

LATER PATENTS AS PRIOR ART

"Whoever without authority makes, uses or sells any patented invention . . . infringes the patent"¹ and may be sued for doing so. He, in turn, may defend on the statutory ground that the patent is invalid.² Under the statute,³ the defendant may use other patents, called reference patents, to invalidate the patent in suit if these reference patents negative any of the "conditions for patentability" which are listed in part II of the statute.⁴ In determining the defensive competence of any of the possible reference patents, the defendant must consider a number of factors: what is dis-

1. Patent Act of 1952, 35 U.S.C. § 271 (1964). Unless otherwise indicated, hereafter all citations to statute sections are to 35 U.S.C. (1964).

2. The popularity of this defense is evidenced by the fact that approximately 50% of the patents whose validity has been questioned in court have been found invalid. 41 J. PAT. OFF. SOC'Y 291 (1959).

3. The section of the Patent Act relating to defenses reads as follows:

§ 282. Presumption of validity; defenses

A patent shall be presumed valid. Each claim of a patent (whether in independent or dependent form) shall be presumed valid independently of the validity of other claims; dependent claims shall be presumed valid even though dependent upon an invalid claim. The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting it.

The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

- (1) Noninfringement, absence of liability for infringement or unenforceability,
- (2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability,
- (3) Invalidity of the patent or any claim in suit for failure to comply with any requirement of sections 112 or 251 of this title,
- (4) Any other fact or act made a defense by this title.

In actions involving the validity or infringement of a patent the party asserting invalidity or noninfringement shall give notice in the pleadings or otherwise in writing to the adverse party at least thirty days before the trial, of the country, number, date, and name of the patentee of any patent, the title, date, and page numbers of any publication to be relied upon as anticipation of the patent in suit or, except in actions in the United States Court of Claims, as showing the state of the art, and the name and address of any person who may be relied upon as the prior inventor or as having prior knowledge of or as having previously used or offered for sale the invention of the patent in suit. In the absence of such notice proof of the said matters may not be made at the trial except on such terms as the court requires. *As amended* (Supp. 1965).

The defenses enumerated under subsection (3) relate to indefiniteness in the disclosure of the invention in the patent specification and to reissue of defective patents. Thus, the only section under which the effect of other patents on the validity of the patent in suit becomes an issue is § 282(2). The relevant sections of part II of the statute are §§ 101, 102, and 103.

4. The term "conditions for patentability" is unfortunate. The "conditions" set out in §§ 102 and 103 are in fact conditions for non-patentability. If any of the conditions listed in these sections is shown to exist, an inventor is not entitled to a patent on his invention. The terminology used herein is based on the construction that these conditions represent positive conditions for patentability, so as to conform with the titles of the sections rather than with their actual arrangement.

closed in the specification and drawings of the reference patent, what is claimed, to whom it was issued, and certain critical dates. These dates are the date the reference patent was applied for and when it was issued. If the reference patent was applied for before, but issued after, the application date of the patent in suit, the reference patent is known as a "copending patent."⁵ The status of copending patents as references has been the subject of considerable concern, both before and since the enactment of the present statute.⁶

This note will consider the competence of a copending patent applied for before the patent in suit, but issued after the issuance of the patent in suit. It will not be concerned with the case in which both patents are to the same person. In that situation, the rule against double patenting is the only bar applicable. Under this rule the later patent may not be a bar to an earlier one to the same inventor.⁷ Therefore, this note will consider only the case in which the later-issued patent is to a different inventor.

Under the present statute a copending patent to another is a valid reference against an *application* not only for what it claims, but for what it discloses.⁸ The same is true of a prior-issued copending patent to another when raised as a defense in an infringement suit.⁹ When, however, the patent sought to be raised as a defense in not only a copending patent but

5. Virtually every writer in the field of copending patents has noted the ambiguity of the term. The earliest seems to have been Commissioner of Patents Newton in *Ex parte Thomas*, 251 O.G. Pat. Off. 839 (1918). As used herein, the term "copending patent" refers to a patent applied for before, but granted after, the application date of the patent or application in issue, regardless of the identity of the patentee of the copending patent.

6. The most frequently discussed problem was whether that which is shown, but not claimed, in a copending patent to another inventor is competent defensive material if what is shown is not identical with the invention claimed by the later applicant. This question has at last been resolved by the Supreme Court. *Hazeltine Research, Inc. v. Brenner*, 382 U.S. 252 (1965).

7. The basic problems are discussed in *Application of Sarett*, 327 F.2d 1005, 1010-11, 1014-15 (C.C.P.A. 1964). See Palmer, *Double Patenting and Patent Soliciting*, 41 J. PAT. OFF. SOC'Y, 458, 462 (1959); Rosenberg, *Double Patenting*, 45 J. PAT. OFF. SOC'Y, 34 (1963).

The rule is that an inventor cannot patent the same invention twice. Since the invention patented is that which is described by the claims of the patent, the claims must be compared to see whether they describe the "same" invention. What constitutes the "same" invention is the basic question of the law of double patenting. For a carefully reasoned analysis of the grounds on which double patenting might be found and a discussion of the earlier cases see E. STRINGHAM, *DOUBLE PATENTING* § 2860 (1933). The later cases and their holdings are compiled by Palmer, *supra*.

8. § 102(e).

9. § 282(2).

also later-issued,¹⁰ three questions are presented: (1) whether there are sound reasons for treating a later-issued copending patent differently from a prior-issued patent; (2) if so, to what extent a later-issued patent should still be considered valid defensive material in a patent infringement suit; (3) to what extent the courts have recognized a difference between prior-issued and later-issued copending patents.¹¹

I. THE LAW BEFORE 1952

The present statute and the court decisions since its passage rely heavily on the earlier statute and case law.

1. *Statutory Defenses*

Revised Statutes section 4920,¹² the statute which provided defenses in infringement suits from before the turn of the century until passage of the present statute, had five defenses, two of which—the third and the fourth—were relevant to copending patents.¹³ These were generally described by the courts as “description in the prior art,”¹⁴ which was thought

10. The order of events in the situation considered can be set out as follows:

- X files application disclosing invention A.
- P files application claiming invention A.
- P receives patent on invention A.
- X receives patent.

We shall be concerned with the effect given a “later issued” copending patent (the patent to X) in an infringement suit (on the patent to P).

11. The possibility that later-issued patents should be treated differently from prior-issued patents seems to have been raised most clearly by Johnson, *The Alexander Milburn Co. vs. Davis-Bournonville Co.*, 8 J. PAT. OFF. SOC'Y 413, 415, 419, 422 (1926). See *Ex parte Thomas*, 251 O.G. PAT. OFF. 839, 841 (1918). See also Roth, *Obviousness Under Section 103*, 47 J. PAT. OFF. SOC'Y 811, 824-25 (1965).

12. Patent Act of 1897, ch. 391, § 2, 29 Stat. 692, as amended, ch. 450, § 1, 53 Stat. 1212 (1939).

13. Patent Act of 1897, ch. 391, § 2, 29 Stat. 692, as amended, ch. 450, § 1, 53 Stat. 1212 (1939):

In any action for infringement the 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 any one or more of the following special matters:

Third. That it has been patented or described in some printed publication prior to his supposed invention thereof . . . or,

Fourth. That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented;

And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of the patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented or to have had the prior knowledge of the thing patented

14. The third defense.

to mean publication, and "prior inventorship,"¹⁵ which was thought to entail both conception and reduction to practice. The history of the statute, however, seems to have been largely a losing battle by courts to maintain a distinction between the two.¹⁶

2. *Early Decisions*

Commentators on the general problems of copending patents have generally been content to write off the pre-1926 history of the courts' treatment of copending patents as hopelessly confused.¹⁷ Three cases in this period, however, so presage the trends in the later law that they should be discussed.¹⁸

The earliest of these cases, *Sundh Elec. Co. v. Interborough Rapid Transit Co.*,¹⁹ was a patent infringement suit on a patent to Sundh. The defendant introduced a patent to one Ihlder to show that Sundh was not the first inventor. The respective critical dates of the two patents are typical of those which raise the problem under consideration:

June 10, 1902: Ihlder application for patent filed.

March 16, 1903: Sundh application filed.

July 14, 1903: Sundh patent issued.

