Chapman Vs. Wintroath

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Appeal No. : 252 U.S. 126

Appellant : Chapman

Respondent : Wintroath

Judgement :

Chapman v. Wintroath - 252 U.S. 126 (1920)
U.S. Supreme Court Chapman v. Wintroath, 252 U.S. 126 (1920)

Chapman v. Wintroath

No. 117

Argued January 9, 1920

Decided March 1, 1920

252 U.S. 126

CERTIORARI TO THE COURT OF APPEALS

OF THE DISTRICT OF COLUMBIA

SYLLABUS

An inventor whose application disclosed, but did not claim, an invention which is later patented to another is allowed by the patent law two years after such patent issues within which to file a second or divisional application claiming the invention, and this period may not be restricted by the courts upon the ground that so much delay may be prejudicial to public or private interests. P. 252 U. S. 134 . Rev.Stats. 4886.

Such a second application is not to be regarded as an amendment to the original application and, so subject to the one-year limitation of Rev.Stats. 4894. P. 252 U. S. 138 .

Nor can the right to make it be deemed lost by laches or abandonment merely because of a delay not exceeding the two years allowed by the statute. P. 252 U. S. 139 .

47 App.D.C. 428 reversed.

The case is stated in the opinion.

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MR. JUSTICE CLARKE delivered the opinion of the Court.

In 1909, Mathew T. Chapman and Mark C. Chapman filed an application for a patent on an "improvement in deep well pumps." The mechanism involved was complicated, the specification intricate and long, and the claims numbered 34. The application met with unusual difficulties in the Patent Office, and, although it had been regularly prosecuted, as required by law and the rules of the Office, it was still pending without having been passed to patent in 1915, when the controversy in this case arose.

In 1912, John A. Wintroath filed an application for a patent on "new and useful improvements in well mechanism," which was also elaborate and intricate, with 12

combination claims, but a patent was issued upon it on November 25, 1913.

Almost 20 months later, on June 6, 1915, the Chapmans filed a divisional application, in which the claims of the Wintroath patent were copied and on this application such proceedings were had in the Patent Office that, on March 24, 1916, an interference was declared between it and the Wintroath patent.

The interference proceeding related to the combination of a fluid-operated bearing supporting a downwardly extending shaft, and auxiliary bearing means for sustaining any resultant downward or upward thrust of such shaft. It is sufficiently described in Count 3 of the notice of interference:

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"3. In deep well pumping mechanism, the combination with pump means including a pump casing located beneath the surface of the earth and rotary impeller means in said casing, of a downwardly extending power shaft driven from above and adapted to drive said impeller means, a fluid operated bearing cooperating to support said shaft, said fluid operated bearing being located substantially at the top of said shaft so that the shaft depends from the fluid bearing, and by its own weight tends to draw itself into a substantially straight vertical line, means for supplying fluid under pressure to said fluid bearing independently of the action of the pump means, auxiliary bearing means for sustaining any resultant downward thrust of said power shaft, and auxiliary bearing means for sustaining any resultant upward thrust of said power shaft."

Wintroath admits that the invention thus in issue was clearly disclosed in the parent application of the Chapmans, but he contends that their divisional application claiming the discovery should be denied because of their delay of nearly 20 months in filing, after the publication of his patent, and the Chapmans, while asserting that their parent application fully disclosed the invention involved, admit that the combination of the Wintroath patent was not specifically claimed in it.

Pursuant to notice and the rules of the Patent Office, Wintroath, on April 27, 1916, filed a statement declaring that he conceived the invention contained in the claims of his patent "on or about the first of October, 1910," and thereupon, because this date was subsequent to the Chapman filing date, March 10, 1909, the Examiner of Interferences notified him that judgment on the record would be entered against him unless he showed cause within 30 days why such action should not be taken.

