54TH CONGRESS, 2D SESSION. } S. _____

Rufus L. B. Clarke

Protest on Removal

from Patent Office.

[illegible] ]

9—128

216 New Jersey Avenue
South East
Washington D.C

Hon. George H. Howe

Dear Sir

Some time since, I placed in the hands of Senator Lane Petition & Brief and Supplementary Brief & other papers, Challenging the power of the President to remove an Officer appointed by him & the Senate - & Especially does the Tenure of the Senator & Especially an Officer having no Executive duties, but only purely judicial. I understand it was duly presented to the Senate & referred to the Judiciary Committee of which you are Chairman.

I doubt if you must Executive time & with the Crowds of which would seem to be more important Matters than the right & power of the President to remove an Examiner in Chief of the Patent Office, this Case has been brought to your Attention

Of Course you are aware that the Republican Party by repeated acts of Congress & Especially by the Tenure of Office Act & the Impeachment Trial of Andrew Johnson & the Written Opinions of its ablest Expounders - is fully Committed to the doctrine laid & pressed by me, & as the Oldest record

Republicans. I ask a full &
Carefull Consideration

Will it be agreeable to you to
designate time & place when I can
call & have a 15 Minutes interview, in
order that I may learn what steps are
necessary, & what I may do to prepare
the Case properly by furnishing a brief
Synopsis of Authority &c &c

Hoping that your attention has
not been Called to the Case, I enclose
a Copy of Orders Brief

Respectfully
Your Obt. Svt.
R L B Clarke

# MEMORANDUM

In the matter of the Confirmation of J. H. Brickenstein as Examiner-in-Chief in the U. S. Patent Office.

In the matter of the confirmation of a successor to Mr. R. L. B. Clarke, removed from the position of Examiner-in-Chief in the United States Patent Office, it has been urged on his behalf that his successor should not be confirmed for the reasons—

(1) That the President has no right to remove an Examiner-in-Chief, except by and with the consent of the Senate, and

(2) That the board of Examiners-in-Chief in the United States Patent Office is an inferior court or tribunal under Art. III, Sec. 1 of the Constitution, and therefore these Examiners-in-Chief hold office during good behavior.

Neither of these reasons is thought to be valid.

No discussion of the first ground seems necessary.

As to the second, the following considerations are presented, and it may be well at the outset to call attention to the character and duties of this board of Examiners-in-Chief.

The important sections of the statute having reference to this board are the following:

"SEC. 476. There shall be *in the Patent Office* a Commissioner of Patents, one Assistant Commissioner, and *three examiners-in-chief*, who shall be appointed by the President, by and with the advice and consent of the Senate. All other officers, clerks, and employés authorized by law for the Office shall be appointed by the Secretary of the Interior, upon the nomination of the Commissioner of Patents.

"SEC. 482. The examiners-in-chief shall be persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the appellant, to *revise and determine upon* the validity of the adverse decisions of examiners upon applications for patents, and for re-issues of patents, and in interference cases: and, when required by the Commissioner, they shall hear and

report upon claims for extensions, and perform such other like duties as he may assign them.

"SEC. 4909. Every applicant for a patent or for the re-issue of a patent, *any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners-in-chief; having once paid the fee for such appeal.*

"SEC. 4910. If such party is dissatisfied with the decision of the examiners-in chief, he may, on payment of the fee prescribed, appeal to the Commissioner in person."

It will be noted that the main and practically the only duty of this board is to revise and determine upon the validity of the adverse decisions of the primary examiners.

Though this function of revising the decision of the primary examiners is necessarily exercised in a judicial way, it is at once apparent that the powers of this tribunal are not those of a court.

Nowhere does the statute so refer to it. It is a tribunal IN THE PATENT OFFICE, has no jurisdiction outside of it, has no seal, issues no process, is not a court of record; it can not punish for contempt, can not summon witnesses, can not require evidence to be produced before it, can not and does not issue any judgments or decrees. Its decisions take effect only through the Commissioner of Patents. Even if it decides that an applicant is entitled to a patent, and the patent is granted, it is signed by the *Commissioner of Patents*, and the patent is, when granted, only the evidence of a *prima facie* right whose validity has subsequently to be determined by the Federal courts.