October 20, 1903: Ihlder patent issued.²⁰

The trial court had found that the Ihlder patent did not "anticipate" the patent in suit because it was copending and later-issued, and hence "was

15. The fourth defense.

16. Compare *Davis-Bournonville Co. v. Alexander Milburn Co.*, 297 Fed. 846 (S.D.N.Y. 1924), with *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390 (1926).

17. See, e.g., Dodds, *The Anticipatory Competence of Copending Patents*, 28 J. PAT. OFF. SOC'Y 238, 241 (1946).

18. *Sundh Elec. Co. v. Interborough Rapid Transit Co.*, 198 Fed. 94 (2d Cir. 1912); *Lemley v. Dobson-Evans Co.*, 243 Fed. 391 (6th Cir. 1917); *Ex parte Thomas*, 251 O.G. Pat. Off. 839 (1918). The first two cases are particularly interesting because they represent the lines of decisions in the Second and Sixth Circuits which led to the fateful case of *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390 (1926).

The three cases are of special interest because of their use of the term "anticipation." The cases did not use the term to refer solely to either of the defenses, but often used it to mask a transition from one defense to the other.

19. 198 Fed. 94 (2d Cir. 1912).

20. The Ihlder patent is what has been denominated a later-issued copending patent. The dates are somewhat atypical in that both applications were allowed so quickly by the Patent Office. For an analysis of the present rate of applications through the Patent office see, e.g., Milmore, *Commentaria, Pendency of Patent Applications*, 41 J. PAT. OFF. SOC'Y 510 (1959). Some increase in the rate has been achieved by recent changes in the Patent Office procedure, so the present rate is probably less than a median pendency of over three years as indicated by Milmore.

not of the prior art."²¹ The Second Circuit considered the trial court's discussion to be limited to the third defense²² and, while affirming the correctness of its analysis of the third defense, determined that the fourth defense, prior inventorship, should have been applied.²³ The court found that Ihlder both described and claimed the same invention claimed in the Sundh patent, and could account for the failure of the Patent Office to declare an interference "only on the theory of oversight."²⁴

A Sixth Circuit case, *Lemley v. Dobson-Evans Co.*,²⁵ held the patent in suit invalid because of an earlier patent which showed the general arrangement claimed, when that patent was taken together with two patents which were copending with the patent in suit. The copending patents showed the equivalence of the various means called for by the main reference patent. The court re-examined its position that "a patent, the filing date of which antedated the filing date of the patent in suit, was, prima facie, anticipatory" and decided to maintain it.²⁶ The court concluded at the outset that there was really no difference between the third defense and the fourth, and thus treated both defenses as matters of pleading.²⁷

21. *Sundh Elec. Co. v. Interborough Rapid Transit Co.*, 222 Fed. 334 (C.C.S.D.N.Y. 1911), *rev'd*, 198 Fed. 94 (2d cir. 1912).

22. 198 Fed. at 96.

23. *Id.* at 97, 98. Other courts had recognized the distinction between the third defense (disclosure in the prior art) and the fourth defense (prior inventorship) that in the former a reference patent was effective only as of the date of issue, whereas in the latter the application date could be relied upon. *See Barnes Automatic Sprinkler Co. v. Walworth Mfg. Co.*, 60 Fed. 605 (7th Cir. 1894); *Diamond Drill & Mach. Co. v. Kelly Bros.*, 120 Fed. 282, 287 (C.C.E.D. Pa. 1902).

24. 198 Fed. at 98. The court's analysis was:

In order to maintain this fourth defense it must, of course, appear that the invention of the patent in suit and the invention of the prior application are the same. . . .

. . . [T]he substantial invention of each patent is the invention set forth in the claims when such claims are construed in the light of the specifications. We may best compare the third claims of both patents.

. . . Each of these claims reads with great precision upon the devices of both patents. Since both were pending in the Patent Office at the same time, interference should have been declared. *Id.* at 97-98.

25. 243 Fed. 391 (6th Cir. 1917).

26. *Id.* at 395.

27. The court said:

The patent statute . . . catalogues five supposedly independent matters of defense, and requires the pleading of those which are to be relied upon. The separation is not analytically perfect; the last clause [b] of "third" seems to belong to "fifth," and since the patentee could not possibly be the first inventor of something that, before his invention, had been patented to or described by another, the entire first clause [a] of "third" seems quite unnecessary. However, we have to deal with the statute as it is. *Lemley v. Dobson-Evans Co.*, 243 Fed. 391, 395 (6th Cir. 1917).

The court supported its conclusion that if the invention was described by another then

The third case, *Ex parte Thomas*,²⁸ represents a carefully reasoned analysis of the problem of the anticipatory competence of copending patents, both in terms of the statute and the policy behind the statute. Although the question decided was whether a patent should be granted, the discussion was based on the third and fourth defenses in an infringement suit.²⁹ It quickly disposed of the third defense by ruling that a copending patent can not be an "anticipation" of an application because "knowledge of an anticipating invention must be accessible to the public."³⁰ The commissioner then pointed out that the fourth defense would undoubtedly have been met if the copending patent had *claimed* the invention.³¹ The requirement of reduction to practice was disposed of by holding that the filing of an allowable application constitutes "constructive" reduction to practice.³² Therefore, if the copending patent describes but does not claim the invention, and the patentee fails to claim the invention, the public suc-

the patentee could not be the first inventor by extending "the familiar [sic] Patent Office rule, [that] the filing of an allowable application is a constructive reduction to practice" to cover everything disclosed in the application. *Id.* at 396. This extension of the fiction of constructive reduction to practice allowed the court to meet nicely the principles that invention, to be complete, requires two steps, conception and reduction to practice, and that a mere description is not a reduction to practice. (On the other hand, it does not seem to lend much support to the broad pronouncement that the "entire first clause [a] of 'third' seems quite unnecessary," unless the court also considered a description in a printed publication a constructive reduction to practice.) See generally Willner, *Origin and Development of the Doctrine of Constructive Reduction to Practice*, 34 J. PAT. OFF. SOC'Y 618 (1954). This much of the analysis is all that was really needed for the court to conclude that disclosure of the invention in a copending patent to another would be sufficient to show that the patentee of the patent in suit was not the first inventor. The court cites several cases for this proposition, including the *Sundh* case. 243 Fed. at 396.

Once the court had concluded that there was no need for the third defense, it easily inferred that since references cited under the third defense were combined to show "anticipation," references cited under the fourth defense could also be combined. "Some [of the cases cited *contra*] seem to depend upon a distinction between 'anticipation' and 'priority of invention,' applying the former name to the third defense and the latter to the fourth, though we do not see why 'anticipation' is not properly applicable to both." *Id.* at 397. "When we consider this *prior art*, including [the copending patents] . . . we are forced to conclude that [the patentee] . . . took no inventive step." *Id.* (emphasis added).

28. 251 O.G. Pat. Off. 839 (1918). *Ex parte Thomas* is not mentioned in the *Milburn* case. Its significance has been recognized relatively recently by commentators. See Dodds, *supra* note 17; Roth, *supra* note 10.

29. The third defense is equated with "anticipation" in the prior art and the fourth defense with "priority."

30. 251 O.G. Pat. Off. at 840. Compare *Lemley v. Dobson-Evans Co.*, 243 Fed. 391 (6th Cir. 1917). This case is discussed 251 O.G. Pat. Off. at 846-47.

31. 251 O.G. Pat. Off. at 840.

32. *Id.*; see Levy, *Offensive Defensive Patents*, 39 J. PAT. OFF. SOC'Y 159 (1957); Randle, *Patent Invalidity: Prior Knowledge as Evidenced by an Unpublished Written Description*, 45 J. PAT. OFF. SOC'Y 97 (1963); Willner, *supra* note 27.

ceeds to his rights.³³ This theory of public succession to the prior patentee's rights is intertwined with a contract theory of patents. The patent grant is the consideration given by the public and the disclosure of the invention is the consideration given by the inventor. If the public has already succeeded to the right of a prior inventor who would have been entitled to a patent had he claimed the invention, it would receive no consideration for a patent grant to a later applicant.³⁴

3. *The Milburn Case*

The present law of the competence of copending patents is based, to an extent which will become apparent, on the landmark decision of *Alexander Milburn Co. v. Davis-Bournonville Co.*³⁵ This was a patent infringement suit on a patent to one Whitford. The defendant gave notice of the defense of prior invention, and produced patents to Clifford and to Reich. These were both copending patents, the former issued prior to Whitford's patent and the latter after Whitford's patent.³⁶ Each described the invention claimed in the patent in suit, but neither claimed it. The case was tried in the district court before Judge Learned Hand. The court held that neither of the copending patents invalidated the patent in suit; their failure to point out or claim the invention prevented either from being used as proof of prior inventorship.³⁷

33. 251 O.G. Pat. Off. at 840-42.

