

# The University of Chicago

Metallurgical Laboratory

MIDWAY 0800  
EXT. 1290

September 14, 1943

Mr. J. P. Hume  
Wilkinson, Huxley, Byron & Knight  
1350 North State Street  
Chicago, Illinois

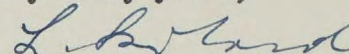
Dear Mr. Hume:

Enclosed you will find Captain Lavender's letter with my answer attached to it, and also the English translation which I believe represents Mr. Adam's representations with pencil corrections which were probably made by my lawyer.

I am willing to represent that the agreement does not cover any patents for which I apply after October 15, 1941. There is no provision in the agreement which would cover such patent applications, whereas according to the fourth paragraph of Article 3, patents for which I applied before October 15, 1941 might fall under the agreement under certain conditions. I am also willing to certify the translation of the last two paragraphs of Article 4, in case these two last paragraphs should be considered as relevant.

It would seem to me that Captain Lavender either should accept my representations as given above or else obtain a certified translation of the agreement himself and use his own judgment. In writing to Captain Lavender, please keep in mind that I do not wish to appear uncooperative.

Very truly yours,



L. Szilard

P.S. You might draw Captain Lavender's attention to the fact that the preamble of the agreement which contains the word "integration" could hardly be considered a correct translation of the German origin, and that the German original was obviously meant to represent the preliminary agreement which was concluded by correspondence.

ap/Enc.

WILKINSON, HUXLEY, BYRON & KNIGHT

COPY

FIRST NATIONAL BANK BUILDING

CHICAGO  
Zone 3

September  
16th  
1943

CAPTAIN ROBERT A. LAVENDER, U.S.N.  
1530 P Street, N.W.,  
Washington, D.C.

Dear Sir:

I am writing to you on behalf of Dr. Szilard, who has advised you in his letter of September 14th that he was forwarding your letter of September 2nd to me with the suggestion that I write to you directly with respect to your request for an approved translation of the 1936 agreement.

Dr. Szilard consulted me because in his effort to draft a satisfactory translation he found that in many instances the selection of particular English words or terms to the exclusion of others necessarily involved an interpretation of the agreement from the standpoint of its legal significance. Dr. Szilard naturally hesitates to assume the role of a court or to adopt conclusions of law with respect to the agreement such as would be necessary to comply with your request. I am sure you will appreciate that no literal translation of a legal document is completely reliable or correct, but necessarily depends upon the construction placed upon that document by the translator.

Notwithstanding what has been said, Dr. Szilard has no hesitation in representing to the Government that the 1936 agreement extends only to inventions for which patent applications were applied for prior to October 15, 1941.

In view of this fact and the further fact that your request will require a legal interpretation of the agreement which Dr. Szilard wishes to avoid, it is sincerely hoped that your purposes will not require his approval of any translation of the agreement.

Capt. Robert A. Lavender, U.S.N.  
Page 2 - Sept. 16, 1943

Dr. Szilard has asked me to also state that the word "integration", which is found in the first line of the translation which you have, does not properly express the meaning of the corresponding term employed in the original German text, as he contends that the German text itself expresses the entire agreement between the parties, and incorporates the tentative understanding set forth in the prior correspondence. Accordingly, it is apparent that the letters themselves do not bear upon the agreement which was entered into.

Very truly yours,

WILKINSON, HUXLEY, BYRON & KNIGHT

By James P. Hume

JPH-NK

\* HENRY M. HUXLEY  
CHARLES L. BYRON  
MILTON T. MILLER  
\* HOWARD W. HODGKINS  
RALPH MUNDEN  
JAMES P. HUME  
HOWARD SOMERVELL  
RUSSELL H. CLARK  
GORDON F. HOOK

\* ENLOE WILKINSON  
GERRIT P. GROEN

\* ON LEAVE

WILKINSON, HUXLEY, BYRON & KNIGHT

FIRST NATIONAL BANK BUILDING

CHICAGO

Zone 3

September  
16th  
1943

GEORGE L. WILKINSON  
COUNSEL  
HERVEY S. KNIGHT  
RETIRED

CLARENCE F. POOLE  
ASSOCIATE ATTORNEY

TELEPHONE  
RANDOLPH 4848

Dr. Leo Szilard,  
Metallurgical Laboratory,  
The University of Chicago,  
Chicago, Illinois.

Dear Dr. Szilard:

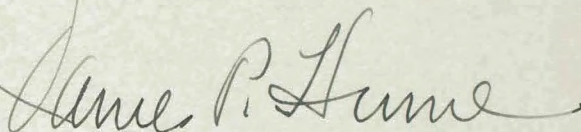
I am returning to you the various papers which  
I received from you yesterday.

I am also enclosing copy of a letter which I  
have sent to Captain Lavender. You will notice that I  
have revised the letter to incorporate the suggestion  
that you made to me on the telephone.

Very truly yours,

WILKINSON, HUXLEY, BYRON & KNIGHT

By



JPH-NK

Enc.

