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## Rules Defining the Use of Trade Terms in Patent Applications

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RULES DEFINING THE USE OF TRADE TERMS IN  
PATENT APPLICATIONS

INTRODUCTION

Recently, an inventor submitted an application for a patent on a new and novel material for use as a heat shield upon reentry into the atmosphere.<sup>1</sup> The material was a mixture of low-temperature vulcanizable silicone resin with a catalyst and filler. "LTV-602 Resin," manufactured by General Electric Company, was suggested in the application as an example of the silicone resin. Predictably, the examiner issued an initial rejection based on the use of the trade name "LTV-602 Resin," and the ensuing argument on this issue has continued to the present time.

The United States Patent Office has such an aversion to the use of trademarks and trade names in patent applications that whenever a patent attorney uses one he can expect to be forced to argue its proper use to the examiner. The reason for this aversion is that the relationship between trade terms and the products they identify is sometimes "indefinite, uncertain and arbitrary";<sup>2</sup> therefore, they do not properly disclose the invention. To illustrate this using a hypothetical example, suppose an inventor discovered that "Coca Cola," when mixed with sulfur and chlorine in the right proportions, produces a glue with amazing adhesive qualities. The inventor submits an application for a patent but, because the exact ingredients of "Coca Cola" are kept secret, he must use the trade name "Coca Cola" in his application. This raises the question of whether the invention has been fully disclosed. The invention is valuable only so long as the mixture which is presently designated by the trade name "Coca Cola" remains available. If the manufacturer of "Coca Cola" discontinues this beverage or modifies its composition, the invention can, quite likely, no longer be made. If

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1. A case currently pending in the Patent Office.

2. Manual of Patent Examining Procedure § 608.01 (v) (12th rev. ed. 1967). In the note following the definitions, the following paragraph appears: "The relationship between a trademark and the product it identifies is sometimes indefinite, uncertain and arbitrary. The formula or characteristics of the product may change from time to time and yet it may continue to be sold under the same trademark. In patent specifications, every element or ingredient of the product should be set forth in positive, exact, intelligible language, so that there will be no uncertainty as to what is meant. Arbitrary trademarks which are liable to mean different things at the pleasure of the manufacturers do not constitute such language."

a patent were issued based on this disclosure its value would be at the mercy of the manufacturer of the trade name product and, therefore, its future would be uncertain. Understandably, the Patent Office does not like to award a present monopoly to the inventor if it cannot be certain that the invention will be available to society as a whole once the monopoly comes to an end. Although the reasoning of the Patent Office is generally sound, under certain circumstances courts have allowed the use of trademarks and trade names in patent applications. Such decisions have arisen under a variety of factual situations and have developed rules on a case-by-case basis. However, no known rules transcend all the factual situations and give a clear statement of the law. Examiners don't seem to hesitate in giving a first rejection based on the use of a trade term, but they are more apprehensive about final rejections because they are unsure of the law. Consequently, much time and effort is wasted by examiners and attorneys arguing this point but it is rarely the decisive issue in a case. The Patent Office has attempted to guide examiners in § 608.01(v) of the Manual of Patent Examining Procedure (hereinafter referred to as MPEP) where the terms "trademark" and "names used in trade" are defined and rules governing their use in patent applications are given. However, these rules appear to be somewhat incomplete and misleading.<sup>3</sup> This discussion will attempt to present a simplified statement of the law in this area so that examiners and attorneys can appraise their positions with a minimum of effort and thereby preclude pointless arguments. Based on an analysis of the statutes and recent cases, this note defines a set of rules which control the use of trademarks and trade names, hereafter referred to as "trade terms,"<sup>4</sup> in patent applications. It is sub-

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3. Essentially, MPEP § 608.01 (v) (12th rev. ed. 1967) asserts that "names used in trade," which do not point to the product of one producer, are acceptable in applications if they have fixed meanings, and that "trademarks," which indicate the product of only one producer, can be used only when they are not physically or chemically involved in the invention or where they are identified by scientific language. This note is concerned only with names which indicate the product of one producer and are called "trademarks" by § 608.01(v). See also note 4 *infra*. The two main criticisms of § 608.01(v) MPEP are (1) that it does not set guidelines for determining the sufficiency of the scientific language which must accompany a "trademark," and (2) that it does not conform with the line of decisions from which Rule #2 of this note was drawn. See Rule #2 p. 1110 *infra*. Also, 608.01(v) does not distinguish between the use of "trademarks" in specifications and in claims.