34. *Id.* at 841-42. The rest of the decision is devoted to a discussion of prior cases. *Sundh* is treated as not necessarily based on the fact that the identical invention was claimed, but rather as probably based on identity of disclosure. *Id.* at 846. *Lemley's* failure to distinguish between the third and fourth defenses is rejected. *Id.* at 846-47. The rules adopted by the decision are summarized (at 848-49), and the ultimate test adopted is whether the invention claimed in the application in suit has any "material and substantial" limitations which distinguish it from the invention disclosed in the copending patent.

35. 270 U.S. 390 (1926), *rev'g* 1 F.2d 227 (2d Cir.), which had affirmed 297 Fed. 846 (S.D.N.Y. 1924). A summary of the decision in each court is found in Johnson, *supra* note 10.

36. In other words, Clifford was a prior-issued copending patent and Reich was a later-issued copending patent.

37. 297 Fed. at 851-55. Hand's opinion treats § 4920, note 13 *supra*, as a mere matter of pleading in an infringement suit and, relying on the "Inventions Patentable" section of the statute, Patent Act of 1897, ch. 391, § 1, 29 Stat. 692, *as amended*, ch. 450, § 1, 53 Stat. 1212 (1939), treats an "invention" as anything "new" in an absolute sense. Without getting into the question of "constructive reduction to practice," it considers "invention" to be the act of *pointing out* the particular combination of elements which is new and useful. The only reason a publication which does not point out the combination is a bar is that the combination is thereby dedicated to the public. The opinion suggests that the considerations in comparing claims of copending applications are similar to those in double patenting. *See* note 7 *supra*.

The Court of Appeals, affirming the finding of validity of the patent in suit, considered only the Clifford (prior-issued) patent.³⁸

The Supreme Court also considered only the prior-issued Clifford patent and reversed the judgment of the lower courts.³⁹ Mr. Justice Holmes delivered a terse opinion for a unanimous Court.⁴⁰ The opinion disposed of the argument relied on by the lower courts by saying:

The question is not whether Clifford showed himself by the description to be the first inventor The question is whether Clifford's disclosure made it impossible for Whitford to claim the invention at a later date. . . . It is not necessary to show who did invent the thing in order to show that Whitford did not.⁴¹

The Court found the natural meaning of the statutory fourth defense to be that one must really be the first inventor to obtain a patent. Certain exceptions to this natural meaning are allowed "in view of the gain to the public that the patent laws mean to secure."⁴²

The Court then attacked the problem from a different angle, that of the third defense:

On the other hand publication in a periodical is a bar. This as it seems to us is more than an arbitrary enactment, and illustrates, as does the rule concerning previous public use, the principle that, subject to the exceptions mentioned, one really must be the first inventor in order to be entitled to a patent.⁴³

Since publication is a bar because it shows the patentee is not the first inventor,

38. The opinion of the Court of Appeals treats the problem in similar fashion. It does rely on the third and fourth defenses. The third defense did not apply on the basis of *Sundh*. The fourth defense failed because Clifford's failure to claim the invention indicated that he had not completed even the first step of invention, formulation of the concept. Thus, the court had no need to discuss reduction to practice. The test applied by the court was whether the prior applicant "was entitled to the first patent." 1 F.2d at 232.

39. 270 U.S. 390 (1926).

40. The reasoning of this opinion has never been completely explained by commentators or the courts. To quote Thomas Mann (describing *Death in Venice*), it "is indeed a crystallization in the true sense of the word; it is a structure and an image, . . . by its nature of such inexhaustible allusiveness, that it might well dazzle the eyes of its creator himself as it took shape." MANN, *STORIES OF THREE DECADES* viii (1955).

41. 270 U.S. at 401.

42. *Id.* at 400. Three exceptions are noted: a description not communicated to anyone, an abandoned patent application (because of Patent Office procedure), and foreign inventions not patented or described in a printed publication.

43. *Id.* at 400.

the delays of the Patent Office ought not to cut down the effect of what has been done Clifford had done all that he could do to make his description public We see no reason in the words or policy of the law for allowing Whitford to profit by the delay and make himself out to be the first inventor when he was not so in fact, when Clifford had shown knowledge inconsistent with the allowance of Whitford's claim . . . and when otherwise the publication of his patent would abandon the thing described to the public unless it already was old⁴⁴

The Court's finding that the basic rule underlying both the third and fourth defenses is that the patentee must be the first inventor implicitly depends on the reasoning in *Lemley* that there is really no difference between the defenses of prior invention and prior publication. It is possible that the Court failed completely to distinguish between "invention" as conception and an "invention" as a completed invention, reduced to practice.⁴⁵ The Court might also have intended to indicate that publication was a constructive reduction to practice or that a description in a patent application is an exception to the rule that a mere description is not a constructive reduction to practice.⁴⁶

None of these possible rationales of the Court's position seems to fit very well with the apparent reason for making publication a bar, which is that publication of the conception of an invention dedicates that conception to the public (if no one in a position to claim the invention in a patent *at the time of the publication* does so within the statutory period). Therefore, no one who conceives an invention after it has been dedicated to the public can be allowed to claim it in a patent.⁴⁷ Both policies can be reconciled, however, in the following suggested explanation of the *Milburn* case. The Court may simply have felt that the policy of the patent system

44. *Id.* at 401 (citations omitted). The significance given by the Court to the third defense, as showing the patentee not to be the first inventor, is a key to the *Milburn* case.

45. See Orenbuch, *Abandoned Applications as Prior Art*, 45 J. PAT. OFF. SOC'Y 613 (1963).

46. See Randle, *supra* note 32; Stringham, "Coping" Patents as Reference, 8 J. PAT. OFF. SOC'Y 407 (1926). The Court, however, disposes of the argument that filing an allowable application is a constructive reduction to practice only of the invention claimed on two grounds: (1) a patentee can file a new application within the statutory "time-bar" period, claiming anything disclosed in the original application and be given the advantage of the filing date of his first application, and (2) "a description that would bar a patent if printed in a periodical or in an issued patent is equally effective as far as reduction to practice goes." 270 U.S. at 401-02.

47. Compare Pirri, *Does Statutory Basis Exist for Rule 131?*, 44 J. PAT. OFF. SOC'Y 730 (1962).

was to reward the first person to conceive an invention and take steps to make it public through the Patent Office.

If the conception of an invention by someone (not necessarily the applicant) is disclosed in a patent application before a second inventor's conception of the invention, and, in addition, the invention is made public by the issuance of a patent on the first application while the second to conceive is still trying to make the invention public through the Patent Office, all of the objectives of the patent system have been met without granting a patent to the second inventor. Thus, although the precise words of neither the third nor the fourth defense fit a description of the invention in a copending patent, the Court may have felt that the policy of the patent system was best upheld by allowing such a description as a defense.⁴⁸ If this policy consideration did lie behind the decision, then the Court's treatment might have been different had it felt any need to discuss the later-issued Reich patent.

Although implications of the *Milburn* decision were sweeping,⁴⁹ the problems created in the lower courts, were relatively few. The overriding concern seemed to be whether copending patents were to be considered broadly as prior art or limited to showing prior invention.⁵⁰ Under either approach, no substantial reason existed for distinguishing a later-issued copending patent from a prior-issued copending patent. If a copending patent is *prima facie* evidence of prior invention of everything disclosed in the application, the date of its issue is immaterial.⁵¹ Likewise, if a

48. See also Oisher & Steinhauser, *The Role of the Prior Inventor Under § 102(g)*, 29 BROOKLYN L. REV. 196 (1963), 45 J. PAT. OFF. SOC'Y 595 (1963).

