



1958

## What Is Prior Art

Virgil E. Woodcock

Follow this and additional works at: <https://digitalcommons.law.villanova.edu/vlr>



Part of the [Intellectual Property Law Commons](#)

---

### Recommended Citation

Virgil E. Woodcock, *What Is Prior Art*, 3 Vill. L. Rev. 255 (1958).

Available at: <https://digitalcommons.law.villanova.edu/vlr/vol3/iss3/1>

This Article is brought to you for free and open access by Villanova University Charles Widger School of Law Digital Repository. It has been accepted for inclusion in Villanova Law Review by an authorized editor of Villanova University Charles Widger School of Law Digital Repository.

# Villanova Law Review

VOLUME 3

APRIL, 1958

NUMBER 3

## WHAT IS PRIOR ART?\*

VIRGIL E. WOODCOCK †

AS LONG AGO as 1890, Professor William C. Robinson emphasized that the first step in any investigation of the principles and rules of Patent Law, as well as the only guide to their understanding, is a clear comprehension of the necessary attributes of an invention.<sup>1</sup>

The first element of an invention is twofold: an original thought coupled with a plan for carrying it out. The idea conceived by the inventor is the result of his creative not his imitative faculties. Necessarily the inventor has originated an idea which is new to him. It does not matter whether he comes to perceive his new idea by accident, insight or patient experiment. But it must be conceived, it must be new. It must also include a plan or an outline of operative means or instrumentalities for carrying out the invention to achieve a useful or practical result.

The second element is reduction to practice. That which has been conceived must be made operative and useful. It must be brought to the point where, if put in the hands of the public, it is ready for immediate use for its intended purpose. "A written description of the proposed invention, even when so fully illustrated by drawings that any person skilled in the art could carry out the ideas of the inventor is not sufficient . . ." <sup>2</sup> to qualify as a reduction to practice.

The statutory classes of patentable inventions are set forth in section 101 of title 35 of the United States Code. If an invention falls within one of the statutory classes, the inventor will be entitled to a

---

\* A Paper presented at the Patent Law Seminar held at Villanova University School of Law, November 4, 1957.

† Member of the Philadelphia Bar; Admitted to Practice before the United States Patent Office; Partner in the Firm of Woodcock and Phelan, Philadelphia, Pa.

1. THE LAW OF PATENTS FOR USEFUL INVENTIONS 114 (1890).  
2. *Id* at 181.

patent if he can meet the "conditions for patentability" set forth in sections 102 and 103 of title 35. The grant of a patent and the validity of a patent are, under the 1952 Patent Act,<sup>3</sup> subject to the same "conditions for patentability."

Under section 282 the second defense to a suit alleging infringement of a patent is: "Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability."<sup>4</sup>

It is the purpose of this paper to investigate these statutory conditions for patentability in so far as they relate to the problem of prior art.

Should the attributes of an invention discussed by Professor Robinson be applied to the determination of prior invention as a defense in an infringement suit? Should there be a clear conception of the inventor's new idea together with instrumentalities for reducing it to practice in a prior disclosure urged as anticipatory? Must the prior art have been reduced to practice for its disclosure to be anticipatory? In answering these questions we shall first consider section 102(g) since it deals with prior inventions of another.

## I.

### PRIOR INVENTIONS OF ANOTHER.

"Section 102.

A person shall be entitled to a patent unless—

. . . .

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other."

Party *A* is sued for infringement of a patent. He learns that *B* conceived the invention ten years before, and had reduced it to practice four years before the patentee's date of invention of the claimed subject

3. All citations to the Patent Act of 1952 will be given by reference to 35 U.S.C. (1952). By the Patent Act of 1952, 66 STAT. 792, Title 35 was revised, codified and enacted into positive law.

4. Part II of Title 35 consists of sections 100 through 188. The reference back to the "conditions for patentability" in part II of Title 35 is new in the Patent Act of 1952. The earlier law, REV. STAT. § 4920 (1875), listed five defenses to a suit alleging infringement. The last four were concerned with the conditions now set forth in section 102.

matter in suit. Can *A* use *B*'s conception and reduction to practice to defeat the infringement suit?

The answer appears to be in the affirmative. The defense is adequate. As long ago as 1870, in *Seymour v. Osborne*,<sup>5</sup> the Supreme Court considered and analyzed evidence of prior invention against one of the patents in suit with respect to which the invention date was established as early in 1849. The evidence established that the alleged earlier inventor had, indeed, built a machine in the autumn of 1848, subsequent to the close of the harvest season. The testimony did not show that such machine had ever been used for cutting grain during that harvesting season. The next year the machine was returned to the shop of the maker where it remained for sometime. Eventually it was broken on his order, and was never restored until long subsequent to the complainant's patent.

The Court fully considered the defense and held that an inventor must have proceeded so far as to have reduced his idea to practice and embodied it in some distinct form, if it is to anticipate a later "completed invention."

A few years later, 1874, it was argued in *Coffin v. Ogden*,<sup>6</sup> that the law was quite well settled in this country and in England to the effect that to defeat a patent, the prior invention ". . . must have been completed, reduced to practical form and communicated to the public, or something else must have been done with it, giving reliable assurance that the public would have received the benefit of it from such prior invention." It was further argued that anything short of such requirement would be in conflict with the policy, purpose and principles of the patent system.

The facts in *Coffin v. Ogden* were as follows: Kirkham, the patentee, established the completion of his invention (a lock) in March 1861. The defendant brought forth evidence that one Erbe had made his invention not later than January 1, 1861. The principal witness testified that before the first of January, 1861, he visited Erbe at his house and was there shown a lock and how it worked. He described how the lock could be taken apart and said he had never before seen a reversible lock. He testified that the one he then examined was the same in construction as the exhibit lock introduced by the defense. Erbe had shown the witness the lock twice afterwards, and while he saw such a lock attached to the door at Jones, Wallingford Co., he could not testify as to when he had seen it, or whether it was the first or some later lock that had been made for that purpose. Erbe made a

---

5. 78 U.S. (11 Wall.) 33 (1871).

6. 85 U.S. (18 Wall.) 821, 822 (1874).

total of three locks, and the witnesses who had examined them testified as to their construction. The first of these he gave to Jones, Wallingford Co. The second, he sent to Washington when he applied for a patent. The third, he made for a friend of Jones. The record does not disclose why Erbe did not obtain a patent.

The Court, in speaking of the defendant, said:

“The burden of proof rests upon him, and every reasonable doubt should be resolved against him. If the thing were embryotic or inchoate; if it rested in speculation or experiment; if the process pursued for its development had failed to reach the point of consummation,—it cannot avail to defeat a patent founded upon a discovery or invention which was completed; while in the other case there was only progress, however near that progress may have approximated to the end in view. The law required, not conjecture but certainty. If the question relate to a machine, as thus exhibited, the conception must have been clothed in substantial forms which demonstrate at once its practical efficacy and utility. *Reed v. Cutter*, 1 Story 590. The prior knowledge and use by a single person is sufficient. The number is immaterial. *Bedford v. Hunt*, 1 Mas. 302. Until his work is done, the inventor has given nothing to the public.”<sup>7</sup>

The Court then held:

“Here it is abundantly proved that the lock originally made by Erbe ‘was complete and capable of working.’ The priority of Erbe’s invention is clearly shown.”<sup>8</sup>

An invention, earlier conceived by another who was using reasonable diligence<sup>9</sup> from a time prior to conception by the patentee, if pleaded and proved, will represent a complete defense to a suit for infringement.<sup>10</sup>

If, after conception and reduction to practice, the inventor does nothing further with his invention, but puts it aside for a period of

7. *Id.* at 823.

8. *Id.* at 824.

9. It is interesting to note that Captain George H. Robillard, representing the Department of Defense, appeared at the hearings and urged the amendment of subsection (g) of section 102 to add to the exercise of diligence the “putting of the invention into use or in otherwise making knowledge thereof available to the public.” Captain Robillard said:

“This subsection as now written in the Bill could be interpreted to constitute a secret reduction to practice in anticipation of an issued patent. This interpretation is contrary to existing law, and is not approved by the Department of Defense.”

10. Under section 102(g) consider the following fact situation: Defendant finds that in the Virgin Islands *B* has conceived and reduced an invention to practice. Does that qualify as an invention made in this country? There is no doubt that it does, since section 100(c) provides: “The terms ‘United States’ and ‘this country’ mean the United States of America, its territories and possessions.”

ten years, can a defendant later resurrect that work and successfully establish invention prior to the plaintiff's?

In *Mason v. Hepburn*,<sup>11</sup> Mason had conceived and reduced to practice a clip for a magazine type of firearm. From the date of his reduction to practice in 1887 until 1894, a period of seven years, he did nothing with his invention. In 1894 he learned that Hepburn had been granted a patent for the same invention. Thereupon, Mason filed an application for letters patent and requested an interference. It was held that Mason could not prevail because he had suppressed the invention *until spurred into activity by his adversary*, who, of course, was diligent, and had proceeded without any knowledge of what Mason had done. Since *Mason v. Hepburn*, proof of inducement into activity has become important in rebutting the defense of prior invention.

There is considerable doubt that suppression will be presumed from a mere lapse of time between reduction to practice and the filing of the application.

The discussion of section 102(g) may be concluded with a brief reference to the requirement of "reasonable diligence." The Practice Manual,<sup>12</sup> paragraph 715.07(a) headed "Diligence" emphasizes that:

"In patent law, an inventor is either diligent at a given time or he is not diligent; there are no degrees of diligence. A man may be diligent within the meaning of the patent law when he is doing nothing, if the lack of activity is excused."<sup>13</sup>

## II.

### PRIOR KNOWLEDGE AND USE.

"Section 102.

A person shall be entitled to a patent unless—

. . .

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent. . . ."

---

11. 1898 Com. Dec. Pat. 510.

12. A manual of practice before the United States Patent Office.

13. With thousands of persons in the service of the United States located in all parts of the world, it is worth mentioning that section 104 gives to all persons, civil and military, if domiciled in the United States and serving in a foreign country in connection with operations by or on behalf of the United States, the same rights of priority with respect to the inventions as if the same had been made in the United States.

Are "the same rights of priority" limited only to those cases in which the inventor is seeking to obtain a patent? Or is his earlier date of invention available as a defense against a later inventor who has a patent? The question does not appear to have been decided.

As to the above section, the revision notes say:

“The interpretation by the courts of paragraph (a) as being more restricted than the actual language would suggest (for example, ‘known’ has been held to mean ‘publicly known’) is recognized, but no change in the language is made at this time.”<sup>14</sup>

It has long been established that “prior knowledge or use” must be accessible to the public.<sup>15</sup>

In *Pennock v. Dialogue*,<sup>16</sup> a suit for infringement, the plaintiff's invention had been completed in 1811. Application for the letters patent was not made until seven years later, in 1818. During the seven year period, some 13,000 feet of hose had been constructed according to the invention of the patentees and had been made and sold in Philadelphia, some of it as early as 1811. The manufacture and sale was with the permission of the patentees.

This case was decided under the act of 1793, which then required that the invention must *not* have been “known or used before the application.”

That act also included the defense “. . . that the thing thus secured by patent was not originally discovered by the patentee, but had been in use, or had been described in some public work, anterior to the supposed discovery of the patentee.”<sup>17</sup>

Mr. Justice Story, in stating the opinion of the Court, said:

“It has not been, and indeed cannot be, denied that an inventor may abandon his invention and surrender or dedicate it to the public. This inchoate right, thus once gone, cannot afterward be resumed at his pleasure; for, where gifts are once made to the public in this way, they become absolute.”<sup>18</sup>

In considering the words “not known or used before the application,” Mr. Justice Story observed:

“They cannot mean that the thing invented was not known or used before the application by the inventor himself. . . . The use, as well as the knowledge of his invention, must be indispensable, to enable him to ascertain its competency to the end proposed, as well as to perfect its component parts.”<sup>19</sup>

14. 35 U.S.C. § 102 n. (1952).

