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Curb-Stone Patent Opinions

Dwight B. Cheever

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HAVING been asked almost every day for the last nine years for offhand—commonly called curb-stone—opinions on one or more of certain very elementary propositions in Patent Law, it has occurred to me that perhaps a discussion of some of these questions would be of more practical value to the readers of this magazine than a comprehensive discussion of a more elaborate subject.

As the statutes under which patents are issued will have to be several times referred to during the course of this paper, it will perhaps be best to quote two sections at this point.

“Sec. 4886. Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, not known or used by others in this country, before his 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, and not in public use, or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may upon payment of the fees required by law, and other due proceedings had, obtain a patent therefor.”

“Sec. 4884. Every patent shall contain a short title or description of the invention or discovery, correctly indicating its nature and design, and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the exclusive right to make, use, and vend the invention or discovery throughout the United States and the Territories thereof, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof.”

One of the most frequent questions is:

1. *“My patent shows such and such a device. Can I make something else without invalidating my patent?”*

An inspection of the foregoing sections of the statutes shows that they provide for a grant to the patentee of the exclusive right to make, use and sell the devices of his patent. In other words, they grant him the right to keep others from making such devices during the life of the patent. There is nothing whatever in the wording of the statute compelling the patentee or those taking title from him to make anything and consequently the patentee is, so far as his patent is concerned, just as free to make what he pleases as though he had no patent at all.

2. "To what extent must I use my patent in order to keep it valid?"

As noted in the discussion under the last question, there is nothing in the statute requiring the patentee to use the device at all and consequently the validity of the patent is not in any way affected by the use or nonuse of the same except that in bringing a suit upon a patent the courts sometimes hold that the fact that it has gone into extensive use where other devices have not been used is some evidence of patentable value in the device. The last two questions will be found answered fully, though perhaps indirectly, in the case of *Bement v. The National Harrow Co.*¹ In this case a contract was entered into granting a license under 85 different patents in which the licensee agreed not to sell devices at less than a fixed price. An action under this contract and modifications of it was defended upon the ground that it was a violation of the anti-trust laws, and the court in overruling this contention said:

"This brings us to a consideration of the terms of the license contracts for the purpose of determining whether they violate the act of Congress. The first important and most material fact in considering this question is that the agreements concern articles protected by letters patent of the Government of the United States. The plaintiff, according to the finding of the referee, was at the time when these licenses were executed the absolute owner of the letters patent relating to the float spring tooth harrow business. It was, therefore, the owner of a monopoly recognized by the Constitution and by the statutes of Congress. An owner of a patent has the right to sell it or to keep it; to manufacture the article himself or to license others to manufacture it; to sell such article himself or to authorize others to sell it. As stated by Mr. Justice Nelson, in *Wilson v. Rousseau*, 4 How. 646, 674, in speaking of a patent:

"The law has thus impressed upon it all the qualities and characteristics of property for the specified period and has enabled him to hold and deal with it the same as in the case of any other description of property belonging to him, and on his death it passes, with his personal estate, to his legal representatives, and becomes part of the assets."

"Again, as stated by Mr. Chief Justice Marshall, in *Grant v. Raymond*, 6 Pet. 218, 241:

"To promote the progress of useful arts, is the interest and policy of every enlightened government. It entered into the views of the framers of our Constitution, and the power "to promote the

¹ 186 U. S. 70.

progress of science and useful arts, by securing for limited times to authors and inventors, the exclusive right to their respective writings and discoveries," is among those expressly given to Congress. This subject was among the first which followed the organization of our Government. It was taken up by the first Congress at its second session, and an act was passed authorizing a patent to be issued to the inventor of any useful art, etc., on his petition, "granting to such petitioner, his heirs, administrators or assigns, for any term not exceeding fourteen years, the sole and exclusive right and liberty of making, using and vending to others to be used, the said invention or discovery." The law further declares that the patent "shall be good and available to the grantee or grantees by force of this act, to all and every intent and purpose herein contained." The amendatory act of 1793 contains the same language, and it cannot be doubted that the settled purpose of the United States has ever been, and continues to be, to confer on the authors of useful inventions an exclusive right to their inventions for the time mentioned in their patent. It is the reward stipulated for the advantages derived by the public for the exertions of the individual, and is intended as a stimulus to those exertions. The laws which are passed to give effect to this purpose ought, we think, to be construed in the spirit in which they have been made; and to execute the contract fairly on the part of the United States, where the full benefit has been actually received; if this can be done without transcending the intention of the statute, or countenancing acts which are fraudulent or may prove mischievous. The public yields nothing which it has not agreed to yield; it receives all which it has contracted to receive. The full benefit of the discovery, after its enjoyment by the discoverer for fourteen years, is preserved; and for his exclusive enjoyment of it during that time the public faith is pledged.

