
**Patents - Patentable Invention: Question of Law or Fact? -
Brothers Incorporated v. Browning Manufacturing Company, 137
U.S.P.Q. 624 (8th Cir. 1963)**

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view of most courts,²³ although there is growing a trend of authority to the contrary.²⁴ However questionable this rule may be,²⁵ it is beyond the scope of this study to inquire further into this broader question.

Thus, if we accept the hypothesis that there should be no contribution permitted among joint tort-feasors, it follows that any settlement with one joint tort-feasor, no matter how large or small, should not infringe on the plaintiff's right to collect the entire balance of his damages from any other joint tort-feasor. He could have collected the entire amount from any defendant he chose. There would also seem to be no argument to refute the contention that the admission into evidence of a previous settlement from one joint tort-feasor might lead a jury to believe that it had the wrong party before it, or that the plaintiff had received adequate compensation for his injury. It would therefore appear that the rule in *DeLude v. Rimek* and *Burger v. Van Severn* represents the better reasoned view for adjusting a judgement where the plaintiff has received a settlement out of court from a joint tort-feasor.

Since no recent case applying Illinois law has followed any other rule, it seems clear that this is the current Illinois law on this issue, and it would seem likely that other jurisdictions will follow the lead of North Carolina and Maryland in adopting this rule in succeeding years.

²³ *Union Stock Yards Co. of Omaha v. C., B & Q. R.R.* 196 U.S. 217 (1904); *Chapin v. C & E.I.R.R.*, 18 Ill. App. 47 (1885); *RESTATEMENT, TORTS*, § 879 (1948); *See generally Prosser, Joint Torts and Several Liability*, 25 CALIF. L. REV. 413, 418 (1937).

²⁴ *E.g. Judson v. People's Bank and Trust Co.*, 25 N.J. 17, 134 A.2d 761 (1957); *George's Radio, Inc. v. Capital Transit Co.*, 126 F.2d 219, 75 U.S. App. D.C. 187 (1947); *Quatray v. Wicker*, 178 La. 289, 151 So. 208 (1933); *Goldman v. Mitchell-Fletcher Co.*, 292 Pa. 354, 141 231 (1928).

²⁵ *See also Pennsylvania Co. v. West Penn. Rys.*, 110 Ohio St. 516, 144 N.E. 51 (1924), where following this rule blindly led to a blatantly unjust conclusion.

PATENTS—PATENTABLE INVENTION: QUESTION OF LAW OR FACT?

Brothers Incorporated brought action against Browning Mfg. Co. to secure a declaratory judgment that United States Patent No. 2,610,557, relating to a pneumatic roller compactor, was invalid since the claimed invention had been fully described and illustrated in a printed pamphlet which had been prepared and publicly distributed by Browning Mfg. Co., more than one year prior to the date of the application for patent.¹ Browning

¹ 35 U.S.C. § 102 (b) states: "A person shall be entitled to a patent unless . . . the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States."

Mfg. Co., denied this and counterclaimed, asserting patent infringement on the part of Brothers Incorporated, and seeking an injunction and an accounting. Plaintiffs joined issue on the counterclaim. In their complaint the plaintiffs alleged that they had been notified by the defendant that pneumatic roller compactors made by the plaintiffs infringed the patent in suit. The District Court for the District of Minnesota held that the publication of the description of the invention in the pamphlet rendered the patent invalid and entered judgment for the plaintiffs. On appeal the Court of Appeals for the Eighth Circuit affirmed the lower court's findings of invalidity, stating that since the patentability of an invention is a question of fact, the decision of the District Court is conclusive upon them. *Brothers Incorporated v. Browning Manufacturing Co.*, 137 U.S.P.Q. 624 (8th Circuit, 1963).

Whether patentable invention is a question of law or of fact has created much confusion. There are a number of jurisdictions that profess adherence on this question to Rule 52(a) of the Federal Rules of Civil Procedure,² which states that findings of fact of the trial judge shall be final "unless clearly erroneous."³

The circuits are divided, with the 1st, 3rd, 6th, 8th, 9th, and the District of Columbia holding patentable invention to be a question of fact and adhering to the "clearly erroneous" test on review.⁴ The 2nd and 5th grant a broad review, without mention of the clear error rule.⁵

The 4th Circuit in a recent case, *Heyl and Patterson, Inc. v. McDowell Co., Inc.*⁶ held that the question of the validity of a patent is a question of law. In the well-known case of *National Slug Rejectors Inc. v. A.B.T. Mfg. Corp.*,⁷ the leading case in the 7th Circuit, the opinion categorically

² The 1st, 3rd, 6th, 8th, 9th, and the District of Columbia U.S. Circuits.

