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Statutory Protection of Intellectual Property Rights

*Richard G. Smith**

INTELLECTUAL PROPERTY is not subject to evaluation by the physical sciences. It can neither be weighed nor measured, and consequently it cannot be defined, as is realty, by metes and bounds; nor can it be identified and reduced to a plat of subdivision and recorded. As intellectual property is an intangible, its identification and protection under legal process provides peculiar problems.

Presently, intellectual property is protected primarily by statutory provisions, as the methods provided by common law have inherent frailty. This statement is not meant to imply that common law protection is still not of significance, nor no longer relied upon. For example, property rights in trade secrets are lost when they are no longer secret. As protection of certain intellectual property rights is granted by statute, the general rule follows that the statutory provision is construed narrowly when in derogation of the common law.

Intellectual property includes creation in the fine arts; illustratively, paintings, musical compositions, three dimensional objects including sculpture, poetry and prose writings, etc. In general, the foregoing embodiments of intellectual creations are subject to protection under the copyright law. Creations primarily useful in industrial and agricultural pursuits, which include inventions and discoveries and industrial designs, fall within the scope of the patent law. Trademarks and service marks, which in and of themselves are valueless and which become subject to property rights, fall within the purview of the trademark laws only subsequent to use. These identifying letter-combinations and representations, as the reputation of the maker is established, become invaluable adjuncts of the enterprise as these marks grow to connote to the consuming function of our culture the integrity of the maker of the trademarked product and the quality of the so identified product.

In general, there is great confusion over the protection afforded by copyrights, designs, patents and trademarks. Copy-

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rights in general provide, by formal registration, protection for creations in the field of fine arts. Design patents are concerned with the three-dimensional appearance of objects. Patents that have relation to science, invention and discovery always have relation to the "useful" arts—useful as opposed to aesthetic, and directly as concerns utility. The term "Letters Patent" is often used as further distinction. Trademarks have relation to identification of products within certain classes or categories by combinations of identifying marks not "confusingly similar" to other identifying marks used on goods within the same classes or categories.

In United States, the great body of statutory law and correlative interpretation afforded by the case law in ever expanding libraries has its source in the provisions of Article I, Section 8 of the United States Constitution:

The Congress shall have power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries. . . To make all laws which shall be necessary and proper for carrying into execution the foregoing powers. . .

The copyright law has been codified and enacted by the Act of July 30, 1947 as amended, and which enactments are printed under Title 17 of the United States Code.

The patent laws were most recently codified and enacted and the new Patent Codification Act took effect on January 1, 1953. The Act is identified under Title 35, United States Code.

The trademark laws will be found in Title 15, U. S. Code and in the statutes at large.

Various other statutes, state and federal, relate to these matters while primarily concerned with other phases of statutory law. These basic sources provide the fountainhead of substantive and adjective law relating to intellectual property. For exemplary purposes, this exposition will be concerned solely with the problems arising from the domain of invention and discovery and the application of the provisions of the patent laws.

Primary source books in the practice of patent law are the "Rules of Practice of the United States Patent Office in Patent Cases"¹ and a guide used internally by the Patent Office, published primarily for patent examiners, entitled "Manual of Patent

¹ Available from the Superintendent of Documents, Washington 25, D. C. —50¢

Office Procedure." The bulk of Patent Office case law is reported in the United States Patent Quarterly (U. S. P. Q.) as it has interpreted the rules of the Commissioners of Patents promulgated under Constitutional provisions and the Acts of the Congress pursuant thereto. The federal reports of various titles also contain much in the way of interpretive rulings affecting intellectual property rights in general.

In any attempt at accurate communication, the intended meaning of the terms employed is one of the largest obstacles to mutual understanding. At least as much as in any other highly complex field of endeavor, semantics presents an ever bothersome roadblock in patent practice. Definitions of terms are incomplete and suffer from inaccuracy but are essential as a point of beginning.

A patent, according to the statement on its face, is a grant unto the named inventor, his successors or assigns for the term of seventeen years from the date of this grant the right to exclude others from making, using or selling the said invention throughout the United States.

This grant is in the nature of a contract between the Federal Government and the inventor.

The *quid pro quo* between inventor and Government is that the inventor first makes a formal written disclosure of his invention, illustrates by drawings where practical, and by example, the best mode of practice of his invention in such terms as to enable one ordinarily skilled in the art to which his invention most closely relates to practice the invention. The disclosure is terminated with one or more very carefully and accurately phrased sentences of definition of what the inventor has contributed to the art which is of new, novel and useful nature. This formal written disclosure in complete form is called the *specification* and the series of sentences of definition of his contribution are referred to as the *claims*. It is these definitions, which measure the scope of the exclusive grant, which provide most of the issues. The exclusive right to exclude others from practicing the subject matter of the claims for a limited time is the grant made in return for the complete disclosure of the specification.²

² 35 U. S. C. § 112.

