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**Patent Law - Function of the Apparatus Rejection - Inconsistent with the Patent Act of 1952 - Ex Parte Symons, 134 U.S.P.Q. 74 (Pat. Off. Bd. Of App., 1962)**

DePaul College of Law

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health of the community.<sup>20</sup> Under this power, the control over children for the protection of their health by the state seems almost limitless.<sup>21</sup> In fact the police power of the state has been extended to cover a case involving an unborn child. In *Hoener v. Bertinato*,<sup>22</sup> parents of an unborn child refused to consent to a blood transfusion for the child to be given immediately after birth. Medical opinion and history of past pregnancies of the mother indicated that the transfusion would be essential to save the infant's life. The court held that the parents were neglecting to provide the child with proper protection, and ordered that the blood transfusions be administered. This unborn child's right to life and health entitled it to legal protection.

The purpose of the law allowing a state to take custody of a child, where the child is in need of medical care and its parents refuse to permit such care to be given, is to insure the health, welfare and well being of the child. Any parental action which would jeopardize this objective constitutes such a violation of duty as to forfeit the right of custody.

<sup>20</sup> *Prince v. Massachusetts*, 321 U.S. 158 (1944); *Klein v. Klein*, 8 App. Div. 2d 844, 190 N.Y.S. 2d 402 (1959).

<sup>21</sup> Limitations have been set down in these cases relying on the Washington Supreme Court Decisions in *In re Hudson*, 13 Wash. 2d 673, 126 P. 2d 765 (1942). The court held that it does not have authority to take custody and subject a minor child to surgical operation over the objection of its parents. The mere fact that a court is convinced of the necessity of subjecting a minor child to a surgical operation will not sustain a court order which deprives the parent of the responsibility and the right to decide the ultimate welfare of the child. These limitations, however, have been confined to instances arising within the State of Washington. *In re Frank*, 41 Wash. 2d 294, 248 P.2d 553 (1952); *In re Petrie*, 40 Wash. 2d 809, 246 P. 2d 465 (1952); *Wade v. State*, 39 Wash. 2d 744, 238 P. 2d 914 (1951).

<sup>22</sup> 67 N.J. Super. 517, 171 A.2d 140 (1961).

### PATENT LAW—FUNCTION OF THE APPARATUS REJECTION—INCONSISTENT WITH THE PATENT ACT OF 1952

Appellant, Loren G. Symons, filed a patent application<sup>1</sup> claiming as his invention both a method of and apparatus for grinding<sup>2</sup> in a *Rotating and Gyration Ball Mill*. The method sought to be patented comprised the operative steps performed by the apparatus in effecting the grinding operation. The Patent Office Examiner reviewing the application, made a

<sup>1</sup> Serial No. 511,655 filed May 27, 1955, issued as Patent No. 3,042,322 on July 3, 1962.

<sup>2</sup> Method or process, and apparatus, are separate classes of subject matter recognized by statute as patentable. 35 U.S.C.A. § 101 (1953).

final decision that such a method amounted to no more than the mere "function of the apparatus"<sup>3</sup> and therefore was unpatentable, citing as his authority the case of *In re Anthony G. Horvath*.<sup>4</sup> The applicant appealed from such final rejection to the Patent Office Board of Appeals, particularly challenging the consistency of the "function of the apparatus" rejection of method claims, with the 1952 Patent Act.<sup>5</sup> As to this issue, the Board of Appeals reversed the examiner's rejection and held that the rejection of method claims as the "function of the apparatus" was inconsistent with the 1952 Patent Act. *Ex parte Symons*, 134 U.S.P.Q. 74 (Pat. Off. Bd. of App., 1962).

The concept that the "function of an apparatus" is unpatentable, had its origin in an 1853 Supreme Court decision in the case of *O'Reilly v. Morse*.<sup>6</sup> That case involved the validity of a reissue claim directed to the use of the motive power of electro-magnetism for printing intelligible characters at distances. The court, in holding such claim invalid, concluded that a method claim directed solely to the *result* accomplished by the use of a motive power, without reciting the intermediate steps of how such result is effected, is not a patentable process. The court reasoned that the result or *function of an apparatus* is just too broad to be a patentable process. The same court in *Corning v. Burden* held later that year, "[such] method represents the *function of the apparatus*, or effect produced by the machine . . . [and] it is well settled that a man cannot have a patent on the abstract effect of a machine, but only for the machine itself."<sup>7</sup>

This original concept, however, was perverted in a 1901 decision of the Court of Appeals for the District of Columbia in *In re Weston*.<sup>8</sup> That court, in an effort to resolve the prevalent confusion over the doctrine,<sup>9</sup> compiled prior constructions thereof and concluded that all processes, mechanical in nature, are unpatentable as the "function of the disclosed apparatus" unless they can be performed "by another and different apparatus" or "by hand." But this decision requires that an applicant, in

<sup>3</sup> This is a case law rejection applied to applications containing both process and apparatus claims where the process allegedly cannot be performed without the apparatus, the reasoning being that the invention lies only in the claimed apparatus. *In re Ernst et al*, 21 C.C.P.A. 1235, 71 F.2d 169 (1934).

