hundred and sixty-six dollars; and is entitled, of course, to have this *trebled* and the defendants are ruined. *Is this legal?*"¹³

But the Court, apparently lost in the same admiration for the inventor that characterized the lower court's opinion, swept aside this suggestion for a defense of intervening rights arising from acts performed by the defendant prior to the grant of the reissue. In the glib words of Chief Justice Marshall,

"It is not probable that the defect in the specification can be so apparent as to be perceived by any but those who examine it for the purpose of pirating the invention."¹⁴

If a purpose of the specification is, as the Supreme Court had said, "to put the public in possession of what the party [patentee] claims as his own invention, so as to . . . guard against prejudice or injury from the use of an invention *which the [third] party may otherwise innocently suppose not to be patented*,"¹⁵ it is difficult to see a proper basis for the Court's righteous indignation when a party came before it who had accepted the principle of the Supreme Court, who had taken

13. *Grant v. Raymond*, *supra* note 7, at 230.

The wrong to persons who innocently used an invention before the original patent of that invention, arising from the enforcement of the subsequently granted patent rights—a situation analogous to that of intervening rights—had been recognized by a court in what is probably the first recorded utterance pertinent to the subject. In 1824, speaking of persons who started to manufacture before the grant of the patent, a Circuit Court had said: "But I am inclined to think . . . a patent should not be permitted to operate to the prejudice of persons thus situated, on the principle that innocent third persons are not to be injured by relation back, so as to deprive them of a right lawfully acquired. And if a person knowing of an invention proceeds to put it in use, the inventor not having secured his right by patent, the latter ought not to be permitted to take away that which was previously lawfully made. No man is to be permitted to lie by for years, and then take out a patent." *Morris v. Huntington*, Fed. Cas. No. 9831, at 820 (C. C. S. D. N. Y. 1824).

14. *Supra* note 7, at 243.

15. *Evans v. Eaton*, *supra* note 2, at 434. (italics and parenthetical insertions added).

the patentee at his word, who had examined the original patent to see what the patentee claimed, and who had acted on the information so obtained.

The argument of the plaintiff in the *Grant* case, accepted—one is tempted to say, swallowed—by the Court, is that: “The public yields nothing which it has not agreed to yield; it receives all which it has contracted to receive.”¹⁶ In neither statement is the Court correct. The public did not receive from the original patent the exact and specific instruction needed to put the invention to practical use, and it did not receive that exact statement of the limits of the monopoly which would enable other inventors and manufacturers to proceed with safety—and these, it will be noted, are the only two things the public is intended to receive. The patentee, on the other hand, got from his original patent the full monopoly which he had asked for, insofar as the public had agreed to grant it. If the monopoly was too limited to suit his desires, it was solely because his own contribution to the public was correspondingly limited and required the efforts and contributions of others to make it commensurate with the invention which he sought to monopolize by reissue.

Grant v. Raymond was decided in the January term of the Court. On the third of July in the same year, Congress passed the first reissue statute and included a provision hostile to a defense of intervening rights.¹⁷ This was supplanted in the Patent Act of 1836 by the following provision, which has undergone only minor changes down to the present day:

“And the patent, so reissued, together with the corrected description and specification, shall have the same effect and operation in law, on the trial of all actions hereafter commenced for causes subsequently accruing, as though the same had been originally filed in such corrected form, before the issuing out of the original patent.”¹⁸

Clearly, if the reissued patent has the same effect as though it had been filed at the time the original was filed, no acts by persons other than the patentee, if performed after that date, can serve as a defense. Congress seems to have deliberately endeavored to perpetuate the worst features of the *Grant* case, and at the same time preclude the only safe-

16. *Supra* note 7, at 242.

17. “But no public use or privilege of the invention so patented, derived from or after the grant of the original patent, either under any special license of the inventor, or without the consent of the patentee that there shall be a free public use thereof, shall, in any manner, prejudice his right of recovery for any use or violation of his invention after the grant of such new patent as aforesaid.” 4 STAT. 559 (1832).

18. 5 STAT. 117, 122 (1836); now 16 STAT. 205 (1870), 35 U. S. C. § 64 (1926).

guard suggested by the Court, namely, the defense of intervening rights.

In *Stimpson v. The West Chester Railroad Co.*,¹⁹ Stimpson's patent, coming before the Court in 1846, had been originally issued in 1831 and reissued in 1835. In 1843, the Railroad had used, in the construction of its tracks and engine-wheels, the invention subsequently claimed in the reissue. It was impossible to determine the exact differences between the reissue and the original patent, for the latter had been burned in the Patent Office fire of 1836. Its scope, therefore, had to be determined by oral testimony. The invention was an idea to enable railroad trains to round curves by allowing the outer wheel to ride upon its flange, the inner wheel riding upon its tread of smaller diameter. With such a device it is desirable to have the flange of the inner wheel travel in a groove in the rail to prevent the car from sliding off the tracks sideways. This fact was alluded to in the original and described in the reissue. The other change in the reissue consisted in the omission of certain uses for which, it had apparently been found, the invention was not adapted. The defendant maintained that it had a right to continue to use its equipment because it was constructed before the reissue application.

The Court was forced to pass upon an important preliminary question as to whether Congress had the power to permit an inventor by reissue to compel the discontinuance of the use of an invention although that use had been lawfully begun prior to the reissue. The Court based its answer in the affirmative upon *Evans v. Jordan*.²⁰ That case involved a statute giving Evans a renewal of his patent after the original had expired. During the interval, while the invention was not protected, Jordan had constructed his machine, but it was held that the grant of the renewal enabled Evans to stop Jordan's use of it. The statute, as interpreted by the Court, seems to have been a clear abuse of the power of government; whether or not invalid under the Fifth Amendment, the interpretation, with its injury to the innocent intervenor, should have been avoided at all costs. Under the rule of the *Evans* case, Congress would apparently have the power today to grant a renewal of the original Bell patent to the heirs of Mr. Bell, and so to strangle the American Telephone and Telegraph Company together with all of its competitors and in effect to confiscate their property.

The carrying over of the *Evans v. Jordan* principle into reissue law, however, is still more vicious. An extended patent (renewal) can only be obtained by an act of Congress and the practice of granting such

19. 4 How. 380 (U. S. 1846).

20. 9 Cr. 199 (U. S. 1815).

extensions has been discontinued; but reissues are terrifyingly numerous and the possibility that patents may be reissued is a continuing threat to every business concern.

