
Gerald Rose

Stephen M. Martin

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# RECENT DEVELOPMENTS IN PATENT OFFICE PRACTICE—1978

Gerald Rose* & Stephen M. Martin**

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INTRODUCTION

The year 1978 was by any standard an eventful year. Internationally, the Patent Cooperation Treaty and the European Patent Convention are now in effect, an extensive body of literature has developed on how we should adjust our typewriters, paper feeders, and concepts to the new systems.

The year has also been eventful in the United States Supreme Court. The Court in Parker v. Flook\(^1\) held that a patent could not be obtained on a process which consisted of old steps plus a newly discovered mathematical formula, or algorithm. On the heels of Flook, the Court granted certiorari in Parker v. Bergy\(^2\) and remanded the case to the Court of Customs and Patent Appeals (CCPA) "for further consideration in

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light of *Parker v. Flook.* Bergy, and its companion case, *In re Chakrabarty,* had held that living microorganisms were patentable subject matter. Upon reconsideration, the court again held that living microorganisms were patentable subject matter. The third matter before the Supreme Court was *Quick Point Pencil Co. v. Aronson.* A divided appellate panel had held that an agreement to pay royalties on an invention defined in a pending application became unenforceable if the application did not issue as a patent. Recently, the Supreme Court reversed, holding that enforcement of royalty contracts on unpatentable inventions does not withdraw any ideas from the public domain.

This year attorneys have resurrected an old defense and clarified the more current ones. First, the "old combination" rejection was again used to invalidate patents. Though long considered antiquated, and rejected by most tribunals, it has been resurrected in several cases. However, the Second Circuit has definitively rejected it this past year.

A year ago there were a number of patent cases holding patents invalid for failure to comply with the "best mode" requirement of 35 U.S.C. section 112. The number of cases is tapering off, and there was one important reversal this past year of a 1977 decision. But the defense is still in vogue.

Many trial courts are not utilizing the Patent and Trademark Office's procedure of permitting a patentee to have the PTO reexamine his patent in light of newly cited prior art. At least where the patentee applies for a reissue under the "Dann Amendments," the courts have indicated a willingness to defer

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8. The "Best Mode" defense comes from 35 U.S.C. § 112 (1976), which provides:

   The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention. (emphasis added).
discovery until the Office can reexamine and reassess patentability.\textsuperscript{10}

Finally, a few cases this past year reflected adversely the often-observed tendency of patent trial lawyers to over-discover, over-brief, and over-try their cases.\textsuperscript{11} The respective courts have blasted either one or both attorneys for departing from a realistic perspective.

In short, this has been a busy year.

II. Supreme Court

A. Parker v. Flook

On June 22, 1978, the United States Supreme Court, in \textit{Parker v. Flook,}\textsuperscript{12} held that "a claim for an improved method of calculation, even when tied to a specific end use, is unpatentable subject matter under section 101."\textsuperscript{13} But the Court's holding that "this case must . . . be considered as if the [newly discovered] principle or mathematical formula were well known"\textsuperscript{14} will cause future problems.

The CCPA decision of \textit{In re Flook}\textsuperscript{15} was a unanimous opinion written by Judge Baldwin which had authorized claims such as the following:

A method for updating the value of at least one alarm limit on at least one process variable involved in a process comprising the catalytic chemical conversion of hydrocarbons wherein said alarm limit has a current value of (a certain equation) which comprises: (1) determining the present value of said process variable . . . determining a new alarm base . . . using the following equation (omitted); (3) determining an updated alarm limit value which is defined (by another equation) and, thereafter (4) adjusting that alarm limit to said updated alarm limit value.\textsuperscript{16}

More simply stated, the idea was to measure the present value of a process parameter such as temperature, use a newly devised mathematical formula to calculate an updated "alarm

\begin{itemize}
\item[10.] 955 O.G. 1054 (February 22, 1977). For other works on patentability, see CHISUM, PATENTS (Matthew Bender 1978); PATENT LAW CONFERENCE COURSEBOOK, NONOBVIOUSNESS: THE STANDARD OF PATENTABILITY IN THE UNITED STATES (BNA 1977); Rose, 1978 PATENT LAW HANDBOOK (1978).
\item[11.] See notes 326-40 and accompanying text infra.
\item[13.] See 35 U.S.C. § 101 (1976) which provides: "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title." See notes 62-84 and accompanying text infra.
\item[14.] Parker v. Flook, 437 U.S. at 592, 198 U.S.P.Q. at 198.
\item[16.] \textit{Id.} at 22, 195 U.S.P.Q. at 10.
\end{itemize}
limit” for that parameter, and then automatically adjust the alarm limit to the updated value. The calculation was “accomplished by some type of computer in accordance with a mathematical control equation.”

The CCPA had observed that this was “a claim to a process which uses an algorithm to modify a conventional manufacturing system.”

It had distinguished the case from its prior holding in In re Christensen on the basis that Christensen was “expressly limited to claims directed to determining data used in an algorithm and solving the algorithm, that is, to claims in which nothing is done after solution of the algorithm.” There was, in short, no “post-solution activity” or use recited in the claims of Christensen.

The CCPA had also distinguished the holding of Gottschalk v. Benson stating, “The present claims do not preempt the formula or algorithm contained therein, because solution of the algorithm, per se, would not infringe the claims.”

Mr. Justice Stevens, writing for the majority, declined to accept this distinction from Benson. The Court reviewed some of its earlier precedents and concluded that “[t]he process itself, not merely the mathematical algorithm, must be new and useful.”

It then launched into the troublesome holding, stating “we think this case must also be considered as if the principle or mathematical formula were well known.” It added that “a scientific principle, such as that expressed in respondent’s algorithm, reveals a relationship that has always existed.”

This would be troublesome by itself. But then the Court proceeded to assume that the algorithm, no matter how nonobvious, could not form the basis of a patentable claim because the algorithm must be excluded for all purposes in determining pat-

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17. Id.
18. Id.
23. Parker v. Flook, 437 U.S. at 590, 198 U.S.P.Q. at 197. “The notion that post solution activity, no matter how conventional or obvious in itself, can transform an unpatentable principle into a patentable process exalts form over substance.”
The majority opinion concluded, “It is our duty to construe the patent statutes as they now read, in light of our prior precedents, and we must proceed cautiously when we are asked to extend patent rights into areas wholly unforeseen by Congress.” It ended to the effect that “we should not extend patent rights . . . unless the argument for extension of privilege is based on more than mere inference from ambiguous statutory language. We would require a clear and certain signal from Congress. . . .” Such “[d]ifficult questions of policy concerning the kinds of programs that may be appropriate for patent protection and the form and duration of such protection can be answered by Congress on the basis of current empirical data not equally available to this tribunal.”

The dissent phrased the issue as “whether a claimed process loses its status of subject matter patentability simply because one step in the process would not be patentable subject matter if considered in isolation.” It recognized that “thousands of processes and combinations have been patented that contained one or more steps or elements that themselves would have been unpatentable subject matter.”

B. Parker v. Bergy

Four days after Flook, the Court vacated and remanded In re Bergy “for further consideration in light of Parker v. Flook.” Bergy had obtained a composition-of-matter claim to a “biologically pure culture” of heretofore old, naturally existing, microorganisms. The issue on remand was: what part of Flook is to be considered? Is it the first reason of Flook—exclusion of “newly patentable under § 101 not because it contains a mathematical algorithm as one component, but because once that algorithm is assumed to be within prior art, the application, considered as a whole, contains no patentable invention.” Otherwise stated, “as if [it] . . . were well known.”

27. Id. at 594, 198 U.S.P.Q. at 198: “Respondant's process is unpatentable under § 101 not because it contains a mathematical algorithm as one component, but because once that algorithm is assumed to be within prior art, the application, considered as a whole, contains no patentable invention.” Otherwise stated, “as if [it] . . . were well known.” Id. at 592, 198 U.S.P.Q. at 198.
28. Id. at 596, 198 U.S.P.Q. at 199.
31. Id. at 598, 198 U.S.P.Q. at 201 (Stewart, J., dissenting); cf. 35 U.S.C. § 100(b) (1976) which provides: “The term ‘process’ means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.”
discovered scientific principles,"34 as to which Bergy's composition of purified old material undoubtedly qualifies? Or is it the second reason—"proceed cautiously when . . . asked to extend patent rights into areas wholly unforeseen by Congress"?35 Under either interpretation, things did not look too well for Mr. Bergy and his bugs.36

Shortly following Bergy, the Solicitor General petitioned the Supreme Court to vacate the decision in Bergy's companion case, In re Chakrabarty.37 He also petitioned the CCPA to vacate its decision, to recall its mandate, and to set the case down for reargument with Bergy.38

The decisions of In re Bergy and In re Chakrabarty broke new ground in the law. The issue was: are living microorganisms patentable? And while the CCPA, answering in the affirmative in both cases, took pains to say that "we are not deciding whether living things in general, or at most, whether any living things other than microorganisms, are [patentable],"39 the decisions are of first impression.

Bergy and Chakrabarty provided similar fact patterns. The respective applicants had each discovered new chemical processes. Bergy's was the fermentation preparation of an antibiotic (lincomycin) using a newly discovered natural strain of Streptomyces bacteria. Chakrabarty's was the degradation of spilled oil with "genetic engineered" bacteria. In neither case was there any difficulty in obtaining patent protection on the process.

But the respective microorganisms themselves were new, useful, and nonobvious.40 Bergy assured that his "invention" was new (and did not exist in nature) by claiming a "biologically pure culture"; Chakrabarty's microorganisms were man-created mutants. Assuming that they might have other uses, the respective applicants sought patents on the microorganisms per se. After all, were they not a "manufacture" or "composition of matter" within the statutory scope of patentable matter?41 Or were they?

35. Id. at 597, 198 U.S.P.Q. at 200.
36. On remand, the court held that Parker was not applicable. See notes 56-59 and accompanying text infra.
38. On rehearing, the court affirmed its prior holding that living organisms can be protected as new compositions or articles of manufacture. In re Bergy, 201 U.S.P.Q. at 363.
41. See id.
Legal precedent was remote. On the one hand, processes which used living microorganisms had long been held patentable—ranging from the original septic tank through the fermentation preparation of specific chemical compounds. Similarly, synthetic counterparts of naturally existing products were patentable—vitamin B-12 had existed in livers and adrenalin had been found in the adrenal glands.

On the other hand, the Supreme Court had held that “an inoculant for leguminous plants comprising mutually non-inhibitive strains of different species of bacteria” was an unpatentable “discovery of some of the handiwork of nature.”

Perhaps most troublesome was the argument of the dissenters that the Plant Patent Act of 1930 was intended to “extend” patent protection to certain plants, and yet that Act did not include bacteria. If the “extended” Act did not cover bacteria, how could the basic Act do so? Alternatively, if the basic Patent Act, as held by Bergy and Chakrabarty, covered living things, there should have been no need for any “extension.”

The majority only partly responded. The Plant Patent Act was enacted without any Congressional reference to microorganisms. But in any event, that Act included plants by relaxing the “description” requirement applicable to other patents, which specified that a reader must be able to produce the thing patented, and be able to distinguish it from what is old.

While the press indicated much surprise, probably few chemists did. In 1828, Wöhler showed there was no insurmount-

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42. Cameron Septic Tank Co. v. Saratoga Springs, 159 F. 453 (2d Cir. 1908).
45. Parke Davis & Co. v. H.K. Mulford Co., 189 F. 95 (S.D.N.Y. 1911), aff’d, 196 F. 496 (2d Cir. 1912).
47. See 35 U.S.C. §§ 161-164 (1976) which provides in relevant part: “Whoever invents or discovers and asexually reproduces any distinct and new variety of plant, including cultivated sports, mutants, hybrids and newly found seedlings, other than a tuber-propagated plant or a plant found in an uncultivated state, may obtain a patent . . . ”

The claim in the specification shall be in formal terms to the plant shown and described.”
able difference between “inorganic” and “organic” chemistry when he heated two inorganic compounds (ammonium sulfate and potassium cyanate) and produced an organic one (urea). In 1953, Crick, Watson, and Wilkins blurred the boundaries between organic chemistry and biochemistry when they showed that DNA (the genetic code) is a double helix composed of simple organic compounds.

The bottom line argument, though, was that Congress could legislate to make anything patentable that would “promote the progress of . . . useful arts.” The recital of patentable subject matter in section 101, “process, machine, manufacture or composition of matter,” is broad and only partly fills the authorization. And “there is nothing in the words of section 101 which excludes patents for living organisms.” These microbes were “useful” beyond question.

As the majority noted in Bergey, “microorganisms . . . are much more akin to inanimate chemical compositions such as reactants, reagents, and catalysts than they are to horses and honeybees or raspberries and roses.” There was no reason for “excluding [a microorganism] from the . . . categories of patentable inventions on the sole ground that it is alive. It is because it is alive that it is useful.”

On rehearing, the CCPA distinguished Flook, stating:

[T]hat the process aspects of their inventions are not only subject matter within § 101 but also new and unobvious under § 102 and § 103, therefore patentable. Flook (sic) was concerned only with the question of what is a “process” under § 101, in the context of computer program protection. No such issue is presented in either of these appeals.

The court then rejected the solicitor’s argument that section 101

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50. See THE NEW ENCYCLOPEDIA BRITANNICA 905 (1979).
51. See THE NEW ENCYCLOPEDIA BRITANNICA 994 (1979). But see Schering Corp. v. Gilbert, 153 F.2d 428, 68 U.S.P.Q. 84 (2d Cir. 1946). Note the late date that new chemical compounds were held to be patentable as compositions of matter.
52. U.S. CONST. art. 1, sec. 8, cl. 8.
55. Id.; accord, In re Chakrabarty, 571 F.2d at 44, 197 U.S.P.Q. at 78 (Markey, C.J., concurring). “There are but two sources for manufactures and compositions of matter. They are God . . . and man.” In Chakrabarty, the living microorganisms were man made “manufactures” or “compositions.” “No Congressional intent to limit patents to dead inventions lurks in the lacuna of the statute.” See Kiley, Common Sense and the Uncommon Bacterium—is Life Patentable?, 60 J. PAT. OFF. SOC’Y 468 (1978). However, any definitive answer must await the CCPA’s holdings and then, perhaps, the Supreme Court’s.
required a signal from Congress before approving the position of the litigant to open the privilege of patents wider than Congress had intended. Finally, the court reaffirmed the prior holding that microorganisms were patentable.

III. The Statutes

Although no major patent legislation was passed this year, the courts have more thoroughly interpreted existing statutes. This section will thoroughly examine the activities concerning these statutes.

A. 35 U.S.C. Section 26—Photocopies of Declarations

35 U.S.C. section 26 provides that:

Any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be executed in a specified manner, may be provisionally accepted by the Commissioner despite a defective execution, provided a properly executed document is submitted within such time as may be prescribed.

The Office has indicated some concern as to whether this included the filing of photocopies of declarations. Two cases have held section 26 applicable to the filing of photocopies of declarations where the signed declaration was not timely received by the attorney responsible for filing the application.

