

EQUITABLE DEFENSES TO A BROADENED REISSUE PATENT

The purpose of this note is to trace the history, development and present status of the equitable rights of persons accused of infringing a broadened¹ reissue patent. These equitable rights arise as defenses, in favor of one who, during the interval between the date of an original patent and the date of its reissue, has acted in such a way that strict enforcement of the reissue would substantially injure him. These rights will be considered in light of the impact of the 1952 Patent Act on prior case law.

I. REISSUE

A reissue patent is in the nature of an amendment which cures what would otherwise be an at least partially inoperative patent.² The dominant purpose of the reissue is to reinstate certain inadvertently lost rights of the inventor.³

A reissue will be granted only for the same invention covered by the original patent.⁴ No new matter may be added.⁵ Although a reissue may arise from partial invalidity of the original patent, such inoperativeness must result either from defective or insufficient specifications or from a situation where the patentee claimed more⁶ or less⁷ than he had a right to claim as new, resulting from inadvertence, accident or mistake.⁸ A show-

1. A reissue is broadened when it serves to bring under the monopoly things that the original patent would not have covered. *Supreme Mfg. Corp. v. Security Mfg. Co.*, 299 Fed. 65 (9th Cir. 1924). For purposes of this note, reissues containing claims that both narrowed and broadened those of the original patent will be considered as broadened reissues.

2. Today, the original patent need not be completely inoperative for a reissue to be granted. 35 U.S.C. § 251 (1958). Upon the granting of the reissue, the original patent is surrendered.

3. Infringement actions begun under claims of the original patent are not abated by the issuance of a reissue. See 35 U.S.C. § 252 (1958). However, for purposes of this discussion, it is assumed that the original patent has not been infringed.

4. *Parker & Whipple Co. v. Yale Clock Co.*, 123 U.S. 87 (1887).

5. *Powder Co. v. Powder Works*, 98 U.S. 126 (1878).

6. 16 Stat. 230 (1870).

7. This was added in the 1952 Patent Act for the first time. 35 U.S.C. § 251 (1958). The majority of cases had permitted this as a proper ground for reissue. *E.g.*, *Smith v. Merriam*, 6 Fed. 713 (D. Mass. 1881). *Contra*, *Leggett v. Standard Oil Co.*, 149 U.S. 287 (1893); *Wichita Visible Gasoline Pump Co. v. Clear Vision Pump Co.*, 19 F.2d 435 (8th Cir. 1927).

8. *Fay v. Mason*, 120 Fed. 506 (W.D.N.Y. 1903); *Stafford Co. v. Coldwell-Gildard Co.*, 202 Fed. 744 (1st Cir. 1913).

ing of fraud or deception is fatal.⁹ Moreover, the patentee must have demonstrated diligence in making the reissue application.¹⁰

A reissued patent (specifications corrected) has the same effect and operation in law on the trial of all subsequent claims as if the corrected specifications had originally been granted.¹¹ The required surrender of the original at the reissue date does not affect pending or existing actions insofar as the claims of the original and reissue are identical. Such claims constitute a continuation of the original patent and have effect from the original patent date.¹²

Reissue patent questions were first presented to the Supreme Court in 1832 in the case of *Grant v. Raymond*.¹³ The plaintiff had received his patent in 1821 for an improvement in the mode of manufacturing hat bodies. "[O]wing to the defective specification"¹⁴ on which it was issued, he requested in 1825 that his original patent be canceled and that a new one issue, with the specification corrected. The reissuance was approved by the Court in accordance with the "general spirit and object of the law," thereby preventing the public from availing itself of the opportunity to take advantage of specification defects.