The *Stimpson* case had been decided by the lower court in favor of the Railroad Company. The trial judge had confidently announced a doctrine of intervening rights, charging the jury in part as follows:

"It clearly appears that the defendants constructed their railroad with the plaintiff's curves in 1834, one year or more before the plaintiff's application for his renewed patent; consequently, they may continue its use without liability to the plaintiff."²¹

But the judgment for the defendant was reversed by the Supreme Court on the ground that the Act of 1832, under which the reissue had been granted, expressly excluded the proffered defense; and the Court went on to say that in this respect the Act of 1836 "made no material change in the act of 1832."²² The Court left no doubt as to its attitude toward the proposed doctrine of intervening rights:

"Now it is plain that no prior use of the defective patent can authorize the use of the invention after the emanation of the renewed patent under the above section . . . Now any person using an invention protected by a renewed patent subsequently to the date of this act is guilty of an infringement, however long he may have used the same after the date of the defective and surrendered patent."²³

A consideration of the claims of the reissue and the claims of the original patent, however, shows that in every proper sense they covered the same invention within the same scope, so that the operations of the defendant infringed the original patent as well as the reissue. It appears, therefore, that the question of intervening rights did not really come before the Court. The *Stimpson* case is more nearly in line with the case of *Abercrombie & Fitch Co. v. Baldwin*,²⁴ where a somewhat similar discussion of intervening rights occurs, but in which the whole foundation of the doctrine or of the denial of the doctrine is lacking for the reason that the defendant's operation infringed the original patent as well as the reissue.

From the *Stimpson* decision until 1882, few attorneys had the temerity to present the defense of intervening rights; and, whenever presented, it was peremptorily denied.²⁵ The holding of the Supreme Court in

21. *Supra* note 19, at 402.

22. *Ibid.*

23. *Id.* at 402-403.

24. 245 U. S. 198 (1917).

25. *Battin v. Taggart*, 17 How. 74, 84 (U. S. 1854); *Agawam Company v. Jordan*, 7 Wall. 583, 609 (U. S. 1869); *Goodyear v. Day*, Fed. Cas. No. 5,566 (C. C. D. N. J.

Battin v. Taggart,²⁶ in 1854, is typical; and, insofar as it dealt with intervening rights, may be summarized in the Court's statement (quoting the *Stimpson* case) that:

"Where a defective patent had been surrendered, and a new one taken out, and the patentee brought an action for a violation of his patent right . . . proof of the use of the thing patented, during the interval between the original and renewed patents, will not defeat the action."²⁷

The Rights of the Public: The Doctrine of Laches

In 1882, the Supreme Court of the United States, in *Miller v. Brass Co.*,²⁸ without citing a case,²⁹ announced a doctrine which, although itself little more than a makeshift, was to have far reaching consequences. Briefly, the doctrine was that a broadened reissue is invalid if applied for after the expiration of an unreasonable length of time from the grant of the original patent. Fifteen years had elapsed in the *Miller* case between the grant of the original and the application for the broadened reissue on which suit was brought. In the opinion of the Court the reissue was not for the same invention that had been described in the original, and the dismissal might have been affirmed on that ground without further comment. But the Court went on to "another grave objection"—that there had been no inadvertence or mistake in the original. "The pretense in this case that there was an inadvertence and oversight which had escaped the notice of the patentee for fifteen years is too bald for human credence." The error, if any, "was obvious on the first inspection of the patent."³⁰

Again the Court might have affirmed without further discussion. But no,

"If two years' public enjoyment of an invention with the consent and allowance of the inventor is evidence of abandonment, and a bar to an application for a patent, a public disclaimer in the patent itself should be construed

1852); *Carr v. Rice*, 1 Fisher's Patent Cases 189, 211 (C. C. S. D. N. Y. 1856). *Cf. Howe v. Williams*, 2 Clifford 245, 261, 262 (C. C. D. Mass. 1863).

26. *Supra* note 25.

27. *Id.* at 84.

28. 104 U. S. 350 (1882).

29. The defense of laches by mere passage of time had been expressly denied in *Hussey v. Bradley*, 5 Blatch. 134, 148 (C. C. N. D. N. Y. 1863). Generally the question had not even been considered, court and counsel having tacitly assumed that the mere passage of time did not make a reissue invalid. *Brooks v. Fiske*, 15 How. 212 (U. S. 1853); *Agawam Company v. Jordan*, *supra* note 25; *Smith v. Pearce*, 2 McLean 176 (C. C. D. Ohio 1840); *Allen v. Blunt*, 2 Wood. & M. 121 (C. C. D. Mass. 1846). Here, as elsewhere, citations are intended to be representative rather than exhaustive.

30. *Supra* note 28, at 352.

equally favorable to the public. Nothing but a clear mistake, or inadvertence, and a speedy application for its correction, is admissible when it is sought merely to enlarge the claim."³¹

The Court explained that broadened reissues, enlarging the claims of the original, were not in the congressional mind when the reissued statute was passed, although

"By a curious misapplication of the law it has come to be principally resorted to for the purpose of enlarging and expanding patent claims. And the evils which have grown from the practice have assumed large proportions. Patents have been so expanded and idealized, years after their first issue, that hundreds and thousands of mechanics and manufacturers, who had just reason to suppose that the field of action was open, have been obliged to discontinue their employments, or to pay an enormous tax for continuing them."³²

One of the chief objections, then, that the Court makes to a broadened reissue granted long after the original patent, is based upon the possibility of certain intervening acts by persons other than the patentee.

"It will not do for the patentee to wait until other inventors have produced new forms of improvement, and then, with the new light thus acquired, under pretense of inadvertence and mistake, apply for such an enlargement of his claim as to make it embrace these new forms. Such a process of expansion carried on indefinitely, without regard to lapse of time, would operate most unjustly against the public . . ."³³

Although historically the doctrine of intervening rights sprang from the doctrine of laches, it clearly appears from the above passages that the sentiment of intervening rights, and the evil at which the doctrine of intervening rights directly aims, played a large part in inspiring the doctrine of laches; and that that evil, the injury to innocent intervenors, represents the primary injustice involved in broadened reissues. The Court could easily have avoided discussion of laches and intervening rights if it had so chosen; the fact that it went out of its way to enunciate the new doctrine, which, as it seems, fairly burst through a wall of neutral facts, indicates that the recognition of intervening rights—and its spiritual offshoot (although chronological antecedent), the doctrine of laches—rests upon a fundamental and undeniable demand of justice and equity.

In the years immediately following the *Miller* case, a large number of reissues came before the Supreme Court. In all of those which involved substantial broadening, the Court refused to sustain the reissue. The case of *James v. Campbell*³⁴ deserves special comment. In it the

31. *Ibid.*

32. *Id.* at 354-355.

33. *Id.* at 355.

34. 104 U. S. 356 (1882).

Court held a reissue invalid on the ground that if the original patent was clear and there was no real mistake, a reissue could not be had for the purpose of expanding and generalizing the claim. This is a holding to the effect that a reissue which substantially changes the scope of an unambiguous patent has no justification. Here, in a decision handed down on the same day as the *Miller* case, is the birth of a doctrine of departure from the original invention which has not yet perhaps received its proper recognition.