4. For the purpose of this note the definition of "trade name" given in Webster's New Collegiate Dictionary is designated by the expression "trade term," and this definition is thought to include both trademarks and trade names. It is: "An arbitrary

mitted that the rules presented in this note could be used as a basis for rewriting § 608.01(v) MPEP.

This discussion will be confined to the question of whether a trade term was properly used in a patent application.<sup>5</sup> For clarity, the problems of using trade terms in specifications and in claims are discussed separately.

### USE OF TRADE TERMS IN SPECIFICATIONS

Within the limits of the constitutional grant,<sup>6</sup> Congress may set out conditions and tests for patentability. Congress has passed no statutes which refer directly to the use of trade terms in patent specifications so the statutory provision most often relied upon in this area is of a more general nature. This provision dictates that the specification must contain a description of one embodiment of the invention which would enable a person skilled in the art to "make and use" the invention.<sup>7</sup> The most significant difficulty in applying this statute to trade terms used in patent specifications is the time element involved. Must persons skilled in the art be able to "make and use" the invention at the time the application is filed only, or must they also be able to make and use the invention at subsequent dates? When a trade term is used in a specification, those skilled in the art can usually obtain the trade term product intended by the inventor from the manufacturer at the time the application is filed. But as time passes, the manufacturer may modify his

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adopted name given by a manufacturer or merchant to an article to distinguish it as one produced or sold by him."

5. Not discussed here are the problems of how to correct a misused trade term in a patent application, which is primarily a question of new matter in amendments and is dealt with in § 608.01(v) MPEP. Also not discussed is the problem of how to properly identify the trade terms used in patent applications which is also treated in § 608.01(v) MPEP. This note does not take up the problem of protecting property rights to trademarks used in patents. An historical insight into this problem can be obtained by reading, *The Use of Trade-Marks in Patent Specifications*, 2 GEO. WASH. L. REV. 51 (1933).

6. Patents are unique in that they are monopolies which are expressly protected by the constitution. The provision is U.S. CONST. art. I, § 8, which delegates the power to Congress "to promote the progress of science and useful arts, by securing for limited times to . . . inventors the exclusive right to their respective . . . discoveries."

7. Patents, 35 U.S.C. § 112 1st paragraph (1952). The complete provision is: "The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention."

product without changing the trade term and this may render it impossible for those skilled in the art to obtain the trade name product originally intended by the inventor; thus, those skilled in the art may no longer be able to "make and use" the invention at some future time. Therefore, when a trade term is used in a specification there must be some assurance that the product which it identifies at the time the application is filed will be the same product identified by that trade term in the future. It is hoped that the following rules will dispose of this and other problems.

*Rule #1—A TRADE TERM IS PROPERLY USED IN A SPECIFICATION IF THOSE SKILLED IN THE ART CAN MAKE THE PRODUCT DESIGNATED BY THE TRADE TERM AT THE TIME THE APPLICATION IS FILED, USING THE SPECIFICATION AND/OR PUBLISHED LITERATURE THAT IS IMPLIED BY THE SPECIFICATION*

This rule fixes "the time the application is filed" as the reference date; however, the condition set forth to be met at that time—that one skilled in the art must be able to *MAKE* the product—is of such a nature that assurance is provided that the product identified by the trade term when the application is filed will continue to be the same product identified by that trade term in the future. The rationale of this rule is that the trade term used in the specification does not designate the product of a particular manufacturer only, but it also designates the product which can be made by those skilled in the art using the specification and/or published literature which is implicated by the specification. Even if the manufacturer alters his product without changing the trade term, those skilled in the art can still obtain the original product intended by the inventor by making their own.