A few months after the *Grant* decision, Congress demonstrated approval of reissued patents by passing a statute regulating them.¹⁵ The law of reissue has met with various statutory modifications since that date.¹⁶

It was initially evident that there was a possibility of substantial harm to one who acted in the period between the date of the granting of the original patent and its reissue. A question posed by the defendant's attorney in the *Grant* case illustrated the situation with which a defendant could be faced:

A man builds an expensive factory, puts in costly machinery not patented, not described in any specification; he expends much money; by and by he is sued for violating a patent, and he finds that since he built, an old patent has come out with a new specification. A hearing, of which he knew nothing has been had before the secretary, and a new patent has issued, and he is called on to stop his factory. . . .
*Is this legal?*¹⁷

9. *Westinghouse Elec. & Mfg. Co. v. Stanley Elec. Mfg. Co.*, 115 Fed. 810 (D. Mass. 1902).

10. *Pelzer v. Meyberg*, 97 Fed. 969 (S.D. Cal. 1899).

11. 16 Stat. 230 (1870).

12. Added in the 1952 Patent Act. 35 U.S.C. § 252 (1958).

13. 31 U.S. (6 Pet.) 218 (1832).

14. *Id.* at 223.

15. 4 Stat. 162 (1832).

16. For a discussion of the subsequent statutes, see 2 WALKER, PATENTS §§ 302-05 (Deller ed. 1937).

17. *Grant v. Raymond*, 31 U.S. (6 Pet.) 218, 230 (1832). (Emphasis added.)

However, the Court rejected the plea, holding as a "matter of *equity*" that any defense was void because the only way that a defendant could have realized that his structure did not infringe the plaintiff's patent was by examining the patent for the purpose of pirating it.¹⁸

Thus, in order not to infringe a patent, one was forced to exercise a high degree of foreseeability because he was held to constructive knowledge of every conceivable method by which a patentee could broaden his claims in a reissue. It no longer seemed necessary for the patentee to exercise diligence when stating his claims in the original patent. Other persons who did the patentee's extrapolation work for him by creating new structures which did not infringe the original patent but were covered by a reissue, found themselves liable in treble for "infringement" damages.

For a long period after 1832 there was only one available defense, in the absence of fraud, to a suit for reissue infringement. The defendant was required to prove the reissue void for statutory non-compliance.¹⁹ This could be done in various ways. Originally, the defendant could show that: the original patent was valid and operative and its specification neither defective nor insufficient;²⁰ there was an absence of inadvertence, accident or mistake;²¹ the reissue was not for the same invention as the original;²² or that the reissue contained new matter.²³ Later, the defendant was allowed to prove that the original claim was broadened to include items intentionally rejected,²⁴ omitted, discarded or abandoned in the original patent.²⁵

During this period, equitable defenses were unsuccessfully attempted. In an early case²⁶ in which the defendant raised an equitable defense the Supreme Court clearly stated its position on intervening rights of parties. It stated that no one, regardless of the extent to which he used the invention prior to the date of the reissue, would be authorized to use it subsequent to that time. Statements such as "[P]roof of the use of the thing patented, during the interval between the original and renewed patents," would not defeat the action, seemed to illustrate well, the judicial rejection of intervening rights.²⁷

18. *Id.* at 240.

19. 5 Stat. 357 (1836).

20. See note 6 *supra*.

21. See note 8 *supra*.

22. See note 4 *supra*.

23. See note 5 *supra*.

24. *Olin v. Timken*, 155 U.S. 141 (1894). The patentee was not allowed to broaden his claims to include more than he had intended to include in the original patent.

25. *In re Appeal of Denton*, 12 App. D.C. 504 (Ct. App. 1898).

26. *Stimpson v. Westchester R.R.*, 45 U.S. (4 How.) 380 (1846).

27. *Battin v. Taggart*, 58 U.S. (17 How.) 74, 84 (1854).

II. DOCTRINE OF LACHES

Equitable defenses first found recognition in 1882. In *Edward Miller & Co. v. Bridgeport Brass Co.*,²⁸ which involved an 1860 patent for alleged improvements in lamps, the patentee claimed that as a consequence of the improvements, a lamp would no longer need a chimney. The patent was reissued in 1873 and again in 1876. Although the patented improvements failed, both the plaintiff and the defendant discovered that restoration of the chimney in conjunction with the claimed improvements improved lamp performance.