In the conduct of its proceedings it is governed by rules established with the approval of the Secretary of the Interior by the Commissioner. Its decisions are appealable to him and his decisions are binding upon the Examiners-in-Chief.

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The Commissioner has had occasion to insist upon this point with reference to the very Mr. Clarke above referred to.

In the case of Clymer *v.* Riley, C. D. 1874, p. 73, General Legget, the then Commissioner, said:

"The question * * * has been twice before the Acting Commissioner, and in both instances clearly and positively decided in the affirmative, and that should be so considered by the Examiner. In the second decision the Acting Commissioner takes occasion to suggest the impropriety of the Examiner or Examiner-in-Chief having revived this question in the further examination of the case.

"Yet in the final action of the board, one member (Mr. Clarke), with both of the Acting Commissioners before him, and in full view of said suggestion, takes occasion again to revive and discuss the question, in a manner, too, not altogether courteous. In doing this he has been guilty of an official impropriety that can not be passed in silence. The official decisions and directions of the Commissioner and Acting Commissioner are *binding upon all in the office, including the Examiners-in-Chief,* until reversed by the Secretary. There is but one course open to officers and employes in the Patent Office who deny this relation between the head of the office and the subordinates."

The case of Snowden *v.* Pearce, MS. (App. Cases) Dunlop, J., decided in 1861 is relied upon as authority for the contention that the board of Examiners-in-Chief is a tribunal independent of the Commissioner of Patents.

The statements made by the judge in that case were not necessary to the decision of the case and were purely *obiter dicta.* Moreover, in Hull *v.* Commissioner of Patents, 7 O. G. 559, decided in 1875, it was expressly decided by the majority of the Supreme Court of the District of Columbia, that the Commissioner had the right to revise even the favorable decisions of the Examiners-in-Chief.

It thus appears that surrounding and controlling transactions of this board with its limited jurisdiction, is the authority of the Commissioner of Patents and the Secretary of the Interior.

Yet it is seriously contended that this board of Examiners-in-Chief is a United States Court under Art. III, Section 1, of the Constitution.

The provision of the Constitution referred to is Art. III, Section 1.

"The judicial power of the United States shall be vested in one Supreme Court, and in such *inferior Courts* as the Congress may from time to time ordain and establish. The judges, both of the Supreme and inferior courts, shall hold their offices during good behavior," etc.

Article I, Section VIII, provides:

The Congress shall have power—

"9. To constitute *tribunals* inferior to the Supreme Court."

The authority alleged to support this contention is Butterworth *v.* Hoe, 112 U. S., 50.

In Butterworth *v.* Hoe, the court was considering the relative powers of the Commissioner of Patents and the Secretary of the Interior, and in stating summarily the various sections of the statute relating to the procedure to be followed in the Patent Office, used the following language:

"The claim is examined in the first instance by a primary examiner assigned to the class to which it belongs; if twice rejected by him, the applicant is entitled (R. S. Sec. 4409) to appeal from his decision to that of the board of Examiners-in-Chief, *constituted a tribunal for that purpose;* and from their decision if adverse, he may appeal to the Commissioner in person. R. S. 4910."

The word "tribunal" is used in its ordinary descriptive

sense, and its use does not necessarily mean that the Supreme Court regarded this board as a court, much less as a United States Court under Art. III of the Constitution.

The character of this board of Examiners-in-Chief was not under consideration, and there was nothing in the case to remotely suggest that there was any necessity for defining its status. It certainly never occurred to the judges to imagine that this appeal board in an executive bureau of an executive department of the Government was a United States Court.

The whole argument of Mr. Clarke is based upon the assumption that because a *tribunal*, having duties judicial or quasi-judicial in character is created by act of Congress, that it thereby becomes a United States Court, whose judges shall hold their offices during good behavior.