(1) *Make the Product Using the Specification*

In rare cases the trade term itself furnishes sufficient information to allow one skilled in the art to make the product; thus, where the trade name of a chemical product was included in the specification and the product was named according to the Geneva system of representing molecular structure, there was held to be a sufficient disclosure.<sup>8</sup> How-

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8. *E. I. duPont de Nemours and Co. v. Ladd*, 140 U.S.P.Q. 297, 328 F.2d 547 (D.C. Cir. 1964).

ever, in the usual case where the trade name product can be made using the specification, the description given in addition to the trade term must be used. A trade term is not objectionable in a specification so long as the product is otherwise sufficiently described. So, if the specification calls for the use of "Hibulk" paper of X Corporation which is "made by the soda process from about 70% short deciduous fibers and 30% of long coniferous fibers, sized with resin, having a density of 5-to-10 seconds and having a low Mullen," then the paper has been sufficiently described because one skilled in the art could make the paper from the additional description.<sup>9</sup> Further, the trade name "Quarternary Ammonium Salt" which is described in the specification as a mixed higher alkyl benzyl dimethyl chloride (in which the alkyl groups contain 8-to-18 and mainly 12-to-14 carbon atoms) is sufficiently described because one skilled in the art would know from the description that this trade name product is a coconut oil derivative.<sup>10</sup> Also, a description explaining in detail the method of making the Goodyear product of "Pliolite" is adequate because one skilled in the art could make the product.<sup>11</sup>

(2) *Make the Product Using Published Literature That Is Implicated by the Specification*

One practical method of proving that a trade name has been properly used in a specification is to employ the additional description given with the trade term to implicate a patent of an invention with the same description. Accordingly, it was held in *United States Rubber Co. v. Marzall*<sup>12</sup> that where the specification included the trade name "Marbon S" along with the description, a "hard inelastic resinous polymerization product derived from polymerizing a composition comprising butadiene and styrene," and a German patent was introduced which described in detail various methods of making a "hard inelastic resin from butadiene and styrene," then there was sufficient disclosure because one skilled in the art could make such a product as "Marbon S" using the German patent. Along this same line, where the specification called for "Zyrox 3007" of X Corporation, "which is a condensate of chlorinated aromatic compounds and has a chlorine content of 25%, specific gravity at 25°C. of 1.29 to 1.32, a softening point of 65° to 70°C. and a

9. See *Ex parte* Gessler, 77 U.S.P.Q. 509 (P. O. Bd. App. 1946).

10. *Ex parte* Cross, 113 U.S.P.Q. 547 (P.O. Bd. App. 1956).

11. See *In re* Gebauer-Fuelnegg, 50 U.S.P.Q. 125, 121 F.2d 505 (C.C.P.A. 1941).

12. *United States Rubber Co. v. Marzall*, 86 U.S.P.Q. 441, 91 F. Supp. 1 (D.D.C. 1950).

stromer viscosity at 130°C. of 20 to 27," and an expert testified that this same result could be obtained with a British patent, there was sufficient disclosure.<sup>13</sup>

Other publications can also be implicated by the trade term or additional description in a specification which will enable one skilled in the art to make the trade name article. There are no known cases holding directly on this, but the Court of Customs and Patent Appeals has held that, in an interference suit, where one patent used the trade name "Thyratron Tube" and the other patent included a description of how to make a certain tube, publications on how to make "Thyratron Tubes" could be used to determine that the tubes used in the two patents were essentially the same.<sup>14</sup>

It should be carefully noted that only publications implicated by the specification can be used. To state this in the negative, publications that are not implicated by the specification cannot be used to determine if one skilled in the art could make the trade name article. The reason for this is that if one skilled in the art were trying to make the invention described in the specification, he would not be led to seek information in a publication not implicated by specification. Thus, where the specification used the trade name "Amberlite IRC-50," and a patent, which described a procedure for making "Amberlite IRC-50" but made no reference to that name, was presented into evidence, then it was held that there had been insufficient disclosure.<sup>15</sup> Further, dicta in *United States Rubber Co. v. Marzall*<sup>16</sup> indicates that had the trade name "Marbon S" been used alone, the disclosure would have been insufficient because one skilled in the art would not have been led to the German patent without the additional description.