The patentee's application for his second reissue (1876) described the lamp manufactured by both parties in the interval. The Court found that the reissue was not for the originally patented invention, and, because of the absence of inadvertence or mistake in the original patent, held it void. Stating that it was not the intention of Congress for broadened reissues to be granted,²⁹ the Court called attention to the inequitable results often accompanying broadened reissues. It further explained that the law did not authorize patent expansion without regard to lapse of time, since it would "operate most unjustly against the public."³⁰ This was the first time that laches was recognized as a possible defense to the validity of reissues, and this case laid the foundation for subsequent invocation of that doctrine.

The doctrine of laches found immediate application.³¹ In *Bantz v. Frantz*³² an unreasonable delay of more than thirteen years was held an abandonment of the right to correct by reissue. Thereafter, a large number of reissues were litigated, and in many cases laches was applied to hold them void, although lengths of time held to be unreasonable varied.³³

The *Miller* case had declared the question of reasonableness to be a court determination, but had inadvertently suggested a two-year rule by comparing this interval to the period of public use.³⁴ This two-year stand-

28. 104 U.S. 350 (1882).

29. *Id.* at 354.

30. *Id.* at 355.

31. Several cases decided the same year as the *Miller* case invoked the doctrine of laches: *Johnson v. Railroad Co.*, 105 U.S. 539 (1882); *Mathews v. Machine Co.*, 105 U.S. 54 (1882); *Bantz v. Frantz*, 105 U.S. 160 (1882).

It has been suggested that Chief Justice Taney, in *Knight v. Baltimore & O. R.R.*, 14 Fed. Cas. 758 (No. 7882) (C.C.D. Md. 1840), instructed a jury that the plaintiff must have acted in a reasonable time after discovery of error. But courts did not adopt such a rule, preferring instead to use the date of the original patent. 2 WALKER, PATENTS § 323 (Deller ed. 1937).

32. 105 U.S. 160 (1882).

33. *E.g.*, *Electric Gas-Lighting Co. v. Boston Elec. Co.*, 139 U.S. 481 (1891) (eight years); *Mahn v. Harwood*, 112 U.S. 354 (1884) (four years).

34. Originally, an object was not patentable if it had been in public use for a period

ard was subsequently adopted in *Mahn v. Harwood*.³⁵ Recognizing the inadvisability of an invariable rule, the Court nevertheless followed the *Miller* suggestion of two years, in the absence of extenuating circumstances.³⁶ The two-year rule has been adopted by a majority of the courts considering the problem of laches.³⁷

In 1939 Congress changed the "public use" period from two years to one year,³⁸ and it was later suggested that the same change should be made in the laches period.³⁹ Although this reasoning was generally rejected, there was at least one decision based on a one-year rule.⁴⁰ It would seem desirable to keep the reissue interval in conformity with the public use period. If a structure has been in public use more than one year it is not patentable under the public use rule. However, if the patentee has a patent that can be broadened to include a structure that has been in public use for more than a year, he is given an extra year to reissue under the *Miller* doctrine. This added time may unnecessarily benefit the patentee at the expense of the public which often justifiably relies upon the narrow provisions of the original patent.

Two aspects of laches as formerly applied by the courts should be considered. First, when the doctrine was strictly applied *time* was the sole consideration and intervening use by parties who relied on the original patent had no relevance. Second, the two year rule provided for exceptions when circumstances justified them. Justifying circumstances appeared in a few cases⁴¹ but in no Supreme Court decision.⁴² However, the 1952 Patent Act has removed this latter problem from consideration.⁴³

III. INTERVENING RIGHTS

The question of intervening rights was an underlying issue in many cases invoking the *Miller* doctrine. Indeed, several courts seemed to rec-

exceeding two years. The period was changed in 1939 to one year. See text accompanying notes 38 & 39 *infra*.

35. 112 U.S. 354 (1884).

36. *Id.* at 363.