\* HENRY M. HUXLEY  
CHARLES L. BYRON  
MILTON T. MILLER  
\* HOWARD W. HODGKINS  
RALPH MUNDEN  
JAMES P. HUME  
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RUSSELL H. CLARK  
GORDON F. HOOK

\* ENLOE WILKINSON  
GERRIT P. GROEN

\* ON LEAVE

WILKINSON, HUXLEY, BYRON & KNIGHT

FIRST NATIONAL BANK BUILDING

CHICAGO 3

November  
13th  
1943

GEORGE L. WILKINSON  
COUNSEL  
HERVEY S. KNIGHT  
RETIRE

CLARENCE F. POOLE  
ASSOCIATE ATTORNEY

TELEPHONE  
RANDOLPH 4848

MR. LEO SZILARD,  
Metallurgical Laboratory  
THE UNIVERSITY OF CHICAGO,  
Chicago, Illinois.

Dear Mr. Szilard:

I am enclosing an original and one copy of an assignment conveying U.S. Patent No. 2,161,985 to Benjamin Liebowitz, of New Canaan, Connecticut, which is to be executed by you before a Notary Public. The copy is for your files.

I am also enclosing an assignment to Mr. Liebowitz conveying British patent No. 440,023, of December 12, 1935. There are two red-line copies of this assignment, both of which are to be executed, and one copy for your files. The blank spaces in the British assignment have been lettered and the note attached will indicate the inserts to be made.

If there are any questions, please call me on the telephone.

Very truly yours,

WILKINSON, HUXLEY, BYRON & KNIGHT

By

*James P. Hume*

JPH-NK

Enc.

Dear Mr Sjilard

Enclosed is the so called  
"Corrected Draft" which I have  
further revised. I have not  
change in any respect the  
substance of the writing,  
I have only improved the  
language and made certain  
of its provisions clear. Look  
it over carefully & see if it  
is alright - I think it is.  
You may call me at the  
Office on Tuesday. - address  
me at the Chase Hotel  
St Louis on Wednesday through  
Saturday or at the Bellevue  
Stratford Hotel Philadelphia  
on Sunday Nov. 28 through  
Dec. 3<sup>rd</sup> I may be in  
Washington on Dec 1<sup>st</sup> in  
which address care of my  
father, Thomas Hume - 917-15<sup>th</sup>  
St. Washington, also it is possible  
I may be in New York on Dec  
1<sup>st</sup> or 2<sup>nd</sup> in which case  
address care - Mrs Parmelee  
McFadden - 25 Beekman Place N.Y.

Regards  
JPHume

~~SECRET~~

*Minor  
amendments*

*Corrected Draft*

*11/17/43*

*FOL*

MEMORANDUM OF AGREEMENT made this                      day of

1943 between Leo Szilard of Chicago, Illinois

(hereinafter referred to as Szilard) and the Government  
of the United States (hereinafter referred to as the  
Government) represented for the purpose hereof by the  
United States Engineers, Manhattan District, War Department.

*Contracting Officer of the*

WHEREAS, Szilard, ~~as joint inventor~~, has invented  
certain new and useful improvements in Methods for Testing  
Materials, for which he is about to file an application for  
U. S. Letters Patent, identified as S-1/501, and believes  
that he now owns certain rights, privileges, and interests

*the* hereinafter granted, and

*relative  
1 thereto,*

WHEREAS, Szilard believes that he is the sole or  
joint inventor of certain inventions, discoveries and  
improvements in the field of Nuclear Physics made prior to  
1 November 1940; and

WHEREAS, Szilard believes that he is now the owner  
of the entire right, title and interest in and to all in-  
ventions, discoveries and improvements made by him in the  
field of Nuclear Physics prior to 1 November 1940 and  
hereinafter granted, and that he now is the owner of an  
undivided right, title and interest in and to any and all  
inventions, discoveries and improvements jointly made by him  
with others in the field of Nuclear Physics prior to 1  
November 1940 *of the* and hereinafter granted; and

WHEREAS, Szilard believes that he is the sole or  
joint inventor of certain inventions, discoveries and  
improvements in the field of Nuclear Physics made after 1  
November 1940, and alone or jointly has conceived and  
developed methods, apparatus, devices and compositions

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~~SECRET~~

And believe, that he now owns the heretofore granted rights, privileges and interest relative thereto,

in said field after 1 November 1940, all while in the employ of the Trustees of Columbia University in the City of New York and/or The University of Chicago starting 1 November 1940, pursuant to certain employment agreements with said Universities, respectively, and admits <sup>that</sup> he is obligated to do whatever is necessary to take out patents on any and all inventions, discoveries and improvements in any and all countries made by him during the periods of said employments as and when requested by either of said Universities <sup>the University of Chicago</sup> ~~to the~~ <sup>upon request of the University of Chicago</sup> ~~case may be to said Universities or to other assignees designated by either of them~~ and <sup>to</sup> assign all rights, title and interest in <sup>(and to)</sup> any and all sole or joint inventions, discoveries and improvements <sup>(thereon), as well as</sup> any and all patents and applications thereof <sup>to the University of Chicago, or to other assignee designated by the University of Chicago;</sup> and