Although there have been no known cases holding that the implicated literature used by one skilled in the art to make the trade term product must be "published," it appears logical that it must. Otherwise the procedure for making the trade term product would not be a matter of public record and would not, therefore, be of a permanent nature. It can readily be seen that this would not be desirable if the trade term is to have one fixed meaning in the future. The extent to which such

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13. See *Ex parte Perkins*, 102 U.S.P.Q. 361 (P.O. Bd. App. 1953).

14. *Ronald v. Morgenstern*, 33 U.S.P.Q. 597, 90 F.2d 270 (C.C.P.A. 1937).

15. *Ex parte Bickell*, 122 U.S.P.Q. 27 (P.O. Bd. App. 1957).

16. *United States Rubber Co. v. Marzall*, 86 U.S.P.Q. 441, 91 F. Supp. 1 (D.D.C. 1950).

literature must be "published" before its counterpart trade term may be used in a patent specification remains for judicial determination.

*Rule #2—A TRADE TERM IS ALSO PROPERLY USED IN A SPECIFICATION IF THE PRODUCT IS GENERALLY KNOWN TO PERSONS SKILLED IN THE ART AND IS READILY OBTAINABLE AT THE TIME THE APPLICATION IS FILED, PROVIDED THE COMPOSITION OF THE PRODUCT IS A TRADE SECRET AND THERE IS REASON TO BELIEVE THAT WHENEVER THE COMPOSITION OF THE PRODUCT IS MODIFIED THE TRADE TERM WILL ALSO BE CHANGED.*

As in Rule #1, this rule fixes "the time the application is filed" as the reference date; however, the proviso—that there be a reason to believe that whenever the composition of the product is modified the trade term will also be changed—gives some assurance that the trade term used in the specification will continue in the future to identify the product originally intended by the inventor. Perhaps this rule is more controversial than Rule #1 because the requirement here for such assurance is less definite than for Rule #1. In Rule #1 the trade term designated one fixed product which could be made by those skilled in the art as well as by the manufacturer; here, the trade term designates the product of a manufacturer only. It follows that, in Rule #2, only the manufacturer can give assurance that the trade term used in the specification will continue to designate one fixed product in the future. It is not yet certain in what form this assurance must be given in order to satisfy Rule #2 and, therefore, this area of law appears ripe for judicial interpretation. If a patent applicant finds that he must use a trade term in his application it might benefit his cause if he would submit to the examiner a written statement from the manufacturer to the effect that the trade term will be changed if the product is modified.

Rule #2 follows from two district court decisions and one Court of Customs and Patent Appeals case. The Patent Office Board of Appeals has never used this rule and has, in several cases, denied its existence.<sup>17</sup> The justification for the rule is that the inventor has disclosed something useful to society even though he cannot make the trade name product which he has used to describe his invention, and such

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17. See *Ex parte* Appeal No. 8,244, 29 J.P.O.S. 911 (P.O. Bd. App. 1947); *Ex parte* Appeal No. 49,006, 26 J.P.O.S. 638 (P.O. Bd. App. 1944). See also note 25 *infra*.



disclosure should be rewarded.<sup>18</sup> If the usefulness of the invention to society is dependent on the continued availability of the trade name product, so is the usefulness of the patent monopoly to the inventor. The reward fits the benefit to society.

The essence of this rule was first put forth in 1941 by the Court of Customs and Patent Appeals in *In re Gebauer-Fuelnegg*<sup>19</sup> and then again in 1955 by the Federal District Court for the District of Columbia in *Lamm v. Watson*,<sup>20</sup> but in both these cases certain language was used which made it possible to avoid the rule.<sup>21</sup> In 1963, however, the District Court for the District of Columbia established the existence of the rule to a much greater degree of certainty in *Leutzinger v. Ladd*.<sup>22</sup> In that case, one of the components of the invention was "Carnauba" wax, the composition of which was a trade secret and could not, therefore, be made by one skilled in the art. Evidence was presented tending to prove that "Carnauba" wax was generally known to persons skilled in the art, and that it was readily obtainable at the time the application was filed. Further evidence showed that whenever the composition of

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18. See generally, *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). The patent monopoly was established by our founding fathers as a reward and inducement to bring forth new knowledge to be shared by society. It follows that the federal government has a constitutional duty to refuse a patent to an inventor if he has not adequately disclosed his invention because, if he has not, he should not receive a reward when he has shared no new knowledge.