The Court, however, gradually shifted from the position that a broadened reissue was for a different invention than the original to one of laying emphasis upon the length of delay before application for the reissue. In 1884, in *Mahn v. Harwood*,³⁵ the doctrine of laches in broadened reissues crystallized from dictum to stare decisis, and the suggested analogy to the rule of public use supplied the term of two years as the normal measure of laches. From that year, courts and Patent Office alike have always accepted the rule that a lapse of more than two years³⁶ between the grant of an original patent and the application for a broadened reissue³⁷ will invalidate the reissued patent unless the delay is excused by special circumstances;³⁸ although, to be sure,

35. 112 U. S. 354 (1884).

36. The case of *Topliff v. Topliff*, 145 U. S. 156 (1892), is clear that the doctrine of laches does not affect the validity of promptly-applied-for broadened reissues. Summarizing sixteen cases, the Court observed: "From this summary of the authorities it may be regarded as the settled rule of this court that the power to reissue may be exercised when the patent is inoperative by reason of the fact that the specification as originally drawn was defective or insufficient, or *the claims were narrower than the actual invention of the patentee*, provided the error has arisen from inadvertence or mistake, and the patentee is guilty of no fraud or deception." *Id.* at 170 (italics added).

37. Mr. Justice Bradley's opinion in the *Miller* case, *supra* note 28, was based very definitely on a recognition of the abuses involved in *broadened* reissues; and he said, with respect to other reissues: "The correction of a patent by means of a reissue, where it is invalid or inoperative for want of a full and clear description of the invention, cannot be attended with such injurious results as follow from the enlargement of the claim. And hence a reissue may be proper in such cases, though a longer period has elapsed since the issue of the original patent." *Supra* note 28, at 355-356.

38. When the Commissioner of Patents refuses to grant a reissue for want of unusual circumstances which excuse the delay, his decision is almost certain to be affirmed. Application of Schneider, 262 Fed. 718 (App. D. C. 1920) (delay of 2 years and 8 months; appellant said "he had no occasion to review his patent until the present time"); *In re Lees*, 269 Fed. 679 (App. D. C. 1920) (delay of 2 years and 5 months; appellant unskilled in patent matters, relied upon solicitor, and only recently discovered the deficiency in the original); *In re Hoiland*, 270 Fed. 704 (App. D. C. 1921); *In re Mummert*, 278 Fed. 399 (App. D. C. 1922) (delay of 3½ years; ill health, death of husband, absence of son in military service); Application of Parks, 16 F. (2d) 541 (App. D. C. 1926) (delay of 3½ years; change of attorneys, financial difficulties in business ventures, lack of time); *In re Markel*, 17 F. (2d) 685 (App. D. C. 1927) (delay of almost 5 years; employment by U. S.

their failure to distinguish broadened reissues in all cases prevents one from predicting with certainty the outcome of a particular case.

The language of the Court in *Topliff v. Topliff*³⁹ indicates the frequent use of the doctrine of laches and gives a hint of the doctrine of intervening rights (which was, in spite of the words of the Court, still in embryo):

"In the large number of cases which have come up to this court since that of *Mahn v. Harwood* was decided, in which reissues have been held to be invalid, it will be found that the opinion of the court was put upon the ground, either that the patentee had been guilty of inexcusable laches, usually of from four to sixteen years, or that circumstances had occurred since the granting of the original patent which made the reissue operate harshly or unjustly to the defendant in the case."⁴⁰

Accepting the two-year rule, the Court affirmed the validity of a broadened reissue applied for within that period, although granted many years later.

But this two-year rule propounded by the Court rests upon a false analogy. The Patent Act of 1793 provided that a patent could not be granted if the invention was in use before the application for patent.⁴¹ This provision worked great hardship upon the inventor because to make certain that his device was operative and commercially useful, it was frequently necessary to put it to use. The law was therefore changed in 1839 to provide a period of two years within which he might apply for a patent after the device went into public use.⁴² Now this period

government as locomotive inspector). See also *Ives v. Sargent*, 119 U. S. 652 (1887); *Hartshorn v. Saginaw Barrel Co.*, 119 U. S. 664 (1887).

When the Commissioner of Patents grants a broadened reissue after a delay of more than two years before the application for reissue, the courts find special circumstances to excuse the delay frequently enough to make it impossible for a third person to determine, in advance of an adjudication, whether or not a broadened reissue granted after such delay is in truth invalid. *Worthington Pump & Machinery Corp. v. Clark Bros. Co.*, 17 F. (2d) 189 (W. D. N. Y. 1927) (delay of 3½ years from March, 1912; assignor of patent, a German citizen, presumably was unfamiliar with our patent laws and believed that the original accurately claimed his invention; negotiations for the assignment were delayed by the World War until February, 1915); *Gross v. Norris*, 18 F. (2d) 418 (D. Md. 1927) (delay of 2 years and 7 months; an appeal, ultimately successful, from a decision declaring the original invalid, was pending at the end of the second year). But *cf.* *Boland v. Thompson*, 26 Fed. 633 (C. C. S. D. N. Y. 1886).

Even a reissued patent applied for within two years of the original grant, and subsequently granted, may be held invalid if the delay was unreasonable. *H. W. Roos Co. v. McMillan*, 64 F. (2d) 568 (C. C. A. 6th, 1933), *cert. den.*, 54 Sup. Ct. 121 (1933).

39. *Supra* note 36.

40. *Id.* at 169.

41. 1 STAT. 318 (1793).

42. 5 STAT. 353 (1839).

of two years for study, development, and commercial exploitation was probably intended in large part to enable the inventor to get the true grasp of his invention. There is, therefore, no justification whatever for the grant of another period of two years for further exploitation and further development unless it is deliberately intended to permit the reissue to include new inventions made after the grant of the original patent.

Moreover, at the time provision was made in the statute for the two-year period, the grant of a patent almost as soon as the application was filed gave the inventor little opportunity to revise his application after it was first drafted. The reissue statute was provided to give him a second chance at his specification. In contrast to this situation, the inventor at the present time has for the proper visualization of his specification not only the preliminary two years before which he must file an application but also from one to six years while his application is being examined, criticized, and molded by the give and take between the attorney and the Patent Office experts. There appears to be little justification, therefore, for the addition of two more years.

Thus, while the doctrine of laches attacks the injustice involved in broadened reissues, it does so upon an illogical foundation, with the result that it stops at an arbitrary point and leaves part of the injustice altogether untouched.

The Rights of the Public: The Doctrine of Intervening Rights

Mr. Justice Bradley, by his language in the *Miller* case, had impregnated the federal judiciary with the seed of a doctrine which, after an interim of thirty-five years, took definite form in the decision of Judge Augustus N. Hand in *Ashley v. Samuel C. Tatum Co.*⁴³ There had previously been indications of the embryonic formulation of the doctrine. Continually, in cases where no question of intervening rights required decision, courts had expressed sympathy for any persons who, having entered upon an unimpeachable course of action prior to the plaintiff's application for a broadened reissue, might be obliged because of that reissue to forego that course of action and thereby to suffer a loss.⁴⁴

43. 240 Fed. 979 (S. D. N. Y. 1917).

