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## DOUBLE PATENTING IN COPENDING APPLICATIONS

*Chris H. Nanz\**

THE framers of the Constitution in providing therein the basis for our Patent System exercised in that, as in numerous other instances, almost inspired foresight, for it is impossible to estimate how much of our present prosperity, how many of our material comforts or what part of our present high place in the family of nations has resulted from the development of our Patent System.

By Article I, Section 8 of the Constitution of the United States, Congress is granted the power "To promote the Progress of Science and Useful Arts, by securing to Authors and Inventors the exclusive right to their respective Writings and Discoveries," and Congress, in the exercise of that power, has enacted statutes which provide that "Any person who has invented any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof,—may, upon payment of the fees required by law, and other due proceedings had, obtain a patent therefor,"<sup>1</sup> which patent "shall contain—a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the exclusive right to make, use, and vend the invention or discovery throughout the United States and the Territories thereof."<sup>2</sup>

Although there are numerous statutes defining the substantive and adjective rules upon which our Patent System depends, no one of them denies the power to grant

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<sup>1</sup> U. S. Revised Statutes, Title LX, Sec. 4886.

<sup>2</sup> U. S. Revised Statutes, Title LX, Sec. 4884.

to an inventor more than one patent for the same invention, which granting is termed, for want of a better name, "double patenting."

Nevertheless, Judge Story as early as 1819 decided in *Odiorne v. Amesboro Nail Factory*, 2 Mason 28; Fed. Cases 10,430, that:

"An inventor cannot, under the patent act of the United States, have two subsisting valid patents at the same time for the same invention. The first patent, while it remains in full force and unappealed, is an estoppel to any subsequent patent by the same person for the same invention, and the time of his exclusive right begins to run from that period."

The reasons given for this holding are first, that the power to create a monopoly is exhausted by the granting of the first patent and second, that a second and later patent for the same invention has the effect of prolonging the period of monopoly beyond that provided by law. The ruling in this case, which is among the earliest recorded cases dealing with the question of double patenting, has been followed almost without exception, some courts adopting the first ground and the others, constituting the majority, taking the second ground.

An excellent statement of the reason for not permitting double patenting is found in the brief of the argument of counsel for the plaintiff in the case of *United States of America v. American Bell Telephone Co.*, 167 U. S. 224, which statement was adopted by the court in that case. The reason is stated therein as follows:

"The thing which the public pays for in submitting to the monopoly created by a patent is the free enjoyment of the invention after the patent expires. To deny to the public this free use of the invention to which it has become entitled under the contract (of patent) is to take away from it a thing of value which it has bought and paid for."

"A second patent covering the same invention has this effect. It deprives the public of the consideration which it was to receive for being excluded from the free use of the thing during the life of the first patent."

It appears that the Supreme Court of the United States first mentioned the rule against double patenting in 1853 in the case of *O'Reilly et al v. Morse et al*, 15 How. 61, and specifically approved the rule in 1865 in *The Suffolk Mfg. Co. v. Hayden*, 3 Wall. 315. In the first decision, after holding that Prof. Morse might take out a new patent for an improvement on his original telegraph apparatus covered by an earlier patent, the court said:

"All that the law requires of him is that he shall not claim as new, what is covered by a former invention, whether made by himself or any other person,"

while in the latter case it was held that:

"Where the Patent Office grants a patent for one invention, and afterwards, upon a claim filed previously to that on which said patent has been granted, issues another, the second, not the first, void."

From these and other decisions<sup>3</sup> it is clear that double patenting is opposed to the spirit and purpose of the Patent System, but the question of when double patenting occurs is one upon which the decisions of the various courts are not in harmony.

The procedure to follow in order to determine when double patenting exists was stated in *McMillan et ux v. Rees et ux*, 1 Fed. 722, to be an examination of the tenor and scope of the claims of the patents under consideration,<sup>4</sup> the claims comprising those parts of the patents in which the inventor specifically points out and distinctly defines the part, improvement, or combination which he claims as his invention or discovery<sup>5</sup>. A similar rule was

<sup>3</sup> *Mosler Safe and Lock Co. v. Mosler, Bahmann & Co.*, 127 U. S. 354; *James v. Campbell*, 104 U. S. 356; *McCreary v. Pennsylvania Canal Co.*, 141 U. S. 459; *Washburn Co. v. Beats Em All Co.* (The Barbed Wire patent), 143 U. S. 275; *Underwood v. Gerber*, 149 U. S. 224; *Miller v. Eagle Mfg. Co.*, 151 U. S. 186.

<sup>4</sup> See also, *Adams v. Bellaire Stamping Co. et ux*, 28 Fed. 360; *Thomas-Houston Electric Co. v. Elmira & H. Ry. Co.*, 71 Fed. 396; *Thomas-Houston v. Western Electric Co.*, 158 Fed. 813; *Kawneer Mfg. Co. v. Toledo Plate & Window Glass Co.*, 232 Fed. 362.

<sup>5</sup> U. S. Revised Statutes, Title LX, Sec. 4888.

laid down at a later date in *Waterbury Buckle Co. v. G. E. Prentice Mfg. Co.*, 294 Fed. 930, in which it is said:

“The test respecting ‘double patenting’ is whether the claims of both patents, when properly construed in the light of the description given, define substantially the same things.”

It was also decided in *The Underfeed Stoker Co. of America v. The American Ship Windlass Co.*, 165 Fed. 65, that the rule that only one patent may be granted for the same invention applies to cases in which the claims in the different patents define the same invention although they differ in language<sup>6</sup>, while it is stated in *Miller v. Eagle Mfg. Co.*, 151 U. S. 186, that a mere difference in the scope of the claims of each patent is insufficient to prevent the operation of the rule against double patenting<sup>7</sup>. It has also been held that where the claims of separate patents differ only in the statement of the functions of the elements claimed in the patents, the claims define the same invention and the later patent is void for double patenting<sup>8</sup>.

Where the inventor has disclosed the same invention in two or more different patents, and has claimed it in the same form of claim in each of the patents, it is, of course, a comparatively simple matter to determine that this constitutes a case of double patenting, but the problem is seldom so simple.

The statutes which govern the granting of patents recognize four main classes of invention, namely: arts or processes, machines or apparatus, manufactures or the products obtained by carrying out processes either by

<sup>6</sup> See also, *Root v. Sioux City Cable Co.*, 42 Fed. 412; *Thomas-Houston Electric Co. v. Elmira & H. Ry. Co.* 71 Fed. 396; *Cadwell v. Firestone Tire & Rubber Co.*, 13 F. (2d) 483; *Thomas-Houston Electric Co. v. Western Electric Co.*, 158 Fed. 813; *In re Woodsome et al.*, 10 F. (2d) 1003; *Ex parte Holt*, 29 O. G., 171; 1884 C. D., 43; *Ex parte Ransom*, 39 O. G., 119; 1887 C. D., 22.

<sup>7</sup> See also, *Russel v. Kern*, 69 Fed. 94; *Otis Elevator Co. v. Portland*, 127 Fed. 557; *In re Woodsome et al.*, 15 F. (2d) 1033.

<sup>8</sup> *Miller v. Eagle Mfg. Co.*, 151 U. S. 186; *Thomas-Houston Electric Co. v. Jeffery Mfg. Co.*, 101 Fed. 121; *National Hollow Brake Beam Co. v. Interchangeable Brake Beam Co.*, 106 Fed. 693.

hand or by the use of machines, and compositions of matter or substances which result from the combination of two or more ingredients. In addition to these four classes, the Patent Statutes provide for the granting of a design patent to "Any person who has invented any new, original, and ornamental design for an article of manufacture,"<sup>9</sup> and who has paid the required fees and has complied with all the specified rules of procedure.

Also, inventions falling within the four main classes described above, which are termed "mechanical" patents, as distinguished from patents for designs, may be of varying degrees of broadness. For example, a person may invent a patentable machine and at the same time invent one or more elements of the complete machine which are also patentable, or one may invent a patentable process which includes as a part thereof one or more individual steps which are patentable. Then again, a person may have a broad mental concept, which when reduced to practice is patentable, and in reducing it to practice may invent several specific patentable embodiments of the invention, in which case, if he follows the proper procedure, he may obtain a broad or "generic" patent for the broad idea and, in addition, one or more specific patents for the specific embodiments or "species."

It is readily conceivable that, with all of the above mentioned possibilities present, the question of double patenting may arise not only in the case where the same invention is claimed by the same inventor in the same form of claim in two or more mechanical patents or applications for such patents, or where the same invention is claimed in two or more design patents<sup>10</sup>, but also where a single invention is claimed in more than one patent in different forms of claims, corresponding to the various statutory classes of inventions and variations thereof outlined above.

<sup>9</sup> U. S. Revised Statutes, Title LX, Sec. 4929.

