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Malpractice of Patent Attorneys

B. Joan Holdridge*

PRACTICE OF PATENT LAW has been described in the following terms by Chief Justice Holmes:

“The practice of patent law is one of the most complex and difficult today. The proceedings and forms not only require an extensive knowledge of the legal field but also considerable experience in engineering.

In conjunction with the inherent difficulty of the practice, the patent attorney has greater control over the processing of the application and the determination of the extent of the rights granted under the patent than is found in any other attorney-client relation.”

From the above quotation one can readily see that, under many circumstances, negligence or fraud¹ on the part of the attorney can cause the inventor to lose his right to a patent. It is a credit to the profession that there have been so few actions against patent attorneys.

This article will consider briefly the general nature of patent practice, and will indicate those areas where negligence on the part of the attorney could prevent a person from obtaining a patent or from having as full coverage of his invention as that to which he is entitled. For discussion of the possible liability of the attorney for his negligence in law practice generally, see Professor Gardner's article in a previous issue of this publication.²

The Patent Application

Any person who has invented or discovered a new method or machine not known or used by others in this country, nor described in any printed publication in this or any other country before the date of his invention or discovery, is entitled to a patent.³ However, if the invention has been described in a printed

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¹ One of the few malpractice actions brought against a patent attorney was that of fraud in *Dulberg v. Mock*, 1 N. Y. 2d 54, 133 N. E. 2d 695 (1956).

² 6 Clev. Mar. L. R. 264 (1957).

³ 35 U. S. C., Sec. 101.

publication⁴ or has been in public use or on sale⁵ in this country for more than one year prior to application, it is deemed abandoned and the inventor may not obtain a patent upon it.⁶ But, the invalidation of some claims of a patent because parts covered have been in public use more than the statutory period prior to the patentee's application does not invalidate the remainder of the claims.⁷

Since the date on which the application is made is controlling in determining whether or not an invention has been in public use, on sale, or described in a printed publication more than one year prior to the application,⁸ diligence on the part of the patent attorney in preparing the application is essential.

When an applicant files for a patent in another country first, he must file an application in this country within twelve months (six months in case of designs) from the earliest date on which any foreign application was filed.⁹

The application itself consists of a petition, specification, oath, drawings if necessary, filing fee, and a power of attorney to the attorney who is to act before the Patent Office on behalf of the inventor.¹⁰ If some essential element of the application is missing, the applicant has six months in which to complete the application; otherwise it is abandoned and not subject to revival.¹¹

The specification must describe the method or article to be patented, in such a way as to insure that one skilled in the art will be able to manufacture the patented article or to follow the patented method without further instructions.¹²

⁴ *Carter Products v. Colgate-Palmolive-Peet Co.*, 130 F. Supp. 557 (D. C. Md., 1955), *affd.* 230 F. 2d 855 (C. A. 4, 1956).

⁵ "By operation of the statutory provision, such use or sale becomes *ipso facto* abandonment." *Picard v. United Aircraft Corp.*, 128 F. 2d 632, 635 (C. C. A. 2, 1942).

⁶ "The fact he was an alien enemy of the country and the faults of his attorney explain it (his delay in applying does not make his case fall within any provision of the law that would treat those things as excuses for any setting aside of the rule that failure to apply for a patent within two years (now one year) after an invention was put into public use or sale precludes obtaining a valid patent."

Bocz v. Hudson Motor Car Co., 19 F. Supp. 385, 388 (D. C. Mich., 1937).

⁷ *National Biscuit Co. v. Old South Cone Co.*, 25 F. Supp. 619 (D. C. Mass., 1938), *affd.* 105 F. 2d 422 (C. C. A. 1, 1939).

⁸ *Lorenz v. Colgate-Palmolive-Peet Co.*, 60 F. Supp. 824 (D. C. N. J., 1945), *affd.* 167 F. 2d 423 (C. C. A. 3, 1948).

⁹ 35 U. S. C., Sec. 119.

¹⁰ 35 U. S. C., Sec. 111.

¹¹ Rule 77, Patent Office Rules of Practice.

¹² *Health Products Corp. v. Ex-Lax Mfg. Co.*, 22 F. 2d 286 (C. C. A. 2, 1927).