Novelty, Utility and Invention

In order for a concept and its reduction to practice to be patentable, the subject matter thereof must fall into a statutorily defined class. The subject matter may relate to a (1) process, (2) machine, (3) manufacture, (4) a composition of matter or any new and useful improvement in the enumerated subject matter.³

Subject matter within this classification, to be patentable, must in turn have several attributes or qualities. The subject matter must be new or novel. If it has been described in a printed publication in the United States or a foreign country before its invention by the applicant or more than one year prior to the date of the application for a patent in the United States, the application does not meet the first fundamental requirement of novelty.⁴ All the printed or published literature of man becomes potentially available to establish lack of novelty in subject matter considered to have inventive merit. This vast collection of published matter forms a reservoir of source material from which is drawn the "prior art." Prior art is a term used to describe the selected literature which most closely relates to the subject matter of a patent application. The "prior art" is found by searching the world's publications from theses in the libraries of technical schools, from the stacks of the Library of Congress, from the published patents of every country, and the most fruitful source, the patents published by the United States. These vast sources of reports on technical progress constitute source information of prior art. If one finds a description of the invention, alleged to be such by the inventor, in this source material from any time period—even two hundred years old, and from a point as distant as the Sorbonne—the invention may be established as lacking novelty.

Patentable subject matter must also possess utility. Both novelty and utility are prerequisites. By *utility* is meant that the invention must be operable to perform a use. Perpetual motion machines, because they are inoperable, lack utility. The amount of utility essential may be very small, and like the consideration that supports an agreement, the law does not look to the amount involved. The patentable invention need not be perfected to its ultimate, but it must be operable to produce the intended end purpose.

³ *Id.* § 101.

⁴ *Id.* § 102.

Judge Holtzoff has put it thus:⁵

It is fundamental that a patent may be granted only on a new and useful process, machine, manufacture, or composition of matter, 35 U. S. C. 101. In other words there must be both novelty and utility as a basis for the granting of a patent. "Utility" is a broad term and implies among other things capacity to perform the function or to attain the result claimed by the applicant in his disclosure. . . It must be borne in mind in this connection that the burden is on the applicant for a patent to prove that he is entitled to it, and therefore the onus is on him to show that the invention will operate as disclosed in the application and will achieve its objective.

Invention, the third requisite of patentability, has not been defined acceptably either by statute or by the courts. As in the opening comment of this article referring to Intellectual Property, progress towards the meaning of invention has been approached, more by describing what an invention is not, rather than what it is.

In *Clark Thread Company*⁶ the statement appears:

A conception of the mind is not an invention until represented in some physical form.

Thus, it would appear that invention is something mental or intellectual plus something more. The something more involves the reduction to practice of the mental concept, and as invention may embrace a process, machine, a manufacture or a composition of matter, these have been held reduced to practice by the court as follows:

A process is reduced to practice when it is successfully performed. A machine is reduced to practice when it is assembled, adjusted and used. A manufacture is reduced to practice when it is completely manufactured. A composition of matter is reduced to practice when it is completely composed.⁷

The inventive act consists of two steps. The first, which is purely mental, in turn consists of two mental steps: (a) recognition of a problem to be solved, and (b) a mental conception of a

⁵ *Isenstead v. Watson*, 157 F. Supp. 7, 9 (D. C., D. C. 1957); 115 U. S. P. Q. 409 (1957).

⁶ *Clark Thread Company v. Willimantic Linen Company*, 140 U. S. 481, 11 S. Ct. 846, 35 L. Ed. 521 (1891).

⁷ *Corona Cord Tire Company v. Dovan Chemical Corp.*, 276 U. S. 358, 48 S. Ct. 380, 72 L. Ed. 610 (1928).

means or mode of solution of the problem recognized. The second step is purely physical and involves reducing to practice the mental parts of the first step. This may be done by physical practice of the invention, or by constructive reduction to practice through filing of an application for patent in the Patent Office.

Discovery involves the same two steps, but in reverse order. One observes by a physical act a result which provides a mode of solution of a recognized problem. Dr. Fleming discovered that the mold *penicillium notatum* inhibited the growth of deadly organisms in a Petrie dish. He applied the discovery of the physical act of inhibition to the problem of control of infectious organisms in living tissue, a problem which he recognized as related to his observation of mold inhibition.

An *invention* does not become such as long as it has not been established by physical evidences of the mental concept. Merely filing an application for patent in accordance with the statutory requirement is acceptable, however, as a physical reduction to practice, and the date of filing of the application may be referred to as the date of constructive reduction to practice of the invention.