37. *E.g.*, *Wollensak v. Sargent*, 151 U.S. 221 (1894); *Supreme Mfg. Corp. v. Security Mfg. Co.*, 299 Fed. 65 (9th Cir. 1924).

38. 53 Stat. 450 (1939).

39. See *Interstate Bakeries v. General Bakeries Co.*, 84 F. Supp. 92, 107 (D. Kan. 1948).

40. *In re Dufault*, 41 C.C.P.A. (Patents) 971, 214 F.2d 181 (1954). This case apparently was initiated prior to the 1952 Act which codified the two-year rule.

41. See *e.g.*, *Worthington Pump & Mach. Corp. v. Clark Bros.*, 17 F.2d 189 (W.D.N.Y. 1927) (original patentee, a German citizen, hindered by outbreak of World War I).

42. *Hartshorn v. Saginaw Barrel Co.*, 119 U.S. 663 (1887).

43. 35 U.S.C. § 252 (1958). Under present law application must be made within two years of the original patent.

ognize the relevancy of these rights in patent reissue cases.⁴⁴ Decisions, however, were not based on intervening rights, even when the courts favored the defendants. Laches or the invalidity of the reissue *ab initio* were the preferred rationales.⁴⁵

In 1915, however, the second circuit based an opinion squarely upon the intervening rights doctrine.⁴⁶ The defendant manufactured and sold automatic trackers for player pianos. Subsequently, the complainant broadened his original patent to include this device. While recognizing the validity of the reissue, the court nevertheless held the complainant *estopped* from interfering with the defendant's tracker business since the defendant had produced his product in the belief, warranted by the complainant's conduct, that it would not be challenged as an infringement.⁴⁷

A district court in New York made a similar finding two years later.⁴⁸ During the seven years which had elapsed between the original patent and the application for broadened reissue,⁴⁹ the defendant had patented and begun manufacture of his device. Judge Augustus Hand held that although the reissue was infringed, the suit could not be maintained because the defendant had acquired intervening rights.

In their initial recognition of intervening rights courts equated them with the doctrine of estoppel.⁵⁰ When the elements of estoppel could not be established, the doctrine of intervening rights was not applied.⁵¹ Thus a complete reversal in the law had taken place: the defendant was no longer prohibited from relying on the narrow claims of a patent,⁵² but rather the defendant, in order to obtain intervening rights, was required to have

44. *Dunham v. Dennison Mfg. Co.*, 40 Fed. 667 (S.D.N.Y. 1889), *aff'd*, 154 U.S. 103 (1894).

45. See text accompanying notes 19-25 *supra*.

46. *Autopiano Co. v. American Player Action Co.*, 222 Fed. 276 (2d Cir. 1915).

47. *Id.* at 282. It has been said that this was merely dictum and that the court actually decided the case on the absence of inadvertence in the original patent. Rice & Grossman, *Reissued Patents and Intervening Rights*, 43 YALE L.J. 766, 779 n.44 (1939).

48. *Ashley v. Samuel C. Tatum Co.*, 240 Fed. 979 (S.D.N.Y. 1917).

49. The delay, caused by protracted litigation over a disputed point of law, was excused by the court.

50. *E.g.*, *Ashland Fire Brick Co. v. General Refractories Co.*, 27 F.2d 744 (6th Cir. 1928).

51. In a 1916 case, the year after the *Ashley* decision (note 48 *supra*), the Sixth Circuit Court of Appeals discussed the doctrine of intervening rights but found that the defendant had not done enough in reliance upon the original patent to be able to raise estoppel. *American Automotoneer Co. v. Porter*, 232 Fed. 456 (6th Cir. 1916).

52. See text accompanying note 18 *supra*.

relied. Furthermore, not all circuits were willing to recognize a reissue that could be enforceable against everyone except the defendant.⁵³

In 1924, the Supreme Court recognized the emerging doctrine of intervening rights and the conflict in circuit opinions concerning it, when it granted certiorari in *Keller v. Adams-Campbell Co.*⁵⁴ Regrettably, the facts of that case would not allow the Court to reconcile the circuits because the reissue was held not infringed and hence certiorari was dismissed as improvidently granted.

