PATENT-OFFICE MANUAL,

INCLUDING

THE LAW AND PRACTICE OF CASES IN THE UNITED STATES PATENT OFFICE AND THE COURTS HOLDING A REVISORY RELATION THERETO.

ALSO, AN APPENDIX OF COPYRIGHT DECISIONS, ETC.

BY

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PREFACE.

THE purpose of this book is to facilitate the labors of inventors and attorneys in the United States Patent Office by a convenient summary of the more important rulings governing proceedings in that bureau down to the time of going to press. Owing to the constantly increasing activity in invention, many notable decisions are of dates so recent as to be here for the first time methodically presented. On mooted questions it has been aimed, wherever procurable, to give the conclusions of the court of last resort (herein distinguished by an asterisk), and to afford copious cross references to cases which illustrate or which seem to qualify or form exceptions to general rules.

The Patent Office Decisions, the Court of Claims Decisions, and the Treasury Department, matter contained in Gourick's Washington Digest, edited and published by DAVID A. GOURICK, Esq., of the Washington (D. C.) Bar, have been of great assistance in the preparation of the Manual, and are used by the permission of Mr. Gourick.

The close relation of literary and artistic property to franchises within the jurisdiction of the Commissioner of Patents, has made it necessary to append a chapter on Copyrights.

GEO. H. KNIGHT.

TEMPLE COURT,
NEW YORK, 1894.

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ABBREVIATIONS.

Revised Statutes of the United States	R. S.
The United States Supreme Court	U. S. S. C.
Decisions of U. S. Supreme Court and of U. S. Circuit Courts of Appeals	*
U. S. Supreme Court Reports, Official	U. S.
" " " " Lawyers' Edition	L. ed.
United States Circuit Courts	U. S. C. C.
" " " " (Federal Reporter)	F. R.
The Supreme Court of the District of Columbia,	Supr. Ct. Dist. Col.
Decisions of the Commissioner of Patents (published)	C. D.
" " " " " (manuscript)	C. D. MS.
Patent-Office Rules	P. O. R.
Official Gazette of the U. S. Patent Office	O. G.
Ex parte	x. p.

PATENT-OFFICE MANUAL.

CHAPTER I.

THE PATENT FRANCHISE.

WITH the revival of the arts of civilization in the fourteenth and following centuries, an important species of property, unknown to ancient law, began to receive recognition; this property was neither in land nor in chattels, but in constructive ideas. The imperishable and prolific character of constructive ideas renders them of far more enduring value to the world than any form of material wealth;[1] and the manifest prosperity of the countries that were first to accord such recognition of intellectual property has led to the adoption of the principle by every progressive nation.[2]

Long anterior to any statutory provision, the practice of crown grants of brief monopolies in particular industries "new to the realm" had its uses at the time, and was valuable for the legislation which it ultimately led to, but had the misfortune to share the opprobrium that justly attached to the more frequent, better known, and wholly mischievous concessions of trade monopolies in the ordinary pursuits and commodities of life. A signal illustration of the abuse to which this royal prerogative was liable was seen when so wise and (usually) so just a sovereign as Elizabeth could sell to a single speculator the exclusive privilege of dealing in salt, under which that important commodity rose to thirteen-fold

[1] Historical Review of Civilization, by Charles Morris, ii. 117.

[2] See Appendix B.

its ordinary price, and yet capriciously refuse a patent to the unfortunate William Lee, the inventor of the knitting-machine and the founder of the great textile industries of modern England.

The loose and arbitrary practice of extorting revenue by farming out, or sale for a lump sum, of monopolies in the necessaries of life, was injurious in several important directions. It kept alive the meddlesome and conceited mediæval interference with the natural and healthy channels of trade. It enriched a few greedy middlemen, who, having made one profit by bribing officials to betray the crown, made another profit by their extortionate prices to the public. It encroached alike on individual and on public rights and liberties by sequestrating the means of subsistence and by enabling a despotically inclined monarch to levy taxes without parliamentary sanction. Finally, as already intimated, it brought into unmerited contempt the comparatively rare and generally commendable grants of a temporary franchise to the inventor or introducer of an industry "new to the realm."

Toward the close of the sixteenth century these evils had become so flagrant that much of the time of English tribunals was consumed in annulment of crown grants "whereby any person was sought to be restrained from any freedom which he had before, or to be hindered in his lawful trade;"[1] and it is a noteworthy circumstance that these very tribunals usually sustained grants of exclusive privileges for limited periods "to whomsoever bringeth to and for the commonwealth a new manufacture, by his invention, costs, and charges."[2] Thus did these eminent jurists prototype and give cue to the legislation that shortly followed.

The expediency and justice being conceded of a policy which should guarantee to inventors some compensation for their pains and sacrifices and the benefits which they

[1] Hawkins.

[2] Ib.

have conferred on the community, there remained only to be considered the manner of its accomplishment; and no plan ever yet proposed has approached, either in practicableness or fairness that which had already been exemplified in the practice of the crown grants already spoken of, by which the person to whom the public was indebted for the art or invention was guaranteed the exclusive control of it for a limited period. In such a system no person is deprived of a single right, liberty, or possession previously enjoyed, and each is free to use the improvement or to refrain from its use. Moreover, the system is the most equitable arrangement conceivable for the inventor, because his reward will ordinarily be commensurate with the value given, so that the patent is itself a self-regulating instrument, characterized by an interchange of benefits in accordance with the natural laws of supply and demand. The farmer who so desired could continue to break ground with the wooden implements inherited from his ancestors, could scatter the seed broadcast, could gather the ripened crop with the sickle, and could separate the grain from the husk by flail or by hoofs of his cattle, instead of availing himself of the steel plough, the grain-drill, the self-binding harvester, and the threshing and separating machine; and the like is manifestly true in every department of industry. Finally, at the expiration of the brief monopoly, the general public would fall full heir to the invention without money and without price.

Systematic grant of patents for inventions dates from the so-called "Statute of Monopolies," wrung from James I. (A. D. 1623). The main purpose of this famous enactment was to put an end to the grants of monopolies in the ordinary trades and commodities of life; but a sort of codicil was wisely appended which excepted from the prohibition "any letters-patent and grants or privilege for the term of fourteen years or under, hereafter to be

made, of the sole working or making of any manner of new manufactures which others, at the time of making such letters-patent and grants, shall not use; so, also, that they be not contrary to the law nor mischievous to the State by raising the price of commodities at home, or hurt of trade, or generally inconvenient."[1]

It is a significant fact that England (then a country at the pastoral stage whose chief export was raw wool) soon became noted for her manufactures, finally outstripping all rivals in industrial progress, and especially in those intelligent phases of it which lead most rapidly to national wealth. A like statement is applicable, in a still more marked degree, to the United States, especially in its last half-century of unprecedented progress under "the American Patent System," inaugurated by Senator John Ruggles.

The patent system of the United States dates from colonial times. Each colony operated quite independently of any other in granting patents for the prosecution of industries not then known within its limits; and hence it sometimes happened that a particular manufacture would be free on one side and subject to a patent on the other side of a State line. These inconveniences suggested the advantage of a national patent system; and at the instance of such master minds as Madison of Virginia and Pinckney of South Carolina, an enabling clause (clause 8, sec. 8, art. 1) was embodied in the Constitution, which laid the foundation for the legislation providing for the grant of patents for inventions and designs, and the registration of copyrights and labels. This clause empowered Congress "to promote the progress of science and the useful arts by securing, for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries." This enabling clause in the

[1] At a later period (A.D. 1709) the Copyright Act (8 Anne, c. 19) extended a like protection to authors.

fundamental law was shortly followed by the Act of April 10, 1790, and subsequent legislation, which authorized the grant of patents "for the term of fourteen years to the first and original inventor of any new and useful art, machine, manufacture, or composition of matter not known in the United States nor published or patented elsewhere," on the payment of a trifling fee (merely such as was supposed requisite for the expenses of carrying out the provisions of the law) and the filing of a description of the invention "in such full, clear, and exact terms (describing the best mode known to the applicant of carrying out the principle of the invention) as to enable one skilled in the art to which it appertains or with which it is most nearly allied, to compound and use it without making any experiments of his own." Except in the low and merely administrative fee, and that the grant appeared as the legalization of an inherent right, the patent law of the United States during its first half-century was copied wholly from British lines of procedure;[1] hence (just as under the British law of this day) if the application appeared to be in correct legal form and the fees were duly paid, the patent issued as a matter of course, without inquiry as to whether the invention was really new or old, or whether there had been, in fact, any invention at all. Under such a system (?) patents were of course frequently issued for things either totally lacking in inventive novelty or which had already been the subject of a previous grant. In addition to these charges of abuse of the practice of indiscriminate grants, Senator John Ruggles, of Maine, brought forward[2] the still graver charge of the occasional procural of patents for pretended inventions for the sole purpose of levying black-mail.

To prevent the abuses referred to, Mr. Ruggles proposed a system of technical examination of all applica-

[1] Pennock & Sellers *v.* Dialogue, 2 Pet. 19 (21).
[2] Dec. 31, 1835.

tions. Such a system, which inaugurated a new era in the grant of letters-patent for inventions, was embodied by its author in the Statute of July 4, 1836, by which the United States Patent Office, as we now know it, was created as a distinct bureau, which was to be controlled by a Commissioner charged with both judicial and administrative duties, and having subject to his direction a corps of Examiners whose duty it was made to determine the novelty or otherwise of the device presented and the sufficiency of the description of it in the specification. The Act of 1836 was followed, in the years 1837 and 1839, by supplementary acts, in which Mr. Ruggles completed what is now known as "the American System," on the lines he had already laid down. Subsequent legislation has been directed to the improvement in details suggested from time to time in the practical working of the system; the most important being the Act of March 2, 1861, by which the term of patents thereafter to be granted was increased to seventeen years, and such longer term was declared incapable of being extended as the fourteen-year patents had been. On the 1st of December, 1873,[1] all previous patent legislation became merged in the Revised Statutes of the United States.

The institution of the Patent Bureau, with its Commissioner and corps of scientific Examiners, — while not inimical to *bona-fide* inventors, — was declared by its author to have for its prime and chief purpose the protection of the public.[2] Although it would increase several-fold the expense of administration, the Senator estimated that the then existing government charges to applicants would suffice to defray all expenses. Not only has the event justified Mr. Ruggles's estimate that the office would continue to be self-supporting, but the system itself has

[1] The Revised Statutes embrace the laws, general and permanent in their nature, in force Dec. 1, 1873; but were not enacted until June 22, 1874, and were not printed and given to the public until 1875.

[2] Speech of Senator Ruggles, Dec. 31, 1835.

proved to have been of great public benefit; and we have the competent testimony of each succeeding head of the bureau that its usefulness will become still more abundantly manifest when Congress, in its wisdom, shall permit the surplus revenue of the office to be applied to the preparation of indexed digests of the various industrial arts, and other means of thorough and exhaustive technical examination.

