
Patents - Originality of Invention - Suggestions to Inventors

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under the "single act" statute in spite of the fact that a tort had been committed.

An era of rapid technological achievements has enabled corporations to extend the scope of their activities. It has also become increasingly less burdensome to defend actions in jurisdictions foreign to the corporation.²² The Supreme Court has applied a flexible standard of reasonableness and fair play to the requirements of due process, providing both latitude and limitation to the exercise of state court jurisdiction over foreign corporations.²³ The outermost limits of jurisdiction on the commission of a tortious act have not been clearly defined, but it is apparent that the application of "single act" statutes to impose jurisdiction over a foreign corporation on the basis of a single tort without prior business in the state satisfies due process.²⁴

The holding in the present case is an attempt by the New York court to extend its jurisdiction over a foreign corporation. While previous cases have upheld jurisdiction when the damage occurs in the state where the action is brought, in this case jurisdiction was allowed in spite of the fact that the damage occurred in another state. It remains to be seen whether or not other courts will uphold the decision that "the occurrence of the harm in Connecticut was incidental for jurisdictional purposes."²⁵

Harold Stotland

²² The doctrine of relative inconveniences has been applied in cases involving in personam jurisdiction over foreign corporations. See *Chovan v. E. I. Dupont De Nemours & Co.*, 217 F. Supp. 808 (E.D. Mich. 1963); *Dahlberg Co. v. American Sound Products, Inc.*, 179 F. Supp. 928 (D. Minn. 1959); *Johns v. Bay State Abrasive Prod. Co.*, 89 F. Supp. 654 (D. Md. 1950).

²³ 326 U.S. 310 (1945).

²⁴ *McMahon v. Boeing Airplane Co.*, 199 F. Supp. 908 (N.D. Ill. 1961); *Hutchinson v. Boyd & Sons Press Sales, Inc.*, 188 F. Supp. 876 (D. Minn. 1960).

²⁵ 21 App. Div. 2d 285, 286, 250 N.Y.S.2d 216, 218 (1964).

PATENTS—ORIGINALITY OF INVENTION—SUGGESTIONS TO INVENTORS

Polye, the junior party in an interference proceeding had isolated the cause of failure in a certain type of electric switch. Uhl, the senior party in interference, had discussed the problem with Polye and suggested the incorporation of a certain chemical compound into the switch to obviate the difficulty. Polye experimented with the idea of Uhl, reduced to practice the improved version, and filed a patent application. The Court of

Custom and Patent Appeals, overruling the Patent Office Board of Patent Interferences *Polye v. Uhl*, 51 C.C.P.A. 1067, 328 F.2d 893, 140 U.S.P.Q. 584 (1964), awarded priority to Polye on the ground that Uhl did not show that he "invented or suggested the entire invention as embodied in the combination of elements claimed in the counts in issue."¹ In another recent interference case involving similar circumstances, the same court applied a somewhat different test to determine the award of priority. Here, the senior party had announced in a trade publication his discovery of a new method for the effective elimination of undesirable sea lamprey by the use of a chemical which would destroy its larvae. In a letter to the senior party, the junior party suggested the use of another compound which could be manufactured at a much lower cost than the first compound. The senior party performed extensive tests establishing the utility and effectiveness of the suggested compound in achieving the desired result. The test used by the court in awarding priority to the junior party was: if the disclosure by the party offering suggestions had been such as to enable a person of ordinary skill in the art to practice the disclosure without extensive research and experimentation then priority is awarded to the former. *Applegate v. Scherer*, ____ C.C.P.A. ____, 332 F.2d 571, 141 U.S.P.Q. 796 (1964).

The issue of originality of invention in its broadest sense is presented in many different situations in patent law,² and there is strong reason to expect that more and more litigation will involve claims of derivation of invention.³ This note is written to pursue a consistent set of principles of

¹ 51 C.C.P.A. at ____, 328 F. 2d at 898, 140 U.S.P.Q. at 588. Count one in issue read (140 U.S.P.Q. at 587): "In a level switch . . . the improvement which comprises a thinly fluid dispersion in the electrolyte of at least five percent of a hydrogen acceptor. . . ." Count two is in dependent form and specifies the hydrogen acceptor as "an unsaturated organic solvent" and calls for the use of a catalyst. Counts three and four, also in dependent form, relate to the chemical composition of the electrolyte. Claim five names the hydrogen acceptor as allyl alcohol.