44. *Miller v. Brass Company*, *supra* note 28, at 355; *White v. Dunbar*, 119 U. S. 47, 62 (1886); *Topliff v. Topliff*, *supra* note 36, at 165, 171; *Carpenter Straw-Sewing Mach. Co. v. Searle*, 60 Fed. 82, 85 (C. C. A. 2d, 1894); *Autopiano Co. v. American Player Action Co.*, 222 Fed. 276 (C. C. A. 2d, 1915); *Crown Cork & Seal Co. v. Aluminum Stopper Co.*, 108 Fed. 845, 851 (C. C. A. 4th, 1901); *American Automotoneer Co. v. Porter*, 232 Fed. 456, 462, 463 (C. C. A. 6th, 1916); *Hudnut v. Lafayette Hominy Mills*, 26 Fed. 636, 637 (C. C. D. Ind. 1886); *Wooster v. Handy*, 21 Fed. 51 (C. C. S. D. N. Y. 1884).

In *Autopiano Co. v. American Player Action Co.*, *supra*, a first reissue, granted six years

But always, where the court favored the alleged infringer, there were other and better established grounds on which to rest the decision, generally unexcused delay of more than two years, or a divergence between the invention described in the original and the invention sought to be patented in the reissue. The emergence of the doctrine was not, however, without danger of miscarriage. In *A. D. Howe Machinery Co. v. Coffield Motor Washer Co.*⁴⁵ the Circuit Court of Appeals for the Fourth Circuit flatly refused to adopt a doctrine of intervening rights to favor respondents who, during the seven months that elapsed between the original patent and the application for a broadened reissue, had built, but had not yet marketed to any appreciable extent, some of the motors which infringed the reissue without infringing the original patent.

In articulating the doctrine of intervening rights, Judge Hand, sitting in New York, did not mention the Fourth Circuit decision. Over seven years had elapsed between the original patent and the application for the broadened reissue on which the complainant's suit in the *Ashley* case was based, but special circumstances excused the delay, and the complainant would have been entitled to a decree had it not been for the defendant's intervening rights. Four years before the application for a reissue the defendant took out a patent and began to manufacture and sell inkstands under it. The defendant's inkstands infringed the reissue patent but did not infringe the original patent. Judge Hand said:

"I can feel no doubt that a business of some importance has been built up by the defendant between the dates of the granting of the original patent and of the reissue, and that consequently intervening rights have arisen within the legal acceptance of the term. Under these circumstances, complainants cannot be allowed to claim 'infringement by this particular defendant in continuing the manufacture and sale which it entered upon while the . . . [original patent] was the only public announcement of complainant's alleged monopoly.' See *Autopiano Co. v. American Player Action Co.* . . ."⁴⁶

The court expressly found the reissue patent valid, and undoubtedly would have allowed the complainant to maintain a suit against an infringer who had acquired no private intervening rights.

after the original patent, narrowed the claims, and a year later a second reissue restored the claims, of the original. The defendant, sued for infringement, had begun the manufacture and sale of his article (which infringed the second reissue, but not the first) between the respective grants of the two reissues. The court tried to rest its decision against the complainant on intervening rights; but the absence of inadvertence in the application for the first reissue, reduces anything said about intervening rights to the status of dictum.

45. 197 Fed. 541 (C. C. A. 4th, 1912), *cert. den.*, 227 U. S. 677(1913). See also, *Crown Cork & Seal Co. v. Aluminum Stopper Co.*, *supra* note 44.

46. *Supra* note 43, at 982.

Nine more years elapsed before the question again presented itself in its pure form. In 1926 Judge Cochrane of the federal District Court for Kentucky, in a long and carefully written opinion, awarded an injunction and an accounting to the owner of a broadened reissue patent which had been applied for one year after the grant of the original patent.⁴⁷ The invention was a brick-making machine. The defendant, a competitor brick maker, proposed in the interim to construct certain brick-making machines, and, being correctly advised that the proposed machines would not infringe the plaintiff's patent, proceeded to construct and to use two such machines and to advertise and sell the product. The plaintiff then applied for a reissue, which covered the defendant's machines. Judge Cochran attempted to distinguish the *Ashley* case on the ground that in it a seven years' delay was found excusable because of special circumstances, and that perhaps

" . . . in such a case where such special circumstances are not known, to [sic] a party, who, after the lapse of two years and before the making of the application, enters upon the manufacture and sale of the articles which infringe the reissue, acquires an intervening right and the reissue, though valid, is not enforceable against him."⁴⁸

The decree was reversed upon appeal in *Ashland Fire Brick Co. v. General Refractories Co.*⁴⁹ The defendant, it was held, had "at least" a right to continue to manufacture bricks with the two machines which it had used prior to the application for reissue. The court definitely based its holding on the theory of a personal estoppel. To the argument that the statute gave notice of the patentee's right to reissue, and that there could therefore be no estoppel, the court replied:

"This result might logically follow if there were any such general right to a reissue within the maximum period; but there is not. The right to a reissue is exceptional, and is possessed only by those who can come within the exceptions. It must affirmatively appear, not only that the state of the art permitted a broader claim, but that the failure to get it was the result of inadvertence. There being no presumption that a patent can be reissued, and the special cases where it may be done being relatively few, it does not seem that

47. *General Refractories Co. v. Ashland Fire Brick Co.*, 15 F. (2d) 215 (E. D. Ky. 1926).

48. *Id.* at 230.

49. 27 F. (2d) 744 (C. C. A. 6th, 1928), *cert.* dismissed on petitioner's motion, 278 U. S. 662 (1928). Judge Cochran had not cited the Fourth Circuit case, although it was the only one that might conceivably have been regarded as direct authority for his holding; and the Circuit Court of Appeals returned the courtesy by failing to cite the *Ashley* case. The almost consistent failure of courts, in dealing with the subject of intervening rights, to evidence a thorough grasp of the authorities, makes it extraordinarily difficult to draw consistent rules of law from the decisions.

the public, acting on the faith of things as they are, should carry the burden of a change it has no reason to expect. A competitor, observing that the patent is limited to specific features which he does not care to use, may naturally assume that the limitation was either intentional, or necessary, or both."⁵⁰

The court, however, did

"... not overlook the difficulty which sometimes exists in finding all the elements of a conventional estoppel. If, within the two-year period and before the defendant, relying on the limitations in the original patent, has acted to his prejudice (e.g., by building a non-infringing machine) the patentee had filed his application for reissue, manifestly the defendant could not claim any intervening right, although he acted upon the faith of the dedication in the original patent, being without knowledge of the reissue application. This consideration is not, we think, inconsistent with the finding of a true estoppel in a case where the reissue application had not been filed thus early. The right to claim the estoppel depends upon the dedication and its existence as a continuing offer of immunity. By his reissue application, the patentee withdraws that offer, in the only generally possible way. When the defendant acts, he knows that the offer may have been withdrawn in this effective but nonpublic way, and he takes his chances upon the existence of such a withdrawal. Lacking any legislation, the loss must fall upon the later comer."⁵¹

