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The *Muncie Gear* Doctrine and the Effect of Section 132 Upon It

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INTRODUCTION

In 1942, the United States Supreme Court rendered its decision in *Muncie Gear Works, Inc. v. Outboard Marine & Mfg. Co.*¹ Since that decision was handed down, all but one² of the federal appeals courts that have dealt with the issue³ have correctly interpreted the so-called "late claiming" doctrine⁴ announced in *Muncie Gear*. This interpretation invalidates patent claims presented by amendment⁵ more than the statutory period after public sale or use only

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¹ 315 U.S. 759 (1942).
² The United States Court of Appeals for the Second Circuit has not correctly dealt with the issue. See notes 152-77 and accompanying text infra. Although it can reasonably be argued that the Court of Claims also mishandled the issue in Pratt and Whitney Co. v. United States, 345 F.2d 838, 843-45 (Ct. Cl. 1965) (alternative holding), that panel's discussion on this point is far less than clear. Given several later decisions by the Court of Claims in Bendix Corp. v. United States, 600 F.2d 1384 (Ct. Cl. 1979), and Rel-Reeves, Inc. v. United States, 534 F.2d 274 (Ct. Cl. 1976), the *Pratt and Whitney* decision should be viewed as having been poorly written rather than incorrectly decided. See notes 103-14 and accompanying text infra. In any event, through *Bendix* and *Rel-Reeves*, the Court of Claims has corrected any mistaken interpretation of *Muncie Gear* that may have existed as a result of its *Pratt and Whitney* decision. *Id.*
³ The United States Courts of Appeal for the First, Second, Fourth, Fifth, Sixth, Seventh, Ninth, and Tenth Circuits, the Court of Claims, and the Court of Customs and Patent Appeals have dealt with the issue. See notes 6 and 7 infra.
⁵ The word amendment as used herein refers not only to amendments as that term is used literally in the proceedings before the U.S. Patent and Trademark Office, but also to continuation applications, which are amendments in essence but not form. See note 77
if the claims were not supported by the disclosure of the original application.\textsuperscript{6} Only the United States Court of Appeals for the Second Circuit has taken the decision a step further toward what is truly a non-statutory “late claiming” doctrine and invalidated patent claims that, though supported by the original disclosure, were not directed to matter essentially the same as that claimed in the original application.\textsuperscript{7} When compared with the language and reasoning of \textit{Muncie Gear} itself\textsuperscript{8} and with the scheme embodied in the reissue statutes,\textsuperscript{9} the Second Circuit's interpretation of \textit{Muncie

\textit{infra.}


8. 315 U.S. 759, 769-68.

Gear is unreasonable and analytically unsound. With respect to the disclosure requirement, non-Second Circuit federal appeals courts have therefore been correct in their dealings with the decision in Muncie Gear.

Nevertheless, the continued analysis of amendments under the test announced in Muncie Gear is improper. Though the parameters established by Muncie Gear may have been justifiably followed in the decade immediately following the Muncie Gear decision, the enactment of 35 U.S.C. section 132 in 1952 flatly rejected an essential element of the Muncie Gear analysis with respect to the validity of an amendment to a patent application.10 Under section 132, the only relevant issue is whether an amendment presents claims not supported by the disclosure of the original application.11

Though none of the non-Second Circuit federal appeals courts have spoken directly to this issue, they have taken widely disparate and often confusing approaches in dealing with section 132 and the supposed "late claiming" doctrine of Muncie Gear. One of the circuit courts has relied exclusively on section 132 without mention of the Muncie Gear test.12 Four of the circuits13 have relied on or referred to section 132 erratically and confusingly at best. Incredibly, three circuit courts14 and the Court of Claims15 continue to rely solely on the Muncie Gear test, making no mention of section 132 at all. And, of course, the Second Circuit16 has promulgated an interpretation of Muncie Gear on which section 132 has no effect when the claims in issue, though not claiming new matter, are directed to matter not essentially identical to that originally claimed by the patentee. Thus, despite the twenty-six-year-old statutory mandate of section 132, the federal appeals courts have yet to realize the full effect of section 132 and the inapplicability of the supposed "late claiming" doctrine of Muncie Gear when determining the validity of an amendment that presents claims not supported by the disclosure of the original ap-

10. See text accompanying notes 66-73 infra.
12. The Third Circuit has so relied. See text accompanying notes 144-47 infra.
13. The Fourth, Fifth, Seventh, and Ninth Circuits have followed this approach. See text accompanying notes 110-43 infra.
14. The First, Sixth, and Tenth Circuits ignore § 132. See text accompanying notes 85-102 infra.
15. See text accompanying notes 103-09 infra.
16. See text accompanying notes 152-77 infra.
lication. They also disagree with the very interpretation of the *Muncie Gear* decision itself.

This article will first examine the impropriety of the interpretation of *Muncie Gear* that yields the non-statutory "late claiming" doctrine. In this context, the rationale and holding of *Muncie Gear* as well as the logic of the statutory scheme embodied in the reissue statutes will be discussed. Then, the article will examine the effect of section 132 upon the analysis of an amendment to a patent application. Finally, the conflicting federal appeals court decisions under both *Muncie Gear* and section 132 will be analyzed in terms of their interpretations of *Muncie Gear* and the recognition given to section 132.

**The Holding of Muncie Gear**

*The Muncie Gear Decision*

In *Muncie Gear*, the respondents, the patentee and its exclusive licensee, brought a patent infringement action against the petitioners, a manufacturer and a sales company. The patent in issue was directed to an invention in a water propulsion device which the petitioners' outboard motors had allegedly infringed. Though the defense had not been expressly dealt with in the District or Appeals Courts, prior public use or sale of a device embodied in the patentee's claims became the dispositive issue on certiorari to the Supreme Court.

The patentee's original application in *Muncie Gear* was filed on August 25, 1926, and had urged an anti-torque plate as the invention. This plate extended behind the propeller of the outboard motor to compensate for the constant turning force on the boat generated by the rotating propeller. The patentee did not file the

17. See note 9 supra.
18. Respondent Johnson Brothers Engineering Corp. was the owner of the patent. Respondent Outboard, Marine & Manufacturing Co. was the exclusive licensee under the patent.
19. Petitioner Muncie Gear Works, Inc., manufactured the outboard motors which were alleged to infringe U.S. Patent No. 1,716,962, owned by Johnson Brothers Engineering Corp. Petitioner Bruns & Collins, Inc., sold the outboard motors made by Muncie Gear Works, Inc.
20. 315 U.S. 759, 759-60.
21. *Id.* at 765; the district court opinion was not reported.
24. *Id.* at 761-62.
final amendment to the original patent application until March 30, 1929. That amendment contained four claims directed to an anti-cavitation plate as the invention, rather than the originally emphasized anti-torque plate. The anti-cavitation plate, horizontally mounted on the housing above the propeller, increased the propulsive effect of the propeller by preventing air from being drawn into the propeller from above the water's surface. Two of the amended claims also mentioned for the first time an unbroken exterior surface on the housing of the device. These four claims became the claims in issue.

The respondents had admitted at trial that the respondent-licensee's predecessor had marketed outboard motors with all of the features of the claims in suit in January or February of 1926. Additionally, one of the respondents' competitors had manufactured and sold a similar device one year later. Thus, both public uses had occurred more than two years prior to the amendment of March 30, 1929.

