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PATENTS - EQUITY PLEADING - SUFFICIENCY OF "SHORT FORM" OF BILL OF COMPLAINT - BURDEN OF PROOF OF VALIDITY OF PATENT INFRINGEMENT SUIT

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PATENTS — EQUITY PLEADING — SUFFICIENCY OF "SHORT FORM" OF BILL OF COMPLAINT — BURDEN OF PROOF OF VALIDITY OF PATENT INFRINGEMENT SUIT — Complainant brought suit for infringement of letters patent and used the so-called "short form" of bill of complaint.¹ Defendant moved to dismiss the bill for insufficient facts to constitute a cause of action, since there were no allegations of compliance with the statutory provisions for issuance of a patent.² The District Court and the Circuit Court of Appeals for the Eighth Circuit³ sustained the demurrer, but the Supreme Court *held* that under Equity Rule 25⁴ the short form of bill of complaint contained all the ultimate facts necessary for complainant to state a cause of action. *Mumm v. Jacob E. Decker & Sons*, 301 U. S. 168, 57 S. Ct. 675 (1937).

Prior to 1912 it was necessary for complainant to use the "long form" of bill of complaint in order to set forth a cause of action which would be good against demurrer.⁵ Only a few decisions expressed a contrary view.⁶ However, Equity Rule 25, promulgated in 1912, provides: "Hereafter it shall be sufficient that a bill in equity shall contain. . . Third, a short and simple statement of the ultimate facts upon which the plaintiff asks relief, omitting any mere statement of evidence." Thereafter the district courts and circuit courts of appeal were divided as to whether allegations of compliance with the

¹The short form of bill of complaint differs from the long form in that the former does not contain allegations that the invention was not known or used by others in this country before the inventor's invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country before his invention or discovery thereof, or more than two years prior to his application for letters patent in the United States, and not in public use or on sale in this country for more than two years prior to the date of his said application for letters patent, and had not been abandoned, nor patented nor caused to be patented by him or his representatives or assigns in any country foreign to the United States on an application filed more than twelve months prior to the filing of his application for letters patent of the United States.

² U. S. Rev. Stat., § 4886, 4887 (1878), 35 U. S. C., §§ 31, 32 (1935).

³ Decision reported in 86 F. (2d) 77 (1936).

⁴ Printed following 28 U. S. C. A., § 723 (1928).

⁵ I WALKER, PATENTS, 6th ed., § 617j, p. 695 (1929); AMDUR, PATENT LAW AND PRACTICE 780 (1935).

⁶ *American Cereal Co. v. Oriental Food Co.*, (C. C. Ill. 1906) 145 F. 649; *Fichtel v. Barthel*, (C. C. N. Y. 1909) 173 F. 489. In *McCoy v. Nelson*, 131 U. S. 484, 7 S. Ct. 1000 (1887), the Supreme Court appears to approve the short form, but the bill is not set forth in the report.

statute were necessary to a statement of the "ultimate facts."⁷ There were two chief phases to the controversy. First, since if interlocutory relief is asked by the plaintiff he must swear to the bill,⁸ some courts felt that unfounded litigation could be prevented if plaintiff were required to include in the bill allegations of compliance with the statutory requisite for issuance of a patent.⁹ The Supreme Court disposed of this contention with the statement that the advantage does not justify departure from standards of correct pleading.¹⁰ The second argument was concerned with the question of on which party the burden of proof as to compliance or non-compliance with the statutes rests. When plaintiff introduces his patent in evidence he makes out a prima facie case of the validity of the issuance of the patent and of the novelty of the subject matter.¹¹ On the other hand, if defendant wishes to dispute compliance with the statutory provisions he must give notice in advance of trial as to the grounds on which he will dispute validity.¹² It should be noted that the denial need not necessarily be put in the answer to the bill.¹³ Hence, some courts were of the opinion that statutory compliance is a condition precedent to validity of the patent and the

⁷ The short form was approved in: *Moeller v. Scranton Glass Instrument Co.*, (C. C. A. 3d, 1927) 19 F. (2d) 14; *Zenith Carbureter Co. v. Stromberg Motor Devices*, (D. C. Mich. 1913) 205 F. 158; *Pittsburgh Water Heater Co. v. Beler Water Heater Co.*, (D. C. Pa. 1915) 222 F. 950; *Jost v. Borden Stove Co.*, (D. C. Pa. 1920) 262 F. 163; *McCullough Egg Equipment Co. v. Poultry Producers*, (D. C. Cal. 1931) 50 F. (2d) 945.