<sup>10</sup> *Faris v. Patsy Frok & Romper Co.*, 273 Fed. 900; *Gross v. Norris*, 18 F. (2d) 418.

Another element which may have an important bearing on the case is that of copendency, that is whether or not the applications for patent which form the basis of the patents were pending in the Patent Office at the same time and, if the applications were copending, whether any of the claims in a later issued patent were added by way of amendment after the issuance of a prior patent.

In the following discussion the general rules, as deduced from the reported cases, will be given concerning double patenting in copending applications for inventions in the various statutory classes and in the case of copending applications for machines and elements thereof or processes and steps in the processes, but special emphasis will be placed upon the question of double patenting in copending applications for inventions bearing the relation to each other of genus and species.

In discussing the decisions relating to the question of double patenting in copending applications, the subject will be divided into the following sections: A. Articles and Processes, B. Articles and Machines, C. Machines and Processes, D. Machines and Elements, E. Processes and Steps, F. Mechanical and Design Patents, and G. Genus and Species.

Unfortunately, it has been impossible to find a large number of cases upon any one point because some of the questions involved therein have not been decided squarely in many cases, since the questions involved have arisen only a few times, and again, certain questions have been decided differently in different jurisdictions. Thus not all of the decisions cited herein directly involve the question of double patenting, but it is believed that they all do have an important bearing upon that question.

The cases relating to patents numbers 424,695 and 495,443, and the reissue of the latter patent, number 11,872, all granted to C. J. Van Depoele, clearly illustrate the conflict which sometimes arises in the various courts. Van Depoele, the inventor of the devices covered by these

patents, was the inventor of the first practical trolley car, the one upon which the modern trolley cars are based, and these patents relate to an overhead trolley switch for switching a trolley from one overhead wire to another, and to a contact device carried by the trolley for use with the switch. An application was filed and subsequently became involved in an interference proceeding<sup>21</sup> in the Patent Office to determine the question of priority of invention between it and another application filed by another inventor. While Van Depoele's original application was pending, a divisional application was filed and issued, the later application covering the structure claimed in the prior application except that it did not include a certain pressure element found in the prior application. The divisional application matured into patent number 426,695 and the prior application subsequently became patent number 495,443.

These patents were assigned to the Thomas-Houston Electric Co., that Company filed a number of infringement suits thereon and the question of double patenting was raised on those suits. It was held that the element omitted in the divisional application and the patent granted thereon would have to be read into the claims in that patent in order to render the device claimed therein operative, thereby making the claims in the two patents cover the same device. For this reason patent number 495,443, since it was issued last, was held to be void for double patenting in *Thomas-Houston Electric Co. v. Sterling Meaker Co.*, 171 Fed. 111 (C. C. of N. J.); *Same v. Hoosick Ry. Co.*, 82 Fed. 461 (C. C. A., 2d Cir.); *Same v. Union Ry. Co.*, 86 Fed. 636 (C.C.A.,

<sup>21</sup> Section 4904 of U. S. Revised Statutes, Title LX, provides that: "Whenever an application is made for a patent which, in the opinion of the commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicants and patentees, as the case may be, and shall direct the primary examiner to determine the question of priority. And the commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals."



2d Cir.); and *Same v. Jeffrey Mfg. Co.*, 101 Fed. 121 (C.C.A., 6th Cir.), although the later patent was sustained in *Thomas-Houston Electric Co. v. Winchester Ave. Ry. Co. et al*, 71 Fed. 192 (C.C. of Conn.)

After the above mentioned adverse decisions, patent number 495,443 was reissued,<sup>12</sup> it then becoming reissue patent number 11,872, in which the pressure element discussed above was canceled from the drawing, all reference thereto was omitted in the specification and it was expressly disclaimed. The reissue was held void in *Thomas-Houston Electric Co. v. Black River Traction Co.*, 124 Fed. 495, because it did not cover the same invention covered by the patent of which it was a reissue, but on appeal, in *Thomas-Houston Electric Co. v. Black River Traction Co.*, 135 Fed. 759 (C.C.A., 2d Cir.), the reissue was held valid as a subcombination and was held to be for a different invention than that covered by patent number 424,659, the first one issued. However, in *Thomas-Houston Electric Co. v. Western Electric Co.*, 158 Fed. 813, the same court held the reissue void for laches in applying for the same and on the ground of undue breadth.

For the sake of simplicity, the classes of invention set out in the Statutes will be designated usually in the following discussion by their more commonly used names of process or method, apparatus, article and composition, instead of by their more technical names of art, machine, manufacture and composition of matter employed in the Statutes. Also unless otherwise specified, the term article

<sup>12</sup> Sec. 4916 of U. S. Revised Statutes, Title LX, provides that: "Whenever any patent is 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, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued—for the unexpired part of the term of the original patent." Such a corrected patent is called a reissue patent.

is intended to include both manufactures and compositions of matter.

Before entering upon a detailed discussion of the question of double patenting in copending application, it is believed advisable to state some of the general rules relating to the question of double patenting.

In the first place, it should be noted that the question of double patenting arises only in the case where a second patent is issued to one and the same patentee for the same invention patented by him in a prior patent, for, as was stated in *Eick v. The Economic Machinery Co.*, 297 Fed. 835, :

“A later patent, issued for the same invention covered by a prior patent, but to a different patentee, is not void, and the owner of the later patent may sue the owner of the earlier, either at law or in equity for infringement, the question of priority of inventions being a matter which may be put in issue and determined.”

It was similarly held in *Waterbury Buckle Co. v. G. E. Prentice Co.*, *supra*, that where two patents issued to different persons were each assigned to the same corporation, that corporation is not the same patentee and the doctrine of double patenting does not apply.

A still stronger case which held substantially the same way as did the *Waterbury Buckle Co.* case, is that of *Van Heusen Products Co. v. Earl & Wilson*, 300 Fed. 922, in which it was held that :

“A later patent is not invalidated by an earlier one to another person although some of the claims are substantially the same, where the later patentee is the true inventor, notwithstanding the fact that both applications were under the control of the same assignee who allowed the earlier application upon which the later patent was granted to become forfeited for failure to pay the final fee, then prosecuted the later application to patent, and afterward renewed the forfeited application and secured the later patent thereon ; and it is not material whether this situation resulted from a mere mistake in overlapping the claims or from a fraudulent intent to extend the monopoly which could not in fact be extended because the earlier patent would be the only valid patent.”

In *Ex parte Pearsall*, 135 O. G. 221, it was held that where an inventor filed an application and assigned it to one party and later filed another application for the same invention which he assigned to another party, a patent issued on the later filed application is a bar to the grant of a patent on the earlier filed application.

Another general rule worthy of notice is stated in *The Suffolk Mfg. Co. v. Hayden*, *supra*, which holds that where two patents have been granted to the same inventor for the same invention, the later issued patent is void, and the date of issue, not the date of application<sup>13</sup>, determines the question of priority between the patents. The foregoing rule is concisely stated in *Mygatt et al. v. Schaffer*, 218 Fed. 827, as follows:

“Where applications for two patents for essentially the same invention were filed by the same applicant on the same day, the date of issue determines the priority, and the fact that the application for the later patent bears the lower serial number is immaterial.”

Although the court was considering design patents in this case, the rule stated applies equally well to mechanical patents since by statute the same regulations and provisions apply to each type of patents, except in those cases where the respective provisions cannot apply because of the essential differences in the two kinds of patents<sup>14</sup>.

However, in *National Electric Ticket Register Co. v. Automatic Ticket Register Co.*, 15 F. (2d) 257, the court apparently reached a different conclusion, for it was held in that case that:

“Where an inventor files an application for a ticket-issuing machine employing a spring motor for driving it in one direction only, which goes to patent after a second application for a similar machine positively driven in both directions, as by an electric motor, in which feature patentability is alleged to reside, in a suit on this first patent and on the question of invention, while the second patent granted on the earlier application is not prior art, the struc-

<sup>13</sup>See also, *Birmingham v. Gates*, 78 Fed. 350.

<sup>14</sup>U. S. Revised Statutes, Title LX, Sec. 4933.

ture described therein was known to the inventor before the second application was filed, and what the patentee knew and put into his earlier application he cannot assert to be new when he filed his later application; and the claims of the first patent are invalid if they cover no inventive idea over the structure of the second patent when taken with the prior art."

Where two patents to the same inventor claim the same invention and are issued on the same day, it has been held that the patentee may choose which patent he wishes to be declared valid and which to be held void<sup>25</sup>. The latter rule was not followed, however, in *Crown Cork and Seal Co. of Baltimore City v. Standard Stopper Co. et al*, 136 Fed. 841, in which the court said:

"Where two patents are issued on the same day by the Patent Office, and there is no other evidence of seniority between them than such as appears from their several numbers, the earlier in number must be regarded the senior and the earlier in publication."