B. 35 U.S.C. Sections 100 & 101

1. Computer Programs

Two decisions of the CCPA prior to Parker v. Flook, and one subsequent decision, concerned the patentability of programs for general purpose programmable digital computers. In In re Freeman, the claims were to a "system for typesetting alphanumeric information, using a computer-based control sys-
tem in conjunction with a phototypesetter of conventional design" that was “especially useful in printing mathematical formulæ.” The claims were to the apparatus and to the method. Neither the method claims nor the apparatus claims made reference to any algorithm.

The court declined to follow the board’s analysis that the claims were merely an idea and reversed its conclusion. Because an invention was intended to be performed in conjunction with a computer does not, by that fact alone, make claims to that invention unpatentable. In Freeman, neither the method claims nor the apparatus claims recited process steps which were mathematical calculations, formulae, or equations. Consequently, they could not be tested by any interpretation of Gottschalk v. Benson or Dann v. Johnston.

The second case, In re Toma, was a reversal of a rejection of claims to a method for translating languages. The claims involved a method and did not recite any algorithm although the specification disclosed a computer program for the chore. In keeping with Freeman, the Toma court looked at the entire claim, rather than to any part of it by itself, and held that where a claim does not “directly or indirectly recite a Benson-type algorithm,” it was not within the holding of Benson. Benson had used the term “algorithm” in a “specific sense, namely ‘a procedure for solving a given type of mathematical problem.’” In Toma, there was no such mathematical problem. Further, a translation method was in the “technological art,” as it “is a method of operating a machine.”

The third computer case, In re Schreiber, affirmed a rejection of claims based on art that had intervened between an earlier application (on which reliance was sought under 35 U.S.C.

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65. Id. at 1238, 197 U.S.P.Q. at 465-66.
66. 409 U.S. 63, 175 U.S.P.Q. 673 (1972); see notes 68 & 69 and accompanying text infra. Benson held that ideas are not patentable—and that patenting a formula with no use but for a digital computer would in effect be a patent of the algorithm. Id. at 71, 175 U.S.P.Q. at 676.
72. Id. at 878, 197 U.S.P.Q. at 857. The examiner had held that only those inventions which enhance the internal operation of the digital computer are in the technological or useful arts. See In re Musgrave, 431 F.2d 882, 167 U.S.P.Q. 280 (C.C.P.A. 1970).
section 120) and a later application. The earlier application had disclosed generically, but not specifically, the concept of the intervening reference. The claims called for a formula which with certain values would correspond to the intervening art. 74 These values, however, had not been taught in the earlier application.

2. 35 U.S.C. Section 101—Utility

Two important cases involved the utility, or usefulness requirement of section 101. 75 In Ex parte Krenzer, 76 a class of new chemical compounds was claimed, and it was asserted that they were useful as herbicides. Apparently there was little actual proof of their herbicidal utility. The board held that statements of utility by the applicant must be accepted as true “unless there is reason to doubt the objective truth of the statements contained [in the specification].” 77 Here there were no “reasonable” doubts as to whether the invention would function as stated. “Reasonable” doubts would exist where the invention was “highly unusual,” “incredible,” or “too speculative.” 80

The other case involving utility was In re Sichert. 81 In Sichert, certain herbicidal extracts were claimed in combination as being useful “against congestions in the lymphatic system.” 82 Although not stated in the specification, the examiner had ar-

74. See 35 U.S.C. § 120 (1976) which provided in relevant part: “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 filed in the United States by the same inventor shall have the same effect, as to such invention . . . .” In Schreiber, there was no such disclosure. 587 F.2d at 62, 199 U.S.P.Q. at 785.


82. Id. at 1157, 196 U.S.P.Q. at 210.
gued that the concoction was intended as a cancer cure. The court held that the utility as a lymphatic system anti-congestive was not “incredible” within the meaning of “speculative, incredible, esoteric, factually misleading or contrary to the common knowledge of persons of ordinary skill.”

The evidence, including a medical affidavit, satisfied section 101.

C. 35 U.S.C. Section 102

1. Prior Art

The year brought the normal collection of inconsistent case authorities interpreting 35 U.S.C. section 102, which, among other things, defines what is prior art. In general, the CCPA in *In re Samour* reconfirmed prior law to the effect that two references can be “combined,” in certain circumstances, to make out a section 102 anticipation. In *Samour*, the basic reference described a compound but gave no method for preparing it, thereby disqualifying the reference as “non-enabling.”


84. *In re Sichert*, 566 F.2d at 1163, 196 U.S.P.Q. at 214. *Sichert* reaffirmed *In re Anthony*, 414 F.2d 1383, 162 U.S.P.Q. 594 (C.C.P.A. 1969), as to whether a patent applicant has to prove that his therapeutic composition was “safe.”

85. *See* 35 U.S.C. § 102 (1976) which provides in relevant part, “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 discussing the cases, attention should be directed to three articles: *Gholz, Establishing The Time the Intention was Made*; *Janicke, What is ‘Prior Art’ under § 102? The Need For Policy Thought*; *Rose, Ascertaining Differences—When is the ‘Invention not Identically Disclosed or Described’? in 1977 Patent Law Conference Course-Book* (BNA 1977).


87. The term “anticipation” is sometimes used as a synonym for an identical disclosure or description of § 102, but sometimes not. In *Wilden Pump & Eng’r v. Pressed & Welded Prods.*, 199 U.S.P.Q. 390 (N.D. Cal. 1978), the court used it in the anticipatory sense stating: “Anticipation is strictly a technical defense. Unless all of the same elements are found in exactly the same situation and united in the same way to perform the identical function, there is no anticipation.” *Id.* at 399; *accord*, *Hancock Labs. v. American Hosp. Supply*, 199 U.S.P.Q. 274 (N.D. Ill. 1978) (method of preparing pig heart valves for use in human transplants anticipated by identical method for preparing pig heart valves for pathological study). *Contra*, *Chemetron Corp. v. Airco, Inc.*, 198 U.S.P.Q. 119 (N.D. Ill. 1976) (method of removing drainage from a patient not anticipated by apparently identical method for doing the same with cadavers; summary judgment denied).

ever, a subsequent auxiliary reference (also prior art) suggested how to make the compound. The court allowed the combination because the subject matter was in possession of the public more than one year prior to the applicant's filing date.

Two cases from the same court illustrate the difficulty in determining when an invention is completely described in the prior art. In each case, the respective inventors had practiced a method that was apparently operationally identical to the prior art. Each had sought to distinguish from the prior art by reason of functional claim limitations.

The first case was In re May. The claims were to “a method of effecting analgesic and morphine antagonistic activity without producing physical dependence in animals which comprises administering [a certain compound].” The prior art showed one of the claimed compounds as being a useful analgesic, but had neither taught nor suggested the “without producing physical dependence” limitation. The court held that “[w]hile the references do not show a specific recognition of that result, its discovery by appellant is tantamount only to finding a property in the old composition, not in the . . . compound for which it is argued, a new use has been found.” In other words, the “without producing physical dependence” limitation could not “serve to patentably distinguish the claimed process from the prior art.”

In In re Marshall, the claimed method was to “a weight control process which comprises . . . periodically anesthetizing the nerve endings in the digestive tract [by administering a certain anesthetic].” That same material had been used for the treatment of ulcers. In contrast to May, the claims were allowed, as the court held:

These claims are directed to a weight control process. Applicant

89. In re Samour, 571 F.2d at 562-63, 197 U.S.P.Q. at 4 (§ 102 rejection was affirmed).
90. The Samour court rejected the contention that one skilled in the art needed an incentive to make the compound before references to the same subject matter could be combined. Id. at 563, 197 U.S.P.Q. at 4.
93. Id. at 1084, 197 U.S.P.Q. at 602 (emphasis added).
94. Id. at 1087, 197 U.S.P.Q. at 604.
96. In re May, 574 F.2d at 1090, 197 U.S.P.Q. at 607.
98. Id. at 302, 198 U.S.P.Q. at 345.
uses an effective amount of the anesthetic . . . in order to control weight. The [prior art], however, teaches using drugs containing the anesthetic . . . in order to treat [certain syndromes such as peptic ulcer]. Nothing in the [prior art] remotely suggests taking [the anesthetic] to lose weight. If anyone ever lost weight by following the [prior art] teachings, it was an unrecognized accident. An accidental or unwitting duplication of an invention cannot constitute an anticipation.99

2. Described in a Printed Publication

Important law was made, or at least restated by three cases, in connection with “described in a printed publication” under section 102(a) and/or section 102(b).100

In In re Samour,101 discussed previously, the court held that a publication that described a prior art compound, but which failed to both describe a method of preparation and to disclose the effects on people became an “enabling” and anticipatory description in a publication when another reference, also prior art, suggested how to make the compound in question. The public was in possession of the invention when the secondary reference was later published. Thus, even though persons skilled in the art had no incentive to “combine” the two references, the critical issue remained: did the public have possession of the subject matter more than one year prior to the applicant’s filing date?102

The second case, In re Bayer,103 decided the specific issue of when a library thesis became a “printed publication.” Was it when the thesis was placed in the library, or when it was catalogued and shelved? Holding that only the latter events qualified the thesis as a “publication,” the court allowed the claims. The court began its decision stating:

It is well settled that in determining whether a printed document constitutes a publication bar under 35 U.S.C. § 102(c), the touchstone is public accessibility. This follows logically from the theory that the patent grant is in the nature of a contract between the inventor and the public. Access of knowledge of the invention is already accessible to the public, there is a failure of considera-


100. 35 U.S.C. § 102(a)(b) (1976). Section 102(b) provides in relevant part, “A person shall be entitled to a patent unless . . . (b) the invention was patented or described in a printed publication . . . or in public use or on sale in this country, more than one year prior to the date of the application . . . ”; see note 85 supra for the language of § 102(a).


102. Id. at 562, 197 U.S.P.Q. at 4.

tion and no patent may be granted.\textsuperscript{104}

It then concluded:

We think it is apparent that a printed document may qualify as a "publication" under 35 U.S.C. § 102(b), notwithstanding that accessibility thereto is restricted to a "part of the public," so long as accessibility is sufficient to raise a presumption that the public concerned with the art would know of [the invention]. . . . Accessibility to appellant's thesis by the three members of the graduate committee under the circumstances of the present case does not raise such a presumption.

Moreover, since appellant's thesis could have been located in the university library only by one having been informed of its existence by the faculty committee, and not by means of the customary research aids available in the library, the "probability of public knowledge of the contents of the [thesis]" was virtually nil.\textsuperscript{105}

The third case was \textit{In re Schaumann}.\textsuperscript{106} \textit{Schaumann} decided the recurrent question of whether, when, and if a generic description is a specific disclosure of each member of the genus. As stated by the unsuccessful appellant, the issue was "whether the disclosure of a chemical genus may ever constitute a description of a specific compound falling within the ambit of the genus."\textsuperscript{107}

The plaintiff contended and asked the court to hold that \textit{In re Ruschig}\textsuperscript{108} overruled its prior decision of \textit{In re Petering}.\textsuperscript{109} \textit{Petering} had held that a generic class of some twenty compounds was a specific disclosure or description of each member of the class "as fully as if he had drawn each structural formula or had written each name. . . ."\textsuperscript{110} But \textit{Petering}, or at least the generalization from \textit{Petering}, had been condemned in \textit{In re Ruschig}. The \textit{Ruschig} court held:

\textit{We did not intend our Petering opinion or decision to become a precedent for the mechanistic dissection and recombination of the components of the specific illustrative compounds in every chemical reference containing them, to create hindsight anticipation with the guidance of an applicant's disclosure, on the theory that such reconstructed disclosures describe specific compounds within the

\textsuperscript{104} Id. at 1358, 196 U.S.P.Q. at 671; \textit{In re Tenney}, 254 F.2d 619, 117 U.S.P.Q. 348 (C.C.P.A. 1958) (single microfilm copy not a printed publication).


\textsuperscript{107} Id. at 315, 197 U.S.P.Q. at 7.


\textsuperscript{110} \textit{In re Petering}, 301 F.2d at 682, 133 U.S.P.Q. at 280.
meaning of § 102. . . . To do this, the board selects [different radicals] to create, ex-post-facto four undisclosed specific compounds out of a possible 259, according to appellants' apparently valid calculation. This is not the kind of description we found in Petering and we do not find here any “anticipation” . . . .

_Schaumann_ had involved a genus of fourteen compounds in the prior art. Actually, the genus was broader, but the CCPA considered the claims of the prior art reference to focus on the fourteen compounds. It stated:

When we consider [these factors, the prior art] embraces a very limited number of compounds closely related to one another in structure, we are led inevitably to the conclusion that the reference provides a description of those compounds just as surely as if they were identified in the reference by name. Since one of the compounds thus described is [being claimed by the appellant] we agree with the examiner and the majority of the board that appellants’ right to a patent thereon is barred under 35 U.S.C. § 102(b).

3. _In Public Use or on Sale_

This year, the usual controversies have developed as to whether an alleged incident of public use or “on sale” is commercial and hence invalidating, or experimental and therefore not. The courts also confronted the issue of whether the invention must be “on hand” (i.e., available for delivery) before there can be an “on sale”?113

_Bird Provision Co. v. Owens Country Sausage, Inc._114 affirmed the invalidity of claims which were found to be anticipated by four instances of prior use. Summarizing, the court stated:

The bar to patent validity thrown up by § 102(b) is basically a reflection of the public policy that an inventor should not be permitted to extend the effective duration of his patent monopoly through covert commercial exploitation of his invention. [citation omitted] Thus, a public use may be established either by showing a nonsecret, nonexperimental use of the process or showing that the inventor himself used the process primarily for trade and profit.

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111. _In re_ Rushig, 343 F.2d at 974, 145 U.S.P.Q. at 282 (emphasis supplied); _see_ _In re_ Ruschig (II), 379 F.2d 990, 154 U.S.P.Q. 118 (C.C.P.A. 1967), where the court held: “Surely, given time, a chemist could name (especially with the aid of a computer) all of the half million compounds within the scope of the broadest claims, which claim is supported by the broad disclosure. This does not constitute support for each compound individually when separately claimed.” _Id._ at 994, 154 U.S.P.Q. at 122; _accord, In re_ Wertheim, 541 F.2d 257, 191 U.S.P.Q. 90 (C.C.P.A. 1976); _In re_ Waymouth, 499 F.2d 1273, 182 U.S.P.Q. 290 (C.C.P.A. 1974); _In re_ Smith, 458 F.2d 1389, 173 U.S.P.Q. 679 (C.C.P.A. 1972); _In re_ Wagner, 371 F.2d 877, 152 U.S.P.Q. 552 (C.C.P.A. 1967); _see_ _Hunt v. Treppschuh_, 223 F.2d 1386, 137 U.S.P.Q. 428 (C.C.P.A. 1955). 112. _In re_ Schaumann, 572 F.2d at 916, 197 U.S.P.Q. at 8.


114. 560 F.2d 369, 197 U.S.P.Q. 134 (5th Cir. 1978).
prior to the critical date, regardless of whether his use was secret.\textsuperscript{115}

The Fifth Circuit also considered public use aspects under section 102(a), finding that the "process has been used on American farms for generations."\textsuperscript{116}

The same court, in \textit{Lear Siegler, Inc. v. Ark-Ell Springs, Inc.},\textsuperscript{117} sustained the validity of a patent over the contention that the inventor had sold springs made from his patented die more than a year before the filing date. The trial court had found that his primary intention was experimental, and the sale only incidental.

