Frasch Vs. Moore

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Decided On : Oct-19-1908

Appeal No. : 211 U.S. 1

Appellant : Frasch

Respondent : Moore

Judgement :

Frasch v. Moore - 211 U.S. 1 (1908)
U.S. Supreme Court Frasch v. Moore, 211 U.S. 1 (1908)

Frasch v. Moore

No. 14

Argued April 23, 24, 1908

Decided October 19, 1908

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APPEAL FROM AND IN ERROR TO THE COURT

OF APPEALS OF THE DISTRICT OF COLUMBIA

SYLLABUS

A decision of the Court of Appeals of the District of Columbia in an appeal from the Commissioner of Patents under Rev.Stat. 4914, 4915, 9 of the Act of February 9, 1893, c. 74, 27 Stat. 434, and 780, Rev.Stat., District of Columbia, is interlocutory and not final, and is not reviewable by this Court under 8 of the Act of February 9, 1893, either by appeal or writ of error. *Rousseau v. Browne,* 21 App.D.C. 73, approved. ,

Appeal from and writ of error to review, 27 App.D.C. 25, dismissed.

Frasch applied for a patent for an invention of a new and useful improvement in the art of making salt by evaporation of brine. He expressed his alleged invention in six claims, three of which were for the process of removing incrustation of calcium sulphate from brine-heating surfaces, and three of them were for an apparatus for use in the process.

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At the time when the application was fired, Rule 41 of the Patent Office did not permit the joinder of claims for process and claims for apparatus in one and the same application. The examiner required division between the process and apparatus claims, and refused to act upon the merits. An appeal was taken to the examiners in chief, but the examiner refused to forward it. A petition was then filed asking the Commissioner of Patents to direct that the appeal be heard. The Commissioner held that the examiner was right in refusing to forward the appeal. From that decision appeal was taken to the Court of Appeals of the District, which held that it did not have jurisdiction to entertain it. Frasch then filed a petition in this Court for a mandamus directing the Court of Appeals to hear and determine the appeal, which petition was dismissed. *Ex Parte Frasch,* 192 U. S. 566 .

But in *United States ex Rel. Steinmetz v. Allen,* 192 U. S. 543 , it was held that Rule 41, as applied by the Commissioner, was invalid, and that the remedy for his action was by mandamus in the Supreme Court of the District to compel the

Commissioner to act. Accordingly, the proceedings in the present case were resumed in the Patent Office, and the applicant asked the Commissioner to direct that the appeal theretofore taken to the examiners in chief be heard by them. The Commissioner granted this petition. The primary examiner furnished the required statement and a supplementary statement of the grounds of his decision requiring division. The examiners in chief affirmed the decision of the primary examiner "requiring a division of these claims for an art and for an independent machine used to perform the art;" one examiner in chief, dissenting, held that division should not be required. On appeal to the Commissioner, he affirmed the examiners in chief in part only -- that is to say, he held that Process Claim No. 1 must be divided from the other process claims and the apparatus claims, but that Process Claims Nos. 2 and 3 and the Apparatus Claims Nos. 4, 5, and 6 might be joined in one application. Rehearing was denied, and an appeal was taken to the Court of Appeals for

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the District of Columbia, which affirmed the decision of the Commissioner of Patents for reasons given at large in an opinion, and directed the clerk of the court to "certify this opinion and proceedings in this Court in the premises to the Commissioner of Patents, according to law."

An appeal and a writ of error were allowed, the court stating through Mr. Chief Justice Shepard:

"We are inclined to the view that this case is not appealable to the Supreme Court of the United States, but, as the question has never been directly decided, so far as we are advised, we will grant the petition in order that the question of the right to appeal in such a case may be directly presented for the determination of the court of last resort."

The record was filed January 25, 1907, and on February 4 a petition for certiorari.

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MR. CHIEF JUSTICE FULLER delivered the opinion of the Court.

Section 8 of the Act of February 9, 1893, 27 Stat. 434, 436, c. 74, provides:

"That any final judgment or decree of the said Court of Appeals may be reexamined and affirmed, reversed, or modified by the Supreme Court of the United States, upon writ of error or appeal, in all causes in which the matter in dispute, exclusive of costs, shall exceed the sum of five thousand dollars, in the same manner and under the same regulations as heretofore provided for in cases of writs of error on judgment or appeals from decrees rendered in the Supreme Court of the District of Columbia, and also in cases, without regard to the sum or value of the matter in dispute, wherein is involved the validity of any patent or copyright, or in which is drawn in question the validity of a treaty or statute of or an authority exercised under the United States."