² For example, lack of originality is a defense to an infringement suit, *De Laski v. Thropp*, 218 Fed. 458 (1914), affirmed 226 Fed. 941; *Agawam Wollen Co. v. Jordan*, 74 U.S. (7 Wall.) 583 (1868). Origination of invention in third party may be the issue in an interference where the two parties to the interference have worked independently, *Alpert v. Slatin*, 49 C.C.P.A. (Patents) 1343, 305 F.2d 891, 134 U.S.P.Q. 296 (1962). An applicant for patent may try to overcome a reference claiming lack of originality in or derivation by the author, *In re Tansel*, 45 C.C.P.A. (Patents) 834, 253 F.2d 241, 117 U.S.P.Q. 188 (1958). Of course, as a defense in an infringement suit, lack of originality has been regarded as a technical defense and looked upon with disfavor by the courts, *De Laski v. Thropp*, *supra*. 35 U.S.C. 256 (1958) now provides that no patent shall be invalid because of misjoinder or nonjoinder of inventors where the error was not intentional and there has been no deception.

³ The Melman Report, Study No. 11 of Senate Res. 236, 85th Congress, 2nd sess. at 57, (1958) recognizes the situation in contemporary research efforts, "In actual operation, designation of a specified individual as 'the' inventor often becomes increasingly diffi-

the law as it relates to the situation in which both parties to a patent interference proceeding had communicated concerning the subject matter of the interference counts prior to filing an application, and each claims to be the sole inventor.⁴ Title 35 of the United States Code in section 135 treats all interferences as involving an issue of priority, but the court in the *Applegate* Case correctly points out that in an originality case, the issue is not who is the first or prior inventor, but who made the invention, noting: "An originality or derivation case, which this is, is quite unlike a case involving independent inventors, between whom true 'priority' must be decided."⁵

Originality is a question of fact, and the burden is on the junior party to establish by a preponderance of the evidence derivation on the part of the senior party.⁶ This issue, when it is made, is ancillary to the question of priority⁷ and a party raising it has the right to have it determined; all other issues are subsidiary.⁸ A party can raise questions of diligence in reduction to practice⁹ and suppression, concealment, and abandonment¹⁰ only when that party has satisfied the condition that he is an independent inventor, and not when he had derived knowledge of the invention from his opponent.

When an inventor claims that his opponent in interferences has derived the invention from him he narrows the issue considerably, but the courts require that he lay a strong foundation of facts to substantiate his claim. As held in *Rider v. Griffith*:¹¹ where the issue is originality, the party

cult, if not impossible, under modern conditions because of the division of labor and interdependence which exists. Research is increasingly a joint process to which persons with various technical skills contribute necessary parts."

⁴ 35 U.S.C. 102 states: "A person shall be entitled to a patent unless— . . .

(f) he did not himself invent the subject matter sought to be patented, . . ."

35 U.S.C. 115 (1958) reads: "The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent. . . ."

⁵ 141 U.S.P.Q. at 798. See, also *Orange-Crush Co. v. American Ornamental Bottle Corp.*, 60 F.2d 518, 14 U.S.P.Q. 171 (C.A. 4, 1932); *Browning v. Johnson*, 50 App. D.C. 335, 271 Fed. 1017 (1921); *Baumgardner v. Hudson*, 51 App. D.C. 150, 277 Fed. 552 (1922); *Smith v. Pritchard*, 58 App. D.C. 9, 24 Fed. 2d 274 (1928).

⁶ *Keeler v. Kistler*, (P.O. Bd. Pat. Inter.) 128 U.S.P.Q. 442 (1958).

⁷ *Kratz v. Calvert*, 29 C.C.P.A. (Patents) 1097, 129 F.2d 542, 54 U.S.P.Q. 264 (1942).

⁸ *Moler v. Purdy*, (P.O. Bd. Pat. Inter.) 131 U.S.P.Q. 276 (1960).

⁹ *Browning v. Johnson*, 50 App. D.C. 335, 271 Fed. 1017 (1921); *Orange-Crush Co. v. American Ornamental Bottle Corp.*, 60 F.2d 518, 14 U.S.P.Q. 171 (C.A. 4, 1932); *Beall v. Ormsby*, 33 C.C.P.A. (Patents) 959, 154 F.2d 663, 69 U.S.P.Q. 314 (1946).