The conflict in the cases was recognized by the Supreme Court in the recent case of *Keller v. Adams-Campbell Co.*:⁵²

"The extent of the operation of the estoppel creating intervening rights in such a case presents a question not free from difficulty . . . The views of the Circuit Courts of Appeals on the general subject of the scope of intervening rights are not entirely easy to reconcile . . . The question, if it were really before us, would be one sufficiently important therefore to justify our consideration of it on certiorari."⁵³

This would indicate that the Court regards the question of intervening rights as an open one, despite its century-old statements apparently to the contrary, and it is submitted that in view of the liberal tendencies of the Court as now constituted it will probably recognize intervening rights if the question comes before it.⁵⁴

50. *Id.* at 746.

51. *Ibid.*

52. 264 U. S. 314 (1924).

53. *Id.* at 317-318.

54. On the question of intervening rights in non-broadened reissues it is impossible to ascertain whether or not there exists a direct Supreme Court pronouncement. In *Abercrombie & Fitch Co. v. Baldwin*, *supra* note 24, the plaintiffs brought suit upon a reissue patent for which application had been made seven years after the grant of the original patent. Briefly, the original had claimed a combination, in a described lamp, of a certain water tube and stirring rod with a bent end; the drawings and description likewise referred to a bent rod. The Seventh Circuit had held that a combination with a straight

Analysis of the Doctrine of Intervening Rights

The *General Refractories* case and the *Ashley* case alone rest unequivocally on the doctrine of intervening rights. It is proposed therefore to take them as the basis of analysis.

rod did not infringe the patent. *Bleser v. Baldwin*, 199 Fed. 133 (C. C. A. 7th, 1912). The reissue, accordingly, covered the combination with the rod whether bent or straight; but the Third Circuit held it invalid on the ground that "a reissue cannot be allowed to broaden the original patent . . . , especially after such a lapse of time as seven years, and after the claim had been limited by a final adjudication." *Grier Brothers Co. v. Baldwin*, 219 Fed. 735, 739 (C. C. A. 3d, 1915). The suit that finally reached the Supreme Court began in the Second Circuit. *Baldwin v. Abercrombie & Fitch Co.*, 227 Fed. 455 (S. D. N. Y. 1915), *aff'd*, 228 Fed. 895 (C. C. A. 2d, 1915). There the Circuit Court of Appeals found that the Seventh Circuit had erred in holding that the original did not cover a combination with a straight rod, and that the Third Circuit was therefore wrong in holding that the reissue broadened the original. "The straight rod idea," said the Second Circuit, "was an alternative form, which the patentee was entitled to use instead of a rod with a bent form." 228 Fed. at 900. The Supreme Court affirmed a decree for the plaintiff, and for the same reason. The Court believed "that the original patent did not need the exposition of the reissue. It exhibited an invention . . . entitled to invoke the doctrine of equivalents . . . Whether the rod was bent or made straight was unimportant." *Supra* note 24, at 207-208. Of course, then, although one of the defendants had begun to manufacture the infringing lamp before the application for reissue, no question of intervening rights could arise; for the reissues did not alter the substance of the original. If the defendant's lamp infringed the reissue, it must also have infringed the original patent before the application for reissue, and the reissue has, therefore, not altered the defendant's position. See *Krauth v. Autographic Register Co.*, 285 Fed. 199, 205 (D. N. J. 1921), *rev'd* on other grounds, *Autographic Register Co. v. Diesbach*, 286 Fed. 470 (C. C. A. 3d, 1922). The Circuit Court of Appeals therefore had not gone into the question. The District Court had ventured a few aimless words on the matter, without citation of authority. Neither the District Court nor the Supreme Court seemed to understand that their general holding in the case dismissed the question altogether. They presented their argument on intervening rights as if it were intrinsically necessary to the decision. The Supreme Court, quoting the District Court in full, said: "To the contention that the Justrite Company, the manufacturing defendant, acquired rights before the reissue, we again may oppose the reasoning and conclusion of District Judge Mayer and their affirmance by the Circuit Court of Appeals. The learned judge said: 'It will be remembered that this company entered the field with its lamp at a time when the validity and scope of the Baldwin patent were still unquestioned and when after some five years of capable effort, the Baldwin lamp had created an extensive market. The Justrite Company took its chances and, in view of the necessities of the situation, it is relieved of all accountability for the period prior to the granting of the reissue patent; but when the reissue was granted, the Justrite Company again took its chances.

"By the reissuance of the patent, the patentee loses all in the way of an accounting under the original patent, but the dominant purpose of the reissue statute was to save to the inventor the future remaining after the reissue.

"I see nothing in the course of plaintiffs or defendants which would allow a court of equity to conclude that defendants are to be relieved because of intervening rights.'" *Supra* note 24, at 209-210.

Taken by itself, this passage may be regarded as an answer to the defense of interven-

(1) The court in the *General Refractories* case,⁵⁵ like the court in the *Ashley* case,⁵⁶ not only rests its decision on the ground of personal estoppel, but expressly rejects mere intervening public use as a defense. The defendant must himself have used the invention which the subsequently-applied-for reissue covered and which the original patent failed to protect, or must himself have performed whatever other intervening acts constitute the defense. But the limitation of the doctrine to such a defendant is merely a dictum, and must be weighed against dicta favoring the defense of intervening public use.

It may be questioned whether the personal estoppel theory of these cases is tenable. There are two arguments against it, one merely damaging in effect, the other totally destructive. To begin with the former, it is generally conceded that if the intervening acts began after the plaintiff's application for a reissue, although before the grant of the reissued patent, there is no defense;⁵⁷ in other words, after making a public deception, sufficient to create an estoppel in favor of anyone who acts upon it, the patentee may avoid any further estoppel by a secret act, which does not correct the public deception. A curious sort of estoppel! In all logic there should at least be included in the protection of the estoppel all persons who act before the reissued patent is granted; although the contrary seems to be generally conceded, there is no decision on the point.

ing rights in cases of non-broadened issues, that one who, before the application for reissue, uses the invention which the reissue, but not the original, protects, simply "takes his chances." The words of the District Court, sanctioned by the Supreme Court, have been referred to in reply to the defense of intervening rights in cases both of broadened and of non-broadened reissues. *Frick Co. v. Lindsay*, 27 F. (2d) 59, 63 (C. C. A. 4th, 1928); *General Refractories Co. v. Ashland Fire Brick*, *supra* note 47, at 226, 227; *Vortex Manufacturing Co. v. F. N. Burt Co.*, 297 Fed. 513, 517 (W. D. N. Y. 1924). And, although the weight of authority in cases of broadened reissues favors intervening rights, the weight of what little authority can be found opposes the defense where non-broadened reissues are involved. *Babcock & Wilcox Co. v. Springfield Boiler Co.*, 16 F. (2d) 964 (C. C. A. 2d, 1927); *Hawie Manufacturing Co. v. Hatheway Manufacturing Co.*, 27 F. (2d) 937 (D. Conn. 1928); *Albertson & Co. v. Beckley-Ralston Co.*, 258 Fed. 453 (N. D. Ill. 1919); *Steiner & Voegtly Hardware Co. v. Tabor Sash Co.*, 178 Fed. 831 (C. C. D. N. J. 1910); *cf. Vortex Manufacturing Co. v. F. N. Burt Co.*, *supra*. For a case seemingly *contra*, although it is not clear whether the decision rests on laches or on intervening rights, see *Diamond Drill Contracting Co. v. Mitchell*, 269 Fde. 261 (C. C. A. 9th, 1920).