WHEREAS, the Government is desirous of acquiring the rights, privileges and interests hereinafter granted <sup>with</sup> ~~and~~ <sup>believed to be,</sup> ~~respect to Szilard~~ <sup>owned by Szilard</sup> at the present time, in and to said applications to be filed and identified as S-1/501, for Method of Testing Materials and in and to the inventions, discoveries and improvements disclosed therein; and the entire right, title and interest of Szilard in and to any and all sole or joint inventions, discoveries and improvements in the field of Nuclear Physics made prior to 1 November 1940 and now believed to be owned by Szilard; and

<sup>Szilard's</sup> ~~his~~ WHEREAS, the Government is desirous of acquiring <sup>his</sup> entire right, title and interest in and to any and all sole or joint inventions, discoveries and improvements ~~(heretofore (or hereafter))~~ made by Szilard while employed by the Trustees of Columbia University in the City of New York and/or the University of Chicago on behalf of the Government;

NOW THEREFORE to all whom it may concern, be it known that for and in consideration of the sum of  
to Szilard, in hand paid

~~SECRET~~

SECRET

by the Government and for other good and valuable considerations, the receipt of which is hereby acknowledged:

1. Szilard has sold, assigned, and transferred, and by these presents does sell, assign and transfer unto the Government as represented for the purpose hereof, by the Director of the Office of Scientific Research and Development, Office for Emergency Management, Executive Office of the President and/or his assigns, his entire right, title and interest that he now owns as joint inventor in the United States Patent Application, to be filed and identified as S-1/502, for the Method of Testing Materials and in and to the inventions, discoveries, and improvements disclosed in said United States Patent Application to be filed.

2. Szilard has sold, assigned and transferred and by these presents does sell, assign and transfer unto the Government as represented for the purpose hereof by the Director of the Office of Scientific Research and Development, Office for Emergency Management, Executive Office of the President and/or his assigns, his entire right, title and interest in and to any and all inventions, discoveries and improvements in the field of Nuclear Physics made by him alone or jointly with others prior to 1 November 1940 and in and to any and all Better's Patent wherever they may be granted thereon as well as reissues and extensions of said Letters Patent, together with any and all of his inventions covered by applications filed by him and subsequently abandoned, the same to be held and enjoyed by the said Government to the full end of the term or terms for which Letters Patent are or may be granted, reissued or extended, as fully and entirely as the same would have been held or enjoyed by him had this assignment not been made, excepting <sup>1</sup> from this provision United States Letters Patent No. 2161,985

However the assignment made in this paragraph 2 does not extend to

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~~SECRET~~

issued to Szilard 3 June 1939 and entitled "Process of Producing Radioactive Elements", British Patent No. \_\_\_\_\_, and Secret British Patent assigned to the British Admiralty in 1936, *or the inventions covered by said patents, or any of them.*

3. Szilard has sold, assigned and transferred and by these presents does sell, assign and transfer unto the Government as represented *for the purpose hereof by the* Director of the Office of Scientific Research and Development, Office for Emergency Management, *Executive Office of the* President and/or his assigns his entire right, title and interest in and to any and all inventions, discoveries and improvements (*heretofore (and hereinafter)*) made by him alone or jointly with others while employed by the Trustees of Columbia University in the City of New York and/or the University of Chicago, on behalf of the Government of the United States, *The assignment in this paragraph 3 is made by Szilard* in accordance with *request made by said* Universities.

4. Szilard agrees to make, execute, and deliver unto the Government or to the Director of the Office of Scientific Research and Development, Office for Emergency Management, Executive Office of the President and/or his assigns any and all papers, documents, affidavits, renewal, divisional and reissue applications, statements, or other instruments in such usual or other form, terms, and contents as may be required by the Government or the Director of the Office of Scientific Research and Development, Office for Emergency Management, Executive Office of the President or his assigns in or incident to the filing, prosecution or conduct of any and all applications, before as well as after the issuance of any Letters Patent thereon, or in the adjustment or settlement of any interferences or other actions or proceedings that said applications may encounter

*and at the request of the University of Chicago, which is hereby made by the affixing of the signature of a duly authorized person, acting for and on behalf of said University of Chicago*

SECRET

or in which they may become involved, and Szilard agrees that he will aid and assist the Government of the United States in every way in protecting the inventions as may be requested by the Government or the Director of the Office of Scientific Research and Development, Office for Emergency Management, Executive Office of the President or his assigns, except that any expenses <sup>incurred in connection with</sup> arising through extending such assistance <sup>shall</sup> will be paid <sup>by</sup> for the Government under proper arrangement <sup>to be made by</sup> with the Government, <sup>with Szilard, for that purpose</sup> and in case the services of Szilard are required involving loss of time and income by Szilard, <sup>shall</sup> Szilard will be paid by the Government at the prevailing rate for the type of services rendered by proper arrangement <sup>to be made by</sup> with the Government. <sup>with Szilard for that purpose.</sup>

5. Szilard understands and agrees that with respect to any patentable discovery or invention coming under this agreement, the Contracting Officer of the Office of Scientific Research and Development, Office for Emergency Management, Executive Office of the President and/or the Contracting Officer of the United States Engineers, Manhattan District, War Department, or their duly appointed representative, shall have the sole power to determine whether or not a patent application shall be filed covering any and all of said inventions, discoveries and improvements made by Szilard.