15. *Gayler v. Wilder*, 51 U.S. (10 How.) 477 (1850). In *Evans v. Eaton*, 27 U.S. (3 Wheat.) 1 (1829), Chief Justice Marshall dealt with the question whether a prior use had to be with knowledge of the patentee. The answer was in the negative.

16. 27 U.S. (2 Pet.) 1 (1829).

17. *Id.* at 17.

18. *Id.* at 16.

19. *Id.* at 18.

He then observed,

“The words, then, to have any rational interpretation, must mean, not known or used by others before the application. But how known or used? If it were necessary, as it well might be, to employ others to assist in the original structure or use by the inventor himself; or if before his application for a patent his invention should be pirated by another, or used without his consent; it can scarcely be supposed that the legislature had within its contemplation such knowledge or use.

“We think, then, the true meaning must be, not known or used by the public before the application.”<sup>20</sup>

Later in the case the Court sums up its views as to the patent right:

“[The statute] gives the right to the *first* and true inventor, and to him only; if known or used before his supposed discovery he is not the *first*, although he may be a *true* inventor, and that is the case to which the clause looks. But it is not inconsistent with this doctrine, that although he is the *first*, as well as the *true* inventor, yet if he shall put it into public use, or sell it for public use before he applies for a patent, that this should furnish another bar to his claim. In this view an interpretation is given to every clause of the statute without introducing any inconsistency, or interfering with the ordinary meaning of its language. No public policy is overlooked; and no injury can ordinarily occur to the first inventor, which is not in some sort the result of his own laches or voluntary inaction.”<sup>21</sup> (Emphasis supplied.)

Another of the leading cases is *Gayler v. Wilder*,<sup>22</sup> decided in 1850. In 1830, Fitzgerald completed his invention. The application was filed in 1836 and the patent issued June 4, 1843. The invention involved a

20. *Id.* at 18-19.

21. *Id.* at 23.

It is in this case that there appears the famous quotation:

“While one great object [of the patent system] was, by holding out a reasonable reward to inventors, and giving them an exclusive right to their inventions for a limited period, to stimulate the efforts of genius; the main object was to ‘promote the progress of science and useful arts;’ and this could be done best by giving the public at large a right to make, construct, use, and vend the thing invented, at as early a period as possible; having a due regard to the rights of the inventor. If an inventor should be permitted to hold back from the knowledge of the public the secrets of his invention; if he should for a long period of years retain the monopoly, and make, and sell his invention publicly, and thus gather the whole profits of it, relying upon his superior skill and knowledge of the structure; and then, and then only, when the danger of competition should force him to secure the exclusive right, he should be allowed to take out a patent, and thus exclude the public from any further use than what should be derived under it during his fourteen years; it would materially retard the progress of science and the useful arts, and give a premium to those who should be least prompt to communicate their discoveries.” *Id.* at 19.

22. 51 U.S. (10 How.) 477 (1850).



so-called Salamander safe used to protect books, and the like, from fire and comprised concentric boxes with a three inch plaster of Paris fire-wall between them. The defense pleaded prior invention and prior use in the suit for infringement. The facts in support of the defense, in brief, were as follows:

Between 1829 and 1832, James Conner had built a safe of double-chest construction. The intermediate space was filled with plaster of Paris. It was substantially the same as Fitzgerald's invention, but there was no plaster of Paris on the top of the safe. Conner made the safe for his private use and used it in the counting room of his foundry until 1838. It then passed into other hands. The evidence was corroborated by Conner's brother, who fixed the time as between 1831 and 1832. Only one safe was made by Conner.

There was no evidence in the case that the mode of construction was known to the person into whose hands the safe fell, and there was no evidence that any value was attached to it as a place of security for papers against fire, or that it had ever been used for that purpose.

At the trial, the court had instructed the jury:

“. . . that if Conner had *not* made his discovery public, but had used it simply for his own private purpose, and it had been finally forgotten or abandoned, such a discovery and use would be no obstacle to the taking out of a patent by Fitzgerald, or those claiming under him, if he be an original, though not the first, inventor or discoverer of the improvement.”<sup>23</sup>

Important in the foregoing quotation is the query: Had Conner finally forgotten or abandoned his invention? Chief Justice Taney, speaking for the Court, pointed out that it was very clear under the United States Patent Law of 1836 that the patentee does not always have to be the original and first inventor or discoverer.

Similar exceptions apply today. It is clear from section 102(a) that prior knowledge or public use in a foreign country is no bar or defense against a patentee who, when he filed his application, in fact believed himself to be the original inventor or discoverer.

Referring now to the date of completion of invention by the patentee, Chief Justice Taney said:

“If the foreign invention had been printed or patented, it was already given to the world and open to the people of this country, as well as of others, upon reasonable inquiry. They would there-

---

23. *Id.* at 485.

fore derive no advantage from the invention here. It would confer no benefit upon the community, and the inventor therefore is not considered to be entitled to the reward. But if the foreign discovery is not patented, nor described in any printed publication it might be known and used in remote places for ages, and the people of this country be unable to profit by it. The means of obtaining knowledge would not be within their reach; and, as far as their interest is concerned, it would be the same thing as if the improvement had never been discovered.”<sup>24</sup>

He then concludes that Fitzgerald must be regarded as the first and original inventor of the safe in question upon the following grounds:

“[a] Conner’s safe had been kept and used for years, yet no test had been applied to it, and its capacity for resisting heat was not known;

[b] there was no evidence to show that any particular value was attached to it after it passed from his possession . . .

[c] [there was no evidence to show] that it was ever afterward used as a place of security for papers; and

[d] it appeared that he himself did not attempt to make another like the one he is supposed to have invented, but used a different one. And upon this state of the evidence the court put it to the jury to say, whether this safe had been finally forgotten or abandoned before Fitzgerald’s invention, and whether he was the original inventor of the safe for which he obtained the patent.  
 . . . ”<sup>25</sup>

From the foregoing it seems clear that the basis of the decision was Conner’s abandonment of his invention.<sup>26</sup>

In strong dissents, it was urged that Conner was the prior inventor, the use of his safe in his business was a public use, at least one to

24. *Id.* at 497.

25. *Id.* at 497-98.

26. The Chief Justice stated it this way:

“For if the Conner safe had passed away from the memory of Conner himself, and of those who had seen it, and the safe itself had disappeared, the knowledge of the improvement was as completely lost as if it had never been discovered. The public could derive no benefit from it until it was discovered by another inventor. And if Fitzgerald made his discovery by his own efforts, without any knowledge of Conner’s, he invented an improvement that was then new, and at that time unknown; and it was not the less new and unknown because Conner’s safe was recalled to his memory by the success of Fitzgerald’s.” *Id.* at 498.

The discussion of this case may be concluded with one more quotation:

“We do not understand the Circuit Court to have said that the omission of Conner to try the value of his safe by proper tests would deprive it of its priority; nor his omission to bring it into public use. He might have omitted both, and also abandoned its use, and been ignorant of the extent of its value; yet, if it was the same with Fitzgerald’s, the latter would not upon such grounds be entitled to a patent, provided Conner’s safe and its mode of construction were still in the memory of Conner before they were recalled by Fitzgerald’s patent.” *Ibid.*

which the public had access, and that the period of time within which Conner was assumed to have forgotten entirely about the construction of the safe was too short to have any basis in reason or fact.

The case of *Westinghouse Machine Co. v. General Electric Co.*,<sup>27</sup> throws some additional light upon the language used in section 102(a). The facts were as follows: De Kando had reduced his invention to practice in Italy early in 1905. In March of that year, a Mr. Waterman visited him at Budapest, had the invention explained to him by De Kando, received the full written description of the invention, and later saw the same in operation in Italy. On May 5, Waterman brought into the United States the written description, and his own notes of the invention. On June 7, Waterman disclosed the De Kando invention to Stillwell, and on June 19, 1905, he delivered a paper before a meeting of the American Institute of Electrical Engineers describing the invention in full. De Kando filed his patent application on July 3, 1906, after issuance of a patent to Armstrong on February 6, 1906, on an application filed June 28, 1905. Armstrong apparently relied upon his filing date of June 28, 1905. The case came on to the second circuit and presented the question: "Who is the first inventor?"

Under section 104 of the 1952 act, it is, of course, provided that:

"[A]n applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country, except as provided in section 119 of this title."<sup>28</sup>

However, the appellant in the Westinghouse case proceeded upon the theory that Armstrong was not entitled to his patent by reason of the provision in section 4886 that the invention was "known . . . in this country before his invention or discovery thereof."

We can decide the case at once, if we assume that the requirement of section 4886 (and of the 1952 act) is that there be not only a conception but also a reduction to practice in order for the invention to be "known . . . in this country" to qualify as a bar to the issuance of the patent, or to qualify as a valid defense in a suit for infringement. Perhaps the court had that in mind when it said:

"As we construe this section, [4923] reduction to practice in a foreign country can never operate to destroy a patent applied for here, however widely known such reduction to practice may be,

27. 207 Fed. 75 (2d Cir. 1913).

28. Section 119 has reference to the International Convention for the Protection of Industrial Property. 35 U.S.C. § 119, n. (1952).

either among foreigners or among persons living here, unless the invention be patented or described in a printed publication. To that extent section 4923 qualifies the language of section 4886, which without such qualification might well lead to a different result.”<sup>29</sup>

Thus Westinghouse failed in its contention that prior knowledge by De Kando was a bar to Armstrong.

The case of *Brush v. Condit*<sup>30</sup> involved Brush's reissue patent, No. 8,718, originally No. 203,411, filed September 28, 1877, dated May 7, 1879. The principal defense against the patent was involved in the following: One Hayes experimented with a lamp made by another, and to overcome defects added to it the clutch which was the subject matter of the Brush patent. Rough drawings were made in the middle or the latter part of May, 1876. The lamp was finished by the end of June and tested. It was used when needed from June until September 16, 1876. At that time in September, a man by the name of King changed the clutch to one which was not anticipatory of the Brush patent. The Hayes lamp was used in the shop which at the time was lighted by gas lamps and continued to be so lighted. However, the Hayes lamp was occasionally used in the evening as well as outside the shop when there was need of it. Other employees at the factory saw the lamp in operation.

Thus, there was presented to the court a single use of a single lamp for the short period of about two and one-half months. The question was whether that single lamp and that single use qualified as an anticipation of the Brush patent. The question was one of prior invention and not of statutory time-bar, for the reason that the use was not over two years before Brush filed.

The Court held that the Hayes lamp was a completed and perfected invention. The fact that no more of the lamps were made had

29. 207 Fed. at 78.

The court further commented:

“A machine is certainly knowable when its various component parts are brought together and, cooperating with each other, function successfully. De Kando's device was knowable in this sense when it was installed in Italy. It would become known to any competent person who examined it, saw what its component parts were and what function it performed. Waterman, upon the facts as found above, acquired that knowledge and he carried his knowledge with him wherever he went. When he was here he was a person in this country by whom the De Kando device was known. And when he imparted his knowledge to others here they also became persons in this country by whom the De Kando device was known.” *Id.* at 77-78.

No explanation appears in the case as to why De Kando delayed in filing his application from May 5, 1904 when Waterman brought the disclosure in the United States, until July 3, 1906.

The court did not discuss the spurring into activity which might well have occurred since De Kando filed, some five months after Armstrong's patent had issued.

