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Patent Law: Secret Use as Affecting Right to a Patent

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PATENT LAW—SECRET USE AS AFFECTING RIGHT TO A PATENT.—An unusually obvious piece of judicial legislation, of practical importance to the manufacturing world, was promulgated in the case of *Macbeth-Evans Glass Co. v. General Electric Co.*, 246 Fed. 695. The facts were that in 1903 Macbeth had invented a process for making glass. Since that time the plaintiff company, of which Macbeth was president, had been using that process. This use had, however, been "secret". In 1910 an employee of the plaintiff revealed the process to the Jefferson Glass Co., which at once began to use it, but on application of the Macbeth Co. the state court enjoined the Jefferson Co. from further use of the process and from disclosing it to others. *Macbeth-Evans Glass Co. v. Schnellbach*, 239 Pa. 76. The secret of the process was not revealed by the proceedings in this suit. It does not appear how the General Electric Co. acquired knowledge of the process; whether it did learn the secret of the Macbeth process, or evolved a similar process by its

own independent efforts. Macbeth applied for a patent in 1913 and when it was issued the Macbeth Co., as his assignee, brought this suit for infringement. The General Electric Co. defended on the ground that Macbeth had lost his right to a patent, by his failure to apply for one reasonably soon after he had perfected his invention, and that, consequently, the patent issued to him was void.

The statutes provide that the first and original inventor may obtain a patent upon application, *unless* his invention has been in public use or on sale more than two years prior to his application, or *unless* he is proved to have abandoned the invention. R. S. 4886. These are the only exceptions stated. Macbeth was conceded to be the first and original inventor. It was admitted also that the invention had never been sold—although its products had been. Macbeth was obviously not proved to have abandoned his invention. On the contrary he was using it, and displayed a very vital interest in it. "The constant effort made to preserve the secret was inconsistent with intent to abandon the invention".

The court *might* have held that the so-called secret use of the invention by the Macbeth Co. for the ten years preceding the application was in fact a public use. This would have had the authority of *Perkins v. Nassua Card Co.*, 2 Fed. 451. In that case the invention was used in a factory employing a score of workmen, all of whom had keys to the building, and to which visitors were occasionally admitted. This was held to be a public use, such as would preclude the inventor from a patent, because "when the public have had means of knowledge they have had knowledge of the invention." So also, in *Eggbert v. Lippmann*, 104 U. S. 333, the invention of a type of corset-steel was held to have been in "public use" without further evidence than that the inventor's wife wore a pair of corsets containing such steels. (Compare also *Jenner v. Bowen*, 139 Fed. 556.) But the court did not choose to adopt this solution of the case. On the contrary, it was expressly assumed that the use of the invention had been a secret use. Still more convincingly might the court have held that the use by the Jefferson Co. and by the General Electric Co. was truly a public use. Neither the consent of the inventor (*Andrews v. Hovey*, 123 U. S. 267, 124 U. S. 694) nor the extent of the use (*Swain v. Holyoke Mach. Co.*, 109 Fed. 154) is material in the question of public use. But this simple solution also the court ignored. The case was deliberately made to turn upon the issue of "whether one who has discovered and perfected an invention can employ it secretly more than nine years for purposes only of profit, and then, upon encountering difficulty in preserving his secret, rightfully secure a patent."

Since the right to a patent had not been forfeited through public use nor abandonment of the invention, it must have been lost, if at all, in some other way. As the statute expressly mentions these two causes of forfeiture and no others, it might be supposed that only these were intended as causes of forfeiture; the maxim *expressio unius* might be supposed to apply. Even more indubitably might it be supposed that the emphasis placed on *public* use by the statute would preclude loss of right through secret use. The decisions prior to the one under discussion did proceed upon this supposition. Neither

secret use nor *public knowledge* has been held a cause of forfeiture. Thus, in *Bates v. Coe*, 98 U. S. 31, 46, the court said, as a basis for rejecting certain evidence, "Inventors may if they can, keep their invention secret; and if they do for any length of time, they do not forfeit their right to apply for a patent, unless another in the mean time has made the invention and secured by patent the exclusive right to make, use and vend the patented improvement. Within that rule and subject to that condition, inventors may delay to apply for a patent." In *Parks v. Booth*, 102 U. S. 96, 105, the same judge repeated, "Inventors may, if they can, keep their inventions secret; but if they do not, and suffer the same to go into public use for a period exceeding what is allowed by the Patent Act, they forfeit their right to a patent." So also, in *Egbert v. Lippman*, *supra*, Mr. Justice MILLER, dissenting from the finding that a certain use had in fact been public, makes the apparently undisputed statement, that "the word *public* is therefore, an important member of the sentence" and a secret use will not preclude a patent. In *Eliabeth v. Paving Co.*, 97 U. S. 126, 136, it was held that not only was the word public important, but "use" was equally so, and that mere *public knowledge* of the invention, though for more than two years prior to the application would not affect the patent. There must, the court said, explicitly, be a *use* by the *public* before the court can imply either an abandonment of the invention or a loss of the right to a patent. The only authority in any way opposed to this interpretation is dictum. In *Kendall v. Winsor*, 21 How. 322, for instance, the decision was in favor of the patentee, but the court did say that one "may forfeit his rights as an inventor * * * by an attempt to withhold the benefit of his improvement from the public *until a similar or the same improvement shall have been made and introduced by others*". (Present writer's italics.) There is no evidence whatsoever in the Macbeth case that the invention was ever made by anyone but Macbeth.

Most of this authority was considered in the principal case. It was not overruled, but was declared somehow to accord with the proposition that a thoroughly secret, non-public use, without any proof of abandonment of the invention may deprive the inventor of his statutory right to a patent. Freed from restriction of this authority the court took the position that it would be out of accord with sound public policy to allow an inventor to maintain a virtual monopoly of his device by using it in secret for a number of years, and then to acquire a statutory monopoly for a longer period. Accordingly, the court read into the statute a provision that the right of a first and original inventor to a patent will be forfeited by secret use for purposes of profit. This interpretative legislation is quite in analogous accord with the decisions by which it has been settled that, as between rival applicants for a patent, the "first and original inventor" is not the one who first invented the device, but the one who first reduced the device to actual practice. *Automatic Weighing Mach. Co. v. Pneumatic Scale Co.*, 166 Fed. 288; *One-Piece Lens Co. v. Bisight Co.*, 246 Fed. 450. As the decision was virtually affirmed by the Supreme Court in refusing a writ of *certiorari*, 246 U. S. 659, and was cited with approval in *E. W. Bliss Co. v. Southern Can Co.*, 251 Fed. 903, 907, it will probably stand as the proper interpretation of the statute. J. B. W.