19. *In re Gebauer-Fuelnegg*, 50 U.S.P.Q. 125, 121 F.2d 505 (C.C.P.A. 1941). In this case the invention was to coat sheet metal with a product known on the market as "Pliolite." A publication was introduced which showed that "Pliolite" was made by Goodyear Tire and Rubber Co. and was on the market two months prior to filing. After the examiner objected to the use of the trade name the applicant amended, disclosing in detail the method of making "Pliolite." The court held that there was sufficient disclosure because "Pliolite" was on the market and was generally known to those skilled in the art at the time the application was filed. Commenting on this case later, the Patent Office Board of Appeals, in *Ex parte Appeal No. 8,244*, note 25 *infra*, wrote: "It is believed that the correct construction of the decision is that a disclosure by trade name is insufficient, but when the material is well known by trade name at the time of filing the application, a proper disclosure of the composition (as by method of making it) can be added to the specification and it is not new matter."

20. *Lamm v. Watson*, 108 U.S.P.Q. 203, 138 F. Supp. 219 (D.D.C. 1955). Here, the specifications suggested the use of a substance having the trademark "Acryloid 710." The court rejected the use of this trademark because: (1) it was not established that one skilled in the art could make "Acryloid 710," and (2) it was not established that "Acryloid 710" was a substance known to persons skilled in the art and readily obtainable. Later, there was controversy as to whether these two criteria must be met simultaneously or alternately. See also note 25 *infra*.

21. See notes 19 and 20 *supra* and note 25 *infra*.

22. *Leutzinger v. Ladd*, 139 U.S.P.Q. 196, 222 F. Supp. 681 (D.D.C. 1963).

such wax was modified by the manufacturer, the trade name was also changed. In deciding that the trade name constituted sufficient disclosure the court carefully dissected the cases of *In re Gebauer-Fuelnegg*<sup>23</sup> and *Lamm v. Watson*<sup>24</sup> and extracted from them the essentials of Rule #2.

There have been no known Patent Office Board of Appeals cases in this area since *Leutzinger*; however, *Leutzinger* would appear to make it judicially unsound for that administrative body to avoid the import of Rule #2 as it has in the past.<sup>25</sup> It also appears that *Leutzinger* weakened the regulation as set forth in § 608.01(v) Manual of Patent Examining Procedure.<sup>26</sup>

The proviso in Rule #2 is necessary to insure that the general rule is not broader than the facts of the case from which it was drawn. In *Leutzinger* the product was a trade secret and there was evidence that the name would be changed if the composition of the product were modified. In addition, the provision that the product must be a trade secret is necessary to bring this rule within 35 U.S.C. § 112<sup>27</sup> which requires the invention to "set forth the best mode contemplated by the inventor of carrying out his invention." If the product is not a trade secret then the best mode contemplated by the inventor includes a description of how to make the product. The burden of rendering the most detailed description available of how to make and use the invention should be on the inventor and not on the public.<sup>28</sup>

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23. *In re Gebauer-Fuelnegg*, 50 U.S.P.Q. 125, 121 F.2d 505 (C.C.P.A. 1941). See also note 19 *supra*.

24. *Lamm v. Watson*, 108 U.S.P.Q. 203, 138 F. Supp. 219 (D.D.C. 1955). See also note 20 *supra*.

25. See *Ex parte* Appeal No. 8,244, 29 J.P.O.S. 911 (P.O. Bd. App. 1947); *Ex parte* Appeal No. 49,006, 26 J.P.O.S. 638 (P.O. Bd. App. 1944). In both of these cases the Board expressed the belief that *In re Gebauer-Fuelnegg* did not enunciate the provisions of Rule #2. See also note 19 *supra*. In *Ex parte Bickell*, 122 U.S.P.Q. 27 (P.O. Bd. App. 1957), the Board indicated that the two criteria laid down in *Lamm v. Watson* must be met simultaneously. See also note 20 *supra*.