In that case the lower numbered patent was considered as prior art as related to the higher numbered patent, but since the two patents did not claim the same invention, the later patent was not rendered void on the ground of double patenting.

Still another rule of general application is that a subsequent valid patent cannot be issued to an inventor for any invention described in a prior patent to himself and which might have been claimed therein if the application for the subsequent patent is filed after the prior patent has been issued<sup>26</sup>. If the application for the later patent is filed before the former patent is issued the rule is otherwise<sup>27</sup>. This rule is not based on ground of double patenting, but rather on the theory that the failure to claim

<sup>25</sup> *Brush Electric Co. v. Julian Electric Co.*, 41 Fed. 697; *Electrical Accumulator Co. v. Brush Electric Co.*, 52 Fed. 130; *H. S. Johns Mfg. Co. v. Robertson*, 89 Fed. 504.

<sup>26</sup> *Mathews et ux v. Flower et ux*, 25 Fed. 830; *Barnes Automatic Sprinkler Co. v. Wolworth Mfg. Co.*, 60 Fed. 605.

<sup>27</sup> *Washburn Co. v. Beats Em All Co.* (The Barbed Wire patent), 143 U. S. 275; *Singer et al v. Braunsdorf et al*, 7 Blatchford 521; Fed. Cases, 12, 897; *Wheeler v. McCormick*, Fed. Cases, 17, 499; *Graham v. Geneva Lake Crawford Mfg. Co.*, 11 Fed. 138; *Graham v. McCormick et ux*, 11 Fed. 859; *Ide v. Trorlicht, Duncker & Renard Carpet Co. et al* 115

the patentable matter in the patent which is first to issue is considered a dedication of this matter to the public. The rule and the reason therefor are concisely stated in *Victor Talking Machine Co. v. American Graphophone Co.*, 140 Fed. 860, in which the court said:

"It is a general rule that a patentee dedicates to the public such inventions as are described in a patent and might have been claimed therein but which were not claimed therein; but it may also be stated as a general rule that a patent is never invalidated by the fact that the invention claimed in it was described, but not claimed, in a patent granted subsequently to the making of the application for the patent secondly issued, but before it was granted."

Another general rule relating to the question of double patenting is that stated in *Ex parte Williams*, 245 O. G. 277, in which it was said:

"The statute that provides for disclaimers<sup>18</sup> does not allow a patentee to disclaim an invention claimed in a patent for the purpose of securing the claims covering that invention in a pending application, as it would, in effect, extend the monopoly granted by the first patent."

#### A. ARTICLES AND PROCESSES.

Where one patent claims an article and a second and later patent claims a method of making the article, the general rule appears to be that both an article and the method of making it may be patented without giving rise to a case of double patenting<sup>19</sup>. However, there is an ex-

Fed. 137; *Anderson v. Collins*, 122 Fed. 451; *Victor Talking Machine Co. v. American Graphophone Co.*, 140 Fed. 860; *Kinnear Mfg. Co. v. Wilson*, 142 Fed. 970; *Rudolph Wurlitzer Co. v. Sheppy*, 156 Fed. 585; *Hillard v. Fisher Book Typewriter Co.*, 159 Fed. 439; *Century Electric Co. v. Westinghouse Electric & Mfg. Co.*, 191 Fed. 350; *Toledo Plate & Window Glass Co. v. Kawneer Mfg. Co.*, 237 Fed. 364; *Pittsburgh Plate Glass Co. v. American Window Glass Co.*, 276 Fed. 197.

<sup>18</sup> Sec. 4917 of U. S. Revised Statutes, Title LX, provides that whenever, through inadvertence, accident, or mistake, a patentee claims more than that of which he was the original inventor, he may file a written disclaimer of such parts of the thing patented as he shall choose not to claim and such disclaimer will thereafter be considered a part of the original specification.

<sup>19</sup> *Aurora Mantle & Lamp Co. v. Kaufman*, 243 Fed. 911; *In re Zenk*, 267 Fed. 327; *General Bakelite Co. v. General Insulite Co.*, 276 Fed. 166; *General Electric Co. v. P. R. Mallory Co. and Same v. Save Electric Corp.*, 298 Fed. 597.

ception to this rule in the case where the claims of a subsequent process or method patent cover merely the necessary or obvious steps of making an article claimed in an earlier patent, in which case the two patents are considered to be for the same invention<sup>20</sup>. In other words, where there is a single process and the only possible result thereof is a single product, only one patent is permissible, but where there are several processes by means of which the article in question may be made, the article and the processes as well may be patented in separate patents. In this connection, it might also be noted that where a patent has been obtained for an article produced by one process, a second patent to the same patentee for the same article produced by another process is invalid<sup>21</sup>.

Since one of the statutory bars to the granting of a patent is that the invention was described in a printed publication more than two years before the filing of the application for patent<sup>22</sup>, a patent for the method of making an article granted more than two years prior to the date of application for a patent covering the article disclosed in the prior patent, is a bar to the granting of the article patent<sup>23</sup>, because the prior patent constitutes a printed publication.

#### B. ARTICLES AND MACHINES.

Although there is authority to the contrary<sup>24</sup>, the better rule seems to be that patents obtained on copending applications for an article and a machine for making the article are both valid<sup>25</sup>, unless the article is necessarily made by the machine, in which case only one valid patent may

<sup>20</sup> *Mosler Safe & Lock Co. v. Mosler*, 127 U. S. 354; *Oval Wood Dish Co. et al v. Sandy Creek, N. Y., Wood Mfg. Co.*, 60 Fed. 285; *General Electric Co. v. P. R. Mallory Co. and Same v. Save Electric Corp.*, 298 Fed. 483.

<sup>21</sup> *Reynolds v. Standard Paint Co.*, 68 Fed. 483.

<sup>22</sup> U. S. Revised Statutes, Title LX, Sec. 4886.

<sup>23</sup> *In re Griffith*, 187 O.G. 517.

<sup>24</sup> *McKay et ux v. Jackmann et ux*; *Same v. Scott Sole Sewing-Machine Co. et ux*; and *Same v. Lehmen et ux*, 12 Fed. 615.

<sup>25</sup> *McKay, Trustee, etc. v. Dibert*, 5 Fed. 587.

be granted<sup>26</sup>. This rule corresponds to the one stated above in connection with patents for articles and methods of making the articles, and it appears to be a logical one. As in the case mentioned above, the application for the later patent must in any case be filed within two years after the issuance of the earlier patent in order to avoid the statutory bar of prior publication.

### C. MACHINES AND PROCESSES.

In cases involving a patent for a machine and a later patent obtained on an application which was copending with that upon which the machine patent was issued, for a method which the machine is capable of performing, the weight of authority seems to be that both patents are valid<sup>27</sup>. However, this rule is subject to the exception, similar to the exceptions to the rules outlined above in connection with patents for articles and processes, and articles and machines, that if the method claimed in the later patent cannot be practiced except by using the machine claimed in the earlier patent, the later patent is void<sup>28</sup>. The rule with its exception is clearly stated in the case of *The One Piece Bifocal Lens Co. v. The Bisight Co.*, 246 Fed. 450, in which it is said:

“A valid patent cannot be granted for a process, unless the patentee tells how to practice it, and if, in making a machine for that purpose, he exercises his inventive skill, he may patent the new machine, and it will not be a case of double patenting, unless the process cannot be practiced except by such machine.”

An apparent exception to the rule just stated is found in *Century Electric Co. v. Westinghouse Electric and Mfg. Co.*, 191 Fed. 350, in which it was stated that:

<sup>26</sup> *Adrian Wire Fence Co. v. Jackson Fence Co.*, 190 Fed. 195.

<sup>27</sup> *McKay, Trustee, etc. v. Dibert*, 5 Fed. 587; *Simonds Rolling-Machine Co. v. Hathorne Mfg. Co. et al*, 90 Fed. 201, *Dayton Fan and Motor Co. v. Westinghouse Electric & Mfg. Co.*, 118 Fed. 562; *Crown Cork & Seal Co. v. American Cork Specialty Co. et al* and *Same v. Johnson*, 201 Fed. 344; *The One Piece Bifocal Lens Co. v. The Bisight Co.*, 246 Fed. 450.

<sup>28</sup> *Ex parte Edison*, 220 O.G. 1373; *Ex parte Sweetland*, 297 O.G. 397; *In re Taylor*, 285 Fed. 983.

“Separate patents for a new and useful process and for a new and useful apparatus to practice it may be sustained, although no other apparatus to practice it is known, and although the apparatus cannot be used without practicing the process.”