30. 132 U.S. 39 (1889).

been argued as very significant. The Court believed that Hayes' employer, Wallace and Sons, not having a suitable generator for the lamp had adequate excuse for not pursuing commercial exploitation. As to the single use, the Court quoted with approval the lower court's opinion, which in part said:

"The case is that of the public, well-known, practical use, in ordinary work, with as much success as was reasonable to expect at that stage in the development of the mechanism belonging to electric arc lighting, of the exact invention which was subsequently made by the patentee. . . ." <sup>31</sup>

Keeping in mind that a written description of an invention which has not been published is merely evidence of conception, and that without a reduction to practice it will not be considered as evidence of completion of the invention, reference is made to the case of *Ex Parte Perley*,<sup>32</sup> decided by the Board of Appeals in 1946.

Perley and others had filed their parent application on July 18, 1940. Against it, the Examiner cited an article submitted to the Electrochemical Society on January 3, 1939. The article was presented before the Society in October 1940, and was published on October 7, 1940. There was some evidence in the case that members of the Electrochemical Society were familiar with the article as early as March 3, 1939. Clearly, the publication on October 7, 1940 was after the Perley filing date of July 18th.

May the Examiner properly refer to the earlier dates as evidence of prior invention, with the effect that to that extent they be effective against Perley?

The Board of Appeals ruled that the article having become known to members of the Society as early as March 3, 1939 was effective as of that date against the Perley application. Accordingly, an affidavit under Rule 131 would have had to establish an invention date prior to March 3, 1939. This decision represented an effort to extend the Milburn doctrine, which will be discussed later.<sup>33</sup>

The existence of a written description intended for publication thoroughly describing an invention and made available to the public thus acquired an effectiveness similar or equal to the constructive

31. *Id.* at 48.

32. 72 U.S.P.Q. 396 (1946).

33. See text at note 63.

The doctrine of the *Perley* case was reaffirmed by the Board of Appeals in *Ex Parte Appeal No. 16,138*, 31 J. PAT. OFF. SOC'Y 635 (1949) and in *Ex Parte Theimer*, 100 U.S.P.Q. 168 (1952). In *Ex Parte Speier*, 100 U.S.P.Q. 169 (1952), an effort was made to rationalize the decision under the doctrine of the *Milburn* case.

reduction to practice occurring by the filing of an allowable patent application in the United States Patent Office.

The case of *Corona Cord Tire Co. v. Davan Chemical Corp.*,<sup>34</sup> involved the question of the effect of the oral delivery of a paper before a society (between the second and sixth of September, 1919). Kratz' paper was not printed in the two years before Weiss' application for a patent. Kratz' paper was delivered before the society over two years before Weiss filed (November 12, 1921). The Supreme Court refused to hold the paper to be the equivalent of a prior patent or publication. The Court so held even though the applicant had not attacked it as insufficient as a reference under section 4886 of the Revised Statutes. Weiss established his invention by way of a completed experiment on February 10, 1919. The proof in behalf of Kratz was his completion of the invention for the shipment of one thousand inner tubes as early as August 1917. There was no further commercial use of the Kratz discovery.

In *Ex parte Lorand*<sup>35</sup> the Board of Appeals began to see some difficulties. The applicant filed letters stating that the publishers, after a period of a year, destroyed the manuscripts. Additionally, the author of the article refused to reply to a letter asking if he would swear the original manuscript was identical with the published article. With these differences the board held the prima facie effect of the published date (July 31, 1950) of the receipt of the manuscript had been overcome. The later publication date of January 1951 was held to apply.

After this considerable digression, the Board of Appeals should now be back on the right track as a result of the recent decision by the Court of Customs and Patent Appeals in *Application of Schlittler*.<sup>36</sup>

In that case the applicants had filed in Switzerland on May 21, 1948, and in the United States on May 9, 1949. Does an article published in November, 1948, but carrying the notation "Received April 30, 1948" represent prima facie evidence of knowledge by others in this country ahead of the applicants' invention?

In the Patent Office seven members of the Board of Appeals answered in the affirmative while two dissented. The Court of Customs and Patent Appeals rephrased the question to be decided: "Whether the Nystrom article, regardless of the date received, constitutes sufficient evidence of prior knowledge or use of the claimed invention by others in this country within the meaning of 35 U.S.C. § 102(a)?"<sup>37</sup>

---

34. 276 U.S. 358 (1928).

35. 107 U.S.P.Q. 304 (1955).

36. 43 C.C.P.A. (Patents)—, 234 F.2d 882 (1956).

37. *Id.* at 884.

The court answered in the negative expressly rejecting the asserted extension of the *Milburn* doctrine.<sup>38</sup>

To qualify under Section 102(a) there must be some evidence of a reduction to practice. A manuscript intended for publication does not constitute a reduction to practice.<sup>39</sup> More is required than knowledge of a prior conception. Therefore the manuscript does not qualify under section 102(a) since it is evidence of conception only and not of a reduction to practice.<sup>40</sup>

In *Rem-Cru Titanium v. Watson*<sup>41</sup> the Patent Office pleaded that a report prepared by the Battelle Memorial Institute and transmitted to the Wright Patterson Air Force Base on September 23, 1949, was effective as of that date to evidence prior knowledge by others. The applicant, Vordabl, had filed December 10, 1949. The Battelle report was not available to the public until several years later. The Court, relying upon the *Schlittler* case, held the report to be ineffective as evidence of prior knowledge.

In an earlier case such reports had been held not to qualify as printed publications.<sup>42</sup>

### III.

#### PRIOR PATENTING.

Section 102 also states:

"A person shall be entitled to a patent unless—

(a) the invention was . . . patented . . . in this or a foreign country, before the invention thereof by the applicant for patent. . . ."

There is much literature on the subject of when a patent is effective as such and not as a publication. The exact date of patenting is sometimes quite important, since that date may be earlier than the publication date. Where publication first occurs, reliance is placed upon the patent as a printed publication instead of as a patent per se. In some countries, patents are not printed, and hence the date the patent becomes effective as such is of primary importance.

To be a bar, the prior patent must be accessible to the public in the country in which granted: it need not be printed, if enrolled and sealed. Once the patent has been enrolled and sealed, it matters not

38. See text at note 63.

39. *Kear v. Roder*, 28 C.C.P.A. (Patents) 774, 115 F.2d 810 (1940).

40. *Stearns v. Tinker & Rasor*, 220 F.2d 49 (9th Cir. 1955).

41. 152 F. Supp. 282 (D.D.C. 1957).

42. *Ex Parte Harris*, 79 U.S.P.Q. 439 (Comm'r of Patents 1948).

that it is later declared invalid or is allowed to expire because of failure to pay taxes and the like.<sup>43</sup>

The British provisional specification was held to be a publication as long ago as 1876, in the case of *Cohn v. United States Corset Co.*<sup>44</sup> The United States patent had been filed April 15, 1873. There was in the United States Patent Office a British provisional specification received in the United States Patent Office January 20, 1854.

By this time, one would suppose the law would be fixed as to whether or not the Gebrauchsmuster<sup>45</sup> is effective as a patent. Stringham argues that it should be, and a number of cases are cited to indicate that it has been so used. But in *Ex parte Smith*,<sup>46</sup> decided by the Board of Appeals in 1941, it was held that Gebrauchsmusters are not patents within the meaning of the statutes.

Where the foreign patent has not been published and hence does not qualify as a printed publication, there is authority that the foreign patent must claim the same invention in order to be anticipatory.<sup>47</sup>

#### IV.

##### PRIOR DESCRIPTION IN A PRINTED PUBLICATION.

Section 102(a) further provides that if the invention has been described in a printed publication in this or a foreign country before the invention thereof by the applicant for patent, a patent will not be granted. Under this language no proof of a reduction to practice is required.

In how much detail must the invention be described? Remembering the elements of an invention, there must be a disclosure of the

43. In many countries, such as Austria, Czechoslovakia, Great Britain, Hungary and Switzerland, the date upon which the patent is enrolled and sealed does not appear on the face of the patent itself. In Great Britain, publication is generally completed within two or three weeks of the date of acceptance of the complete specification. The sealing takes place at a later date, depending upon oppositions, extensions, etc. In order to ascertain the sealing date, it is necessary to go through the Official Journal of Patents. The letter "S" preceding the patent number indicates that it was sealed on the date there given. Sealing generally takes place about two or three months after the acceptance date appearing on the patent.

For more detailed information, reference may be had to the Manual of Patent Examining Procedure, Paragraphs 901.04 and following, and to the Manual of Foreign Patents by Belknap Severance, published in 1935 by the Patent Office Society.

44. 93 U.S. 366 (1876).

45. The Gebrauchsmuster is a hybrid patent according to United States standards. It is intended to cover design improvements falling short of an inventive advance required of utility patents.

46. 82 U.S.P.Q. 83 (1941). See also *Permutit Co. v. Graver Corp.*, 43 F.2d 898 (7th Cir. 1930), and cases cited therein. *But see* *American Casting Machine Co. v. Pittsburg Coal Washer Co.*, 237 Fed. 590 (3d Cir. 1916).

47. *American Tri-Ergon Corp. v. Paramount Publix Corp.*, 71 F.2d 153 (2d Cir. 1934); *General Electric Co. v. Alexander*, 280 Fed. 852 (2d Cir. 1922); *Carter Products Inc. v. Colgate-Palmolive Co.*, 130 F. Supp. 557 (D. Md. 1955); *Shimadzu v. Electric Storage Battery Co.*, 17 F. Supp. 42 (E.D. Pa. 1936).



same or an equivalent conception including operative instrumentalities for practicing the invention.

Since a prior reduction to practice is not required under section 102(a) should the requirements as to disclosure be strictly or liberally construed?

If the issuance of patents is to be encouraged, the tests as to adequacy of disclosure should be as severe for the printed publication as for the proofs of conception and reduction to practice. If the issuance of patents is to be discouraged, the requirements of the description in the printed publication should be relaxed.

If the description is of an operative means understandable as such by one skilled in the art to which it pertains, it should be accepted as adequate. This principle also explains why textbooks are so seldom anticipatory. Textbooks discussing abstract laws are tools for designing operative instrumentalities. These tools are not anticipatory of such instrumentalities.

May a drawing alone meet the requirements of a "description"? Andrew R. Benson, in a Patent Office Paper delivered on November 2, 1916 entitled "Scope of the Phrase Described in a Printed Publication"<sup>48</sup> points out that the word "described" does not mean a narrative, necessarily, but is broad; *i.e.* ". . . to represent by drawing; to draw a plan of; to delineate; to trace or mark out; (2) to represent by words written or spoken; to give an account of; to make known to others by words or signs."

Much controversy would have been avoided in some of the cases if closer attention had been given to the foregoing definitions.

Benson says the word "printed" may be defined: "(1) To fix or impress; (2) To stamp something in or upon; to make an impression or mark by pressure; (3) To strike off an impression from a set of type or the like; (4) To take a copy from a negative by the action of light upon a sensitized surface."<sup>49</sup> These definitions, of course, show that the term "printed" has a much broader meaning than the popular concept.<sup>50</sup>

In 1916 Benson raised the question as to publications in Braille as meeting the requirement of "printed" and also of phonograph records. There still remains open the question whether a phonographic recording would come within the definition and within the words, "described in a printed publication."

---

48. P. 4.

49. P. 10.

50. See, *Ex Parte Boende*, 105 U.S.P.Q. 453 (1955).

We now come to the meaning of the word "publication." An early case on the subject is *Cottier v. Stimson*<sup>51</sup> where the court said:

"[S]omething besides printing is required. The statute goes upon the theory that the work has been made accessible to the public, and that the invention has been thereby given to the public, and is no longer patentable by any one. *Publication means put into general circulation* or on sale, where the work is accessible to the public. See *Reeves v. Keystone Bridge Co.*, 5 Fisher 467." (Emphasis supplied.)

The quotation is now a classic. The facts are also of interest because the quotation is pure dictum. The "publication" in question was entitled "A Treatise on Ventilation", a book of 226 pages, reported to be the second edition of two courses of lectures delivered on the subject of ventilation by Lewis W. Leeds before the Franklin Institute of Philadelphia. The title page indicated that it was printed by John Wiley & Son, New York, 1871, who styled themselves as "publishers," but there was no other evidence in the case that the copy introduced in evidence was a work that was ever on sale or in circulation.