55. "In approving and adopting the theory of *estoppel* to support a private intervening right in the nature of a license as against a *generally valid reissue*, we do not overlook the difficulty which sometimes exists in finding all the elements of a conventional estoppel." *Supra* note 49, at 746. (italics added).

56. "While, therefore, the reissue patent is *valid* and infringed, this suit cannot be maintained against this particular defendant . . ." *Supra* note 43, at 982. (italics added).

57. *Ashland Fire Brick Co. v. General Refractories Co.*, *supra* note 49, at 746; *H. W. Roos Co. v. McMillan*, *supra* note 38, at 569.

But an argument from the statute itself completely destroys the possibility of a personal estoppel. If the patentee inadvertently failed to claim in full his invention or inventions, so the statute provides, he may apply for a reissue, and the reissue will be valid *as of the date of the original patent*.⁵⁸ The potential infringer has notice of the statute. He knows that if the patentee was inadvertent he may later lay claim to anything which by his inadvertence was omitted, provided only that the patent grant somewhere suggests the omitted matter.⁵⁹ The court in the *General Refractories* case replied that there is "no presumption that a patent can be reissued."⁶⁰ It is difficult to see what force lies in that undoubted truth; for, presumption or no presumption, the right to apply for a retroactive reissue is given by the statute, and the infringer is therefore charged with notice of it. Unless the original patent be regarded as an actual, positive *assertion* by the patentee that he has made no inadvertent error in his application—and only the most excessive contractualism could drive one so to regard it,—there is no basis for a personal estoppel.

In a case⁶¹ in which there had been four years of unexcused delay before the application for a broadened reissue, and in which expensive experiments (to develop the device which the reissue sought to cover) by persons not involved in the litigation had intervened, Judge Learned Hand vigorously advanced a number of arguments against the theory of personal estoppel, and concluded that no personal estoppel was necessary to a decision for the defendants in the case at bar. Indeed, in view of the long delay, not even intervening public acts need have been proved.

That dictum is therefore weak as an authority; but with regard to the evils to be cured, its soundness is manifest. The first of these—the granting of reissues to secure additional inventions which the patentee never invented—will surely be more completely extirpated by the broader doctrine of intervening rights which permits any person to take advantage of any other person's intervening acts as a defense. The curious situation in which competitors will find themselves if courts follow the narrower doctrine is apparent. Competitor *A*, who began to use the invention just before it was claimed in (or, by the language of the courts,

58. In the words of the statute, the reissue "shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form . . ." Note 8, *supra*.

59. Note 4, *supra*.

60. *Supra* note 49, at 746.

61. *Otis Elevator Co. v. Atlantic Elevator Co.*, 47 F. (2d) 545 (C. C. A. 2d, 1931).

just before the application for) a reissue, may continue to use it, but competitor *B*, who began a few weeks later, cannot use it at all; as a result, if the invention is very valuable, *A* may be able to drive *B* out of business. Surely this would give *A*, who had no legal monopoly whatever, an unfair advantage.

The practical results of the respective doctrines, as well as the evils to be cured, demand that the defense of intervening rights, or, as it might better be called, the defense of intervening use, be available to everyone and not merely to the intervening user—in short, that it completely invalidate the broadened features of the reissued patent.⁶²

(2) The question arises as to whether it is necessary to the defense of intervening rights that the defendant (or other intervenor) shall have *relied* upon the patentee's failure to cover his "invention" in the original patent. Although the opinion in the *Ashley* case does not reveal that the defendant did so rely, the *General Refractories* decision expressly rests on the fact that

"... after the issue of the original patent and with knowledge of it and expressly appreciating its limited character, indeed, being governed therein by the advice of patent counsel, the defendant built a noninfringing brick machine, and still before the reissue application another one, at a substantial expense, and put them into commercial use on a large scale by extensively selling their product, and thus made them substantially material to its manufacturing business . . ."⁶³

If the ground of personal estoppel applies, such reliance would of course be necessary (and it would have to be by the defendant himself). But by the better view, as has been seen, personal estoppel is not a sound

62. The need for such invalidation has not gone unnoticed. On March 15, 1933, Representative Joseph A. Gavagan of New York introduced the following bill to amend the reissue statute: "*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That section 4916 of the Revised Statutes (U. S. C., title 35, sec. 64) be amended by adding at the end thereof the following: 'But such a reissued patent shall have no effect other than the effect of said original patent, against any act, or acts, indicated or begun in good faith prior to the issuance of said reissued patent; and it shall be sufficient for a person sued for infringement of the reissued patent to prove such intervening act, or acts, of himself or another.'*" H. R. 3526, 73d Cong., 1st Sess. (1933). The same bill had been introduced during the previous Congress and had been favorably reported out of Committee. H. R. REP. NO. 1421, 72d Cong., 1st Sess. (1931) Ser. No. 9493.

It is submitted that the following amendment to the reissue statute would secure with greater certainty and unambiguity the ends apparently sought by the framers of the above bill: "Provided that in the event that any device, composition, process, or any other embodiment or form of an invention, within the scope of any claim of the reissued patent but not within the scope of the claims of the original patent, shall have been in public use or on sale in this country prior to the grant of such reissued patent, such reissued patent shall be void as to said claim."

63. *Supra* note 49, at 746.

basis of intervening rights; and if attention is directed primarily at the evils to be cured, the necessity of reliance disappears.

Further, there is a subtle sort of reliance, generally present in cases where no direct reliance appears, which cannot be proved in court. Persons sufficiently educated to invent a device in a given field, or interested in manufacturing a certain device, generally have a pretty fair understanding of the state of the art in the field,—an understanding based partly upon familiarity with other devices, but chiefly upon the problems which are being discussed and written about, the improvements for which manufacturers cry, and the general literature on the subject. A patent claiming a useful new invention in the field would, in all probability, force its way into and considerably change this body of information. The very fact that the original patent failed to claim the invention, then, may well have misled the entire art and have indirectly led the defendant, or other intervenor, to perform the intervening acts, even though he never saw the patent. It does not appear, therefore, that the doctrine can properly depend upon the proof of conscious reliance by the intervenor on the original patent.