This exception is merely an apparent one, however, because the patents under consideration in that case were issued in accordance with Rule 41<sup>29</sup> as it read at that time, which required that “Claims for a machine and its product” and “Claims for a machine and the process in the performance of which the machine is used must be presented in separate applications.” This Rule was held, in *Steinmetz v. Allen*, 192 U. S. 543, to violate the provisions of the Statutes<sup>30</sup> and it has since been amended to provide that inventions falling within the various statutory classes need not be presented in separate applications, unless they are independent inventions. Should the question presented in the Century Electric Co. case arise in connection with patents granted after Rule 41 was amended, the rule stated in the Bifocal Lens Co. case would undoubtedly be applied.

The case of *H. Ward Leonard, Inc. v. Maxwell Motor Sales Co.*, 288 Fed. 62, is seemingly an irreconcilable exception to the rule that when a patent for a machine has been granted, no subsequent valid patent can be granted for a method which cannot be practiced without employing the machine covered by the prior patent. In that case an apparatus patent and a subsequent process patent were involved and the court could not conceive of a possible infringement of one patent without an infringement of the other, yet both patents were held to be valid. This holding is contrary to the weight of authority and the only apparent reason for the decision is that the Patent Office had insisted on a division of the patentee’s original application, against his wishes, into the two applications which formed the basis of the patents in issue, and

<sup>29</sup> “Rules of Practice in the United States Patent Office,” Gov. Printing Off.

<sup>30</sup> U. S. Revised Statutes, Title LX, Sec. 4886.



the court, realizing that a decision declaring the second patent void would work a hardship in that particular case, evidently allowed that fact to influence their decision.

As in the two prior cases, where the machine and the method are patentably distinct, a disclosure in one is not a bar, as a printed publication, to the granting of a patent on the other, unless the application for the second patent is filed more than two years after the first patent was issued.

In this connection reference may be made to the decision rendered in *Gladding-McBean Corp. v. N. Clark & Sons*, 16 F. (2d) 50, although it is not clearly within the scope of this discussion. In that case, the McBean patent number 1,289,429, for a tile and process of making the tile, was held void on the ground that the subject matter thereof had been dedicated to the public for failure to claim it in the prior patent number 1,184,254 to the same inventor for a die or machine for making the tile, and which disclosed the process and product claimed in the second patent. The application for the later patent was not copending with the application for the first patent and was not a division thereof, although the application for the second patent was filed within a year after the grant of the first patent. The inventions appear to be divisible and it seems that the Examiner in the Patent Office had required claims for the product to be divided out of the first application. According to prior authorities, if the inventions were in fact divisible, and not inseparable, the second patent would not be invalid unless applied for more than two years after the first patent was granted. It would seem, therefore, that this decision is directly opposed to the established law.

#### D. MACHINES AND ELEMENTS

When we come to consider the question of double patenting in connection with patents claiming a machine and one or more specific elements of the machine, it appears

that the respective filing dates of the patents under consideration are immaterial. The courts hold generally that an inventor may not sustain a subsequent patent for an essential element of an invention secured by a former patent without which that invention would not have been patentable<sup>21</sup>. Or stating the rule more generally, a single novel element can be made the basis for one patent only and a subsequent patent thereon is invalid.

This rule, as is the case with most rules, has not been strictly followed, however, for in the patents under consideration in *Palmer v. John E. Brown Mfg. Co.*, 92 Fed. 925, a specific mechanical movement claimed in an earlier patent was also claimed in a later patent as used in a quilting machine, and both patents were declared valid, while in *Spear v. Keystone Lantern Co.*, 131 Fed. 879, both a patent which claimed a single element and a later patent which claimed the same element combined with other elements to form a complete device, were held to be valid. Also, in the case of *Dodge Storage Co. v. New York Central & Hudson R. R. Co.*, 139 Fed. 976, a patent claiming the novel element of a prior patent in combination with a number of old elements was held valid on the ground that the claims in the two patents were not co-extensive, although the general rule as stated above was held to be the correct one.

The case of *Toledo Plate & Window Glass Co. v. Kawneer Mfg. Co.*, 237 Fed. 364, also appears to be *contra* to the above stated rule, for it was held in that case that:

<sup>21</sup> *Underwood v. Gerber*, 149 U. S. 224; *Palmer Pneumatic Tire Co. v. Lozier* 90 Fed. 732; *American Bell Telephone Co. v. National Tel. Mfg. Co.*, 109 Fed. 976; *Industrial Mfg. Co. v. Wilcox and Gibbs Sewing Machine Co.*, 112 Fed. 535; *Thomas-Houston Electric Co. v. Black River Traction Co.*, 124 Fed. 495; *Davix Calyx Drill Co. v. Plunger Elevator Co.*, 135 Fed. 119; *Western Electric Co. v. Galesboro Union Telephone Co.*, 148 Fed. 857; *Dey Time Register Co. v. Syracuse Time Recorder Co.*, 152 Fed. 440; *Washburn v. Consolidated Safety Pin Co.*, 197 Fed. 552; *Pittsburgh Plate Glass Co. v. American Window Glass Co.*, 276 Fed. 197.

"The fact that an element of a combination is made the subject of a separate claim in an earlier patent does not render void a later patent to the same inventor covering a combination including such element."

#### E. PROCESSES AND STEPS.

No cases were found in which the question of double patenting in copending applications where one of the applications claimed a process and another application filed by the same inventor claimed one or more steps included in the process claimed in the other application, had been decided. It would seem, however, that the "essential element" rule stated in connection with patents for machines and elements thereof, would also apply in the case of processes and steps therein and that if the step claimed in one patent is an essential part of the process claimed in a prior patent, the later patent claiming the essential step would be invalid.

#### F. MECHANICAL AND DESIGN PATENTS.

Although not so closely related, as a group, to design patents as they are to each other, "mechanical" patents, which include the different kinds of inventions discussed herein before, may disclose the same inventions that are disclosed in design patents and the question of double patenting has also been raised in connection with these different kinds of patents. As was stated in *Luminous Unit Co. v. Freeman-Sweet Co.*, 249 Fed. 876, :

"The rule of double patenting, under which a subsequently issued patent for a device already patented is void, although application for the latter was first filed, applies to an earlier design patent and a later mechanical patent;—" However, the patents under consideration in that case were not granted to the same patentee and therefore a true case of double patenting could not have arisen, although the question of anticipation might have been raised.

The rule was stated again in *Williams Calk Co. v. Neverslip Mfg. Co.*, 136 Fed. 210, affirmed in 145 Fed. 928, as follows :

"A person cannot take out two patents for the same invention, and it is immaterial that one is for a design and the other for a mechanical device, where the two are indistinguishable in their characteristics and are manifestly the outcome of one and the same inventive idea."

The latter case is apparently contrary to *Collender v. Griffith*, 2 Fed. 206, in which an article patent was held valid and not anticipated by a design patent issued two years prior to the issuance of the article patent because the article patent was directed to structure, while the design patent related to appearance.

It was held in *President Suspender Co. v. MacWilliams*, 233 Fed. 433, that where a design shows how the article is made, there is no invention in a subsequent mechanical patent which is a mere expansion of the other. However, the patents in question were not copending.

The case of *Mathieu v. Mitchell Vance Co.*, 7 F. (2d) 837, held that the test of the validity of a mechanical patent over a prior design patent is whether the later patent disclosed anything different from that which is disclosed in the design patent, and that the difference in the respective disclosure which would render the later mechanical patent valid might consist in the material used or in characteristics inherent in the material used. In that case the later mechanical patent was held valid because the mechanical functions of the article claimed therein were independent of the design of the article.

Although the cases cited above concern situations in which the design patent was issued first, a prior mechanical patent may also render a subsequent design patent invalid if the design covered by the later patent is an almost exact copy of the device disclosed in the prior mechanical patent<sup>32</sup>.

However, in *Bayley & Sons, Inc., v. Standard Art Glass Co.*, 249 Fed. 476, it was held that:

<sup>32</sup> *Carey Mfg. Co. v. Neal*, 90 Fed. 725; *Bradley v. Eccles*, 126 Fed. 945.

“Where an inventor at the same time devises a container for electric lights of pleasing design and a mechanical contrivance conveniently united with an aesthetic cover, he has made two inventions, and, though he at first secures only a mechanical patent, he may within the two year period procure a design patent, without violating the rule against double patenting.”

Similarly, in *Boyle v. Rousso*, 16 F. (2d) 666, the court said:

“That a device forms proper subject matter for a mechanical patent and is so protected does not disqualify it from also being proper subject matter for a design patent, if new, the result of invention, and sufficiently attractive to the eye.”