While both the majority and the dissent in \textit{Gould, Inc. v. United States}\textsuperscript{118} relied on the same cases, they reached opposite conclusions. The issue was whether the inventor had placed his torpedo engine on sale by offering arguably experimental quantities to the Navy more than a year before his filing date. The Navy wanted a liquid-propelled engine, but the experiments (or sales) were for solid propellant systems. The majority, citing and discussing a number of cases where an "on sale" had occurred by offering limited quantities to potentially commercial customers, held that the activities amounted to a commercialization of the invention.\textsuperscript{119} Even where the patentee did not have


\textsuperscript{117} 569 F.2d 286, 197 U.S.P.Q. 273 (5th Cir. 1978); \textit{cf.} March v. United States, 568 F.2d 722, 198 U.S.P.Q. 456 (Cl. Ct. 1977) (although held invalid for obviousness, an anticipation was avoided notwithstanding possible incidental and occasional practice of the system in episodic instances of extraordinary rainfall).


\textsuperscript{119} 579 F.2d at 584, 198 U.S.P.Q. at 164. The court relied on Judge Wright's observations in Philco Corp. v. Admiral Corp., 199 F. Supp. 797, 815, 131 U.S.P.Q. 413, 429 (D. Del. 1961), where the court stated:

The in public use or on sale rules as applied to the independent craftsman who constructs a product to order for instance, may lead to absurd results when applied to an integrated, mass production industry with highly organized merchandising systems. The question of what is experimentation and what is not may also take on a different complexion depending on the character of the device, the nature of the industry and the facilities available to the particular inventor.

\textit{See} Metallizing Eng'r Co. v. Kenyon Bearing & Auto Parts Co., 153 F.2d 516, 68 U.S.P.Q. 54 (2d Cir. 1946) (balance of inventor's interest and those of the public); \textit{cf.} Diet v. United States, 176 F. Supp. 357, 123 U.S.P.Q. 21 (S.D. Cal. 1959), \textit{aff'd}, 283 F.2d 693, 127 U.S.P.Q. 419 (9th Cir. 1960) (sale more than one year prior to application held to violate 102(b) even though for secret military contract); Chicopee Mfg. Corp. v. Columbus Fiber Mills Co., 165 F.
the capability to manufacture any commercial quantity at that time, some courts have held the patents invalid under section 102(b).120

However, to show the gross incompatibility of the decisions, one should consider those cases where the courts have validated the patents even though the purported experiment greatly resembled a commercial display.121 In Bergstrom v. Sears, Roebuck & Co.,122 the court sustained a patent even though the inventor had sent letters to a magazine columnist advising that the device was available at a price. The court held this not to be an “on sale,” as neither the columnist nor the magazine were likely to be purchasers.123 As in several other cases, the court held that an inventor can exercise his judgment in not disclosing experimental uses or “on sales” to the PTO.124 Finally, it seems clear that a visible, operative, experimental prototype of an invention, without more, is not a public use by the inventor.125

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123. Bergstrom v. Sears, Roebuck & Co., 457 F. Supp. at 220, 199 U.S.P.Q. at 278 (D. Minn. 1978) (there were no publications of the magazine prior to the critical date).


4. “Patented” Under Sections 102(a), 102(b) and 102(d)

Until the end of this year, the term “patented” in section 102 has had different meanings in section 102(a)\textsuperscript{126} and section 102(b)\textsuperscript{127} than it does in section 102(d).\textsuperscript{128} Under section 102(a) and section 102(b), “patented” usually means both accessibility to the public and the commencement of an enforceable legal right. Under section 102(d), accessibility is not a factor and only the acquisition of a right is germane.\textsuperscript{129}

In the United States, there is usually no problem as to when a patent becomes “patented,” as the patent is both accessible to the public and marks the onset of legal rights on the same day.\textsuperscript{130} In foreign countries with different patent systems, public accessibility may occur either before, simultaneously with, or after the acquisition of an enforceable right.\textsuperscript{131}

Therefore, the different meanings of the term “patented” was an issue in several cases this past year. In \textit{Steelcase, Inc. v. Delwood Furniture Co.},\textsuperscript{132} the invalidity of utility and design patents on what was “perhaps the most successful [chair] model ever offered on the American market” was affirmed on art contained in a Belgian patent. The court held that foreign patents are to be treated for purposes of section 103 as domestic patents. Therefore, “there is no reason, . . . to restrict the examination of foreign patents to their explicit claims and ignore

\begin{itemize}
  \item U.S.P.Q. 401 (E.D. Neb. 1978) (the patent was, however, held invalid under § 103 as representing “conventional engineering practice”).
  \item 35 U.S.C. § 102(a) (1976) provides in relevant part: “[T]he invention was . . . patented . . . in this or a foreign country before the invention thereof by the applicant for patent.”
  \item \textit{Id.} § 102(b) provides in relevant part: “[T]he invention was patented . . . in this or a foreign country . . . more than one year prior to the date of the application for patent in the United States.”
  \item \textit{Id.} § 102(d) provides in relevant part: “[T]he invention was first patented or caused to be patented . . . by the applicant or his legal representative or assigned in a foreign country prior to the date of the application for patents in this or on an application . . . held more than twelve months before the filing of the application in the United States”; see Duplan v. Deering Milliken Res. Corp., 353 F. Supp. 826, 177 U.S.P.Q. 515 (D.S.C. 1973), \textit{aff’d}, 487 F.2d 459, 179 U.S.P.Q. 449 (4th Cir.), \textit{cert. denied}, 415 U.S. 978 (1973).
  \item \textit{Compare} 35 U.S.C. § 102(a) and (b) (1976) with 35 U.S.C. § 102(d) (1976).
  \item \textit{See} Hefter, \textit{The Questionable Status of Those U.S. Patents Bearing Issue Dates Between March 7, 1978 and September 5, 1978—National and International Ramifications of United States Patent Printing Delay}, 60 J. Pat. Off. Soc’y 685 (1978), where the author deals with the short period in this country when patent printing was delayed, and accordingly we followed the “foreign” system of granting legal rights before the document itself was accessible.
  \item \textit{See note} 132 \textit{infra}.
\end{itemize}
what can be inferred from the claim."  

In *Ex parte Fujishiro*, the board held that a Japanese utility model patent does not become “patented” for purposes of section 102(d) when it is laid open for public inspection, but rather when it is afterwards published. The first event, the court held, does not create enforceable rights.

Further illustrating the different definitions of “patent” was *Ex parte Appeal No. 242-47*. Therein, the “De’livre” date of a French patent was held to create a section 102(d) bar. The board expressly distinguished this from the different situation under section 102(a) or section 102(b). Interestingly, once the board reached this conclusion, it held that the patent became prior art under 35 U.S.C. section 103.

But then came *In re Monks* which involved the question of when a British patent became “patented” under section 102(d). The British specification was published before the United States filing date but was “sealed” subsequently. Under British practice, infringement damages are backdated to the date of publication.

Examining the history of section 102(d) specifically and section 102 in general, the court held that “patented” should mean the same throughout section 102. That is, “patented” meant the granting or issuance of a legal right, and this occurred when the patent was sealed.

5. **Made in This Country by Another Who Has Not Abandoned, Suppressed, or Concealed It**

Under 35 U.S.C. section 102(g), a patent is not obtainable

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133. *Id.* at 77, 199 U.S.P.Q. at 73.
136. *Contra, In re Bass*, 474 F.2d 1276, 177 U.S.P.Q. 178 (C.C.P.A. 1973) (holding that certain portions of § 102 placed matter in the public domain for the purpose of being “prior art” for § 103, but included § 102(d) as a “loss of rights” section rather than as a “prior art,” or novelty section). According to *Bass*, an applicant could obtain a valid U.S. patent on an “obvious” modification of a § 102(d) reference. *See also Lee Pharma'l v. Kreps, Sec'y of Commerce*, 577 F.2d 610, 198 U.S.P.Q. 601 (9th Cir. 1978), *cert. denied*, 439 U.S. 1073, 200 U.S.P.Q. 832 (1979), where an effort under the Freedom of Information Act to gain access to abandoned patent application files was thwarted. The court held that abandoned applications must be maintained in secrecy.
138. *Id.* at 310, 200 U.S.P.Q. at 129: “the distinction . . . make[s] no sense from a policy standpoint.”
139. 35 U.S.C. § 102(g) (1976) provides in pertinent part: A person shall be entitled to a patent unless (g) before the applicant's invention . . . [it] was made in this country by another who had not
if “before the applicant’s invention thereof the invention was
made in this country by another who had not abandoned, sup-
pressed, or concealed it.” In Continental Copper & Steel Indus-
tries v. New York Wire Co., the contested patent was held
invalid based on the prior invention of another who had not
abandoned, suppressed, or concealed his invention. Once the
defendant had shown that the invention was previously made
by another, “the force of the statutory presumption of validity of
a patent fades, thereby shifting the burden to the patent holder
to establish that the first inventor abandoned, suppressed, or
concealed his invention.” “Abandonment” was not proved by
showing that the other had abandoned his own patent applica-
tion subsequent to the present inventor’s date.

6. Miscellaneous Prior Art Cases

In Rohm & Haas Co. v. Owens-Corning Fiberglass Corp., the
court confirmed the rule that, under section 102(e), where an
erlier filed application is relied upon as prior art, and that ap-
lication is a continuation-in-part of a still-earlier one, only the
teachings contained in the first application and carried over into
the continuation-in-part are prior art as of the first application
filing date. In other words, even though an invention is dis-
closed in an application, unless a patent issues which describes
the invention of the first application, the first application is not a
section 102(e) reference even though it is in fact accessible to
the public.

What the sections on prior art seem to suggest is that when
a court wants to hold a patent invalid, it will find a way. Having
one’s patents previously held valid in prior litigation, and
even being awarded a Nobel Prize for one’s discoveries, does not

abandoned, suppressed or concealed it. In determining priority . . .
there shall be considered . . . the respective dates of conception and
reduction to practice . . . the reasonable diligence of one who was first
to conceive . . . [and] and last to reduce to practice . . .

141. Id. at 36; accord, Allen v. Brady Co., 508 F.2d 64, 184 U.S.P.Q. 385 (7th
Cir. 1954).
U.S.P.Q. at 35.
144. 35 U.S.C. § 102(e) (1977) provides: “[T]he 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.”
1971), modified, 483 F.2d 858, 177 U.S.P.Q. 481 (5th Cir.), cert. dismissed, 414
help when a court really wants to hold a patent invalid.\textsuperscript{146} Nor does the fact that the court, to do this, holds as prior art the foreign priority date of a foreign inventor, contrary to what has long been regarded as settled law.\textsuperscript{147}

An example of this was illustrated in \textit{Studiengesellschaft Kohle mbH v. Eastman Kodak Co.}\textsuperscript{148} There the invention by Professor Karl Ziegler was a certain catalyst system for polymerizing olefins, especially ethylene, to solid polymers. He disclosed the system to an Italian scientist, Dr. Natta, who first used it successfully for polymerizing another olefin, propylene. Natta then filed his own patent application. Other courts had held that prior foreign applications of a party are not prior art as to a United States application.\textsuperscript{149} However, this court construed Ziegler's United States patents as attempting to cover Natta's invention. The court found there was no reference in Ziegler's United States applications to Natta's priority as to propylene and held that Natta's foreign applications were prior art.\textsuperscript{150}

\textbf{D. 35 U.S.C. Section 103—Patentability of Structurally Obvious Chemical Compounds}

One important case dealt with the question of whether structurally obvious chemical compounds can be patented as new compositions of matter on the basis of their having non-obvious properties, if they also have properties which are obvious.\textsuperscript{151} The case, \textit{In re May},\textsuperscript{152} has done much to reconcile some apparently conflicting authorities. A chronological approach to the issue is probably most helpful.

\begin{itemize}
  \item \textsuperscript{146} See \textit{Studiengesellschaft Kohle mbH v. Eastman Kodak Co.}, 197 U.S.P.Q. 164 (E.D. Tex. 1977).
  \item \textsuperscript{148} 197 U.S.P.Q. 164 (E.D. Tex. 1977).
  \item \textsuperscript{150} \textit{Studiengesellschaft Kohle mbH v. Eastman Kodak Co.}, 197 U.S.P.Q. at 175.
  \item \textsuperscript{151} 35 U.S.C. § 103 (1976) provides:
    A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 . . . 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 . . . .
  \item \textsuperscript{152} 574 F.2d 1082, 197 U.S.P.Q. 601 (C.C.P.A. 1978).
\end{itemize}
In the three *In re Hass*\textsuperscript{153} cases of 1944, the CCPA had held that “in order to be patentable, novel members of a homologous series of chemical compounds must possess some un-obvious or unexpected beneficial properties \textit{not possessed by} a homologous compound disclosed in the prior art.” This was repeated in the 1950 case of *In re Henze*,\textsuperscript{154} where the court said: 

The burden is on the applicant to rebut that presumption [of patentability of structurally related chemical compounds] by a showing that the claimed compound possesses unobvious or unexpected beneficial properties \textit{not actually possessed} by the prior art homolog. \textit{It is immaterial that the prior art homolog may not be recognized or known to be useful for the same purpose or to possess the same properties as the claimed compound}.'\textsuperscript{155} And this remained the law for some nineteen years.

Departure from \textit{Haas-Henze} was presaged by *In re Ruff*.\textsuperscript{156} The actual holding in \textit{Ruff} was that one’s own teachings of equivalency was not an admission that equivalency was obvious. The rationale of \textit{Ruff} was broader. “Prior art” meant only what the art itself taught or suggested, not what it taught or suggested after an applicant’s disclosure is available.

Expanding upon this rationale, the court in *In re Papesch*\textsuperscript{157} reversed the board’s decision which had relied on the \textit{Haas-Henze} precedents. Furthermore, in contrast to \textit{Haas-Henze}, where the prior art compound had no disclosed utility, the applicant in \textit{Papesch} demonstrated that the prior art did not in fact have the pharmaceutical property asserted for the new materials. An augmented board held this evidence irrelevant. This holding was reversed, as “the subject matter as a whole” in section 103 requires consideration of composition and properties:

Returning now to the decision of the board in this case, we think that it rests on one fundamental error of law, namely, the failure to take into consideration the biological or pharmaceutical property of the compounds as anti-inflammatory agents on the grounds that to chemists the structure of the compounds would be so obvious as to be beyond doubt, and that a showing of such properties is to be used only to resolve doubt.

From the standpoint of patent law, a compound and all of its properties are inseparable; they are one and the same thing. The graphic formulae, the chemical nomenclature, the systems of classification and studies such as concepts of homology, isomerism, etc., are mere symbols by which compounds can be identified, classified, and compared. But a formula is not a compound and while it

\textsuperscript{153} In re Hass, 141 F.2d 130, 60 U.S.P.Q. 552 (C.C.P.A. 1944); In re Hass, 141 F.2d 127, 60 U.S.P.Q. 548 (C.C.P.A. 1944); In re Hass, 141 F.2d 122, 60 U.S.P.Q. 544 (C.C.P.A. 1944).


\textsuperscript{155} Id. at 201, 85 U.S.P.Q. at 267 (emphasis added).