The court, after observing that it was not improbable that the work had been regularly published and in general circulation, pointed out the need for proof but did not feel too badly about it because: ". . . waiving this objection, the invention of Eastmond is neither described nor referred to in it."<sup>52</sup>

In past years, a number of decisions have held that catalogues and descriptive bulletins addressed to a limited or restricted part of the public do not come within the definition of printed publications. However, the more recent cases hold the contrary.<sup>53</sup>

If the dates are adequately established by competent evidence, books in English or in any other language are available as references; so are catalogues, circulars, published drawings with or without descriptive matter, and manuals of instruction.

Is a single copy of a thesis in a library a printed publication? A district court found little difficulty in holding that it was not within the statute. The Court of Appeals for the Sixth Circuit, in *Hamilton Laboratories, Inc. v. Massengill*,<sup>54</sup> reversed, stating:

"While perhaps not determinative of ultimate issues in the present case, the Weed thesis is in the prior art and marks a step in its development since it was put on file in the library of the

51. 20 Fed. 906, 910 (D. Ore. 1884).

52. *Ibid.*

53. *E.g.*, *Ex Parte Hallinan*, 86 U.S.P.Q. 47 (1948).

54. 111 F.2d 584, 585 (6th Cir. 1940).

college, available to students there, and to other libraries having exchange arrangements with Iowa State. . . . We think intent that the fruits of research be available to the public is determinative of publication under the statute whether the paper be printed or typewritten, although the court below decided otherwise.”

The date upon which the thesis is placed in the university library appears to be the date when it becomes available to the public. That will be its effective date as a “printed publication.”

The case of *Ex parte Hershberger*,<sup>55</sup> brought before the Board of Appeals a single manuscript-thesis deposited in a library with a notice prohibiting all or any part of it from being copied without the express consent of its author. The Board of Appeals ruled:

“A primary purpose of so placing the thesis on shelves was to make known the contents thereof to the general public, a condition to which the author must have at least tacitly agreed in offering the treatise to the University. He, therefore, did not and could not restrict the circulation of the thesis to a limited number of individuals. Hence no restriction appears to have been placed on the reading of the text. It was available to anyone to read who was interested therein. Potentially, therefore, the thesis had a wide field of circulation.”<sup>56</sup>

The board waived aside the effect of the restrictive notice in preserving the author’s property rights in the literary work as questions not before it:

“The sole question for our consideration is whether or not the ideas expressed in the thesis, in the form of a complete disclosure of an invention, are incorporated within a printed publication to satisfy the patent statute. In our opinion, the thesis with its disclosures is a printed publication within the meaning of the patent statutes.”<sup>57</sup>

The printed publication, regardless of the form, must be proved to have been published as of a given date. Any competent evidence will be admissible on this point, the usual and most easily obtained evidence being the date of receipt of the publication in a library. Should it not also include when it was available to readers?

In *Ex parte Carnehan*,<sup>58</sup> the question arose as to whether a magazine had an effective date as a publication when it was placed in the

---

55. 96 U.S.P.Q. 54 (1953).

56. *Id.* at 56.

57. *Ibid.*

58. 76 U.S.P.Q. 335 (1947).

mails, or whether that date was when the magazine was received. The Board of Appeals held that though the magazine had been printed sometime prior to February 12, 1940, in order for it to become available to readers all over the country, it had to be mailed, and though copies were placed in the mails on February 12, 1940, that date was *not* taken as the date of "publication." The Carnehan application was filed on February 13, 1941. The Board noted that all mail in transit is preserved in secrecy. Accordingly, the date that the magazine "Electronics" was received in the Patent Office, February 15, 1940, was the earliest date accorded to it.

In the case of *Ex parte Haller*,<sup>59</sup> the Examiner had rejected Haller on an Australian patent bearing the notation "Published October 9, 1947." Haller filed photostats from texts on practice in other countries to the effect that "published" in Australia does not mean "printed." The opening of the application to the public is, in Australia, deemed to be "published." The rejection was reversed.

The same rule applies to British provisional applications opened to the public. They must comprise a printed publication to qualify under Section 102(a). A manuscript or typewritten British provisional application is not a part of the prior art because it is not a printed publication. This is so even though it be open to inspection to the British Public. For contrast, a manuscript or typewritten document comprising a patent duly enrolled and sealed is a part of the prior art.

#### *Alien Property Custodian Publications.*

In 1943, applications vested in the Alien Property Custodian during World War II were published even though they had not become patents. The Patent Office Practice Manual, Paragraph 901.06 (c), sets forth the practice and instructs the Examiner to use such published applications only as a printed publication effective from the date of publication which is printed on each copy. However, before citing one of them, the Examiner must verify whether the application has become abandoned or patented. Of course, as soon as such an application issues as a patent, it then becomes effective as of the filing date, which, of course, will be earlier than, and perhaps much earlier than, the publication date. Thus, we have the anomaly of a shifting date for a publication. I have found no cases dealing with such published applications. In principle, it could well be argued that the *Milburn* case would make such publications effective as of the filing date.

---

59. 103 U.S.P.Q. 332 (1953).

*Abstracts of United States Applications.*

Under order of January 25, 1949,<sup>60</sup> provision was made for the publication of abstracts upon the request of the applicant. The abstracts contain a figure of the application drawing and a brief description of the subject matter. Again, the Practice Manual instructs the Examining Corps to use the publication of the abstract. However, in the Practice Manual, 711.06(f) this statement appears:

"If properly prepared, it should not be necessary to refer to the complete application file, but in any case in which material in the application file is used as a reference it should only be used as evidence of matters of public knowledge on the date of the publication of the abstract."

What has been said above with respect to the Alien Property Custodian publications, of course, applies here.

The practice of publishing abstracts was discontinued as of August 3, 1953.

*Manuals and Instruction Books issued as "Restricted," "Classified" or "Confidential".*

We are all familiar with the multitude of printed matter issued under World War II statutes allowing material to be classified as "Secret", "Confidential" or "Restricted." Is such printed matter acceptable as evidence of prior invention?

The Patent Office Manual of Practice, Paragraph 707.05(f) says that it is although it cannot be used for that purpose until it is declassified. The Manual says:

"For the purpose of anticipation predicated upon prior knowledge under 35 U.S.C. 102(a) the above noted declassified material may be taken as *prima facie* evidence of such prior knowledge as of its printing date even though such material was classified at that time. When so used the material does not constitute a statutory bar and its printing date may be antedated by an affidavit under Rule 131. (Notice of Feb. 24, 1947, revised)."

The Manual also says that the classified material becomes a printed publication after declassification and "when the material was made available to the public." This date, if not on the material, is to be determined by reference to the Office of Technical Services, Commerce Department.<sup>61</sup> Here is an illustration of a single document to which

60. 619 O.G.U.S. PAT. OFF. 258.

61. Ex Parte Harris, 79 U.S.P.Q. 439 (Comm'r of Patents 1948).

the Patent Office ascribes two effective dates. The printed matter is accepted as evidence of a completed invention as of its printing date, notwithstanding the document is then under such secrecy that disclosure to an inventor would put behind bars the person violating the secrecy order. So far as known, the position of the Patent Office has not been reviewed by any court.

Sometimes the subject matter of the printed material is the same as that of a pending application which is also placed under secrecy. As a consequence, no foreign applications may be filed until the subject matter is declassified. That event is beyond the control of the inventor. When he is notified that his application and the printed material have been declassified, the notice may have come too late to save certain of his rights to foreign patents. In some countries an application must be on file before publication anywhere in the world. Thus the inventor cannot file until the printed material is declassified. When it is, it is as of that moment too late to file in Italy and in the Netherlands, for example.<sup>62</sup>

## V.

### PRIOR FILING BY ANOTHER.

"Section 102.

A person shall be entitled to a patent unless—

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent . . . ."

The foregoing is stated as an enactment of the rule of *Milburn v. Davis-Bournonville*,<sup>63</sup> The rule can also be stated: A United States patent is effective as an anticipation from the time of its earliest effective filing date. It is interesting to note that the *Milburn* case was tried before Judge Learned Hand during the time he was a District Judge and was decided by him on January 8, 1934.<sup>64</sup>

The facts were as follows: The Whitford patent 1,028,410 was filed March 4, 1911, and issued June 4, 1912. The principal prior art relied upon was a Clifford patent 1,016,613, filed on January 31, 1911 (before Whitford's), and issued February 6, 1912.

Judge Learned Hand looked at Clifford's disclosure in this manner: Upon his disclosure he could have, indeed, written claims like those of Whitford. However, his claims were for different combinations and not like the claims of Whitford. Thus, he argued that in

62. The writer is indebted to Mr. E. D. Phinney of the I.T. & T. Co. for this point.

63. 270 U.S. 390 (1926).

64. 297 Fed. 846 (S.D.N.Y. 1924).

the absence of perception by Clifford of the particular combinations set forth by Whitford, there would not be anticipation. Judge Hand also went so far as to see whether he could find in the Clifford patent any purpose or object or intent that the combination claimed by Whitford was contemplated and disclosed by Clifford.

The case came on to the Supreme Court because of a conflict of decisions between the second and sixth circuits. Mr. Justice Holmes started with this presumption: "It is not disputed that this application (of Clifford's) gave a complete and adequate description of the thing patented to Whitford, but it did not claim it."<sup>65</sup> He also premised a conclusion upon the fourth defense under section 4886 of the Revised Statutes that the patentee must be the original and first inventor or discoverer, saying:

"Taking these words in their natural sense as they would be read by the common man, obviously one is not the first inventor if, as was the case here, somebody else has made a complete and adequate description of the thing claimed before the earliest moment to which the alleged inventor can carry his invention back."<sup>66</sup>

Immediately after stating the proposition so broadly, he modified it:

"In view of the gain to the public that the patent laws mean to secure we assume for the purposes of decision that it would have been no bar to Whitford's patent if Clifford had written out his prior description and kept it in his portfolio uncommunicated to any one."<sup>67</sup>

Coming now to more of the meat of his opinion:

"On the other hand, publication in a periodical is a bar. This as it seems to us is more than an arbitrary enactment and illustrates, as does the rule concerning previous public use, the principle that, subject to the exceptions mentioned, one really must be the first inventor in order to be entitled to a patent."<sup>68</sup>

The second circuit had conceded that if the Clifford patent had issued before the filing of the Whitford patent, it would have been a complete bar. With this premise, it was easy for Mr. Justice Holmes to say:

"The delays of the Patent Office ought not to cut down the effect of what has been done. The description shows that Whitford was not the first inventor. Clifford had done all that he could

---

65. 270 U.S. at 399.

66. *Id.* at 400.

67. *Ibid.*

68. *Ibid.*

do to make his description public. He had taken steps that would make it public as soon as the Patent Office did its work, although, of course, amendments might be required of him before the end could be reached. We see no reason in the words or policy of the law for allowing Whitford to profit by the delay and make himself out to be the first inventor when he was not so in fact, when Clifford had shown knowledge inconsistent with the allowance of Whitford's claim . . . and when otherwise the publication of his patent would abandon the thing described to the public unless it was already old. . . ." <sup>69</sup>

As to Judge Learned Hand's argument that the question was whether Clifford had shown himself to be an inventor of the subject matter, Mr. Justice Holmes said "No":

"The question is whether Clifford's disclosure made it impossible for Whitford to claim the invention at a later date. The disclosure would have had the same effect as at present if Clifford had added to his description a statement that he did not claim the thing described because he abandoned it or because he believed it to be old. It is not necessary to show who did invent the thing in order to show that Whitford did not." <sup>70</sup>

As to the argument which had been made, that a thing may not be constructively reduced to practice, unless claimed, the Court said:

"It is said that without a claim the thing described is not reduced to practice. But this seems to us to rest on a false theory helped out by the fiction that by a claim it is reduced to practice. A new application and a claim may be based on the original application within two years, and the original priority established notwithstanding intervening claims. . . . *A description that would bar a patent if printed in a periodical or in an issued patent is equally effective in an application as far as reduction to practice goes.*" (Emphasis supplied.) <sup>71</sup>

For reasons that will immediately appear relevant, the Court also said: "The policy of the statute as to foreign inventions obviously stands on its own footing and cannot be applied to domestic affairs." <sup>72</sup>

The rule of the *Milburn* case has many ramifications. For example, in the Manual of Patent Examining Procedure <sup>73</sup> it is made clear that where a forfeited or an abandoned application is referred to in an issued United States patent, and the patent relies upon the dis-

---

69. *Id.* at 401.