That this is an entirely erroneous assumption is shown by the fact that actual courts of justice having all the powers of courts in the legal sense of the term, have been created by Congress, and have been expressly decided by the Supreme Court, not to be United States Courts, or within the 3d Art. of the Constitution.

Thus, in McAllister *v.* U. S., 141 U. S., 174, the question arose as to whether the Territorial Courts came under this provision of the Constitution and the Supreme Court expressly held that they did not, and that a judge of such court was not excepted from that provision in the Tenure of Office Act (now repealed) authorizing the President to suspend or remove civil officers "except judges of the Courts of the United States."

A number of cases are referred to by the court.

In American Ins. Co. *v.* Canter, 1 Pet., 511, 546, the court said:

"We have only to pursue this subject one step further, to perceive that this provision of the Constitution does not apply to it. The next sentence declares that 'the

judges, both of the Supreme and inferior courts, shall hold their offices during good behavior.' The judges of the Superior Courts of Florida hold their offices for four years. These courts, then, are not constitutional courts, in which the judicial power conferred by the Constitution on the General Government can be deposited. They are incapable of receiving it. They are legislative courts, created in virtue of the general right of sovereignty which exists in the Government, or in virtue of that clause which enables Congress to make all needful rules and regulations respecting the territory belonging to the United States. The jurisdiction with which they are invested is *not a part of that judicial power, which is defined in the third article of the Constitution*, but is conferred by Congress, in the execution of those general powers which that body possesses over the Territories of the United States."

And in Benner *v.* Porter, 9 How., 235, 242, 243:

"Congress must not only ordain and establish courts within a State, and prescribe their jurisdiction, but the judges appointed to administer them *must possess the constitutional tenure of office* before they can become invested with any portion of the judicial power of the Union. There is no exception to this rule in the Constitution."

No terms through which the Examiners-in-Chief shall hold office is specified in the Statute.

The correct inference from the omission in the statute of any statement defining the term of office is, therefore, that this board of Examiners-in-Chief is *not* a Federal Court, *because it does not possess the constitutional tenure of office.*

If the Congress had intended to make this board of appeals an inferior court in the constitutional sense, they would have expressly made it so, and would have specified that the Examiners-in-Chief should hold office during good behavior.

As it is, the statute provides only that the Examiners-

in-Chief shall, like the Commissioner of Patents and his Assistant, be appointed by the President by and with the consent of the Senate, and shall have certain specifically defined duties.

And it is to be noted that the commissions of those persons appointed to be Examiners-in-Chief now state, and have for many years stated, that they are to hold office "during the pleasure of the President for the time being."

There is, however, a more fundamental reason for not regarding this board as a U. S. Court.

It was the express purpose of the Constitution to keep as distinct as possible the judicial and executive branches of the Government.

If this appeal board is a Federal Court we have the curious anomaly of a United States Court inserted into an executive bureau of an executive department between an executive subordinate and an executive head, the latter having authority to review the court's decisions.

If Congress had intended to create or had been aware that they were creating any such judicial monstrosity, they would have taken great care definitely so to enact.

No authorities are necessary to show that the executive and judicial branches of the Government have always been kept rigidly apart. The following citations may however be interesting.

The Supreme Court in the case of Gordon *v.* U. S., 2 Wall., 561, refused to entertain an appeal from the Court of Claims as then constituted, because its decisions were reviewable by the Secretary of the Treasury, an executive officer, and that fact denied to it the judicial power from the exercise of which alone appeal could be taken to the Supreme Court.

So also in U. S. *v.* Ritchie, 17 Howard, 525, it seems to have been assumed that no appeal could be taken from a board of executive officers (land commissioners) to a

court, and the jurisdiction was sustained only on the ground that the actions were independent suits in which the questions were heard *de novo*, and both parties had full right to introduce evidence.

If a tribunal from which appeal lies to an executive officer is not an inferior court under Art. III of the Constitution, then this board of Examiners-in-Chief is not a Federal court.