"In *Heaton-Peninsular Company v. Eureka Specialty Company*, 47 U. S. App. 146, 160, it is stated regarding a patentee:

"If he see fit, he may reserve to himself the exclusive use of his invention or discovery. If he will neither use his device nor permit others to use it, he has but suppressed his own. That the grant is made upon the reasonable expectation that he will either put his invention to practical use or permit others to avail themselves of it upon reasonable terms, is doubtless true. This expectation is based alone upon the supposition that the patentee's interest will induce him to use, or let others use, his invention. The public has retained no other security to enforce such expectations. A suppression can endure but for the life of the patent, and the dis-

closure he has made will enable all to enjoy the fruit of his genius. His title is exclusive, and so clearly within the constitutional provisions in respect of private property that he is neither bound to use his discovery himself nor permit others to use it. The dictum found in *Hoe v. Knapp*, 17 Fed. Rep. 204, is not supported by reason or authority.’”

The court then states a few exceptions to the rule in the case of Public Service Corporations and concludes:

“These cases are cited in the opinion of the court in the case of *Heaton-Peninsular Company v. Eureka Specialty Company*, supra. Notwithstanding these exceptions, the general rule is absolute freedom in the use or sale of rights under the patent laws of the United States. The very object of these laws is monopoly, and the rule is, with few exceptions, that any conditions which are not in their very nature illegal with regard to this kind of property, imposed by the patentee and agreed to by the licensee for the right to manufacture or use or sell the article, will be upheld by the courts. The fact that the conditions in the contracts keep up the monopoly or fix prices does not render them illegal.”

3. *“John Doe has a patent. Can I make and use myself one of the devices of that patent?”*

There is the greatest popular misapprehension as to the proper answer to this question, most persons assuming that the answer is “Yes.” An inspection of the statutes quoted shows that the patent gives the patentee the exclusive right to make, use and sell his device and there is no exception of the character embodied in the question. The popular misapprehension appears to arise from the fact that single users of simple devices are ordinarily seldom prosecuted for infringement. This is, however, due to the expense of carrying on a patent suit and not to any defect in the right to sue. In a well-known case in the Supreme Court, the complainant collected many thousands of dollars by bringing suits against farmers and others for using, under the misapprehension above referred to, a patented well-boring device and then settling each suit on payment of \$50.00 or upwards.

Some of the heaviest patent cases have been those in which a single valuable machine in use by the defendant was the only evidence of infringement in the case and such a suit can always be brought where the complainant considers infringement of sufficient importance to go to the expense of bringing suit.

Other sections of the statute, not quoted, provide that for a patent

to be valid the drawings must show and the specification describe an operative device, from which it follows that any person doubting the operativeness of the structure shown and described in the patent may make one of the devices and use it long enough to determine that the patent is operative. When he has done this he has, for the reason stated, no right to use the device further. This is the only exception to the rule noted.

4. *"Must I mark devices manufactured under my patent 'patented,' and how near to the actual machine must the mark be placed?"*

The section of the statute affecting this matter is United States R. S. § 4900, which reads as follows:

"It shall be the duty of all patentees, and their assigns and legal representatives, and of all persons making or vending any patented article for or under them, to give sufficient notice to the public that the same is patented; either by affixing thereon the word 'patented,' together with the day and year the patent was granted; or when, from the character of the article, this can not be done, by fixing to it, or to the package wherein one or more of them is enclosed, a label containing the like notice; and in any suit for infringement, by the party failing so to mark, no damages shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement, and continued, after such notice, to make, use or vend the article so patented."