(3) A further question of importance is that of the extent to which the defendant, or other intervenor, need go in order to establish the defense of intervening rights, and the acts he must perform. In the *General Refractories* case the defendant built machines "at a substantial expense," made bricks with them, and extensively sold the bricks. In the *Ashley* case the defendant took out a patent and made and sold inkstands under it. In each case the intervening use had become an integral part of the defendant's business. The *Howe Machinery* case, in which no intervening rights were found to exist, may conceivably be distinguished on the ground that it was not there proved that the infringing article "was in any substantial sense put upon the market before complainant applied for its reissue,"⁶⁴ although the general tenor of the opinion is contrary to the doctrine of intervening rights.

The fact that he has sold only a small number of the articles, does not adversely affect a defendant's intervening rights.⁶⁵ On the other hand, the mere taking out of patents for which application was made prior to the issuance of the plaintiff's original patent, will not create intervening rights;⁶⁶ but if the defendant's invention is made after the issue of the plaintiff's original patent, an intervening patent covering the defendant's invention may be sufficient.⁶⁷ No definitive rule can be

64. *Supra* note 45, at 547.

65. *Autopiano Co. v. American Player Action Co.*, *supra* note 44.

66. *American Automotoneer Co. v. Porter*, *supra* note 44.

67. *Id.* at 463.

drawn from the adjudicated cases, but in general it may be said that in jurisdictions where intervening rights are recognized any clear loss⁶⁸ which the intervenor will sustain as a result of the enforcement of the reissue will suffice as a basis for such rights.

The nature of the problems raised by broadened patents and the emerging doctrine of intervening rights would indicate that a mere study of the decisions is not sufficient. Even were they more in accord, the broader aspects of the question would invite inquiry. "When studied with any degree of thoroughness," said the late Professor Babbitt, "the economic problem will be found to run into the political problem, the political problem in turn into the philosophical problem, and the philosophical problem itself to be almost indissolubly bound up at last with the religious problem."⁶⁹ The religious phase of the problem, if it has one, is not within the scope of this article, but a study of the legal phase will be of little value unless we are prepared to reach down to its economic and philosophic foundation.⁷⁰ Judicial authorities have paid lip service to legal technique while doing violence to legal principles and to human justice. To resolve the problem adequately it is necessary in the last analysis to go beyond legal technique and to lay bare, on the one hand, the practical considerations and, on the other hand, the philosophic principles which favor one side or the other.⁷¹

68. It has been held that the mere production of articles where no "substantial investment" is involved will not constitute intervening rights. *Naivette v. Bishinger*, 61 F. (2d) 433 (C. C. A. 6th, 1932).

69. *BABBITT, DEMOCRACY AND LEADERSHIP* (1929) 1.

70. At one time writers on patent law were more ready than now to recognize the philosophic aspect of their subject. Cf. *CHEVALIER, LES BREVETS D'INVENTION* (1878) 44: ". . . que seraient les lois dont serait absent ce qu'on nomme la métaphysique, c'est-à-dire le recours aux principes? Si le législateur ne consent pas à être métaphysicien dans ce sens, il est sujet à faire de mauvaise besogne."

71. In the light of the broad economic and philosophic significance of such a problem, it seems unfortunate that the bar in general has lost interest in patent law, and that patent law has become more and more a thing apart. There are two apparent causes of this phenomenon: the increasing complexity of mechanical invention and the centralization of the business of manufacturing. Large manufacturing enterprises are the source of the most lucrative reward for the honest patent lawyer, but in return they demand a narrowing of the attorney's activities. Some companies have even offered free legal tuition to their laboratory specialists, with a view to transforming them into patent attorneys to deal with their respective specialties. As a result patent lawyers have become a distinct class in themselves, and their brothers have learned to regard their work with the awe properly felt in the presence of unapproachable mystery.

For patent law as a whole the result has naturally been unhappy. The freshness of criticism which the bar at large always brings to a live problem has been replaced by the established specialists' smug satisfaction with things as they are. Like all members of

THE PRESENT PROBLEM

Although the courts have developed weapons with which to combat the evils inherent in broadened reissues, the question remains whether these weapons are adequate. The first weapon—the simple holding that the original patentee did not invent the invention claimed in the reissue—would be adequate did the courts feel free to use it liberally; but the Patent Office has in each case already found, ostensibly, that the patentee is justified, and there is a presumption that the Patent Office did not err. The difficulty here lies in the fact that in the *ex parte* proceeding before the Patent Office that body has no adequate means of testing the technical facts, but in general must accept the state of facts presented by the applicant; whereas in the courts all the technical evidence necessary may be introduced by the opposing party. To regard the holding of the Patent Office as presumptively correct is, therefore, to give the patentee an unfair advantage. Furthermore, the difficulty of proving, before a court untrained in science and mechanics, that the patentee did not invent what he has claimed, especially in view of the fact that the burden rests upon the defendant, constitutes a stumbling block in the way of the effective use of this most direct weapon.

The doctrine of laches, by its inherent limitation to a given number of years, cannot possibly cover all of the cases in which abuses may arise.

The doctrine of intervening rights goes more nearly to the heart of the evil. The great harm in broadened reissues lies in their effect on those who, prior to a reissue, have used and perhaps built businesses around the invention in question. This harm, the strict application of the doctrine will to a great degree eradicate. There are occasional cases, however, where, although no one prior to the reissue has made any tangible use of the invention, the patentee knows it has been conceived and hastens to add it to the scope of his patent by reissue. In such instances the first and not the second evil is present, and the only harm will be to persons who would otherwise have used the invention in the future without interference. The doctrine of intervening rights does

an established religious caste, they understand the relationship between their special prestige and the maintenance of the status quo. It is difficult to account, for example, for the dying out of the movement for a separate patent court, unless we take into consideration the jealous conservatism of the patent bar. Many prominent patent lawyers, whose mechanical and scientific understanding are now about commensurate with that of the judges before whom they appear, would undoubtedly find themselves helpless before a court learned in both law and the physical sciences. It would be interesting to speculate upon the fate of the problem of this paper if it had been subjected to a fresher criticism from the general bar.

not help them. Furthermore, if the doctrine is given the broad scope which is here urged as desirable—that is, if it invalidates the reissue and therefore serves as a defense for others than the intervening actor—it may often be difficult for the defendant, when not himself the intervening actor, to prove the intervening use.