70. *Ibid.*

71. *Id.* at 401-02.

72. *Id.* at 402.

73. Para. 901.02.



closure of the abandoned or forfeited application, that disclosure is incorporated by reference into the disclosure of the patent and is in that way then made available to the public—but with the early filing date effective as part of the prior art as of that time.<sup>74</sup>

Where the reference patent refers to a copending or abandoned application, which discloses subject matter in common with the patent and subject matter not in common with the patent the effective date of the reference as to the common subject matter will be the filing date of the abandoned application, but not to the other subject matter. Mention in the later filed application of the earlier filed applications is now required by section 120 of the 1952 act in order to obtain the advantage of the earlier dates. There it says:

“An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States by the same inventor shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.”<sup>75</sup>

Thus, there is now statutory authority for carrying back the effective date of the constructive reduction to practice to the earliest filed application relied upon for priority by the patentee.

In the *Asseff* case<sup>76</sup> the Court of Appeals for the District of Columbia approved a combination rejection where one reference patent had its date carried back to the filing date of an abandoned application only in part disclosing the subject matter of the later filed case.

In the *Kendall* case,<sup>77</sup> the Court of Appeals for the First Circuit held it was proper to use against a joint application a patent issued to one of the joint inventors.

What is the situation with respect to an invention disclosed but not claimed in a copending application where one of the coinventors has filed a sole application claiming that subject matter? *Ex Parte Hempel*,<sup>78</sup> is a decision by the Board of Appeals holding that it is quite

74. The Patent Office relies upon *Application of Heritage*, 37 C.C.P.A. (Patents) 1109, 182 F.2d 639 (1950), as its authority. For a criticism of the case, see W. B. Jones, *Ex Parte Heritage (Vs. Fink)*, 33 J. PAT. OFF. SOC'Y 729 (1951).

75. Section 112 sets out the requirements of the specification.

76. *Asseff v. Marzall*, 189 F.2d 660 (D.C. Cir. 1951).

77. *Kendall Co. v. Tetley Tea Co., Inc.*, 182 F.2d 558 (1st Cir. 1951).

78. 88 U.S.P.Q. 124 (1951).

proper to accept an affidavit under Rule 131 and without the requirement of a disclaimer by the co-patentee. If there has never been a claim to the invention, what is there for the co-patentee to disclaim?

Since the discussion of the *Milburn* case began with Judge Learned Hand's decision, it is surprising to find that he authored a later opinion which has dicta expanding the doctrine in a direction contrary to his initial ruling. In the case of *Van Der Horst Corp. v. Chromium Corp.*,<sup>79</sup> the facts are simple. Van Der Horst completed his invention February 21, 1939. A 1940 British patent of Stokes, was filed November 2, 1938, ahead of Van Der Horst's application.

The Court of Appeals for the Second Circuit said:

"Under the doctrine of the *Alexander Milburn Co. v. Davis Bournonville Co.* . . . the pendency of an earlier application in a patent office makes the applicant a 'prior inventor' under the Patent Act; moreover, the application is itself for all purposes the equivalent of a printed publication: that is to say, its anticipatory effect is not confined to the very letter of the disclosure any more than is that of a printed publication."<sup>80</sup>

A per curiam decision on a petition for rehearing in the same case was handed down on August 21, 1952.<sup>81</sup> The court does not hesitate to say that in its previous decision it had failed "to take into consideration section 72 of Title 35 of the U. S. Code" which, of course, provides that a patent will not be held void if the invention or discovery had been previously known or used in a foreign country, if it had not been patented or described in a printed publication. Nevertheless, the court ducked actual reversal of its decision on the point, saying:

"Thus the question appears to come down to whether 'known' in § 72 is to be interpreted as including the foreign applicant and such officials as receive the application; or whether it only means 'known' to outsiders.

"It is not necessary to decide the point, and we leave it open, because we remain of opinion that any new elements Van Der Horst may have disclosed were not enough to support a patent."<sup>82</sup>

Section 4923 of the Revised Statutes provided that a patent "shall not be held void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country before his invention or discovery thereof." It seems to me that that section made

---

79. 197 F.2d 791 (2d Cir. 1952).

80. *Id.* at 794.

81. 198 F.2d 748 (2d Cir. 1952).

82. *Id.* at 749.

it perfectly clear that the Court of Appeals for the Second Circuit was in error on its first decision and that there was no need to leave the question open.

However, corresponding sections 102 and 104 in the 1952 act do not use language quite like that of section 4923. Section 104 provides:

"In proceedings in the Patent Office and in the courts, an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country, except as provided in section 119 of this title."<sup>83</sup>

Under the prior law enunciated in section 4923, the patent "shall not be held to be void on account of being known or used in a foreign country before his invention or discovery thereof . . . ." Section 104 seems to limit the applicant for a patent and the patentee from establishing an earlier date of invention by activities abroad. The limitation upon anticipatory use pronounced by the court can be argued from section 102(a) which requires "known" to be in this country.

In *Ex parte Lemieux*,<sup>84</sup> the Board of Appeals traces the history of section 104 and points out that an applicant's own publication abroad will not be a bar whether his United States application be within or outside of the Convention, so long as the publication is not a time-bar, *i.e.*, over one year. The board also notes an exception to section 104 in cases involving originality: the foreign inventor may then rely on his work abroad in his behalf.

Paragraphs (a), (e) and (g) of section 102 have now been discussed. These three paragraphs and section 103 each refer to the fact that the anticipation must have an effective date ahead of the time the applicant made his invention. The filing date is of less importance to defenses and rejections based on paragraphs (a), (e), (g) and section 103 since in none is there the equivalent of the statutory time-bar of 102(b). The inventor can in nearly all cases prove an invention date ahead of his filing date. Such is not the case under section 102(b).

## VI.

### PUBLICATION, PUBLIC USE AND SALE.

"Section 102.

A person shall be entitled to a patent unless—

. . . .

(b) the invention was patented or described *in a printed publication* in this or a foreign country or in *public use* or *on sale*

83. Section 119 has reference to the International Convention for the Protection of Industrial Property, 35 U.S.C. § 119, n. (1952).

84. 115 U.S.P.Q. 148 (1957).

in this country, more than one year prior to the date of the application for patent in the United States . . . ." (Emphasis supplied.)

Paragraph (b) says that an applicant may not antedate any patent or any printed publication throughout the world with an effective date over a year ahead of applicant's *filing date*. He cannot antedate any public use over a year ahead of his filing date. The same rule applies if the invention be on sale more than the statutory year. Thus, paragraph (b) wholly differs from paragraph (a) and adds the "on sale" defense. Paragraph (b) is a statutory expression of public policy which, through its penalty feature, requires the inventor promptly to file his application and within a year from each of the specified events.

It is to be noted that while manuscripts are not acceptable as evidence of prior knowledge of a completed invention under paragraph (a), as soon as that manuscript is published and the statutory year passes, it is then accepted as a disclosure of a completed invention with an effective date corresponding with its date of publication.

Under paragraphs (a) and (b), it is the fact of publication in some country that counts—not its availability to inventors in this country. Publications frozen behind the Iron Curtain, if susceptible of proof, will anticipate though not available in this country until the last minute during which they can be relied upon as a defense in a civil action.<sup>85</sup>

In the case of *In Re Ward*,<sup>86</sup> the appellant argued that during World War II Switzerland was surrounded by the enemy and its patents confined within its borders. The court held that availability is not a requirement. The Swiss patent qualified as a reference to anticipate the claims.

In *Ex Parte Klotz*,<sup>87</sup> the Board of Appeals by way of dictum said: "[T]here is no authority which holds that what is disclosed in a foreign patent may not be considered with the disclosures of other patents to negative patentability."

#### *When is an Invention "On Sale"?*

In the *McCreery Engineering Co.* case<sup>88</sup> the patentee had proposed to a building committee the construction of certain apparatus described and claimed in his patent. A contract was entered into on March 16,

85. The rule in Great Britain is that the publications must be available in that country.

86. 43 C.C.P.A. (Patents) 1007, 236 F.2d 428 (1956).

87. 102 U.S.P.Q. 169, 170 (1954).

88. *McCreery Engineering Co. v. Massachusetts Fan Co.*, 195 Fed. 498 (1st Cir. 1912).

1905, with the work to be completed by February 27, 1906. However, the work was not completed or paid for until July 3, 1906. The application was filed March 5, 1908. Thus, the application was filed over two years after the contract had been entered into and under the terms of which the work was to be completed. The court said: "We are of the opinion that proof of a mere contract to construct from plans and to deliver in future a machine or manufacture not proven to be previously completed, falls short of proof that the machine or invention was 'on sale'." <sup>89</sup> The court further ruled that the burden rests upon the defendant to show that the machine existed as a complete article of sale, not on paper, but in fact.

It is clear that the law pertaining to contracts and sales generally does not apply to the defense "on sale" under the patent laws. In the decision on a rehearing in the *Burke* <sup>90</sup> case, the court held:

"If patented articles are on hand ready to be delivered to any purchaser, they are on sale, whether any of them has been sold or not. But, if they are not, they cannot be said to be on sale within the meaning of the act, though the invention itself has ceased to be experimental and is complete. This certainly should be true of articles which can be carried in stock, like the motors in question."

In the 1941 case of *Connecticut Paper Products Co. v. New York Paper Co.*,<sup>91</sup> the facts differ somewhat. A model of the Emerson Paper Dispenser had been prepared and shown to the sales manager of the Boston Drinking Cup Co., prior to March 3, 1938. The application was filed April 15, 1940, over two years later. As a result of looking over the model, an agreement was reached that the Boston Company would order fifteen million cups from Emerson. The court held that the dispenser had not been on sale within the two-year period, notwithstanding the fact of the negotiations, the inspection of the model, and the consummation of the agreement over two years before the filing date.

The same result was reached in the *Sturtevant* <sup>92</sup> case by the Court of Appeals for the First Circuit, and that court emphasized: "In this circuit the question of what constitutes a putting 'on sale' is not one for the 'witty diversities of the law of sales.'"

In the *Aerovox* case,<sup>93</sup> the application had been filed February 28,

89. *Id.* at 501.

90. *Burke Electric Co. v. Independent Pneumatic Tool Co.*, 234 Fed. 93 (2d Cir. 1916).

91. 39 F. Supp. 127 (D. Md. 1941).

92. *B. F. Sturtevant Co. v. Massachusetts Hair & Felt Co.*, 124 F.2d 95, 97 (1st Cir. 1941).

93. *Aerovox Corp. v. Polymet Mfg. Corp.*, 67 F.2d 860 (2d Cir. 1933).

1929. In the autumn of 1926, Dubilier had filled two orders for condensers: one for the Victor Talking Machine Company and the other for the Willard Company. The condensers were of the oil-filled type, and the question before the court was whether they had been sold experimentally or secretly. An effort was made to establish that the purpose of the sales was for a test to find out the feasibility of the manufacturing proposition. The court rejected the evidence, saying that while an inventor has the right to determine not only the operability, but the usefulness of the invention to its intended purposes, nevertheless there is a limit in his so doing. The fact the condensers had been sold was held to be adequate.

