

1936

Invention and the Law, by Harry Aubrey Toulmin

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Gerrit D. Foster, *Invention and the Law*, by Harry Aubrey Toulmin, 20 Marq. L. Rev. 203 (1936).
Available at: <https://scholarship.law.marquette.edu/mulr/vol20/iss4/11>

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BOOK REVIEWS

Invention and the Law, by Harry Aubrey Toulmin, Jr. Prentice Hall, Inc., New York, 1936, 399 pages.

There are now pending in Congress companion bills in which it is proposed that there be established a separate appellate court having exclusive jurisdiction of cases arising under the federal patent laws on appeal from the various federal district courts.¹ One of the reasons advanced in support of such a court is the fact that confusion and unfairness arise when conflicting decisions involving the same patent are made by the present federal circuit courts of appeals of different circuits.² If the test of what is and what is not invention was standard and objective such diversity of legal conclusion should not result.

By the plan adopted in the book under review the author indicates that the test of invention is non-standard and subjective. Chapter III deals with the determination of what is invention and Chapter IV with what is not invention. If, by applying the rules of Chapter IV to a given fact situation, a conclusion is reached that such situation is not barred from being termed "invention," such conclusion does not necessarily include that such fact situation should affirmatively be so termed. By applying the rules of Chapter III the conclusion might be that such fact situation did not attain the status of "invention." To one mind a fact situation may generate an opinion that it constitutes invention, to another mind that it does not. The decision of what is invention, invention itself being based on mental concept, depends upon the type of mind that makes the decision. Only by presenting the determining mind with analogous fact situations and previous judicial holdings thereon can the natural opinion of such mind be swayed and changed. The book under review gives no aid to the attorney in finding cases presenting fact situations which he can use in the process of formulating the opinion of the determining mind.

To the lawyer who realizes that his first duty is to present facts in a manner best calculated to produce in the determining mind an opinion sought, this book offers a quick and handy means of serving up to the determining mind the language and word formulae most suitable to support the opinion which has been formed. This book, under headings familiar to the patent lawyer, reports in full those quotations from leading United States Supreme Court and circuit courts of appeals decisions which are adapted to nicely pad out a brief. In this latter aspect the book surpasses the present digest systems. Nowhere can one so readily find desired word formulae.

The layman was not forgotten by the author in preparing this book. The first two chapters dealing with the background and general characteristics of patentable invention are fundamental. As to the author's style little can be said as the major portion of the book is concerned with setting forth at length quotations from reported cases. At most the style is patterned after that of the well prepared brief. The patent bar can make use of this book as a ready index to needed supporting quotations. However the need of an analytical work presenting cases in some classified form of concise fact situations, whereby cases may be found which can be used in compelling rather than supporting desired opinions, is great and at present unfulfilled.

GERRIT D. FOSTER.

¹ H. R. 12371, 74th Congress, 2d Session, Jan. 16, 1936; S.3823, 74th Congress, 2d Session, April 20, 1936.

² For example the Eibel patent No. 845,224 was held valid in *Eibel Process Co. v. Remington-Martin Co.*, 234 Fed. 624 (C.C.A. 2d, 1916) and void in *Minnesota & Ontario Paper Co. v. Eibel Process Co.*, 274 Fed. 540 (C.C.A. 1st, 1921).