¹⁰ *Finch v. Dillenback*, 28 C.C.P.A. (Patents) 1171, 121 F.2d 459, 49 U.S.P.Q. 731 (1941); *Stanley v. Gump*, (P.O. Bd. Pat. Inter.) 136 U.S.P.Q. 483 (1962).

¹¹ 33 C.C.P.A. (Patents) 884, 154 F.2d 193, 69 U.S.P.Q. 112 (1946).

claiming derivation must show that he was in possession of the invention before the date of the alleged disclosure and that his opponent had both a motive and opportunity to learn it.

However, in a substantial number of cases involving originality, each party honestly believes himself to be the true inventor, having made the most significant contribution to the effort. There is usually no great dispute concerning the facts. As indicated by the two cases that introduce this note, the courts are not uniform in applying a test in this latter situation.

The circumstances may be illustrated by the case of *Tolle v. Starkey*¹² in which the counts defined a method of electrostatically painting non-conducting articles. Tolle had suggested heating the articles before painting; and Starkey, while conducting experiments to make the idea practicable had discovered that it would work only when the articles were heated to a certain minimum temperature. The court awarded priority to Starkey holding that, despite the fact that Tolle's suggestion was the "spark" which led to the final satisfactory result, the suggestion had not been merely to perform experimentation to optimize the time during which heat was to be applied. The fact was that the method as suggested would not work unless the articles themselves were heated above a specific temperature. That is, Tolle's suggestion of applying hot air was not operable *per se*. What the court was saying, without stating it explicitly, was that Tolle's suggestion could not be put to practical use with only the exercise of ordinary skill. Starkey had exercised inventiveness; though admittedly not unrelated to Tolle's suggestion, it was independent of it.

As the *Applegate v. Scherer* case indicates, the matter must be approached in terms of who made the invention. The court must first determine exactly where the invention lay before determining who made it. The Patent Office Board of Patent Interferences deciding the case of *Stanley v. Gump*¹³ phrased it this way: "Even if Gump *et al* had added details not disclosed to them or inherent in Stanley's disclosure, this would not be basis for award of priority in an originality contest, so long as such details represented nothing more than the normal skill of the art."

Therefore, it must be determined who made the suggestion which constituted the inventive concept defined in the counts.¹⁴ The disclosure must not have been so broad that it required extensive research and ex-

¹² 45 C.C.P.A. (Patents) 979, 255 F.2d 935, 118 U.S.P.Q. 292 (1958).

¹³ 136 U.S.P.Q. at 486.

¹⁴ See, *Van Otteren v. Hafner*, 47 C.C.P.A. (Patents) 995, 278 F.2d 738, 126 U.S.P.Q. 151 (1960), where it was found that the first count contained "the essential features of the invention," and the second count involved only features exhibiting mechanical skill in an embodiment of the first count. See also, *Barnet v. Wied*, 39 C.C.P.A. (Patents) 882, 195 F.2d 311, 93 U.S.P.Q. 161 (1952).

perimentation to implement¹⁵ for this would indicate that there had not been a complete conception of the invention.¹⁶ One cannot claim that his opponent has derived an invention from a suggestion which indicates a desirable result without having disclosed to him any specific means for obtaining that result.¹⁷

In an originality case, where a disclosure does contain the elements of invention defined by the interference counts, the inventor need not have knowledge of all the advantages of his idea nor even that it will operate effectively. To hold otherwise, as indicated in *Applegate v. Scherer*, would mean: ". . . that one could never communicate an invention thought up by him to another who is to try it out, for, when the tester succeeds, the one who does no more than exercise ordinary skill would be rewarded and the inventor would not be. Such cannot be the law."¹⁸

The test applied in the *Applegate* case, namely, that in an originality contest it is sufficient for an award of priority that an inventor make a disclosure which would enable a person of ordinary skill in the art to practice it without the exercise of the inventive faculty seems clearly to be the most sound rule, being in accord with the philosophy that a patent should be granted only to the one who advances the art. Consistent application of this rule in originality cases requires that the substance, not the formal wording, of the counts be construed to determine what constitutes the invention that has been defined by the counts,¹⁹ and that priority be awarded to the one who contributed the invention. A strict construction of the interference counts may lead to the situation where the actual inventor is defeated in a contest to claim his invention be-

¹⁵ *O'Donnell v. Hartt*, 22 C.C.P.A. (Patents) 958, 75 F.2d 195, 24 U.S.P.Q. 379 (1935); *Tolle v. Starkey*, 45 C.C.P.A. (Patents) 979, 255 F.2d 935, 118 U.S.P.Q. 292 (1958).