In the case of *Sontag Chain Stores Co. v. National Nut Co.*,⁵⁵ the ninth circuit held the doctrine of intervening rights inapplicable because the defendant admittedly did not rely on the scope of the plaintiff's patent and the doctrine of estoppel could not be justified. Certiorari was granted, and for the first time, the Supreme Court was able to pass upon intervening rights. The Court acknowledged the defendant's intervening rights and approved in the holding in *Ashland Fire Brick Co. v. General Refractories Co.*, thereby invoking estoppel as the basis of intervening rights. The Court further recognized that a reissue valid against the world could be unenforceable when applied to a particular defendant. However, to satisfy the knowledge requirement of estoppel, the Court used constructive knowledge of the patent under section 39 of the then existing patent laws.⁵⁷

Although most, if not all, courts recognized a doctrine of intervening rights by 1952, there was no uniformity about what the defendant had to do in the intervening period to qualify for such rights. It was clear, however, that the only relevant actions of the defendant were those taken in the interval between the date when the original was granted and the application date for the reissue.⁵⁸

The defendant was required to have made some expenditure,⁵⁹ but ex-

53. *Otis Elevator Co. v. Atlantic Elevator Co.*, 47 F.2d 545 (2d Cir. 1931). The court stated that to the best of its knowledge, no reissue had ever been held valid to the world although unenforceable against the defendant, refusing to recognize other circuits' decisions.

54. 264 U.S. 314 (1924). Various cases were cited by the Court, but some of them were not even based on the doctrine. *Id.* at 318.

55. 107 F.2d 318 (9th Cir. 1939), *rev'd*, 310 U.S. 281 (1940).

56. 27 F.2d 744 (6th Cir. 1928) (one of the initial decisions recognizing intervening rights). See text accompanying note 50 *supra*.

57. 35 U.S.C. § 39 (1929). This section required recording of all patents in the books of the patent office. It has been generally held that constructive notice of all recorded patents goes to the world. See, *e.g.*, *Wine Ry. Appliance Co. v. Enterprise Ry. Equip. Co.*, 297 U.S. 387, 393 (1936).

58. *H. W. Roos Co. v. McMillan*, 64 F.2d 568 (6th Cir. 1933).

59. *Ibid.*

pense in research was not sufficient.⁶⁰ A considerable sum was necessary,⁶¹ or at least a substantial amount which exceeded the cost of research.⁶² Commencement of production was not required,⁶³ but if the devices had been placed on the market, some of them must have been sold.⁶⁴

In addition, courts generally required the defendant to have made substantial use of the device.⁶⁵ In one case it was held sufficient if the defendant used his device before the plaintiff's was marketed.⁶⁶ However, the mere patenting of a device by the defendant in the interval would not per se create intervening rights.⁶⁷ Where the defendant applied for his patent before, but received it after the plaintiff received his reissue, intervening rights could not be interposed⁶⁸ in the absence of more substantial action.

The doctrine of laches and the doctrine of intervening rights were, then, the two basic defenses to patent reissues that were allowed by the courts. Laches depended on the lack of diligence of the patentee upon discovery of error in the original patent, and if applied would invalidate the reissue.⁶⁹ On the other hand, the doctrine of intervening rights was based upon actions of the defendant and only rendered the reissue unenforceable against the person acquiring the rights.⁷⁰ Frequently, however, the courts confused the two doctrines, and often used intervening rights as evidence of laches.⁷¹ When the courts invoked intervening rights as evidence of laches, they may have meant that "public art" had advanced to such an extent that it would be unjust to allow the original patent to be reissued. Failure

60. *Tulchen v. Perey Mfg. Co.* 87 F.2d 302 (2d Cir. 1937). No more than one experimental turnstile had been made.

61. *Supreme Mfg. Corp. v. Security Mfg. Co.*, 299 Fed. 65 (9th Cir. 1924).