\textsuperscript{157} 315 F.2d 381, 137 U.S.P.Q. 42 (C.C.P.A. 1963).
may serve in a claim to identify what is being patented, as the metes and bounds of a deed identify a plot of land, the thing that is patented is not the formula but the compound identified by it. And the patentability of the thing does not depend on the similarity of its formula to that of another compound but on the similarity of the former compound to the latter. There is no basis in law for ignoring any property in making such a comparison. An assumed similarity based on a comparison of formulae must give way evidence that the assumption is erroneous.\(^{158}\)

In short, "obviousness of the compound... is realistically and legally, a composite of both structure and properties."\(^{159}\)

Shortly thereafter, the courts began to carve out exceptions to the Papesch rule.\(^{160}\) The courts held that where the prior art compounds were known to have certain properties, the discovery of a new property for a structurally obvious new compound required affirmative proof that the new property was absent (or, at least, not present to the same degree) in the old materials.\(^{161}\) However, the Haas-Henze precedent, and those cases explaining it, were limited or overruled in In re Stemniski.\(^{162}\) In Stemniski, the prior art compounds, which made the claimed ones structurally obvious, had no known or obvious utility. Under these circumstances, the court held that the discovery of any nonobvious utility in the novel compounds (irrespective of whether the old compounds in fact had the same utility) made the new compounds patentable. It asked the rhetorical question, among others:

\[\text{Why should it be said that a reference makes obvious to one of ordinary skill in the art an isomer, homolog or analog of related}\]

\(^{158}\) Id. at 391, 137 U.S.P.Q. at 51.

\(^{159}\) Id. at 392, 137 U.S.P.Q. at 52; accord, In re Ruschig, 343 F.2d 985, 145 U.S.P.Q. 274 (C.C.P.A. 1965); see Commissioner v. Deutsche Gold, 397 F.2d 656, 157 U.S.P.Q. 549 (D.C. Cir. 1968), where Judge [now Chief Justice] Burger quoted with approval "the sound reasoning of the Papesch case." But see In re Riden, 318 F.2d 761, 138 U.S.P.Q. 112 (C.C.P.A. 1963), where the court returned to the Haas-Henze rule stating, "It is true that [the prior art] does not teach that the compounds have insecticide properties, but that there is no showing that they don't."


\(^{161}\) In re DeMontmollin, 344 F.2d at 979, 145 U.S.P.Q. at 424, where the court reasoned "under the circumstances and weighing the available evidence, we do not regard the additional ability to dye cotton sufficient to render the subject matter as a whole unobvious."

\(^{162}\) 444 F.2d 581, 170 U.S.P.Q. 343 (C.C.P.A. 1971). Those cases which limited Papesch were distinguished and limited. See cases cited in note 152 supra. Focusing on In re Mod, 408 F.2d 1055, 161 U.S.P.Q. 281 (C.C.P.A. 1969), the court, which had distinguished Papesch, said that in that case "the primary reference also disclosed a significant utility for the prescribed compounds," 444 F.2d at 585, 170 U.S.P.Q. at 346 (emphasis in original), which one of ordinary skill would consider the structurally closely-related compounds of the claims to likewise possess.
structure, when that mythical, but intensely practical, person knows of no "practical" reason to make the reference compound, much less any structurally related compounds?163

The court concluded that since Henze had been "honored as much in its breach as in its observance,"164 and was illogical, Henze and Riden, "to the extent that [they] are inconsistent with the views expressed herein, they no longer will be followed and are overruled."165 Stemniski, however, was not immediately accepted by the other circuits or lower courts.166

But in In re Albrecht,167 the CCPA reaffirmed Stemniski. Albrecht involved the issue of "whether a novel chemical compound is unobvious . . . if it is discovered . . . to have a new and advantageous property not possessed by a prior art compound, notwithstanding the fact that it may possess a property known to be possessed by the known compound."168 There the prior art compound was disclosed as being "only faintly active" as an anesthetic and was irritating. The new compounds had antiviral activity, which was shown to be absent in the prior art compounds. Since the prior art compounds "cannot be regarded as useful" for the sole use disclosed (i.e., as an anesthetic), "a person having ordinary skill in the art would lack the 'necessary impetus' to make the claimed compounds."169 The court concluded that "a newly discovered activity of a claimed novel compound which bears no material relationship to the activity disclosed for the prior art analogs is further evidence, not to be ignored, of the nonobviousness of the claimed invention."170

In 1977, two cases from the CCPA retreated somewhat from Stemniski and Albrecht, not only by reason of their holdings but also because neither decision cited either Stemniski or Albrecht.171 In In re Wilder,172 the applicant claimed, as a new composition of matter, a novel chemical compound which was

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164. Id. at 587, 170 U.S.P.Q. at 348.
165. Id.
168. Id. at 1394, 185 U.S.P.Q. at 588.
169. Id. at 1396, 185 U.S.P.Q. at 590. In re Mod, 408 F.2d 1055, 161 U.S.P.Q. 281 (C.C.P.A. 1969), was distinguished because "the common property of the prior art compound was a specific significant property." 514 F.2d at 1396, 185 U.S.P.Q. at 590.
170. 514 F.2d at 1396, 185 U.S.P.Q. at 590.
the homologue of one prior art compound and the isomer of another. Wilder had discovered that his compound was an inhibitor for rubber and was nontoxic. The prior art compounds were taught as gasoline stabilizers, and the art said nothing about their toxicity. The fact that the applicant, Wilder, had discovered the property of nontoxicity was unavailing. It turned out that both of the prior art compounds were effective rubber inhibitors, and one was nontoxic. The court held:

Although appellant's evidence shows a substantial difference in skin toxicity between the claimed compound and the isomer, the evidence does not point out a single actual difference in properties between the claimed compound and the homologue. Wilder's discovery of the absence of skin toxicity in the claimed compound does not end the inquiry, because one who claims a compound, per se, which is structurally similar to a prior art compound must rebut the presumed expectation that the structurally similar compounds have similar properties. . . . Appellant has shown no actual difference in properties between the two compounds or any other evidence sufficient to rebut that expectation.

Because the expectation of similar properties stands unrebutted, it necessarily follows that an expectation of similar uses also stands unrebutted. This expectation of similar uses necessarily implies an expectation that the claimed compound would have been a substantially equivalent substitute for the prior art gasoline antidegradant and this expectation stands rebutted. Since this expectation of equivalency for the prior art use stands, we must conclude that it would have been obvious to use the claimed compound as a gasoline antidegradant. . . .

The second case, In re Shette, affirmed a board decision as to a composition claim but reversed as to the method claims. In Shette, the invention was to a class of compounds useful in curbing the appetites of animals, and the prior art had disclosed a similar (structurally obvious) class “to combat microbial infestation.” The court held:

Confronted with PTO evidence of obviousness, appellant has offered no evidence of unobviousness, as by showing an actual difference in properties between his compounds and the prior art compounds. . . . Appellant merely shows that his novel compounds are appetite suppressants, whereas the reference compounds are not so known. Further, appellant has not indicated whether his compounds are antiviral, as is [the] prior art compound. Presented with such an absence of comparative or other evidence with respect to the properties of the compounds and the claimed composition, we hold that composition claim 52 would have

175. Id. at 86, 195 U.S.P.Q. at 756.
been obvious from and unpatentable over the prior art.\textsuperscript{176} But as to the method claims, the courts directed their allowance even though the dosages of the prior art and of the claims were the same:

The Patent Office has failed to show a reasonable expectation, or some predictability, that [the prior art] compound would be an effective appetite suppressant if administered in the dosage disclosed by [another reference]. The mere hindsight assertion that corresponding dosages render appellant's method obvious is untenable . . . . That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown.\textsuperscript{177}

\textit{In re May},\textsuperscript{178} decided this past year, reversed the rejection of composition claims and held that even though one property of the new compound, analgesic (pain-relieving) capability, was obvious, another property, nonaddictiveness, was not obvious. Evidence in the case included an impressive showing that analgesic properties were not difficult to attain, but nonaddictiveness was a desideratum that was the long-sought goal of pharmaceutical researchers. As to these showings, the court observed:

[There is] uncontroverted evidence that the \textit{raison d'etre} for research for those skilled in this art was, and still is, not simply to produce another analgesic compound, but to produce one which would exert this therapeutic value while at the same time being nonaddictive. This, in our view, diminishes the significance that should be attached to the expected beneficial result of potent analgesic, i.e., it diminishes its evidentiary value that one skilled in the art would have been motivated to make appellants' compounds and to use them to effect analgesia, and enhances the significance that should be attached to appellants' unexpected result of nonaddictive, potent analgesic, i.e., it enhances its evidentiary value as an objective indicium of nonobviousness.\textsuperscript{179}

When considering the composition claims, the court emphasized that these were admittedly novel compounds.

The board had stated "that since the property of analgesic activity would have been expected, the fact that the prior art did not recognize another advantageous property (viz., nonaddictiveness) does not diminish the teaching of analgesic activ-

\textsuperscript{176} \textit{Id.} (citation omitted); \textit{see In re Hoch}, 428 F.2d 1391, 166 U.S.P.Q. 406 (C.C.P.A. 1970).


\textsuperscript{179} \textit{Id.} at 1093, 197 U.S.P.Q. at 610; \textit{see In re Labatino}, 387 F.2d 981, 156 U.S.P.Q. 212 (C.C.P.A. 1968) (also an analysis compound claim).
The CCPA, on the authority of *Albrecht*, disagreed as a matter of law. It said:

Thus, *merely* because those skilled in the art would have expected the compounds of Claim 11 to have analgesic activity, does not mean, as the board apparently suggests, that an irrebuttable presumption of obviousness has been established. Those properties which would have been expected must be balanced against the unexpected property.\(^{181}\)

The court distinguished the *Wilder* case on the facts and on the basis of an "implicit" assumption that had there been sufficient evidence in *Wilder*, the decision might have gone otherwise.

While there was an attempt to reconcile *May* with *Albrecht* and *Wilder*, the core issue was decided differently in *May* and *Albrecht* than in *Wilder*. In all three cases, and at least minimally in *Stemniski* and *Shette*, there was one obvious property and one nonobvious one. In all the cases, the applicant was unable to show that the nonobvious property was *in fact* absent in the prior art compound. Yet in *May, Stemniski* and *Albrecht*, the claims were allowed, while in *Wilder* and *Shette* they were not.\(^{182}\)

### E. 35 U.S.C. Section 112—Specification and Claims

Title 35 U.S.C. section 112,\(^ {183}\) which defines the requirements of the specification and its claims, continued to be the source of lively and inconsistent decisions. Curiously, the focus seems to be changing. In 1976, there was a disproportionately large number of "best mode" cases under section 112;\(^ {184}\) in 1977, the "description" requirement received the most attention;\(^ {185}\) but in 1978, several cases revived the "old combination" rejection, although there is uncertainty as to whether the rejection itself is proper under the statute.\(^ {186}\)

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180. *In re May*, 574 F.2d at 1093, 197 U.S.P.Q. at 610.
181. *Id.* (emphasis in original) (the court failed to mention *In re Shette*); see *In re Albrecht*, 514 F.2d 1389, 185 U.S.P.Q. 585 (C.C.P.A. 1975).
183. 35 U.S.C. § 112 (1976) provides in relevant part:
   The specification shall contain a written description of the invention, and of the manner and process of making and using it in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
184. See notes 209-22 and accompanying text infra.
185. See notes 179-93 and accompanying text infra.
186. See notes 231-48 and accompanying text infra.
1. Description

The "description" requirement of section 112 stems from the statutory language "a written description of the invention,"187 and means a written description in the specification commensurate in scope or breadth with the entire invention being claimed.188 Notwithstanding the requirement of a "written" description, it is settled that an inherent description in the specification is an adequate one.189

Whether a generic description or definition constitutes a written description of a species or sub-genus included within the genus is frequently a troublesome problem. It was considered in two cases this past year.190 In In re Edwards,191 the issue was whether the applicant could rely on an earlier application to provide a "written description" of the presently claimed invention, where it was necessary to select ingredients and narrow ranges within the scope of the earlier application in order to conform with the claims of the present case. Concluding that "each case turns on its own specific facts,"192 the court found in the earlier application a basis for selecting the restricted ranges and specific ingredients necessary to make out the later claimed invention. Explaining, the court stated:

The function of the description requirement is to insure that the inventor had possession as of the filing date of the application relied on, of the specific subject matter later claimed by him. To comply with the description requirement, it is not necessary that the application describe the claimed invention in ipis verbis; all that is required is that it reasonably convey to persons skilled in the art that, as of the filing date thereof, the inventor had possession of the subject matter later claimed by him. In the context of the present case, this translates into whether the patent application provides adequate direction which reasonably leads persons skilled in the art to the later claimed compound. By the very nature of this inquiry, each case turns on its own specific facts.193

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193. In re Edwards, 568 F.2d at 1351, 196 U.S.P.Q. at 467 (citations omit-
Recent Developments

In re Schreiber\textsuperscript{194} also involved the question of whether a generic disclosure supported a specific example embraced within, but not specifically stated as such in, the earlier application. In contrast to Edwards, the Schreiber court held that one could not claim a species based on an earlier-filed generic application which did not expressly disclose that species. Unfortunately, the decision in Schreiber is rather brief and does not explore the breadth of the problem. More case development is certain to occur.

2. Enablement

The “enablement” requirement of section 112, sometimes spoken of as the two requirements of “how to make” and “how to use,” derives from the statutory phrase “the manner and process of making and using [the invention] in such...terms as to enable any person skilled in the art...to make and use the same.”\textsuperscript{195} An applicant is required to provide an “enablement” of the entire scope or breadth of the invention.\textsuperscript{196} The “enablement” requirement, in brief, means that there must be a reasonable correlation between the scope of disclosure and the scope of the claims.\textsuperscript{197} In other words, people must be able to practice the invention over the entire claimed range.\textsuperscript{198}

\textsuperscript{196} Cf. Badowski v. United States, 278 F.2d 934, 125 U.S.P.Q. 656 (Cl. Ct. 1960) (invention covered by patent is defined by language of patent claim and not by specification, specification merely teaches others one or more ways of practicing the invention).
\textsuperscript{197} Charvat v. Commissioner of Patents, 503 F.2d 138, 182 U.S.P.Q. 577 (D.C. Cir. 1974), where the court stated:

The final test is whether the appellant’s claims are sufficiently definite to allow a person of ordinary skill in the art to produce appellant’s wheel without undue experimentation. Since...appellant has already received a process patent, that very fact implies that one skilled in the art could easily and mechanically reproduce the claimed invention.

\textsuperscript{198} Talouck v. Nubel, 559 F.2d 1183, 194 U.S.P.Q. 521 (C.C.P.A. 1977)}
Failure to comply with the "enablement" requirement is a ground for invalidating a patent, even in a motion for summary judgment. In *Hanes Corp. v. Millard*, information was deliberately left out of the patent. A document admitted that "[t]he practical and extremely important point of the lengths of thread in each type of stitch was not explained in the Picard patent because it was wished at the beginning to make the task more difficult for eventual counterfeiters." When a potential licensee was unable to produce the claimed fabric, invalidity was established. Even though the patent was directed to a novel fabric, the patentee's argument that the fabric could be made on other prior art machines not disclosed in the patent was unavailing.