The Statute of Monopolies proclaimed no new species of property, still less did it recognize any pre-existing or natural right; it merely restricted within useful bounds a prerogative whose exercise had always been wholly discretionary with the crown, — which it even now is, at least in theory, as the very language employed in the English grants still shows. The authors of the Constitution of the United States, on the contrary, at the very outset of their dealing with the subject, based their action on totally different grounds. Under American law, the exclusive privilege of an invention was no longer an act of executive grace; it was the legal habilitation of an already existing *right*; the inventor was to be secured, for a specified time, in the exclusive use of *his* discovery; the inventor having deposited a complete and intelligible specification and the small fee exacted to cover expenses of the Office, it was made the *duty* of the executive to issue the patent or public certification of proprietorship. In acknowledgment of this right to an invention, which American law recognizes to be inherent in the author of it, President Ulysses S. Grant said: "The Patent System of the United States is, in many respects, radically different from that of any other country. Inferentially, at least, the purpose of the framers of the Constitution appears to have been to recognize property in a new invention as a right belonging to the inventor, not a favor conferred by the Government." [1] The eminent ex-

[1] Pres. Message (U. S. Grant) to 43d Congress, 1st Sess., Ex. Doc. 27.

pounder of the Constitution, Daniel Webster, said: "The American Constitution does not attempt to give an inventor a right to his invention, or an author a right to his composition; it recognizes an original, pre-existing, inherent right of property in the invention, and authorizes Congress to secure to inventors the enjoyment of that right; but the right exists before the Constitution and above the Constitution, and is, as a natural right, more than that which a man can assert in almost any other kind of property." [1]

According to the best authorities, letters patent for an invention may be regarded as in the nature of a contract between the inventor and the general public: [2] thus, Coryton was of the opinion that the clearest insight into the peculiarities of this species of property is from considering it as the result of a contract entered into by the executive (as the public's representative) with the patentee. The parties meet on the understanding that one has a secret to communicate, the other a favor to confer in return.[3] According to Phillips, all laws of this description (providing for exclusive privileges to authors, artists, and inventors) grant only a temporary monopoly, because they offer a compromise between the creator of the work or industry and the rest of the community by which each party surrenders something, and for which it is proposed that he shall receive an equivalent.[4] The Hon. William H. Seward said: "The productions of my mind are, confessedly, as really property as the fabrics of my hands; indeed, they are much more exclusively my own. The patent is a contract by which I convey my inventions to the commonwealth forever, in consideration of the exclusive enjoyment of it by myself for a limited period." [5] Justice Baldwin defined a patent to be a contract between

[1] Arg. of Daniel Webster in case of Goodyear *v.* Day.
[2] Kendall *et al. v.* Winsor, 21 Howard, 322.*
[3] Coryton, 41.
[4] Phillips, 22.
[5] W. H. Seward, in argument before Nelson, J.

the public and the inventor of a new and useful art or manufacture, whereby, in consideration of a complete disclosure of the invention, the exclusive right thereto for a limited period is guaranteed to the inventor and his representatives.[1] In a statement of the reciprocal obligations of the patentee and the public, Professor Robinson says that the right of the public is to be put into immediate possession of a distinct knowledge of the invention, and it is the duty of the patentee to give this knowledge; the right of the patentee is to enjoy unmolested the exclusive use of the invention during the life of the patent, and it is the duty of the public to secure him in this right by the ordinary forms of legal protection and redress. These reciprocal rights and obligations are to be assured to the respective parties only by imposing upon each the necessity of fully, literally, and immediately discharging its legal duty to the other; in other words, by interpreting each side of the contract against its promisor and in favor of its promisee.[2]

As the residual beneficiaries of all lapsed or unestablished individual rights, the public at large, in every Patent-Office procedure, have interests which the law [3] makes it the duty of the Commissioner of Patents and those acting under his instructions to safeguard; all such procedures are therefore, in a certain sense, *inter-partes*;[4] but, in practice, the term "ex parte" conveniently distinguishes uncontested from contested cases; and these latter are necessarily subjected to much the more rigorous treatment, in order that exact justice shall be meted out to the contending applicants, and that the patent, if granted at all, shall be to him, and to him alone, to whom the world is indebted for the invention in controversy. A great part of the time of the Office is taken up on these strenuously contested controversies.

[1] Baldwin, J., in Whitney *v.* Emmett. [2] 1 Robinson, 59.
[3] Revised Statutes of the United States, Section 4893.
[4] Reed *v.* Landman; Cook *v.* Leech; Abbey, ex parte; (INTERFERENCES.)

CHAPTER II.

DECISIONS RELATING TO U. S. PATENTS FOR INVENTIONS.

ABANDONMENT, FORFEITURE, ETC.

1. A completed invention may be abandoned to the public.

An incomplete invention may be forfeited in favor of one later to conceive but first to reduce the invention to practice.

The questions of abandonment and of forfeiture arising in interference proceedings are distinct questions; for abandonment of an invention operates in favor of the public, while forfeiture operates in favor of a later inventor. The former has reference to a completed invention; the latter to one that was relinquished or laid aside by the originator at an immature or not fully operative stage.

Hyatt *v.* French, *Leggett, Com.*, 8 Dec., 1873, 4 O. G. 609.

ABANDONMENT OF THE INVENTION.

1. Abandonment of an invention cannot be established on mere presumption or inference. The proof must be positive and conclusive.

Abandonment or dedication of the invention is in the nature of the forfeiture of a right, which the law does not favor, and it should be made out beyond all reason-

able doubt. It can be established by positive proof only, not by mere presumption or inference.

Pitts *v.* Hall, *Nelson and Conclin, JJ.* By *Nelson, J.*, June, 1851, 2 Blatch. 237.

See also Russell *v.* Scow, *Thacher, Act. Com.*, 17 Feb., 1874, 5 O. G. 149.

2. The establishment of abandonment, by two years' public use or otherwise, requires proof so clear as to put the matter beyond all reasonable doubt.

Bury *v.* Thompson, *Simonds, Com.*, 21 Aug., 1891.

3. Abandonment of the invention may take place in one of several ways; for example, —

(*i.*) By ACQUIESCENCE: As where the inventor looks on and sees his invention going into general use, without protest.

Treadwell *v.* Bladen, *Washington, J.*, Oct., 1827, 4 Wash. 708.

(*ii.*) By DEDICATION: As where the inventor announces surrender of the invention to the public.

Pennock *v.* Dialogue, U. S. S. C. By *Storey, J.*, Jan., 1829, 2 Pet. 16.*

(*iii.*) By INACTION: As where the inventor takes no steps to secure a patent within two years after first public use of the invention.

Sec. 4887 R. S.

4. A single public use more than two years before application constitutes abandonment.

Use *in* public and use *by* the public distinguished.

There may be a use in public of the device by an inventor or his agents for the purpose of experiment,

or there may be a use by the public of the invention with his acquiescence. In the eye of the law, the one is a private use, and may, if the nature of the invention justify it, and no contestant appear, be of several years' duration; the other is a public use of the invention, a single instance of which more than two years before application constitutes abandonment of the invention to the public.

City of Elizabeth *v.* The Nicholson Pavement Co., U. S. S. C. By *Bradley, J.*, Oct. term, 1877, 97 U. S. 126.✽

See, also, Russell *v.* Mallory, 5 Fish. 632; Egbert *v.* Lipman, 21 O. G. 71; Consol. Co. *v.* Wright, 94 U. S. 92; ✽ Rifle Co. *v.* Arms Co., 14 Blatch. 94.

5. Lapse of Time.

Lapse of time, *per se*, does not, of itself, constitute abandonment (Cartridge Co. *v.* Arms Co., 14 Blatch. 94). As to intent, — Bury's belief that he was constantly and continuously in possession of this invention negatives any attempt to give it away; and *his quick action when he heard that some one else was selling the embodied improvement*, is a similar negative.

Bury *v.* Thompson, *Simonds, Com.*, 21 Aug., 1891, 58 O. G. 1255. To same purport, see DELIBERATION; and (9) *et seq.*, DILIGENCE.

6. Abandoned Invention and abandoned Experiment distinguished.

After making a full-size working-machine which was reduced to practice and was known to two other persons besides the inventor, who were laid under no obligations of secrecy, abandonment of invention (by two years' public use or otherwise) might ensue; but the device had

advanced beyond the stage at which it could be called an abandoned experiment.

Ib.

Compare ABANDONED EXPERIMENTS.

7. Two Years' Public Use.

The invalidating two years' public use, of the statute, does not require the knowledge, consent, or allowance of the inventor.

Drawbaugh, x. p., *Simonds, Com.*, 28 Oct., 1891, 57 O. G. 693.

8. Public Use.

Where, for more than two years before applying for a patent, applicant taught his invention to a large number of persons throughout the country, with no suggestion that it was an experiment, and received pay for such instructions, *Held*, to constitute abandonment of the invention.

Inter. Tooth Crown Co. *v.* Gaylord, U. S. S. C. By *Brown, J.*, 27 Ap., 1891, 35 L. ed. 347.✽

9. Abandonment by two years' public use is not avoided by reason of the improvement having been hidden from view by its position in the machinery in which it was used.

Brush *v.* Condit, U. S. S. C. By *Blatchford, J.*, 4 Nov., 1889, 33 L. ed. 251.

10. The question of diligence arises only where one [who was first to disclose the inventive thought] is endeavoring to adapt and perfect the invention; but after such perfection of the invention, the only possible abandonment of it is to the public.

Shaffer *v.* Fraser, *Frothingham, Act. Com.*, 23 Jan., 1892, C. D. Ms.

11. An invention is not abandoned by a public use more than two years preceding a second application filed within two years after expiration of the earlier application.

A. filed an application in 1884, which application became abandoned, by reason of two years' lack of prosecution, 17 Nov., 1887. While this application was yet pending, to wit, in March, 1887, he reduced his invention to practice in public. In June, 1889, he filed a second application for the same invention. *Held*, that the reduction to practice before the abandonment of his first application, and the filing of the second application within two years after said abandonment, saved his rights from dedication to the public.

Witherow *v.* Robert, *Simonds, Com.*, 22 Ap., 1892, 59 O. G. 787.

12. Leaning to Liberality where Construction works Forfeiture.

One ground of rejection by the Examiners-in-Chief was that the method was described and its use illustrated in a prior patent to the applicant, without reservation (Mullen & Mullen, x. p., 50 O. G. 837, and Lord, x. p., 50 O. G. 987). *Held*, that it was the duty of the Office to be guided by the courts in the matter, and also to lean toward the side of liberality where strict construction works a forfeiture; and being guided by such considerations, it must be held that the delay of a month and a half between the issue of applicant's patent and the filing of the application in question did not amount to an abandonment (Eastern Paper Bag Co. *v.* Standard Paper Bag Co., 30 F. R. 63; Holmes Elec. Pro. Co. *v.* Met. Burg. Alarm Co., 33 F. R. 254; and Eastern Paper Bag Co. *v.* Nixon, 35 F. R. 752).

Scott, x. p., *Simonds, Com.*, 11 May, 1892, C. D. Ms.

NOTE. — **The foregoing, and Mullen & Mullen, (3)** DEDICATION, **appear to mark important exceptions to the rule laid down in Hill & Prentice, (1)** DEDICATION.

13. A party who had, by two years' failure to prosecute his application, forfeited to the public whatever rights he might have had in the invention, does not recover them by being subsequently made a party to interference proceedings.

Dodge, x. p., *Mitchell, Com.*, 18 Mar., 1891, C. D. Ms.

14. Abandonment of Invention by a Foreign Applicant.

In an interference contest between the holder of a United States patent and an applicant from abroad, the patentee having objected that the foreign applicant, by not having applied for the American patent within two years of the date of the first printed publication which disclosed the invention in issue, had abandoned his invention to the public: *Held*, that the objection was not well taken, as there was no proof of public use or sale, or that the invention had been introduced into public use in the United States for more than two years prior to the application, and no proof of abandonment. Alike with a foreign as with a domestic applicant, the policy of the law does not favor abandonment, — the presumption is always against it, and strict proof of it is invariably required; and the filing of an American application within a reasonable time after the foreign publication raises a presumption against abandonment.

Gueguen *v.* Westinghouse, *Mitchell, Com.*, 20 Mar., 1891, C. D. Ms.

ABANDONED EXPERIMENTS.

1. **Fruitless experiments are unavailable as evidence of invention.**

Mere experiments which are not followed by diligence and a perfecting of the invention, must be considered as abandoned.

Chipman *v.* Fales, *Fisher, Com.*, 1869, C. D. 44.

2. **An abandoned experiment is not such a publication as will render invalid a patent for an invention similar to the thing that had been experimentally produced.**

Pickering *v.* Miller, *McKennan, J.*, 25 Ap., 1883, 25 O. G. 89.

3. **Where a model which embodied the inventor's earlier idea was destroyed, and the inventor proceeded to experiment in and perfect other devices for producing the same results, his acts afford a very strong presumptive evidence of abandonment of the invention shown in such model.**

Barnes *v.* Clinton, *Duell, Com.*, 12 June, 1876, 9 O. G. 1158.

4. **When a person, in his endeavors to devise a machine for performing certain operations, constructs a mechanism incapable of producing the results aimed at, and afterward branches off in another direction and attempts to create a new and different machine for performing the same operation, his first attempt must be regarded as an abandoned experiment.**

Wicks *v.* Dubois, *Doolittle, Act. Com.*, 16 Feb. 1877, 11. O. G. 244.

Compare, of like tenor, Hunter *v.* Jenkin, (13) DILIGENCE; Clark Thread Co. *v.* Willimantic Linen Co., (30) INVENTION; and Bentley *v.* Wightman *v.* Sprague, (11) REDUCTION TO PRACTICE.

ABANDONED APPLICATIONS.

The records of abandoned applications in the U. S. Patent Office are not open to public inspection.

It is not to be conceded that inventions represented in abandoned applications in the Patent Office are the property of the public. In default of two years' public use of the invention, such an application may be re-instated or revived, and will have lost none of its original right of secrecy. To permit free inspection of such files would be to uncover to public scrutiny, inventions which are still the property of the applicants, and which may ultimately mature into patents.