62. *Ashland Fire Brick Co. v. General Refractories Co.*, 27 F.2d 744 (6th Cir. 1928).

63. *American Automotoneer Co. v. Porter*, 232 Fed. 456 (6th Cir. 1916).

64. *Bull Dog Floor Clip Co. v. Munson Mfg. Co.*, 19 F.2d 43 (8th Cir. 1927); *A. D. Howe Mach. Co. v. Coffield Motor Washer Co.*, 197 Fed. 541 (4th Cir. 1912).

65. *Sontag Chain Stores Co. v. National Nut Co.*, 310 U.S. 281 (1940). (nine months held to be sufficient).

66. *Rancourt v. Panco Rubber Co.*, 67 F.2d 790 (1st Cir. 1933).

67. *Monogram Mfg. Co. v. Glemby Co.*, 136 F.2d 961 (2d Cir. 1943).

68. *American Automotoneer Co. v. Porter*, 232 Fed. 456 (6th Cir. 1916).

69. The period that was considered as evidence of laches started with the grant of the original patent, and not with the discovery of the error in the patent. See note 31 *supra*. The probable explanation of this rule is that courts were interested in the errors on the face of patents rather than the errors that intervening third parties brought to the attention of patentees.

70. *Autopiano Co. v. American Player Action Co.*, 222 Fed. 276 (2d Cir. 1915).

71. *Carpenter Straw-Sewing Mach. Co. v. Searle*, 60 Fed. 82 (2d Cir. 1894); *Baltimore Car-Wheel Co. v. North Baltimore Passenger Ry. Co.*, 21 Fed. 47 (D. Md. 1884). In *H. W. Roos Co. v. McMillan*, 64 F.2d 568 (6th Cir. 1933), it was held that although the reissue was applied for within two years, the presence of intervening rights of a person not a party to the suit made it void.

to judicially define the use of the term "intervening rights" created much confusion, and whether it meant the right of a defendant to be immune from a valid reissue or the right of the public to have a reissue declared void was often conjectural.

In summary, prior to the 1952 Patent Act, a broadened reissue applied for more than two years after the granting of the original was void, in the absence of extenuating circumstances. However, it was valid if application was made within two years unless there were persons who had acted in the interval. If the defendant had so acted, the broadened reissue was valid to the world but unenforceable against him. On the other hand, if he had not acted, but could prove that some third party had, the reissue was void to the world.⁷² The situation was indeed curious! Therefore one might easily conclude that laches was the only governing doctrine, and intervening rights were *de facto* nonexistent.

IV. THE 1952 PATENT ACT⁷³

The patent act of 1952 stemmed from two movements: one to amend the existing patent laws, and the other to revise and codify the case law.⁷⁴

Grounds for reissue are declared in the first paragraph of section 251, where for the first time the right to broaden received *statutory* recognition.⁷⁵ Paragraph four codified the two year rule, making it an absolute limitation. A reissue enlarging the scope of the original patent is prohibited, unless it is applied for within two years from the original grant.⁷⁶ The possibility of extenuating circumstances is thereby eliminated.⁷⁷

Section 252 posited the effect of the reissue, setting forth when the claims are considered effective.⁷⁸ Although paragraph two provided for intervening rights, it did not technically codify established doctrine. Prior case law recognized such rights only in the interval between original grant and *application* for reissue.⁷⁹ The statute, however, changed the rule to encompass the period "prior to the *grant* of the reissue."⁸⁰

72. H. W. Roos Co. v. McMillan, *supra* note 71.

73. 35 U.S.C. (1958).

74. Federico, *Commentary on the New Patent Act*, 35 U.S.C.A. 1 (1958). Sections 251 and 252 are pertinent to this discussion.