Relying upon section 4886 of the Revised Statutes, the Court stated the applicable rule of law; "The claims in question are invalid if there was public use or sale, of the device which they are claimed to cover, more than two years before the first disclosure thereof to the Patent Office." The Court emphasized that the

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25. Id. at 762. The Court had noted earlier in the opinion that the original specifications and drawing, filed on August 25, 1926, had "both indicated an anti-cavitation plate which the specifications said 'prevents cavitation,' but it was in no way asserted that the cavitation plate was new, or that it was being employed in any novel cooperative relation to the other elements." Id. at 761-62. The Court further noted that other interim amendments, prior to the final amendment in issue on certiorari, "did not even suggest the presently asserted invention." Id. at 762. When the amendment in issue was finally filed on March 30, 1929, the patentee had made changes, the effect of which, said the Court, "was aptly described by the patent examiner: 'The amendments have been such that the claims now emphasize the anti-cavitation plate rather than the anti-torque plate.' With changes which are immaterial here, the new claims so offered became the claims in issue." Id.

26. Id. at 762-63.
27. Id.
28. Id. at 764.
29. Id.
31. 315 U.S. 759, 768. The period is now one year under 35 U.S.C. § 102(b)(1972). Section 102(b) now provides: "A person shall be entitled to a patent unless . . . the invention was patented or described in a printed publication in this or a foreign country, more than one year prior to the date of application for patent in the United States." (Emphasis added.) The former "Patent Office" as referred to in Muncie Gear is now entitled the "Patent and Trademark Office." 1975 amendments to Patent Act, Pub. L. No. 93-596, § 1, 88 Stat. 1949 (amending 35 U.S.C. § 1 (1952)).
original application and all pre-March 30, 1929, amendments had "wholly failed to disclose the invention now asserted." Thus, the Court stated, "We think the conclusion is inescapable that there was public use, or sale, of devices embodying the asserted invention, more than two years before it was first presented to the Patent Office." All claims were held invalid.

The Correct Interpretation of Muncie Gear

Despite the express language and reasoning of Muncie Gear, at least one author and a multiplicity of defendants' attorneys have attempted to stretch Muncie Gear well beyond its express holding to encompass a non-statutory "late claiming" doctrine. According to this alleged doctrine, "claims directed to an invention disclosed but not claimed in the [original] application may not be added to the amendment more than the statutory period after public use." There is no sound basis for such a doctrine.

In Muncie Gear, the Court explicitly found no disclosure of the later claimed invention in the original application. Moreover, the rule of law announced by the Court as the rationale for its decision focused solely on public use or sale two years prior to the "first disclosure" of the invention to the Patent Office. Further, the Court's holding invalidated the claims because of public use or sale two years before the invention in issue "was first presented to the Patent Office." The court's language, reasoning, and holding therefore allow for no interpretation that would authorize the supposed non-statutory "late claiming" doctrine. More correctly stated, the Court had, at most, created a "late disclosure" doctrine wherein claims submitted via amendment two years after public sale or use would be invalid only when unsupported by the original disclosure.

Some have argued that a close examination of the facts of

32. 315 U.S. 759, 768.
33. Id.
34. Id.
35. Gardner, supra note 2.
36. See cases cited in notes 6 and 7 supra for a small sampling of the cases in which the federal courts have had to deal with such attempts by defendants. See also, Flocks and Neimark, supra note 4, at 677, 700-03.
37. Gardner, supra note 4, at 321, 327.
38. 315 U.S. 759, 768. See the text accompanying notes 31-33 supra.
39. Id.
40. Id.
41. E.g., Gardner, supra note 4, at 324-27.
Muncie Gear reveals that two of the claims in issue were directed to an invention that had been disclosed in the original application. Thus, they assert that those two claims were held invalid since they were added to the application in violation of their non-statutory late claiming doctrine.42

Assuming, arguendo, that the invention at issue in Muncie Gear was in fact disclosed in the original application, such a circumstance does not justify promulgation of a non-statutory late claiming doctrine. Clearly, the Supreme Court believed that the original application in Muncie Gear "wholly failed to disclose the invention [then] asserted" by the patentee.43 Furthermore, there is no reference in the Muncie Gear opinion to any rule of law that would support the Court's invalidation of claims when the invention claimed by amendment was disclosed in the original application.44

42. Id.
43. 315 U.S. 759, 768.
44. The Court in Muncie Gear placed reliance on only two cases in deriving its holding. 315 U.S. at 768. Both cases, Schriber-Shroth Co. v. Cleveland Trust Co., 305 U.S. 47, 53-61 (1938) and Chicago & N.W. Ry. Co. v. Sayles, 97 U.S. 554, 563-64 (1878), essentially held that an application could not be amended to embrace an invention not originally disclosed when adverse rights of the public have intervened. Hence, neither case can be cited as support for the invalidation of claims offered by amendment which are supported by the original disclosure.

Of particular importance in this regard are several cases that the Supreme Court would surely have cited in Muncie Gear had it intended to create a non-statutory late claiming defense. The two cases, General Talking Pictures Corp. v. Western Electric Co., 304 U.S. 175, 183 (1938), and Crown Cork & Seal Co. v. Ferdinand Gutmann Co., 304 U.S. 159, 167 (1938), had held that, at least in the absence of "intervening adverse rights," an applicant need show no excuse for claiming originally disclosed but unclaimed subject matter two years after his own public sale or use. In both Crown Cork & Seal, 304 U.S. at 167-68, and General Talking Pictures, 304 U.S. at 183, the language referring to "intervening adverse rights" was merely an attempt by the Court to limit its decisions to the issues immediately before it—issues not involving any sort of prior adverse rights. Nevertheless, the absence of citation to either case in Muncie Gear is important for two reasons.

First, a late claiming doctrine would have been an extension of the language in both cases concerning the claiming of originally disclosed but unclaimed subject matter more than two years after public sale or use by someone other than the patentee or assignee. Surely the Court would have made note of this fact had it intended to announce a rule of law which would require the invalidation of claims directed to an invention originally disclosed but not claimed if submitted more than two years after public sale or use by anyone.

Secondly, had the Court in Muncie Gear intended to create such a late claiming doctrine, it would, of course, have then been reversing the very holdings of both Crown Cork & Seal and General Talking Pictures. Such a lack of citation by the Court in Muncie Gear to two decisions that it would have been reversing would be even more difficult to comprehend. The absence of reference to either case thus makes a late claiming doctrine all the more suspect and doubtful.

See D. Chisum, supra note 4, for a more complete discussion of the case history prior to Muncie Gear.
Thus, the facts notwithstanding, the Court did not intend to create a non-statutory late claiming doctrine. Supreme Court authority for the alleged doctrine is non-existent.

Hypothetical argument aside, the facts of Muncie Gear do not, in and of themselves, support any non-statutory late claiming doctrine. An analysis of the Muncie Gear facts in light of the law of disclosure compels the conclusion that all four claims in issue were directed to an invention that was not “disclosed” in the original application.