In the *Lorenz* case,<sup>94</sup> the Court of Appeals for the Third Circuit, in 1948, said:

"The prior-public-use proviso of R.S. § 4886 was enacted by Congress in the public interest. It contains no qualification or exception which limits the nature of the public use. We think that Congress intended that if an inventor does not protect his discovery by an application for a patent within the period prescribed by the Act, and an intervening public use arises from any source whatsoever, the inventor must be barred from a patent or from the fruits of his monopoly, if a patent has issued to him. There is not a single word in the statute which would tend to put an inventor, whose disclosures have been pirated, in any different position from one who has permitted the use of his process."

When there is good evidence of a prior public use, or of the invention being "on sale", the courts do not hesitate to strike down the patent. As to situations where injustice appears, the court, in the *Lorenz* case, observed:

"As Judge Cox said in the *Eastman* case, [134 Fed. 844 (3d Cir. 1905),] isolated instances of injustice may result if the law be strictly applied, but the inventor's remedy is sure. He is master of the situation and by prompt action can protect himself fully and render the defense of prior public use impossible: 'If . . . [the inventor] fails to take so simple and reasonable a precaution why should it not be said that the risk is his own and that he cannot complain of the consequences of his own supineness?' "<sup>95</sup>

#### *Prior Public Use and Experimental Use.*

The *Lorenz* case is worth reading since it does present a hardship case where public use was held to be a bar against the inventor. *Lorenz*

94. *Lorenz v. Colgate-Palmolive-Peet Co.*, 167 F.2d 423, 429 (3d Cir. 1948).

95. *Id.* at 430.

had filed his application on January 24, 1920. He disclosed it to one Ittner, Colgate's chief chemist, who advised him he had no interest in the invention shown in the application. Later Lorenz abandoned his application. Some eleven years later, on February 19, 1931, Ittner filed an application which matured into a patent on July 18, 1933. As soon as Lorenz saw it, he filed a new application with a filing date of November 8, 1934. He copied all of Ittner's claims, received an award of priority, and, of course, his patent issued. Thus, the case before the third circuit was under section 4918 of the Revised Statutes. Upon a counterclaim for invalidity, the court found that Ittner had done a certain amount of experimental work, and by November, 1931, he had in operation in the factory a process for the commercial production of soap and glycerine. This process was used until 1932, at which time it was discontinued. Was this brief period of use for commercial purposes adequate to qualify as a statutory bar against the Lorenz patent? As already indicated, the court said "Yes".

The question as to whether a machine is "on sale" or in "public use" is frequently involved in the same case.

What is the situation where a machine had been completed but was a demonstration model and not one suitable for delivery?

The prospective customer disbelieved that the machine would perform as promised by the supplier. To demonstrate that it would work as intended, the experimental machine was shown to him and a number of operations were performed on it quite satisfactorily. On the basis of the demonstration, an order was placed for several of the machines, more than two years prior to the application date. The Court of Customs and Patent Appeals in *In re Bertram*,<sup>96</sup> declined to answer the question as to whether the machine was "on sale", but approved the ruling of the Board of Appeals:

"Where a use is public, it is believed that the law regards it either as experimental or public use as we know of no authority for a third use, to be regarded as a "demonstration use," and which is neither of the other two."

In the *National Biscuit* case,<sup>97</sup> the application date was March 10, 1923. The evidence indicated that the McClaren machine had been delivered to the Atlantic Cone Co. about October 25, 1920. The machine broke down frequently. In February 1921, new cove bars were installed, and much of the trouble was eliminated. The court found that the customer's demand for the delivery of the second machine

96. 24 C.C.P.A. (Patents) 1073, 88 F.2d 834, 836-37. (1937).

97. *National Biscuit Co. v. Crown Baking Co., Inc.*, 105 F.2d 422 (1st Cir. 1939).

indicated entire satisfaction with the operation. The court held there was prior public use.

The *National Biscuit* case is also of interest because of the clear statement of the following:

“The burden of proof is on the defendant to show a public use or sale. It is not essential that a defendant show that the use, for example, was of a perfect, commercially operative machine, or as perfect as later improvements made it. The burden of avoiding the effect of a prior public use or sale by showing that the device used or sold was not complete or perfect, or in other words commercially inoperative, but was perfected through experiments made while in use during commercial operation, is on the plaintiff and must be shown by strong and convincing proof.”<sup>98</sup>

The “burden of proof” shifts after the defendant introduces evidence establishing prior public use of the machine over one year prior to the application date (or, under the old law, more than two years prior to the application date). Thereafter, the burden is upon the plaintiff to show by exceptionally strong evidence that the use was experimental and not public.

*Experimental Use: Field Trials, Durability Tests, In Secret or in Public.*

*City of Elizabeth v. American Nicholson Pavement Co.*,<sup>99</sup> decided by the Supreme Court in 1877, is most frequently referred to as the leading case on the subject of experimental use. There are a few facts in the case worthy of review. First, the patent in suit, Re. 2,748, of August 20, 1867, the original of which was filed August 8, 1854, had in its specification the following: “I would remark, as to the durability of my pavement, that for the purposes of experiment I have had some of it in use for six years before the month of March, 1854, on a road on which the travel has been very great.” It is unusual that on the face of the patent itself, there is a statement of experimental use of over six years preceding the filing date. As a matter of fact, it appeared that Nicholson in June or July, 1848, had installed a patch of pavement in a street, near Boston. That street was *not* a public road, but belonged to the Boston and Roxbury Mill Corp., which received a toll for its use. Upon payment of the toll, the public was free to travel over the road. Nicholson was a stockholder and Treasury of the Roxbury Mill Corp. The test strip was 75 feet in length, and was constructed by Nicholson at his own expense. The evidence indicated

98. *Id.* at 425.

99. 97 U.S. 126 (1878).



that he examined it nearly every day to observe wear. It also appeared that Nicholson had filed a caveat in the Patent Office in August, 1847, which fully disclosed his invention. For Nicholson, it was argued that his was the first successful wooden pavement introduced into this country, and that it required ten years after the patent was issued to obtain public approval and acceptance of the invention. One reason was that the wooden pavement had to compete with stone pavements, especially from Belgium, from which the most approved form of stone pavement came. Where there is strong competition, durability and cost become very important factors; since durability is self-evidently a question of time, the six years' use of the pavement should be considered as reasonable. In holding for Nicholson, the Court pointed out that the use of the pavement in question was public in one sense, but posed the question: "But can it be said that the invention was in public use?"<sup>100</sup> The principle was well set forth: "The use of an invention by the inventor himself, or by any other person under his direction, by way of experiment, and in order to bring the invention to perfection, has never been regarded as such a use."<sup>101</sup> The Court also found that in the very nature of things, a street pavement is something that cannot be experimented upon satisfactorily except on a highway which is always public. Not so with a machine which could be tested and tried in a building either with or without closed doors. When the inventor is in good faith testing its operation, should it not be considered an experimental use, even though he might not see cause to alter or to improve the invention. The effect of the foregoing argument is brought out by the Court:

"If durability is one of the qualities to be attained, a long period, perhaps years, may be necessary to enable the inventor to discover whether his purpose is accomplished. And though, during all that period, he may not find that any changes are necessary, yet he may be justly said to be using his machine only by way of experiment."<sup>102</sup>

The Court then pointed out some of the tests:

"So long as he does not voluntarily allow others to make it and use it, and so long as it is not on sale for general use, he keeps the invention under his own control, and does not lose his title to a patent.

"It would not be necessary . . . that the machine should be put up and used, only in the inventor's own shop or premises.

---

100. *Id.* at 134.

101. *Ibid.*

102. *Id.* at 135.

He may have it put up and used in the premises of another, and the use may inure to the benefit of the owner of the establishment. Still, if used under the surveillance of the inventor, and for the purpose of enabling him to test the machine, and ascertain whether it will answer the purpose intended, and make such alterations and improvements as experience demonstrates to be necessary, it will still be a mere experimental use and not a public use, within the meaning of the statute.

“ . . . the public may incidentally derive a benefit from it. If it be a grist mill . . . customers from the surrounding country may enjoy the use of it by having their grain made into flour. . . .

“But if the inventor allows his machine to be used by other persons generally, either with or without compensation, . . . then it will be in public use. . . .

“Had the city of Boston, or other parties, used the invention, by laying down the pavement in other streets and places, with Nicholson's consent and allowance, then, indeed, the invention would have been in public use. . . .”<sup>103</sup>

Nicholson did not sell his pavement, did not allow others to use it, did not let it go beyond his control, and did nothing that indicated any intent to do so. He kept it under his own eyes and never for a moment abandoned his intent to obtain a patent for it. The filing of the caveat was part of the evidence of his intent to obtain a patent. The effect of long experimental use as an extension of monopoly was considered by the Court. And it said:

“His monopoly only continues for the allotted period, in any event; and it is the interest of the public, as well as himself, that the invention should be perfect, and properly tested before a patent is granted for it. Any attempt to use it for a profit, and not by way of experiment, for a longer period than two years before the application, would deprive the inventor of his right to a patent.”<sup>104</sup>

The case of *Egbert v. Lippman*<sup>105</sup> involved a patent filed March 1866. Some eleven years earlier, in 1855, Barnes had made a pair of corset steels for a lady who afterwards became his wife. She used them in her corsets; when one wore out, she put the steels in another one. In 1858, after the steels themselves were worn out, Barnes made her another pair. By this time it appeared to him that he might have

---

103. *Id.* at 135-36.

104. *Id.* at 137.

105. 104 U.S. 333 (1881).

something very good, so he made a pair for a Mrs. Bower to try the effect on a stout lady. In 1863, some three years before the filing of his application, he brought one Sturgis to the house, and told his wife that he wished to show him the corset steels. She briefly retired and then brought her corset to the room and with a pair of scissors removed the steels therefrom. Sturgis was quite enthusiastic over the prospects of the invention. The argument presented was quite modern:

“If a man seeing the needs of an intimate friend, arising from defects in corset steels is led to invent a great improvement and gives her two in succession to test its qualities, and with the intention of procuring a patent, the friend thus testing his invention, meanwhile becoming his wife; and further to try its value on a different form gives one to a stout lady, also his friend, for that purpose, and such use on these two forms continues over two years, while he is delayed in obtaining a patent by sickness, is such use legally *public* under the statute, so as to work a forfeiture of the letters patent, as a ‘peremptory consequence’ of this plan adopted by the inventor to secure a test of his invention?”<sup>106</sup>

The Court in its opinion observed:

“We remark, secondly, that, whether the use of an invention is public or private, does not necessarily depend upon the number of persons to whom its use is known. If an inventor, having made his device, gives or sells it to another, to be used by the donee or vendee, without limitation or restriction, or injunction of secrecy, and it is so used, such use is public, within the meaning of the statute, even though the use and knowledge of the use may be confined to one person.”<sup>107</sup>

The Court then went on to outline that some inventions by their very character are only capable of being used where they cannot be seen or observed by the public eye. Such is true of a lever or a spring, hidden in the running gear of a watch, or of a ratchet, shaft or cog-wheel covered from view in the recesses of a machine for spinning or weaving.

“Nevertheless, if its inventor sells a machine of which his invention forms a part, and allows it to be used without restriction of any kind, the use is a public one, within the meaning of the law. So, on the other hand, a use necessarily open to public view, if made in good faith solely to test the qualities of the invention, and for the purpose of experiment, is not a public use within the meaning of the statute.”<sup>108</sup>

---

106. 13 Brodix Sup. Ct. Dec. 276 (1889).

107. 104 U.S. at 336.