6. Szilard further agrees that the Government shall have the irrevocable and exclusive right to prosecute all patent applications, wherever filed, covering inventions made by him and Szilard hereby grants to the Government the full power of substitution and revocation, to make alterations and amendments to any and all said patent applications, to receive all Letters Patent and to transact all business in

SECRET

~~SECRET~~

any Patent Office in connection with any applications,  
and to prosecute, conduct and make adjustments and  
settlements of any interferences or other acts or proceed-  
ings that any and all said inventions and/or said applications  
and patents may encounter or in which they may become involved.

IN TESTIMONY WHEREOF, THIS AGREEMENT HAS BEEN

EXECUTED THIS \_\_\_\_\_ DAY OF \_\_\_\_\_, 1943.

Witness:

\_\_\_\_\_  
Leo Szilard

(SEAL)

\_\_\_\_\_  
GOVERNMENT OF THE UNITED STATES

By \_\_\_\_\_

Contracting Officer  
United States Engineers  
Manhattan District  
War Department

~~SECRET~~

~~SECRET~~

STATE OF ILLINOIS )  
                          ) ss.  
COUNTY OF COOK     )

THIS DOCUMENT HAS BEEN  
TAKEN FROM A FILE OF THE  
ARGONNE NATIONAL LABORATORY  
AND WAS TURNED OVER TO  
LEO SZILARD ON \_\_\_\_\_

I, \_\_\_\_\_, a Notary  
Public in and for the County and State aforesaid, do  
hereby certify that LEO SZILARD, personally known to me  
to be the same person whose name is subscribed to the  
foregoing instrument, appeared before me this day in  
person and acknowledged that he signed, sealed and de-  
livered the said instrument as his free and voluntary  
act and deed for the uses and purposes therein set forth.

Given under my hand and Notarial Seal this  
\_\_\_\_\_ day of \_\_\_\_\_, 1943.

\_\_\_\_\_  
Notary Public

Assented to and  
approved by:

Trustees of Columbia University  
in the City of New York

By \_\_\_\_\_

Assented to and  
approved by:

Board of Trustees of the  
University of Chicago

By \_\_\_\_\_

\_\_\_\_\_

~~SECRET~~

WILKINSON, HUXLEY, BYRON & KNIGHT

FIRST NATIONAL BANK BUILDING

CHICAGO  
3

November  
24th  
1943

GEORGE L. WILKINSON  
COUNSEL  
HERVEY S. KNIGHT  
RETIRED

CLARENCE F. POOLE  
ASSOCIATE ATTORNEY

TELEPHONE  
RANDOLPH 4848

HENRY M. HUXLEY  
CHARLES L. BYRON  
MILTON T. MILLER  
\* HOWARD W. HODGKINS  
RALPH MUNDEN  
JAMES P. HUME  
HOWARD SOMERVELL  
RUSSELL H. CLARK  
GORDON F. HOOK

\* ENLOE WILKINSON  
GERRIT P. GROEN

\* ON LEAVE

MR. LEO SZILARD,  
Metallurgical Laboratory,  
THE UNIVERSITY OF CHICAGO,  
Chicago, Illinois.

Dear Mr. Szilard:

In accordance with your request, I have  
checked my diary and find that our charge for ser-  
vices rendered amounts to a total of \$375.00. This  
is based on time at our regular per diem rate.

Very truly yours,

WILKINSON, HUXLEY, BYRON & KNIGHT

By

*James P. Hume*  
J.P.H.

JPH-NK

HENRY M. HUXLEY  
CHARLES L. BYRON  
MILTON T. MILLER  
\* HOWARD W. HODGKINS  
RALPH MUNDEN  
JAMES P. HUME  
HOWARD SOMERVELL  
RUSSELL H. CLARK  
GORDON F. HOOK

\* ENLOE WILKINSON  
GERRIT P. GROEN

\* ON LEAVE

WILKINSON, HUXLEY, BYRON & KNIGHT

FIRST NATIONAL BANK BUILDING

CHICAGO  
3

December  
17th  
1943

GEORGE L. WILKINSON  
COUNSEL  
HERVEY S. KNIGHT  
RETIRED

CLARENCE F. POOLE  
ASSOCIATE ATTORNEY

TELEPHONE  
RANDOLPH 4848

Mr. Leo Szilard,  
Metallurgical Laboratory,  
THE UNIVERSITY OF CHICAGO,  
Chicago, Illinois.

Dear Mr. Szilard:

This will confirm the various telephone conversations I have had with you recently in regard to the wording of a proposed employment contract.

According to my understanding, the new agreement which was submitted for your signature includes the following provision:

"that every invention or improvement developed by Szilard during the course of such employment or resulting from or suggested by any work Szilard may do in the course of such employment pertaining to the work now or hereafter carried on by the Department, shall become the property of the Government of the United States."

As I have already indicated, I think this language is too broad and should not extend to inventions or improvements resulting from or suggested by any work that you may do. Furthermore, the provision should not extend to all inventions "pertaining to the work now or hereafter carried on by the Department" but should be limited to inventions pertaining to the work carried on by the Department during the period of your employment.