Fifty-two years before the Muncie Gear decision, the Supreme Court announced its definition of "new matter" in Topliff v. Topliff.45 "New matter" is a term of art in patent law referring to that which is added to a patent application and directed to an invention beyond the original disclosure.46 The Topliff Court explained that a patentee has claimed new matter when he amends his application to "change the invention" or introduce "what might be the subject matter of another application for patent."47

In Muncie Gear, the Court recognized that, "The [original] specifications and drawings indicated an anti-cavitation plate which the specifications said 'prevents cavitation,' but it was in no way asserted that the cavitation plate was new, or that it was being employed in any novel cooperative relation to the other elements."48 It was not until two years after public use or sale of a device embodied in the claims in issue that the patentee in Muncie Gear claimed the anti-cavitation plate as his invention.49 The patentee had therefore changed his invention, as the claims submitted via amendment were then directed to the anti-cavitation plate rather than the originally emphasized anti-torque plate.50 Thus, the patentee in Muncie Gear went beyond the original disclosure to include new matter in each of the claims in issue.

45. 145 U.S. 156 (1892).
46. Giant Powder Co. v. California Powder Works, 98 U.S. 126, 137-38 (1891). Cf., Sontag Chain Stores Co. v. Nat'l Nut Co., 310 U.S. 281 (1940); Topliff v. Topliff, 145 U.S. 156 (1892) (Both cases use the term "new matter" to mean that which is added to a patent application beyond the original disclosure.).
47. 145 U.S. 156, 166. The Court's explanation of the term "new matter" in Topliff is a direct quote from Powder Co. v. Powder Works, 98 U.S. 126, 137-38 (1891).
49. Id. at 762.
50. Id.
Conflict with the Reissue Statutes

There is yet another difficulty with the argument that *Muncie Gear* created a non-statutory late claiming doctrine. Any such doctrine would directly conflict with the scheme presented in the reissue statutes.\(^1\) It is true that the statutes were not enacted until ten years after *Muncie Gear* was handed down. Given, however, the tortuous interpretation which *Muncie Gear* must be put through to derive the highly suspect late claiming doctrine, the contradictory situation which that interpretation creates when compared to the results reached by the reissue statutes is simply unreasonable and unjustified.

35 U.S.C. section 251 provides that, when an originally granted patent is found to be partly inoperative or invalid due to error without any deceptive intent on the part of the patentee, the patentee or assignee may refile the application under the provision of 35 U.S.C. section 120 and obtain the benefit of the earlier filing date. It is further provided that "No reissue patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years of the grant from the original patent."\(^2\) 35 U.S.C. section 120 provides that a correctly filed\(^3\) reissue application "shall have the same effect, as to such application, as though filed on the date of the prior application. . . ." The scheme is completed by reference to 35 U.S.C. section 252 which states:

> No reissued patent shall abridge or affect the right of any person or his successors in business who made, purchased or used prior to the grant of a reissue anything patented by the reissued patent, to continue the use of, or to sell to others to be used or sold, the specific thing so made, purchased or used, unless the making, using or selling of such thing infringes a valid claim of the reissued patent which was in the original patent.

The result of this statutory scheme for reissues in the 1952 Act is that the patentee is entitled by statutory right to decide to seek a reissue patent with claims broadened to include the originally disclosed invention any time during the pendency of his original

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53. A reissue application is correctly filed when it meets the requirement of 35 U.S.C. § 112. Section 112 explains the manner in which the specifications and claims must be written.
The patentee is also entitled to a broadened reissue patent within two years after the grant of the original patent. The reissue patent retains full force and effect against all infringers except those who have acquired intervening rights, i.e., those who had begun making, selling, or using a device, not embraced in the original patent, which the reissued patent was subsequently broadened to include.

Therefore, if a non-statutory late claiming doctrine had been promulgated in *Muncie Gear*, a patentee could not broaden his original claims by amendment if there has been public use two years before the date of amendment. On the other hand, under the reissue statutes, the same patentee can broaden his claims, notwithstanding public use or sale, to embrace the same invention originally disclosed if he files a reissue application, instead of an amendment, within two years after the original grant. Moreover, should the patentee violate the non-statutory late claiming doctrine, all claims in violation will be held invalid. Correctly filed reissue claims, on the other hand, will remain valid even though broadened. They simply become unenforceable against those who have acquired intervening rights. The supposed late claiming doctrine and reissue statutes have thus taken contradictory stances with the result hinging upon the form of broadening employed: amendment or reissue. No valid reason exists for such distinction.

Because the reissue scheme is statutory in origin, it cannot be interfered with by the courts even though they may feel that the scheme is inimical to the public interest or contrary to the supposed late claiming doctrine. Therefore, the contradictory and

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54. 35 U.S.C. §§ 120, 251.
55. *Id.*
57. *Gardner, supra note 4*, at 321, 327.
58. *Id. See also* Kahn v. Dynamics Corp. of Am., 508 F.2d 939, 943 (2d Cir.) (alternative holding), aff'd 367 F. Supp. 63, 72-73 (S.D.N.Y. 1973) (alternative holding).
59. The Supreme Court made this proposition clear in *United States v. American Bell Tele.*, 167 U.S. 224 (1897), where the government sought to invalidate a patent because of the patentee's delay in filing his original application until almost two years after the date of his invention. The Court answered:

Under § 4886, Rev. Stat., an inventor has two years from the time his invention is disclosed to the public within which to make his application, and unless an abandonment is shown during that period he is entitled to a patent. . . . The statute has given this right, and no consideration of public benefit can take it from him. His right exists because Congress declares that it should. . . . 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
unreasonable result reached under a non-statutory late claiming doctrine must yield to the policy embodied in the reissue statute which allows the broadening of claims when supported by the patentee's original disclosure.

Perhaps the most persuasive argument in favor of the literal interpretation of *Muncie Gear* espoused herein is the overwhelming legal precedent in favor of that interpretation. Of thirty-one opinions handed down by the federal appeals courts that have addressed the issue, only one opinion clearly varied from the "late disclosure" interpretation which *Muncie Gear* demands. The vast majority of federal appeals courts have uniformly and correctly followed the plain wording of *Muncie Gear* to invalidate claims offered in an amendment "if there was public use or sale, of the device which they are claimed to cover, more than two years before the first disclosure thereof to the Patent Office."63

**The Effect of the 1952 Patent Act on Muncie Gear**

Ten years after *Muncie Gear* was decided, Congress enacted the 1952 Patent Act,64 which is still in force today. It has been asserted that this Act did no more in large part than codify existing judicial precedents.65 However, an analysis of the Act as it affects the holding of *Muncie Gear* reveals that the Patent Act did not codify that case. It altered *Muncie Gear's* rule of law abruptly.

As explained above,66 the Court in *Muncie Gear* held that claims

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60. *No court can disregard any statutory provisions in respect to these matters on the ground that in its judgment they are unwise or prejudicial to the interests of the public.* 167 U.S. 224, 246-47 (emphasis added).

61. See cases cited in notes 6 and 7 supra.

62. The First, Second, Fourth, Fifth, Sixth, Seventh, Ninth, and Tenth Circuits, the Court of Claims, and the Court of Customs and Patent Appeals have addressed the issue. See notes 6 and 7 supra.