In the PTO, a patent's teaching as to how to practice the invention over the claimed range must be accepted as true unless the Office has a reasonable basis for asserting that the specification was incorrect. Nor is it a basis for holding that enablement is faulty where the claims may include an inoperative range or an inoperative number of components. Once the Office does, however, establish a reasonable basis for asserting that the specification is non-enabling over its entire range, "the burden shifted to appellant to show that one of ordinary skill in the art could practice the claimed invention without undue experimentation." As the court in *In re Sichert* explained:

In determining what constitutes undue experimentation, many factors are taken into account, including the guidance provided by the specification for selecting those embodiments of the invention which achieved the disclosed utility. Such guidance is essential where the invention involves an unpredictable art. . . . [t]he scope (those skilled in the art should not have to perform undue experiments); *In re Bode*, 550 F.2d 656, 193 U.S.P.Q. 12 (C.C.P.A. 1977) (persons skilled in the art to complement that which has been done); *cf. In re Stephens*, 529 F.2d 1343, 189 U.S.P.Q. 659 (C.C.P.A. 1976) (other considerations are the nature of the invention, the state of the prior art and the relative skill of those in that art); *In re Armbruster*, 512 F.2d 676, 185 U.S.P.Q. 152 (C.C.P.A. 1975) (does not have to convince those skilled in the art that assertions are correct).

200. *Id.* at 309, 196 U.S.P.Q. at 160 (emphasis in original).
201. *Id.* at 309, 196 U.S.P.Q. at 160 (emphasis in original).
of enablement varies inversely with the degree of unpredictability of the involved factors.\textsuperscript{206}

However, where the characteristics of a material are known, the material need not be defined with precision in the specification in order to comply with “enablement.”\textsuperscript{207} In \textit{In re Goodwin},\textsuperscript{208} the claims involved carbonmonofluoride; one claim called it “(\text{CF}_x)_n.” A section 112 rejection was reversed as the court held:

Despite the undefined subscripts in the term (\text{CF}_x)_n, when we read these claims in light of the specification, as we must, we are constrained to accept the appellants’ contention that the aforementioned term, as employed in their application, is synonymous with carbonmonofluoride, which the Board described as “a known material of known properties.” Notwithstanding appellants have used the claim terminology “known as (\text{CF}_x)_n” and have nonetheless utterly failed to provide evidence of the knowledge in the art, we find enough, though by no means overwhelming, support in the specification to conclude that one skilled in the art would be apprised of a reasonable degree of particularity and distinctness.\textsuperscript{209}

3. \textit{Best Mode}

The “best mode” requirement of section 112 comes from the phrase “the best mode contemplated by the inventor of carrying out his invention.”\textsuperscript{210} The year of the “best mode” was 1977. This previously undiscovered section of the statute was applied, either as the sole or as the main basis for invalidity, in four cases.\textsuperscript{211} It was asserted but not sustained in two cases.\textsuperscript{212}

This past year, the defense was alive and well, but not nearly so successful.\textsuperscript{213} In \textit{Thyssen Plastic Anger K.G. v. In-}


\textsuperscript{207} \textit{In re Goodwin}, 576 F.2d 375, 198 U.S.P.Q. 1 (C.C.P.A. 1978); \textit{cf.} \textit{Edison Elec. Light Co. v. United States Elec. Light Co.}, 52 F. 300 (2d Cir. 1892) (something may be left to the knowledge and skill of the mechanic or manufacturer and yet be definite).


\textsuperscript{209} \textit{Id.} at 378, 198 U.S.P.Q. at 3.


\textsuperscript{212} \textit{E.g.}, \textit{Columbia Broadcasting Sys., Inc. v. Zenith Radio Corp.}, 537 F.2d 896, 192 U.S.P.Q. 68 (7th Cir. 1976); \textit{International Tel. & Tel. Corp. v. Racher Corp.}, 188 U.S.P.Q. 214 (D. Mass. 1975), \textit{aff'd}, 538 F.2d 453, 191 U.S.P.Q. 1 (1st Cir. 1976); \textit{see Studiengesellschaft Kohle mbH v. Eastman Kodak Co.}, 197 U.S.P.Q. 164 (E.D. Tex. 1977) (one of many successful defenses was that the best mode requirement had not been complied with).

\textsuperscript{213} \textit{See} Carlson, \textit{Best Mode Disclosure Requirement in Patent Practice},
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duplas, Inc., the patent concerned a method for forming extruder pipes or tubes. This involved a periodic slowing down of the speed at which the length of the pipe traveled to create a thickened portion of the pipe. This slowing was accomplished by a “second gear” attachment, which was shown in the patent as merely a box marked “conventional.”

The First Circuit reversed the lower court’s summary rejection of the patent. Without commenting on the “contemplated by the inventor” phrase of section 112, it held that there were factual issues as to whether the “second gear” was in fact the best mode and whether it was in fact “conventional and known.”

In Carpet Seaming Tape Licensing Corp. v. Best Seam, Inc., the patentee intentionally failed to disclose the best mode of carrying out his invention. The court held that the failure to disclose the need for an impervious carpet seaming tape, a “necessary element” of the invention, “when it was known to the inventor at the time he filed [his] application... was... fraud of the Patent Office and of the public.” The invention, which was accompanied by widespread copying and extensive licensing, was lost. Further, once the main patent was declared invalid by reason of “unclean hands,” all the other patents in the package were held unenforceable by failing to disclose the best mode.

Although the best mode contemplated by the inventor must be disclosed, this need not take the form of an actual working example. And only a single “best mode” need be disclosed.

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215. Id. at 400, 200 U.S.P.Q. at 198.

216. Id.

217. Id. at 402, 200 U.S.P.Q. at 199. The court held, “Summary judgment is not to be turned into a trial by affidavit... (I)t is not to be turned into a trial by affidavit and depositions. The resolution of genuine issues of material fact can only be decided after a trial on the merits.” See Studiengesellschaft Kohle mbH v. Eastman Kodak Co., 197 U.S.P.Q. 164 (E.D. Tex. 1977) (where one of many successful defenses was that the best mode requirement had not been complied with).


219. Id. at 247; cf. Lockheed Aircraft Corp. v. United States, 553 F.2d 69, 193 U.S.P.Q. 449 (C.C.P.A. 1977) (only has to disclose best mode conceived by him, not all conceivable modes).


The "best mode" is an essential requirement of section 112, and an applicant must comply with this in order to be entitled to rely on an earlier-filed application under section 119 or section 120.222 Thus, in an interference,223 if there is evidence that a party failed to disclose the best mode, the evidence must be considered. The evidence is ancillary to the priority issue (of the second application) and if sustained will prevent reliance on an earlier application.224

4. Particularly Pointing Out and Distinctly Claiming

The requirement that the claims "particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention" appears in the second paragraph of 35 U.S.C. section 112.225 In general, this means that the claims must have a reasonably definite and determinable meaning so that persons reading the patent will have a fair idea of the scope of the protection.226

In Gould, Inc. v. Graphic Controls Corp.,227 the court was confronted with different meanings of the word "surface" as applied to the base and to the bumps on an electrostatic printing paper. Recognizing that there were "some problems of word usage which were not at all felicitously resolved" in the patent, and that this had caused a "semantic mire," the court nonetheless found that the claims were sufficiently definite for validity and to establish infringement.228

The court in Duplan Corp. v. Deering Milliken, Inc.229 considered particularity and distinctness among the innumerable grounds for invalidating patents. The court said:

222. See 35 U.S.C. §§ 119-120 (1976). These provisions provide an advantage for applicants within the United States over those applying in foreign countries.


228. Id. at 17. The court held that there is a heavy burden on those claiming the patent to be invalid); see King-Seeley Thermos Co. v. Tastee Freez Indus., Inc., 357 F.2d 875, 149 U.S.P.Q. 4 (7th Cir. 1966).

The court agrees with the plaintiffs that the patent law does not require alleged infringers to play this type of Russian roulette. The patentee simply failed to inform the public of the limits of his monopoly with the result that those producing the yarns could never know which process could be safely used without a license and which could not. The patent is void for indefiniteness under 35 U.S.C. § 112.230

5. Old Combination

A surprising development this year is the resurgence of the "old combination" rejection, that is, the ostensible impropriety of a claim covering the combination of a novel element with old elements.231 The doctrine dates back to the Supreme Court decision of *Lincoln Engineering Co. v. Stewart-Warner Corp.*232 This past year in *Jamesbury Corp. v. Litton Industrial Products, Inc.*,233 the court explained:

That case [*Lincoln*] involved a suit for contributory infringement against a supplier of an old element which was included in the claim of the alleged combination patent. The patent claimed a combination of a grease gun, hose, coupler and fitting of the type commonly used for packing wheel bearings. All the elements, as well as their use in combination, were known to the art. The only novelty stemmed from improvement in the "chuck" or coupler that utilized fluid pressure to "cock" the jaws of the coupler after each operation. The basic structure of even the "chuck" remains conventional however. The Supreme Court held that the minor improvement in the coupler does not justify a claim embracing the entire mechanism. "[T]he improvement of any one part of an old combination gives no right to claim that improvement in combination with other old parts which perform no new function in the combination."234

On the purported authority of *Lincoln*, at least one lower court had held invalid claims to a combination of elements where one of the elements was new, but where the overall combination was old (in a loose sense).235

The next major development occurred in *In re Gustafson*.236 The case actually involved a rejection on "aggregation" and was

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reversed and remanded because the Patent Office had never explicitly said what part of the statute authorized such a rejection. This was taken by the bar and by the bench as a disavowal of the “old combination” rejection. However, two years later, the CCPA in In re Bernhart found a statutory basis for the “old combination” rejection. The court held that section 112 authorized the rejection.

Illustrating the rebirth of the defense were five recent decisions which concerned the “old combination” rejection. In Pettibone Corp. v. Fargo Machine & Tool Co., the issue was whether the supplier of an unpatented component of a patented combination was liable as an infringer if the component was the novel element in a combination claim. Conversely, was the claim valid? After reviewing the authorities, the court answered “yes” to both questions, stating:

> Where a combination patent claims one component as its principal novelty, and that novelty is described in an environment of old elements, a party who supplies a novel element to be used in the environment described in the patent is a contributory infringer. There would be no contributory infringement if a party supplied one of the old elements as a replacement part, and no contributory infringement if a party supplies the novel component for a different purpose. But when a party supplies the novel components for use in the defined environment, the patentee has a cause of action for contributory infringement.

Then, in Jamesbury Corp. v. Litton Industrial Products, Inc., the Connecticut district court declined to follow a prior Court of Claims adjudication of a patent on an improved seal for a ball valve, where the claims were to the combined ball, valve, and improved seal. The “old combination” defense had been raised but rejected by the Court of Claims in a prior suit, although this was not appreciated by the district court. Applying Lincoln and its progeny, the district court granted summary judgment of invalidity on the ground of old combination.

Promptly thereafter, the defendants in the Court of Claims

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239. In re Bernhart, 417 F.2d at 1403, 163 U.S.P.Q. at 618, where the court stated, “The Patent Office Board of Appeals ... in Ex parte Des Granges, 864 O.G. 112, 162 U.S.P.Q. 379 (1968) ... found that there was a statutory basis for the rejection in that portion of section 112 which requires that the claims specifically point out and distinctly claim the invention.”
241. Id. at 1283, 198 U.S.P.Q. at 47.
moved for modification in that court based on the Connecticut decision.\textsuperscript{243} This was denied for several reasons, one of which was that the predicate of the Connecticut decision, namely that old combination had not been involved in the Court of Claims, was erroneous.

On appeal from the Connecticut case, the Second Circuit reversed.\textsuperscript{244} After extensively reviewing the authorities, it concluded:

A combination claim containing elements old in the art may be patented, not only when it discloses a “new function” within the meaning of Lincoln Engineering, \textit{supra}, but also when, by cooperation of the elements claimed, it discloses a new result that represents a marked improvement over prior art.

\ldots

Moreover, we think that the addition of the elements of ball and valve to the novel sealing ring narrowed rather than broadened the claims. The aphorism that “in a patent claim, more means less” is true here. Jamesbury is not attempting to prevent others from using \textit{any} ball valve but is attempting to prevent others from using only a ball valve with a sealing ring like this.\textsuperscript{245}

Indeed, as a matter of utility, “the novelty lies in the very combination of valve, ball and sealing rings.”\textsuperscript{246}

The last case concerning “old combination” was \textit{Duplan Corp. v. Deering Milliken, Inc.}\textsuperscript{247} The court applied the defense and, largely on that basis, invalidated one of the patents, stating:

Contrary to defendants' argument, the heater elements on the “375” patent does not “cooperate” with the other elements within the meaning of the Lincoln Engineering doctrine, for cooperation with other elements means something more than the performance by each element of the same function in the same manner it was designed to perform. Normally all elements, old or new, must of necessity “co-act” or the machine will not operate. In order to support a finding of invention, however, it must appear that the co-action of the improved elements with the old element has a synergistic effect \ldots

In summary, the “375” patent represents nothing more than the sixth repatenting by Chavanoz of an old combination with one element, the heater, improved, with the other element performing the same function in identical fashion in each of the “invention” and with any results in the operation of the overall apparatus being di-


\textsuperscript{244} Id. at 923-24, 199 U.S.P.Q. at 647-48. (emphasis in original).

\textsuperscript{245} Id. at 921, 199 U.S.P.Q. at 644; cf. \textit{Reese v. Elkhart Welding & Boiler Works, Inc.}, 447 F.2d 517, 171 U.S.P.Q. 129 (7th Cir. 1971) (combination of elements to produce a new and useful result).

rectly attributable to the improvement in the heater element. The patent is condemned under the doctrine of Lincoln Engineering.248

6. Markush Claims

One day someone will build a monument, a large one, to the attorney in Ex parte Markush.249 Not only did he patent an invention, but he invented a patent. And, further, he made more work for more lawyers than anyone outside of Congress.

Scarcely a year goes by without there being extensive developments in Markush claim practice. In recent years the controversy has centered around the PTO's procedure of "withdrawing from consideration" of a Markush claim and refusing to consider it on the merits because it was directed to "multiple patentably distinct inventions."250 The 1978 Markush issue was whether 35 U.S.C. section 121251 is a basis for withdrawing, rejecting, objecting to, or otherwise disallowing a Markush claim which embraces "patently distinct" species.252

In In re Weber,253 the claims were rejected "for misjoinder under 35 U.S.C. section 121" and "as being improper Markush claims."254 The latter rejection was treated by the CCPA as being "supportive" of the former. The court first held that it had jurisdiction over both rejections but then proceeded to contend that section 121 provides a basis for rejecting Markush claims which embrace two or more distinct inventions. The court reasoned that this would be improper:

An applicant is given, by the statute, the right to claim his invention with the limitations he regards as necessary to circumscribe that invention, with the proviso that the application comply with the requirements of § 112. We have decided in the past that § 112, second paragraph, which says in part "[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention" allows the inventor to claim the invention as he contemplates it. In re Wolfrum, 486 F.2d 588, 179 USPQ 620 (CCPA 1973).