26. § 608.01(v) MPEP note 2 *supra*, contains the Patent Office policy with regard to the application of 35 U.S.C. § 112, note 7 *supra*, to trade terms used in patents. In the second paragraph under the heading TRADEMARKS, § 608.01(v) MPEP points out that identification of trademarks by scientific language is necessary where some physical or chemical characteristic of the trademark article is involved in the invention. (See Rule #3, p. 1113 *infra* for discussion of trademark articles which only augment the invention). However, Rule #2 does not have such a strict requirement. See also note 20 *supra* for a short discussion on the infirmities of § 608.01(v) MPEP.

27. Patents, 35 U.S.C. § 112 (1952). See note 7 *supra* for text.

28. The *Leutzinger* decision applied this logic in reverse by indicating that if the

The proviso requiring that there be a reason to believe that whenever the composition of the product is modified, the trade term will also be changed, is especially necessary to overcome the strongest and most frequent objection to the provisions of Rule #2. The objection is that it might be impossible for others to make and sell the invention after the patent expires, should the present manufacturer improve his product but still sell it under same trade name.<sup>29</sup> This objection involves the "time element problem" mentioned earlier. Must persons skilled in the art be able to make and use the invention at the time the application is filed, or when the patent runs out to comply with 35 U.S.C. § 112?<sup>30</sup> Most authorities use the date the application was filed as a reference;<sup>31</sup> however, the Patent Office is duty-bound to seek assurance that the public will benefit from the invention upon expiration of the patent.<sup>32</sup> This provision provides such assurance.

*Rule #3—A TRADE TERM IS ALSO PROPERLY USED IN A SPECIFICATION IF IT DESIGNATES A COMPONENT OF THE EMBODIMENT WHICH IS NOT ESSENTIAL TO THE INVENTION.*

This rule removes a technicality from the path of an inventor striving to get a patent and is generally accepted by authorities.<sup>33</sup> It acknowledges that the inventor's duty to disclose components which merely

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trade name product is in fact a trade secret the inventor is not required to find out how the product is made.

29. *Ex parte* Steigerwald, 131 U.S.P.Q. 74 (P.O. Bd. App. 1961); *Ex parte* Bickell, 122 U.S.P.Q. 27 (P.O. Bd. App. 1957); *Ex parte* Appeal No. 8,244, 29 J.P.O.S. 911 (P.O. Bd. App. 1947); *Ex parte* Appeal No. 49,006, 26 J.P.O.S. 638 (P.O. Bd. App. 1944); § 608.01(v) MPEP note 3 *supra*.

30. Patents, 35 U.S.C. § 112 (1952). See note 7 *supra* for text.

31. See, e.g., *Ex parte* Moersch, 104 U.S.P.Q. 122 (P.O. Bd. App. 1954). Here, the invention was a process for making certain antibiotic materials. A necessary material was identified using a trade name and did not appear to be available at time of filing. The inventor introduced a publication dated two days after filing disclosing a source for the material as well as a method of preparing it. The Board regretfully held that there was an incomplete disclosure because the date of filing is the important one and the publication was two days late.

32. See generally, *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). Note 18 *supra*.

33. See *Ex parte* Gessler, 77 U.S.P.Q. 509 (P.O. Bd. App. 1946) where both the examiner and the Board agreed that materials essential to the invention must be distinguished from those which are not essential with regard to designating them by trade names.

complement the invention is not as high as his duty to disclose components of the actual invention. This is true even though such components are covered by 35 U.S.C. § 112<sup>34</sup> in that it requires a "full, clear, concise, and exact" description which would enable any person skilled in the art to "use" the invention. Thus, where the invention is to crystallize the free water of X-type slurries by adding Y agent to the slurries which reacts with the water, and the trademark "Oronite" is given as an example of X-type slurries, there has been sufficient disclosure because the slurries remain inert during the process.<sup>35</sup> Also, where the invention is simulated snow out of a pressure can from a composition of talc and certain resins, an example of which are those resins with "X" trademark, there has been sufficient disclosure because the invention here was the use of talc and not the resins.<sup>36</sup>

It should be understood that a trade name is allowed only as an example of a specified component and that it is still necessary, under this rule, for the claims and specifications to make clear what the scope of the component is. It must also be apparent that the trade name article does lie within the scope of the specified component. Thus, in the above-mentioned case of simulated snow, it was necessary to delineate a class of resins and it was essential that "X" resins belong to the class of resins so delineated.<sup>37</sup> A similar requirement was also present in the other example above.