In the recent case of *Gross v. Norris*, 18 F (2d) 418, after reviewing the authorities, the court reached the same conclusions that were stated in *Collender v. Griffith, supra*, and held that a case of double patenting could not arise between mechanical and design patents. The reasons given by the court for these conclusions are as follows:

“But it is difficult to understand how a situation of double patenting can arise in the case of a design patent and of a mechanical patent applicable to the same device, notwithstanding certain statements in the books to the contrary. (Citing the *Luminous Unit v. Freeman-Sweet*, and the *Williams Calk v. Neverslip Co.* cases, *supra*). There may be double patenting when two patents for the same mechanical structure are sought, as in *Miller v. Eagle Mfg. Co.*, *supra*, and when two patents for the same design are applied for, as in *Faris v. Patsy Frok and Romper Co.*, 273 Fed. 900. But a design patent and a mechanical patent relate to different subject matter. The first pertains to the appearance while the second relates to the mechanical structure of a device, and it is well settled that a design and a mechanical patent covering the same article of manufacture, may coexist. (Citing among others *Bayley & Sons, Inc. v. Standard Art Glass Co.*, *supra*, and *Baker et al v. Hughes-Evans Co. et al*, 270 Fed. 97). ”

“It is true that a design patent cannot be used to protect a mechanical function, or to cover an article whose configuration affects its utility alone and whose appearance is a matter of no consequence. *Theodore W. Foster & Bros. Co. v. Tilden Thurber Co.*, 200 Fed. 54. Yet if an attempt is made to cover such a structure by both kinds of patents, double patenting does not re-

sult, for the reason that the design patent is invalid. *Fred Messmer Mfg. Co. v. Albert Pick & Co.*, 251 Fed. 894.”

The reasoning upon which is based the decision that a design patent covering an article whose configuration affects its utility alone, is void, is that a design patent is by statute granted only for ornamental designs which appeal to the aesthetic senses, and not for utilitarian results obtained by an article.

The court further held in the above cited case that:

“A design first published may give such precise informaton that there can be no invention in a later mechanical patent pertaining to the same article, and a diagrammatic drawing filed as part of a mechanical patent may anticipate claims of a later design.” But:

“Disclosure of a design in a drawing attached to the specification of a mechanical patent, previously filed, did not necessarily act as an anticipation of the design patent, nor as a disclaimer or an abandonment thereof, where both applications were pending in the Patent Office at the same time”.

The following statement in *Baker et al v. Hughes-Evans Co. et al*, 270 Fed. 97, is also of interest:

“It is true,—that the same device or article may exhibit mechanical invention and a patentable design; but it is not true that the design can ever be used to appropriate (per se) the mechanical function. The two patents must be separable; otherwise it would be a contradiction to grant patents for them.”

It would seem that the better rule is that if an inventor devises an article which has sufficient novelty and utility to entitle the inventor to a mechanical patent therefor, and which at the same time has sufficient ornamental novelty, apart from its utility, to be the subject of a design patent, the inventor should be entitled to both a mechanical and a design patent, especially if the applications therefor are copending. Even if one of the patents does disclose the essential features of the other, in view of the fact that the two inventions belong to essentially different types of inventions and cannot be joined in a single application, it would seem that the rule stated in *Bayley & Sons, Inc. v. Standard Art Glass Co.*, *supra*, is the correct one, and one patent should not constitute a bar to the

other, unless the application for the later patent is filed more than two years after the prior one was granted.

#### G. GENUS AND SPECIES.

Although the general rule, as stated hereinbefore, in connection with *The Suffolk Mfg. Co. v. Hayden* and *Myatt et al v. Schaffer, supra*, is that between copending applications of the same inventor for the same invention the date of issue, not the date of application, determines the question of priority, this is not strictly the rule in the case of copending applications for inventions which are related to each other as genus and species, and the respective filing dates of the applications may have an important bearing on the validity of a generic patent issued after a more specific patent has been granted.

The leading case dealing with the question of double patenting where generic and specific inventions are involved is that of *Miller v. Eagle Mfg. Co.*, 151 U. S. 186, and that decision has probably been cited more frequently by counsel and by the courts in cases involving double patenting than any other one decision. This case concerns two patents granted to the same inventor for a spring employed in a cultivator which was so designed that it urged the cultivator beam downwardly when the latter was in operative position and upwardly when the beam was raised above a certain position. The original applications contained claims covering both functions of the spring, but, due to the fact that the claims covering the lifting action of the spring became involved in an interference proceeding, a divisional application covering the depressing function of the spring was subsequently filed and was issued. This patent contained a reference to the copending application and stated what the later case covered. After the successful termination of the interference proceeding, the original application was issued containing claims covering the spring broadly. The Supreme Court held that the two patents were for the same invention and said:

"An inventor cannot have two valid patents for the same invention when the only distinction is that the later one has a broader or more generic claim for matters included in the specific form in the prior patent," and also held that:

"An inventor who takes out a patent covering specifically his entire invention cannot, even by inserting a reservation, obtain a subsequent valid patent covering more broadly a particular feature of the same invention."

Although the case under consideration did not require them, the court laid down the following rules covering cases of this kind, which have been generally followed by the Federal Courts:

"The result of the foregoing and other authorities is that no patent can issue for an invention actually covered by a former patent, especially to the same patentee, although the terms of the claims may differ; that the second patent, although containing a broader claim, more general in its character than the specific claims contained in the prior patent is also (?) void; but where the second patent covers matter described in the prior patent, essentially distinct and separable from the invention covered thereby, and claims made thereunder, its validity may be sustained.

"In the last class of cases it must distinctly appear that the invention covered by the later patent was a separate invention; distinctly different and independent from that covered by the first patent; in other words it must be something substantially different from that comprehended in the first patent. It must consist in something more than a mere distinction of the breadth and scope of the claims of each patent. If the case comes within the first or second of the above classes, the second patent is absolutely void."

These rules correspond generally to those promulgated in 1890, four years prior to the *Miller v. Eagle* decision, in *ex parte* Mullen and Mullen, 50 O.G. 837; 1890 C.D. 9, which are as follows:

"1. Where the applications are based upon the same structure (or invention) so that there can be no patentable line between the claims but merely a difference in scope only one patent may be granted.

"2. Where the matter embraced or described but not claimed in the first application could have been claimed therein, the application claiming such matter must be copending with the first, or else no patent can be granted therefor because the grant of a patent on the first application amounts to a dedication to the public of such matter.



"3. Where the matter embraced or described but not claimed in the first application could not have been claimed therein, an application therefor filed within two years after the grant of the patent on the first application may be allowed unless a bar has been created by public use or sale."\*

When considering patents covering generic and specific inventions, it is doubtful whether the question involved is truly that of double patenting, since the patents do not actually cover the same invention, but the question involved is almost indistinguishable from that of double patenting because in both cases the question to be determined is whether a later patent tends to prolong the monopoly granted by an earlier patent. It is believed to be readily apparent that a subsequent generic patent, which dominates a prior patent granted to the same inventor for a species, may tend to prolong the monopoly obtained by the former patent. The next question to be determined is when a later generic patent is invalidated by a prior specific patent.

In addition to the decisions mentioned above, there are several others which hold that a mere difference in the scope of the claims is insufficient to avoid the objection of double patenting. *Ex parte* Ransom, 39 O.G. 119; 1887 C.D. 22, holds:

"A patent should not issue upon an application covering subject matter shown in a prior patent to the same party, but not constituting a proper division of said patent.",

while it was held in the case of *In re Woodsome et al*, 15 F. (2d) 1003, that:

"Where applicants for a patent involving a single inventive idea, on division being required because of a difference in the scope of the claims, canceled broad generic claims and accepted a patent based on narrow claims, specific in character, they cannot thereafter obtain a new patent based on the broad claims canceled from the prior application."

\* This concise statement of the rules laid down in the case of *Ex parte Mullen and Mullen* is taken from "Double Patenting," Charles H. Schaffer, Pg. 4. See Bibliography.

"The objection of double patenting is not void merely because the claims are of different scope; two patents may be regarded as for the same invention though one claims only a special machine and the other claims broadly a genus."

The latter part of the decision quoted from *In re Woodsome et al* follows the decision in *Otis Elevator Co. v. Portland Co.*, 122 Fed. 557, which holds that:

"Two patents may be for the same invention, although the earlier is for a specific machine, while the latter contains broader claims, which embrace both the prior specific machine and others as well."

The decision in *Ex parte Ransom* is based on the identical rule set out in *Ex parte Holt*, 29 O.G., 171; 1884 C.D. 43, and the reason for the rule is given in the latter decision as follows:

"No invention can be divided along a line determined merely by the scope of claims upon the same subject matter.—It seems clear that subject matter cannot be divided along an imaginary line, a distinction of scope, not of substance,—of the mind, not of matter. If there is to be a division of a case it must be upon lines indicating distinct and separate parts of the same invention."

It is also held by way of dictum in the latter case that a patent for a species should not be allowed while the application for the genus is delayed by interference, etc., even though they may be patented separately, but this statement is contra to weight of authority as will be apparent from the cases discussed hereinafter.

