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Appendix 3

The American Patent System

America's patent laws and practices were a crucial feature of the world within which Edison the inventor matured. The U.S. Patent Office administered these laws and collected fees from inventors in order to meet its operating expenses. These fees, quite modest in comparison with their British counterparts, made U.S. patents accessible to many inventors. American patents provided inventors with exclusive ownership of their creations for seventeen years. In return, inventors had to disclose to the public the details of their invention. The patent system, established under the U.S. Constitution, was intended to provide economic incentive for the inventor, who could assign all or partial rights in a patent to other individuals or companies. Inventors frequently sold their patent rights for a flat sum or in exchange for royalty payments. Some also obtained financial support for past or ongoing inventive activity or for help in establishing businesses to exploit their inventions.

To obtain a patent, the inventor submitted to the U.S. Patent Office an application consisting of a proper specification, carefully measured drawings, and, in most cases, a physical model of the invention. The application required careful preparation so that it clearly stated its claims and described the invention and how it worked. After the inventor submitted the application, an official examiner scrutinized it and determined whether the description and claims were satisfactory. If the examiner concluded that the application was acceptable and that the invention was new, useful, and unknown prior to the time of submission, a patent could be issued. If an application was rejected, the inventor could amend the written description or the claims but not the drawings or model. Such amendments were allowed in order to make the application clearer or to make the claims more precise or narrow. The cycle of rejection and amendment could involve...
many rounds and take many years before the patent was issued or the application was abandoned.

If two or more persons submitted applications for substantially the same invention, the Patent Office issued the patent to the inventor with the best claim to priority. This often made inventive activity much like a race, particularly when others were known to be working on the same problem. It also placed a premium on careful record-keeping and secrecy. To establish priority, inventors at this time often submitted caveats to the Patent Office. Caveats were preliminary applications in which the inventor made claims to one or more potential inventions without presenting the detail required in a formal application. The Patent Office noted the subject matter of the caveat and placed it in a confidential archive. If within one year another inventor filed an application on a similar process or device, the Patent Office notified the holder of the caveat, who then had three months to submit a formal application.4

When two or more inventors submitted similar patent applications or when one inventor submitted an application for an invention that had already been patented by another, these applications and patents were declared in interference with each other. The Patent Office then held a quasi-judicial hearing before the examiner of interferences to determine which inventor had priority. The proceedings often included depositions, testimony, exhibits, and arguments. The inventor could appeal the decision of the examiner first to the commissioner of patents and then to a federal court in the District of Columbia. The Patent Office could not rescind an issued patent, but it could issue a patent for the same invention to a second inventor who established priority. The issuance of a patent did not, therefore, provide the inventor with a definitive claim. Economically significant patents were often challenged in court on grounds of priority, novelty, and ownership.

Many inventors turned to professional patent solicitors and agencies to ensure the cogency of their claims in applications and to defend their patents in interference proceedings. Because any "person of intelligence or good moral character" could appear as a patent attorney, many mid-nineteenth-century patent solicitors had no formal legal training. Commonly they had some technical training and had made a study of the patent laws and procedures. For example, Franklin Pope, a telegraph engineer and inventor who was associated briefly with Edison, served as a patent expert for the Western Union Telegraph Company and then established his own practice as a patent attorney. Only attorneys admitted to the bar, however, could bring suit in the federal courts regarding infringement or ownership of a patent, and a number of such attorneys specialized in patent law.

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General and specialized technical journals of the day publicized and promoted the patent system. Patent solicitors also helped educate inventors about the system. Munn & Company, the nation’s largest patent agency, published the *Scientific American*. This popular mechanics’ magazine featured news of the Patent Office and promoted inventions. Likewise, many other technical journals presented articles about the Patent Office and patent law, editorialized about needed reforms, and published information about the latest patents issued. Munn & Company also published several editions of its handbook on patent law with instructions for obtaining patents. Other patent solicitors also published such guides and some acted as propagandists for the patent system through speeches and articles.\(^5\)

When describing the patent system’s contribution to American progress, nineteenth-century advocates usually pointed to major inventions such as Samuel Morse’s telegraph, Cyrus McCormick’s reaper, and Elias Howe’s sewing machine. Most patents and inventions, however, represented improvements or variations of existing technologies. Some of these later became as essential to an industry as the patent that gave it birth. Improvements often allowed a technology to develop in new ways or made its use more profitable. An important improvement provided competitive advantages to the firm that controlled the patent and, in a few cases, even prevented competition by denying use of an essential invention. While a patented variation might not improve the operation of a technology, the firm already possessing key patents for a technology might use it to prevent someone else from patenting or using an alternative method not embodied in those patents. Such noncompetitive use of patents received little public attention until late in the century, when large firms gained increasing power in American society. As firms competed for larger market shares, control not only of inventions but of the inventors themselves often became an important strategy. As a telegraph inventor, Edison became a central figure in telegraph competition involving Western Union.

1. This account of U.S. patent law and practice is derived from Munn & Co. 1878, which includes copies of the patent laws from 1836 to 1870; and U.S. Patent Office 1875.

2. The 1861 Patent Act set fees that remained in force for several decades. These included $15 for filing an application, $10 for filing a caveat, and $20 for issuing a patent. Additional fees were collected during interference proceedings, when recording an assignment, or for design patents. Prior to 1852 the fee for a patent for the entire United Kingdom cost a minimum of £310. In that year, the fee was reduced to £25, but renewal fees of £50 after three years and £100 after seven years were required to keep the patent in force for the full term allowed. Munn & Co. 1876, 76; Davenport 1979, 57–58.
3. When a model could illustrate an invention, the Patent Office re-
quired the inventor to submit one. The growing number of electrical and
chemical patents precipitated the dropping of this requirement about
1880, however. Ferguson and Baer 1979, 11; U.S. Patent Office 1880,
13.

4. A caveat could be renewed annually. The caveat procedure fell into
disuse during the late nineteenth century, and Congress abolished it in
1910. Curtis 1873, 332–33; Deller 1937, 977.

5. On Munn & Co. see Borut 1977. An early guide was Phillips 1837.
Henry Howson, a Philadelphia solicitor, served on the U.S. Patent As-
sociation's Committee on Publication and published several pamphlets
on the patent system. See, for example, Howson 1871, 1874, and 1878.