<sup>4</sup> 41 C.C.P.A. 844, 211 F.2d 604 (1954).

<sup>5</sup> Title 35, U.S.C.A. (1953).

<sup>6</sup> 15 How. 61 (U.S., 1853).

<sup>7</sup> 15 How. 252, 268 (U.S., 1853) (emphasis added).

<sup>8</sup> 17 D.C. App. 431 (1901).

<sup>9</sup> In *Risdon Iron and Locomotive Works v. Medart*, the Supreme Court indicated that only processes which involved chemical or other elemental action were patentable. 158 U.S. 68 (1895).

addition to his original machine, either show an old apparatus employing his method, or invent a new one; and if he does the former, the method will undoubtedly be rendered unpatentable as being anticipated in the prior art. Further, this decision equates "function of the apparatus" with the method performed by the apparatus, rather than the "result or effect of the apparatus" established in the *Morse and Corning Cases*.

Despite the obvious inconsistency of the *Weston Case* with the doctrine laid down in the *Morse and Corning Cases*, the decision in the *Weston Case* still stands as law, only the exceptions being modified. The criterion of "other apparatus" was gradually narrowed by the courts to "apparatus having nonequivalent elements,"<sup>10</sup> then "apparatus differing substantially,"<sup>11</sup> next "apparatus differing in its essential character"<sup>12</sup> and finally "apparatus differing substantially in its essential character."<sup>13</sup> The "by hand" exception was expanded to include hand operation with "prior art apparatus"<sup>14</sup> or "ordinary tools of common usage."<sup>15</sup> In addition, two other exceptions were recognized: the first arose in cases where the apparatus is capable of performing other and different methods;<sup>16</sup> and the second, where there are no allowable or allowed apparatus claims.<sup>17</sup> Thus evolved the doctrine as it is known today.

In holding this doctrine to be inconsistent with the 1952 Patent Act in the *Symons Case*,<sup>18</sup> the Board of Appeals premised their decision upon the congressional intent underlying the statute.<sup>19</sup> The substitution of "process" for "art" in section 101<sup>20</sup> and the definition thereof in section 100(b) as including "a new use of a known . . . machine"<sup>21</sup> were cited to show congressional intent to grant patents on both apparatus and processes of machines. The board then, however, equated "known" in section 100(b)

<sup>10</sup> *In re Ernst*, 21 C.C.P.A. 1235, 71 F. 2d 169 (1934).

<sup>11</sup> *In re Middleton*, 35 C.C.P.A. 1166, 167 F. 2d 1012 (1948).

<sup>12</sup> *In re Nichols*, 36 C.C.P.A. 759, 171 F. 2d 300 (1948).

<sup>13</sup> *In re Ashbaugh*, 36 C.C.P.A. 902, 173 F. 2d 273 (1949).

<sup>14</sup> *In re McKee*, 23 C.C.P.A. 717, 79 F. 2d 905 (1935).

<sup>15</sup> *In re Parker*, 23 C.C.P.A. 721, 79 F. 2d 908 (1935).

<sup>16</sup> *In re Middleton*, 35 C.C.P.A. 1166, 167 F. 2d 1012 (1948); *Ex parte Scherer*, 103 U.S.P.Q. 107 (Pat. Off. Bd. of App., 1954).

<sup>17</sup> *In re Horvath*, 41 C.C.P.A. 844, 211 F. 2d 604 (1954).

<sup>18</sup> 134 U.S.P.Q. 74, 80 (1962).

<sup>19</sup> Tit. 35, U.S.C.A. (1953).

<sup>20</sup> "Whoever invents or discovers any new and useful process, . . . may obtain a patent therefor, subject to the conditions and requirements of this title." 35 U.S.C.A. § 101 (1953).

<sup>21</sup> "The term 'process' means process, art or method, and includes a new use for a known . . . , machine, . . ." 35 U.S.C.A. § 100(b) (1953).

with "new" and pointed out that "[c]learly, the same is true if the process is a *new* use of a *new* apparatus."<sup>22</sup>

Supplementing that argument, the board cited the new provision in section 121, which states that where two independent inventions are sought to be patented in a single application, neither shall operate as a reference against the other, either as an application or a patent.<sup>23</sup> The board then added, "the inference is clear that it is contrary to congressional intent to reject either one [process or apparatus] on the basis of, or because of the existence of, the other in the *same* case."<sup>24</sup>

The board further propounded as its strongest argument, that the change from the permissive "may" to the mandatory "shall" in section 102 so that it now reads "A person *shall* be entitled to a patent unless . . . ,"<sup>25</sup> coupled with the addition of section 101 of the phrase "subject to the conditions and requirements of this title,"<sup>26</sup> expressly forbid the use of nonstatutory provisions to deny patentability. The board could find no statutory support for the rejection and concluded that a method satisfying all statutory requirements for patentability, could not be so rejected; holding, "There being no statutory basis for the rejection, it should, in our opinion, be reversed."<sup>27</sup>