Therefore, although the doctrine of intervening rights in its broad form will come close to achieving the desired end, the complete and technically correct remedy can come only through the abolition of broadened reissues altogether. It is significant that whenever the Supreme Court has felt that relief was needed against a broadened reissue it has not created a personal defense but has given relief by declaring the broadened claims void. Yet the courts, though they have enunciated the doctrine of intervening rights in complete independence of the legislature, cannot go further and abolish broadened reissues altogether without changing their long established interpretation of the reissue statute. The final step in the curious history of broadened reissues must be taken by the legislature itself.

Legislative abolition of broadened reissues would seem to be highly desirable. But as has been observed, non-broadened reissues are subject, although to a lesser extent, to the same condemnation. There exists, then, good reason to urge that all forms of patent reissue be abolished. The advocate of the reissue statute may answer that consideration has been given only to the point of view of the infringer and not to that of the patentee. The inventor, by an innocent mistake, has failed to claim what he meant to claim. But to the contention that he should not be so severely penalized for so trivial an error, it may be replied that even in the relatively rare case of a really innocent mistake, the results of the error, as has been shown, may be far from trivial.

Nor ought there be ignored the policy in favor of putting an invention into *use*. Almost every great system of patent law includes a compulsory licensing provision. That of the United States has no such requirement,⁷² but permits the patentee to allow the patented invention to rot for seventeen years on the shelf and so to paralyze inventive and mercantile initiative. Surely this should not be furthered to the extent of permitting the patentee to accomplish the same effect with respect to an invention which he has not even patented.

It may be argued that this view ignores the primary purpose of the Patent Law—to promote invention by offering reward to the prospective

72. As a result, manufacturers often acquire patents not to utilize them but simply "to prevent their utilization by competitors." JONES, *THE TRUST PROBLEM IN THE UNITED STATES* (1921) 125.

inventor. When he sees his fellow-inventor unable to reap benefit from an apparently patented invention because of inadvertence, probably by the solicitor, in the wording or substance of the patent, will he not choose some other occupation?

The truth is, however, that the prospective inventor knows astonishingly little about the business affairs of his fellow-inventors. He knows only that there is a Patent Law, and that Bessemer and a number of other inventors no whit superior to himself have made a fortune by patenting their inventions. To be sure, he may have heard some other inventor-patentee complain that his invention has been pirated, but that chronic complaint is and will be forever heard, no matter what form the law may take. In one way or another, even valid and proper patents repeatedly fail to satisfy their respective owners; and the repeal of the reissue statute affecting only patents otherwise inoperative, can constitute no more than an additional drop in a well-filled bucket. If there is any great force in the Patent Law to encourage invention, surely the occasional mishap due to faulty letters patent will not seriously affect it.

Again, the ultimate purpose of the Patent Law is not to promote invention but to further the progress of science and the useful arts⁷³ by securing inventions for the use of the public; and one who by his faulty wording interferes with public use of an invention, even if it be his own invention, acts against that ultimate purpose.⁷⁴

But further, can it be assumed that the proper carrying out of the purposes of the Constitution demands that this peculiar right of reissue be given to inventors at so great a public cost? Or has the time come when the rights of the business world and the general public should themselves enter more fully into consideration, even if the result requires a revaluation of the protection which the Patent Law affords to inventors? In a certain sense, the Patent Law is economically the reverse of individualistic, for it places the individual, in the matter of reward for invention, under the protection of the state. Yet basically the Patent Law goes hand in hand with the general attitude—at once philosophic, economic and sociological—which for want of a better name has been called “Individualism,” for it assumes that the welfare of society depends primarily upon the acts of the gifted individual.

This attitude we recognize as an integral part of the popular and

73. U. S. Const., Art. 1, § 8, cl. 8.

74. And, of course, if the inventor gets a complete monopoly of everything he asks, there is little reason to regard him as cheated because he did not ask for more. The very fact that he did not ask for more, indeed, is fairly conclusive evidence that he had thought of nothing more.

literary philosophy, and, to a more limited extent, of the technical philosophy, of the late eighteenth and early nineteenth centuries. But today, and especially in the field of discovery and invention,⁷⁵ the anti-individualistic attitude meets with full justification; modern thought recognizes that "when the state of a science and the social need reach a certain point, a number of individuals are likely to solve the same problem."⁷⁶ The advance of physical science depends in only small part upon the sporadic contribution of the occasional genius. An invention is, in truth, not strictly the product of an individual but the summation of the aggregate contributions, each perhaps minute in itself, of many investigators. The incandescent lamp was invented by Grove, who used a platinum filament. Moissant suggested that the best filament would be made of one of the eight high-melting-point metals, one of which is tungsten, and undertook laborious research to determine the properties of each of those metals. Many workers in the field developed the chemistry involved, until finally Auer von Welsbach produced tungsten lamps on a commercial scale. Before that time, however, there was so much scientific literature on the subject that all of the other metals had been eliminated, and commercial development of the process was reduced to a mere matter of industrial and business organization. The history of the tungsten filament is typical.⁷⁷ The state of the pertinent art reaches a point where the invention must soon be made. One inventor perceives a twig protruding above the ground, another perceives another twig; each pulls at his twig and finds it connects with the same root.

75. Liberal thinkers who have to some extent opposed the anti-individualistic tendency, have generally preferred to support their opinions by reference to great men of literature, statecraft, and religion, and have studiously avoided scientists. See JAMES, *THE WILL TO BELIEVE* (1912) 228 *et seq.* Cf. HOCKING, *THE MEANING OF GOD IN HUMAN EXPERIENCE* (1912) 337. It is interesting that Bismarck, one of the great men listed by James, argued strenuously against the patent system. RECENT DISCUSSIONS ON THE ABOLITION OF PATENTS FOR INVENTIONS (1869) 185 *et seq.*

76. THOMAS, *SOURCE BOOK FOR SOCIAL ORIGINS* (1909) Introduction 20, quoted in HAYES, *INTRODUCTION TO THE STUDY OF SOCIOLOGY* (1919) 478, 479.

77. Cf. *The Chicago and Northwestern Railway Co. v. Sayles*, 97 U. S. 554, 556 (1878): "Like almost all other inventions, that of double brakes came when, in the progress of mechanical improvement, it was needed; and being sought by many minds, it is not wonderful that it was developed in different and independent forms, all original, and yet all bearing a somewhat general resemblance to each other. In such cases, if one inventor precedes all the rest, and strikes out something which includes and underlies all that they produce, he acquires a monopoly, and subjects them to tribute."

The owner of the root is he who runs more quickly to the Patent Office.⁷⁸ Such being the nature of the inventive process, surely little of the impulse to create would be lost by a repeal of the reissue statute.

78. Of course, one must not ignore the part that an occasional individual plays by inventing a useful device an appreciable time before the advance of the pertinent science would have reached it. But in such a person the urge to invent is probably so great that if, instead of offering reward, our law condemned every successful inventor to ten years of penal servitude, he would have invented with equal fire and with equal success. The creative impulse lies deeper in human nature than the founders of our Patent Law suspected. See WOODWORTH, *PSYCHOLOGY* (1921) 517.