³ FED. R. CIV. P., 52 (a).

⁴ *Collins v. Owen*, 310 F.2d 884 (8th Cir. 1962); *Gibson-Stewart Co. v. William Bros. Boiler and Mfg. Co.*, 264 F.2d 776 (6th Cir. 1959); *United Mattress Mach. Co. v. Handy Button Mach. Co.*, 207 F.2d 1 (3rd Cir., 1953); *Lane-Wells Co. v. M. O. Johnson Oil Field Service Corp.*, 181 F.2d 707 (9th Cir. 1950); *Faulkner v. Gibbs*, 170 F.2d 34 (9th Cir. 1948); *Galion Metallic Vault Co. v. Edward G. Budd, Mfg. Co.*, 169 F.2d 72 (3rd Cir. 1948); *General Motors Corp. v. Kesling*, 164 F.2d 824 (8th Cir. 1947); *White v. E. L. Bruce Co.*, 162 F.2d 304 (3rd Cir. 1947); *Lincoln Stores, Inc. v. Nashua Mfg. Co.*, 157 F.2d 154 (1st Cir. 1946); *Page v. Meyers*, 155 F.2d 57 (9th Cir. 1946); *Besser v. Ooms*, 154 F.2d 17 (D.C. 1946); *Cleo Syrup Corp. v. The Coca-Cola Co.*, 139 F.2d 416 (8th Cir. 1943); *Zephyr American Corp. v. Bates Mfg. Co.*, 128 F.2d 380 (3rd Cir. 1942); *Minnesota Mining and Mfg. Co. v. Coe*, 118 F.2d 593 (D. C. 1940); *Vulcan Corp. v. Slipper City Wood Heel Co.*, 89 F.2d 109 (6th Cir. 1937).

⁵ *Schaefer, Inc. v. Mohawk Cabinet Co.*, 276 F.2d 204 (2nd Cir. 1960); *Interstate Rubber Product Corp. v. Radiator Specialty Co.*, 114 F. Supp. 120 (D.C.W.D. 1953); *Sudiah v. Jacobson*, 56 F.2d 421, 425 (2nd Cir. 1932); *Hazeltine Corp. v. Radio Corp. of America*, 52 F.2d 504 (S.D. N.Y. 1931).

⁶ 137 U.S.P.Q. 620 (4th Cir. 1963).

⁷ 164 F.2d 333 (7th Cir. 1947).

states: "This century-old question is always perplexing. We cannot avoid or evade it. We must meet it. Patentable invention is a question of law."⁸ Hence, the 4th and 7th Circuits hold that patentability is a question of law.⁹

The decisions of the United States Supreme Court have not been very helpful in clarifying the confusion on this issue. In a decision in 1938,¹⁰ the Court said: "In a patent case . . . the questions of validity and infringement are questions of fact."¹¹ Continuing the Court said: "Even though the finding determines a mixed question of law and fact, the finding is conclusive unless the court is able to so separate the question as to see clearly what and where the mistake of law is."¹²

In the instant case the Court refused to disturb the findings of the lower court but the discussion clearly indicated that the question of validity (in this case same as "inventions") is a mixed question of law and fact.

In a 1942 decision¹³ the Supreme Court upheld concurrent decisions of the lower courts that a patent was valid and infringed. The question as to whether elements were combined in a way as to constitute a patentable invention was said to be a "question of the novelty,"¹⁴ one of fact not to be disturbed where there was evidence to support it.

Justices Black, Douglas, and Murphy dissented and argued that the Court should have held the patent invalid, saying:

And where, as here, an appellate court can determine from a mere construction and comparison of patents that an alleged new invention is in reality identical with inventions claimed in prior patents, the question of patentability should be reviewed. . . .

But novelty and usefulness are not enough, for to be patentable, improvements must, under the Constitution and the statute, amount to an invention or discovery.¹⁵

This dissent was realistic to the extent that it recognized that the question of invention involves some elements of law.

This subject was further brought to attention in the widely known *A & P Case*.¹⁶ Although the two lower courts had concurred in holding

⁸ *Id.* at 336.

⁹ See *Noble Co. v. The C. S. Johnson Co.*, 241 F. 2d 469 (7th Cir. 1957); *Harley C. Loney Co. v. Ravenscroft*, 162 F.2d 703 (7th Cir. 1947); *Galland-Henning Mfg. Co. v. Logemann Bros Co.*, 142 F.2d 700 (7th Cir. 1944).

¹⁰ *United States v. Esnault-Pelterie*, 303 U.S. 26 (1938).