Although, as in the case of double patenting, there is no provision in the Statutes which requires that independent inventions be covered in separate patents, nevertheless, it is generally recognized that this is the correct procedure<sup>33</sup> and, as stated hereinbefore, Rule 41 of "The Rules of Practice provides that where two or more inventions all contribute toward the same useful result, they all may be covered in a single patent"<sup>34</sup>, but where the

<sup>33</sup> *Ex parte Ballman and Evers*, 361 O.G. 3.

<sup>34</sup> See also, *Ide v. Trorlicht, Duncker & Renard Carpet Co. et al*, 115 Fed. 137; *Century Electric Co. v. Westinghouse Electric & Mfg. Co.*, 191 Fed. 350; *Pittsburgh Plate Glass Co. v. American Window Glass Co.*, 276 Fed. 197.

inventions are separate and independent, they must be claimed in separate patents. Different species of the same generic idea are considered separate and independent inventions, and, although generic claims may be made in one patent which are broad enough to include all of the different species of the invention, and the patent containing the generic claims may also contain claims specifically covering one of the species<sup>85</sup>, it was decided as early as 1870, in *Ex parte Eagle*, 1870 C. D. 137, that only one species could be specifically claimed in any one patent and that different species would each have to be claimed specifically in a separate patent. The Patent Office has consistently followed the above rule and has refused to grant a patent specifically claiming more than one species<sup>86</sup>. It is this rule which causes the question as to the validity of generic patents over specific ones to be raised, for if all of the species could be claimed in a single patent that would be the usual procedure, and the question of double patenting would seldom arise in cases of this type.

In discussing the cases dealing with double patenting where the inventions involved are those of the same inventor and bear the relation of genus and species, it will be convenient to divide the decisions into the following groups:

(1) Where the generic claims are in the first patent to issue;

(2) Where the generic claims are in a patent applied for first but issued after a patent containing specific claims;

(3) Where the generic claims are in a patent applied for after the filing of an application for a specific invention, but before the issuance of the latter, and issued after the granting of the specific patent; and (4) Where

<sup>85</sup> *Ex parte Plimpton*, 101 O. G. 2567; *Ex parte Herreshoff*, 106 O. G. 1779.

<sup>86</sup> *Ex parte Worden*, 99 O. G. 1622; *Ex parte Dallas* 106 O. G. 996; *Ex parte Brown*, 108 O. G. 1052; *Ex parte Weston*, 173 O. G. 285.

a patent containing generic claims and one or more patents containing specific claims are issued concurrently.

1. In cases where the generic claims are in a patent issued before the issuance of another patent to the same inventor containing specific claims, the rule which applies is the one prescribed in *The Suffolk Mfg. Co. v. Hayden*, *supra*, namely, that the filing dates of the applications are disregarded and the dates of issue control the question of priority. Since the generic or dominating patent is granted first in the cases in this group, there is no possibility of prolonging the monopoly granted because the patent granting the broad monopoly expires first. In the decisions falling within this group, the courts have reached the logical conclusion and have consistently held the generic and the specific valid". It is stated in positive terms in *Welsbach Light Co. v. Cohn*, 181 Fed. 122, and in *Heidbrink v. McKesson*, 290 Fed. 665, that the date of issue, and not the date of application, controls. In the former case it is held that:

"An inventor having two applications for patents pending at the same time, may base his broadest claims on the one which he considers shows the best form of mechanism, although it may be the later application, and the patent issued thereon will not be anticipated by a later patent issued on his earlier application."

while in the latter case the court said:

"An inventor who discloses operative means for producing a certain result in two applications filed at different times is at liberty to take valid claims in the later application when it was the first to issue."

In this as in similar cases, the generic patent is a printed publication which is a bar to the granting of a specific patent covering matter disclosed therein if the

<sup>21</sup> *Independent Electric Co. v. Jeffrey Mfg. Co. et al*, 76 Fed. 981; *Victor Talking Machine Co. et al v. American Graphophone Co.*, 145 Fed. 350; *Victor Talking Machine Co. v. Duplex Phonograph Co.*, 177 Fed. 248; *Welsbach Light Co. v. Cohn*, 181 Fed. 122; *Gould Storage Battery Co., v. Electric Storage Battery Co.*, 192 Fed. 28; *Horton Mfg. Co. v. White Lily Mfg. Co.*, 213 Fed. 471; *Van Kannel Revolving Door Co. v. Winton Hotel Co.*, 263 Fed. 988; *Heidbrink v. McKesson* 290 Fed. 665; *Cookingham v. Warren Bros. Co.*, 3 F. (2d) 899.

application for the latter is filed more than two years subsequent to the granting of the prior patent.

2. Where the application for patent bearing generic claims is filed before the filing of an application for a specific patent to the same patentee, but the former application is issued after the issuance of a patent on the later filed application, the general rule seems to be that the later generic patent is valid, provided the delay in the issuance of the later patent is not due to the fault of the patentee<sup>88</sup>, and this is true regardless of the fact that the applications for the respective patents were not divisional or that the later patent is not a reissue of an earlier patent<sup>89</sup>.

One of the earliest cases dealing with this question is that of *The Suffolk Mfg. Co. v. Hayden, supra*, in which it was held that:

"Where a party having made application for a patent for certain improvements, afterwards, with his claims still on file, makes application for another but distinct improvement in the same branch of art, in which second application he describes the former improvement, but does not in such second application claim it as original, the description in such second application and non-

<sup>88</sup> *The Suffolk Mfg. Co. v. Hayden*, 3 Wall. 315; *United States of America v. American Bell Telephone Co.*, 167 U. S. 224; *Singer v. Braunsdorf*, 7 Blatchford 521; Fed. Cases 12,897; *Holmes Electric Protective Co. v. Metropolitan Burglar Alarm Co.*, 33 Fed. 254; *Eagle Mfg. Co. v. Bradley*, 35 Fed. 295; *Electric Accumulator Co. v. Brush Electric Co.*, 52 Fed. 130; *Thomas-Houston Electric Co., v. Winchester Ave. Ry. Co.*, et al, 71 Fed. 192; *Thomas-Houston Electric Co. v. Elmira and H. Ry. Co.*, 71 Fed. 396; *Thomas-Houston Electric Co. v. Ohio Brass Co.*, 80 Fed. 712; *Allington & Curtis Mfg. Co. et al v. Glor et al*, 83 Fed. 1014; *Allington & Curtis Mfg. Co. et al v. Globe Co. and Same v. Lee*, 89 Fed. 865; *Tesla Electric Co. v. Scott et al*, 97 Fed. 588; *Ide v. Trorlicht, Duncker & Renard Carpet Co. et al*, 115 Fed. 137; *Electric Storage Battery Co. v. Buffalo Electric Carriage Co.*, 117 Fed. 314; *Dayton Fan & Motor Co. v. Westinghouse Electric & Mfg. Co.*, 118 Fed. 562; *Anderson v. Collins*, 122 Fed. 451; *Westinghouse Electric & Mfg. Co. v. Electric Appliance Co.*, 142 Fed. 545; *Kinnear Mfg. Co. v. Wilson*, 142 Fed. 970; *Thomas-Houston Electric Co. v. Ill. Telephone Const. Co. et al*, 143 Fed. 534; *Century Electric Co. v. Westinghouse Electric & Mfg. Co.*, 191 Fed. 350; *North American Chemical Co. v. Dexter*, 252 Fed. 148; *Higgins Mfg. Co. v. Watson*, 263 Fed. 378; *Folbert Auto Specialty Co. v. Mayo-Skinner Mfg. Co.*, 292 Fed. 883; *Ex parte Edison*, 49 O. G., 1691.

<sup>89</sup> *Gibbs v. Montgomery Ward & Co.*, 19 F. (2d) 613.

claim of it there, is not a dedication of the first invention to the public."

Although the rule as stated in some cases, such as *The Folbert Auto Specialty Co. v. Mayo-Skinner Mfg. Co.*, 292 Fed. 883, which holds that "Delay in granting a broad patent until after the grant of a specific patent to the same patentee on a later application does not invalidate the broad patent," makes no reference to the question of the patentee's laches in obtaining the later generic patent, it seems that laches on the part of the patentee would destroy the validity of the later generic patent, for, as stated in *Gibbs v. Montgomery Ward & Co.*, 19 F. (2d) 613, :

"It is conceivable that a second patent covering subject matter described but not claimed in a copending prior patent, may be so long delayed through the fault of the patentee that in the interval, rights may be required by other persons which the patentee will be estopped to deny."

What appears to be the true rule is stated in *Ex parte Edison*, 49 O. G. 1691, as follows:

"When an applicant is detained in the Office to contest priority, or for any other reason, not involving his own laches, and meanwhile applies for and takes out patents for improvements upon the invention described in the first application, the improvement patents referring to the earlier application, such intermediate patents do not bar the right to a patent upon the subject matter of the earlier application whenever the Office is ready to grant the same."