Fowler, x. p., *Mitchell, Com.*, 14 Oct., 1889, 49 O. G. 562.

For exception to the above general rule, see U. S. *v.* Com. of Pat's, (1) CERTIFIED COPY.

ABANDONMENT OF AN APPLICATION.

1. All applications for U. S. patents are required to be presented in proper condition for examination (Sec. 4888 R. S.), and in default of being put in such condition within two years after filing, or of applicant's neglect to prosecute within two years after an Office action, of which he has been duly notified, such application is regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable.

Sec. 4894 R. S.

2. If an applicant neglect to prosecute his application for two years after the date when the last official notice of any action of the Office was *mailed* to him, the application will be held to be abandoned, as set forth in Rule 171.

P. O. R. 77.

3. Prosecution, to save an application from abandonment, must include such "proper action" as the condition of the case may require.

P. O. R. 171.

4. A broad distinction is to be recognized between constructive abandonment of an application and constructive abandonment of the invention; the former may, and frequently does, exist without involving the latter.

Fowler, x. p., *Mitchell, Com.*, 14 Oct., 1889, 49 O. G. 562.

5. Demands of Public Policy.

Section 4894 of the Revised Statutes, requiring that an application shall be completed and prepared for examination within two years after filing, and that not more than two years shall elapse without prosecution after any action thereon, gives ample time to the applicant; and public policy demands that the Office shall consider it as exhausting the liberality which the law extends as regards forfeitures.

Price, x. p., *Simonds, Com.*, 11 Nov., 1891, 57 O. G. 1000.
Compare Cordrey, (2) DELAY.

NOTE. — Abandonment or forfeiture of an application of course does not necessarily imply a forfeiture of the invention; for if it be new and useful, a patent may be secured upon a new application, providing it be filed within two years after expiration of the first application.

Compare Fowler, x. p., (4) *supra;* and Witherow *v.* Robert (11) and Scott (12) ABANDONMENT OF THE INVENTION.

6. A requirement (not a suggestion merely) made by the Examiner of the applicant, must be acted on within two years, to avoid abandonment.

Hume, x. p., *Simonds, Com.*, 28 Sep., 1891, C. D. Ms.

7. "Action," to save abandonment of application, must be in *Writing*.

A mere oral interview with the Examiner as to what he would do, is not sufficient action upon which to base a petition to revive an application which has become abandoned by two years' inaction within the meaning of Section 4894 R. S.

Day, x. p., *Frothingham, Act. Com.*, 28 Nov., 1891, C. D. Ms.

8. Failure to Prosecute.

Where the claimant had failed to prosecute his application for over four years, *Held*, that, to negative the presumption of abandonment, it was necessary to show, to the satisfaction of the Commissioner, that the failure to prosecute within two years from the last Office action, was unavoidable *in each and every part of that period* (Root, x. p., 1887, C. D. 81), and *also* to account for the subsequent failure, for over two years more, to prosecute the application.

Chittenden, x. p., *Mitchell, Com.*, 2 April, 1891, C. D. Ms.

9. "Proper Action" Defined. — Rule 171.

Proper action, within the meaning of Rule 171, is any such action as is prescribed by Statute of by the Rules of Practice. For example: If the case has been once rejected, proper action is a request for reconsideration on an amendment; if the application has been again rejected, and on the original references, proper action is an appeal to the Examiners-in-Chief; after an objection as to form, proper action may consist in either a compliance with the Examiner's requirements, or a request for reconsideration, or a petition to the Commissioner.

Harvey, x. p., *Fisher, Act. Com.*, 25 Feb., 1890, C. D. Ms.

10. Insufficient "Action."— Rule 171.

To assert, in a broader form, claims which the Examiners-in-Chief have rejected, without applying to the Commissioner to have the case re-opened and without a "showing" (Rule 142), is not such an action as a case which is closed requires, to save it from abandonment (Rule 171).

Zimmerman, x. p., *Frothingham, Act. Com.*, 24 Aug., 1891, C. D. Ms.

11. Neglect, Misinformation, — not Excusable.

On January 30 applicant was advised that an interference had been declared between his case and another, and that his case would be held up for revision under Rule 96, after decision in interference. On November 12 the interference was decided in favor of said applicant, of which due notice was mailed to him, but he took no action for more than two years. *Held* (overruling applicant's contention that the Office should have notified him, at termination of interference, that the case was awaiting his action): Applicant and his attorney were bound to *know* what was contained in the record, and also what action its condition required; nor was applicant's neglect excused by the fact that the application in question had been confounded with another of his applications.

Brown, x. p., *Frothingham, Act. Com.*, 23 May, 1892, C. D. Ms.

12. Insufficient "Action." — Rule 77 (2).

Application was filed 11 May, 1889, and the customary acknowledgment sent to applicant. Nothing further was done in the case until 5 Feb., 1890, when, at applicant's request, action was suspended until further notice. On 28 Nov., 1891, applicant requested action, but the Examiner refused to act on the application, holding that

it had become abandoned for want of prosecution for more than two years after notice of last action. *Held*, that, under Section 4894 R. S., and part 2, of Rule 77, the two years ran from the Official action of 14 May, 1889; and that the application became abandoned by applicant's failure to call for action within two years thereof.

Carpenter, x. p., *Frothingham, Act. Com.*, 15 Feb., 1892, C. D. Ms.

13. Neglect to Appeal.

Neglect to appeal to the Supreme Court of the District of Columbia within the time prescribed, constitutes an abandonment of the application which will not be rectified by fruitless attempts to obtain a rehearing (Gandy *v.* Marble, 122 U. S. 432,* ; Kirk *v.* Com. of Patents, 37 O. G. 451,* ; Vose *v.* The Trustees, &c., 2 Woods, 647 ; Cambuston *v.* U. S., 95 U. S. 285, * ; Wylie *v.* Coxe, 14 How. 1,*).

Miller, x. p., *Mitchell, Com.*, 25 June, 1890, C. D. Ms.

14. The Office cannot act upon a protest of abandonment filed by a party having a merely equitable interest. *Quære*, whether the protest might afterward be considered as evidence of intention not to abandon the application, in case the legal title should become vested in protestant?

Smith, x. p., *Frothingham, Act. Com.*, 10 Aug., 1891, C. D. Ms.

15. Extension of Time held to be an "Action" within the Meaning of Sec. 4894 R. S.

Application was acted upon by the Office, 13 Sep., 1888. Applicant obtained, on 21 Dec., 1889, a grant of extension of time in which to amend. There was no further action until 2 Jan., 1891, when applicant filed an amend-

ment. The Examiner refused admission to this amendment on the ground that the application had become abandoned by non-action within two years from 13 Sep., 1888. *Held*, that the Office letter of 21 Dec., 1889, granting extension, constituted an action within the meaning of the law, and, consequently, applicant's amendment was within the legal limit and therefore admissible.

Barre, x. p., *Mitchell, Com.*, 29 April, 1891, C. D. Ms.

16. Sufficient "Action."

Where the Office action was of a twofold character, one branch requiring a division and the other branch relating to discrepancy between a certain claim and certain subject-matter disclaimed, and applicant responded, within two years, with an action as to the discrepancy but not as to the requirement of division: *Held*, that applicant had not failed to take steps in the prosecution of his application within the two years required by law.

Bassett, x. p., *Mitchell, Com.*, 12 June, 1891, C. D. Ms.

ABORTIVE EXPERIMENTS. See ABANDONED EXPERIMENTS; DILIGENCE; INTERFERENCE; REDUCTION TO PRACTICE.

ADAPTATION.

1. Where parts are dispensed with and other devices employed in their places, rendering necessary certain additions to meet new aspects of the case: *Held*, that here is presumptive proof of invention as distinguished from that form of skill which manifests itself in a mere change of expedients, such as the substitution of mechanical equivalents.

Armstrong, x. p., *Leggett, Com.*, 28 Dec., 1872, 2 O. G. 704.

2. When devices, however well known in other machines or for other purposes, have never been employed

in a given machine or for purposes suggestive of the new application, legitimate combinations may be formed embodying such old devices.

Underwood, x. p., *Fisher, Com.*, 3 June, 1870, C. D. 53.

3. Where an inventor merely brings an old element into his machine, he makes no invention; but where he does more, — dispenses with certain parts, duplicates others, re-arranges and simplifies the machine, — he *must be held to have made an invention.*

Mundy *v.* Lindergood, U. S. C. C. S. D. N. Y., *Wheeler, J.*, 23 Ap., 1884, 27 O. G. 718. See also, 1872, C. D. 25; 24 O. G. 303; 28 O. G. 96; and Blinn *v.* Gale, *Paine, Com.*, 26 Aug., 1879, 16 O. G. 723.

4. If an old device or process be put to a new use which is not analogous to the old one, and the adaptation of the process to the new use is of such a character as to require the exercise of inventive skill to produce it, such use will not be denied the merit of patentability.

Ansonia Brass & Copper Co. *v.* Elec. Sup. Co., U. S. S. C. By *Brown*, J., 14 March, 1892, 58 O. G. 1692, ✿.

Compare (31) *et seq.*, INVENTION.

5. Whoever employs an old device in a new or modified way to produce a new and useful result, must be regarded as an inventor.

The objection of "double use" can only be raised when the old device applied to the new purpose is used in substantially the old way, or with such modifications only as call for nothing more than ordinary skill.

Burnham, x. p., *Duncan, Act. Com.*, 1872, C. D. 25.

6. An elevated water-tank for railway-stations, having its top or its top and bottom protected from external

cold by a space filled with air, or some other non-conductor of heat, is not anticipated by a refrigerator having spaces in its top and walls. Such new application of the non-conductibility of confined air and kindred substances is made under such widely different conditions and with such modifications in the previous mode of use as must have called for something more than mere adaptation, — it constitutes invention.

1872, C. D. 25.

Compare ANTICIPATION; PATENTABLE INVENTION; UTILITY.

ADDITIONAL EVIDENCE.

Satisfactory "Showing" Required.

When it is sought to present, for consideration, additional evidence, the attempt must be accompanied by a satisfactory "showing" why such evidence was not introduced at the first hearing.

Spielman, x. p., *Simonds, Com.*, 16 Sep., 1891, 56 O. G. 1707.

Compare Parry & Parry *v.* Black, (108); and Van Depoele *v.* Deeke, (169) INTERFERENCE.

ADMISSIONS.

Where it appears that the filer of an application in interference with a patent already granted, had, before making his application, contracted with the original patentees to manufacture and supply them with certain articles to be made under their patent, his subsequent application, and the evidence offered to support it, should be subjected to the sharpest scrutiny.

Dillon *v.* Kimball *et al.*, *Simonds, Com.*, 9 Jan., 1892, 58 O. G. 384.

AFFIDAVIT.

TO ANTEDATE REFERENCE.

1. An applicant cannot be held to have complied with Rule 75 when he merely avers that he conceived the invention and disclosed it to others, without stating by what agency the disclosure was made, and the details of which it consisted. To permit an applicant to prevail upon his naked statement of conception and disclosure would be to transfer the seat of judgment and decision from the tribunal sitting in the case to the mind of the applicant, — a transaction radically defective in principle and contrary to all judicial usage.

Donovan, x. p., *Mitchell, Com.*, 27 June, 1890, 52 O. G. 309.
See also Hansen *v.* Davis, *Mitchell, Com.*, 55 O. G. 998.

2. Applicant was required by the Examiner to file the drawings referred to in his affidavit, and to also file affidavits of those to whom the said drawings had been disclosed, properly identifying them. *Held,* that the Examiner should undoubtedly be upheld as far as relates to the drawings (Saunders, x. p., 1883, C. D. 23), but that the requirement that the affidavits of the persons to whom the drawings were disclosed should be furnished, must be overruled.

Hurlbut, x. p., *Mitchell, Com.*, 2 Aug., 1890, 52 O. G. 1062.
See REFERENCES.

3. The Affidavit required of Applicant who demands Interference with a Patent.

The affidavit which Paragraph 2 of Rule 94 requires of an applicant who desires his application to be put in interference with a patent, does not necessarily call for the showing of facts required by Rule 75, and is merely

an *ex parte* matter. The right to call for such showing is discretionary with the Office.

Ries *v.* Thomson, *Simonds, Com.*, 9 Dec., 1891, 57 O. G. 1598.

AGGREGATION.

Aggregation without New Function, not Patentable.