63. Kahn v. Dynamics Corp. of Am., note 7 supra. See text accompanying notes 66-73 infra.


66. See text accompanying note 31 supra.
added by amendment were invalid if there was public use or sale of a device embodied in the claims more than the statutory period before the first disclosure of the invention to the Patent Office. In *Cardinal of Adrian, Inc. v. Peerless Wood Products, Inc.*, the Sixth Circuit recognized that this rule results in a “two-pronged” test in which claims are held invalid if:

1. The amendments made to each patent application broadened the patent so that it covered additional inventions, i.e., contained new matter [and]
2. The amendments constituted the first disclosure of the devices which had been in public use or sale for more than a year...

In 1952, however, 35 U.S.C. section 132 was enacted into law. Section 132 provides, “No amendment shall introduce new matter into the disclosure of the invention.” The section makes no reference to the second prong of the two-pronged test announced in *Muncie Gear*; the “public use or sale” element of the analysis of amendments was eliminated. Under the plain language of section 132, a claim embodying new matter that is added by amendment is invalid without reference to any public use or sale of the invention embodied in the claim.

The result achieved by section 132 cannot be disregarded or changed by judicial authority alone. Because Congress acted pursuant to its Article I powers in enacting section 132, the statutory rights and limitation inherent in that section must be enforced. Thus, with respect to amendments, *Muncie Gear* was overruled legislatively by section 132.

There is, however, a situation in which the two-pronged analysis of *Muncie Gear* should continue to have vitality. This is the case where new matter is added, not by amendment, but by a “continuation-in-part application.”

Under 35 U.S.C. section 120, an application for patent of an invention disclosed in a prior application by the same inventor can be filed while the application is pending. This later-filed applica-

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67. At the time *Muncie Gear* was decided the statutory period was two years. The corresponding statutory period today is one year. See note 31 supra.
68. 515 F.2d 534 (6th Cir. 1975).
69. Id. at 538 (emphasis in original).
70. 35 U.S.C. § 132.
71. See note 59 supra and accompanying text.
73. See note 59 supra and accompanying text.
tion is commonly referred to as a continuing application. For the portion of the invention claimed in the continuing application that was originally disclosed, the application "shall have the same effect . . . as though filed on the date of the prior application." Section 120 makes no provision, however, for those portions of the continuing application that consist of new matter, and section 132 only places a ban on new matter that is offered via amendment.

Technically, as the term is used in the rules governing the examination of patent applications by the Patent and Trademark Office, a refiled application that contains new matter is referred to as a "continuation-in-part application." Therefore, when a continuation-in-part application is filed, section 132 is inapplicable and the Muncie Gear two-pronged analysis remains appropriate.

The use of the two-pronged Muncie Gear test to determine the validity of a continuation-in-part application is not novel. For example, in Cardinal of Adrian, Inc. v. Peerless Wood Products, Inc., the Sixth Circuit was confronted with a situation where the patentee had filed a continuing application that the court found to contain new matter. Thus, the patentee had, in effect, filed a continuation-in-part application though the court made no mention of the label that the patentee had used. The court correctly turned to the two-pronged test of Muncie Gear and held that, since the claiming of new matter via the continuing application had occurred more than one year after public use of a device embodied in the claims, the claims were invalid.

Federal Appellate Decisions Under Muncie Gear or Section 132

Despite section 132's total ban on the presentation of new matter in an amendment, at least seven of the United States Circuit Courts of Appeal and the Court of Claims continue to employ

75. 35 U.S.C. § 120.
77. Those continuing applications which do not add new matter are called either continuation or divisional applications. Manual of Patent Examining Procedure §§ 201.06, 201.07 at 8-9, 10.2 (rev. 3d ed. Jan. 1978). The distinction between continuation and divisional applications is not relevant for purposes of this article, however.
78. 515 F.2d 534 (6th Cir. 1975).
79. Id. at 539.
81. The First, Fourth, Fifth, Sixth, Seventh, Ninth, and Tenth Circuits continue to employ the full Muncie Gear test. See text accompanying notes 85-102, 110-43 infra.
the full, late disclosure type of two-pronged test from *Muncie Gear* when a patentee is alleged to have violated the supposed late claiming doctrine. Indeed, three of the same seven circuits have never even acknowledged the existence of section 132 or its ban on new matter. Only in the U.S. Court of Customs and Patent Appeals can it be argued, though very tenuously, that section 132 has been or will be recognized for what it is—a partial rejection of *Muncie Gear*’s two-pronged test. Amazingly, however, no federal appeals court decision was found that either expressly or impliedly addressed the conflict between section 132 and the *Muncie Gear* test.

**Failure to Address Section 132**

The First, Sixth, and Tenth Circuits and the Court of Claims have completely failed to acknowledge the existence of section 132. They have, however, adopted the late disclosure interpretation of *Muncie Gear* when the validity of an amendment is put in issue by the late claiming defense.

1. The First Circuit

In two cases, one decided in 1968 and the other in 1969, the Court of Appeals for the First Circuit plainly adopted the late disclosure interpretation of *Muncie Gear* when the validity of an amendment was put in issue by the late claiming defense. In the first of the two, *General Instrument Corp. v. Hughes Aircraft Co.*, the court upheld the defense, stating:

> [C]laim 60 . . . must be considered new matter. [Citation omitted.] And since commercial sales of [a device], which embodied all the ‘new matter’ embraced in claim 60, had commenced over a year prior to the filing thereof the claim fails for ‘late claiming.’ 35 U.S.C. §102 (b); *Muncie Gear Works, Inc. v. Outboard Marine & Mfg. Co.* . . .

A year later, in *International Paper Box Machine Co. v. Specialty Automatic Machine Corp.*, the First Circuit again made approv-

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82. *See* text accompanying notes 103-09 infra.
83. *See* text accompanying notes 85-102 infra.
84. *See* text accompanying notes 148-51 infra.
87. 399 F.2d 373, 377 (1st Cir. 1968).
88. 414 F.2d 1254, 1261 (1st Cir. 1969).
ing reference to "the Muncie Gear Doctrine." Finding that the claim at issue in *International Paper* had been disclosed in the patentee's original application, the court never reached the "prior public use or sale" prong of the Muncie Gear test.\(^8\)

Neither *General Instrument* nor *International Paper* made even passing reference to the section 132 ban on the addition of new matter *via* amendment. Thus, the First Circuit continues to rely on the two-pronged test of *Muncie Gear* without any recognition that the second prong, the "public use or sale" prong, is no longer relevant in the analysis of an amendment.

2. The Sixth Circuit

Since the Supreme Court handed down its decision in *Muncie Gear*, the United States Court of Appeals for the Sixth Circuit has consistently and repeatedly applied the late disclosure version of the two-pronged Muncie Gear test when the validity of an amendment has come into question.\(^9\) In the five decisions rendered by the Sixth Circuit in which the amendments in issue were subject to the provisions of the 1952 Patent Act,\(^1\) not one has made even footnote reference to the existence of section 132 or its flat ban on new matter.

*Cardinal of Adrian, Inc. v. Peerless Wood Products, Inc.*,\(^2\) a

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89. *Id.* at 1261-62.