The long form was required in: *Ingrassia v. A. C. W. Mfg. Corp.*, (C. C. A. 2d, 1928) 24 F. (2d) 703; *Mumm v. Jacob E. Decker & Sons*, (C. C. A. 8th, 1936) 86 F. (2d) 77; *Bayley & Sons v. Braunstein Bros.*, (D. C. N. Y. 1916) 237 F. 671; *Schaum & Uhlinger v. Copley-Plaza Operating Co.*, (D. C. Mass. 1917) 243 F. 924; *White v. Studebaker Corp.*, (D. C. Cal. 1929) 30 F. (2d) 835; and in several other decisions of the New York district courts.

⁸ Equity Rule 25, paragraph "fifth." 1 WALKER, PATENTS, 6th ed., § 617p (1929).

⁹ See especially the opinion in the principal case in the Circuit Court of Appeals, (C. C. A. 8th, 1936) 86 F. (2d) 77.

¹⁰ The reasonableness of this holding is apparent when it is considered that in the inventor's application for a patent he must swear to the same allegations as are contained in the long form of bill of complaint. Rules of Practice of U. S. Patent Office, § 46 (1935). Assuming that if the inventor swore falsely in his patent application he would swear falsely in his bill of complaint, the requirement urged by proponents of the long form would, therefore, be effective in preventing unfounded litigation in but two cases: First, where the inventor has discovered facts negating the novelty of his invention subsequent to the application for his patent and prior to the commencement of his infringement suit; and, second, when the plaintiff in the infringement suit is the assignee of the inventor and knows facts which were not known to the inventor when the latter made his application.

¹¹ *Smith v. Goodyear Dental Vulcanite Co.*, 93 U. S. 486 at 499, 23 L. Ed. 952 (1877); *Lehnbeuter v. Holthaus*, 105 U. S. 94, 26 L. Ed. 939 (1881); *Cantrell v. Wallick*, 117 U. S. 689 at 695, 6 S. Ct. 970 (1885).

¹² U. S. Rev. Stat., § 4920 (1878), 35 U. S. C., § 69 (1935).

¹³ "In any action . . . defendant may plead the general issue, and, having given notice in writing to the plaintiff or his attorney thirty days before, may prove on trial," etc. U. S. Rev. Stat., § 4920 (1878), 35 U. S. C., § 69 (1935).

burden of alleging and proving it rests with the plaintiff,¹⁴ while the other view was that the burden rests on the defendant to allege all special defences and hence plaintiff need not allege an anticipatory denial of them.¹⁵ The Supreme Court has settled the question by holding that the grant of the patent is prima facie evidence of novelty and the burden of proving want of such novelty is on the defendant and that, therefore, it is not necessary for plaintiff to plead compliance with the statutory requisites of novelty. The holding seems justified in the light of the modern tendency toward simplifying pleadings.¹⁶

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¹⁴ Hayes-Young Tie Plate Co. v. St. Louis Transit Co., (C. C. A. 8th, 1905) 137 F. 80; Elliott & Hatch Book-Typewriter Co. v. Fisher Typewriter Co., (C. C. N. Y. 1901) 109 F. 330; Aluminum Die Casting Corp. v. Allied Die-Casting Corp., (D. C. N. Y. 1924) 15 F. (2d) 880.

¹⁵ Jost v. Borden Stove Co., (D. C. Pa. 1920) 262 F. 163; McCullough Egg Equipment Co. v. Poultry Producers, (D. C. Cal. 1931) 50 F. (2d) 945.

¹⁶ For manifestations of this tendency in federal courts, see: Hopkins' Federal Equity Rules, 8th ed., p. 34 (1933); and Proposed Rules of Civil Procedure for the District Courts of the United States, Rule 8 (e) (1) (1937).