The difficulty of adequately describing the invention does not relieve one of the duty of complying with the statute.¹³ Ambiguous language in a disclosure has been held sufficient to invalidate a patent.¹⁴ However, there have been contra decisions.¹⁵

The patent should contain drawings where necessary or helpful to illustrate the invention, and the drawings should be described in detail in respect to any new disclosure that constitutes the inventive matter claimed; if this is not done, the claim may be declared void.¹⁶ But the drawings cannot substitute for a written description. They serve merely to add clearness and certainty to what is actually described.¹⁷

The applicant for a patent must point out particularly, and distinctly claim the process, part, improvement or combination which he claims as his invention or discovery.¹⁸ Any invention or part thereof which he disclosed in the specification but that he does not specifically claim is deemed dedicated to the public.¹⁹

Similarly, there is no patent monopoly obtained for subject matter disclosed in the drawings and not claimed; this also is dedicated to the public when the patent issues.²⁰

It has been held that "the claim is the grant."²¹ Thus, the value of patents depends largely upon the skillful preparation of the specification and claims.²² Difficulty of claiming the inven-

¹³ *Standard Oil Co. of California v. Tide Water Associated Oil Co.*, 154 F. 2d 579 (C. C. A. 3, 1946).

¹⁴ *Universal Oil Products Co. v. Globe Oil & Refining Co.*, 40 F. Supp. 575 (D. C. Ill., 1941), *affd.* 137 F. 2d 3 (C. C. A. 7, 1943), *affd.* 64 S. Ct. 1110, 322 U. S. 471, 88 L. Ed. 1399 (1944).

¹⁵ *Lever Bros. Co. v. Procter & Gamble Mfg. Co.*, 139 F. 2d 633 (C. C. A. 4, 1943).

¹⁶ *Permutit Co. v. Graver Corp.*, 52 S. Ct. 53, 284 U. S. 52, 76 L. Ed. 163 (1931).

¹⁷ *Typewriters Hilliardized v. Corona Typewriter Co.*, 43 F. 2d 961 (C. C. A. 2, 1930).

¹⁸ *United Carbon Co. v. Pinney & Smith Co.*, 63 S. Ct. 165, 317 U. S. 228, 87 L. Ed. 232 (1942).

¹⁹ *Metal Cutting Tool Service v. National Tool Co.*, 103 F. 2d 581 (C. C. A. 6, 1939).

²⁰ *Windle v. Parks & Woolson Machine Co.*, 134 F. 381 (C. C. A. 2, 1904).

²¹ *Ingersoll-Rand Co. v. Westinghouse Electric & Mfg. Co.*, 19 F. Supp. 403 (D. C. Pa., 1936).

²² "The specification and claims of a patent, particularly if the invention be at all complicated, constitute one of the most difficult legal instruments to draw with accuracy and in view of the fact that valuable inventions are often placed in the hands of inexperienced persons to prepare such specification and claims, it is no matter of surprise that the latter frequently fail to describe with requisite certainty the exact invention of the patentee and err either in claiming that which the patentee has not in fact invented, or in omitting some element which was a valuable or essential part of his actual invention." *Topliff v. Topliff*, 145 U. S. 156, 171, 12 S. Ct. 825, 36 L. Ed. 658 (1891).

tion distinctly is no excuse for failure to comply with statutory requirements.²³

Patent Office Procedures

After filing the application, it is the attorney's responsibility to receive the patent office actions and to prepare replies on time.²⁴ Since it is the applicant's responsibility to get an official action from the Patent Office, any default, even though the error of the Patent Office in mailing the action or filing it, will be charged against the applicant, and he will lose his application.²⁵ It is the attorney's duty to write a letter to the patent office inquiring as to the disposition of the case, if he has not received the official action when he believes it should be due.²⁶

The attorney must reply to the first patent office action within six months, unless a shorter period is specified by the examiner; otherwise the application will be considered abandoned.²⁷

Applications are also sometimes held to be abandoned when the applicant or his attorney has purportedly answered the official action, but the answer has not been fully responsive. Thus, if a ground of rejection should be ignored, the examiner would be within his rights in holding the application to have been abandoned by failure to file a responsive amendment within the required period.²⁸

Before an application abandoned by failure to complete or prosecute can be revived as a pending application, it must be shown to the satisfaction of the Commissioner that the delay was unavoidable.²⁹ When an attorney first discovers that an application has become abandoned, he must act promptly in order for a petition to revive the application to be granted. The attorney must show that his system meets certain standards of the Patent Office that are included to guard against applications becoming unintentionally abandoned. An essential part of a system in a patent attorney's office is a periodical inspection of

²³ *In re Ewald*, 117 F. 2d 755 (Cust. & Pat. App.) 28 C. C. P. A. (Patents) 906 (1941).

²⁴ Rule 35, Patent Office Rules of Practice.

²⁵ 35 U. S. C., Sec. 37.

²⁶ 35 U. S. C., Sec. 133.

²⁷ Rules 135 & 136, Patent Office Rules of Practice.

²⁸ Rule 111, Patent Office Rules of Practice.