49. See, e.g., Stringham, *supra* note 46.

50. See generally Dodds, *supra* note 17; Riordan, *Copending Patents*, 21 J. PAT. OFF. SOC'Y 444 (1939). Some cases subsequent to the Dodds article are listed in Woodcock, *What is Prior Art?*, 3 VILL. L. REV. 255, 297 n.132 (1958). Two obvious approaches to the question were taken by the courts. One group of courts held that the *Milburn* decision on its facts and in its reasoning was concerned only with priority of invention (the fourth defense). See Dobbs, *supra* note 17. Others found in Holmes' reasoning that "a sound distinction cannot be taken between disclosure of a published patent and a patent applied for before but not granted until after a second patent is sought," 270 U.S. at 401, an implication that a patent application which subsequently matures into a patent is to be treated as a *publication* from its application date (under the third defense). See articles cited *supra*.

51. The courts frequently adopted differing terminologies to distinguish other cases and reach the results they felt proper. Cf. note 18 *supra*. The resulting confusion in terminology makes a breakdown of the cases next to impossible. See Dodds, *supra* note 17. A single later-issued copending patent seems to have been relied on as showing the complete invention in some cases. See *Permo, Inc. v. Hudson-Ross, Inc.*, 179 F.2d 386 (7th Cir. 1950); *Gasifier Mfg. Co. v. General Motors Corp.*, 138 F.2d 197 (8th Cir. 1943); *Federal Yeast Corp. v. Fleischmann Co.*, 13 F.2d 570 (4th Cir. 1926), *affirming* 8 F.2d 186 (D.C. Md. 1925) (issued same date); *Safety Car Heating & Lighting Co.*

patent speaks as a publication from its application date, because "the delays of the Patent Office ought not to cut down the effect of what has been done,"⁵² the fact that the Patent Office delayed longer in issuing the copending patent than the patent in suit should not matter.⁵³ Thus, the cases in this period seem to have held unanimously that a later-issued copending patent was a reference, at least if it disclosed the precise invention in issue.⁵⁴

II. THE PATENT ACT OF 1952

1. Section 282(2)

The 1952 Patent Act⁵⁵ was enacted "to revise and codify the laws relating to patents and the Patent Office."⁵⁶ One of the most striking re-

v. General Elec. Co., 64 U.S.P.Q. 295 (S.D.N.Y. 1945), *aff'd*, 155 F.2d 937 (2d Cir. 1946); *De Cew v. Union Bag & Paper Corp.*, 59 F. Supp. 323 (D.N.J. 1945) (invention also claimed); *Western States Mach. Co. v. S.S. Hepworth Co.*, 51 F. Supp. 859 (E.D.N.Y. 1943), *rev'd on other grounds*, 147 F.2d 345 (2d Cir. 1945) (*semble*) (extended discussion of *Milburn* by L. Hand, J.), *cert. denied*, 325 U.S. 873 (1945); *Goldsmith Metal Lathe Co. v. Milcor Steel Co.*, 53 F. Supp. 778 (D. Del. 1943) (not identical); *Maccarone v. Pincus & Tobias, Inc.*, 11 F. Supp. 248 (E.D.N.Y. 1935), *aff'd per curiam*, 82 F.2d 1015 (2d Cir. 1936); *Allied Stamping Co. v. Standard Elec. Equip. Corp.*, 57 F.2d 296 (E.D.N.Y. 1932).

A later-issued copending patent seems to have been used broadly as "prior art" in other cases. *See Williams Bros. Aircraft Corp. v. Gould-Mersereau Co.*, 274 U.S. 713 (1927), *rev'g* 10 F.2d 44 (2d Cir. 1925) (*semble*) (other prior-issued copending patents also considered); *Kendall Co. v. Tetley Tea Co.*, 189 F.2d 558 (1st Cir. 1951); *Electrol, Inc. v. Merrell & Co.*, 39 F.2d 873 (8th Cir. 1930) (by implication); *Osteen v. AnSCO Photoproducts, Inc.*, 27 F.2d 688 (2d Cir. 1928); *Oswego Falls Corp. v. American Seal-Kap Corp.*, 65 F. Supp. 338 (E.D.N.Y. 1946); *Perry v. United States*, 76 F. Supp. 503 (Ct. Cl. 1948) (dictum).

52. *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390 (1926).

53. *See* note 51 *supra*.

54. Had the courts and litigants not been so preoccupied with the question of the effect of disclosures in copending patents generally, they might have been willing to distinguish later-issued from prior-issued copending patents, on an analysis of the *Milburn* case such as given in text accompanying note 45 *supra* and the observation that:

So long as knowledge of an invention disclosed in an application is not accessible to the public the interest of the public is served by the grant of a patent to another inventor covering that invention, in the same way as if there existed no knowledge of it by any one other than the patentee. In that case the public receives the normal valuable consideration for the grant of a patent. For the same reason that accessibility of knowledge of the invention to the public is essential to the defense of anticipation it is essential to the defense of prior invention, although in the latter case it may be effective with reference to a different date. *Ex parte Thomas*, 251 O.G. Pat. Off. 839, 841 (1918) (dicta) (emphasis added).

This different date could logically be taken to be the date on which the patent in suit issued. Whether or not courts would have considered later-issued patents differently before the 1952 statute if urged to do so is a moot question which need not concern us more.

55. The Patent Act of 1952 revised, codified and enacted into law Title 35 of the United States Code.

56. From the title of the act. Federico, *Commentary on the New Patent Act*, 35 U.S.C.A. at 9 (1954). One of the most perplexing problems posed by the act is to what

visions was the modification and collection of the former statute's conditions for patentability into a single section, section 102.⁵⁷ These conditions for patentability (as well as the condition of non-obviousness contained in section 103) have been incorporated by reference into section 282,⁵⁸ which lists the defenses in an infringement suit.⁵⁹ Thus, the present statute provides that the grant of a patent and the validity of the patent once issued are subject to the same "conditions for patentability."⁶⁰ The precise meaning of section 282(2) is subject to question. It could be read to mean that if at any time prior to the raising of the defense in a particular suit an event occurs which under the statutory provisions sheds doubt on the validity of the patent in suit, this event may be pleaded as if it had occurred prior to the granting of the patent (to show that it would have been a bar to the granting of the patent had it occurred prior thereto).⁶¹ A second reading of section 282(2) would limit the defensive material to facts existing at the time the patent was granted, which if known to the Patent Office would have been a bar to the issuance of the patent. To understand the importance of determining which interpretation section 282(2) should be given, we must consider which conditions for patentability might be negated by a later-issued patent.

2. Section 102

Of the seven subsections of section 102, three might be considered "prior art" provisions and four are technical bars based on the applicant's own conduct.⁶² Only the prior art provisions need concern us here:

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 the invention thereof by the applicant for a patent, or

. . . .

extent it was meant to revise the law and to what extent it represents merely a codification. See Beckett, *Judicial Construction of the Patent Act of 1952—Codification v. Substantive Change*, 37 J. PAT. OFF. SOC'Y 467 (1955).

57. These conditions were listed in a variety of places. See § 102(e) (Reviser's notes); H.R. REP. No. 1923, 82d Cong., 2d Sess. (1952), in 34 J. PAT. OFF. SOC'Y 549, 560 (1952); Federico, *supra* note 56, at 17-19.

58. § 282(2), note 3 *supra* and accompanying text.

59. The second defense under § 282 is "Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability."

60. See Woodcock, *supra* note 50, at 255-56.

61. This reading of the statute seems somewhat strained, at best. Nonetheless, in the cases which allow later-issued patents as references under § 102(e) this must be the interpretation given the statute.

62. §§ 102(b) (failure to file within one year after invention made public), (c) (abandonment), (d) (foreign patenting), and (f) (non-invention by applicant).

(e) the 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, or

.....
 (g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

a. subsection (a). Section 102(a) cannot be met by a later-issued patent.⁶³ To be a bar, knowledge or use of the invention must be available to the public before its invention by the patentee of the patent in suit. This restriction on subsection (a) was noted at the time the Act was passed.⁶⁴ Therefore, the existence of a secret patent application at the time the patentee made his invention, even one which becomes a patent and fully describes and claims the invention, cannot be used to show that the invention was "known or used by others" under subsection (a).

b. subsection (e). Section 102(e) codifies the "rule" of the *Milburn* case. It is unique in section 102 because it has no prior statutory basis. Because *Milburn* was decided under the statute then in force,⁶⁵ its emergence as an entirely separate bar poses a problem.