Chief Examiner McCann dissented to Chief Examiner Bailey's majority opinion, but did not attack it on its merits. Instead, he but states his affirmation of the examiner's proposition that the U.S. Court of Customs and Patent Appeals had sustained such rejection after the enactment of the statute.<sup>28</sup>

Prior to the holding in the *Symons Case*, substantially the same conclusion was reached by the District Court for the District of Columbia in *Societi Anonyme v. Marzall*.<sup>29</sup> In addition, Bailey has expressed the same or similar arguments in several earlier cases in concurring or dissenting opinions. In *Ex parte Goldsmith*<sup>30</sup> he analyzed the Supreme Court cases bearing on the issue and reached a conclusion identical to the proposition

<sup>22</sup> 134 U.S.P.Q. 74, 81 (1962).

<sup>23</sup> 35 U.S.C.A. § 121 (1953).

<sup>24</sup> 134 U.S.P.Q. 74, 82 (1962).

<sup>25</sup> The phrase, "A person *shall* be entitled to a patent unless . . ." (emphasis added) is followed by exceptions (a) through (g) which prohibit issuance of a patent in certain instances. 35 U.S.C.A. § 102 (1953).

<sup>26</sup> See note 20.

<sup>27</sup> 134 U.S.P.Q. 74, 83 (1962).

<sup>28</sup> 134 U.S.P.Q. 74, 84 (1962).

<sup>29</sup> 108 F. Supp. 310 (D.D.C., 1952). This case was ignored by the same court in a later case which held contra thereto. *Ferro Engineering Co. v. Watson*, 151 F. Supp. 167 (D.D.C., 1957).

<sup>30</sup> U.S.P.Q. 403 (Pat. Off. Bd. App., 1952).

set forth in *O'Reilly v. Morse*.<sup>31</sup> In *Ex parte Kennedy*,<sup>32</sup> *Ex parte Hart*,<sup>33</sup> and *Ex parte Roth and Rich*,<sup>34</sup> he set forth the same arguments presented in the *Symons Case*.

Of the three arguments set forth by Bailey in the *Symons Case*, the proposition that Congress intended the term "known" in section 100(b) of the 1952 Patent Act<sup>35</sup> to include a "new apparatus" is supported neither by the revisions noted for that section,<sup>36</sup> nor by case law.<sup>37</sup> Further, the applicability of section 121<sup>38</sup> is somewhat doubtful since the instant rejection is not concerned with the disclosed apparatus as a "reference" against the method of claims, but rather as an aid in determining whether the method is a "statutory process."<sup>39</sup>

The third argument propounded by Bailey, however, is tenable and finds support in two recent cases. In *In re Guido H. Stempel, Jr.*,<sup>40</sup> the United States Court of Customs and Patent Appeals held that "under 35 USC 102, an applicant is entitled to a patent unless it is shown that one or another of the prohibitory provisions therein or elsewhere in the statute applies." Also, the District Court for the District of Columbia held in *Monaco v. Hoffman*,<sup>41</sup> "The patent law is, however, entirely statutory and, unlike the common law, may not be molded and adjusted by judicial decisions to meet shifting needs and changing conditions. The Congress alone may afford a remedy, if one is needed."

In addition to supporting that argument, those two cases, and the *Symons Case*, represent the most recent decisions on that issue, and the three decisions further represent three of the most respected tribunals in patent law. Thus, this could be the beginning of a trend to abolish all case law tests for patentability not grounded in the 1952 Patent Act. Whether or not this trend materializes with respect to all such tests remains to be seen, but with respect to the instant "function of the apparatus" rejection, the trend has materialized, and it is anticipated that it will be followed.

<sup>31</sup> 15 How. 61 (U.S., 1853).

<sup>32</sup> 105 U.S.P.Q. 338 (Pat. Off. Bd. App., 1955).

<sup>33</sup> 117 U.S.P.Q. 193 (Pat. Off. Bd. App., 1957).

<sup>34</sup> 118 U.S.P.Q. 112 (Pat. Off. Bd. App., 1958).

<sup>35</sup> Tit. 35 U.S.C.A. (1953).

<sup>36</sup> 34 J. PAT. OFF. SOC'Y., No. 8, page 584 (1952).

<sup>37</sup> Though this same argument was expressed in the majority opinion in *Ex parte Kansas*, the court's conclusion was that structural limitations in a process claim, otherwise not affecting patentability, shall not affect it merely because they represent a new structure. 125 U.S.P.Q. 419, (Pat. Off. Bd. App., 1960).

<sup>38</sup> 35 U.S.C.A. § 121 (1953).

<sup>39</sup> *Ex parte Gutterman*, 104 U.S.P.Q. 89 (Pat. Off. Bd. App., 1954).

<sup>40</sup> 44 C.C.P.A. 820, 241 F. 2d 755 (1957).

<sup>41</sup> 189 F. Supp. 474 (D.D.C., 1960).