Where all the elements of a machine were old, and no new function was performed by the combination: *Held*, that, although the machine was undoubtedly more perfect than other machines for the same purpose, yet, as it was more perfect simply because of the co-operation of a greater number of elements, and not because of any new function performed by the combination, the case came within the many rulings of the Supreme Court holding that a mere aggregation of old elements in a new relation is not patentable.

Union Edge Setter Co. *v.* Keith, U. S. S. C. By *Brown*, J., 6 Ap., 1891, 139 U. S. 530, ✱.

See, to same purport, (1), (10), and (11) COMBINATION; also (30) *et seq.*, INVENTION.

ALLOWANCE.

Allowance takes date from the day notice was mailed to applicant or to his attorney.

Notice of allowance was issued 2 July, 1889, but was erroneously dated 2 June, 1889, which attorney knew was a mere clerical error, but sought to have the case withdrawn from issue. *Held*, that it could not be held that, because of said error, the case had not been regularly passed and allowed, and that it must be assumed that the attorney knew that under the Statute (Sec. 4885 R. S.) and the rules (Rule 167), the final fee could be paid within six months from the date the notice was

actually *sent*, and, in default thereof, that the case was abandoned.

Farnum, x. p., *Frothingham, Act. Com.*, 7 Jan. 1892, C. D. Ms.

Compare ABANDONED APPLICATION; RE-INSTATEMENT OF FORFEITED APPLICATION. See also Price, x. p., (20) PUBLIC RIGHTS AND OBLIGATIONS.

AMBIGUITY.

1. Claims ambiguous in phraseology, or which relate, or may be so read as to relate, to performances or functions merely, or to abstract principles or results, — not to specified instrumentalities, — are inadmissible, and ought not to be granted. It is the duty of the Office to obviate, as far as possible, the necessity for judicial correction of its errors, and to refuse claims of purely functional form, and even those which are *susceptible* of a functional interpretation.

Ives, x. p., *Paine, Com.*, 4 Dec., 1878, C. D. 134.

2. A mere reference to the body of the specification, by the words "substantially in the manner described," is not good practice, under the Statute requiring that the applicant shall "*distinctly*" claim his invention.

Rice, x. p., *Leggett, Com.*, 2 May, 1874, C. D. 44.

For important qualification of the rule laid down in Rice, *supra*, — *in case of a basic invention*, see decision of the Supreme Court in Morley Machine Co. *v.* Lancaster, ❀ (39) CLAIMS. See also (40), (41), (46) CLAIMS.

ACQUIESCENCE.

Acquiescence in a rejection and acceptance of a patent for the unrejected portions, constitutes abandonment of the rejected portions.

Where an applicant has acquiesced in a rejection, by the Patent Office, of his original claims, by submitting

amended claims, and taken a patent therefor, the Court will limit him to a strict construction of the allowed claims.

The J. L. Mott Iron Works *v.* The Standard M'f'g Co., U. S. C. C. W. D. Pa., *Acheson, J.*, 28 May, 1892, 60 O. G. 2071.

To same purport, see McClain *v.* Ortmayer, ❁ (67); Rocmer *v.* Peddie, ❁ (72); Phœnix Caster Co. *v.* Spiegel, ❁ (73) CLAIMS; and Sargent *v.* Hall Safe & Lock Co., ❁ (10) PUBLIC RIGHTS AND OBLIGATIONS.

AMENDMENT.

1. Amendment must have its foundation either in the drawing or in the specification.

Where there was no foundation, either in the specification or the drawing, upon which the amendment presented could be based, as required by Rule 70: *Held*, that the matter could not be helped by a supplemental oath, nor by the fact that, in a letter to his attorney, before the application was drawn, the applicant had indicated the construction which he desired to put into the case.

Scott, x. p., *Fisher, Act. Com.*, 6 Dec., 1890, C. D. Ms.

2. Substantial Amendment. — Rule 134.

The rejection of a claim based upon a consideration of the merits cannot be avoided by a mere change in the phraseology of the claim, — the substantial meaning of the claim remaining unchanged. Rule 134 provides for action upon an amended claim only when "amended in matter of substance." To be entitled, as of right, to amend after the second rejection without a "showing," — except to put the claim in better form for consideration on appeal (Rule 168), — applicant should be pre-

pared to show that the amendment prior to the second rejection was material in its scope and character.

Gibbs, x. p., *Mitchell, Com.*, 31 Oct., 1890, C. D. Ms.

As to test of materiality in framing claims, see Griswold, x. p., (4) EXAMINATION. Compare also Cheesborough, x. p., (6) RE-OPENING CASE.

3. New Matter Inadmissible.

Where applicant sought to amend his drawing, — not to conform to the specification as it was at the time of the filing of the application, but so as to conform to the specification as proposed to be contemporaneously amended, and the Examiner refused to comply with applicant's request to "admit, consider, and reject, under Rule 133," and (on the contrary) required restoration of the drawing to its original condition as required by Rule 70: *Held*, that the question came properly, by petition, to the Commissioner, and Examiner's action was sustained (Kissner, x. p., 53 O. G. 919). Case distinguished from such as Regan, x. p. (1888, C. D. 161), in which the drawing [or the specification], as originally filed, discloses the controverted matter.

Olmsted, x. p., *Mitchell, Com.*, 11 May, 1891, 46 C. D. Ms. 489.

4. "Benefit of the Doubt."

Where the Examiner refused to admit an amendment, on the ground that it did not substantially change the scope of the claims as originally presented: *Held*, that, as applicant appeared to be shaping his claims in good faith for the purpose of avoiding the references and accommodating himself to the action of the Office, he should be given the benefit of the doubt, and the amendment should be admitted for examination.

Lapham, x. p., *Frothingham, Act. Com.*, 21 Mar., 1891, C. D. Ms.

Compare Rogers, x. p., (2) EXAMINATION; and Noyes, x. p., (9) SPECIFICATION.

5. Admissibility of a claim, founded on the original specification, is a question of "merits," and is appealable to the Examiners-in-Chief.

Applicant presented two claims which he alleged substantially conformed to a recommendation of the Examiners-in-Chief, and, consequently, had foundation in the specification and drawings originally filed; but the Examiner reported adversely to their admission, on the ground that they had no such foundation, and that their admittance for examination would therefore be in violation of Rule 70, and contrary to the decision in Olmsted, x. p. (46 C. D. Ms. 489). *Held*, that Olmsted, x. p., did not sustain the action taken by the Examiner. That decision relates to an entirely different state of facts, and distinctly holds that the question whether a proposed claim is authorized by the specification and drawing as originally filed, is a question which must be decided by the Examiners-in-Chief, on appeal.

Pugsly, x. p., *Frothingham, Act. Com.*, 12 Oct., 1891, C. D. Ms.

NOTE. — Applicant and the Examiner being at issue as to a question of fact, it would seem, from Lapham, x. p., (4) *supra*, and Rogers, x. p., (2) EXAMINATION, that the Examiner, instead of refusing to entertain the claims, should, by rejecting them, have put the case in condition for appeal to the Examiners-in-Chief. In the case of Olmsted, x. p., (3) *supra*, on the contrary, applicant admitted that his new drawing did *not* conform to his original specification.

6. Where an amendment to the statement of invention was not objected to by the Examiner, *Held*, that it could be admitted without withdrawing the case from issue.

Taylor, x. p., *Fisher, Act. Com.*, 16 Jan., 1891, C. D. Ms.

7. Claims inadmissible in a Single Application which could not be included in one and the same Patent.

It is undoubtedly well settled that the refusal to enter an amendment containing claims which, if admitted, would not free the application from its condition as containing two or more separate and independent inventions; or to enter one containing claims which would place the application for the first time in such a condition that division would have to be required, — is a proper action.

Pierce, x. p., *Frothingham*, *Act. Com.*, 6 June, 1892, C. D. Ms.

Compare Robbins, x. p., (3); and Bullard, x. p., (24) DIVISION.

8. An amendment to an application must, to satisfy the requirements of Rule 70, show only such a change as was within the original disclosure that was made when the application was first presented.

Smith, x. p., *Simonds*, *Com.*, 23 Mar., 1892, 58 O. G. 1840.

Compare Holt, x. p., (4) CLAIMS.

9. Amendments should all have been filed before appeal is taken.

Rule 68 is explained to imply that amendments filed after a case has been twice rejected, and has either been appealed or is in condition for appeal, will not be entertained as a matter of course, but only on a "showing," duly verified, of reasons, which the Commissioner shall adjudge to be sufficient, why such amendments were not earlier presented.

Donovan, x. p., *Hall*, *Com.*, 9 July, 1888, C. D. 100.

10. Ordinarily all claims must be presented before the appeal stage.

If, as understood, the claim rejected by the Primary Examiner and by the Examiners-in-Chief was a broad

claim, there is no reason why a narrow and limited claim should not have been presented at the same time, and the judgment of the Office thus obtained upon both at once. If a party is allowed to come into the Office with a broad claim, secure a careful and thorough examination thereof, appeal, and take the judgment of the Office rejecting it, then present another and more limited claim as a matter of right, and pursue the same course of appeals, he could occupy the time of the Office unlimitedly, depending simply upon his skill and ingenuity in gradually reducing or limiting the character of his claim from the broadest to the narrowest scope of which the described invention was susceptible. It must be borne in mind that although the original examination of an application is supposed to be thorough and comprehensive, it is impossible for the Examiner to retain the subject in his mind and be familiar with it weeks or months afterward, when he takes the case up for a second consideration upon a narrower claim. Hence it is that Rule 68 has been adopted, the purpose of which is to require applicants to present their applications with their claims fully set forth, — as broad as they see proper, or as narrow, — in order that the entire subject may receive early and thorough consideration. If applicants fail to observe this requirement, and insist upon a single broad claim, and take an appeal, their right to amend is restricted and limited. Some "showing" must then be made why it was not earlier presented.

Donovan, x. p., *Hall, Com.*, 9 July, 1888, C. D. 100.
Compare (2) *et seq.*, DILATORY METHODS.

11. Amendment preparatory to Appeal.

There is nothing in the decision in Opdyke, x. p. (50 O. G. 1293), nor in any other cases laying down the same principle, which in any way tends to excuse an applicant from making the "showing" called for by

Rule 68, in order to secure the incorporation of amendments "touching the merits of the application" after the case is in condition for appeal.

Schmitz, x. p., *Mitchell, Com.*, 21 July, 1890, C. D. Ms.

NOTE. — The clause in Rule 68, above referred to, is as follows: —

If amendments touching the merits of the application are presented after the case is in condition for appeal, or after appeal has been taken, they may be admitted, upon a showing, duly verified, of good and sufficient reasons why they were not earlier presented.

12. Exception to Rule 68.

Where, after a second rejection and as a preliminary to appeal, applicant presented a new claim, with the statement that it was for the purpose of appeal and not for delay, and it appeared that the new claim covered substantially the subject-matter of the rejected claim, except that it was somewhat more restricted, and the Examiner refused to admit the claim, on the ground that it was not an amendment of the claim in the case, but an additional claim: *Held*, that Rule 68 did not apply to a case where no additional examination was required, and where the claim was the same except with some further restrictions; and that if the amendment did not come within the letter, it certainly did come within the spirit of the rule, and that the claim should be admitted.

Dubois, x. p., *Fisher, Act. Com.*, 23 Dec., 1890, C. D. Ms.

13. Latitude accorded Applicant.

Where amendments are presented for the purpose of putting the case into better condition for appeal to the Examiners-in-Chief, applicant will ordinarily be allowed to determine for himself the form which the application and claims shall assume (Sutliff, x. p., 40, C. D. Ms.

172; Leslie, x. p., 42, C. D. Ms. 235; and Collis, x. p., 50, O. G. 992).

Tuerffs, x. p., *Fisher, Act. Com.*, 4 Nov., 1890, C. D. Ms.

14. Right, in Same Application, to present Claim for Machine after Final Rejection of Claims for Product and for Process, Denied.

After applicant has prosecuted his claims for the article to final rejection, and after his claims to the process have been rejected, he should not be permitted to shift his ground so as to cover another and distinct invention, without a "showing" of good and sufficient reasons therefor, as provided for under Rule 68. It is not, however, intended to express any opinion as to whether or not the claims for the machine might have been presented together with those for the process and the article, in the original filing.

Phelps, x. p., *Frothingham, Act. Com.*, 23 Feb., 1892, C. D. Ms.

Compare with Winterlich, x. p., JOINDER OF MACHINE AND ITS PRODUCT; Butterfield & Batchelor, x. p., (2) RE-OPENING OF CASE; and Kinzer, x. p., (54) CLAIM.