75. See text accompanying note 7 *supra*.

76. Apparently there is no limit of time during which a "narrowed" reissue must be granted. 35 U.S.C. § 251 (1958).

77. See note 43 *supra*.

78. See text accompanying notes 11 & 12 *supra*.

79. H. W. Roos Co. v. McMillan, 64 F.2d 568 (6th Cir. 1933).

80. Thus, at present, rights may also be acquired by one who acted prior to the original patent. It is submitted that the old law, permitting rights to be acquired only up

To obtain intervening rights under section 252, it is only necessary that the person, or his successor in business, has made, purchased or used, prior to the grant of the reissue, that which the reissue covered but the original patent did not.⁸¹ There is no longer a requirement of estoppel; thus an antiquated basis of intervening rights has been eliminated. This deletion climaxed a long period in which estoppel had been questioned as a "proper"⁸² or "sound"⁸³ basis for intervening rights.

It is noteworthy that once intervening rights have been acquired, both absolute and discretionary protection is available. That which was made or used before the reissue date is absolutely free from new claims and may be sold or used thereafter without regard to the reissue. However, these rights do not necessarily extend to the making or procuring of additional devices of a similar nature. In this respect a court may, in its discretion, permit: (1) continuance of the manufacturing of an object and its use or sale; (2) continued manufacture, and use or sale when substantial preparation is made before the grant of the reissue; and (3) use of a process patented by the reissue, practiced or about to be practiced when the reissue was granted, where substantial preparation was made.⁸⁴ Although this judicial discretion is contrary to a large body of case law, which did not give a defendant rights beyond the date of the reissue,⁸⁵ it had been suggested twenty-eight years earlier.⁸⁶

CONCLUSION

Conflicting policy considerations pervade the law of patent reissue. If the inventor is favored and allowed to recapture lost rights, original inventiveness, ingenuity, and imagination will be encouraged. On the other hand, court protection of the would-be infringer by requiring the patentee to express with certainty all that his patent is to cover, will encourage the quest to improve existing devices.

Originally patent reissues were granted liberally and the inventor was allowed to recapture that which his claim had permitted to escape. The policy was to permit the inventor to benefit from his efforts at any costs, but many harsh results were directly attributable to this position. Gradually, however, equity became cognizant of intervening rights. An inventor to the application for reissue, was not sensible, as applications are not constructively known to the world, but are kept in the strictest confidence.

81. 35 U.S.C. § 252 (1958).

82. *Otis Elevator Co. v. Atlantic Elevator Co.*, 47 F.2d 545 (2d Cir. 1931).

83. *Rice & Grossman*, *supra* note 47, at 786-87.

84. *Federico*, *supra* note 74, at 47.

85. *E.g.*, *H. W. Roos Co. v. McMillan*, 64 F.2d 568 (6th Cir. 1933).

86. *Keller v. Adams-Campbell Co.*, 264 U.S. 314 (1924).

who failed to exercise diligence by making a reissue application after the lapse of a reasonable interval frequently had his reissue declared void by the courts. Finally the law gave intervening parties protection irrespective of the inventor's diligence.

The 1952 Patent Act has enhanced the position of "intervening" defendants in several ways:

(1) By eliminating the fictitious basis of estoppel, the statute has obviated the necessity of proving actual or constructive knowledge of, and reliance upon, the original patent.

(2) The "intervening rights" interval between the date of the original patent and the reissue has been extended to the date of actual reissue.

(3) It limited the inventor to a two year period in which to act in the case of a broadened reissue, thereby giving the would-be infringer a greater degree of certainty.

(4) It lessened the amount of action necessary to qualify for intervening rights and entrusts the extent of future remedies to judicial discretion.

However, the statute also benefitted the inventor by guarantying a two-year reissue period, which exceeds the one year "public use" period. Further, the former practice whereby a defendant could avail himself of *another's* intervening rights is eliminated. Finally, the presence of intervening rights can not affect the over-all validity of a reissue within this two year period.

In summary, the 1952 "codification" act has given both the inventor and the intervening party additional rights. An intervening party has definite rights and a patentee is free from all defenses of an infringer who did not act in the interval if the application for reissue was filed within two years.