²⁹ Rule 137, Patent Office Rules of Practice.

all files in the office and the keeping of a docket book of some sort. The patent office keeps a record of the number of inadvertently abandoned applications which each attorney has. Petitions to revive are ordinarily decided on the equities involved; when an attorney makes out a showing that the abandonment was unavoidable and that he has not been lax or careless in living up to his responsibility, the petition will be granted.³⁰

The revival of the application is most important, since the abandonment of an application destroys the continuity of the solicitation of the patent. After abandonment a subsequent application institutes a new and independent proceeding, and the statutory limit on public use or sales which may invalidate the patent issued upon it must be counted from the date of filing of the later application.³¹

Since divisional applications are often required by the Patent Office, to meet the requirement that there be but one invention named and described in each specification,³² the applicant must file the second application before the issuance of the first.³³ It is entirely proper to cover the same disclosure by two or more patents, i.e. one for each species claimed or one for the method and one for the apparatus.³⁴ But, the failure to claim inventions disclosed in an application for a patent is held to constitute abandonment of such invention unless another application covering such claims is pending or is seasonably filed.³⁵

Where two or more applications are co-pending in the Patent Office, the rule is that, when the claims are for separate inventions, "the issuance of the first patent does not abandon the unclaimed matter in its disclosure, the pendency of the second application rebutting any such inference." This is so even though the claims of the second patent do not embody a patentable advance over the earlier disclosures.³⁶

³⁰ Rule 316, Patent Office Rules of Practice.

³¹ *Hayes-Young Tie Plate Co. v. St. Louis Transit Co.*, 137 F. 80 (C. C. A. 8, 1905).

³² *In re Copeman*, 135 F. 2d 349 (Cust. & Pat. App.), 32 C. C. P. A. (Patents) 962 (1943).

³³ *Ex parte Bible*, 70 U. S. Patent Quarterly 370 (1946).

³⁴ *General Tire and Rubber Co. v. Fisk Rubber Corp.*, 104 F. 2d 740 (C. C. A. 6, 1939).

³⁵ *In re Terres*, 150 F. 2d 711 (Cust. & Pat. App.), 32 C. C. P. A. (Patents) 965 (1945).

³⁶ *B. F. Sturtevant Co. v. Massachusetts Hair and Felt Co.*, 122 F. 2d 900 (C. C. A. 1, 1941).

When the examiner rejects all broad claims in an application and feels that no generic claim will be found to be allowable, he requires an election of species. Although the attorney may amend the broad claims in the case, present other broad claims, or argue for the allowance of those already in the case, he must, in order to make his amendment fully responsive, comply with this requirement for an election of species by indicating which species is to be prosecuted in the application to the exclusion of the others in the event no broad claim is found to be allowable.³⁷

If an applicant unqualifiedly acquiesces in the rejection of a claim and the cancellation of narrowing thereof, he evinces an intention to abandon it.³⁸ If the attorney is dissatisfied with the rejection, either of a claim or the entire patent, he should pursue his remedy by appeal, and where, in order to get his patent, he accepts one with a narrower claim, he is bound by it.³⁹

Similarly, when an applicant acquiesces in a rejection of his application and does not appeal, he cannot later recover his application, even though the Patent Office was in error.⁴⁰ Nor is the error of his attorney ground for appeal.⁴¹

The applicant may appeal actions of the Patent Office either to the Court of Customs and Patent Appeals⁴² or to the federal courts,⁴³ if both the examiner and the Board of Appeals⁴⁴ of the Patent Office reject his claims.

Interference Proceedings

Where a pending application interferes with the claims of a patent or another pending application, the Patent Office issues the patent to that applicant who can show prior invention.⁴⁵

The party who first conceived an invention, even though he may be the last to reduce it to practice, is considered to be the

³⁷ Patent Office Order No. 3527, October 24, 1940.

³⁸ *In re Christmass*, 128 F. 2d 596 (Cust. & Pat. App.), 29 C. C. P. A. (Patents) 1037 (1942).

³⁹ *Shepard v. Carrigan*, 6 S. Ct. 493, 116 U. S. 593, 29 L. Ed. 723 (1886).

⁴⁰ *Hastings v. Coe*, 99 F. 2d 129 (App. D. C., 1938).

⁴¹ "The inadvertence of the solicitors of an applicant for a patent is his inadvertence and, on the other hand, their erroneous judgment in submitting to the rejection of claims is his erroneous judgment."

Moneyweight Scale Co. v. Toledo Computing Scale Co., 187 F. 826, 831 (C. C. A. 7, 1911).

⁴² 35 U. S. C., Sec. 141.

⁴³ 35 U. S. C., Sec. 146.

⁴⁴ 35 U. S. C., Sec. 134.

