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Improvements on Machine after Expiration of Original Patent

PATENT LAW

IMPROVEMENTS ON MACHINE AFTER EXPIRATION OF ORIGINAL PATENT

Respondent brought suit for infringement of five claims of an improvement patent. Petitioner had purchased from a German maker, and had used, four machines which were exact duplicates of the plaintiff's machine. The defense was: first, that the improvements were a mere exercise of mechanical skill and thus were not patentable; second, that the claims were so broad as to include the old machine and the new improvements. *Held*, a claim in a patent is not to be construed as reclaiming old elements along with the new combinations merely because the old elements are referred to as a method of showing how the new combination works in conjunction with the old[1] (Justices Black, Douglas, and Murphy, dissenting.)

That the Supreme Court will not disturb a concurrent finding of fact by both lower courts unless that finding is clearly wrong, is undoubtedly a settled rule in patent cases.[2] Equally well settled is the proposition that it is a question of fact and not of law as to whether an improvement requires mere mechanical skill or the exercise of the faculty of invention.[3] Nevertheless, it is submitted that other considerations favor the dissent.

Where a specification, by ambiguity and a needless multiplication of nebulous claims, is calculated to deceive and mislead the public, the patent is void.[4] Intention to deceive and mislead is one of the essential elements of this rule.[5] In the principal case there seem to be ample facts upon which to base such an intention. The whole tenor of the claims is to so intermingle the old machine with the new improvements as to cause confusion,[6] thus extending the protection granted

1. Williams Manufacturing Co. v. United Shoe Machinery Corp., 316 U.S. 364 (1942). The lower courts found the claims valid and infringed. 29 F. Supp. 1015 (S.D. Ohio 1939), aff'd, 121 F. (2d) 273 (C.C.A. 6th, 1941). It is the contention of the majority in the principal case that the claims do not combine the old with the new, because references to old elements were made only to show how the old worked with the new. This position is refuted by the dissenting opinion with references to specific claims.
2. Continental Paper Bag Company v. Eastern Paper Bag Company, 210 U.S. 405 (1908); cf. Altoona Public Theater, Incorporated v. American Tri-Ergon Corporation et al., 294 U.S. 477, 480 (1934); Thompson Spot Welder Company v. Ford Motor Company, 265 U.S. 445, 447 (1923).
3. Thompson Spot Welder Company v. Ford Motor Company, 265 U.S. 445, 446 (1923); Keyes v. Grant 118 U.S. 25, 37 (1886); Condit v. Jackson Corset Company, 35 F. (2d) 4, 6 (C.C.A. 6th, 1929); Shuter v. Davis, 16 Fed. 564, 566 (C.C.S.D.N.Y. 1883).
4. Carlton v. Bokee, 17 Wall. 463, 471 (U.S. 1873), quoted by Justice Black at page 371 of the principal case. See also Fruit Treating Corporation et al. v. Food Machinery Corporation, 112 F. (2d) 119 (C.C.A. 5th, 1940).
5. A. B. Dick Co. v. Underwood Typewriter Co. 246 Fed. 309 (S.D. N.Y. 1917); Tompkins v. Gage, 24 Fed. Cas. 35, No. 14,088 (C.C.N.D.N.Y. 1865).
6. Justice Black's discussion of claim 42 at p. 377.

the improvement patent over the old and expired patent.[7] Studies made by the Temporary National Economic Committee show that this practice is used for the express purpose of extending the term of the expired patent.[8] An analogous situation arises when a patentee attempts to extend the monopoly of his patent over an unpatented product. Such an attempt has been held generally ineffective.[9]

The primary purpose of patent law is not to create private fortunes for the owners of the patents but "to promote the progress of science and the useful arts."[10] The source of the power to grant patents and the consideration for granting them are the advantages which the public will derive from them, especially after the expiration of the patent monopoly, when the discoveries in them become a part of the public stock of knowledge.[11] When, as here, the patentee has a virtual monopoly of all the machinery for a given purpose[12] the patent, if doubtful, should be declared invalid to protect the public.