15. Amendment must be seasonably presented.

After the Examiners-in-Chief had sustained Primary Examiner's rejection, petition to remand the case to Primary Examiner for interlocutory appeal as to said claims and to permit certain new claims, was denied at this stage of the proceedings, but without prejudice to the renewal of the petition after a decision by the Commissioner on the rejected claims.

Johnson, x. p., *Mitchell, Com.*, 25 June, 1890, C. D. Ms.

Compare Ellmaker, (16) *infra*; and Cheeseborough, x. p., (6) RE-OPENING CASE.

16. It has long been held by the Office that when a case is ready for appeal, no amendment will be admitted unless good and sufficient reason be shown why it was not earlier presented. This practice was approved by the present Commissioner, in the case of Cordrey, x. p. (48 O. G. 397), and may now be considered established.

Ellmaker, x. p., *Fisher, Act. Com.*, 19 June, 1890, C. D. Ms.
Compare Johnson, x. p., (15) *supra.*

17. After a decision by the Examiners-in-Chief, an amendment with nothing to support it but an affidavit by an expert to the effect that the references do not anticipate applicant's invention, will not be received. (See Rules 142 and 68, and the case of Parker, x. p., C. D. Ms.)

Anderson, x. p., *Fisher, Act. Com.*, 18 Feb., 1890, C. D. Ms.
Compare Corning *v.* Burden, (1) EXPERTS.

18. Amendments appealable to the Commissioner and Amendments appealable to the Examiners-in-Chief, Defined and Distinguished.

Objections to the specification accompanied by the Examiner's refusal to act further on the merits until the objections have been removed, are reviewable by a petition to the Commissioner, and not by an appeal to the Examiners-in-Chief. Amendments involving departure of invention raise no question for the Examiners-in-Chief unless they consist of new claims, either in whole or in part, or enlarge the meaning of the old claims already in the case.

Cäbel, x. p., *Mitchell, Com.*, 22 Nov., 1890, 55 O. G. 863.

19. An appeal case, amended in vital particulars must, before action on "merits," be returned to the Primary Examiner.

Amendments after appeal may be admitted for the purpose of putting the rejected claim in better form for consideration on appeal. Such amendments, however, should not vary the scope of the claim. If they have been admitted, and do vary the scope of the claim, the appellate tribunal should not pass upon the "merits," but the case should be sent back to the Primary Examiner for action.

Hooper & Clark, x. p., *Frothingham, Act. Com.*, 18 July, 1891, 56 O. G. 929.

20. An amendment upon the "merits," after final rejection, should be accompanied by a verified "showing" of good and sufficient reasons why it was not earlier presented.

Peloubet, x. p., *Frothingham, Act. Com.*, 26 May, 1891, 56 O. G. 928.

21. While an allowed application cannot, ordinarily, be re-opened for revision, modern restrictions on remedy by re-issue justify some indulgence in the original application.

While it is a general rule that applications which have been allowed will not be recalled for the purpose of amendment, an exception to the rule must be recognized in cases where great hardship or irreparable injury would otherwise result. Especially is this true since under modern decisions of the courts the right of re-issue has become so restricted that any failure, in the first application, to obtain full protection of an invention is, in a vast majority of cases, without remedy.

Myers, x. p., *Mitchell, Com.*, 24 Sep., 1889, 49 O. G. 131.

Compare Cordrey, x. p., (2); Lowe *v.* Springer *v.* Morse *v.* Granger, (3) DELAY; Pacholder, x. p., (1); Wharton, x. p., (2) PHRASEOLOGY; Pearson, x. p., (1) PIONEER INVENTION; Holt, x. p., (1) NEW MATTER; and Noyes, x. p., (9) SPECIFICATION.

22. Amendment after Allowance.

As a general rule, applications which have been allowed will not be recalled for the purpose of amendment, but an exception to the rule must be recognized in cases where great hardship or irreparable injury would otherwise result. Hence, where the claim sought to be incorporated is so specially pertinent to the subject-matter of the application, and so inseparable in its nature from the particular invention sought to be patented, that, if allowed in another application, there would be grave doubt whether the patent therefor would be valid, amendment after allowance should be permitted.

Ib.

To same purport, see Heald *v.* Rice, (1) JOINDER OF INVENTIONS. For general rule, to which the above case forms an exception, see (2), (9), (10), (11), (14), (15), (16), (17), and (20) *supra.*

23. Amendment for the Purpose of dominating Subsequent Inventions by Others, — Discountenanced.

Officials of the Patent Office, having judicial or quasi-judicial duties, should be upon their guard against amendments made late in the history of proceedings upon an application, which are apparently inspired by the purpose of dominating inventions subsequently made by other inventors, and not embraced within the scope of the application as originally filed.

Rogers *v.* Wissinger, *Mitchell, Com.*, 7 Mar., 1891, 56 O. G. 804.

24. Applicant's attorney may insert amended claims in consonance with the specification without having them verified by a special oath of applicant.

Railway Register M'f'g Co. *v.* N. Hudson Railway Co., *Nixon, J.*, 24 Feb., 1885, 32 O. G. 519.

25. Amendment of Drawing.

Petition to amend a drawing and thereby bring out a feature of construction not shown in the drawing as originally presented, nor described in the specification, but shown in an exhibit model not a part of the application, denied (Kissner, x. p., 53 O. G. 919).

Austin, x. p., *Simonds, Com.*, 19 Aug., 1891, 56 O. G. 1059.

26. Amendment of Preliminary Statement.

Motion to amend a preliminary statement, after a delay of four months and a half, denied.

Gornall *v.* Lovejoy, *Simonds, Com.*, 12 Aug., 1891, 56 O. G. 927.

ANALYSIS.

An applicant cannot be compelled to make an analysis of his material; but the Office has no facilities for making any such analysis, and if applicant is unwilling to make one, so as to facilitate examination, he must take the consequences.

Street, x. p., *Frothingham, Act. Com.*, 23 Feb., 1892, C. D. Ms. Compare Corson, x. p., (1); and Perkins, x. p., (2)

PRACTICAL DEMONSTRATION.

ANSWER.

The defence of "No Patentable Combination" can be made by setting it up in the answer.

Hendy *v.* Goldsmith, U. S. S. C. By *Blatchford, J.*, 14 May, 1888, 43 O. G. 1117, ✽.

ANTICIPATION.

1. Prior description in a printed publication or in a patent (to invalidate a United States patent) must be such as would be sufficient in such a patent.

Parker *v.* Stiles, *M'Lean, J.*, Nov., 1849, Western Law Journal.

Compare, to same purport, Green, x. p., (16) *infra.*

NOTE. — The decision of Commissioner Butterworth, in Borden, x. p., (3) PRIOR PUBLICATION, seems to have sustained action of rejection of an application on a reference of less completeness than was required in Parker *v.* Stiles, for invalidation of a granted patent. See, however, numerous cases cited in note to Borden, x. p.

2. When genius and patient perseverance have at length succeeded, in spite of sneers and scoffs, in perfecting some valuable invention or discovery, how seldom is it followed by a reward! Envy robs the inventor of the honor, while speculators, swindlers, and pirates rob him of the profits. Every unsuccessful experimenter who did or did not come near making the discovery, now claims it. Every one who can invent an improvement or vary its form claims a right to pirate the original discovery. We need not summon Morse, Blanchard, or Woodworth to prove that this is the usual history of every great discovery or invention.

Goodyear *v.* Day, *Grier, J.*, Mar., 1852, 2 Wallace, Jr., 283.

3. How invariable it is that — after a great invention has been brought before the world and has become known to the public and put in a form to be useful — people start up in various places and declare that they invented the same thing long before! These pretended prior inventors had thought of such a thing, perhaps, but they had never carried it to the extent of

making it of practical utility, *so that the world could obtain possession of it;* but when they find that another had completed that which they had begun, they are astonished that they did not see, think they must have seen, all that is necessary, and claim that they have invented it. After having seen what has been done, the mind is very apt to blend subsequent information with prior recollections and confuse them together. Prophecy after the event is easy prophecy. I think that this is one of the cases in which several of the witnesses have been led into the illusion of believing that they knew before what they have been taught by Mr. Howe's invention and specification.

Howe *v.* Underwood, *Sprague, J.*, Feb., 1854, 1 Fisher, 161.

Of like tenor, see (5), (7), (8), (9), (10), (15), (16), (17), (18), (19), and (24) *infra.*

4. A device which was used for about two and one half months only, and was then laid aside, *Held*, to be an anticipation of the patented invention, when the use was not for the purpose of testing the device, but was a public and practical one, with as much success as was reasonable to expect at that early stage of a particular art.

Brush *v.* Condit, *Shipman, J.*, 12 July, 1884, 28 O. G., 451.

5. Allegation of prior invention is usually entirely within control of the party asserting it; and so wide is the opportunity for self-deception or mistake, that the authorities are almost unanimous in holding that it must be established by proof clear, positive, and unequivocal; nothing must be left to speculation or conjecture.

Thayer *v.* Hart, *Coxe, J.*, 28 June, 1884, 28 O. G., 542.

6. That which would infringe the patent, if later, anticipates it if earlier.

Sessions *v.* Romadka, *Dyer, J.*, 26 July, 1884, 28 O. G., 721.

7. The presumption of the law is that the patentee is the inventor of that for which letters-patent are granted to him. Whoever alleges the contrary must assume the burden of proof. Evidence of doubtful probative force will not overthrow the legal presumption.

Am. Bell Telephone Co. *v.* The People's Telephone Co. *et al.*, U. S. C. C. S. D. N. Y., *Wallace, J.*, 1884, 29 O. G., 1029.

8. To constitute an effective defence, the proof of anticipation must be as full as required in the specification of a patent.

Patented inventions cannot be superseded by the mere introduction of a foreign publication of the kind, though of prior date, unless the description and drawings contain and exhibit a substantial representation of the patented improvement, in such full, clear, and exact terms as to enable any person skilled in the art or science to which it appertains to make, construct, and practise the invention to the same practical extent as he would be enabled to do if the information were derived from a prior patent. The prior knowledge of an invention, to avoid a patent, must be knowledge equal to that to be given by a patent.

New Process Fermentation Co. *v.* Koch, *Brown, J.*, May, 1854, 29 O. G., 537. See also Seymour *v.* Osborne, U. S. S. C. By *Clifford, J.*, 9 Jan., 1871, 11 Wall., 516,*.

9. It has been frequently held that drawings alone, unaccompanied by letter-press description, will never invalidate a patent.

Ib.

See also Parsons *v.* Colgate, 24 O. G., 203; Atterbury, x. p., 9 Ib., 640; Judson *v.* Cope, 1 Fish., 615; Reeves *v.* Keystone Bridge Co., 5 Fish., 456; and Seymour *v.* Osborne, 11 Wall., 516,*.

10. The Test of Probabilities.

As a guide to truth it is safer to rely upon the actions of men than upon their expressed declarations, — when the actions and the declarations are inconsistent. All persons reason in the direction of their desires, and resolve doubts in their own favor. When the dim and distant recollection of a party concerning his own conduct or that of another, in a matter of great interest to him who speaks, is found to be wholly at variance with what the known facts in that connection would naturally suggest and prompt, the fair inference is that the recollection of the witness is at fault, and that the logic of the known facts points nearer to the truth. It is natural for persons to hunt hastily through the pigeon-holes of memory where unpleasant or damaging truths are supposed to be stored away; and, on the other hand, it is just as natural to encourage and quicken the pace of a lagging and uncertain recollection which is believed to contain even a fragmentary fact which will tend to mend a flaw in a title through which valuable interests may escape. It is in such cases that *the desire, coupled with the imperfect conception of a device, ripens and matures in the light of subsequent knowledge;* but it very frequently occurs that the inventor confounds his original device and his later conception, and gives the latter the date of the former, and does it innocently. In such cases we appeal to the inherent probabilities which are always the ear-marks of truth.

Voelker *v.* Gray *v.* Edison *v.* Bell, *Butterworth, Com.*, 3 Mar., 1885, 30 O. G., 1091.

11. Benefit of the Doubt.

Where evidence, adduced by defendant, of alleged prior use of the patented article sued upon, is such as to leave the Court in doubt whether or not the exact device

in question was ever hit upon by a prior experimenter, and where it appears that the first general use of the device came from its publication by the patentee, this doubt should be resolved in his favor.

The Washburn & Moen M'f'g Co. *et al. v.* The Beat Em All Barbed Wire Co. *et al.*, U. S. S. C. By *Brown, J.*, 29 Feb., 1892, 58 O. G., 1555, ✱.