92. 515 F.2d 532 (6th Cir. 1975). This decision was also discussed in another context in the text accompanying notes 78-80 *supra*. The case involved several patents, one (the '532 patent) which had been altered by amendment and another (the '124 patent) which had been obtained *via* a continuation-in-part application. *Cardinal of Adrian*, 515 F.2d at 537-39. The prior discussion focused on the court's analysis of the continuation-in-part application in issue in the case. The instant discussion focuses on the court's analysis of the validity of the patent application which had been altered by amendment.
1974 decision, is the most recent of the Sixth Circuit decisions applying the Muncie Gear test. In Cardinal of Adrian, the court explained in detail the “two-pronged test” which it relied upon to invalidate the plaintiff-patentee’s claims. Cardinal of Adrian is important, however, as an example not only of the continued and incorrect use of the two-pronged test in the Sixth Circuit when new matter has been added by amendment, but also of the severity of judicial misunderstanding of the effect of Section 132 on Muncie Gear’s holding.

In discussing its interpretation of the two-pronged test, the Cardinal of Adrian court went so far as to say that “[t]he introduction of new matter [by amendment] is not itself prohibited where the rights of the public have not intervened.” The fact is, of course, that the intervening rights of the public has become an irrelevant consideration when new matter has been added to the disclosure by amendment. The Cardinal of Adrian court had obviously never been exposed to the mandate of 35 U.S.C. section 132 and, as a result, rendered a decision with dicta diametrically opposed to the express language of the statute.

3. The Tenth Circuit

The Tenth Circuit also views Muncie Gear as a late disclosure case, but totally unaware of the existence of section 132, it has consistently, but incorrectly, engaged in the entire two-pronged Muncie Gear analysis of amendments to patent applications which were subject to the provisions of the 1952 Act. Price v. Lake Shore Supply R.M., Inc., is both an illustrative example of the Tenth Circuit decisions and the latest word spoken by that court on the issue.

In Price, the defendant in a patent infringement action charged that “the Muncie Gear ruling was fatal to plaintiff’s patent.” The

93. Id. at 538.
94. Id. at 539.
95. Id. at 538 (emphasis added). Intervening rights as used in this context refers to prior public sale or use by a party other than the patentee or assignee. See, e.g., Scriber-Shroth Co. v. Cleveland Trust Co., 305 U.S. 47, 57 (1938).
97. 510 F.2d 388 (10th Cir. 1974).
98. Id. at 393.
court first explained in detail the Muncie Gear test. Then examining Muncie Gear's second prong first, it found that the plaintiff-patentee had added the suspect claims more than one year after the public sale of a device embodied in the claims. Upon analysis of the first prong, however, the court found that the claims in issue did not add "new matter" into the original disclosure of the invention. The claims were, therefore, held valid.

4. The Court of Claims

The Court of Claims has thrice considered Muncie Gear based defenses. After a confusing discussion of its interpretation of Muncie Gear in the first of the three cases, this court subsequently clarified its adherence to a late disclosure view of the Muncie Gear doctrine.

The first decision was in Pratt and Whitney Co. v. United States. The Court in Pratt and Whitney invalidated a broadened claim submitted for the first time in a divisional application more than the statutory period after public use or sale. It must be emphasized, however, that the court in Pratt and Whitney did not explicitly address whether or not the claims in issue had added new matter, yet the court did seem to intimate that new matter was contained in the suspect claim. The Pratt and Whitney court repeatedly referred to the application in issue as allegedly having been a divisional application, the necessary implication being that the court doubted the accuracy of the patentee's label for the application. Hence, the court may have been voicing its belief that the application should have been labeled a continuation-in-part application for having added new matter via

99. Id.
100. Id.
101. Id.
102. Id.
103. Bendix Corp. v. United States, 600 F.2d 1364 (Ct. Cl. 1979); Rel-Reeves, Inc. v. United States, 534 F.2d 274 (Ct. Cl. 1976); Pratt and Whitney Co. v. United States, 345 F.2d 838 (Ct. Cl. 1965) (alternative holding).
105. Bendix Corp. v. United States, 600 F.2d 1364 (Ct. Cl. 1979); Rel-Reeves, Inc. v. United States, 534 F.2d 274 (Ct. Cl. 1976).
106. 345 F.2d 838 (Ct. Cl. 1965).
107. For a discussion of the distinction between divisional and other types of applications, see notes 74-77 and accompanying text supra.
108. 345 F.2d at 843-44.
109. 345 F.2d at 840, 843.
the suspect claim. Under this interpretation of the *Pratt and Whitney* decision, the court's invalidation of a claim added more than one year after prior public use or sale would make complete sense.

Subsequent decisions by the Court of Claims have impliedly clarified, or at the very least corrected, the *Pratt and Whitney* decision. The first of the subsequent decisions was *Rel-Reeves, Inc. v. United States* in 1976.110 Without any reference to the *Pratt and Whitney* decision, the court in *Rel-Reeves* went through a complete analysis of the claims in issue under a late disclosure type *Muncie Gear* test.111 Because the claims had not added new matter to the disclosure of the original application, they were held valid under *Muncie Gear*.112

In *Bendix Corp. v. United States*,113 the Court of Claims reiterated its view of the *Muncie Gear* decision as announced in *Rel-Reeves*, again making no reference to the *Pratt and Whitney* decision. The court in *Bendix* found that claims submitted via amendment did not embody new matter and were therefore valid under *Muncie Gear*.114

Given the uniformity of the interpretations given *Muncie Gear* in *Rel-Reeves* and *Bendix* and the lack of reference in those decisions to any conflict that might exist between *Pratt and Whitney* and *Rel-Reeves* or *Bendix*, it is not illogical to presume that *Pratt and Whitney* was indeed a poorly written decision that hinged upon a finding of new matter being added more than one year after public sale or use. Such an interpretation of *Pratt and Whitney* would, of course, put the decision in full conformance with the holding of *Muncie Gear* and the scheme embodied in the reissue statutes. Nevertheless, as the more recent *Bendix* and *Rel-Reeves* decisions make clear, the Court of Claims presently views *Muncie Gear* as having created no more than a late disclosure type of defense.

Though the Court of Claims has correctly interpreted *Muncie Gear*, it too has failed to realize the impact of section 132 on the *Muncie Gear* analysis. The amendments in issue in *Pratt and Whitney* and in *Bendix* were filed in 1951 and 1944, respectively,

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110. 534 F.2d 274 (Ct. Cl. 1976).
111. 534 F.2d at 280-81.
112. *Id.* at 281.
113. 600 F.2d 1364 (Ct. Cl. 1979).
114. 600 F.2d at 1369-70.
and were not subject to the statutory ban on new matter enacted in the Patent Act of 1952. There was thus no reason for the Court of Claims to consider the effect of section 132 on Muncie Gear in either decision, but the court in Rel-Reeves dealt with an amendment subject to the 1952 Act. As revealed by the analysis in Rel-Reeves, the Court of Claims has not been apprised of the section's existence and its effect on the Muncie Gear two-pronged test.

The Coexistence of the Muncie Gear Test with Section 132

The Fourth, Fifth, Seventh, and Ninth Circuits have also correctly interpreted Muncie Gear as a late disclosure case. Although these circuits have recognized the existence of section 132, intra-circuit as well as inter-circuit disagreement exists as to whether the analysis performed is based upon section 132 or the two-pronged test of Muncie Gear.