108. *Ibid.*

The foregoing principles were then applied to the facts of the case. The corset steels were presented to the lady friend for her use.

“He imposed no obligation of secrecy, nor any condition or restriction whatever. They were not presented for the purpose of experiment, nor to test their qualities. No such claim is set up in her testimony. The invention was at the time complete, and there is no evidence that it was afterwards changed or improved. The donee of the steels used them for years for the purpose and in the manner designed by the inventor. They were not capable of any other use.”<sup>109</sup>

Then the Court finally set forth another reason: “The inventor slept on his rights for eleven years.”<sup>110</sup> The dissent in the case is likewise quite modern in the argument advanced.

“A private use with consent, which could lead to no copy or reproduction of the machine, which taught no one but the party permitted the nature of the invention, and which left the public at large as ignorant of this as it was before the author’s discovery, was no abandonment to the public, and gave no right to defeat his claim for a patent. If the little steel spring inserted in a single pair of corsets, and used by only one woman, covered by her outer clothing, and in a position always withheld from public observation, is a *public* use of that piece of steel, I am at a loss to know the line between a private and a public use.”<sup>111</sup>

#### *Changes Made During Experimental Use.*

In the case of *Smith & Griggs Mfg. Co. v. Sprague*<sup>112</sup> the Sprague patents in suit were filed November 11, 1879, and on December 2, 1878. From the fall of 1874 until the fall of 1877, Sprague had had in operation a machine and had produced some 50,000 gross of levers of the type then used on shoe buckles. These levers he had sold to customers. There was considerable evidence that the machines choked in operation, that workmen had to pick apart the overlapping blanks, and that the beads were not parallel to the slots. During the course of the operation of the machine numerous changes were made in it. There was some evidence that the defective organization was perfected in the early part of 1878. At that time Sprague introduced springs between certain levers and the discs which prevented their overlapping. A rib was also provided in order to keep the blank in position when it was forced upon the mandrel. It was argued that the changes perfected

109. *Id.* at 337.

110. *Ibid.*

111. *Id.* at 339. On the same facts involving inaccessible shims, the Court of Customs and Patent Appeals, in *Application of Blaisdell*, 44 C.C.P.A. (Patents), 242 F.2d 779 (1957), found public use while the Court of Appeals for the District of Columbia found none in *Watson v. Allen*, 117 U.S.P.Q. 69 (1958).

112. 123 U.S. 249 (1887).

the invention and enabled the inventor to take the final step between partial and complete success. In *rejecting* the foregoing argument, the Court pointed out that Sprague had not been seeking a patent on the entire machine and was not content with claims limited to features required to make the machine a complete success. The Court believed that the complainant had a machine:

“. . . practically useful for the purpose for which it was designed, which could be used with commercial success as superior to modes of manufacture previously in use, and which, in fact, he did so use for profit in the ordinary course and conduct of his business, and for the purpose of a successful prosecution of that business, it can hardly be said with propriety that such use was merely experimental, although during the period of its operation he was also engaged in the invention of improvements by which he hoped and expected to make it more valuable and useful.”<sup>113</sup>

The Court pointed out that as to the plea of continued experiment to perfect the machines:

“There are few machines, probably, which are not susceptible of further development and improvement, and the ingenuity of mechanics and inventors is commonly on the alert to discover defects and invent remedies. The alterations made in the machine in question, however useful, were not vital to its organization. Without them it could and did work so as to be commercially successful.”

“. . . .”  
 “The proof falls far short of establishing that the main purpose in view, in the use of the machine by the patentee, prior to his application, was to perfect its mechanism and improve its operation.”<sup>114</sup>

In *Ex parte Petty*<sup>115</sup> the Board of Appeals reversed the Examiner's rejection on the basis of testimony in an interference to the effect that the recorder of the application had been reduced to practice prior to the end of 1936; that the recorder had been used to produce records that were sold and delivered to members of the public, and that the sale of such records took place some four and one-half years prior to the filing of the application. The fact of the public use was held not to have been demonstrated as far as the recorder was concerned, and the board likewise rejected the Examiner's contention of Petty's abandonment of his right to a patent, a matter we will shortly be discussing.

The reasoning of the *Petty* case is to be contrasted with that of the Court of Appeals for the Second Circuit in *Metallizing Engineering*

113. *Id.* at 256.

114. *Id.* at 265-66.

115. 68 U.S.P.Q. 374 (1946).

*Co., Inc. v. Kenyon Bearing & Auto Parts Co., Inc.*<sup>116</sup> In this case, the inventor, Meduna, had filed his application August 6, 1942. The evidence showed that before the critical date of August 6, 1941, there had been a use of the invention, not primarily for the purposes of experiment, and hence commercial. However, the commercial use was not public, but secret. The question then is whether the inventor's secret use will invalidate his own patent. The court reversed its earlier ruling on the point in *Peerless Roll Leaf Co., Inc. v. Griffin & Sons Co.*<sup>117</sup> In the *Peerless* case, the court held that since the patent was for a machine which had been kept secret, the fact that the output from the machine had been freely sold on the market was no reason why the patent should be held invalid. The court contrasted this with its earlier holding in *Grasselli Chemical Co. v. National Aniline & Chemical Co., Inc.*,<sup>118</sup> in which the patent was for a process which had been kept secret, but the product had been sold upon the market for more than two years. The court held that although the process could not have been discovered from the product, the sales constituted a prior use. The decision in the *Metallizing* case, however, goes off on the following ground: The effect upon the right to a patent of the inventor's competitive exploitation of his machine or of his process. This question really comes under 102(c) involving whether or not the inventor has abandoned the invention, *i.e.*, abandoned the right to obtain a valid patent on his invention. The Court of Appeals for the Second Circuit answered the question:

" . . . it is a condition upon an inventor's right to a patent that he shall not exploit his discovery competitively after it is ready for patenting; he must content himself with either secrecy, or legal monopoly. It is true that for the limited period of two years he was allowed to do so, possibly in order to give him time and to prepare an application; and even that has been recently cut down by half. But if he goes beyond that period of probation, he forfeits his right regardless of how little the public may have learned about the invention; just as he can forfeit it by too long concealment, even without exploiting the invention at all."<sup>119</sup>

## VII.

### ABANDONMENT.

"Section 102

A person shall be entitled to a patent unless—

. . .

(c) he has abandoned the invention. . . ."

116. 153 F.2d 516 (2d Cir. 1946).

117. 29 F.2d 646 (2d Cir. 1928).

118. 26 F.2d 305 (2d Cir. 1928).

119. 153 F.2d at 520.

The Supreme Court, in 1859, in *Kendall v. Winsor*,<sup>120</sup> a case apparently not mentioned by Judge Learned Hand in the *Metallizing* case, presented the basis for this condition for patentability as follows:

“It is undeniably true, that the limited and temporary monopoly granted to inventors was never designed for their exclusive profit or advantage; the benefit to the public or community at large was another and doubtless the primary object in granting and securing the monopoly. This was at once the equivalent given by the public for benefits bestowed by the genius and meditations and skill of individuals, and the incentive to further efforts for the same important objects. The true policy and ends of the patent laws enacted under this government are disclosed in that article of the Constitution, the source of all these laws, *viz*, ‘to promote the progress of science and the useful arts,’ contemplating and necessarily implying their extension, and increasing adaptation to the uses of society. . . . By correct induction from these truths, it follows that the inventor who designedly, and with the view of applying it indefinitely and exclusively for his own profit, withholds his invention from the public, comes not within the policy or objects of the Constitution or acts of Congress. He does not promote, and, if aided in his design, would impede, the progress of science and the useful arts. And with a very bad grace could he appeal for favor or protection to that society which, if he had not injured, he certainly had never benefited nor intended to benefit. Hence, if, during such a concealment, an invention similar to or identical with his own should be made and patented, or brought into use without a patent, the latter could not be inhibited nor restricted, upon proof of its identity with a machine previously invented and withheld and concealed by the inventor from the public. The rights and interests, whether of the public or of individuals, can never be made to yield to schemes of selfishness or cupidity; moreover, that which is once given to or invested in the public cannot be recalled nor taken from them.”

The facts in *Kendall v. Winsor* were fairly simple. Plaintiff had made a machine in 1848 that was partially successful. But, in 1849, he had begun four others and had completed them during the same year. He made harness on them when he could get orders. The machines gave him a considerable amount of trouble, particularly as to the tendency of the bobbin to get out of the clutch. He continued his work and simplified the machine until, in November, 1854, he sent his model and specifications to the Patent Office. He had kept the machines from the view of the public and had allowed none of the hands employed in the mill to introduce persons to view them. All the hands were pledged not to divulge the invention. It was further alleged that one Aldridge,

---

120. 62 U.S. (21 How.) 322, 327-28 (1859).

in his employ, broke faith, and gave information to the defendants for the building of its machine. The Supreme Court approved the instructions to the jury that if the plaintiff's conduct were such as to justify the defendants in believing he did not intend to take letters patent but to rely on the difficulty of imitating his machine, taken in conjunction with the means he took to keep it secret, this would be a defense to the action. The period of commercial use of the product was about five years before the filing date.

In the *Macbeth* case,<sup>121</sup> there was before the Court of Appeals for the Sixth Circuit a fact situation showing that the patentee, Macbeth, had discovered and perfected the formula and process in issue prior to the fall of 1903. In that year, his company commenced to use his formula and process in secret for making glass for illuminating purposes. On May 9, 1913, he made application for a patent which later issued as No. 1,097,600. As additional background, it appeared that in 1910 one of Macbeth's employees had stolen his secrets and with another had started to manufacture the same glass by the secret method. Suit was brought and a decree was entered enjoining the defendants in that case from making any glass by the secret process. In the instant case, the question involved Macbeth's right to enforce his patent. The court limited its consideration "to questions pertinent to abandonment" and observed that Macbeth's course of conduct indicated either his intent

". . . to abandon the right to secure protection under the patent laws, or to retain such right and if necessity should arise then to obtain through a patent, a practical extension of any previous exclusive use (secured through secrecy) into a total period beyond the expressed limitation fixed by those laws."<sup>122</sup>

The court rejected the contention that the patentee could eat his cake and have it too. The *Kendall v. Winsor* case was cited as supporting authority, and indeed there is a review by the court of a great many decisions which may be consulted for further elaboration of this subject.

There is a peculiar twist in the case of *Doulett v. Muther*,<sup>123</sup> where the Court of Appeals for the District of Columbia held that Doulett had not elected to maintain his invention in secret for the reason that it was in open operation in the shop where the mechanics and others present saw the machine in operation. They were under no general injunction as to secrecy. "They were merely requested not to divulge

---

<sup>121.</sup> *Macbeth-Evans Glass Co. v. General Electric Co.*, 246 Fed. 695 (6th Cir. 1917).

<sup>122.</sup> *Id.* at 699-700.

<sup>123.</sup> 277 Fed. 600 (D.C. Cir. 1922).



it to 'any machine company' and we think this precaution was clearly within the inventor's rights."<sup>124</sup> However, the Examiners-in-Chief had held Doulett's conduct to amount to concealment of the invention with later stirring into action by his opponent. Now you have the real horns of a dilemma. If there is a considerable period of experimental use and everyone concerned with the invention is sworn to secrecy, is there not an election amounting to concealment, a secret use of the invention, and thus an abandonment of the right to obtain a patent? If, on the other hand, there is no injunction of secrecy, is there not the greatest probability that the so-called experimental or secret use may be held a public use and the patent forfeited? There is indeed a fine line the inventor must walk as between these two situations.

Perhaps it is worth emphasizing here that Judge Learned Hand properly and clearly distinguished between the effect of the secret use of the invention upon the inventor's right to obtain a patent and the absence of secrecy which may make the use a statutory bar.

### VIII.

#### EARLY FILING.

"Section 102.

A person shall be entitled to a patent unless—

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States. . . ."