It was held in *The Cleveland Foundry Co. v. Detroit Vapor Stove Co.*, 131 Fed. 853, that the fact that the generic patent was delayed in the Patent Office until the conclusion of an appeal, filed by the applicant from the decision of the Primary Examiner in refusing to allow the claims<sup>40</sup>, did not constitute laches on the part of the applicant, since he was clearly within his legal rights in filing the appeal.

Similarly, in *United States of America v. American Bell Telephone Co.*, *supra*, a later generic pat-

<sup>40</sup> U. S. Revised Statutes, Title LX, Sec. 4909, et seq.

ent was held not to be invalidated by a prior specific patent to the same inventor issued on an application filed subsequently to the filing of the application for the generic patent, although the generic patent was issued a number of years after the issuance of the specific patent, and the patentee had in every case waited almost the full time granted by law<sup>41</sup> to respond to the actions on the application made by the Examiner in the Patent Office.

It would seem that the rule which provides that a subsequent generic patent which is first filed is not rendered invalid by a prior specific patent issued on a later filed application when the patentee is not guilty of laches, is an equitable one. Applications for broad inventions are often involved in interferences and it is often necessary to file appeals in such cases, each of which proceedings causes delay which cannot be attributed to the fault of the applicant. In any event, it is generally more difficult to obtain the allowance of a generic patent than a specific one, and applications for generic inventions usually remain in the Patent Office longer than do applications for specific inventions.

3. No case was found in which the question of the validity of a generic patent issued after the granting of a patent for a species, on an application filed after the filing of the application on which the specific patent was granted, was squarely decided, and the *dicta* found in decisions in various circuits seem to be in conflict.

It has been held that where an application containing broad claims is filed after a more specific patent has been granted, the later patent is void<sup>42</sup>, but this rule seems to be based more upon the ground of dedication than upon double patenting, since the broad claims could have been inserted in the prior patent and were not included in an application which was copending with that upon which the first patent was granted.

<sup>41</sup> U. S. Revised Statutes, Title LX, Sec. 4894.

<sup>42</sup> *Sickles v. Falls Co.*, 4 Blatchford 508; Fed. Cases 12,834; *Hauser et al v. Starr*, 203 Fed. 264.

In *Otis Elevator Co. v. Portland Co.*, 127 Fed. 557, a later filed, but copending, application was allowed after an earlier filed patented was granted. The claims in the later patent merely defined the invention claimed in the earlier patent in broader terms and the later patent was declared void.

In the case of *Morse Chain Link Co. v. Link Belt Machinery Co.*, 164 Fed. 331, a patent containing specific claims was filed first and issued first, while a subsequent patent granted on an application which was copending with the first application, contained broader claims. The patentee contended that the first patent covered a species while the later patent was for the generic invention, and in response to this contention the court said:

"In this view we cannot concur. This is not a case in which a patentee, having first made application for a generic invention, has subsequently applied for patents for specific improvements. This is a case in which a patentee, possessed of an alleged generic idea, elected to first apply for a patent for a specific embodiment embracing the essential feature of the generic idea,—and later specifying such essential feature in another specific embodiment, claims that the generic idea growing out of such essential feature, belongs to the latter, and not to the earlier, patent. To allow this, it seems to us would be to make the second patent overlap the first, a result that involves the patentee in this dilemma, either that his second patent is not generic in the respect named, or that it is a double patenting."

The court also said in the same case:

"It is no doubt true that, where an application in which an invention is expressed broadly is pending at the same time with one upon narrower lines, the taking out of the latter does not preclude the subsequent allowance of the other in specific form. But that, unfortunately, is not this case. Both applications, of course, were pending together; but the one into which the broad claims were eventually brought was the specific and not the generic form, coming in apparently as an afterthought, when the other was already then months out."

From these excerpts it appears that the court was of the opinion that in that particular case the later patent was void, but that there might be circumstances, such



as where the generic claims are in the patent disclosing a generic form of the invention, where a later generic patent might be valid, even if filed after the earlier specific application has been filed. At any rate, the later patent was not declared void in the *Morse v. Link Belt* case, but the case was decided against the patentee on the ground of non-infringement and the above statements were merely *dicta*.

In *Union Typewriter Co. v. L. C. Smith & Bros.*, 173 Fed. 288, affirmed in 181 Fed. 966, an application for a species was filed and subsequently another application was filed which purported to cover an improvement on the invention covered by the first application. The first application was issued with specific claims and after it was issued claims covering the same invention covered by the claims in the patent, but more generic in scope, were inserted in the later application. A patent was granted on the latter application containing the generic claims and in holding the latter patent void, the lower court said:

“Where, therefore, an earlier patent, with narrow specific claims, is allowed to come out, and after it has issued, claims of alleged broad or generic scope are brought in by way of amendment to another patent, which is applied for as an improvement on the first, the claims of the second patent, if construed broadly, being conflicting with and anticipated by the first patent, are void as amounting to double patenting, which the law does not allow, a result which the copendence or overlapping of the second patent is powerless to prevent.”

The court approved the rule stated by way of *dictum* in the *Morse v. Link Belt* case, *supra*, and, in referring to the rule stated in *Victor Talking Mach. Co., et al v. American Graphophone Co.*, 145 Fed. 350, that a generic patent applied for after the filing of a specific application, but issued before the issuance of the specific patent, is valid, stated:

“Of course there is no abandonment by the earlier narrow application in this instance. Had the inventor, however, got his

specific patent and later his generic one, it would have presented a very different case."

This statement was, of course, unnecessary for the decision of the question involved in the case under consideration and, based as it was on *dicta* found in another case, has little force.

Another relevant statement made by the court in the above cited case is as follows:

"The truth is that there is no particular saving grace in copendency, independent and apart from other things. Otherwise, the filing of an application for a mere improvement, as here, before the earlier patent comes out, would allow anything to be brought into such application by way of new and enlarged claims, that the experience in the practice of the invention suggest, which surely is not the law."

Although the application for the generic patent which was declared void in the above cited case was filed and issued after a specific patent, it was not in effect copending with the earlier filed application because the generic claims were filed after the earlier patent was granted; and, in addition, the later generic claims merely differed in scope from the earlier ones and were therefore void under the general rule against double patenting stated in *Miller v. Eagle Mfg. Co.*, *supra*. It would seem, therefore, that this case fails to decide whether a subsequent generic patent would be valid if the generic claims contained therein were copending with claims for a species contained in an earlier filed and earlier issued patent. The rule stated above that broad claims inserted in an application after the allowance of a species patent are void, has been set out in other decisions<sup>48</sup> on similar states of fact, but none of them squarely decides the question under discussion.

The case of *Vapor Car Heating Co., Inc., et al v. Gold Car Heating & Lighting Co.*, 296 Fed. 188, is a comparatively recent case in which this question is dis-

<sup>48</sup> *Jones v. Larter*, 92 O. G. 383; 1900 C. D. Ill; *In re Carrier*, 4 F (2d) 1013.

cussed by way of *dictum*. Before discussing the merits of two patents, the latter of which was under consideration as being void for double patenting, the court laid down the general rules pertaining to double patenting, saying in substance as follows:

“Where a patent has issued, no subsequent claim by the same patentee can be valid for the same invention; but if the claims be different, and the applications are copending, it makes no difference in which of the two applications the broader claims appear, and the generic claims may issue last, unless they were for the first time introduced into the application after the first patent issued.”

The court questions the correctness of the dictum cited hereinbefore from the *Morse v. Link Belt* case and stated that, although it did not appear when the generic claims were inserted in the subsequent application discussed in that case, if the broad claims were in the later application when the earlier patent was issued, the court felt that in that circuit (the Second) the generic patent would be valid. The *Union Typewriter v. Smith* case, discussed above, was cited by the court to support the last statement in the syllabus quoted above.

In the *Vapor Car v. Gold* case, the application for the later patent was filed before the application for the earlier patent was filed and the claims of the later patent were limited in view of the earlier patent to avoid double patenting, since they were very similar, so that as limited they were not infringed. This case was affirmed in 16 F. (2d) 194, but the question of double patenting was not raised in the appellate court.

From the foregoing discussion, it seems that this case is not a direct authority for any rule by means of which the question of the validity of a subsequent patent over a prior specific patent granted on an earlier filed, but copending, application, may be determined.

In *Cookingham v. Warren Bros. Co.*, 3 F. (2) 899, it was held:

"That inventions stand in the relation of genus and species does not prevent the inventor from obtaining a patent for each, and, when the inventions are different, it is immaterial that one issued before the other,"

but the generic patent was filed first and issued first in that case, and it seems that the above statement was intended to mean that the earlier generic patent did not invalidate the later specific one.

A number of cases hold that if the claims are different and the applications are copending, it makes no difference in which application the broad claims appear<sup>4</sup>, but the question under discussion was not involved in those cases and they cannot be considered as absolute authority on that question.