It is, therefore, apparent that if this tribunal is a court at all it certainly is not an inferior court under Art. III of the Constitution, since no tenure of office during good behavior is specified in the statute creating it; that this board is entirely within the executive, not the judicial, branch of the Government; and that its members are therefore subject to removal by the President as are other executive officers.

J. H. Brickenstein,
Exr-in-Chief. U.S. Patent Off.

Columbus Junction, Iowa.
Febuary 10, 1896.

Hon.R.L.B.Clarke,
Washington, D. C.

My Dear Sir: Please accept my thanks for a copy of your brief and Protest presented to the Senate in the matter of your attempted removal by the President.....

The controlling question is seen to be as to whether the office is judicial or not. If it is that ends it. That the office is judicial to all intents and purposes the showing of the Brief goes to establish the fact beyond a doubt and makes your position in this regard invincible.

With all confidence in the result of your case before the Senate,

I am truly yours,
Francis Springer.

Judge Springer for many years Judge of the 1st Judicial District Iowa, and no man stands higher in the judiciary of the State.

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An opinion is asked as to the character of the Board of Appeals in the Patent Office.

We have always considered the Board of Appeals in the Patent Office as purely a judicial Tribunal, without a single executive function, and wholly independent of the Commissioner or Secretary of the Interior.

There can be no question about this and never has been.

H.E.Paine, Ex.Com,of Pats;
Ellis Spear " " "
R.Dyrenforth" " " & Ex.Mem ofBoard.
W.H.Doolittle Ex. Asst.Com.of Pats.
R.J.Fisher Ex.of Brd. Ex.Asst.Com,Pats.
V.D.Stockridge " " " " " "
H.A.Seymour.

MASON, FENWICK & LAWRENCE,
PATENT LAWYERS, SOLICITORS AND EXPERTS,
PRACTICE IN U. S. SUPREME COURT,
OFFICES: 602 F ST., NEAR U. S. PATENT OFFICE.

ESTABLISHED 1861.

HOOD BUILDING,
TELEPHONE 440.

ORIGINAL MEMBERS OF THE FIRM:
CHARLES MASON,
Former Commissioner of Patents.
ROBERT W. FENWICK,
Patent Counselor and Expert.
DEWITT C. LAWRENCE,
ATTORNEY AND COUNSELOR AT LAW,
Nine years an officer in Patent Office in capacity of Chief Clerk and Acting Commissioner of Patents, Examiner and member of "Board of Appeals."
EDWARD T. FENWICK,
Patent Lawyer.

Washington, D. C., April 30- 1896

Judge R. L. B. Clarke

Dear Sir.

From the following expressed opinion of Judge Charles Mason, former Commissioner of Patents, it will be seen that he held firmly to the view that the Examiners in Chief of the Patent Office, were Judicial Officers, and that the Commissioner of Patents could not control their decisions when made in cases appealed to them, unless

an appeal was regularly taken
to him as a Judicial Officer

Yours Truly—

Marm Selwick Lawrence

Extract from argument of Ex-Commissioner of Patents, Chas. Mason--in the Gordon Ocean Telegraph Cable.

"A wide distinction is to be observed in relation to the authority of the Commissioner in different circumstances. In matters of administration his is the paramount controlling authority. But the granting of a patent is a judicial act. In reference to such cases the law has provided a series of appellate tribunals, of which he is one. When acting in that capacity, he can reverse the action of the Examiners-in-Chief. But like all other appellate tribunals, he must wait in that capacity till a case is duly presented to him, before he can intermeddle with it. He cannot decide beforehand in matters of that nature.

The adjudication of difficult legal questions was, in fact, one of the prime purposes for which this board was organized, and in these adjudications their power was left unrestricted. If doubts exist in any mind upon this subject, they will be dissipated by examining the debate in the House of Representatives (where this act of 1870 originated) while this subject was under discussion there. (See Cong. Globe for 1869, part 4, p. 2855.)"