This paragraph is self-explanatory. It represents another provision tending to assure early filing in the United States. Late filing in the United States is permitted, *i.e.*, outside the Convention but if the foreign patent issues on an application filed in such foreign country over twelve months ahead of the United States filing date an absolute statutory bar arises.<sup>125</sup>

### IX.

#### NON-OBVIOUS SUBJECT MATTER.

"Section 103.

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title,

124. *Id.* at 603.

125. A British provisional application is a filing abroad. In *Re Bastain & Saulsbury*, 1916 Com. Dec. Pat. 160; *but see Ex Parte Hayes*, 1914 Com. Dec. Pat. 93.

if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."

This section is new in the 1952 Patent Act. It is noteworthy for several provisions. For the first time there is a statutory reference to "the prior art." For the first time there is a reference to "a person having ordinary skill in the art to which said subject matter pertains." The knowledge of the mythical person is to be taken "at the time the invention was made." Patentability shall not be negated by the manner in which the invention was made. Since identity of anticipation is not required, section 103 may be taken as the statutory basis for combining references representative of the "prior art."

Mr. P. J. Federico in his "Commentary on the New Patent Act"<sup>126</sup> suggests that:

"The antecedent of the words 'the prior art', which here appear in a statute for the first time, lies in the phrase 'disclosed or described as set forth in Section 102' and hence these words refer to material specified in Section 102 as the basis for comparison."

He further states that section 103 sets forth the problem of determining ". . . the quantum or quality of the novelty present" and that the revision note for the section suggests it may ". . . serve as a basis for the addition at a later time of some criteria which may be worked out."

If Mr. Federico is correct, and his opinions are entitled to serious consideration, then the conditions for patentability under section 102 involving disclosure or descriptions of earlier inventions have the same standing as part of the prior art. Perhaps as logical an explanation is that the phrase "prior art" was intentionally not defined by the act, but as to each applicable condition for patentability of section 102 there is to be present that quantum of novelty as determined by reference to the prior art as it existed "at the time the invention was made."

Consider the following fact situation. The applicant conceives his invention on January 1, 1950. With diligence he reduces it to practice on January 1, 1955. He files his application on January 1, 1956. He claims the combination of *A* and *B*. On January 1, 1953 there were printed publications, one disclosing feature *A* and another disclosing

---

126. 35 U.S.C.A. (1954).

feature *B*. On January 2, 1955, a third publication shows the combination of *A* and *B*. Is the applicant entitled to the patent?

Under section 102(b) a statutory time-bar exists for *A* and *B* taken separately. But the obviousness of their combination is not to be determined as of January 1, 1953, or January 2, 1955, but as of applicant's effective date of invention, namely, January 1, 1950.

The point may be further illustrated by slightly changing the facts. Applicant sells a crude form of his invention. Over a year later he files an application covering the crude form and other features which would not provide the needed quantum of novelty if the crude form were to be combined with earlier publications. May applicant, by establishing his date of invention ahead of the date of sale, foreclose the use of his crude form of the invention as part of the "prior art"?<sup>127</sup>

The language of section 103 seems to leave no doubt that the date an applicant made an invention is the point of reference regardless of the existence of the statutory one-year bars. Such bars must be considered alone and not as part of the general knowledge to be imputed to the "person having ordinary skill," if later than said date of invention.

In the above examples, the applicant had an invention date ahead of the statutory time-bars. What is the answer to the "prior art" question in the following fact situation? A defendant proves under section 102(g) that *A* was the earlier inventor of the combination and that *B* was the earlier inventor of an improved element of the combination. May these two earlier inventions be combined to anticipate the claim of the patent in suit directed to the combination of the two prior inventions?

This problem raises the question as to whether the "prior art" must in theory at least be available to the person skilled in the art. Two inventions not known to other than the respective inventors until the date of trial of the infringement suit cannot, as a matter of logic, be deemed to be a part of the prior art.

The above examples may be extended to commercial use of a process practiced in secret. Such a use by a patentee is fatal to his patent.<sup>128</sup> Is it then a part of the "prior art"?

*Propriety of Combining Patents Issued After Applicants Filing Date.*

The earlier cases are collected and well discussed in two articles dealing with the proposition of whether or not a patent which was copending with the application may be combined with other prior art

127. The writer is indebted to Cyril A. Soans, patent lawyer, Chicago, Illinois for this point.

128. *Soffren v. S. W. Lovell Co., Inc.*, 246 F.2d 769 (1st Cir. 1957).

to anticipate. In the earlier article by Riorden,<sup>129</sup> the conclusion was reached that in both the Court of Customs and Patent Appeals and in the Court of Appeals for the District of Columbia, the weight of opinion is to the effect that it is proper to combine references. In the later article<sup>130</sup> L. B. Dodds argues the contrary proposition and cites a number of court decisions both pro and con. The question has not yet been decided by the Supreme Court.

The Court of Appeals for the Sixth Circuit in *United Specialties Co. v. Industrial Wire Cloth Products Corp.*<sup>131</sup> said:

“While we do not agree with the district court that a prior but co-pending application belongs in the prior art . . . when the issues do not involve priority of conception and putting into practice, we do agree that Zander’s second and third patents are invalid.”

Of course, the basic argument is that an invention disclosed only in a pending application is secret and cannot be known to another inventor who may have come upon the same idea. It is only knowledge accessible to the public that ought to be combined with other like knowledge in order to determine whether or not invention is present.

The rule appears clear in the Second Circuit. The Court of Appeals in *Helene Curtis Industries, Inc. v. Sales Affiliates, Inc.*<sup>132</sup> said:

“We think the defendant is right in its insistence that the Second Speakman patent, which did not issue until after McDonough’s filing date, should not be treated as part of the prior art for purposes of determining the issue of patentable invention in McDonough’s claims. *Old Town Ribbon & Carbon Co. v. Columbia R. & C. Mfg. Co.*, 2 Cir., 159 F.2d 379; *Comolite Corp. v. Davidovicz*, 2 Cir., 111 F.2d 121; *Stelos Co. v. Hosiery Motor-Mend Corp.*, 2 Cir., 72 F.2d 405. . . .”

“Both Speakman’s second U.S. Patent and the Evans and McDonough Patent did not go issue until after the filing date of the patent in suit. On that account, they could not be held to constitute part of the prior art or as anticipating patents under 35 U.S.C.A. § 102(a). *Nevertheless, they were anticipatory under the doctrine of Alexander Milburn Co. v. Davis-Bournonville Co.*,

129. *Copending Patents*, 21 J. PAT. OFF. Soc’y 444 (1939).

130. *The Anticipatory Competence of Copending Patents*, 28 J. PAT. OFF. Soc’y 238 (1946).

131. 186 F.2d 426, 429-30 (6th Cir. 1951).

132. 233 F.2d 148, 157-158 (2d Cir. 1956). There are many other cases in accord with the foregoing quotations. The list, provided by Mr. Dodds, supplementing his paper of 1946, see note 131 *supra*, includes *United Specialties Co. v. Industrial Wire Cloth Products Corp.*, 186 F.2d 426 (6th Cir. 1951); *Permo, Inc. v. Hudson-Ross, Inc.*, 179 F.2d 386 (7th Cir. 1950); *Conmar Products Corp. v. Universal Slide Fastener Co.*, 172 F.2d 150 (2d Cir. 1949); *Old Town Ribbon & Carbon Co., Inc. v. Columbia Ribbon & Carbon Mfg. Co., Inc.*, 159 F.2d 379 (2d Cir. 1947); *Robinson Aviation, Inc. v. Barry Corp.* 106 F. Supp. 514 (D. Mass. 1952).

270 U.S. 390, 70 L. Ed. 651, *now codified in* 35 U.S.C.A. Sec. 102(e). *Old Town Ribbon & Carbon Co. v. Columbia R. & C. Mfg. Co.*, *supra*; *Stelos Co. v. Hosiery-Mend Corp.*, *supra*." (Emphasis supplied.)

Notwithstanding the above decisions, neither the Patent Office nor the Court of Customs and Patent Appeals has relaxed its view to the contrary.

The decision in *Ex parte Kuzmitz*<sup>133</sup> by the Board of Appeals highlights the widely divergent viewpoint. The Examiner combined two patents issued in October, 1951, to anticipate the claims of the application filed March 22, 1949. One patent had been filed March 6, 1942, and the other October 7, 1948. The issues were squarely presented. The board said:

"We have carefully studied the above-quoted paragraphs of Section 102 discussed by appellant as well as its related Section 103 of the 1952 Patent Act without finding therein any explicit or implicit requirement that an invention known or used by others, in order to serve properly as prior art against a person seeking a patent, *must be accessible to the public.*"

"It is also well established that copending applications which, either singly, or in combination with previous patents or other copending applications, or both, disclose knowledge inconsistent with a claim of first invention, are available as references. *Minnesota Mining and Manufacturing Co. v. Coe*, Commissioner of Patents, 1938 C.D. 100, 38 USPQ 513, *supra*; *Dyer v. Coe*, Commissioner of Patents, 535 O.G. 684, 125 F.2d 192, 1942 C.D. 47, 52 USPQ 52; *Ex parte Bullowa et al.*, 56 USPQ 421."<sup>134</sup>

Though not directly pertinent to the practice in the Patent Office of combining copending patents, the case of *Application of Stempel*,<sup>135</sup> points one way out of the difficulty. If the applicant can, in respect

133. 113 U.S.P.Q. 255 (1957).

134. *Id.* at 72. In adhering to this doctrine the court in *Dyer v. Coe*, 125 F.2d 192, 196 (D.C. Cir. 1941), stated:

"We think it can be regarded as settled law that co-pending applications which either singly or in combination with previous patents or other co-pending applications, or both, disclose knowledge inconsistent with a claim of first invention, are available as references. *Cf. Alexander Milburn Co. v. Davis-Bournville Co.*, 1926, 270 U.S. 390, 46 S.Ct. 324, 70 L. Ed. 51."

135. 44 C.C.P.A. (Patents) 820, 241 F.2d 755, 759 (1957).

The court goes on to discuss reference:

"What is a 'reference'? It is nothing more than a patent or publication cited to show that all or part of the invention for which a patent is sought was in the prior art, either more than a year before the filing date to which the applicant is entitled, in which case it is a 'statutory bar' and cannot be sworn back of, or before the applicant's date of invention. When a reference is not a statutory bar, Rule 131 provides a procedure by which the applicant is permitted to show, if he can, that his date of invention was earlier than the date of the reference." *Id.* at 760.

to the feature taken from one patent, show an earlier date for that feature, the combination of references will fail. As the court put it:

“We are convinced that under the law all the applicant can be required to show is priority with respect to so much of the claimed invention as the reference happens to show. When he has done that he has disposed of the reference.”

The anticipatory competence of copending patents combined together or with other disclosures is far from being a settled question. The opposed views should be resolved by the Supreme Court.

The extension of the doctrine of the “constructive reduction to practice” to elevate an application held in secrecy to the status of a printed publication with a date prior to applicant’s date of completion of his invention appears on its face to be unsound. Prior art under Section 10 is certainly not that to which an inventor may not, even on a theoretical basis, have access.

#### CONCLUSION.

Many of the problems herein discussed are familiar. They have been reviewed here because the case law and the 1952 Patent Act do not resolve all questions which arise daily in an active practice. If I may paraphrase Judge Hoover’s observations in the *Arthur Murray*<sup>136</sup> case, the prior art seldom presents a problem on which the searcher may not question his thirst.

“To the contrary, there is so much authority it drowns him. It is a sea—vast and vacillating, overlapping and bewildering. One can fish out of it any kind of strange support for anything, if he lives so long.”<sup>137</sup>

---

136. *Arthur Murray Dance Studios, Inc. v. Witter*, 105 N.E.2d 685 (C.C.P. Ohio 1952).

137. *Id.* at 687.