Some courts tend to treat section 102(e) as if it were merely a definition of one of the other subsections of section 102, just as the lower federal courts used the *Milburn* decision as a definition of either the third or the fourth defense under the old statute.⁶⁶ It is clear, however, that subsection (e) is an independent test which applies to different situations than those covered in subsections (a) and (g). Subsection (e) does not require that knowledge of the invention be available to the public, as does subsection (a). Neither does it require proof of the actual inventor, as does subsection (g). It is met merely by a description of the invention in question in another patent. To use subsection (e) as a qualification of the language of (a) or (g) would render meaningless a part of the statute, con-

63. A later-issued patent could, of course, be useful to a defendant as an indication that the patentee might have used or made public the invention.

64. § 102 (Reviser's notes); see Woodcock, *supra* note 50, at 259-68. *But see* Randle, *supra* note 32. Patent applications are kept secret by the Patent Office under a statutory provision (§122). Therefore, a later-issued patent, by itself, could not constitute proof of prior use or knowledge.

65. See note 13 *supra*; notes 39-48 *supra* and accompanying text.

66. *E.g.*, *Sperry Rand Corp. v. Knapp-Monarch Co.*, 307 F.2d 344 (3d Cir. 1962); *John Blue Co. v. Dempster Mill Mfg. Co.*, 275 F.2d 668 (8th Cir. 1960).

travening the purpose of the legislators to present a coherent system for ruling on patent applications.

The *Milburn* case itself did not consider the effect of a later-issued patent, although it might have done so.⁶⁷ Section 102(e) probably applies to later-issued patents if section 282(2) is interpreted as allowing any fact occurring subsequent to the granting of the patent in suit to be treated as defensive matter as if it had occurred prior to the issuance.⁶⁸ If section 282(2) is interpreted as being limited to the defense that the patent should not have issued in the first place, section 102(e) cannot apply to later-issued patents because the invention was not "described in a patent granted"⁶⁹ at the time of issuance.

c. subsection (g). Besides being the basis for modern interference practice, subsection (g) is a means for invalidating a patent even though the invention was not publicly known or available at the time the patentee made his invention.⁷⁰ In this latter respect it is like subsection (e). In another respect—the value of a patent as evidence—the two subsections differ. While a patent is the only evidence which can show nonconformance with subsection (e), a patent can be used to show nonconformance with subsection (g) only if the patent on its face shows that the invention was made in this country, and that it has not been abandoned, suppressed, or concealed by the inventor. Thus, a copending patent which *claims* the invention would be, by itself, a good reference under subsection (g).⁷¹ If the patentee cannot rely on any date of invention prior to his application date, then the reference patent should be a bar (under either interpretation of section 282(2)).

A patent which merely *discloses* the invention in suit cannot be used as a reference under subsection (g). Although it might be an indication that the "invention" was made by someone before the patentee, it is not necessarily evidence that the invention was made by the applicant, by

67. See notes 35-40 *supra* and accompanying text.

68. There is still a question. To what point in time does the phrase "was described in a patent" refer? In other sections, the past tense is used because the event which acts as a bar must occur before either the invention or application by the patentee of the patent in suit.

69. § 102(e).

70. See Oisher and Steinhauser, *supra* note 48. This article suggests that § 102(a) is available only when the invention has been made public before the invention is made by the patentee, whereas § 102(g) should be available whenever the invention has previously been *completed* by another "whose activities were such that the invention, although not yet available to the public when the patentee enters the field, would become so reasonably early in the normal course of events." *Id.* at 201.

71. This situation is likely to occur only because of oversight by the Patent Office.

someone "in this country," or by one "who had not abandoned, suppressed, or concealed it."⁷²

One of the fundamental differences between the treatment here given the present statute and the Court's treatment of *Milburn* must be emphasized. The statute in effect at the time the *Milburn* decision was handed down provided as the fourth defense "that he [the patentee] was not the original and first inventor or discoverer of any material and substantial part of the thing patented."⁷³ It mattered not who the true inventor might be. If section 102(g) is used, it matters greatly who the first inventor was. A contrary argument might be made that one who has disclosed an invention in a patent application before the invention thereof by the patentee has "constructively reduced to practice" the invention and, therefore, is a prior inventor who has not abandoned, suppressed, or concealed it. This argument is especially weak when applied to 102(g), since that subsection requires certain specific information regarding not just the inventor but the place of invention and the inventor's conduct following his invention. A mere disclosure in a patent application is, at best, evidence of inventorship if no earlier knowledge of the invention can be found. This evidence seems too weak to form a presumption that all the requirements of 102(g) have been met.

Under section 102(g), which requires actual invention, it makes no difference whether a patent is later-issued or prior-issued. Only the application date could be relevant to show the date of invention.

3. Section 103

Section 103 was included in the present statute in order to provide a stabilizing effect on the standard of patentable novelty applied by the Patent Office and courts. It reads:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, 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 to which said subject matter pertains. . . .

A problem which perplexed the courts until recently was whether the "prior art" referred to includes only that prior art which was available

⁷² Cf. Ellis, *Subsequent Inventor's Patent Rights With Regard to an Invention Previously Made by Another Who Kept It Secret*, 35 J. PAT. OFF. SOC'Y 259 (1953); Gambrell & Herman, *The Second Inventor's Patent, The Defense of First Invention, and Public Policy*, 41 J. PAT. OFF. SOC'Y 388 (1959).

⁷³ See note 13 *supra*.

to persons having ordinary skill in the art at the time the invention was made or whether it also includes section 102-like material, which was not publicly available at the time. In 1965, the Supreme Court decided, in *Hazeltine Research, Inc. v. Brenner*,⁷⁴ that section 102(e)-like references were prior art under section 103. The Court, quoting *Milburn*, said, "The delays of the Patent Office ought not to cut down the effect of what has been done. . . . We see no reason in the words or policy of the law for allowing [the second applicant] to profit by the delay. . . ."⁷⁵

If section 282(2) is interpreted to include acts which occur after the patent in suit issued, so that later-issued copending patents are competent references under section 102(e), the *Hazeltine* case seems to establish that a later-issued copending patent is also part of the prior art and may be relied upon as a reference under section 103.⁷⁶

If section 282(2) encompasses only the defense that the patent should not have been granted, the sole remaining question is whether later-issued patents may constitute prior art as section 102(g)-like references under section 103. Since section 102(e)-like references *do* constitute prior art, under the *Hazeltine* case, it is difficult to distinguish section 102(g)-like references as *not* prior art.⁷⁷ The mere fact that such references were not publicly available at the time the invention was made is not a bar to their

74. 382 U.S. 252 (1965).

75. *Hazeltine Research, Inc. v. Brenner*, 382 U.S. 252, 255 (1965).

76. This would probably be true despite the clear language of section 103 that "a patent may not be obtained. . . ."

77. One way to avoid the wholesale incorporation of § 102 into § 103 as "prior art" is to rely on the language of § 103 that "a patent may not be obtained though the invention is not identically *disclosed or described* as set forth in section 102" (emphasis added). The legislative history of § 103 indicates that "the prior art" would have been "that prior art" except for the inconsistency which would have been created since § 102 refers only to the precise invention. *See generally* Roth, *supra* note 10. Thus, what was intended by "prior art" may have been matter *like* "the invention" of § 102, in those subsections which make disclosure or description a bar. These subsections are §§ (a), (b), and (e). *See* Application of Foster, 343 F.2d 980 (C.C.P.A. 1965); Application of Harry, 333 F.2d 920 (C.C.P.A. 1964). Under this interpretation, a § 102(g)-like reference could not be prior art.