Bars to Patentability

There are a number of bars to the granting of a patent and the right to exclude others from the enjoyment of its subject matter. Unless these bars are carefully understood and applied to the factual situation forming the background of a disclosure of an invention, the greatest effort and care in subsequent organization and implementation towards protection by the statutory means provided will be of no consequence.

The subjects of novelty and invention have been briefly touched upon. Aspects of these twin requirements for patentability are inextricably woven into the statutory bars to patentability:⁸

(a) The inventor is not entitled to a patent if it can be shown that his invention was known to others in the United States or a printed description of it was published in a foreign country prior to the invention by the applicant.

(b) The inventor is not entitled to a United States patent if a foreign patent was issued or a paper describing the invention was published in any country, or the invention was used any-

⁸ 35 U. S. C. §§ 102, 103.

where in the world more than one year prior to the date the inventor made his United States application for patent of record.

(c) He is not entitled if he or his agents or assigns filed an application in a foreign country more than one year before the application was filed in the United States.

(d) He is not entitled if his invention was described in a patent granted to another on an application filed in the United States Patent Office before he made his invention.

(e) He is not entitled to a patent if he made his invention subsequent to another party who made the same invention but who had not abandoned, suppressed or concealed it.

In other words,—to be entitled he must have (1) made the invention sought to be patented himself, and (2) he must not have abandoned his invention.

Considerations in securing patent protection to cover intellectual property rights relating to technical matters are next turned to the preparation of the formal document, referred to as the patent specification, which specification includes the claims. The preparation of the specification is governed by statute.⁹

By gross analogy, the specification which includes the description of the invention may be compared with a series of territorial maps, some of which show topographical details, some known and others unknown; some of which show subterranean formations at various depths, some known and others unknown; others of which show and detail roads, bridges, trees and other surface landmarks; some of which are located by accurate survey and others by approximation.

The claims which accompany the specification would then correspond to a deed which might be drawn, carefully delineating all of the various aspects drawn from and entirely dependent upon the information presented by study of all the details of the various maps indicating the metes and bounds and the extent of the various rights running with the land from the center of the earth to the sky which were to be included in the deed.

If we add to this problem the proviso that not all the mineral rights, not all the air rights, and not all the surface rights were to be finally included in the deed; that alternative language was to be avoided; that the final legal description was to be but a single sentence; that nothing was to be mentioned in the deed which was not supported by a clear disclosure on one of the

⁹ Id. §§ 112, 113.

maps; that no point of reference could be referred to unless clearly identified in the maps; that no roads, easements or any property a part of the public way could be included; that no language of negative import, nor of functional nature could be used in the legal description; and that no words of description could be used unless they also were referred to in the maps or defined therein; then many of the limitations inherent in drafting of the patent claims will be better understood.

The drafting of a patent application has been referred to by the Supreme Court in *Topliff v. Topliff*¹⁰ as follows:

The specification and claims of a patent, particularly if the invention be at all complicated, constitute one of the most difficult legal instruments to draw with accuracy, and in view of the fact that valuable inventions are often placed in the hands of inexperienced persons to prepare such specification and claims, it is no matter of surprise that the latter fail to describe with requisite certainty the exact invention of the patentee, and err either in claiming that which the patentee had not in fact invented, or in omitting some element which was a valuable or essential part of his actual invention.

In general it may be said that the disclosure of the invention portion of the specification must, from a practical viewpoint, exceed the statutory requirements which state:⁹

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention. . .

When the nature of the case admits, the applicant shall furnish a drawing.

In practice, the patent specification must, as a minimum, clearly set out as the scope of the invention, by drawings and examples as the case may require, all substantial equivalents in his invention which are not obvious, or which are not clearly shown to be equivalent by available prior art literature. If one sets out in the specification that sodium chloride is a useful and essential component of his composition, and no more, he may only be allowed to claim sodium chloride. If potassium chloride, another similar salt, is equally useful but the applicant so fails to

¹⁰ *Topliff v. Topliff*, 145 U. S. 156, 171, 12 S. Ct. 825, 36 L. Ed. 658 (1892).

mention, he may not later be allowed to enter the statement of equivalency in the specification by amendment. He may be informed that the amendatory matter proposed constitutes new matter and cannot be admitted. Re-filing may be essential. On the other hand, if the applicant states sodium chloride to be a useful and essential element of his invention, and the examiner finds prior art to show another halogen salt to be useful in a similar composition, invention will be denied unless the applicant makes a showing that the particular salt illustrated by him is critical to his invention and that the prior art halogen salt fails to function in an equivalent manner.

The specification must mirror accurately the invention made. The specification writer must sail a treacherous sea between the Charybdis of disclosing an equivalent shown in the prior art (of which it is almost impossible to be aware entirely) and the Scylla of failing to disclose equivalent means outside the scope of his claim language, which will so limit his claim or invention definition that the piratical can easily avoid his claims, practice his invention and profit by his disclosure.