#### USE OF TRADE TERMS IN CLAIMS

Congress has passed no statutes referring directly to the use of trademarks and trade names in patent claims so, again, the general language of 35 U.S.C. § 112 must be relied upon. The provision is as follows: "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."<sup>38</sup>

Unlike the provision in 35 U.S.C. § 112 dealing with specifications,<sup>39</sup> the above provision establishes no test for determining when the words used in a claim are sufficient to point out and distinctly claim the invention. The rule set forth below provides such a test.

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34. Patents, 35 U.S.C. § 112 (1952). See note 7 *supra* for text.

35. *Ex parte* Diffley, 113 U.S.P.Q. 352 (P.O. Bd. App. 1957).

36. *Ex parte* Hohnstine, 122 U.S.P.Q. 290 (P.O. Bd. App. 1958).

37. *Id.*

38. Patents, 35 U.S.C. § 112, 2nd paragraph (1952).

39. Patents, 35 U.S.C. § 112, 1st paragraph (1952). See note 7 *supra* for text.

*Rule #4—A TRADE TERM CAN BE USED IN A CLAIM ONLY IF ITS MEANING HAS BEEN ADEQUATELY DEFINED IN THE SPECIFICATIONS, WHEREBY IT IMPARTS SPECIFIC LIMITATIONS TO THE CLAIM.*

Like the specification, the claims enable those skilled in the art to understand and apply the invention; however, claims have the additional purpose of advising the public of the scope of the invention.<sup>40</sup> The claim must particularly point out and distinctly claim the invention in order that the public may definitely and precisely understand its rights and be warned as to what is excluded from the public domain.<sup>41</sup> For this reason, if a claim leaves any zone of uncertainty it is void.<sup>42</sup> It follows that the trade names used in patent claims must impart specific limitations to the claims. Hence, where the invention is to use a different material to substitute for wooden separators and claim 6 is specifically limited to the use of "Formica," then claim 6 is unacceptable because the trade name "Formica" might mean different things at the pleasure of the manufacturer.<sup>43</sup> Also where a floor mat with an outer tacky layer of "Flexo Wax C-Light" is claimed, this claim should be rejected as being vague and indefinite.<sup>44</sup> Here, the thickness of the layer of wax was critical and use of the trade name did not impart this structural limitation because the manufacturer might vary the ingredients and thereby change the thickness of the layer.

The requirement that the definition of the trade term appear in the specification is simply an application of that old rule that a patentee is his own lexicographer.<sup>45</sup> The patentee may define any word as long as it is not inconsistent with the generally accepted meaning of the term, thus, fixing its meaning and making it unambiguous. When this is done with a trade term, it no longer designates the product of a

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40. See *Gould-National Batteries, Inc. v. Gulton Industries, Inc.* 142 U.S.P.Q. 475, 231 F. Supp. 609 (D.N.J. 1964); *Royal Typewriter Co. v. Remington Rand, Inc.*, 77 U.S.P.Q. 517, 168 F.2d 691 (2d Cir. 1948); *In re Bowles*, 22 U.S.P.Q. 39, 71 F.2d 202 (C.C.P.A. 1934).

41. See *Ekstrom-Carlson & Co. v. Onsrud Mach. Works, Inc.*, 129 U.S.P.Q. 457, 197 F. Supp. 451 (N.D. Ill. 1961).

42. See *Merrill v. Builders Ornamental Iron Co.*, 93 U.S.P.Q. 276, 197 F.2d 16 (10th Cir. 1952).

43. *Ex parte Bolton*, 42 U.S.P.Q. 40 (P.O. Bd. App. 1938).