I, therefore, confirm my recommendation to you, given over the telephone, that you do not sign any employment agreement including the above-quoted provision, unless the same is further qualified as hereinafter referred to.

As I have suggested, I think the agreement should be modified to read somewhat as follows:

"that every invention or improvement developed by Szilard during the course of such employment

Mr. Leo Szilard,  
Page 2 - Dec. 17, 1943

resulting from any work Szilard may do in the course of such employment pertaining to the work carried on by the Department during the period of such employment, shall become the property of the Government of the United States."

You have indicated in our telephone conversations that a modification of the above agreement may be difficult to obtain and, therefore, if the agreement is to be signed it becomes necessary to add a modifying and explaining paragraph. This possibility is based upon your statement that the Department does not construe the above-quoted Section 2 of the proposed agreement as covering inventions or improvements conceived after the termination of your employment. If it is possible to effect such a modification, I think it would be satisfactory for you to sign the agreement if you add the following provision. At the end of Section 2 as above quoted, add:

"This provision is subject to the understanding set forth on page 2 hereof, which is hereby made a part of this agreement."

Then, as an added provision to appear on page 2, you should add words to the following effect:

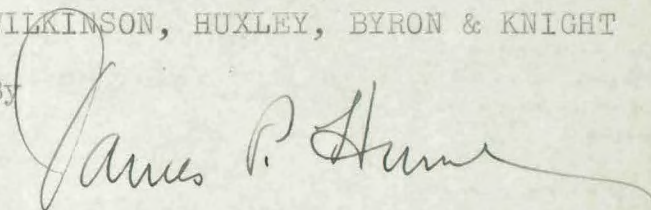
"This agreement is signed by the undersigned with the understanding that Section 2 hereof does not extend to inventions or improvements conceived by the undersigned after the termination of his employment by the Department."

I trust this gives you the information that you wanted.

Very truly yours,

WILKINSON, HUXLEY, BYRON & KNIGHT

By



JPH-NK

c  
o  
p  
y

WILKINSON, HUXLEY, BYRON & KNIGHT  
First National Bank Bldg.  
Chicago

March 3rd, 1944

MR. LEO SZILARD  
c/o Quadrangle Club  
1155 East 57th Street  
Chicago, Illinois.

Dear Mr. Szilard:

I recall that on the occasion of one of our discussions in this office you asked me a question with respect to the rule of patent law in this country relating to joint inventors.

You asked me whether or not it would be proper to file an application in the names of two inventors as joint inventors when, in fact, the broad principle or generic idea had been invented by inventor A and embodied by inventor A in a specific embodiment which was disclosed in the application, and that a different embodiment of the same broad principle was invented by inventor B and was also disclosed. Your question was whether or not, under such circumstances, A and B could with propriety be named as joint inventors.

If I recall correctly, I advised you at that time that I thought they could be named as joint inventors, and if I did so advise you, I now wish to change my position and give you the correct rule.

I have had occasion recently to look up some law on this point. I find that this question has been looked into by the courts and it has been decided that such a joint patent would be invalid. In other words, if a patent is issued jointly to two named inventors and a claim is included in this patent which relates only to the subject-matter contributed solely by one of the two inventors, then the patent is invalid. This is a very rare type of situation and does not often come to light for the reason that the courts also have a rule that they do not look behind the statements of the inventors as to the particular contributions of each. As a result of this second rule, all joint inventions are considered to be the result of joint contributions of the two or more inventors as to the whole of the fundamental aspects of the invention.

As above stated, however, where a complete invention was made by one of the inventors, such as would sustain an application in and of itself, it is improper then to name another inventor of a species as a co-inventor with the original and first inventor.

I know you will understand the applicability of what I have here said to your own problem, and if any action has been taken on my previous advice I suggest that you bring this rule of law to the attention of Captain Lavender in order that an invalid application will not be filed. In other words, I can provide rules of law which establish conclusively the necessity for filing separate applications under the facts which you have indicated to me are controlling in the present instance.

Very truly yours,

/s/ James P. Hume

JPH-MK



HENRY M. HUXLEY  
CHARLES L. BYRON  
MILTON T. MILLER  
\* HOWARD W. HODGKINS  
RALPH MUNDEN  
JAMES P. HUME  
HOWARD SOMERVELL  
RUSSELL H. CLARK  
GORDON F. HOOK

WILKINSON, HUXLEY, BYRON & KNIGHT

FIRST NATIONAL BANK BUILDING

CHICAGO  
3

March  
3 rd  
1944

GEORGE L. WILKINSON  
COUNSEL  
HERVEY S. KNIGHT  
RETIRED

CLARENCE F. POOLE  
ASSOCIATE ATTORNEY

TELEPHONE  
RANDOLPH 4848

\* ENLOE WILKINSON  
GERRIT P. GROEN

\* ON LEAVE

MR. LEO SZILARD,  
c/o Quadrangle Club  
1155 East 57th Street  
Chicago, Illinois.

Dear Mr. Szilard:

I recall that on the occasion of one of our discussions in this office you asked me a question with respect to the rule of patent law in this country relating to joint inventors.