⁴⁵ 35 U. S. C., Sec. 135.

first inventor and is entitled to priority where he has reduced his prior conception to practice with reasonable diligence.⁴⁶ Reduction to practice can be spelled out either by developing a workable model, by successful operation of the method, or by filing of an allowable application for a patent either in this country⁴⁷ or in a foreign country.⁴⁸ However, an abandoned application for a patent may not be relied on as reduction to practice.⁴⁹

An applicant who first files his application for a patent is presumed to be the first inventor, and the burden is on the other party to prove the contrary.⁵⁰ Conversely, an inventor who is first to conceive of an invention but the last to reduce it to practice, has the burden of proving a reduction to practice with reasonable diligence.⁵¹

Where an inventor has placed the control of the invention in the hands of another, the conduct of that person is controlling on the question of diligence.⁵² Thus, the failure to reduce an invention to practice for an unreasonable time after its conception cannot be excused by showing that the inventor merely turned that matter over to his attorney, if, in fact, the attorney in preparing the application and getting into the Patent Office showed inexcusable lack of diligence.⁵³ What constitutes reasonable diligence on the part of the attorney⁵⁴ depends on the facts of the case.⁵⁵

⁴⁶ *Shell Development Co. v. Pierce Oil Co.*, 111 F. Supp. 197 (D. C. D. C., 1953).

⁴⁷ *Automatic Weighing Machine Co. v. Pneumatic Scale Corp.*, 166 F. 288 (C. C. A. 8, 1909).

⁴⁸ *Texas Co. v. Globe Oil and Refinery Co.*, 112 F. Supp. 455 (D. C. Ill., 1953), *affd.* 225 F. 2d 725 (C. C. A. 7, 1955).

⁴⁹ *Fessenden v. Wilson*, 48 F. 2d 422 (Cust. & Pat. App.), 18 C. C. P. A. (Patents) 1171 (1931).

⁵⁰ "As between co-pending applications, respective filing dates fix the respective date of invention in the absence of other evidence."

Dinuba Steel Products Corp. v. Killefer Mfg. Corp., 56 F. 2d 848, 850 (D. C. Cal., 1932).

⁵¹ *Hanna v. Venetian Blind Corp.*, 111 F. 2d 455 (C. C. A. 9, 1940).

⁵² *Wilson v. Goldmark*, 172 F. 2d 575 (Cust. & Pat. App.), 36 C. C. P. A. (Patents) 849 (1949).

⁵³ *Scharman v. Kissel*, 179 F. 2d 991 (Cust. & Pat. App.), 37 C. C. P. A. (Patents) 903 (1950).

⁵⁴ Lack of diligence held shown in *Fearon v. Krasnow*, 172 F. 2d 233 (Cust. & Pat. App.) 36 C. C. P. A. (Patents) 785 (1949).

⁵⁵ "In determining whether an inventor was diligent in reducing an invention to practice, it may be presumed that work performed by the patent attorney on dockets bearing lower numbers than the number of inventor's application was on cases assigned to him prior to receipt of inventor's application and that work performed on dockets bearing higher numbers was on cases subsequently assigned." *Beam v. Parton*, 102 F. 2d 193, 198 (Cust. & Pat. App.), 26 C. C. P. A. (Patents) 889 (1939).

In interference or infringement proceedings, it often becomes necessary to define the precise limit of the claims in a patent which has already issued or which is pending. There are several general rules which are followed:

For example, if the language is ambiguous, the claim will be interpreted in the light of the application or patent from which it originated, if at all possible.⁵⁶

Also, elements or limitations which are not clearly included in a claim will not ordinarily be read into the claim.⁵⁷

Conversely, elements or limitations which are positively included in a claim will not ordinarily be disregarded or ignored.⁵⁸

A further restriction on the last two rules is that elements or limitations specifically included in a claim during proceedings in the Patent Office, as shown by the File Wrapper, are strictly construed, and the patentee is estopped from contending that these limitations should be construed more broadly.⁵⁹

Thus, a competent attorney who is mindful of the rights of the inventor is careful to prevent the development of anything in the file history of the case which later might be used as an estoppel to the detriment of his client's rights. A good attorney will not carelessly cancel claims, enter needless amendments, or introduce broad claims, particularly when such claims are certain to be rejected on prior art references.

In summary, there are numerous cases in which an attorney's negligence or incompetence has caused a patentee to lose some of his rights under the law, but very few in which a patent attorney has actually been sued for malpractice.

⁵⁶ *Nerney v. New York, N. H. & N. H. R. Co.*, 6 F. Supp. 554 (D. C. Conn., 1934).

⁵⁷ *Martin v. Friendly*, 58 F. 2d 421 (Cust. & Pat. App.), 19 C. C. P. A. (Patents) 1181 (1932).

⁵⁸ *In re Sameran*, 86 F. 2d 756 (Cust. & Pat. App.), 24 C. C. P. A. (Patents) 775 (1936).

⁵⁹ *Penn Electrical & Mfg. Co. v. Conroy*, 199 F. 427 (C. C. A. 3, 1912).