The decision of the Court of Appeals sought to be reviewed in the present case is not final, but merely ended an interlocutory stage of the controversy, and sent the applicant back to the Patent Office to conform to the meaning and effect of the rule on division of claims as construed by the Commissioner of Patents, and to pursue the application in the form required to allowance or rejection.

Section 780 of the Revised Statutes of the District of Columbia reads thus:

"The Supreme Court, sitting in banc, shall have jurisdiction of and shall hear and determine all appeals from the decisions of the Commissioner of Patents in accordance with the provisions of sections forty-nine hundred and eleven to section forty-nine hundred and fifteen, inclusive, of Chapter one, Title LX, of the Revised Statutes, 'Patents, Trademarks, and Copyrights.' "

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Section 9 of the "Act to Establish a Court of Appeals for the District of Columbia, and for Other Purposes," approved February 9, 1893, 27 Stat. 434, 436, c. 74, is:

"SEC. 9. That the determination of appeals from the decision of the Commissioner of Patents, now vested in the general term of the Supreme Court of the District of

Columbia, in pursuance of the provisions of section seven hundred and eighty of the Revised Statutes of the United States, relating to the District of Columbia, shall hereafter be, and the same is hereby, vested in the Court of Appeals created by this act, and, in addition, any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said Court of Appeals."

Thus, the special jurisdiction of the District Supreme Court in patent appeals was transferred to and vested in the Court of Appeals, and decisions in interference cases were also made appealable, which had not been previously the case. Rev.Stat. 4911. The law applicable is 4914, Revised Statutes, which provides:

"The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the Commissioner at such early and convenient time as the court may appoint, and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case, the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question."

By 4915, a remedy by bill in equity is given where a patent is refused, and reads as follows:

"SEC. 4915. Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme

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Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity, and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case

may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases where there is no opposing party, a copy of the bill shall be served on the Commissioner, and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not."

The final decision referred to is obviously the judicial decision on the bill in equity, while in interference cases and in all others going up from the Commissioner to the Court of Appeals there is no final judgment in the cause, but one interlocutory in its nature, and binding only upon the Commissioner, "to govern the further proceedings in the case." The opinion or decision of the court, reviewing the Commissioner's decision, is not final, because it does not preclude any person interested from contesting the validity of the patent in court; and, if the decision of the Commissioner grants the patent, that is the end of the matter as between the government and the applicant, and if he refuses it, and the Court of Appeals sustains him, that is merely a qualified finality, for, as we have seen, the decision of that court may be challenged generally and a refusal of patent may be reviewed and contested by bill as provided.

The appeal given to the Court of Appeals of the District from the decision of the Commissioner is not, as Mr. Justice Matthews said in *Butterworth v. United States,*

"the exercise of ordinary jurisdiction at law or in equity on the part of that court, but is one step in the statutory proceeding under

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the patent laws whereby that tribunal is interposed in aid of the Patent Office, though not subject to it. Its adjudication, though not binding upon any who choose, by litigation in courts of general jurisdiction, to question the validity of any patent thus awarded, is nevertheless conclusive upon the Patent Office itself; for, as the statute declares (Rev.Stat. 4914), it 'shall govern the further proceedings in the

case.'"

In *Rousseau v. Brown,* 21 App.D.C. 73, 80, which was an appeal from the Patent Office in the matter of an interference between two applications, the court affirmed the decision of the Commissioner of Patents, ruling against one of the claims on the ground that, priority of invention must be awarded to the other claimant, declined to allow a writ of error or appeal, and said, through Chief Justice Alvey:

"There is no final judgment of this Court rendered in such cases, nor is there any such judgment required or authorized to be rendered, not even for costs of the appeal. This court is simply required in such cases, after hearing and deciding the points as presented, instead of entering judgment here, to return to the Commissioner of Patents a certificate of the proceedings and decision of this court, to be entered of record in the Patent Office, to govern the further proceedings in the case. But it is declared by the statute that no opinion of this court in any such case shall preclude any person interested from the right to contest the validity of any patent that may be granted by the Commissioner of Patents. Rev.Stat. 780, 4914."

"There is no provision of any statute, within our knowledge, that authorizes a writ of error or an appeal to the Supreme Court of the United States in such case as the present. It would seem clear that the case is not within the purview of 8 of the Act of Congress of February 9, 1893, providing for the establishment of this Court. That section only applies to cases where final judgments by this court have been entered, and not to decisions to be made and certified to the Patent Office under the special directions of the statute. "

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We consider these observations as applicable to the present case, and the result is

Appeal and writ of error dismissed, and certiorari denied.

MR. JUSTICE WHITE and MR. JUSTICE Mc KENNA dissent.

MR. JUSTICE MOODY did not sit.