1. The Fourth Circuit

Through two decisions\(^\text{116}\) rendered after the enactment of the Patent Act in 1952, the Court of Appeals for the Fourth Circuit has taken a confusing stance. In one case,\(^\text{116}\) the Fourth Circuit correctly interpreted Muncie Gear as a late disclosure case but failed to recognize the mandate of section 132 and its effect upon the two-pronged test of Muncie Gear. In a later decision,\(^\text{117}\) this circuit recognized the ban of section 132 but made no mention of the Muncie Gear test.

The first of the two decisions was rendered in 1961 in Chicopee Mfg. Co. v. Kendall Co.\(^\text{118}\) In Chicopee, the defendant alleged that the plaintiff-patentee had broadened his claims to include new matter in violation of Muncie Gear. The Fourth Circuit agreed, stating, "[t]here could hardly be a clearer description of an attempt, condemned in Muncie Gear . . . , to broaden a claim to include matter not described in the specification which had become public property through public sale [more than one year prior to the amendment]."\(^\text{119}\) Thus, the Chicopee court had needlessly gone

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\(^{117}\) Rhone-Poulenc S.A. v. Dann, 507 F.2d 261 (4th Cir. 1974).

\(^{118}\) 288 F.2d 719 (4th Cir.), cert. denied, 368 U.S. 825 (1961).

\(^{119}\) Id. at 724.
through the two-pronged analysis, having failed to recognize the existence and effect of section 132.

Thirteen years later, in *Rhone-Poulence S.A. v. Dann*, an amendment to the plaintiff-patentee’s specification was called into question. The Fourth Circuit upheld the claims in issue because the amendment did not add “‘new matter,’ the introduction of which is precluded by 35 U.S.C.A. section 132.” The court in *Rhone-Poulenc*, therefore, recognized the total ban on new matter in section 132 where the amendment at issue was in the specifications and not in the claims, as was the case in *Chicopee* and in *Muncie Gear*.

Because section 132’s ban on new matter distinguishes not between amendments to the specification and amendments to the claims, the recognition of section 132 in *Rhone-Poulenc* logically also should have occurred in *Chicopee*, but it did not. As a result, whether the Fourth Circuit will continue to apply the two-pronged test of *Muncie Gear* when claims are amended is not clear; there is post-1952 Fourth Circuit authority for exclusive reliance on both section 132 and the *Muncie Gear* test.

2. The Fifth Circuit

The Fifth Circuit has twice considered the *Muncie Gear* decision, adopting the late disclosure interpretation both times. The first case was *Tubular Service & Engineering Co. v. Sun Oil Co.* It concerned amendments to a patent application for which the 1952 Patent Act was not relevant. In conducting its two-pronged test under *Muncie Gear*, the court explained that because it found “no material departure . . . between the monopoly [originally] asserted before the Patent Office and that . . . claimed [by amendment],” the court had no reason to analyze the second “prior public sale or use” prong of the test. The claims in issue in *Tubular Service* were held valid and infringed.

Then, in 1973, the Fifth Circuit rendered its decision in *Penn*
Yan Boats, Inc. v. Sea Lark Boats, Inc., adopting per curiam the district court opinion as its own. Penn Yan Boats involved amendments directly subject to the terms of the Act. The district court recognized that, under "the so-called doctrine of 'late claiming' as expressed in Muncie Gear," claims added via amendment must be adequately supported by the originally filed application, i.e., they must not contain new matter. The court then continued by expressing its awareness of the examiner's finding under 35 U.S.C. section 132 that the amendments in issue did not contain new matter. The court made no further reference to section 132, failing to recognize how the section had rendered its analysis under Muncie Gear totally unnecessary.

3. The Seventh Circuit

The Seventh Circuit has correctly interpreted Muncie Gear in the "late disclosure" fashion, yet its decisions present a confusing and contradictory array of approaches toward determining the validity of an amendment. Although this circuit has used and continues to use both section 132 and the literal interpretation of Muncie Gear espoused herein.

127. 359 F. Supp. at 966.
128. Id.

While there is some questionable language in the Faulkner opinion from which one might argue that the case adopted the late claiming interpretation of Muncie Gear, the court clearly held that the claims in issue were invalid under Muncie Gear because they had "wholly failed to disclose mention of the invention asserted under [the] amendments [in issue.]" Faulkner, 561 F.2d at 680. This fact combined with the three prior holdings of the Seventh Circuit, which had each adopted the late disclosure interpretation of Muncie Gear, compel the conclusion that the Seventh Circuit adheres to the literal interpretation of Muncie Gear espoused herein.


ods of analysis, often in the same opinion,\textsuperscript{133} it consistently passes up the opportunity to resolve the contradiction of section 132 inherent in the two-pronged analysis of \textit{Muncie Gear}.

\textit{Helms Products, Inc. v. Lake Shore Mfg. Co.},\textsuperscript{134} decided in 1955, was the first of the Seventh Circuit cases subject to the 1952 Act in which the validity of an amendment that had allegedly added new matter was an issue on appeal. The plaintiff-patentee in \textit{Helms Products} had amended the specification by adding more detail to the description of his invention.\textsuperscript{135} The court held, "35 U.S.C.A. [section] 132 provides that: '*** No amendment shall introduce new matter into the disclosure of the invention.' . . . We think the amendments made in the instant case were [not new matter]."\textsuperscript{136}

Five years later, in \textit{Binks Manufacturing Co. v. Ransburg Electro-Coating Corp.},\textsuperscript{137} the Seventh Circuit failed to recognize the full impact of section 132 which it had quoted in \textit{Helms Products}. When the defendant in \textit{Binks Manufacturing} raised the "late claiming" defense, the court first held that the claims in issue \textit{did not add new matter} in violation of section 132.\textsuperscript{138} Then, not recognizing the effect of that holding on the two-pronged test of \textit{Muncie Gear}, the court stated further, "\textit{Muncie Gear} . . . is not applicable. In the instant case the original application disclosed the basis for the amended claims and there is no evidence of public use more than one year before the invention was first presented to the Patent Office."\textsuperscript{139} The inconsistency of the two holdings is immediately apparent; the "public use or sale" prong of the amendment analysis was made irrelevant by section 132.

The confusing use of both section 132 and the \textit{Muncie Gear} test in \textit{Binks Manufacturing} has never been resolved by the Seventh Circuit. Indeed, subsequent opinions have only enhanced the confusion. Although several Seventh Circuit decisions rendered after \textit{Binks Manufacturing} was decided have continued to place exclu-

\begin{footnotes}
\item 125 supra; Aerosol Research Co. v. Scovill Mfg. Co., note 125 supra; Helms Prods., Inc. v. Lake Shore Mfg., Inc., note 125 supra.
\item 132. See note 124 supra.
\item 134. 227 F.2d 677 (7th Cir. 1955).
\item 135. \textit{Id.} at 679.
\item 136. \textit{Id.}
\item 137. 281 F.2d 252 (7th Cir. 1960), \textit{appeal dismissed}, 366 U.S. 211 (1961).
\item 138. \textit{Id.} at 257.
\item 139. \textit{Id.}
\end{footnotes}
sive reliance on section 132,\(^{140}\) as was done in *Helms Products*, others have turned solely to the two-pronged analysis of *Muncie Gear*.\(^{141}\) To complete the confusion and continue the methodology of *Binks Manufacturing*, still another Seventh Circuit decision has again proceeded to analyze an amendment under both section 132 and the two-pronged test of *Muncie Gear*.\(^{142}\) This continued use of both methods of analysis should be recognized for what it is—an incomplete application of a simple federal statute resulting in a confusing state of Seventh Circuit law.