You asked me whether or not it would be proper to file an application in the names of two inventors as joint inventors when, in fact, the broad principle or generic idea had been invented by inventor A and embodied by inventor A in a specific embodiment which was disclosed in the application, and that a different embodiment of the same broad principle was invented by inventor B and was also disclosed. Your question was whether or not, under such circumstances, A and B could with propriety be named as joint inventors.

If I recall correctly, I advised you at that time that I thought they could be named as joint inventors, and if I did so advise you, I now wish to change my position and give you the correct rule.

I have had occasion recently to look up some law on this point. I find that this question has been looked into by the courts and it has been decided that such a joint patent would be invalid. In other words, if a patent is issued jointly to two named inventors and a claim is included in this patent which relates only to the subject-matter contributed solely by one of the two inventors, then the patent is invalid. This is a very rare type of situation and does not often come to light for the reason that the courts also have a rule that they do not look behind the statements of the inventors as to the particular contributions of each. As a result of this second rule, all joint inventions are considered to be the result of joint contributions of the

Mr. Leo Szilard,  
Page 2 - March 3, 1944

two or more inventors as to the whole of the fundamental aspects of the invention.

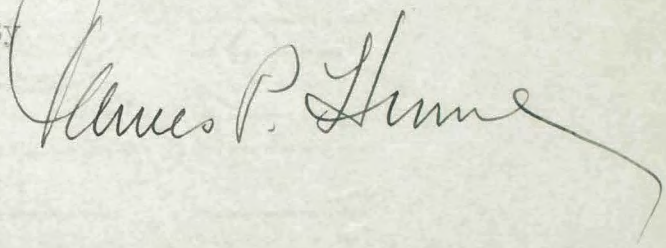
As above stated, however, where a complete invention was made by one of the inventors, such as would sustain an application in and of itself, it is improper then to name another inventor of a species as a co-inventor with the original and first inventor.

I know you will understand the applicability of what I have here said to your own problem, and if any action has been taken on my previous advice I suggest that you bring this rule of law to the attention of Captain Lavender in order that an invalid application will not be filed. In other words, I can provide rules of law which establish conclusively the necessity for filing separate applications under the facts which you have indicated to me are controlling in the present instance.

Very truly yours,

WILKINSON, HUXLEY, BYRON & KNIGHT

By

A handwritten signature in dark ink, appearing to read "Charles P. Hume". The signature is written in a cursive style with a long, sweeping underline that extends to the right.

JPH-MK

WILKINSON, HUXLEY, BYRON & HUME

FIRST NATIONAL BANK BUILDING

CHICAGO 3

COPY

August  
5 th  
1953

Mr. Aaron Novick  
The University of Chicago  
Institute of Radiobiology & Biophysics  
Chicago 37, Illinois.

Dear Mr. Novick:

Re: Case No. 52,280 - Novick & Szilard  
Caffine-Containing Products and  
Method of Their Preparation  
Ser. No. 320,816 - Filed Nov. 15, 1952

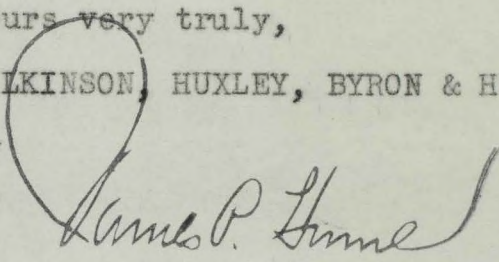
You will find enclosed for your files, copy of  
an action recently received from the Patent Office in the  
above-identified application.

Response to this action must be made within six  
months from the date thereof, or before January 17, 1954.

Yours very truly,

WILKINSON, HUXLEY, BYRON & HUME

By



NK

Enc.

cc-Mr. Szilard

**Department of Commerce**  
**United States Patent Office**  
**Washington**

Please find below a communication from the  
EXAMINER in charge of this application.

Commissioner of Patents

WILKINSON, HUXLEY, BYRON & HUME,  
1604 First National Bank Building,  
Chicago 3, Illinois.

Date: July 17, 1953

Applicant: Aaron Novick et al

Ser. No. 320,816

Filed Nov. 15, 1952

For CAFFEINE CONTAINING  
PRODUCTS AND METHOD  
FOR THEIR PREPARATION

References cited to show the state of the art:

Marshall (Br.)	599,289	Mar. 9, 1948	157/78c
(2 pages)			
Parsons	British Empire Cancer Campaign		
21st Ann. Report	1944	page 42	167/78c

All the claims are rejected for lack of utility.

The utility disclosed is based upon conjecture as to the effect of caffeine as a cancer cause in humans. In absence of clear, convincing, scientific evidence that the incidence of cancer is reduced by the addition of the purine ribosides, all the claims are rejected. Tests in vitro on virus culture are not convincing as to humans. Rudd v. Kingsland 88 U.S.P.Q. 418.

All the claims are further rejected as unduly multiplied. Six claims would appear adequate in a case of this type.

No claim is allowed.

