

Dewey & Almy Chemical Co. v. Mimex Co., Inc., 124 F 2d 986 (1942)
(U.S. Court of Appeals for the Second Circuit)

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Summary

The United States Court of Appeals for the Second Circuit (hereinafter: the Court) held that a prior art to be an anticipation must bear within its four corners adequate directions for the practice of the patent. If the earlier disclosure offers no more than a starting point for further experiments, if its teaching will sometimes succeed and sometimes fail, if it does not inform the art without more how to practice the new invention, it has not correspondingly enriched the store of common knowledge, and it is not an anticipation.

The facts

The plaintiff has two patents: the first referred as the "Latex Patent"¹ and the second patent referred as the "Bentonite Patent."² The Latex Patent describes a cover with a circular groove or recess filled with latex which, when pressed upon a circular ridge in the top of the can, forms an airtight seal. This invention could not be applied to seal cans while the cover was rotating at high speed. The Bentonite Patent was proposed to cure the defects of the Latex patent, with a "sealing composition" of which latex was the base, but which also contained a gum and a hydrophilic colloid associated with a finely powdered mineral. The gum is intended to give viscosity, and the colloid and mineral to give plasticity to the latex. The plaintiffs sued defendant, Mimex, alleging contributory infringement of the "Latex Patent" and direct infringement of the "Bentonite Patent". The lower court held both patents invalid for anticipation by prior art. The Court agreed in respect of the "Latex" patent but disagreed as to the "Bentonite patent" and reversed the lower court in that regard.

The Legal Issues

The Court had to decide whether the "Latex" and the "Bentonite patent" were anticipated by prior art.

The "Latex Patent"

The Court developed its reasoning as follows.³

"Latex is a watery substance in which the rubber particles float in colloid form; the advantage of using it lies in its concentration while retaining the elasticity of the rubber. The substance had been known for many years; patents for its use go back for over a hundred years; e. g. Hancock's British Patent (1825) No. 5122. Nevertheless, it had not become commercially available in quantity (for it did not carry well except in expensive containers) until Milne disclosed in 1914 a method of shipping it cheaply as a concentrate. (British Patent to Samuel Milne (1914) No. 24,680.). The Milne patent disclosed that

¹ Patent No. 1,582,219, issued on April 27, 1926, to Hopkinson and Dewey.

² Patent No. 1,765,134, issued on June 17, 1930, to Dewey and Crocker.

³ See at <https://law.justia.com/cases/federal/appellate-courts/F2/124/986/1506575/>

‘The concentrated latex, preferably while hot, is placed in suitable air and watertight vessels of convenient shape or construction, the joints being sealed, if necessary, by a coating or lining of latex which on drying ensures tightness.’

Milne’s patent, in addition to recognizing that the latex might be treated with any suitable preservative to prevent decay, also suggests that latex could be used as a sealing agent. With Milne’s invention, latex went into large industrial use in Europe, but it was not extensively imported into this country before 1920, by which time new ways of preserving it had been discovered. There is therefore not much antecedent evidence that the invention disclosed in the Latex Patent demanded high originality, even if latex had never before been used to make a seal. As we have said rubber was an old material for that purpose, and latex is only another form of rubber; the patent merely recommended its use as a substitute within a year or two after it became possible to obtain it. We do not mean that the mere substitution of materials cannot be an invention. When for example a material has been available for many years, and no one has thought to use it in a new physical combination to answer a need equally old, there is as much reason for treating its selection as evidence of invention as the selection of any other element. The difficulty in the case at bar is that the necessary setting did not exist for any invention at all. We should not count elements that were not commercially available; a substance, long known to chemists, but not upon the market, is practically as impotent upon the art as though it were unknown. The invention of the "Latex Patent" therefore **amounted to no more than making use of Milne's disclosure** upon can covers about one year after it became commercially possible to do so. That would scarcely have been enough, even if the new use had answered the needs of the industry. As we have said, it did not; it was indeed one step forward, but the art was not satisfied.” (emphasis added)

The Court therefore considered the “Latex patent” as anticipated by prior art and invalid for lack of novelty.

The "Bentonite Patent"

In this respect the Court advanced the following arguments.