Upon reason, it would seem that the true test to apply in cases of this kind is whether the granting of the subsequent generic patent has the effect of prolonging the monopoly granted to the patentee by the earlier patent. Applying this test, it would seem that when the later generic claims merely differ in scope from those in the earlier patent, a true case of double patenting arises and the later patent should be declared void. However, where the claims in the two copending patents are related to each other as a true genus and species and the patentee was not guilty of laches or bad faith in obtaining the generic patent, the latter should be declared valid, even though it was filed and issued later than the earlier copending specific patent.\*

4. Where a patent containing generic claims and one or more patents containing claims covering different spe-

<sup>4</sup>Suffolk Mfg. Co. v. Hayden, 3 Wall. 315; Electric Accumulator Co. v. Brush Electric Co., 52 Fed. 130; Thomas-Houston Electric Co. v. Elmira & H. Ry. Co., 71 Fed. 396; Badische Anilin & Soda Fabrik v. A. Klipstein & Co., 125 Fed. 543; Century Electric Co. v. Westinghouse Electric & Mfg. Co., 191 Fed. 350.

\*This is contrary to the rule stated in "Double Patenting with Relation to Copending Applications," Journal of the Patent Office Society, November, 1926, Vol. 9, No. 3, Pg. III, in which the author states that in all cases the generic patent should be either the first filed or the first issued in order to be patentable over a copending, prior specific patent.

cies of the generic invention are issued concurrently, the general rule is that all of the patents are valid and none of the patents can be held to anticipate any of the other patents<sup>45</sup>. In fact, this rule has also been adopted in cases where the inventions do not bear the relation of genus and species<sup>46</sup>, although a number of cases seem to hold otherwise<sup>47</sup>.

In *Underwood v. Gerber*, 149 U. S. 224, the lower numbered of two successively numbered patents covered a composition of matter and the higher number patent covered the same composition as applied to paper. The claims in the separate patents were in effect for an inseparable method and article, and the higher numbered was declared invalid. This case is the basis for the rule stated in a number of subsequent cases, that of two patents issued on the same day, the lower in number is prior art as to the other. For example, in *Writing Machine Co. v. Hatch Book-Typewriting Co.*, 106 Fed. 507, it is stated that:

“Where two patents issued on the same date on applications filed on different dates, the patent having the lower number and which was granted on the earlier application was held to be the ‘earlier’ and a part of the prior art, with reference to the latter.”

In *Harvey Hubbell, Inc. v. General Electric Co.*, 267 Fed. 564, it was held that of two patents dated the same day, there is a rebuttable presumption that the earlier patent in number is the earlier in publication. However, the bills were dismissed in that case on the

<sup>45</sup> *Badische Anilin & Soda Fabrik v. A. Klipstein & Co. et al*, 125 Fed. 543; *Manhattan General Const. Co. v. Helios Upton Co.*, 135 Fed. 785; *Deister Concentrator Co. v. Deister Mach. Co.*, 263 Fed. 706; *Sandy McGregor Co., v. Vaco Grip Co.*, 2 F. (2d) 655.

<sup>46</sup> *Weston Electrical Instrument Co. v. Empire Electrical Instrument Co.*, 131 Fed. 494; *Theroz Co. v. United States Industrial Chemical Co.*, 14 F. (2d) 629.

<sup>47</sup> *Underwood v. Gerber*, 149 U. S. 224; *Wilcox & Gibbs Sewing Mach. Co. v. Merrow Mach. Co. et al*, 93 Fed. 206; *Writing Machine Co. v. Elliot & Hatch Book-Typewriting Co.*, 106 Fed. 507; *Crown Cork & Seal Co. of Baltimore v. Standard Stopper Co.*, 136 Fed. 841; *Harvey Hubbell, Inc. v. General Electric Co.*, 267 Fed. 564.

ground of non-infringement and the later patent was not declared invalid.

After stating the rule that the Patent Office would allow only one species to be claimed in a single application, the court, in *Badische Anilin & Soda Fabrik v. A. Klipstein & Co. et al*, 125 Fed. 543, said:

"It would be a failure of justice if the patentee of a meritorious invention should be deprived of the fruits of his labors because an arbitrary rule of the Patent Office has brought about complications not contemplated, if authority can be found for securing it to him."

It would seem that the better rule is as stated above, namely, that when generic and specific patents are issued simultaneously they are all valid, and this view is very ably sustained by the following quotation from the decision rendered in *Sandy MacGregor Co. v. Vaco Grip Co.*, 2 F (2d) 655,:

"Nor do we understand how, save for some arbitrary purpose and by arbitrary rule, there can be any priority of grant or of publications as between two patents issued to the same patentee on the same day.—The issue clerk might and probably would recognize the request of the patentee as to priority in number between two patents on the same day; but, lacking such request and compliance, the result would depend upon which one the clerk happened to pick up first out of the several hundred issuing on that day."

One question relating to patents containing generic and specific claims upon which there appears to be a conflict of authority, is that of the right of the public to the invention covered by an expired specific patent which is dominated by an unexpired generic patent to the same patentee.

In *Thomas-Houston Electric Co. v. Ill. Telephone Const. Co. et al*, 143 Fed. 534, a motion for a preliminary injunction was denied on the ground that the alleged infringing device was made under an expired patent to the same patentee which the public was free to use, and also on the ground of *estoppel*. The court in that case said:

"On the expiration of a patent for a combination, the use of such combination becomes free to the public, notwithstanding the fact that it contains as one of its elements a device covered by another patent to the same patentee which has not expired."

This case was affirmed in 152 Fed. 532 on the ground of *estoppel* or implied license alone.

On the other hand, *Thomas-Houston Electric Co. v. Ohio Brass Co.*, 80 Fed. 712, holds by way of *dictum* that the public is not entitled to the subject matter of an expired specific patent until the expiration of the generic one, while *Electric Storage Battery Co. v. Buffalo Electric Carriage Co.*, 120 Fed. 672, holds directly that the expiration of either earlier specific or improvement patents does not affect the validity of later generic patents.

The case of *Waterbury Buckle Co. v. G. E. Prentice Mfg. Co.*, *supra*, while not directly in point, is closely related to the point in question. It is held in that case that:

"Where a patent limited to a specific form of suspender buckle was issued to one inventor, and later another patent of a more general nature, which overshadows the first, was issued to another inventor, and both patents were assigned to the same corporation, expiration of the first patent does not give the public the right to manufacture the buckle devised by the first patentee."

Similarly, the case of *Schute v. Hildreth*, 8 F. (2d) 131, holds that a later patent for a machine is not void in view of a prior patent for a method which is capable of being carried out by other machines and although the process patent had expired the defendants were not entitled to use the machine, which constituted only one of the mechanical means for carrying out the process.

Another interesting case closely related to the subject of double patenting is that of *Keystone Trading Co. v. Zapota Mfg. Co. et al.*, 210 Fed. 180, in which it is held that:

"Rev. St. Sec. 4918<sup>48</sup>, which provides that whenever there are interfering patents any person interested in any of them may maintain a suit in equity in which either of the patents may be adjudged void or other appropriate relief granted, applies to a case where there is a claimed interference between patents granted to the same inventor, although on a finding of interference the later patent becomes *ipso facto* void."

### SUMMARY

From the foregoing discussion the following general rules concerning the question of double patenting in copending applications may be deduced. Where one patent claims an article and a second and later patent claims a method of making the article, both patents are valid, unless the method claimed in the later patent cover is merely the necessary or only one known for making the article. Where two patents are granted on copending applications, one of which claims an article and the other a machine for making the article, they are both valid, unless the article is necessarily made by the machine. A subsequent patent for a method is not invalidated by a prior patent for a machine which is capable of performing the method, unless the method cannot be practiced except by such machine. An inventor cannot sustain a subsequent patent for an essential element of an invention secured by a former patent without which that invention would not be patentable. It would seem that a rule similar to the one just stated would apply to patents defining a method and essential steps in the method, although no cases were found which decided this point. Where an inventor devises a patentable article which aside from its utility has appeal to the aesthetic senses, it seems that both a mechanical patent and a design patent may be granted when the applications therefor are copending. While a generic patent should issue either before or simultaneously with a patent for a species of the generic invention, a later generic patent is not void provided it was filed before the filing of the

<sup>48</sup> U. S. Revised Statutes, Title LX, Sec. 4918.



specific patent and the patentee was not guilty of laches or bad faith in delaying the issuance of the generic patent. When the generic and specific patents are copending, but the generic is filed last and issued last, the courts appear to be in conflict, but the correct rule to be applied in this case is believed to be the same as the one just given where the generic case was filed first, but issued last, namely, that the generic patent is valid provided the patentee was guilty of no bad faith and was diligent in prosecuting the application for the generic patent.

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