Examiner

CHARLES L. BYRON  
JAMES P. HUME  
GORDON F. HOOK  
HOWARD W. HODGKINS  
RALPH MUNDEN  
MILTON T. MILLER  
RUSSELL H. CLARK  
GERRIT P. GROEN  
HOWARD W. CLEMENT  
PATRICK HENRY HUME

WILKINSON, HUXLEY, BYRON & HUME

FIRST NATIONAL BANK BUILDING

CHICAGO 3

December  
8 th  
1952

GEORGE L. WILKINSON  
HENRY M. HUXLEY  
COUNSEL

TELEPHONE  
RANDOLPH 6-4848

Mr. Leo Szilard,  
1155 E. 57th Street  
Chicago, Ill.

Dear Mr. Szilard,

Re: Case No. 52,280 - Novick & Szilard - Caffeine-  
Containing Products & Method for their Production

The above-entitled application was duly filed in the United States Patent Office on November 15, 1952, and given Ser. No. 320,816.

Your attention is called to the following:

1. In Canada, Great Britain, France, Italy, Germany, Austria, Czechoslovakia, Japan, Belgium, Norway and Sweden, and certain other countries which are members of the International Convention for Protection of Industrial Property, applications, if filed under the provisions of the Convention and within one year of the filing date of the U. S. application, will be treated as having been filed in the foreign country on the same date as the U. S. application, thereby ante-dating any filing by another inventor or patent or public use or description occurring in the meantime, which, but for the Convention, might prevent obtaining the foreign patent.

2. In general, applications may be filed in any foreign country, including those mentioned above as members of the International Convention, any time before patenting or publication of the invention, irrespective of the filing date of the United States application. In most countries only public use in the country itself acts as a bar, but in France, Holland, Sweden and certain other countries, public use anywhere acts as a bar, unless an application is filed under the provisions of the International Convention, as discussed in paragraph 1, and the public use took place after the filing of the United States application.

3. In Canada the law provides, apart from filing under the International Convention as discussed in paragraph 1, that an application must be filed -

- (a) before issuance of a patent for the same invention in any country foreign to Canada;
- (b) before publication of the invention anywhere for more than two years; or,
- (c) before public use or sale of the invention in Canada for more than two years.

Very truly yours,

WILKINSON, HUXLEY, BYRON & HUME

By

*James P. Hume*

COPY OF FILING RECEIPT

Address only  
COMMISSIONER OF PATENTS  
Washington, D.C.

Department of Commerce  
UNITED STATES PATENT OFFICE

Serial Number

320,816

Series of 1948

Applicant NOVICK AARON &  
SZILARD Leo -- Chicago, Ill.

Nov. 15, 1952  
Filing Date

Invention CAFFEINE CONTAINING PRODUCTS  
AND METHOD FOR THEIR PREPARA-  
TION.

Case  
Initially assigned  
to  
Division 6

6 extra claims

WILKINSON, HUXLEY, BYRON &  
HUME  
First National Bank Bldg.,  
Chicago 3, Ill.

The petition, specification, oath, and first fee of  
THIRTY-SIX DOLLARS of your application for PATENT above  
identified received.

Respectfully

John A. Marzall,

Commissioner of Patents

89815

Your application will be considered in its order, and you will  
be duly advised as to the examination thereof.

R-27

WILKINSON, HUXLEY, BYRON & HUME

FIRST NATIONAL BANK BUILDING

CHICAGO

3

January

5 th

1954

COPY

Mr. Aaron Novick  
The University of Chicago  
Institute of Radiobiology & Biophysics  
Chicago 37, Illinois.

Dear Mr. Novick:

Re: Case No. 62,280 - Novick & Szilard -  
Caffine-Containing Products and  
Method of Their Preparation -  
Ser. No. 320,816 - Filed Nov. 15, 1952

This letter will serve as a reminder that the above-identified application was acted on by the Patent Office on July 17, 1953, and consequently, under the rules of procedure, it will be necessary to have a satisfactory response on file in the Patent Office in Washington on or before January 17, 1954.

It is our understanding that you are prosecuting this application yourself and that you will attend to the preparation and filing of the response. On the other hand, if there is anything we can do that will be of assistance, please do not hesitate to call upon us.

I will appreciate your acknowledging receipt of this letter in order that we will know that you have received the information contained herein.

Yours very truly,

WILKINSON, HUXLEY, BYRON & HUME

By

*James P. Hume*

JPH-NK

cc-Mr. Leo Szilard

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1/16/54 73131

CHARLES L. BYRON  
JAMES P. HUME  
GORDON F. HOOK  
HOWARD W. HODGKINS  
RALPH MUNDEN  
MILTON T. MILLER  
RUSSELL H. CLARK  
GERRIT P. GROEN  
HOWARD W. CLEMENT  
PATRICK HENRY HUME

WILKINSON, HUXLEY, BYRON & HUME  
FIRST NATIONAL BANK BUILDING  
CHICAGO 3

GEORGE L. WILKINSON  
HENRY M. HUXLEY  
COUNSEL  
TELEPHONE  
RANDOLPH 6-4848

December  
8 th  
1952

Mr. Leo Szilard,  
c/o Quadrangle Club,  
1155 E. 57th Street  
Chicago, Illinois.