4. The Ninth Circuit

In 1960, the Ninth Circuit rendered the first\(^{143}\) of its three decisions that have adhered to the late disclosure interpretation of *Muncie Gear* when a defense based on the decision was raised. In that case, *Aetna Steel Products Corp. v. Southwest Products Co.*\(^{144}\) the court noted that “35 U.S.C. section 132 provides that no amendment shall introduce new matter into the disclosure of the invention.” The court continued:

> While this section was enacted in 1952, after the amendment here involved, that much of the section which excludes new matter is no more than a codification of the existing law. . . . As stated in *Muncie Gear* . . . : ‘The claims in question are invalid if there was public use, or sale of the device which they are claimed to cover, more than two years before the first disclosure thereof to the Patent Office.’\(^{145}\)

Apparently viewing the two-pronged test of *Muncie Gear* as being co-extensive with the ban of section 132 (which, of course, it is not), the court rendered alternative holdings against the validity of the claims for either adding new matter five years after the filing of the original application and for being obvious under the prior

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144. 282 F.2d at 138.

145. *Id.*
The Aetna Steel decision is typical of the Ninth Circuit's failure to acknowledge the effect which section 132 has had on the Muncie Gear two-pronged test. The two Ninth Circuit cases which followed, Aetna Steel, Locklin v. Switzer Bros., Inc.\textsuperscript{147} and Pursche v. Atlas Scraper and Engineering Co.,\textsuperscript{148} relied exclusively on the Muncie Gear test without mentioning section 132. Thus, the Muncie Gear test is still followed exclusively in the Ninth Circuit despite its one-time recognition of section 132.

**Exclusive Reliance Upon Section 132**

Two appellate courts, the Third Circuit and the Court of Customs and Patent Appeals, have turned exclusively to section 132 when the validity of an amendment was put in issue on appeal. Neither court has, however, addressed the effect of section 132 upon Muncie Gear's two-pronged test.

1.  The Third Circuit

In 1972, the Third Circuit decided \textit{Hadco Products, Inc. v. Walter Kidde & Co.},\textsuperscript{149} in which the court made footnote reference to section 132 when it noted that the patentee's application had been amended three times. The court acknowledged that "[t]he addition of new matter to the disclosure by means of an amendment is expressly prohibited under 35 U.S.C. [section] 132."\textsuperscript{150} After apparently giving deference to the opinion of the patent examiner who had found that the amended claims had not added new matter,\textsuperscript{151} the court went on to hold the patent invalid for obviousness.\textsuperscript{152}

\textit{Hadco} is important for its recognition of the flat ban on the addition of new matter under section 132, prior public use or sale regardless. Assuming that the Third Circuit would adopt the late disclosure interpretation of Muncie Gear, the employment of Muncie Gear's two-pronged test by a court in the circuit will thus frustrate not only the plain wording of section 132, but also the Third Circuit's footnote acknowledgment of the Section in \textit{Hadco}.

\textsuperscript{146} \textit{Id. at 334.}
\textsuperscript{147} 299 F.2d 160, 167 (9th Cir. 1961), \textit{cert. denied}, 369 U.S. 891 (1962).
\textsuperscript{148} 300 F.2d 467, 476-77 (9th Cir. 1962), \textit{cert. denied}, 371 U.S. 959 (1963).
\textsuperscript{149} 462 F.2d 1265, 1267 n.3 (3d Cir. 1972).
\textsuperscript{150} \textit{Id.}
\textsuperscript{151} \textit{Id.}
\textsuperscript{152} \textit{Id. at 1276.}
2. The Court of Customs and Patent Appeals

As might be expected, the Court of Customs and Patent Appeals has repeatedly recognized the existence of section 132 and its ban on the addition of new matter. It has not yet dealt with *Muncie Gear* in connection with an amendment subject to the 1952 Patent Act, however.

In its only case dealing with *Muncie Gear*, the Court of Customs and Patent Appeals in *In re Ruscetta* equated the holding of *Muncie Gear* with the statutory bar of section 102(b). Said the court:

> In the Muncie Gear Work case the court predicated its decision on that part of R. S. 4886 which is now codified in section 102(b) dealing with events which constitute bars to a patent if they occur more than a year before the applicant’s effective filing date in the U.S. A filing date, to be effective, must be that of an application which supports the claims.

The court found that the continuing application in question was not entitled to the filing date of the parent application because it contained new matter.

*In re Ruscetta* is important because it reveals that the Court of Custom and Patent Appeals does view *Muncie Gear* as requiring the invalidation of claims only when they have added new matter to the disclosure of the invention one year after public sale or use. Whether this court sees the effect of section 132 on its interpretation of *Muncie Gear* is still a question. Presumably, however, this court, being as familiar as it is with the patent laws, would recognize section 132 for what it does with respect to an analysis of claims under the test of *Muncie Gear*.

A NON-STATUTORY LATE CLAIMING DOCTRINE

The Second Circuit is the only federal appellate court that has adopted the late claiming defense to invalidate claims not containing new matter when added via amendment. Hence, although it has had two occasions to consider the ban of section 132 on new

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155. *Id.* at 691 (emphasis in original).
156. *Id.*
157. *See* note 7 supra.
matter,\textsuperscript{158} it has had no reason to consider the relationship between the two-pronged test of \textit{Muncie Gear} and section 132.

In a series of pre-1952 decisions, the Second Circuit first took an ambiguous stance on its interpretation of \textit{Muncie Gear}. Beginning with \textit{Interchemical Corp. v. Sinclair and Carroll Co.}\textsuperscript{159} in 1944, this court announced that it would hold claims invalid under \textit{Muncie Gear} if added by amendment two years after public use or sale of a device embodied in the claims if they “alter the invention by introducing claims not previously described as was done in \textit{Muncie Gear}.” The court in \textit{Interchemical} held the claims in issue valid, however, because they had added matter which was substantially equivalent to that which was originally described.\textsuperscript{160} Whether the court felt that a claim not “originally described” was one which added new matter was not clear.

Then came \textit{Engineering Development Laboratories v. Radio Corporation of America} in 1946.\textsuperscript{161} In a fairly lengthy but somewhat confusing discussion of the law on point, the court in \textit{Engineering Development} seemed to say that what is critical in invalidating claims under \textit{Muncie Gear} is a finding that they be directed toward a “new invention” not previously claimed.\textsuperscript{162} Since the claiming of a different or new invention is synonymous with the claiming of new matter,\textsuperscript{163} the court had seemingly adopted the late disclosure version of the \textit{Muncie Gear} test.\textsuperscript{164}

The Second Circuit reiterated the terminology of \textit{Engineering Development} in \textit{R.U.V. Engineering Corp. v. Borden Co.} in


\textsuperscript{159} 144 F.2d 842, 846 (2d Cir. 1944), rev’d on other grounds, 325 U.S. 327 (1945).

\textsuperscript{160} Id.