12. A single instance of profitable use in public — anticipates.

Where there had been a public, well-known, practical use in ordinary work, with as much success as was reasonable to expect at that stage in the development of the mechanism belonging to electric arc lighting, of the exact invention which was subsequently made by the patentee; *Held*, that although only one article like the patented invention was ever made, which was used two and one half months only, and although the mechanism in question was necessarily concealed from view during its legitimate use, and notwithstanding that the invention was taken from the lamp and was not afterward used with carbon pencils, it was, nevertheless, under the established rules on the subject, an anticipation of the patented device.

Brush *v.* Condit, *Mitchell, Com.*, 24 Sep., 1889, 49 O. G., 1211.

Compare (4) ***supra.***

13. A domestic applicant is entitled to receive a patent for his invention as against all foreign knowledge or use not based on a patent or a printed publication.

De Ferranti *v.* Westinghouse, *Mitchell, Com.*, 2 July, 1890, 52 O. G., 457.

14. An English patent, in order to anticipate, must have been *sealed* prior to the date of the invention for which the domestic patent was granted.

Smith *v.* Goodyear, U. S. S. C. By *Strong, J.*, 8 Jan. 1877, 93 U. S., 488, ❋. See also Bliss *v.* Merrill, *Coxe, J.*, 7 Dec., 1887, 42 O. G., 97.

15. Prior Patent or Publication.

Novelty is not negatived by any prior patent or printed publication, unless the information contained therein is full enough and precise enough to enable any person skilled in the art to which it relates to perform the process or make the thing covered by the patent sought to be anticipated (Walker on Patents, 57; Seymour *v.* Osborne, 11 Wall., 516,❋; Cohn *v.* U. S. Corset Co. 93 U. S., 366,❋; Eames *v.* Andrews, 122 U. S., 40, ❋).

Deprez & Carpentier *v.* Bernstein *v.* Hunter *v.* Gaulard & Gibbs, *Mitchell, Com.*, 24 Feb., 1891, 54 O. G., 1715.

16. Defective Reference.

A printed publication that expresses a conception of the invention and nothing more, seems to be defective as a reference, in that it does not "place the invention in the possession of the public as fully as if the art itself had been practically and publicly employed" (Robinson on Patents, Sec. 330).

Green, x. p., *Mitchell, Com.*, 28 Ap., 1891, C. D. Ms.
Compare (1), (6), (8), (9) *supra*, and (24) *infra*.

17. Proof of anticipation must be clear, positive, and beyond reasonable doubt.

The usually uncertain character of oral testimony to alleged anticipations of a patented invention has obliged courts to subject such evidence to the closest scrutiny, and not only to impose upon defendants the burden of

proving such anticipations, but to require that the proof shall be clear, satisfactory, and beyond a reasonable doubt. Witnesses whose memories are prodded by the eagerness of interested parties to elicit testimony favorable to themselves, are not usually to be depended upon for accurate information.

Washburn & Moen M'f'g Co. *v.* The Beat Em All Barbed Wire Co., U. S. S. C. By *Brown, J.*, 27 Feb., 1892, 58 O. G., 1555, ✿.

18. Insufficient Alleged Anticipation.

To constitute anticipation of a patented invention, it is not sufficient that the device relied upon might, by modification, be made to accomplish the function performed by the patent in question, if it was not designed by its maker, nor adapted nor actually used for the performance of such functions.

Topliff *v.* Topliff *et al.*, U. S. S. C. By *Brown, J.*, 25 Ap., 1892, 59 O. G., 1256, ✿.

19. Insufficiency of Disclosure in Official Reference.

Upon appeal from a decision of the Examiners-in-Chief which denied patentable novelty upon reference to a patent the material part of which relied upon in the present action was found in the specification, the language referred to being: —

> "By changing the form of the cams, this zigzag edge-stitch can be so modified that the needle passes down first through one of the pieces to be joined, then through the joint, and then through the other piece."

The Commissioner reversed the decision of the Examiners-in-Chief, saying that the form of the cams referred to was neither shown nor described, neither was the stitch itself. Given the pending application, it was easy to find applicant's improvement in the patent referred to; but such a finding required three assumptions, to

wit: (1) that patentee's seam was the same as applicant's; (2) that the modification of cams referred to could be arrived at without invention; and (3) that the machine, thus modified, would work practically upon knit goods, as to which there was ground for much doubt. The Commissioner considered the point a nice one, but held that the patent did not make the disclosure affirmatively and with the certainty required in order to bar an applicant.

Wilcox, x. p., *Simonds, Com.*, 26 Mar., 1892, C. D. Ms.

NOTE. — The learned Commissioner's above ruling is clearly conformable to the doctrine repeatedly laid down by tribunals in such cases. All whom it may concern are thereby warned that modifications deemed of sufficient importance for mention should (equally with the typical form) be described and represented with sufficient particularity to enable its construction by a practitioner, without the exercise of invention on his part (Parker *v.* Stiles, (1); New Process *v.* Koch, (8); Deprez *et al.* *v.* Bernstein *et al.*, (15); and Topliff *v.* Topliff *et al.*, (18) *supra*; Witty & Caffrey, MODIFICATIONS; and Detwold *v.* Reeves, (42) CLAIMS. See also Walton, x. p., (2); Burr *v.* Duryee, (5); and Lockwood, x. p., (7) EQUIVALENTS).

20. Although defendant conceived the idea of his patented device from an examination of complainant's patent, he is, nevertheless, entitled, in a suit for infringement, to claim that complainant's patent was itself anticipated by still earlier devices, especially when such earlier devices show a complete anticipation of his own.

Hoff *v.* Iron Clad M'f'g Co., U. S. S. C. By *Brown, J.*, 30 Mar., 1891, 35 L. ed., 179, ✱.

21. Printed Publication.

While it is true that under the present British statutes no invention can be said to have received a

British patent — within the meaning of Sections 4886 and 4887 R. S. — until the final act of affixing the seal, yet the fact must not be overlooked that the specification of said patent may be published before the sealing of the patent, which *publication* might have the effect of a bar to the granting of an American patent.

Mason *v.* Thompson, *Frothingham, Act. Com.*, 24 Aug., 1891, C. D. Ms.

22. Foreign Patent.

A foreign patent is evidence of perfected invention if the description contained therein is sufficiently clear and definite, and reduction to practice is not necessary to constitute a title to receive an American patent based upon it.

Deprez & Carpentier *v.* Bernstein *v.* Hunter *v.* Gaulard & Gibbs, *Mitchell, Com.*, 24 Feb., 1891, 54 O. G., 1711.

23. A foreign publication is competent as evidence in regard to the state of the art, and as a foundation for the inquiry whether it required invention to pass from the invention therein described to the structure patented.

French *v.* Carter, U. S. S. C. By *Blatchford, J.*, 24 Nov., 1890, 34 L. ed., 664, ✱.

24. It is a matter of extreme doubt whether an application can ever be rejected upon a reference whose construction is not specifically described, but reliance is placed wholly or mainly upon the illustration in the drawings.

Buhlman, x. p., *Fisher, Act. Com.*, 29 May, 1890, C. D. Ms.

25. A combination producing a group of useful results, *Held*, not to be anticipated by several prior combinations of some of the elements, each producing some, but not all, of said results; the superiority of the patented

device over the prior devices resulting not from any particular part or element, but rather from the combination and arrangement of the parts as a whole.

Illinois Watch Co. *v.* Robbins & Avery, U. S. C. C. A. (7th Cir.), Harlan, Woods & Jenkins, JJ. By *Woods, J.*, 1 Oct., 1892, 61 O. G., 721, ✽.

APPARATUS.

1. In the sense of the Patent Act, an apparatus must be classed as a "machine."

Blythe, x. p., *Butterworth, Com.*, 28 July, 1884, 30 O. G., 1321.

2. A new apparatus is a separate invention from the "art" which it is intended to carry out.

Ib.

APPEAL.

1. While not required to have the fulness of a brief, the grounds of appeal should, nevertheless, be explicitly stated.

Rules 133 and 135 require that appellant shall identify the part or parts of the decision appealed from, so that the Examiner may confine his statement to the particular points involved in the appeal, and not be compelled to anticipate every possible aspect which the presentation of the case on appeal may assume; but these reasons need not constitute a brief of the argument upon which the applicant will rely at the hearing; hence the action of the Examiner — refusing to answer the appeal on the grounds that it is not regular in form, or that it did not set forth the points on which it was taken, but stated simply that it was an appeal from the rejection of the claims on the references of record — is overruled.

Callahan, x. p., *Mitchell, Com.*, 6 Feb., 1890, 50 O. G., 990.

Compare Holmes *v.* Coles, U. S. S. C. By *Lamar, J.*, 3 Feb., 1890, 51 O. G., 622, ✽. See also McMillen & Hurst, x. p., (7) EXAMINER; also, (22) INTERFERENCE, and (2), (4), and (5) *infra*.

2. If the statement of reasons required by Rule 147 is defectively short, it does not necessarily render the appeal fatally defective.

Pitney *v.* Smith & Egge, *Mitchell, Com.*, 23 Sep., 1889, C. D. Ms.

3. The rejection of an application on the ground that the subject-matter having been disclosed in a former patent to the applicant without any indication in such patent of intent to claim it elsewhere, the invention must be held to have been dedicated to the public, is a question of the "merits," and appealable to the Examiners-in-Chief.

Comacher, x. p., *Fisher, Act. Com.*, 1 May, 1890, C. D. Ms.

4. A brief statement of reasons of appeal should accompany motion, but is not indispensable.

Upon a motion to dismiss an appeal from the Examiners-in-Chief to the Commissioner, on the ground that it was not accompanied by the "brief statement of reasons" required by Rule 147: *Held*, dismissing the motion, that the Statute does not require that the reasons shall be stated in order to render such appeal valid. The rule is *directory* in its nature, and not a condition precedent to the validity of the appeal.

Holmes & Holmes *v.* Coler, *Mitchell, Com.*, 17 May, 1890, 51 O. G., 1622.

5. All the claims desired to be adjudicated on must be presented on appeal, — in the first instance.

It appears to be the settled practice of the Office that, under ordinary circumstances, the appellant should, in the first instance, bring up narrow claims with his broader claims, on appeal, if they are to be passed upon in the one application under consideration (Parker, x. p.,

C. D. 41, Ms., 390; Jerome, x. p., C. D. 49, Ms., 223, and cases there cited).

Sailor, x. p., *Frothingham, Act. Com.*, 4 Feb., 1892, C. D. Ms.

6. Remandment to Primary Examiner.

Where, upon appeal from the Examiners-in-Chief, it appeared that, in affirming the action of the Primary Examiner, they had based their decision wholly on patents which were neither cited nor relied upon by the Primary Examiner, but which applicant had referred to in his specification as indicating the state of the art and as defining the limits of his invention, and applicant desired to present reasons why such patents did not anticipate, and filed affidavits in support of his views; the case was remanded to the Primary Examiner with direction to consider such patents, and also such affidavits and exhibits as had been filed with the Commissioner, or might hereafter be filed in accordance with the request.

Rogers, x. p., *Fisher, Act. Com.*, 29 Mar., 1890, C. D. Ms.

7. Question of Division.

Refusal by Examiner to entertain a divisional application, on the ground that it covers matter that could not be legitimately divided out of the earlier application, is reviewable by the Commissioner, on petition. It does not involve a question that can be taken to the Examiners-in-Chief by way of appeal, and Examiner's refusal to forward such appeal was properly made.

Fuller, x. p., *Simonds, Com.*, 4 Dec., 1891, 57 O. G., 1883.

8. A rejected application for a patent, pending, on appeal to the Supreme Court of the District of Columbia, is not open to review by the Commissioner of Patents.

Jerome, x. p., *Simonds, Com.*, 21 Jan., 1892, 58 O. G., 945.

9. Election.

A party who moves to dissolve an interference on two grounds, and has his motion granted upon one of them, has no right of appeal upon the other.

Ries *v.* Thomson, *Simonds, Com.*, 9 Dec., 1891, 57 O. G., 1598.

Compare cases under ELECTION and ESTOPPEL.

10. No appeal, by an opposing party, can be taken to any tribunal from a decision affirming the patentability of a claim, or the applicant's right to make the same.

Edison *v.* Stanley, *Simonds, Com.*, 3 Oct., 1891, 57 O. G., 273.

Nevertheless, the Commissioner may, for adequate reasons, withhold the grant. See (7) and (8) COMMISSIONER.

11. An applicant will be required to pay only one fee on a single application, on appeal to the Examiners-in-Chief, even if such appeal be repeated.