Because the 1952 Act is to some extent a codification, a different approach could be taken. "Prior art" could be considered to be without antecedent in the statute and taken to include that defensive matter which has been designated "prior art" by case law. *See* Roth, *supra* note 10, at 817-18. With this approach, copending patents which apply under § 102(e) could be combined because of the case law allowing copending patents as prior art. *See* note 50 *supra*. The changes in the statutory scheme of §§ 102 and 282(2), however, cause some difficulties. Under the case law after *Milburn* but before the statute, later-issued patents were generally not differentiated from prior-issued patents. Therefore, any change in this practice must come from the same interpretation of § 282(2) suggested with regard to § 102. If the question is whether the patent should

being used as prior art under section 103.⁷⁸ Furthermore, Patent Office interference practice allows the use of a patent granted on a winning application to show that the remaining claims in the losing application are obvious, even if the earliest applicant loses. Such a rejection can only be based on the theory that section 102(g)-like references are prior art under section 103.⁷⁹

III. CASES FOLLOWING THE PATENT ACT OF 1952

None of the cases since 1952 which have considered the problem of later-issued patents has discussed it in terms of the statute rather than simply in terms of the *Milburn* case. This can probably be accounted for by the paucity of other situations in which a patent, once validly granted, might subsequently be invalidated by a later occurrence.⁸⁰ Furthermore, the courts have retained the terminology of the old statute, creating confusion under the present statute.⁸¹

have been granted, the later-issued patents disclosing but not claiming material which makes the invention obvious are not competent defensive material. If such patents also claim material which makes the invention obvious, then the case law which held that prior invention must be distinguished from prior art (in that only prior art references could be combined) would suggest that even those patents could not be considered part of the prior art. *See Ex parte Thomas*, 251 O.G. Pat. Off. 839 (1918); notes 28-34 *supra* and accompanying text. *But see Lemley v. Dobson-Evans Co.*, 243 Fed. 391 (6th Cir. 1917); note 25 *supra* and accompanying text; *cf. Western States Mach. Co. v. S.S. Hepworth Co.*, 147 F.2d 345 (2d Cir.), *cert. denied*, 325 U.S. 873 (1945). The serious drawbacks in using an approach which effectively incorporates the old statutory scheme are apparent.

78. *Hazeltine Research, Inc. v. Brenner*, 382 U.S. 252 (1965).

79. Since the later-filed application was by the first inventor, there is no earlier patent application to serve as a § 102(e) reference. *See Application of Gregg*, 244 F.2d 316 (C.C.P.A. 1957); Sobel, *Prior Art and Obviousness*, 47 J. PAT. OFF. SOC'Y 79, 92-96 (1965).

80. Another situation in which a validly granted patent might be invalidated by someone else's later acts would occur in the following sequence of events:

A conceives the invention.

B conceives the invention.

B applies for a patent.

B obtains a patent.

A, who has been diligent ever since he conceived the invention, either reduces to practice or files a patent application, within a year of B's patent.

Is B's patent invalid? *See Woodcock, supra* note 50, at 256-59.

81. In particular, the term "anticipation," which under the old statute was usually equated with description in the "prior art," see notes 27, 51 *supra*, is now generally used in opposition to "prior art." *See Sperry Rand Corp. v. Knapp-Monarch Co.*, 307 F.2d 344 (3d Cir. 1962); *Helene Curtis Indus., Inc. v. Sales Affiliates, Inc.*, 233 F.2d 148 (2d Cir.), *cert. denied*, 353 U.S. 879 (1956) (later-issued copending patent). *But see East Rutherford Syringes, Inc. v. Omega Precision Medical Instrument Co.*, 152 F. Supp. 497 (D.N.J. 1957). Much of the blame for the resulting confusion (particularly

Of ten cases which have considered the competence of later-issued copending patents since the present statute was passed, eight have apparently considered the *Milburn* case binding precedent for using such patents as references for all purposes.⁸² The other two cases each held that a later-issued copending patent is not part of the prior art (under section 103)

when older cases are cited) lies with the statutory provision, § 282, note 3 *supra*, that the defendant must give notice of references to be used "as anticipation" and "as showing the state of the art." Use of these terms was unfortunate. *See Roth v. Harris*, 168 Fed. 279, 282 (2d Cir. 1909).

82. In *Sperry Rand Corp. v. Knapp-Monarch Co.*, 307 F.2d 344 (3d Cir. 1962) the court held: "A patent issued on an application antedating the application for the patent in suit is the equivalent of a printed publication and speaks as of the date of the application regardless of the date on which the patent issues." *Id.* at 346. The court cited cases just prior to the present statute. In *United Parts Mfg. Co. v. Lee Motor Products, Inc.*, 266 F.2d 20 (6th Cir. 1959), the patentee proved a date of invention prior to the application date of a later-issued patent, the "ideas" of which were "quite synonymous." *Id.* at 25. It is not clear whether the term "ideas" means the claimed inventions, but the court indicates that *Milburn* would have been applicable. *Id.* at 23. In *Mohasco Indus., Inc. v. E. T. Barwick Mills, Inc.*, 221 F. Supp. 191 (N.D. Ga. 1963), *aff'd per curiam*, 340 F.2d 319 (5th Cir.), *cert. denied*, 382 U.S. 847 (1965), the patents in suit were held to be "entitled to no presumption of validity over the prior art relied upon by defendants which was not cited or considered by the Patent Office," including a later-issued patent, which had been involved in a Patent Office interference which the patentees had "declined to join." *Id.* at 205. In *Hazeltine Research, Inc. v. Dage Elec. Co.*, 165 F. Supp. 226 (S.D. Ind. 1958), *rev'd*, 271 F.2d 218 (7th Cir. 1959), the court found that the "Patent Office failed to find the most pertinent prior art," including particularly a later-issued patent (which, of course, was not part of the prior art at the time the Patent Office acted), citing *Milburn*. *Id.* at 240, 243. In reversing, the Court of Appeals found the later-issued patent to be directed toward another invention and dismissed it without considering its competence as prior art. In *Magnex, Inc. v. Duro Mfg. Co.*, 159 F. Supp. 322 (N.D. Ill. 1957), the court held: "Under the rule established by *Alexander Milburn Co. v. Davis Bournonville Co.*, 270 U.S. 390, 46 S.Ct. 324, 70 L.Ed. 651, which rule is now codified as part of the Patent Statute (Section 102(e), Patent Codification Act of 1952, 35 U.S.C.A. § 102(e)), the earliest filed of two copending applications is prior art against the later filed even though the later filed may have been first to issue." *Id.* at 325. In *Berghane v. RCA*, 116 F. Supp. 200 (D. Del. 1953), *aff'd*, 217 F.2d 490 (3d Cir. 1954), the court decided that the (later-issued) reference patent was prior art against the patent in suit because it was filed before the patent in suit, without citing any authority at all. The Court of Appeals reached the same result, also without citing any authority.

Two cases involved patents which were issued on the same day to different inventors, but which were owned by the same person. (The cases involved the same set of patents.) In both *Lorenz v. Berklime Corp.*, 215 F. Supp. 869 (N.D. Ill. 1963), and *General Steel Prods. Co. v. Lorenz*, 204 F. Supp. 518 (S.D. Fla. 1962), *aff'd*, 337 F.2d 726 (5th Cir. 1964), the second patent applied for was held invalid over the one earlier applied for under §§ 102 (a), (e), (f), and (g). In the latter case, *Milburn* was cited and the reason given for the multiple grounds was that the earlier application "established invention" by that inventor of "the subject matter disclosed" in that application. *Id.* at 530.

because it was granted subsequent to the *issuance* of the patent in suit.⁸³ These opinions seem to indicate that, had the reference patents disclosed the inventions claimed by the patents in suit, they still would not have been competent references.⁸⁴

Two other cases, while dealing with prior-issued copending patents, contain dicta which indicate that the courts might treat later-issued patents differently, at least when they are sought to be used as prior art.⁸⁵

83. In *Langdon v. Saltzer & Weinsier, Inc.*, 175 F. Supp. 96 (E.D.N.Y. 1959), *aff'd*, 288 F.2d 50 (2d Cir. 1961), the court failed to mention *Milburn* at all. Instead, it cited *Sundh Elec. Co. v. Interborough Rapid Transit Co.*, 198 Fed. 94 (2d Cir. 1912), discussed in notes 19-24 *supra* and accompanying text, in holding that although the later-issued reference patent disclosed and claimed a similar invention, since it "was granted subsequent to the original patent in suit, albeit on a prior application, it should not in any event, be viewed as a part of the prior art." *Id.* at 100. The court held the patent valid and not infringed. On appeal, it was declared invalid on other grounds. In *East Rutherford Syringes, Inc. v. Omega Precision Medical Instrument Co.*, 152 F. Supp. 497 (D.N.J. 1957), the defendant listed several later-issued patents "in the brochure of prior art references." *Id.* at 501. The court refused to consider these patents (although it found the patent invalid on other grounds):

These patents may not be regarded as anticipatory; while it is true they issued on applications filed earlier than the application on which the patent in suit issued, the cited patents issued after the patent in suit issued. It is well established that a patent speaks as an anticipation from the date of its issue and not from the date of the application. [Citations omitted.] The case of *Alexander Milburn Co. v. Davis-Bourmonville Co.*, 270 U.S. 390, 46 S. Ct. 324, 70 L. Ed. 651, cited by the defendants, is not applicable. There the issue was priority of invention; it was interposed by way of defense that the patentee was not the original and first inventor. The references were clearly relevant in that case. *Id.* at 501-02.