As a general proposition, an applicant has a right to have each

248. Id. at 713-18, 197 U.S.P.Q. at 398-402 (you pay your money, you take your choice).
251. 35 U.S.C. § 121 (1976) provides in relevant part: "... if two or more independent and distinct inventions are claimed in one application the Commissioner may require the application to be restricted to one of the inventions."
254. Id. at 459, 198 U.S.P.Q. at 332.
claim examined on the merits . . . If, however, a single claim is
required to be divided up and presented in several applications,
that claim would never be considered on its merit. The totality of
the resulting fragmentary claims would not necessarily be the
equivalent of the original claim. . . .

Reasoning further, the court recognized that the Office
"must have some means for controlling such administrative
matters as examiner caseloads and the amount of searching
done per filing fee." This, however, does not justify transgres-
sion of the statute. The court reasoned, "But, in drawing priori-
ties between the Commissioner as administrator and the
applicant as beneficiary of his statutory rights, we conclude that
the statutory rights are paramount. We hold that a rejection
under § 121 violates the basic right of the applicant to claim his
invention as he chooses." Accordingly, the rejection was re-
versed and remanded for consideration of the "improper Mar-
kush" rejection.

Judge Rich concurred in Weber. He argued that section
121 "says nothing whatever about the rejection of claims, a mat-
ter entirely separate from restriction." He emphasized:

The practice here challenged is tantamount to a refusal by the
PTO to examine a single Markush claim in a single application be-
cause, in its opinion, it is broad enough to 'embrace' or 'cover' a
plurality of inventions which, if presented separately, would be
separately patentable, assuming any one of them to be prior art.

He then went on to deplore the attempts by the PTO to stave off
appellate review of its Markush claim practices, terming them
"mere semantic gamesmanship."

The upshot of Weber is that the Office now has to find a new
basis for rejecting Markush claims as being "improper." Merely
because the claims cover several inventions is not, under the
statutes, sufficient basis for sustaining a rejection.

255. Id. at 458, 198 U.S.P.Q. at 331.
256. Id.
257. Id. at 458-59, 198 U.S.P.Q. at 332; In re Hass, 580 F.2d 461, 198 U.S.P.Q.
334 (C.C.P.A. 1978) (§ 121 does not provide a basis for rejection of a claim).
259. Id. at 460, 198 U.S.P.Q. at 333 (emphasis in original).
260. Id. at 461, 198 U.S.P.Q. at 334.
on requirement that different claims must be "patentable over each other" was
improper); see Ex parte Lewis, 197 U.S.P.Q. 543 (Bd. App. 1977) (as to
what constitutes a "proper" as opposed to an "improper" claim: the Exam-
iners are admonished to view the claimed compounds as a whole, not as to
whether the particular functional groups on a chicken wire formula are
chemically related or unrelated).
Section 135(b) of the Patent Act provides that:

A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.262

In Corbett v. Chisholm,263 the court considered two aspects of section 135(b): can one rely on claims previously cancelled from the pending application, and can one “combine” several claims to meet the “substantially the same subject matter” requirement? In Chisholm, the specifications of both parties were directed to a method of blow-forming plastics in forming sheets. Corbett provoked an interference by copying claims from Chisholm’s patent some 26 months after the patent was issued, and he sought to meet the exception to the one-year cutoff of section 135(b) by asserting that he had been claiming “the same or substantially the same subject matter” earlier.

First the court traced the history of section 135(b), both in the courts and legislature.264 This statute was essentially a statute of limitation intended to secure a patentee’s right, after his patent had been issued for a period of time, unless there was an exceptional situation.265 Such a situation would be provided by another person claiming “the same or substantially the same subject matter” when or shortly after the patent had issued.266 The court held that it must consider claims pending in the application prior to the issuance of the opponent’s patent, even though the claims had been cancelled prior to the issuance.267

Secondly, the court held that the doctrine of inherent disclosure was applicable. However, the inherency required a “necessity” that a limitation of the issued patent be produced when the application claims are followed.268

Thirdly and most importantly, the court discussed whether

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265. See In re Sity, 331 F.2d 617, 141 U.S.P.Q. 505 (C.C.P.A. 1964) (rejected because filed more than one year after issuance date).
268. Id. at 766, 196 U.S.P.Q. at 345.
it could consider several of the application claims together as evidencing a claim for “the same or substantially the same subject matter” as the patent claimed.\textsuperscript{269} Unfortunately, in the present case there were two species involved, and the prior claims were directed to one of the species while the patent claims primarily concerned the other. The court held, as it rejected the claims:

We believe, however, that there is a substantial difference between that which is to be gathered from the perusal of a group of related claims to the \textit{same} invention and that which is to be gathered from the perusal of a group of claims to \textit{related} inventions. The more divergent the subject matter of the individual claims, the less likely it is that coverage of the interstices there between is realized . . . . In our opinion, a reading of all four groups of claims, together, does not manifest a unitary scheme or attempt to secure a property right on the subject matter defined by [the patent].\textsuperscript{270}

\textbf{G. 35 U.S.C. Section 141—Decisions}

Reference was made earlier to cases on Markush claim practice, many of which indirectly concerned 35 U.S.C. section 141, which defines the jurisdiction of the CCPA in terms of what is a “decision of the Board of Appeals.”\textsuperscript{271} Here the courts consider the statutory phrase “an applicant dissatisfied.”\textsuperscript{272}

The interesting case of 1978 on what is an “applicant dissatisfied with a decision of the Board of Appeals” was \textit{In re Priest}.\textsuperscript{273} The appellant had won before the board. The board’s decision, however, in reversing the rejection of composition claims, said that these claims contained a “necessarily inferential” limitation to “particular reaction conditions” of the process claims.\textsuperscript{274} The successful appellant took the case to the CCPA “because he regarded his claimed compositions as patentable under the statute without the [process] limitation.”\textsuperscript{275} In other words, he was “[a]n applicant dissatisfied with the decision of the Board of Appeals” according to section 141.

The CCPA held that it had jurisdiction under section 141 inasmuch as the board’s captioned “Opinion and Decision” expressly found process limitations to be inherently present in the

\begin{itemize}
\item \textsuperscript{269} \textit{Id.}
\item \textsuperscript{270} \textit{Id.; cf.} Engineering Dev. Lab. v. Radio Corp. of Am., 153 F.2d 523, 68 U.S.P.Q. 238 (2d Cir. 1946) (not a different invention if it does not go further than a previous invention).
\item \textsuperscript{271} \textit{See} notes 209-11 and accompanying text \textit{supra}.
\item \textsuperscript{272} \textit{See} 35 U.S.C. § 141 (1976).
\item \textsuperscript{273} 582 F.2d 33, 199 U.S.P.Q. 11 (C.C.P.A. 1978).
\item \textsuperscript{274} \textit{Id.} at 35, 199 U.S.P.Q. at 13.
\item \textsuperscript{275} \textit{Id.} at 36, 199 U.S.P.Q. at 13.
\end{itemize}
appealed composition claims. On the merits, the board had erred by importing an “inferential limitation” into claims that did not recite such limitation. The court found that the claims, even absent the “inferential limitation,” comported with section 112.

H. 35 U.S.C. Sections 116 & 256—Misjoinder and Nonjoinder of Inventors

Sections 116 and 256 of the Patent Act allow either the Commissioner or a court (after notice and hearing) to correct inventorship by either adding an erroneously omitted co-inventor or by deleting an erroneously added one. A condition of either change is that there had been “error . . . without deceptive intention.” But if there is either nonjoinder or misjoinder of inventors, and this cannot be corrected, the patent may be held invalid under a number of sections of the Act.

Two cases this past year dealt with inventorship problems and their correction. First, in Weil v. Fritz, the court formally authorized the common practice of changing inventorship by the method of filing a continuation-in-part application and using the oath or declaration as the medium for correcting misjoinder or nonjoinder. The words “the same inventor” in 35 U.S.C. section 120 are “broadly interpreted to embrace the possibility” of an amended inventorship. The procedure for filing a continu-


277. 35 U.S.C. § 116 (1976) provides: “An invention must be patented by the joint inventors unless one or more refuse to join or can not be found.”

278. 35 U.S.C. § 256 (1976) provides: “If one of the joint applicants was not a joint inventor, upon notice and hearing, the Commissioner may issue a certificate deleting the name.”

279. The patents may be held invalid under 35 U.S.C. §§ 102(f) (he did not invent the subject matter himself); 111 (requiring specification, drawing, and oath); 115 (oath that he is 1st inventor). See also Meikeljon, Misjoinder, Non-joinder, and Whatever—Stoddard v. Dann, 60 J. Pat. Off. Soc’y 505 (1978), which discusses A.F. Stoddard & Co. v. Dann, 584 F.2d 556, 195 U.S.P.Q. 97 (D.C. Cir. 1977), where the court had filled in the “intervals” of the Patent Act and permitted a complete change of inventorship; that is, changing a sole application from one inventor to another without retaining any inventor in common.


281. See 35 U.S.C. § 120 (1976). The continuation in part is still entitled to the benefit of the filing date of the earlier application.
nation-in-part to correct inventorship is "legally equivalent" to a section 116 inventorship amendment.\textsuperscript{282}

The court further held that the continuation-in-part oath or declaration:

Is not material to the question . . . of entitlement under § 120 to the benefit of [the earlier application]. The applicant's oath is not a requirement of § 112, first paragraph, but of 35 U.S.C. § 115; therefore the sufficiency of [the continuation-in-part] oath is not material under § 120, which incorporates only the requirements of § 112, first paragraph.\textsuperscript{283}

\section{35 U.S.C. Section 251—Reissues}

In keeping with the current trend, now formalized in what has come to be called the "Dann Amendments,"\textsuperscript{284} concerning reissuing a patent either in contemplation of litigation or in the course of it, there is an ever increasing number of cases concerning reissues.\textsuperscript{285}

In \textit{Fisher Controls Co., Inc. v. Control Components, Inc.},\textsuperscript{286} the court considered whether it should stay the court proceedings until the outcome of the PTO reissue proceedings. According to the court, the consideration must be "whether a stay of proceedings [in court] pending the outcome of the reissue application, will be of significant benefit to the litigation to justify a further delay in an already lengthy case."\textsuperscript{287}

Holding that here a stay should be granted, the court explained:

The rules governing reissue of patents were amended with the stated purpose of establishing greater reliability of issued patents, strengthening the examining procedures, and providing incentive

\textsuperscript{282} \textit{Compare} 35 U.S.C. § 116 (1976) (joint inventors) \textit{with} § 120 (application subsequent to previous filing by same inventor accorded earlier filing date).

\textsuperscript{283} \textit{Weil v. Fritz}, 572 F.2d at 863, 196 U.S.P.Q. at 608 (C.C.P.A. 1978). The second case involving inventorship and its correction is \textit{Matter v. Tiegel}, 196 U.S.P.Q. 395 (B.P.I. 1976), which held that conversion from joint to sole inventorship is permitted where the conversion is made with reasonable diligence.

\textsuperscript{284} \textit{See} 955 O.G. 1054 (February 22, 1977).

\textsuperscript{285} \textit{See} 35 U.S.C. § 251 (1976), which provides in relevant part:

Whenever a patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent . . . reissue the patent for the invention disclosed in the original patent . . . .


\textsuperscript{287} \textit{443 F. Supp. at 583, 196 U.S.P.Q. at 819}. 
Recent Developments

Recent developments to investment in research and development. As amended, 37 C.F.R. § 1.175, "permits a patent owner to have new prior art considered by the Office by way of reissue application without making any changes in the claims or specifications." The procedure may be used at any time during the period of the patent, and it is suggested that the federal courts may stay proceedings to allow the process of a reissue application, permitting new art to be considered by the PTO.

Although not equal to the litigation opportunities of discovery and confrontation, the new rules do allow for protest. Under 37 C.F.R. § 1.291, members of the public are afforded a means to both protest the reissue and to cite prior art to the PTO.

The examination procedure, as amended, offers some assurance that reissue applications will be handled promptly. While requiring a two month delay to assure notice to all interested parties, the rules give priority to reissue applications over all other applications.

The benefits of the new rules must, of necessity, be found in informed prediction . . . . However, several distinct advantages can be observed in allowing examination of a reissue application before continuing with patent litigation.

1. All prior art presented to the court will have been first considered by the PTO, with its particular expertise.
2. Many discovery problems relating to prior art can be alleviated by the PTO examination.
3. In those cases resulting in effective invalidity of the patent, the suit will likely be dismissed.
4. The outcome of the reexamination may encourage a settlement without the further use of the Court.
5. The record of reexamination would likely be entered at trial, thereby reducing the complexity and length of the litigation.
6. Issues, defenses, and evidence will be more easily limited in pre-trial conferences after a reexamination.
7. The cost will likely be reduced both for the parties and for the court.\footnote{288}

One of the reasons for reissue under 35 U.S.C. section 251 is to allow corrections if the patent, through error, is deemed wholly or partly inoperative or invalid "by reason of the patentee claiming more or less than he had a right to claim in the patent."\footnote{289} Sometimes, although incorrectly, this has been termed an inquiry of what the patentee originally "intended to claim."

In \textit{In re Mead},\footnote{290} the difference between the statutory test of "had a right to claim" and the concept of "intent to claim" was clarified. The appellant in \textit{Mead} sought a reissue for the purpose of broadening its broadest claims and then inserting new

\footnote{288} Id. \textit{But see} General Tire \& Rubber Co. v. Watson-Boumal Assoc., Inc., 193 U.S.P.Q. 497 (D. Del. 1977) (the court granted the motion to stay).
claims to subject matter originally disclosed as preferred (the orientation of bristles) but not originally claimed in the patent.

What apparently happened in *Mead* was that the patentee intended to claim the preferred embodiment in a new application filed within a year after the basic patent issued. Later it was discovered this was impossible by reason of an intervening interference. Thus, it was imperative, in order to obtain protection on the preferred embodiment, to insert specific claims to that embodiment in a reissue of the main case.

The court first reviewed the cases concerning the concept of whether a reissue could only be for subject matter which the patentee had originally "intended to claim." The court explained, "Thus, 'intent to claim' arose from the requirement that the reissue be for the 'same invention' as the original, i.e., that it cover what was 'intended to have been covered' by the original."

As *Mead* explained, there is no requirement of the reissue statute that the reissue could only be for what the patentee had "an intent to claim"; rather, the inquiry is whether there was a description of the invention which is the subject of the reissue. Explaining this, the court stated:

Thus, in *Rowand* and similar cases, "intends to claim" has little to do with "intent" per se, but rather is analogous to the requirement of § 112 first paragraph that the specification contains "a written description of the invention, and of the manner and process of making and using it." It is, as appellant urges, synonymous with "right to claim." Objectively, the record showed that "the subject matter of the appealed claims was never intended to be claimed in the original application, and therefore there was no error within the meaning of section 251."
IV. PATENT & TRADEMARK OFFICE PRACTICE

A. Interference Estoppel

The doctrine of interference estoppel is a peculiarity of PTO practice. What it means is that the loser of an interference ordinarily cannot obtain claims which (1) read on the lost claims or (2) cover "clearly common subject matter" in the interfering applications (or application and patent). He can obtain claims which differ only in "obvious" ways from those lost in the interference, unless his opponent's work or application is otherwise statutory prior art.