Should the applicant disclose and claim too broadly, and be forced by prior art to narrow the scope of his claims during pendency of his application, and he does this without due care for the true nature of his invention (carelessly limits the claims), another monster of the deep, known as *file wrapper estoppel*, will engulf him.

When the application¹¹ is ready for filing, the completed papers will include the specification and accompanying drawings,⁹ if any; an oath¹² which declares that the applicant believes that he is the first inventor and of what country he is a citizen; a petition asking that a patent be granted to him; and most often, because the inventor does not act *pro se*, a power of attorney from inventor to counsel. In addition a fee is required, varying in amount depending on the number of claims accompanying the application papers. The foregoing constitute a complete patent application.

The completed application, when received by the Patent Office, is assigned a filing date and a serial number correlative with the filing date, and the application, after microfilming, is assigned to one of about a hundred examining divisions within the office.

¹¹ 35 U. S. C. § 111.

¹² *Id.* § 115.

In the United States, contrary to the practice in many foreign countries, applications are subjected to examination¹³ on the merits by individuals trained in the sciences; and often by individuals who have completed formal legal training and have been admitted to practice and are members of the Bar. Supervisory positions in the Examining Divisions of the Patent Office are held by men formally trained and experienced in patent prosecution as well as in the sciences and the law.

Usually within six to nine months after the application has been assigned to one of about one hundred examining divisions, the inventor's attorney receives a paper from the Patent Office, referred to as an "Office Action."

The Office Action details the identifying serial number, filing date and the particular division of the Patent Office to which the application has been assigned. Normally, a list of references will be cited. These citations identify the prior art which the patent examiner has found in his search and which he believes most closely anticipate, either alone or in combination, the subject matter of the invention described in applicant's specification.

Within six months thereafter, and after each official action (unless a shorter time is set in some instances), a reply must be received by the Patent Office. In such replies the applicant's attorney attempts to place the case in such condition, by amendment and by argument, that the examiner may pass the application to issue.

As the claims are the instrumentality for defining the applicant's invention over the prior art, and in a sense the rights given up by society, the claims are the subject of most of the matters in issue between the Patent Office and applicant's attorney. The claims provide the battle ground.

When issues have been reached, often an interview¹⁴ in person with the examiner will assist in preparing a case for allowance. If the issues arrived at cannot be overcome by amendment,¹⁵ arguments, affidavits,¹⁶ and interviews, the application may be abandoned;¹⁷ or if applicant's attorney believes errors in examination have been made, final rejection of the application

¹³ *Id.* § 131.

¹⁴ U. S. Pat. Off., Rules of Practice, Rule 133.

¹⁵ *Id.* Rule 115.

¹⁶ *Id.* Rules 131 and 132.

¹⁷ *Id.* Rules 135 and 138.

may be appealed¹⁸ upon payment of a statutory fee and filing of notice of appeal.

Presuming allowance of the application, a final fee is paid within six months after the date of mailing of the notice of allowance by the Patent Office, and the patent issues in due course. A three months delay in issue is provided for upon request at the time of payment of the final fee. This period sometimes provides time to overcome technical problems met in patent prosecution.

If, within two years from the date of the patent grant, the applicant finds that he has erred in some particular and has claimed less than he was in fact entitled to claim, or within a reasonable period if he has erred in some other particular, he may re-file the application, making such corrections thereto as are required, but in accordance with a well-defined procedure. Successful prosecution of the re-issue application follows along much as in the initial prosecution of the application subsequent to the first filing thereof. The applicant may again obtain allowance of the corrected application. Often a re-issue is the only means available to correct inadvertent error in a patent case.

As a patent, when issued, represents personal property, it may be the subject of a variety of transactions, including outright sale, assignment of partial interests, licenses in certain geographical areas, licenses in particular fields of use, etc.; and such instruments affecting title should be recorded in the Patent Office. Any assignment, grant or conveyance not recorded within three months from its date or prior to the date of a subsequent good faith purchase for value, or mortgage for valuable consideration, is void as against one who has a later-acquired interest.

Attorneys qualified to practice before the Patent Office are usually engineering or science graduates of four or five year technical courses, graduated from law school and admitted to practice in the states or districts of their domiciles. Further, they have successfully passed a special examination on Patent Office procedural rules, and are certified to practice before that body.

A roster of attorneys and firms certified to practice before the Patent Office is maintained and published by the Patent Office. Copies of the roster, and other pamphlets of interest in relation to patents, are available from the Superintendent of Documents.

¹⁸ 35 U. S. C. § 134; U. S. Pat. Off. Rules of Practice, Rule 191.