84. The direct holding of *Sundh Elec. Co. v. Interborough Rapid Transit Co.*, 198 Fed. 94 (2d Cir. 1912), relied on in *Langdon v. Saltzer & Weinsier, Inc.*, 175 F. Supp. 96 (E.D.N.Y. 1959), *aff'd*, 288 F.2d 50 (2d Cir. 1961), was that where a later-issued copending patent discloses *and claims* the same invention it is a bar. *See* note 24 *supra* and accompanying text. There is no indication of what the court would do with a later-issued copending patent which disclosed but did not claim the invention claimed by the patent in suit. In *East Rutherford Syringes, Inc. v. Omega Precision Medical Instrument Co.*, 152 F. Supp. 497 (D.N.J. 1957), the court's distinction between anticipation (apparently in the sense of prior art, *see* note 81 *supra* and accompanying text) and priority of invention could no longer be made. *See* *Hazeltine Research, Inc. v. Brenner*, 382 U.S. 252 (1965). Since the court's analysis that "a patent speaks as an anticipation from the date of its issue and not from the date of the application," 152 F. Supp. at 501, does not really support its distinguishing later-issued patents from prior-issued copending patents (because the patentee of the patent in suit can always rely on *his* application date), it is possible that this court would still be willing to give special treatment to later-issued copending patents on some other ground.

85. *Messing v. Quiltmaster Corp.*, 162 F. Supp. 489 (D.N.J. 1958), a case involving only prior-issued copending patents, decided by the same court that decided *East Rutherford Syringes, Inc. v. Omega Precision Medical Instrument Co.*, 152 F. Supp. 497 (D.N.J. 1957), concludes that:

the claims of [the patent in suit] . . . (if they disclose *any* differences between the subject matter thereof and the prior art) embody methods and products which would have been obvious *at the time the patent was issued* to a person having

IV. CRITIQUE

Section 282(2) makes the above discussed tests for patentability defenses in patent infringement suits. Except for later-issued copending patents claiming the invention in dispute, which are clearly references under 102(g), the question of whether later-issued copending patents represent prior art depends upon which interpretation of section 282(2) is adopted. It is suggested that both the statutory language and the relevant policy considerations weigh in favor of interpreting section 282(2) as being limited to those acts occurring before the issuance of the patent in suit.

This interpretation seems to fit the plain meaning of the statute. The defense under section 282(2) is "invalidity of the patent or any claim in suit on any ground specified in Part II of this title as a condition for patentability." Part II is entitled "Patentability of Inventions and Grant of Patents." Section 282(2) appears to refer only to sections 102 and 103,⁸⁶ which list under the heading "Conditions for Patentability" the conditions under which a patent may be *granted*.⁸⁷ Thus, there is support in the language of the statute itself for reading 282(2) to mean "any ground specified in Part II as a condition for *granting* a patent."

Section 102(e) is a codification of the *Milburn* decision. That case did not discuss the effect of later-issued copending patents, but its present statutory setting, discussed above, seem to limit its application to prior-issued patents. It can be argued, however, that the language of the *Milburn* case was sufficiently broad to apply to later-issued as well as prior-issued patents. As has been pointed out, the decision can be explained on a policy basis which would not apply to a later-issued copending patent.⁸⁸ At the time the patent in suit issued, not only had the invention previously been

ordinary skill in the art to which these claims relate. *Id.* at 492 (emphasis added) (alternative holding).

Since this language has no basis in the statute, it must either be a slip or be based on some such analysis of the statute as presented here. See notes 98-99 *infra* and accompanying text. Dictum in the case of *S.W. Farber, Inc. v. Texas Instruments Inc.*, 230 F. Supp. 883 (D. Del. 1964), *aff'd*, 344 F.2d 957 (3d Cir.), *cert. denied*, 382 U.S. 843 (1965) indicates that this court also might be willing to imply the additional requirement that the disclosure of a copending patent be available to the public at the time the patent in suit issues for such a patent to be prior art:

Prior to December 2, 1954, when Foster [the patentee of the patent in suit] completed his invention, the Burch thermal actuator disclosed in Burch's application filed on March 31, 1954, was part of the prior art, since Burch's application antedated Foster's, and *Burch's patent was issued prior to Foster's 230 patent. Id.* at 889 (emphasis added).

86. "§ 102. Conditions for patentability; novelty and loss of right to patent."

"§ 103. Conditions for patentability; non-obvious subject matter."

87. See Federico, *Commentary on the New Patent Act*, 35 U.S.C.A. at 10 (1954).

88. See text accompanying note 48 *supra*.

made, but it also had been made public. Therefore, the public had not really received anything for the patent grant. Since the patentee was not the first inventor, and since the subject matter had been made public by the issuance of the copending patent before his patent issued, the Court was not really concerned with who the first inventor in fact was. Under the view taken in this discussion, neither of the two factors taken alone should be sufficient. Where the actual first inventor is shown, his rights may outweigh those of the patentee. If the actual first inventor is *not* shown, for the purpose of invalidation under subsection (g), the mere possibility that the invention might become available to the public from an independent source after the patent in suit is granted should not bar its issuance. If the possibility has become a fact, that fact should not invalidate a patent which was valid at the time it was granted.

There is no real injustice in this result. If the applicant for the copending patent was in fact a prior inventor of the subject matter, he could have added claims to his pending application, whether or not the patent in suit had yet issued.⁸⁹ The issuance of a patent constitutes constructive notice to the world of the invention.⁹⁰ If, after the patent in suit had been issued, the applicant for the copending patent still failed to claim his invention, he must be deemed to have waived the protection to which a first inventor is usually entitled.⁹¹ The public, in fact, would have benefited if he chose not to claim the invention, because the invention would become public property earlier, albeit not as early as if the patent in suit had not issued. The public would benefit from the patent in suit by receiving an earlier disclosure of the invention. If, on the other hand, the first applicant did not make the invention, the policy favoring the first inventor does not apply and there is no reason to invalidate the patent in suit.⁹²

89. This is true even though the patent might be later-issued because the patentee was in fact the first inventor. Section 102(g) would protect him.

90. Publication of a patent gives notice to the world of the invention and the patentee's claim. If the prior applicant did in fact make the invention this will constitute a defense for him or for anyone else. Furthermore, although his patent is not *per se* a valid reference, it is evidence that he did not abandon, suppress, or conceal the invention. See Gambrell & Herman, *supra* note 72; Oisher & Steinhauser, *supra* note 48; notes 63, 70 *supra*.

91. If the copending patent issues prior to the patent in suit, all inventions which are disclosed but not claimed are of course dedicated to the public. Therefore under either § 102(a) or § 102(e) the patent in suit would be invalid.

92. The reasons for favoring the first inventor in fact over a later *independent* inventor who was the first to take steps to disclose the invention are obscure. When the identity of the first inventor is not known, and thus there is no *personal* interest to protect, *the basic policy of the patent system is to reward an inventor who makes his invention known to the public.*

This treatment of later-issued copending patents has other, more fundamental, justifications. It encourages the earliest possible disclosure of inventions to the public, and it strengthens the patent system. The former is encouraged in two ways. First, inventors who file patent applications for their inventions will be more likely to make a prompt disclosure to the public of the invention in the form of an embodiment of the invention. Since a feature of an "invention" shown but not claimed in a patent is almost of necessity simply an incidental feature of an embodiment of the claimed invention, actual disclosure to the public of the embodiment will serve the double purpose of allowing the public to use and improve on these incidental features and preventing any later inventor who perceives some genus of which these features happen to form one embodiment from appropriating to himself, by patent, a monopoly on such genus. Furthermore, although the speed with which an application is passed upon by the Patent Office is largely out of the hands of the applicant, a system which places some premium, however slight, on the early issuance of patents will tend to prevent prolonging the prosecution of patent applications by applicants.

The interpretation of section 282(2) suggested here would also strengthen the patent system by increasing the patentee's certainty that if he has made a careful search of the relevant art up to the time his patent issued, his patent will be held valid.