Within the rule day, Wintroath filed a motion for judgment in his favor "on the record," claiming that conduct on the part of the Chapmans was shown which estopped

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them from making the claims involved in the interference and which amounted to an abandonment of any rights in respect thereto which they may once have had. The Chapmans contended that such a motion for judgment could not properly be allowed "until an opportunity had been granted for the introduction of evidence." But the Examiner of Interferences, without hearing evidence, entered judgment on the record in favor of Wintroath, and awarded priority to him on the ground that the failure of the Chapmans to make claims corresponding to the interference issue for more than one year after the date of the patent to Wintroath constituted equitable laches which estopped them from successfully making such claims. This holding, based on the earlier decision by the court of appeals in *Rowntree v. Sloan,* 45 App.D.C. 207, was affirmed by the Examiner in Chief, but was reversed by the Commissioner of Patents, whose decision, in turn, was reversed by the court of appeals in the judgment which we are reviewing.

In its decision, the court of appeals holds that an inventor whose parent application discloses, but does not claim, an invention which conflicts with that of a later unexpired patent may file a second application making conflicting claims in order to have the question of priority of invention between the two determined in an interference proceeding, but only within one year from the date of the patent, and that longer delay in filing constitutes equitable laches which bars the later application. By this holding, the court substitutes a one-year rule for a two-year

rule which had prevailed in the Patent Office for many years before the *Rowntree* decision, rendered in 1916, and the principal reason given for this important change is that the second application should be regarded as substantially an amendment to the parent application, and that it would be inequitable to permit a longer time for filing it than the one year allowed by Rev.Stats.

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4894, for further prosecution of an application after office action thereon.

The question presented for decision is, whether this conclusion is justifiable and sound, and the answer must be found in the statutes and rules of the Patent Office, made pursuant to statute, prescribing the action necessary to be taken in order to obtain a patent, for the whole subject is one of statutory origin and regulation.

The statute, which is fundamental to all others in our patent law (Rev.Stats. 4886, as amended March 3, 1897, 29 Stat. 692, c. 391), provides with respect to the effect of a United States patent upon the filing of a subsequent application for a patent on the same discovery, which is all we are concerned with here, that any discoverer of a patentable invention, not known or used by others in this country before his invention or discovery, may file an application for a patent upon it at any time within two years after it may have been patented in this country. Such a prior patent is in no sense a bar to the granting of a second patent for the same invention to an earlier inventor, provided that his application is filed not more than two years after the date of the conflicting patent. The applicant may not be able to prove that he was the first inventor, but the statute gives him two years in which to claim that he was, and in which to secure the institution of an interference proceeding in which the issue of priority between himself and the patentee may be determined in a prescribed manner.

This section, unless it has been modified by other statutes or in effect by decisions of the courts, is plainly not reconcilable with the decision of the court of appeals, and should rule it. Has it been so modified?

The section of the Revised Statutes dealing with inventions previously patented in a foreign country (Rev.Stats. 4887, as amended March 3, 1903, 32 Stat. 1225), provides that no patent shall be granted on an

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application for a patent if the invention has been patented in this or any foreign country more than two years before the date of the actual filing of the application in this country.

Section 4897 of the Revised Statutes (16 Stat. 202, c. 230, 35), in dealing with the renewal of an application in case of failure to pay the final fee within six months of notice that a patent has been allowed, provides that another application may be made for the invention, "the same as in the case of an original application." But such application must be made within two years after the allowance of the original application.

And in Rev.Stats. 4920, providing for pleadings and proofs in infringement suits, it is provided that, when properly pleaded and noticed, the defendant may prove in defense that the patent declared on had been patented prior to the plaintiff's supposed invention "or more than two years prior to his application for a patent therefor," and also that the subject matter of the patent "had been in public use or on sale in this country for *more than two years* before the plaintiff's application for a patent."

Thus, through all of these statutes runs the time limit of two years for the filing of an application, there is no modification in any of them of the like provision in Rev.Stats. 4886, as amended, and no distinction is made between an original and a later or a divisional application with respect to this filing right.

A brief reference to the decisions will show that, until the *Rowntree* case, the courts had left the filing right under Rev.Stats. 4886, as untouched as the statutes thus had left it.

There is no suggestion in the record that the original application of the Chapmans was not prosecuted strictly as required by the statutes and the rules of the Patent Office, and therefore it is settled their rights may not be denied or diminished on the ground that such delay may

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have been prejudicial to either public or private interests.