And the leading case upon the subject is *Dunlap v. Schofield*.²

An inspection of these shows that the patentee has the *alternative* of marking his device patented or of giving notice to the defendant, and that in either event the matter only relates to the question of the recovery of damages. It has never, so far as I have been able to ascertain, been held that the patentee or those holding title under him, cannot maintain a suit and assert full rights under his patent if he has given notice and has never marked any of his devices patented.

5. *"If my patent is granted can anybody interfere with my manufacturing under it?"*

A full discussion of this subject might be made to cover many pages of this magazine. Briefly it may be stated that the first person to invent a broad generic device may have generic claims covering not merely his particular structure but all equivalent structures accomplishing the same results in the same general way and under these claims he can prevent other persons making any device which is an infringement of the claims during the life of his patent. If at

² 152 U. S. 244.

the end of say five years after this first patent is taken out some one comes along with a supposed improvement upon the original device which either itself comes under the original patent or involves the use of the original device or an equivalent of it, and this new party obtains a patent upon his improvement, the rights of the parties, briefly stated, are as follows: The original patentee can during the life of his patent prevent the improver from using the improved device; the original patentee has no right at any time to use the improver's device; the improver cannot during the life of the original patent use his improved device.

The thing for the parties to do under these conditions is to get together either by one buying the other out or by one or both licensing the other to use the device of his patent.

6. *"I have a patent which shows such and such figures. How is it that John Doe now gets a patent on the same thing?"*

The answer to this question is involved in the answer to the last question and lies further in the fact that the improver's patent must unquestionably show something which is not in the first patent, and if the claims, which are the essence of a patent, of the later patent are examined, it will be found that they are every one of them limited to the one or more elements which are actually shown in the second patent, though they may not appear at the first glance, which do not appear in the drawings of the first patent.

7. *"Can I manufacture the device of my invention before my application for patent upon it is filed?"*

The answer is Yes, and for the same reasons as stated in answer to the first two questions; *i. e.*, that the inventor does not have to manufacture anything at any time and, therefore, so far as his patent is concerned, he is at liberty to manufacture what he pleases, when he pleases. The inventor must, however, file his application within two years of beginning public use if he is to obtain a valid patent.³

8. *"Is it safe to show my invention to others before filing my application? If anybody should see my invention could he put in an application, and if so, could I stop him?"*

Patents are only granted to the actual first inventor and where two alleged inventors file applications for the same invention, an interference closely resembling the ordinary law suit, is declared in the Patent Office to determine which one of the parties is actually the first inventor and as a result of that determination one application is rejected and a patent issued upon the other application. This is a somewhat expensive proceeding but usually an effective one, from which it follows that unless there is, in fact, another contem-

³ See U. S. R. S. 4886 Ante.

porary inventor in the field who on seeing the invention is stirred up to file his own application, it is, as a proposition of law, entirely safe to show the invention to others. Practically, however, it is less expensive sometimes to limit the exhibition of the device to friends who can be trusted at least until the application is on file and sometimes longer. There are cases where one party will trump up a fraudulent false application and have an interference declared with a bona fide inventor in the hope that in a settlement to save expense, the inventor will grant some rights under his application or patent. The cases, however, where such fraudulent applications have been carried to a successful termination are exceedingly rare. The disposition of them more often depends upon putting up money for a fight than upon the production of actual evidence. From the foregoing it appears that the answer to the second of the two above questions is that the first inventor can only fight the second inventor while in the Patent Office to determine who is in fact entitled to a patent but that when the patent is actually obtained he can stop the fraudulent inventor's using the device.

9. *"If I learn about an invention known abroad and not patented here, can I get a patent on it?"*

The answer is No; for Section 4886, quoted above, distinctly provides that the patentee must be the first inventor and that the device must not be patented or described in any printed publication in the United States or any foreign country.

10. *"Can I get my patent extended?"*

There was at one time provision for an extension of patents by a proceeding in the Patent Office but this statute was repealed many years ago and there is now no way of getting an extension except by a special act of Congress, which is at best a very expensive proceeding and which in the present attitude of Congress relative to anti-trust legislation, is probably practically impossible at this time.

DWIGHT B. CHEEVER.

CHICAGO.