This past year in Chemetron Corp. v. Airco, Inc., the trial court was confronted with inconsistent decisions by the Board of Patent Interferences. Solomonically, it rejected both the inconsistent decisions and the doctrine of interference estoppel, stating:

In the first place, we have doubts about the applicability of the doctrine of interference estoppel in the Seventh Circuit and in this

specification but what the error is." Id. at 231; cf. Wayne-Gossard Corp. v. Moretz Hosiery Mills, Inc., 447 F. Supp. 12, 199 U.S.P.Q. 87 (W.D.N.C. 1977) (discussed intervening rights as applied to narrowed reissues and the effect of such intervening rights in patent accounting actions); SAB Indus. AB v. Bendix Corp., 199 U.S.P.Q. 95 (E.D. Va. 1978). In Bendix Corp., the reissue application "was not made through inadvertence, accident or mistake, by reason of which the specification as originally drawn is defective or insufficient" but was "made to enlarge the claims in order to embrace the non-infringing defendant's device which had or was about to come into legitimate use"; the reissue was invalid.


court. Research discloses that in recent years, only the Court of Customs and Patent Appeals has followed this doctrine.

Second, the doctrine of interference estoppel has been narrowly applied even by the Court of Customs and Patent Appeals.

Even if the doctrine of interference estoppel is applicable in this court, and even if the facts of this case fit within its contours the ... patent should not be invalidated as a result. The reason is that each time the Court of Customs and Patent Appeals held a patentee estopped, there was a clear and uncontradicted finding of priority by the Board of Patent Interferences. Here, we simply cannot rely on the finding in favor of [one party] in view of the finding in favor of [the other].

B. Interference Practice

Several important decisions came down this past year on various aspects of interference practice. While none made new law, a few were out of the ordinary.

1. Derivation

A few cases treated derivation as the principal issue in an interference. Stated otherwise, the priority question was not who was the first inventor, but who was the inventor.

In Mead v. McKirnan, McKirnan was able to prove that Mead had derived the invention from him. Derivation requires proof both of a complete conception and of communication to the opponent. Having found that McKirnan was the originator of the independent count of interference, the court, without explanation, stated that dependent counts "are obvious variations of the invention of count 1 and therefore rightly belong to

The article gives a number of instances where a foreign inventor either can obtain the benefit of foreign activities, or deny a United States inventor the benefit of domestic ones.

298. Id. at 125 (citations omitted).
299. An especially useful article is Stiefel, Winning an Interference for a Foreign Inventor, 60 J. PAT. OFF. SOC’Y 558 (1978), which speaks of 35 U.S.C. § 104 (1976), which states in part:

In proceedings in the Patent and Trademark 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 119 of this title . . . .

Where, as here, a question of derivation is raised, the party charging derivation has the burden of showing prior complete conception of the claimed subject matter and sufficient communication of the subject matter of the party charged to enable one of ordinary skill in the art to construct and successfully operate the invention.

Further elaboration of the burden of proving derivation was provided in *Kilbey v. Thiele*. The board explained:

The issue of derivation is one of fact and the party asserting derivation has the burden of proof. Derivation is shown by a prior, complete conception of the claimed subject matter and a communication of the complete conception to the party charged with derivation. The communication must have taken place prior to any date on which it can be shown that the one charged with derivation possessed knowledge of the invention.

Later, the board elaborated on the “communication” aspect, explaining that “proof of motive and opportunity alone is insufficient” to establish communication.

2. Conception

How complete must a party's conception be? In *Gunter v. Stream*, one of the parties read a magazine article on heat pipes and concluded that they would be a good substitute for cooling fans in a certain application. Apparently he did not have a detailed concept of every feature of the device, but he did conceive of “all the essential elements of the counts.” Holding that this was sufficient, the court stated:

The conception of the invention consists in the complete performance of the mental part of the inventive act. All that remains to be accomplished in order to perfect the act or instrument, belongs to the department of construction, not invention. It is therefore the formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is thereafter to be applied in practice, that constitutes an available conception, within the meaning of the patent law.

However, *Gunter* does not excuse an inventor who has an imperfect understanding of the invention. Apparently, the inventor must at least have an appreciation for the importance of a certain feature ultimately recited in the count.

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302. 585 F.2d at 507, 199 U.S.P.Q. at 516.
3. Diligence

The CCPA, in *Naber v. Cricchi*, reversed a priority award and found that a party was not diligent when he could have reduced the invention to practice earlier using existing technology, but spent considerable time developing an improved method of making one feature of the invention. The invention was an improved “drain-source-protected” metal-nitride-oxide-semiconductor device which could be used as a memory element in an integrated circuit. During a critical 12-month period, Cricchi devoted considerable time to developing a new layer deposition technique. He admitted that a simple state-of-the-art transistor could have been built at any earlier time and used for testing the invention. This was fatal. The time was not spent in reducing the invention to practice, but in working out commercial technology. Explaining, the court stated:

> The record shows that the work done . . . to improve . . . layer deposition techniques was generally applicable to all [semi-conductor] devices, not merely the “drain-source-protected” device Cricchi’s conception of the invention. It is well settled that to satisfy the “reasonable diligence” requirement of 35 U.S.C. 102(g), the work relied on must ordinarily be directly related to reduction to practice of the invention of the counts in issue. However, work in preparation for filing related patent applications may suffice, as may work required to develop a first invention in order to develop or reduce to practice a second invention.

> There is no evidence that Cricchi’s layered deposition techniques work was in preparation for filing related patent applications or was required to develop a first invention needed to proceed with the invention of the counts . . . Cricchi . . . admitted that a simple transistor embodying the structure embraced by the counts could have been built and tested for its memory characteristics. Cricchi chose not to proceed to a reduction to practice with a simple transistor, but to wait until work on layer deposition techniques progressed. Since he admittedly “possessed the capability of conducting such a test,” it was his burden to reconcile the waiting period with the “reasonable diligence” requirement.

> The board found . . . that the work on layer deposition techniques was required to produce a “useful device,” rather than a “mere laboratory device.” However, there need not be commercial utility to have a reduction to practice.311


4. Reduction to Practice

An interesting quirk of interference law arose in *Elders v. Hardy.*\(^3\)\(^\text{12}\) If a party has not moved to dissolve the interference on the basis that his opponent's application does not support the count, he cannot later argue that an actual reduction to practice of the identical device of the application is not within the count of interference.

A relaxed standard of corroborating a reduction to practice was applied in *Viventi v. Pines.*\(^3\)\(^\text{13}\) The count was to a sulfur-containing compound for protecting metals from corrosion, and it appeared that no person had directly witnessed the reduction to practice. There were, however, “admittedly genuine and witnessed notebook pages [which] provide the details of the operation.” A witness, who testified that he worked nearby, had a general knowledge of the inventor’s work and was aware that the inventor was working on sulfur compounds as “this was quite evident owing to the odors that emanated from his laboratory.”\(^3\)\(^\text{14}\) On the basis of unchallenged notebooks of the inventor, a corroborated reduction to practice was found. A “rule of reason” was applied.

C. Interference Civil Actions

Interference decisions by the Board of Patent Interferences may be appealed to the Court of Customs and Patent Appeals under 35 U.S.C. sections 141-144, or a civil action may be brought in a district court under section 146.\(^3\)\(^\text{15}\) The principal difference is that an appeal to the CCPA calls for a determination “on the evidence produced before the Patent and Trademark Office [Board of Patent Interferences],” while a civil action includes the PTO record but is “without prejudice to the right of the par-

\(^3\)\(^\text{13}\) *Id.* at 237; *cf.* Patterson v. Hauck, 341 F.2d 131, 144 U.S.P.Q. 481 (C.C.P.A. 1965) (all the evidence should be reviewed).
\(^3\)\(^\text{14}\) *See* 35 U.S.C. § 141 (1976), which provides in relevant part: A party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority may appeal to the United States Court of Customs and Patent Appeals, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has filed notice of appeal according to section 142 of this title, files notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 146 of this title. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under section 146, in default of which the decision appealed from shall govern the further proceedings in the case.
ties to take further testimony.” In other words, it is a trial de novo. But how much can be “novo”? 

Over the years, an extended body of law has developed on when a party is not permitted to take such “further testimony” by reason of his not having presented the testimony earlier to the board. Although the rule is differently stated by the various courts, in general, a party will not be allowed to offer testimony if he intentionally, or with gross negligence, did not present it to the board.

In Velsicol Chemical Corp. v. Monsanto Co., Velsicol had lost an interference and then took the case to the district court. Its loss in the PTO was in large part due to the intentional failure to take testimony of two witnesses who, it was later asserted, could have corroborated the reduction to practice. One of them had witnessed the laboratory notebooks. The court held that the deliberate failure to call those witnesses was either intentional or virtually gross negligence. Otherwise stated, the notion that section 146 civil actions are “de novo” must be qualified to recognize that the deference which a court must pay to a PTO holding of priority requires that the best evidence be submitted to the PTO in the first instance.

D. International Patents

On June 1, 1978, both the Patent Cooperation Treaty and the European Patent Convention went into effect.

E. CCPA Confidentiality

The CCPA’s rule 5.13(g) provides that, on motion, records of a pending appeal will be maintained in confidence and the court will sit in camera. In the absence of a motion made and

316. Compare 35 U.S.C. § 141 (1976) with § 146. In other words, a trial de novo. But how much can be novo?

317. 579 F.2d 1038, 198 U.S.P.Q. 584 (7th Cir. 1978).

318. Id.; see 579 F.2d at 1051, 198 U.S.P.Q. at 596 (Pell, J., dissenting). The dissent felt the language of § 146, “without prejudice to the rights of the parties to take further testimony,” had been applied incorrectly. Instead, the majority “has created a new and stultifying standard for the litigant who desires to appeal a decision of the Board of Patent Interferences.”


320. See C.C.P.A. Rules, Rule 5.13(g) (In camera proceedings), which provides: “In a proper case where the interests of justice require, and on a
In a case of first impression, *In re Sarkar*, the appellant in an application involving a computer program filed a motion under the Rule concurrent with his filing of the transcript. The clerk sealed the transcript and submitted the motion to the court for consideration.

The court sustained its own rule, holding:

Any federal court has the *inherent authority* to seal its record when, in the exercise of sound discretion, such action is deemed appropriate. *See* Nixon v. Warner Communications, Inc., 46 U.S.L.W. 4320 (1978). Our Rule 5.13(g) is merely declaratory of this inherent authority never before exercised by this court to protect a trade secret in an ex parte patent appeal.

We are guided in our determination by the opinion of the Supreme Court in Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470, 181 U.S.P.Q. 673 (1974), from which we glean the sentiment that, whenever possible, trade secret law and patent law should be administered in such a manner that the former will not deter an inventor from seeking the benefit of the latter. . . .

Thereafter, in *In re Mosher*, the attorney challenged an order sealing the record. Again Rule 5.13(g) was sustained, as the court stated:

An absence of Rule 5.13(g) would encourage if not require, those who have disclosed trade secrets in a proferred exchange for the limited-term patent right to exclude others, to forgo appeal and fall back upon the unlimited-term protection of trade secret laws, thereby denying the public early (or any) disclosure, and defeating the very purpose of the patent system.

Petitioner's solicitation and concern for the burdens upon this court, though laudable, are unfounded . . . .

We do not share the view that Rule 5.13(g) opens a pandora's box . . . .

V. LITIGATION PROCEDURE

A. Attorneys

Be kind to your friendly neighborhood patent attorney. He's had a rough year. In opinions during the past twelve months, the courts have borne down on patent attorneys with convincing showing thereof by motion properly made, the court will sit in camera, or seal its record, or both." *In re Sarker*, 575 F.2d 870, 872, 197 U.S.P.Q. 788, 790 (C.C.P.A. 1978).

323. *Id.* at 872, 197 U.S.P.Q. at 790-91.
325. *Id.* at 84.
unprecedented ferocity. The decisions make for colorful reading, but for uncomfortable seating.

Little sympathy need be wasted for appellant's counsel, in *Scully Signal Co. v. Electronics Corp.*,326 whose valor was the better part of his discretion. Telling the Court of Appeals that in “thirty years of practice . . . [he] has never seen such a travesty of technology, let alone justice,” in an appeal from the decision of a trial judge who had “never in his life upheld a patent,” brought on a sharp rebuke and a short affirmance.

The attorney in *In re Milmore*327 was suspended from practice before the PTO for one year by reason of his having withheld a “pertinent reference which should have been called to the attention of the Examiner during prosecution.” Evidence of improper intent was found in a letter from the attorney which stated that the reference would make the claims “invalid even if I succeeded in getting the Examiner to allow them.”

Similarly, a reissue application, in *In re Stockebrand*,328 was stricken on the ground that “fraud” within the meaning of Rule 56 had been perpetrated in the original application by not disclosing “prior public use or on sale” events. A letter from the attorney advised the inventor that “you're late.”

In *General Electric Co. v. Valeron Corp.*,329 the defendant's attorney was removed from the case by reason of his having prepared and prosecuted patent applications for the plaintiff which had given him access to “substantially related” inventions. He had an “opportunity” to learn the applicant's assignee's confidences to such an extent that his continuing to represent the defendant would lend an “appearance of impropriety” to the representation. The court synthesized the following principles:

1. If there is a *substantial relationship* or a sufficiently close relationship between the matters on which the attorney worked in his prior retainer and the matters in which he has worked on his subsequent retainer, this is all that the former client need show.

2. This *substantial relationship* or *sufficiently close relationship* test is compelled by the nature of the relationship of attorney and client.

3. All confidences and information of the client are to be protected.

4. The ethical considerations which support this concept require that a lawyer should reserve the confidences and secrets of his

client and that a lawyer should always avoid even the appearance of professional impropriety in so doing.

5. Because of these considerations, a lawyer should be disqualified in a representation in which he may have had access or opportunity to obtain confidential material and the client need show no more than this in order to be protected.330

The court in Connell v. Clairol, Inc.,331 dealt with a frequently arising issue: under what circumstances is the firm that prepared and prosecuted a patent application precluded from representing the patentee in litigation if it appears that one of the defenses will be fraud on the Patent Office? Relying on the Disciplinary Rules of the Code of Professional Responsibility of the American Bar Association, the court adopted two tests:

Specifically, Disciplinary Rules 5-102(a) and (b) require that an attorney and his law firm withdraw from the conduct of the trial if an attorney learns that he or a lawyer in his firm ought to be called as a witness on behalf of this client, and if he or a lawyer in his form may be called as a witness other than on behalf of his client, if it is apparent that such testimony may be prejudicial to his client.332

Although the court refused to apply an exception where this would create a "hardship" on the client, it did qualify the holdings, stating:

If by merely announcing his intention to call opposing counsel as a witness, an adversary could thereby orchestrate that counsel's disqualification under the Disciplinary Rules, such "a device" might often be employed as a purely tactical maneuver... therefore... the court should determine whether counsel's testimony is, in fact, genuinely needed. In the case sub judice, defendant as movant for disqualification of plaintiff's counsel, has declared its intent to call [plaintiffs' attorney] as a witness to show alleged "inequitable conduct" by the plaintiffs at the time their patent application was filed in that there was a failure to disclose relevant prior art.333

Among other problems, patent attorneys seem to have considerable trouble in writing clearly.334 While plaintiffs' counsel have come in for their share of opprobrium, in Bendix Corp. v. United States,335 the court noted "the logomachy which characterizes defendant's regressive dialectic [which] has unduly complicated the otherwise conventional issue of scope and va-
Patent lawyers get into especially embarrassing situations when they appear as expert witnesses. In *Bergstrom v. Sears, Roebuck & Co.*, a former professor, now a practitioner, who had testified as to an arcane point of law was confronted on cross with one of his earlier contrary publications. The opinion quotes extensively and approvingly from his earlier work.