"A party seeking a right under the patent statutes may avail himself of all their provisions, and the courts may not deny him the benefit of a single one. These are questions not of natural, but of purely statutory, right. Congress, instead of fixing seventeen, had the power to fix thirty years as the life of a patent. No court can disregard any statutory provisions in respect to these matters on the ground that, in its judgment, they were unwise or prejudicial to the interests of the public."

United States v. American Bell Telephone Co., 167 U. S. 224 , 167 U. S. 247 .

In reissue cases, where there was no statutory time prescribed for the making of an application for the correction of a patent, and although unusual diligence is required in such cases, this Court adopted the two-year rule as reasonable by analogy to the law of public use before an application for a patent. *Mahn v. Harwood,* 112 U. S. 354 , 112 U. S. 363 ; *Wollensak v. Reiher,* 115 U. S. 96 , 115 U. S. 101 .

To this we must add that not only have later or divisional applications not been dealt with in a hostile spirit by the courts, but, on the contrary, designed as they are to secure the patent to the first discoverer, they have been favored to the extent that, where an invention clearly disclosed in an application, as in this case, is not claimed therein, but is subsequently claimed in another application, the original will be deemed a constructive reduction of the invention to practice and the later one will be given the filing date of the earlier, with all of its priority of right. *Smith & Griggs Manufacturing Co. v. Sprague,* 123 U. S. 249 , 123 U. S. 250 ; *Von Recklinghausen v. Dempster,* 34 App.D.C. 474, 476-477.

These, a few from many, suffice to show that, prior to the *Rowntree* case, the decisions did not tend to modification of the statutory two-year rule.

The court of appeals recognizes all this law as applicable to an original application, but it finds warrant for

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cutting the time limit to one year in the case of later applications in three reasons, *viz.,* because it is inequitable to allow so long a time as two years for filing a new application, claiming a discovery for which a patent has issued, because such a time allowance is contrary to public policy, as unduly extending the patent monopoly if the new application should prevail, and, finally and chiefly, as we have pointed out, because, regarding such a later application as substantially an amendment to the original application, the court discovers, in analogy to the time allowed by statute for amendment to applications (Rev.Stats. 4894), a reason for holding that the failure for more than one year to make a later, in this case a divisional, application, amounts to fatal laches.

However meritorious the first two of these grounds may seem to be, they cannot prevail against the provisions of the statutes (*United States v. American Bell Telephone Co., supra*), and the third does not seem to us persuasive because of the difference in the kind of notice which is given to the applicant cant under Rev.Stats. 4894 and that given him when a patent is issued conflicting with his application.

The one-year provision of Rev.Stats. 4894, as amended March 3, 1897, c. 391, 29 Stat. 693, is that an applicant for a patent who shall fail to prosecute his application within one year after Patent Office action thereon, "of which notice shall have been given" him, shall be regarded as having abandoned his application unless the Commissioner of Patents shall be satisfied that such delay was unavoidable. But when a conflict between inventions disclosed in applications escapes the attention of the Patent Office Examiners, Rev.Stats. 4904, and a patent is issued, with claims conflicting with the disclosures of a pending

application, the applicant receives only such notice of the conflict as he is presumed to derive from the publication of the patent. In the one case. the notice

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is actual and specific, in the other, it is indefinite and constructive only. When the great number of patents constantly being issued is considered, many of them of a voluminous and complicated character, such as we have in this case, with many and variously worded claims, such an implied notice must necessarily be precarious and indefinite to a degree which may well have been thought to be a sufficient justification for allowing the longer two-year period to inventors who must, at their peril, derive from such notice their knowledge of any conflict with their applications.

As has been pointed out, the Examiner of Interferences did not permit the introduction of any evidence with respect to laches or abandonment, and the court of appeals rests its judgment, as he did, wholly upon the delay of the Chapmans in filing their divisional application for more than one year after the Wintroath patent was issued, as this appeared "on the face of the record." While not intending to intimate that there may not be abandonment which might bar an application within the two-year period allowed for filing, yet, upon this discussion of the statutes and decisions, we cannot doubt that, upon the case disclosed in this record, the Chapmans were within their legal rights in filing their divisional application at any time within two years after the publication of the Wintroath patent, and therefore the judgment of the court of appeals must be

Reversed.

MR. JUSTICE Mc REYNOLDS dissents.