44. *In re Dense*, 70 U.S.P.Q. 212, 156 F.2d 76 (C.C.P.A. 1946).

45. See *International Cork Co. v. New Process Cork Co.*, 6 F.2d 420 (2d Cir. 1926); PACOT, PATENT CLAIM DRAFTING 366, § 5530 (2d ed. 1952).

manufacturer, but rather it is a shorthand description of the definition given by the patentee. Consequently, where the claim specifies the ingredient "Navillite," a trade name, and the specification states the mode of preparing this substance, the claim is in the proper form.<sup>46</sup> Also, the trade name "Stanoline," as used in the claims, was not considered objectionable since the characteristics of this wax were given in the specifications.<sup>47</sup>

It is interesting to compare Rule #4 dealing with trade terms in claims with Rule #1 which generally requires that trade terms used in the specification be defined either in the specification or in published literature. The major difference between the two rules is that in Rule #1 the trade term must be defined so as to enable one skilled in the art to "make" the product it designates, whereas in Rule #4 the trade term must be defined so as to "impart specific limitations to the claim." In the former the emphasis is on making and using the invention and in the latter it is on fixing the scope of the invention. A more specific difference between the two rules is that in Rule #1 the trade term can be defined either in the specification or in published literature whereas in Rule #4 the trade term used in a claim *MUST* be defined in the specification. The reason for this strict requirement is that a patent has much greater utility if the scope of the invention can be seen on the face of the patent so that a reader must not search elsewhere to determine what the patent protects. Another very important reason is that if a trade term were used in a claim with no accompanying definition in the specification, the claim would, in effect, be limited to the product of a single manufacturer. For this reason, the use of a trade name in a claim without an accompanying definition has been held to be "bad form."<sup>48</sup> Also, it has been held that where the trade name "Aquasol" was used in a claim and the examiner knew exactly what was meant by this, it was still necessary to define the trade name so that the claim would not be limited to the product of a single manufacturer.<sup>49</sup>

The requirement that trade terms used in claims be defined in the specification is part of the broader rule that words used in claims will

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46. *Ex parte* Stephens, 71 U.S.P.Q. 304 (P.O. Bd. App. 1945).

47. *Ex parte* Canter, 70 U.S.P.Q. 372 (P.O. Bd. App. 1946).

48. *Ex parte* Kattwinkel, 12 U.S.P.Q. 11 (P.O. Bd. App. 1931); *Ex parte* Davis, 80 U.S.P.Q. 448 (P.O. Bd. App. 1949). In both of these cases the court objected to the form of using a trade name in a claim without giving a reason.

49. *Ex parte* Frederick, 75 U.S.P.Q. 298 (P.O. Bd. App. 1947).

be given their ordinary and accustomed meaning unless the inventor intended to use them differently and such different meaning must appear in the specification.<sup>50</sup> The ordinary and accustomed meaning is usually determined by referring to dictionaries<sup>51</sup> or standard works in that field.<sup>52</sup> Generally, the meanings of trade terms cannot be found in either of these references so they have no ordinary and accustomed meanings. It follows that trade terms used in claims must be defined in the specification.

#### SUMMARY

Generally, it is undesirable to use trademarks and trade names in patent applications; however, courts have allowed their use under a variety of factual circumstances. Because of the divergence of such decisions it is difficult for patent attorneys and patent office examiners to appraise whether or not particular trade terms have been properly used in patent applications. This note presents four rules which embody all the known cases involving the use of trade terms in patent applications. It is hoped that these rules will aid patent attorneys and patent office examiners in evaluating the proper use of a particular trade term in a patent application and will help them in determining which cases are applicable to a particular use.

*F. Prince Butler*

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50. *See* *Universal Oil Products Co. v. Globe Oil & Refining Co.*, 58 U.S.P.Q. 504, 137 F.2d 3 (7th Cir. 1943).

51. *See, e.g.*, *Application of Ripper*, 8 U.S.P.Q. 96, 171 F.2d 297 (C.C.P.A. 1948).

52. *See, e.g.*, *Application of Jones*, 65 U.S.P.Q. 480, 149 F.2d 501 (C.C.P.A. 1945).