Finally, three cases echoed “[t]he frequent jest that the massive financial and time burdens of complex patent litigation result in everybody’s loss except the lawyers may not be far from the truth.” This sounds pretty bad, but it’s not all the lawyers’ fault. The dissenting judge in *Gould, Inc. v. United States* may have revealed much of the real difficulty: “It may be we of the judiciary have an unconscious hostility towards the patent system. Our lives would certainly be easier if it did not exist.”

A not insubstantial part of the patent bar and of the bench seems to be working toward that end.

### B. Fraud on the Patent and Trademark Office

Ever since the Supreme Court’s 1965 decision of *Walker*

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337. 457 F. Supp. 213, 199 U.S.P.Q. 269 (D. Minn. 1978); accord, Solvex Corp. v. Freeman, 199 U.S.P.Q. 726 (N.D. Va. 1977) (lawyer-professor-witness “testified at length” against a patent, but when the accounts were being settled and it appeared that “the attorneys’ fees requested . . . total close to the amount of damages that plaintiff requested” the witness’ fees were slashed by over 85%).


>This case, which at its inception involved issues of no great complexity, has become a gigantic, grotesque monster of procedural strife which is about to consume the parties and the court as well. . . . [T]his court cannot help but feel that the parties are more anxious to bring about financial collapse of their opposition than to move this case toward final solution.

In Instrumentation Specialties Co. v. Waters Assocs., 196 U.S.P.Q. 684 (N.D. Ill. 1977), the situation was even worse:

>Either liquid chromatographic instrumentation is very profitable to make and sell and plaintiff’s invention, if any, is second in importance only to the invention of the wheel, or we have another example of patent counsel overkill.


Recent Developments

Process Equipment, Inc. v. Food Machinery & Chemical Corp.,\textsuperscript{341} each year has brought about an increase in the number of reported decisions where fraud, lack of candor, unclean hands, or similar inequitable conduct on the part of patent applicants has been alleged. Walker's combination of authorizing a Clayton Act treble damage award to defendants who succeed in establishing a fraudulent attempt to monopolize, coupled with a holding that conduct less reprehensible than intentional fraud is sufficient to invalidate, has unquestionably been responsible for this upsurge.

For a number of years, it almost seemed that being accused of fraud was like being accused of paternity. A nomination was an election. The standard of conduct always was just a bit higher than the particular patentee's behavior. Then the pendulum swung the other way. While it is difficult to explain this phenomenon, unquestionably a few cases have had a disproportionate impact.

One significant case was Pfizer, Inc. v. International Rectifier Corp.\textsuperscript{342} In Pfizer, the trial court had granted summary judgment based on a variety of episodes of allegedly inequitable conduct, holding that the prosecution amounted "at the very least [to] a calculated recklessness about the truth for the purpose of obtaining a patent containing the broadest possible product and process claims." Moreover, as a matter of law, the withholding of material "facts and beliefs" bearing on issues of anticipation, obviousness, or breadth of claims would constitute unclean hands. There was, according to the district court, a duty to disclose any fact or belief that "may be relevant to an issue of patentability."

On appeal, the summary judgment of invalidity was reversed and the case remanded for a full hearing. First, the appellate court found issues of fact as to "matters of intent, good faith, and credibility" which should not have been resolved by a summary proceeding.\textsuperscript{343}

Second, it specifically held that a duty to disclose any facts or beliefs that "may be relevant to an issue of patentability" was improper. This "imposes an unworkable standard of conduct upon the patent applicant and expands the inequitable conduct defense beyond legitimate limits." The standard of conduct in prosecuting applications "is not one of strict liability for inno-

\textsuperscript{341} 382 U.S. 172, 147 U.S.P.Q. 404 (1965).
\textsuperscript{343} Id. at 185, 190 U.S.P.Q. at 278.
\textsuperscript{344} Id. at 185, 190 U.S.P.Q. at 277.
cent or even negligent omissions or misstatements . . . [but] the misconduct must be accompanied by ‘some element of wrong-
fulness, wilfulness, or bad faith’.” Proof of such misconduct
must be established by “clear, unequivocal and convincing evi-
dence.”

The Pfizer opinion concluded with a paragraph that, as pre-
picted, is frequently repeated in the decisions:

The basic issues in this case are the validity and enforceability
of the patent alleged to have been infringed. An infringement de-
fendant in complex litigation should not be permitted to sidestep
these main issues by nitpicking the patent file in every minute re-
spect with the effect of trying the patentee personally, rather than
the patent. Patentee’s oversights are easily magnified out of pro-
portion by one accused of infringement seeking to escape the reach
of the patent by hostilely combing the inventor’s files in liberal pre-
trial discovery proceedings. Unjustified damage to professional
and social reputations can result, as here, without fostering any
contemporary public opinion in the form of inhibiting future im-
provident grants of patent monopolies.

The PTO, in response to the many fraud charges brought
before the courts—and to the PTO—issued the so-called “Dann
Amendments.” These provided, among other things, for reis-
sues to redetermine patentability, greater public access to pro-
test and public use proceedings, a redefined duty on the part of
patent applicants to disclose material facts to the Office, and the
voluntary provision of prior art statements. Last but not least, a
few courts have awarded attorneys’ fees to the successful plaint-
iffs where the defendant irresponsibly made a “fraud on the
Patent Office” charge.

This past year, for the first time since Walker Process, the
number of “fraud” cases has diminished markedly. Further, as
will appear, there have been a number of clear holdings to the
effect that a patent applicant need not disclose a possibly antici-
patory—reference, on sale, or public use under 35 U.S.C. section
102—if he, in good faith, believes that the reference, etc., either
is not anticipatory or is not a statutory reference.

1. Intent

The courts this past year have emphasized that a willful, de-
liberate, grossly negligent, or otherwise improper intent is indis-
pensible to proof of an unclean hands defense. Thus, even

345. Id. at 187, 190 U.S.P.Q. at 274.
346. Id. at 196, 190 U.S.P.Q. at 286.
349. See Judge Lacey, A Federal District Judge’s Views on Patent Reissue
though a reference “should have been cited,” if it did not anticipate or make the claimed invention obvious, there was no bad faith. 350 While the deliberate withholding of a reference “may tend to indicate a certain lack of candor,” without more, this is not invalidating unclean hands. 351

In *Duplan Corp. v. Deering Milliken, Inc.*, 352 the court considered a number of unclean hands charges. Even where one of the patents was invalid on a known section 102(d) defense, 353 this was only simple negligence. In another instance, 354 the court found a deliberate intent to withhold a reference from the Office; it found 355 yet “another example of . . . unwillingness . . . to say whatever was necessary”; and—believe it or not—criticized the attorney for referring to a prior art patent *only by number* in the specification, stating, “The Heinze patent was never cited nor referred to by the patent examiner during the prosecution of the ’037 patent, but was referred to (by number only) in the specification of the ’037 patent.” 356

2. Anticipatory Prior Art

A new phenomenon has emerged this year: even where a prior reference or other art is anticipatory in a section 102 sense, if an applicant believes in good faith that it is either not anticipatory or not statutory prior art, the courts have tended to exculpate him from liability. 357

Of course, if the reference, or other art, is in fact anticipatory prior art, then the patent is invalid. But lack of malicious or negligent intent prevents an award of attorney' fees and/or, in an appropriate case, a treble antitrust damage award—along

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353. See notes 357-62 and accompanying text infra.
355. *Id.* at 732, 197 U.S.P.Q. at 414.
356. *Id.* at 753, 197 U.S.P.Q. at 432. “It seems to be standard operating procedure for many practitioners before the patent office to downplay any prior art which might constitute an obstacle to patentability.”
with possible additional sanctions such as disbarment, criminal proceedings, or the like.

The first case in which anticipatory prior art (a section 102(d) reference) was intentionally withheld was Duplan. The court found this to be simple negligence only.

In two cases the Office struck reissue applications on the ground that a “fraud,” within the meaning of Rule 56, had been perpetrated during prosecution of the original application. In In re Stockebrand, the attorney had not disclosed “prior public use or on sale” events as well as “relevant” prior art, and he “knew or reasonably should have known” the invention was on sale. Confirmation of the attorney’s mala fides was found in a correspondence in which he had advised the inventor that “you’re late.”

Similarly, in In re Altenpohl the Office deliberately withheld the reissue applicant’s father’s earlier patent, which had been held by the CCPA to be an anticipation, resulting in the striking of the reissue application. It stated:

[G]ood faith and subjective intent, while they are to be considered, should not necessarily be made controlling. Under ordinary circumstances, the fact of misrepresentation coupled with proof that the party making it had knowledge of its falsity is enough to warrant drawing the inference that there was a fraudulent intent. Where public policy demands a complete and accurate disclosure, it may suffice to show nothing more than that the misrepresentations were made in an atmosphere of gross negligence as to their truth.

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359. See Bergstrom v. Sears, Roebuck & Co., 456 F. Supp. 213, 199 U.S.P.Q. 269 (D. Minn. 1978) (not improper to withhold inventor’s commercial activities, particularly when court finds they are not invalidating); Reynolds Metals Co. v. Aluminum Co. of Am., 457 F. Supp. 482, 198 U.S.P.Q. 529 (N.D. Ind. 1978) (bona fide belief it was experimental and no willfulness or bad faith in non-disclosure will not constitute fraud); Clark Equip. Co. v. Keller, 197 U.S.P.Q. 83 (D.N.D.) (no duty to disclose public use which was believed in good faith to be experimental; it was an experimental prototype that did not invalidate), modified, 439 U.S. 825, 200 U.S.P.Q. 64 (1979) (dicta: “a patent applicant has an uncompromising duty toward the patent office to disclose all pertinent facts”); Deere & Co. v. Hesston Corp., 456 F. Supp. 520, 196 U.S.P.Q. 238 (D. Utah 1977) (intentional failure to disclose prior public use invalidates patent; there was no “fraudulent intent or grossly reckless conduct”); cf. Studiengesellschaft Kohle mbH v. Eastman Kodak Co., 450 F. Supp. 1211, 197 U.S.P.Q. 164 (E.D. Tex. 1977) (apparently court criticized the patentee for not disclosing certain events, especially the work of a foreign collaborator, that did not appear to be statutory prior art).
3. Relevant but Not Anticipatory Prior Art

Some of the cases discussed earlier have dealt with disclosure, or failure to disclose, prior art that is not anticipatory, but is "relevant," "material," or "pertinent" to the claimed invention.364 In each instance, the applicant's subjective intent was a factor in assessing his failure to disclose. And, necessarily, the court's objective determination of whether the reference invalidated the patent figured in its assessment of the consequences of non-disclosure.

Only one case is of special significance. In Tapeswitch Corp. of America v. Recora Co.,365 the court recognized that there is a difference in the kind of "fraud" necessary to hold a patent unenforceable and that needed to invoke section 2 of the Sherman Act.

4. Miscellaneous Cases

A few "fraud" cases represent tributes to the ingenuity of applicants and their counsel—or to that of infringers and theirs. In Carpet Seaming Tape Licensing Corp. v. Best Seam, Inc.,366 failure to disclose a "necessary element," that is, the need for an impervious material as carpet backing tape, was "knowingly providing an inadequate disclosure," constituting a fraudulent concealment of the best mode under section 112. Thereafter, filing a continuation-in-part directed to an impervious tape confirmed the "fraud."

A jury in Solvex Corp. v. Freeman367 found intentional misleading of the Office in offering to supply the Examiner with a commercial success affidavit at a time when there was no commercial success.

Even plant patents are not immune from fraud charges. The court in Pan-American Plant Co. v. Matsui368 held that a specification incorrectly describing a plant as "producing very few

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364. See notes 86-99 and accompanying text supra.
culls” was “clearly inaccurate”; this was “especially troubling because [the applicant] knew that the . . . plant material produced 50-60% culls. Such a knowing inaccuracy raises the spectre of fraud and serious questions about the validity of the patent.”

But one man’s fraud is another’s acceptable conduct. Although Rule 56 holds that an application may be stricken if it is signed without having been “inspected” by the applicant; the question is how much inspection is necessary. In Jessel v. Newland, the board had recommended that Jessel’s plant patent application in interference be stricken because it contained a major error in classifying the claimed plant, and this supported Jessel’s testimony by one of the joint applicants that he had not inspected the application. The deputy commissioner, however, in Jessel v. Newland, declined to hold that “inspect” in Rule 56 was the same as “read” but agreed that a fraud had been perpetrated when the applicant had neither read nor inspected the application.

On further appeal to then-Commissioner Dann in Newland v. Jessel, he held that the party’s “behavior was not so serious a departure from acceptable standards as to require striking the . . . application.” He explained:

What is needed to constitute actual inspection? It is certainly desirable that applicants read their applications carefully and completely before signing them. When the applicant is illiterate, blind, or does not understand English, it is acceptable for the application to be read to him or explained in a way that allows him to suppose with some confidence that the application he is called on to sign covers the invention that he believes he had invented. On the other hand, a signing in blank or with no inspection and without other circumstances reasonably leading to such confidence on the part of the applicant would justify striking the application as in essence not vouched for by the applicant.

All of this adds up to something more than a heedless signing in blank, though it is doubtful whether it is enough to qualify as an actual inspection . . . .

There is no suggestion that Mix’s failure to read the application was part of an effort to deceive the Patent and Trademark Office in any way or that it had that effect.

369. Id. at 697 n.7, 198 U.S.P.Q. at 466 n.7.
373. Id. at 505.
Ultimately holding that striking was discretionary, the Commissioner declined to strike.

**CONCLUSION**

This past year, a number of courts have complained of the recent proliferation of patent and antitrust litigation.\(^{374}\) In *Dunlap Corp. v. Deering Milliken, Inc.*, the court placed part of the blame on the United States Patent Office for failing "to say 'no' to any patent solicitor who has the persistance to prosecute a patent through as many as six rejections."\(^{375}\) The result is that many of the patents fail to withstand the stern tests of sections 102 and 103 under current case law.\(^{376}\) This is a low note to end the year for the Patent Office.


\(^{376}\) Id. at 772 n.90, 197 U.S.P.Q. at 446 n.90, where the court stated:

> "Writing patent claims is like trying to define the shape of a cloud. If one can precisely define the shape of a cloud by detailing where all particular pieces go together, the examiner will give a person a patent on it." (citation omitted)

That Judge Hemphill's observation may not be as whimsical as it sounds is perhaps best illustrated by PX 1313 introduced by plaintiffs' trial. It is United States Patent No. 3,936,384 issued on a bar of soap with a religious symbol which is embossed with religious markings. Claims 2 and 3 are dependent on claim 1.