Thomson, x. p., *Frothingham, Act. Com.*, 10 July, 1891, 56 O. G., 1203.

12. Where, in an interference proceeding, the Primary Examiner fixed twenty days in which to appeal from his decision on a motion to dissolve, and the last day fell on Thanksgiving Day: *Held*, that day being a legal holiday, the limit of appeal expired the day before.

Dean & Robie *v.* Foendle, *Fisher, Act. Com.*, 1 Mar., 1890, C. D. Ms.

APPLICANT.

1. Applicant cannot select Examiner.

After the case has been examined and the claims finally rejected in one division, it cannot, at applicant's request, be transferred to another division for further examination. An applicant is not entitled to demand, as a matter of right, that the examination shall be made by a particular Examiner.

Porter, x. p., *Frothingham, Act. Com.*, 6 June, 1892, C. D. Ms.

2. [redacted]

The right of applicants to frame their own claims must be recognized, and the Office must act upon the claim as framed, and not upon a part of the claim, or upon a construction of the claim which ignores a part of it.

Graf & Reynolds, x. p., *Mitchell, Com.*, 6 Mar., 1891, C. D. Ms.

Compare, of like purport, Noyes, x. p., (9) SPECIFICATION; Rogers, x. p., (9) EXAMINATION; Lapham, x. p., (4) AMENDMENT; and cases (1), (2), (3), (4), and (5) PHRASEOLOGY. For instances where Examiner's verbal criticisms were sustained, see Kerr, x. p., (50) and (51), and Rogers, x. p., (52) CLAIMS; Raymond, x. p., (10) EXAMINATION; and Bromley, x. p., (10) SPECIFICATION.

3. Although it is to be deprecated, there is no way in which an applicant can be deprived by the Office of the right to delay for two years before responding to each Official action.

Epstein, x. p., *Fisher, Act. Com.*, 28 Nov., 1890, C. D. Ms.

Compare Todd, x. p., (1), and Cushman, x. p., (2), FORFEITURE; Knowles, x. p., (4) RE-INSTATEMENT OF FORFEITED APPLICATION; and cases (2) *et seq.*, DILATORY METHODS.

4. Deceased Applicant.

A "patent" which purports to issue to and in the name of a deceased person is void.

De La Vergne Refrig. Mach. Co. *v.* Featherstone *et al.*, *Blodgett, J.*, 29 Feb., 1892, 58 O. G., 1842.

5. Where the person or party who would have been entitled to receive the patent dies before the sealing of the patent, a valid grant thereof can be made only to the legal representative, and only on such

representative filing proper credentials of trust or ownership.

Sections 955 and 4896 R. S., and P. O. R., 25.

Compare DECEASE OF INVENTOR.

NOTE. — For an unassigned right, the patent issues to the Executor (or Administrator) in trust for the estate; for an assigned right, the issue is to the Assignee.

6. In Interference with a Patentee.

The burden, as to priority of invention, in an issue between a patent and an application, is upon the applicant to make out such a case as would warrant a cancellation of the patent by the Office, if jurisdiction existed for that purpose.

Gosline *v.* Barney, *Mitchell, Com.*, 9 Nov., 1889, C. D. Ms.

7. Legal Presumption.

In an interference between a patent and an application, where the question was not one of independent origination, but a dispute over the invention of the specific thing patented, the natural presumption in favor of the validity of the patent is greatly strengthened by the fact that the junior party to the interference had full knowledge of the patentee's proceedings before the Office, yet was fifteen months behind him in filing the application.

Hisey *v.* Peters, *Simonds, Com.*, 11 Mar., 1892, 58 O. G., 1691.

8. Where one of the contestants has a patent for the invention in dispute, and the other is an applicant for a patent, the latter, in order to prevail, must present a case, both as to conception and as to reasonable diligence, which does not admit of a reasonable doubt (U. S. Stamping Co. *v.* Jewett *et al.*, 18 Blatch., 469; Duffy *v.* Reynolds *et al.*, 24 F. R., 855; Fisk *v.* Church, 5 Fish., 540; Taylor *v.* Wood, 12 Blatch., 110; Drill Co.

v. Simpson, 37 O. G., 218); and also must (anterior to the filing of patentee's application) have reduced the invention to practical form as an operative machine (Elec. R. R. Sig. Co. *v.* Hall R. R. Sig. Co., 6 F. R., 603; Union Met. Cartr. Co. *v.* U. S. Cartr. Co., 7 F. R., 344).

Hunter *v.* Jenkin, *Simonds, Com.*, 12 Sep., 1891, 56 O. G., 1705.

NOTE. — The patentee's act, in application for patent, is regarded as the legal equivalent of an actual reduction to practice (Lowe *v.* Springer *et al.*, (1) CONSTRUCTIVE REDUCTION TO PRACTICE). To overcome this legal presumption, the later applicant must prove an *actual* reduction prior to such filing date (Lindsay *v.* McDonough, (126) INTERFERENCE). Furthermore, if, when he filed his application, patentee had already put his invention into actual practice, contestant's actual reduction must antedate the patentee's (Grant *v.* Harris, (122) INTERFERENCE).

Compare (118) to (132) inclusive, INTERFERENCE.

THE APPLICATION.

1. Application for United States Letters Patent must be within two years after the first sale or public use of the invention, and must be accompanied by Petition, Oath (or Affirmation), Drawing, Specification, and the fee ($15). It must be made by the Inventor, or (if deceased) by the Executor, or Administrator, for the benefit of the heirs.

Sections 4888 *et seq.* R. S.

2. There must accompany each application for a U. S. patent a written description of the invention (illustrated by a drawing if relating to a machine or to an apparatus), and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled

in the art or science to which it appertains or with which it is most nearly connected to make, construct, compound, and use the same; and, in the case of a machine, to explain the principle thereof and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions. Finally, he is required to distinctly particularize the part, improvement, or combination which he claims as his invention or discovery.

Sections 4888 and 4889 R. S., and P. O. R., 30.

3. An incomplete application which is suffered by applicant to remain so for the space of two years after filing, or an application which after completion he neglects for two years to prosecute, after any action thereon, and notice given him thereof, is regarded as abandoned, unless it shall be shown, to the satisfaction of the Commissioner, that such delay was unavoidable.

Section 4894 R. S., and P. O. R., 31.

Compare ABANDONMENT OF THE INVENTION; ABANDONMENT OF AN APPLICATION; RE-INSTATEMENT OF FORFEITED APPLICATION.

4. Two, or more, co-pending applications by the same applicant on the same indivisible subject-matter, inadmissible.

Applicant had two, or more, separate applications pending, which showed and described substantially the same invention, in each of which, respectively, he had broad and limited claims not, in Examiner's opinion, drawn on legitimate lines of division. *Held*, that an applicant should not be allowed to prosecute at the same time several applications for the same indivisible subject-matter. He must make clear distinctions between his respective applications, and not thrust upon the Office a task which properly belongs to himself, of de-

fining and maintaining the lines between two, or more, kindred applications.

Smith, x. p., *Hall, Com.*, 16 Aug., 1888, 44 O. G., 1183.

NOTE. — For cases where presentation of the same subject-matter in several contemporary applications was approved because the claims in the respective applications were drawn on legitimate lines of division, compare Langlois, x. p., (12), Gabouri, x. p., (13), and Feister, x. p., (14) EXAMINATION.

5. The creator of a generic invention may show and describe several species, and may claim one of them, and may also secure a generic claim inclusive of them all. Claims to other specific forms can be protected only under separate patents.

Eagle, x. p., *Fisher, Com.*, 1870, C. D. 137.

6. Applicant's election of one of several species shown, for his specific claim, bars claims to other species in the same application.

Where an application has received examination upon a specific claim which has been rejected upon references whose sufficiency was so far admitted by applicant as to cause him to cancel said claim, the Examiner held that, while it is true that the inventor of a generic invention has a right to show and describe several species and to claim one of them, and also to present a generic claim inclusive of them all, as clearly set forth in Eagle, x. p., 1870, C. D. 137, nevertheless, having claimed this species, — whether in company with a generic claim or not, — he has made an election, and, when the Office has considered the claims thus presented, and rejected them on references the sufficiency of which was so far admitted by applicant as to cause him to cancel the species claim, he has no right to come before the Office with a claim for another species in the same application; and, further-

more, that the species being fully met, the genus falls with it; that the invention claimed is anticipated in full, and that there remains nothing on which the applicant can base a demand for examination of claim to a second species under the genus. *Held*, that the Examiner's decision was strictly in accordance with the established practice of the Office.

Mitchell, x. p., *Mitchell, Com.*, 25 Sept., 1890, C. D. Ms.

Compare Eagle, x. p., (5) *supra;* also Dewey, x. p., (49), and Heaton, x. p., and Cook, x. p., (85) CLAIM.

7. Filing Date.

Where an application — filed 27 June, 1891 — was complete in all necessary parts, except in the absence from the drawing of a figure 3, called for in the specification: *Held*, upon its appearing that the numeral 4 had been inadvertently affixed to a figure instead of the numeral 3, and that the drawings were in fact complete, that the application should be given a filing date as of June 27, 1891.

Hayes, x. p., *Frothingham, Act. Com.*, 28 July, 1891, C. D. Ms.

8. Documents for Record in the Patent Office required to be Accurate and in Permanent Ink.

When the type-written part of the application and other papers is not in permanent ink, the Examiner may require applicant to furnish accurate copies and in permanent ink, because the permanent character of the written records of the Office is an important matter.

Ritter, x. p., *Simonds, Com.*, 22 Dec., 1891, 57 O. G., 1883.

9. Where, after an application had been rejected, the inventor employed an attorney to prosecute the applica-

tion, and then went into a foreign country and remained abroad for more than two years, during which time he had no communication with his attorney nor made any inquiry either of him or of the Patent Office in reference to the application: *Held*, that it was not such unavoidable delay as would warrant a revival of the application. Neither absence in a foreign country, nor pressure of business, nor intrusting the conduct of an application entirely to an attorney or an assignee, is sufficient reason for holding that a delay was unavoidable (Wickersham, x. p., 18 C. D. Ms., 358; Maxwell, x. p., 21 C. D. Ms., 222; Barrett, x. p., 39 C. D. Ms., 351).

Wiard, x. p., *Fisher, Act. Com.*, 2 Ap. 1890, C. D. Ms.

Compare RE-INSTATEMENT OF APPLICATION.

10. Two Years' Statutory Probation, — Explained and Applied.

Section 4886 of the Revised Statutes — which was in force when complainant's patent was applied for and issued — enacts that a patent may be obtained when the invention has not been "in public use or on sale for more than two years prior to the application;" and Section 4920 provides that it may be pleaded and proved as a defence, in a suit at law or in equity on the patent, that the invention "had been in public use or on sale in this country for more than two years before the application, or had been abandoned to the public."

It is contended by the plaintiff that the principles recognized by this court in Elizabeth *v.* Pavement Co. (97 U. S., 126,*) establish the patentability of his invention, notwithstanding its embodiment in the California Street Railroad. But the Circuit Court held that the proofs in the present case did not show a use of the invention *substantially for experiment*, but showed such a *public use* of it as must defeat the patent. The Circuit

Court further said that the facts were in marked contrast with those in Elizabeth *v.* Pavement Co., because there the use was solely for experiment.

We think that the present case does not fall within the principles laid down in Elizabeth *v.* Pavement Co. The plaintiff did not file a caveat, and there is no evidence that he did not intend to abandon his right to a patent. It does not appear that any part of the structure was made at his own expense, or that he put it down in order to ascertain its durability or its liability to decay, or that what he said he noticed in the spring of 1879 led him to make any further examination in that respect, or to test further the fear which he says he had at that time, or that what he then saw led him to think that the structure was weak or undesirable. It cannot be fairly said, from the proofs, that the plaintiff was engaged in good faith, from the time the road was put into operation, in testing the working of the structure he afterwards patented. He made no experiments with a view to alterations; and we are of the opinion, on the evidence, that sufficient time elapsed to test the durability of the structure, and still permit him to apply for his patent within two years. He did nothing and said nothing which indicated that he was keeping the invention under his control.

In Smith & Griggs M'f'g Co. *v.* Sprague (123 U. S., 249, 256, 257, ❋) it was said, — Mr. Justice Mathews speaking for the Court: —

> A use by the inventor for the purpose of testing the machine, in order by experiment to devise additional means for perfecting the success of its operation, is admissible; and where, as incident to such use, the product of its operation is disposed of by sale, such profit from its use does not change its character; but where the use is mainly for the purpose of trade and profit, and the

experiment is merely incidental to that, the principal, and not the incident, must give character to the use. The thing implied as excepted out of the prohibition of the statute is a use which may be properly characterized as substantially for the purpose of experiment.