¹¹ *Id.* at 29.

¹² *Ibid.*

¹³ *Williams Mfg. Co. v. United Shoe Machinery Corp.*, 316 U.S. 364 (1942).

¹⁴ *Id.* at 367.

¹⁵ *Id.* at 384.

¹⁶ *Great Atlantic and Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147 (1950).

the patent invalid, stating that the courts had not applied the proper criteria in determining invention, Justice Jackson stated in the majority opinion:

We set aside no finding of fact as to invention, for none has been made except as to the extension of the counter, which cannot stand as a matter of law.¹⁷

The District Court apparently had not made a clearcut finding of fact as to invention, but nevertheless the fact that some rules of law are concerned in deciding the question of invention was acknowledged by the Supreme Court.

Justices Douglas and Black in the same case, concurring in the opinion stated: "The standard of patentability is a constitutional standard; and the question of validity of a patent is a question of law."¹⁸

These statements inevitably lead to the conclusion that the question of patentable invention is a mixed question of law and fact. This was first brought out in the 1942 *Hanovia Co. Case*,¹⁹ where the opinion states;

From the foregoing it seems apparent that no general statement can be made concerning the classification of the broad question of patentable invention either as one of fact or as one of law. It is partly one and partly the other.²⁰

Hence, patentable invention is realistically a mixed question of law and fact, and being so, the court as a preliminary matter must determine certain fact questions such as: What was the state of the prior art; what did the patentee do to improve upon the prior art.²¹ Then having decided these fact questions, the court must determine whether what the patentee did was a sufficient advance over the prior art to amount to an invention. In deciding the latter question the court must apply certain standards or rules of law that have been developed by the courts, and some of which are now found in the patent statutes.²² Thus, it is evident that whether or not something can be classified as an "invention" is an ultimate fact to be found by answering questions both of fact and of law. It is therefore a mixed question of fact and law. This is clearly stated in the opinion of District Judge Goodman in *Up-Right, Inc., v. Patent Scaffolding Co.*²³

¹⁷ *Id.* at 153-4.

¹⁸ *Id.* at 155.

¹⁹ *Hanovia Chemical & Mfg. Co. v. David Butterick Co.*, 127 F. 2d 888 (1st Cir. 1942).

²⁰ *Id.* at 890.

²¹ 35 U.S.C. § 102 states in part: "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 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."

²² 35 U.S.C. § 1-293.

²³ 108 U.S.P.Q. 32 (1954).

where he says: "In my opinion, the issue of validity here is one of law, or, at least, a mixed question of law and fact."²⁴ An issue was raised as to whether it amounted to invention to combine certain old elements. In analyzing this question the court said further: "The rule of law is clear and hence there is no need of citing the cases. A comparison of the prior art patents and the plaintiffs' patent gives the answer."²⁵

The Up-Right case is the only instance where it has been found that a court has clearly stated that the question of invention is a mixed question of law and fact. The real nature of this question seems never to have been discussed in the court decisions. It has been only recently that a trend seems to be discernible tending towards regarding patentable inventions as a mixed question of law and fact, but as for definitely establishing this, the courts have a long way to go at the present time.

²⁴ *Ibid.*

²⁵ *Ibid.*

UNIFORM COMMERCIAL CODE—SECURED TRANSACTIONS— ADEQUACY OF FINANCING STATEMENT TO COVER AFTER-ACQUIRED PROPERTY

On November 18, 1960, Firestone & Company, which was in the financing business, loaned Carroll, d/b/a Cozy Kitchen, \$1,911, taking a security agreement covering

. . . the following goods, chattels, and automobiles, namely: The business located at and numbered 570¹ Washington Street, Canton, Mass. Together with all its good-will, fixtures, equipment and merchandise, the fixtures specifically consist of the following: *All contents of the luncheonette including equipment such as: booths and tables, stand and counter (other items irrelevant)* . . . together with all property and articles now, and which may hereafter be, used or mixed with, added or attached to, and/or substituted for any of the foregoing described property.

Firestone filed financing statements with the local town clerk on November 18, and with the Secretary of State on November 22.² These contained only the italicized portion of the security agreement and described the debtor as Carroll, d/b/a Cozy Kitchen. Subsequent to this National Cash Register Company entered into a conditional sales contract with Carroll for the sale of a cash register. The cash register was delivered some time between November 10 and November 25. On the latter date, a new conditional sales contract superseding the old was executed and fi-

¹ The official reporter states the address as being 574, whereas it is actually 570.

² Massachusetts adopted the system of dual filing under the Uniform Commercial Code, section 9-401 (1c). Illinois did not adopt optional paragraph (c).