Dear Leo:

Re: Our Case No. 52,280 - Aaron Novick and  
Leo Szilard - Caffeine-Containing Products  
and Method for their Preparation

We are sending herewith for your files a copy of the filing receipt received from the Patent Office in connection with your above-identified application, which shows that the application was filed in the Patent Office on November 15, 1952, and assigned Serial No. 320,816.

In order that you will have all information pertaining to foreign filing, I am sending our regular form letter on that subject.

Whereas I realize that you may not require our services in connection with the prosecution of this case, nevertheless our responsibility as counsel of record would make it highly desirable to at least have our file on the subject complete. I would like to have, therefore, a copy of the specification and claims as filed, so that our file will conform to that in the Patent Office.

Also bear in mind that amendments and other papers that are filed should be sent in over our signature as counsel for applicants.

This case has been placed on our docket and we will advise you of all communications that are received from the Patent Office.

Yours very truly,

WILKINSON, HUXLEY, BYRON & HUME

By

*James P. Hume*

JPH-NK

Enc.

*Can take no further  
action re: filing, can't pay*

*Photo copy  
as per  
to this letter*

Caffeine containing  
product and method  
for their preparation

320, 816

Nov 5 /52

Draft

1956.

Dear Mr. Hume:

Inclosed I am sending you a copy of a letter which I wrote to Capt. Lavender. I wish to talk to you about this matter after your return and ~~there~~ in the following I will give you the facts which I believe may be pertinent.

On Thursday, December 2nd, I had a conference with Capt. Lavender and Col. Metcalf concerning the proposed agreement. I pointed out that you were out of town but were expected back on the following Monday and that I did not wish to sign any agreement in your absence, but Capt. Lavender said that unless the agreement was signed on the following day there might be an indefinite delay and it was to be feared that this might cause complications with respect to putting through my employment before December 31, 1943. A discussion of whether or not I should sign in your absence was also held with Mr. Compton to whom Capt. Lavender explained his position.

I explained to Capt. Lavender and Mr. Compton that I would want to see General Groves before deciding whether to put my signature under the text of the proposed agreement and I saw General Groves on the following day, December 3, in the presence of Capt. Lavender and Col. Metcalf. I suggested to G. Groves to say clearly that I would not be reemployed unless I signed the text of the proposed agreement but G. Groves said that he was not willing to make such a statement in view of the fact that his saying so would constitute duress. I thereupon explained to G. Groves that the proposed agreement was not satisfactory to me and if I signed it at all I should do it only because in the circumstances I did not wish to be put in the position of having

deserted my work, and I feared that this would be the case if I did not sign it. I told G. Groves that I felt very badly about this situation ~~and~~ if he said clearly that I would not be reemployed if I refused to sign it. In that case I explained to him I would be in a similar position like a man who is accosted in the street by a man who draws a gun and asks for his money. In such a situation you would without hesitation surrender my money and report the case to the police since I would feel that it is for the police rather than for me to deal with such happenings. In the absence of a clear statement by General Groves, however, I explained further, I feel like a man who is accosted on the street by somebody who demands his money while he keeps his hand in his pocket in such a manner that it is not quite clear whether he is holding a gun or just holding his pipe. Finding myself in a similar situation I find it difficult to decide on a course of action.

In the course of further conversation I gave Gen. Groves the promise that I would sign on the afternoon of that day the text of the agreement irrespective whether or not Gen Groves gave me assurance concerning my reemployment, since clearly if I were not reemployed in spite of my having signed the text, then my leaving the project would no longer ~~be~~ be my responsibility, but clearly the responsibility of Gen. Groves.

Later in the day I in fact signed the text of the proposed agreement and gave the copies signed by me to Capt. Lavender in escrow. The text of that agreement acknowledges the receipt by me from the government of the sum specified in the text. The text of

THIS DOCUMENT HAS BEEN  
TAKEN FROM A FILE OF THE  
ARGONNE NATIONAL LABORATORY  
AND WAS TURNED OVER TO  
DR. LEO SZILARD ON

1956.

of that agreement also provides for my assigning to the Government a patent application corresponding to Case S1/501 prepared by the government under supervision of Capt. Lavender and the text of the agreement refers to this patent application as one which is to be filed or as one which I am about to file.

It was my understanding that Lavender would return to me one of the copies which he had in escrow signed by the contracting officer and ~~accompanied~~ accompanied by the check for a sum the receipt of which was already acknowledged in the text of the agreement. I have thus far not received either the signed copy or the check.

Monday of last week I was asked to sign the ~~other~~ oath and assignment attached to Case S-1/501 and I took the position that before doing so I wished to discuss the matter with you.

Upon your return I would wish to discuss with you all the questions which arose out of this situation, both from the strictly legal point of view and also from the point of view of what action would be both legal and in the circumstances fair. As you know, it is not my intention to stretch a legal point unless I feel that in view of the circumstances I am morally entitled to do so. You also know that apart from taking your advice on legal matters, I value your opinion on this latter point of fair play very highly.

The reason I gave you such a detailed description of the circumstances under which I put my signature on the text of the proposed agreement is to enable you to judge the question of fairness which may be involved in the light of the circumstances which accompanied the conclusion of this agreement.

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DR. LEO SZILARD ON

1952