\textsuperscript{161} 153 F.2d 523, 526 (2d Cir. 1946) (L. Hand, J.).

\textsuperscript{162} The court in \textit{Engineering Development} made a conscious effort to avoid taking a clear position on its view of the full extent of the \textit{Muncie Gear} decision, but it did emphasize that, in its view, the facts of \textit{Muncie Gear} had involved the claiming of “new invention” via the amendment in question in the case. 153 F.2d at 526.

\textsuperscript{163} See notes 45-47 supra and accompanying text.

\textsuperscript{164} Judge Learned Hand did say that the claiming of a “new invention” does not involve “only a minor change necessary to secure complete protection for what the applicant originally intended to secure for himself” nor does it involve “mak[ing] express that which would have been regarded as an equivalent of the original [or incorporating] into one claim what was to be gathered from the perusal of all if read together.” 153 F.2d at 526. This negative definition of “new invention” is also in full accord with the positive definition of “new matter” which the Supreme Court has developed. See notes 45-47 supra and accompanying text.
1948. This is understandable, since both opinions were written by the same judge, Learned Hand. The case appeared to leave the focus on whether the claims in question were directed toward a "new invention."  

The last in the pre-1952 series of Second Circuit decisions concerning its interpretation of Muncie Gear was also written by Judge Learned Hand in Harries v. Air King Products Co. in 1950. In line with his prior opinions, Judge Hand again stated that Muncie Gear had involved the claiming of a "new invention." In contrast with prior decisions, however, he muddied the water on the issue. The claims in issue in Harries were not directed to a "new invention," but the court intimated in dicta that an "expansion" of claims might be invalid, even though no new invention had been claimed, if added two years after prior public use or sale. Such an interpretation of the Harries dicta would, of course, result in a non-statutory late claiming defense, but the court went no further, leaving the issue unresolved in holding the claims in issue invalid.

In its first post-1952 decision, the Second Circuit failed to clarify its view of Muncie Gear. In Telechron, Inc. v. Parissi, the court of appeals adopted per curiam the district court's opinion, which had invalidated several broadened claims submitted by amendment more than the statutory period after public sale or use. It appeared, however, that the patentee had claimed new matter by changing the entire focus of the claims in issue from the invention disclosed in the original application. Nevertheless, since the district court's opinion is not entirely clear on this point, the Second Circuit's interpretation of Muncie Gear was still in flux.

The vacillation of the Second Circuit on the issue was finally resolved more than twenty-four years later in Kahn v. Dynamics

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165. 170 F.2d 688, 689 (2d Cir. 1948) (L. Hand, J.).
166. Id.
167. 183 F.2d 158, 160 (2d Cir. 1950).
168. Id.
169. As authority for this statement, Judge Hand cited not Muncie Gear but Crown Cork & Seal Co. v. Ferdinand Gutmann Co., 304 U.S. 159, 167-68 (1938). As explained in note 44 supra, the case held no such thing. The language from Crown Cork & Seal that evidently misled Judge Hand was, as also explained above, merely an attempt by the Court to limit its decision to the facts before it and not an announcement of any such rule of law.
170. 183 F.2d at 160.
172. Id.
Corp. of America with unfortunate results. In an alternative holding in Kahn, the district court had affirmatively espoused the view that Muncie Gear did create a non-statutory late claiming defense. In considering the defense, the district court explained,

it is immaterial . . . whether or not the claims in suit were supported by the application as originally filed. . . . The applicability of the defense is not dependent on whether the claims in issue are based on new matter added to the disclosures subsequent to the filing of the application, and is not rendered inapplicable because broader claims were present in the application as originally filed.

Thus, because Kahn, the plaintiff-patentee, had added claims which were directed to more specific subject matter not essentially the same as that claimed originally, the district court held the claims invalid.

The court of appeals in Kahn affirmed the district courts decision in all respects, but said very little with regard to the late claiming defense and its view of Muncie Gear. The opinion simply states that the claims were invalid because "[t]hey were not presented under either the original or the continuation application until more than one year after equipment substantially the same as that charged to infringe had been on sale or delivered to customers." The net effect of the Kahn decision was, of course, to give appeals court authority to the non-statutory late claiming defense in the Second Circuit.

As previously noted, two cases have been decided by the Second Circuit in which the validity of an amendment was called into question on appeal for the alleged addition of new matter. In both cases, Shaw v. E.B. & A.C. Whiting Co. and Triax Co. v. Hart-

175. Id. at 72-73.
176. Id. at 72.
177. Id.
178. 508 F.2d at 939, 943 (2d Cir.) (alternative holding), cert. denied, 421 U.S. 930 (1975).
179. 508 F.2d at 943.
180. Id.
181. See note 153 supra and accompanying text.
man Fabricators, Inc.,¹⁸³ the court clearly recognized that under 35 U.S.C. section 132 no new matter can be added to an amendment. In both cases the court found that the amendments in question did not add new matter to the disclosure of the invention.¹⁸⁴ No reference was made in either case to the Muncie Gear two-pronged test. The lack of recognition of the effect of section 132 on Muncie Gear is not surprising, however, given the Second Circuit's misunderstanding of the Muncie Gear holding based upon the addition of new matter via amendment two years after public use or sale.

CONCLUSION

The disagreement between the federal courts of appeal over the interpretation of the Muncie Gear doctrine is not surprising. After thirty-two years of repeated advocating by defense counsel and others of an interpretation of Muncie Gear that is contrary to its very language, reasoning, and holding, at least one of the appellate courts was bound to eventually be persuaded to accept the "late claiming" view of the decision. As it now stands, however, only the Second Circuit has accepted the late claiming interpretation—in direct conflict with the late disclosure interpretation espoused by the seven other circuits that have addressed the issue, as well as the Court of Claims and the Court of Customs and Patent Appeals.¹⁸⁵ Only in the Second Circuit will the form over substance difference between alterations made via an amendment and those made through a reissue proceeding continue to unjustifiably cause a total loss of rights in claims changed via amendment.

What is truly surprising is the uniform failure of federal appeals courts to recognize the effect of section 132 on the two-pronged test of Muncie Gear. This lack of recognition, causing continued analysis under the entire two-pronged test when the validity of an amendment is in issue, infuses the needless "prior public use or sale" issue into the analysis at trial and on appeal. It can also lead a confused court to an incorrect finding of validity when new matter has been added to an amendment (in violation of section 132) if public sale or use has not occurred at least one year prior to the date of amendment.

The lack of recognition of the effect of section 132 on the doc-

¹⁸⁴. 417 F.2d at 1106; 479 F.2d at 956-57.
¹⁸⁵. No cases have been found in the Eighth Circuit involving either the Muncie Gear doctrine or § 132.
trine of *Muncie Gear* is probably due to the fact that the courts deal with the case only when defense counsel advocate the late claiming interpretation. Thus, the court examines the defense only in an attempt to clarify the circuit's interpretation of the case. Nevertheless, the appellate courts should be aware of the relationship between the *Muncie Gear* doctrine and section 132. An express recognition of the relationship will not only reduce the number of issues dealt with at trial and the possibility of error, but also finally convince advocates of the late claiming twist that it will not be accepted within the circuit. When the validity of an amendment is suspect, the only salient consideration is whether the amendment added new matter in violation of 35 U.S.C. section 132.