¹⁶ See, *Raiche v. Foley*, 27 C.C.P.A. (Patents) 1180, 113 F.2d 497, 46 U.S.P.Q. 224 (1940).

¹⁷ *Barnet v. Wied*, 39 C.C.P.A. (Patents) 882, 195 F.2d 311, 93 U.S.P.Q. 161 (1952).

¹⁸ 332 F.2d at 573-74, 141 U.S.P.Q. at 799.

¹⁹ See cases cited *supra* note 14. In the matter of construction of the interference counts, it is particularly important to note the distinction between an originality case and a priority contest between two independent inventors. Indiscriminate use of wording out of context can lead to confusion as where the court in the *Polye* Case based its holding on the proposition that: "the law is clear that every limitation in an interference count is to be considered material in determining whether a party should prevail." 328 F.2d at 897, 140 U.S.P.Q. at 587, citing, as authority, *Segall v. Sims*, 47 C.C.P.A. (Patents) 888, 276 F.2d 661, 125 U.S.P.Q. 374 (1960) and *Crome v. Morrogh*, 44 C.C.P.A. (Patents) 704, 239 F.2d 390, 112 U.S.P.Q. 49 (1956). Actually, both *Segall v. Sims* and *Crome v. Morrogh* were priority contests between independent inventors and the holding of both cases was that every limitation in an interference count is material in determining whether a party has the right to make the count, *i.e.*, that his application discloses the subject matter of every limitation in the count—and not whether a party should prevail.

cause his opponent has either substituted an element that is the equivalent of one he disclosed,²⁰ or included a limitation in the count which resulted from the exercise of mere technical skill in perfecting the invention and does not lend patentability to the claim.

James Hill

²⁰ See *Nielsen v. Cahill*, (P.O. Bd. Pat. Inter.) 133 U.S.P.Q. 563, 571 (1961).

REAL PROPERTY—TAX DEEDS—MAY A PERSON NOT OF RECORD ATTACK ORDER ISSUING TAX DEED?

On November 12, 1958, property owned by Arthur T. McIntosh & Co. was sold to Vera Place, the respondent, for unpaid 1957 general taxes, and certificates of purchase were issued to her, describing the property as: "Lot 20 and 21 Northwoods, DuPage County, Illinois (same as described in doc 659621.)"¹ She filed a petition for an order directing the issuance of a tax deed. Service was had upon Arthur T. McIntosh, in whose name the property was last assessed, and notice was published in a newspaper of general circulation in DuPage County. However, on July 2, 1959, Arthur T. McIntosh & Co. sold the property to Helen E. and Joseph J. Bird. A tax deed was issued to Vera Place and recorded on December 20, 1960. Otto C. Stephani acquired title from the Birds' bankrupt estate on November 21, 1961, and recorded the Birds' deed and his deed at that time. Chicago Title and Trust Co., as trustee for Stephani, filed a petition seeking to set aside the tax deed; fraud was alleged in that: (1) the property was insufficiently described;² and (2) the notice was published in a newspaper which was not calculated to reach the petitioner. The Illinois Appellate Court reversed the trial court's dismissal of the petition and remanded the case to the trial court for adjudication of the fraud issue, stating, in effect, that petitioner had standing to attack the issuance of a tax deed. *In re Smith*, 50 Ill. App. 2d 189, 199 N.E.2d 420 (1964).

Before analyzing this case, it may be well to review briefly the procedure followed in an annual tax sale proceeding. When taxes become

¹ Supposedly the number of the plat of subdivision.

² ILL. REV. STAT. ch. 120 § 516 (1963) provides that if the legal description includes the document number of the plat of subdivision, it shall be a good and valid description. Appellant's argument here is that there are two Northwoods in DuPage County and the document number included in the legal description was not that of the plat of subdivision. However, appellee used the legal description of the County Clerk's assessment rolls and that which was on the certificate of purchase issued to her. Therefore, the charge of fraud in this respect seems unfounded.