The significance of an applicant's letting his application mature into a patent has not been afforded due recognition. An inventor (or his assignee) may for a variety of reasons want to file a patent application on his invention even though he is not sure at the time that he ever wants to get a patent. If, for example, at the time his application is found allowable by the Patent Office he has successfully kept his invention a trade secret, he may decide that the law of trade secrets will protect him better than a patent. However, if a thorough search of the pertinent literature has failed to disclose anything likely to invalidate the patent, the applicant may feel that a patent offers better protection. One of the basic tenets of the patent system is that the public is better served by the latter course of action than by the former.⁹³ If the courts adopt the position that a patent may be invalidated by a disclosure made in a later-issued patent, an inventor may well decide to take the chance that his rivals will be able to duplicate his invention on the basis of a mere disclosure in a later-issued patent without the benefit of any disclosure by him, rather than risk a court holding that such a disclosure in a later-issued patent destroys his

93. See Note, *Prior Art in the Patent Law*, 73 HARV. L. REV. 369 (1959).

patent monopoly.⁹⁴ An inventor, in making his choice, would of course recognize that his secret might fall into his rival's hands through many other sources than later-issued copending patents, and that the odds are that no copending application discloses his invention (or a reasonable equivalent thereof).⁹⁵ Nevertheless, if such an application exists and subsequently matures into a patent, his patent is indeed in jeopardy if a court adopts a view contrary to that suggested here and allows a later-issued patent to be used as defensive matter not only for what it claims but for what it discloses. If a court allows the patent as a reference, it is very likely to hold that since this reference was not considered by the Patent Office in granting the patent in suit, the presumption of validity attaching to that grant is seriously weakened, if not destroyed.⁹⁶ This interpretation would bring about the anomalous situation in which the earlier-issued patent could in fact be valid at the time it issued (in the sense that even if all the then existing facts were known, no bar to the grant of the patent would exist) and yet become invalid thereafter.⁹⁷

The use, under section 103, of later-issued 102(e)-like references will depend upon which interpretation of section 282(2) is adopted. The question of whether later-issued 102(g)-like references can be used as prior art, although not affected by how section 282(2) is interpreted, can be answered by a consideration of the policies involved. The policy consideration favoring the first inventor is better satisfied by allowing a later-issued copending patent to be considered part of the prior art under

94. See also Roth, *supra* note 77, at 824-25. The chances that his rivals would discover his invention or would be able to practice it as effectively on the basis merely of a disclosure in another patent are lessened further by the fact that the disclosure is very likely not to be of a very good embodiment of his invention. Such a disclosure would still invalidate his patent. The information which he must disclose to the public in his patent, on the other hand, must be "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." § 112.

95. To the extent that another inventor, by filing an application claiming all or part of the invention, has tried to make his invention public, although he has not yet done so when the patent in suit issues, and can invalidate the patent in suit, the policy favoring early disclosure is contravened in favor of the prior inventor. See also Note, *Prior Art in the Patent Law*, 73 HARV. L. REV. 369, 378-81 (1959). To this extent, the use of the patent system for disclosing inventions is encouraged by adopting, in this case, the rule that "the delays of the Patent Office ought not to cut down the effect of what has been done." *Alexander Milburn Co. v. Davis-Bourmonville Co.*, 270 U.S. 390, 401 (1926).

96. See, e.g., *Hazeltine Research, Inc. v. Dage Elec. Co.*, 165 F. Supp. 226 (S.D. Ind. 1958), *rev'd*, 271 F.2d 218 (1959) (without consideration of the point).

97. See generally Rosenberg, *Double Patenting*, 45 J. PAT. OFF. Soc'y 34, 48-50 (1963).

section 103. If the invention claimed in the copending patent, when taken with other references, makes the invention claimed in the patent in suit obvious, the first inventor (as well as the rest of the public) has been deprived of the right to make, use, or sell something which would have been obvious in view of his own invention.

Nonetheless, the policy of benefiting the public by early disclosure and the policy of benefiting the patent system by increasing the probability that no previously secret bars will appear after a patent issues,⁹⁸ are best served by a rule that any reference, to constitute "prior art," must have been available to the public at the time the patent in suit issued. Such a rule would allow some section 102(g)-like references to be considered prior art, but only those references which had become public at the time the patent in suit issued.⁹⁹

CONCLUSION

The present statute has done away with the "fundamental rule" expressed in the *Milburn* case that "the patentee must be the first inventor" and has substituted section 102(g), making certain prior inventions a bar, and section 102(e), codifying the decision reached by Mr. Justice Holmes. The cases following *Milburn*, on the basis of that decision and in light of the statute then in effect, applied its holding to later-issued as well as prior-issued copending patents. The cases following the passage of the present statute have failed to take into account the changes which that statute made in the law, and have followed older cases. The changes in the present statute seem to be substantive, and seem to promote the purposes of the patent system. A closer examination of the statute by the courts is in order.

For the reasons discussed in this note, later-issued patents to the same inventor may not invalidate the patent in suit. A later-issued copending patent which describes but does not claim the invention claimed by the patent in suit should never invalidate the patent in suit, even if it is to a different inventor.

A later-issued copending patent to another inventor which claims the invention of the patent in suit should always invalidate the patent in suit, unless the patentee of the patent in suit can rely on an earlier date of invention. If it claims an invention which merely makes the invention of the

98. See Roth, *supra* note 77, at 825: "The cards would all be on the table."

99. Such a rule could be engrafted onto § 103 by adding a provision similar to § 102(a) after the first sentence: ". . . and if the invention has become known or has been used by others in this country, or has been patented or described in a printed publication in this or a foreign country."

patent in suit obvious (and the patentees are truly independent), the policy favoring early disclosure of inventions and the contract theory of patents both suggest that the patentee has benefited the public by putting into its possession an invention not then available to it, and should be entitled to a patent. Countervailing these policies are the rights of the earlier "inventor" and the feeling that the delays of the Patent Office should be disregarded. The interest of a patentee of a later-issued copending patent in producing items which are obvious changes in his invention makes it unlikely that the first patentee will prevail when his patent is in suit.

An analysis of the present statute points up both its consistent policy of encouraging the *disclosure* of inventions rather than merely rewarding the first inventor, and the complexities involved in applying that policy. It is apparent that a patent system which allowed the immediate publication of applications by the Patent Office would expedite the policy of making inventions available at the earliest possible date by reducing or eliminating long-term concealment of applications pending in the Patent Office. Such a change could be engrafted onto the present statute without substantial difficulty. An amendment need only provide for either compulsory or optional publication of all applications by the Patent Office when filed or at any time thereafter. Bills of this type are currently being considered.¹⁰⁰ An amendment of this nature would solve several problems at once. It would decrease the burden on the Patent Office in examining thoroughly applications whose only purpose is to provide "defensive patents" which will prevent others from later patenting the same thing.¹⁰¹ Insofar as it encouraged defensive *applications*, such an amendment would tend to make the files of the Patent Office a more reliable source for finding the prior art.

An early-publication statute would also solve most of the problems discussed in this note. Compulsory publication by the Patent Office of all applications would completely do away with the need for section 102(e). A significant feature of an optional publication amendment could be the retention of section 122 (which provides for the secrecy of applications unless the applicant gives authority to reveal the contents of his application)

100. For several years, bills of this type have been before Congress. *E.g.*, H.R. 3561, 88th Cong., 1st Sess. (1963). An even more drastic modification of the present system has been widely advocated in this country. This is a type of system of provisional patents, with intervention provisions, based on the recently adopted Dutch Law. For a discussion of this proposal *see, e.g.*, Duncan, *The European Patent Convention as a Guide to Modernizing Our Patent Examination System*, 8 *IDEA* 405 (1964), in 47 *J. PAT. OFF. SOC'Y* 220 (1965); March 1965 *BULL. A.P.L.A.* 121.

101. *See generally* Levy, *Offensive Defensive Applications*, 39 *J. PAT. OFF. SOC'Y* 159 (1957).

and the deletion of section 102(e) as to future applications. Such an amendment would strengthen issued patents by reducing the chance that they might be invalidated by later-issued patents, would obviate the need for the fiction that an application ever "discloses" the invention as of the date filed, and would at last reduce to practice Mr. Justice Holmes' concept that an applicant, by filing his application, has "done all that he could do to make his description public."¹⁰²

102. *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390, 401 (1926).