“The "Latex Patent" did not go into use as it stood; some way had to be found to stiffen the latex enough to withstand the centrifugal force of rotation. The "Bentonite Patent" added a gum as a "thickening agent" and a new substance called "bentonite," which allows the latex to maintain its liquid status until it is applied to seal a can. Although the bentonite mineral itself was apparently known by other names as early as 1905, it was not until 1915 or 1916 that it was much discussed in chemical publications, and it did not come upon the market in quantity until about 1919. By that time, it had already become known as a "plastic" agent and that its power to absorb water made it valuable in rendering clay more easily workable. The use of bentonite as plastic agent was very far from suggesting its use for sealing purpose and the prior art did not disclose use in conjunction with latex.

The defendant relies chiefly upon Newton's British patent of 1855 (No. 1053) to challenge the bentonite patent. Newton's patent claims the use of latex as a vehicle for fastening upon fabrics pigments employed for colouring, painting, and printing. He suggested mixing the latex with milk or any other albuminous substances, such as the white of eggs, but not gums, to achieve consistency. Newton ruled out using gums "as thickeners" as gums would be "washed out" before the colour could set. The defendant argued that if the pigments of which Newton spoke are thoroughly mixed with gums, the equivalent of "bentonite" will result. This when used with latex, as Newton recommended, becomes a complete reproduction of the patented 'sealing composition'."

On anticipation, the Court stated that

"No doctrine of the patent law is better established than that a prior patent or other publication to be an anticipation must bear within its four corners adequate directions for the practice of the patent invalidated. If the earlier disclosure offers no more than a starting point for further experiments, if its teaching will sometimes succeed and sometimes fail, if it does not inform the art without more how to practice the new invention, it has not correspondingly enriched the store of common knowledge, and it is not an anticipation."

Testing this doctrine, the Court stated that Newton's disclosure was inadequate. Although Newton was not concerned with making a "sealing composition," if his process would have uniformly resulted in the patented seal, it would have been an appropriate anticipation. But Newton never disclosed the seal composition as a target. He instructed to grind the pigments "sufficiently fine" in an indigo mill". "Sufficient for what?" inquired the Court:

"'Sufficiently' only to 'print or stain' fabrics; which gave not the slightest inkling to the invention claimed in the patent, the meaning of which nobody in 1855 could even faintly have comprehended. Again, instead of directing practitioners of his method to mix gum and pigment, Newton told them to avoid gums. Indeed, the whole purpose of the invention was "to remedy this"; so that, instead of prescribing the method to make a synthetic "bentonite," Newton pointed in directly the opposite direction."

The Court went on that event after disregarding Newton's suggestion to avoid gums, one may only occasionally get the "sealing composition" of Dewey and Crocker.

"For the foregoing reasons it seems to us that the claims are valid. The invention has had a most exceptional success; the business of one of the plaintiffs, which had been threatened with extinction by the paper gasket, has become stable; its sales have risen to several millions a year."

The Court consequently considered the "Bentonite patent" as not anticipated by prior art and therefore novel and valid.

Points of significance:

- An invention is new if it is not anticipated by the prior art. "Prior art" is, in general, all the knowledge that existed prior to the relevant filing or priority date of a patent application, in some countries even by way of oral disclosure.
- Anticipation requires an "enabling disclosure" such that the prior art enables a person skilled in the art to put the claimed invention into effect. The policy stated by the Court in the case at hand was, *inter alia*, that:
 - A result that is uncertain in the prior art, combined with a lack of conception of that result in the art, would not bar the grant of a patent right for lack of novelty.
 - Anticipation is not based on "considerable differences" but only on whether there is any difference at all between what is claimed and what is disclosed in the prior art. For that reason there can be no "hit or miss" in anticipation; only squarely hitting the "target" that was "aimed" at by the art will destroy the novelty of a subsequent invention.
 - Prior teachings enrich "the store of common knowledge" as a prerequisite to anticipation under patent law.
- There is no definition of the term "new" in the TRIPS Agreement or in the Paris Convention. In addition, Article 1.1 of the TRIPS Agreement states that "members shall be free to determine the appropriate method of implementing the provision of this Agreement within their own legal system and practice."
 - In view of this, there is no prescription as to how Members define what inventions are to be considered "new" within their domestic system.
 - Member may define the scope of the prior art that defeats the novelty of an invention.

Key words:

Patent, Patentability, Novelty, Prior Art, Person skilled in the art, Anticipation.

Available at:

<http://law.justia.com/cases/federal/appellate-courts/F2/124/986/1506575/>