In addition to the above, the Court cited and applied Hall *v.* Macneale (107 U. S., 90, 96, 97, ✽) and Egbert *v.* Lippmann (104 U. S., 333, 336, ✽).

The decree of the Circuit Judge (*Wallace*) was affirmed.

Henry Root *v.* Third Avenue R. R. Co., U. S. S. C. (Oct. term, case No. 39). By *Blatchford, J.*, 21 Nov., 1892, ✽.

Compare (4), (7), and (8) ABANDONMENT OF THE INVENTION.

ARBITRATION.

Where a contract stipulates that an arbitration is to be a condition precedent to the right to sue under the contract, or even if this may be inferred upon construction, no suit can be maintained unless the plaintiff has made all reasonable efforts to comply with the conditions.

Perkins *v.* U. S. Elec. Lt. Co., *Wallace, J.*, 18 Ap. 1893, 24 O. G., 204.

ART.

1. The Words "Art," "Process," etc., as used under the Patent Law, Defined and Distinguished.

A "process," *eo nomine*, is not made the subject of a patent in our acts of Congress. It is [however] included under the general term "useful art." "An art" may require one or more "processes" or "machines," in order to produce a certain result or "manufacture." The term "machine" includes every mechanical device or combination of mechanical powers and devices to perform some "function" and produce a certain effect or result. But where the result is produced by chemical

action, — by the operation or application of some element or power of nature, or of one substance to another, — such modes, methods, or operations are called "processes." A new process is usually the result of "discovery;" a machine, of "invention." The arts of tanning, dyeing, making water-proof cloth, vulcanizing india-rubber, smelting ores, and numerous others, are usually carried on by processes, as distinguished from machines. One may *discover* a new and useful improvement in the process of tanning irrespective of any particular form of machinery or mechanical device. Another may *invent* a labor-saving machine by which the operation or process may be performed, and each may be entitled to his patent. It is for the discovery or invention of some particular *method* or *means* of producing a beneficial result or effect, that a patent is granted, and not for the result or effect itself. But the term "process" is often used in a more vague sense, in which it cannot be the subject of a patent. Thus, we say that a board is undergoing the "process" of being planed; grain, of being ground; iron, of being hammered or rolled. Here the term is used subjectively or passively, as applied to the material operated on, and not to the method or mode of producing that operation. In this use of the term it represents the function of a machine, or the effect produced by it on the material subjected to its action; but it is well settled that a man cannot have a patent for the function or abstract effect of a machine, but only for the machine which produces it.

Corning *et al. v.* Burden, U. S. S. C. By *Wayne, J.*, Dec., 1853, 15 Howard, 252, ❁.

NOTE. — For further and more comprehensive elucidation of the above legal phrases, see decision of U. S. Supreme Court in Dolbear *v.* Am. Bell Telephone Co., ❁ (16), and of *Wheeler, J.*, in MacKay *v.* Jackman, (45) INVENTION. Compare also Blythe,

x. p., (5) CLASSIFICATION; Young, x. p., (15), and Harrison, x. p., (18) PROCESS; and comments of Commissioner Simonds, in Kelly, x. p., (2), and Dalton, x. p., (3) *infra*.

2. The Word "Art," in Patent Law and Jurisprudence.

The definitions of a "process," in Corning *v.* Burden (15 Howard, 252,*) — quoted, with seeming approval, in Tilghman *v.* Procter (102 U. S., 707, *) and in Cochrane *v.* Deener (94 U. S., 780, *), — are understood to practically define the word "art" in the patent law.

Kelly, x. p., *Simonds, Com.*, 30 Oct., 1891, C. D. Ms.
Compare Young, x. p., (15) PROCESS.

3. Whether the word "Art," as employed in the statute, has been fully defined, — Quære.

It is not believed that the Supreme Court has ever stated the entire range of meaning belonging to the word "art." It has said, in substance, that a process is an art (Corning *v.* Burden, 15 Howard, 252, *; and Cochrane *v.* Deener, 94 U. S., 780, *). The decision of the Supreme Court, endorsing the validity of Bell's telephone patent (126 U. S. 1) shows, however, that chemical processes are not the only things which are comprehended by the word "art" in Section 4886 R. S. An important claim (Claim 5) of Bell's patent, which was presented, considered, and endorsed, presents no such process as was defined by the Supreme Court in Corning *v.* Burden, *supra*, and in Tilghman *v.* Procter (102 U. S., 707, *). So far as can be known, there was no change effected in the nature of any *substance* by the practice of Bell's art. The *art* which was there endorsed may be said to consist in the TRANSMISSION AND REPRODUCTION OF A VOCAL IMPULSE. Nothing appears to show that any change in the *nature* of

that impulse took place during such transmission or reproduction.

Dalton, x. p., *Simonds*, *Com.*, 18 Feb., 1892, C. D. Ms.

NOTE. — Compare instructive actions of the Supreme Court in construing the eighth claim of Samuel F. B. Morse, and the above-cited fifth claim of Alexander Graham Bell, (46) CLAIMS.

4. Grouped Letters for Telegraphic Purposes.

The following claim bears some analogy to that granted to S. F. B. Morse, 13 June, 1848, for certain groups of dots and dashes to represent letters of the alphabet: —

In a printing telegraph, the combination substantially as herein set forth, with a key-board having its keys designated by characters in substantially the following sequence, — BODFGMK – JYEAIOU – SCPLTHER – VIVEAIOU – SCPLTHER – QWEAIOU – BUDFGMK – XYEAIOU – SCPLTHER – VIVAEIOU – BUDFGMK – JYEAIOU – SCPLTHER – QWEAIOU – BUDFGMK – ZYEAIOU – SCPLTHER – XYEAIOU, — with a type-wheel having its periphery engraved with characters corresponding both in form and sequence to the characters upon said keys.

Claim in patent to C. F. Burke, for a printing telegraph, granted 7 Oct., 1884, 29 O. G., 6.

5. Discovery.

Whoever discovers a previously unknown mode of action in the world of physical things and reduces it to practice, getting a novel product or process within the range of patentable subject-matter, distinctly useful and lying outside the range of experience and skill, makes a patentable discovery, even though the discovery be entirely accidental.

Such accidental origin, even if true, would be immaterial unless coupled with one other fact; namely,

that the inventor did not know how he produced the article or product, and could not produce it again.

Vollrath *v.* Comstock, *Simonds, Com.*, 5 May, 1892, 59 O. G., 1105.

NOTE. — The claim in question was as follows: —

"Enamelled ironware having mechanically suspended or held in and throughout the glaze a granular or comminuted material, in color contrasting with that of the body of the enamelled coating, and comparatively infusible as compared to the glaze."

To substantially the same purport as above ruling, see (29) INVENTION.

"A process for breaking and training animals," which was found to be clearly a new and highly useful invention, did not appear to come within the terms of a patentable art such as was laid down by the Supreme Court in Corning *v.* Burden (15 How., 252, ✱), and Cochrane *v.* Deener (94 U. S., 780, ✱), and in the decision of Morton *v.* N. Y. Eye Infirmary (5 Blatch., 116); and the adverse decision of the Examiners-in-Chief was affirmed.

Kelly, x. p., *Simonds, Com.*, 30 Oct., 1891, C. D. Ms.

Compare Griggs *v.* Perrin, (4) COPYRIGHT.

ARTICLE OF MANUFACTURE.

1. Patentable novelty in process does not confer patentability on the product.

A patent for "An Article of Manufacture" cannot be sustained on the ground that it was fabricated by new and improved machinery; it must be a new and improved thing in itself, possessing novelty of its own, independent of the devices, processes, or arts by which it was produced (Cobb, x. p., 1874, C. D. 60; Rumford *v.* Lauer, 10 Blatch., 122).

Draper *v.* Hudson, *Shepley, J.*, 11 Mar., 1873, 3 O. G., 354.

For important exceptions to the above general rule, see Painter, x. p., (2), and Corscaden *v.* Recht, (3.) *infra.*

2. A claim for an article of manufacture should not, as a rule, be defined by the process of producing it. On the other hand, *when a man has made an invention, his right to a patent for it, or his right to a claim properly defining it, is not to be determined by the limitations of the English language.* When the case arises that an article of manufacture is a new thing, a useful thing, and embodies invention, and that article cannot be properly defined and discriminated from the prior art otherwise than by reference to the process of producing it, a case is presented which constitutes a proper exception to the rule. An illustration of such exceptional case was seen in that of the Globe Nail Co. *v.* Horse Nail Co. (19 F. R., 819), where the Court sustained the following claim, which defines the patented article wholly by the process of making it: —

A nail, made by cutting or punching from hot-rolled ribbed bars of metal, a headed blank substantially as described, and by elongating, hardening, and compressing the shanks of such blanks by cold-rolling from the head to the point, thereby giving to all parts of the nail so produced the peculiar qualities specified.

Painter, x. p., *Simonds, Com.*, 9 Nov., 1891., 57 O. G., 999.

3. In the case of Corscaden *v.* Recht, an exception like that announced in the case of Painter (*supra*), to the general rule laid down in Draper *v.* Hudson, was applied, and reference was made to the Supreme Court decision in the case of Plummer *v.* Sargent (120 U. S., 442, ❁), in which a claim for an article defined by the process of making it was held not to be infringed by an article which was made by a different process, although not to be distinguished by mere inspection.

Corscaden *v.* Recht, 26 Aug., 1892, C. D. Ms.

4. The rejection of a claim to an alleged new article of manufacture sustained, where the only new feature of substance which was attained by use of applicant's process was specified by other claims which had been allowed by the Examiners-in-Chief. A thing is not necessarily new because made by a new process.

Rogers, x. p., *Simonds, Com.*, 9 Mar., 1892, C. D. Ms.

5. It is a sound principle of law that the patentee of a new article of manufacture is bound to disclose how to make it, unless the description of the article itself at once suggests to those conversant with the art the means of making it.

If tools and processes for making a new article are not generally known, an illustration of them is permissible.

Amjourn, x. p., *Simonds, Com.*, 3 Mar., 1892, C. D. Ms.

6. Where applicant contended that certain references did not fully anticipate his improvement because his improvement was claimed as an article of manufacture: *Held*, that there is no magic in the use of the words "article of manufacture." *Invention* is required to make a new article of manufacture patentable, just as much as in any other case.

Bromwell, x. p., *Simonds, Com.*, 21 Dec., 1891, C. D. Ms.

ASSIGNEE.

1. An assignee of the entire interest, who, before payment of the final fee, places on record an assignment in which the invention is clearly and unmistakably identified, can have the patent issue to himself. In default of such identification, — such issue denied.

Neither Section 4895 nor Rules 26 and 215 make it *obligatory* upon the Commissioner of Patents to issue a

patent to the assignee of the inventor; and the decisions and rules of the Patent Office prescribe that a patent can issue to the assignee only where the invention is *clearly and unmistakably identified* (Galer *v.* Wilder, 10 How., 477, ❁; Consol. Elec. Lt. Co. *v.* Edison Elec. Lt. Co., 33 O. G., 1597).

In re, Samuel J. Murray, *Fisher*, *Act. Com.*, 18 Aug., 1890, C. D. Ms.

NOTE. — (i) In this case an alleged assignment which petitioner had requested to be recorded, had been returned to him with the statement that it did not identify the invention to which it related sufficiently to warrant its application to any case pending before the Patent Office. The petitioner having returned the assignment (unchanged) to the Office, with a reiteration of his request for withdrawal of the patent from the issue-docket and that it be issued to the assignee, the Acting Commissioner directed that the instrument be recorded for what it was worth, but refused to withhold the patent, — which had been already set for issue to the inventor, — the specification having been printed, the drawings photolithographed, and the Official Gazette printed and ready for delivery. (ii) Petition, the same day, addressed to the Secretary of the Interior for refusal of his signature to the patent, was denied by *Assistant Secretary Bussey*, "for reasons stated in the decision of the Acting Commissioner." (iii) The patent having, accordingly, issued to the inventor, a petition, under Rule 170, for indorsement upon the patent of certificate of Official error, was denied, "because the assignment, although subsequent to the filing of the application, did not identify it by its serial number." *In re*, S. J. Murray, *Mitchell*, *Com.*, 21 May, 1891.

2. Necessity of Precise Identification.

Where the assignments referred to applications as "of even date," but bore a date a day earlier, and the patents were issued in the name of the inventor: *Held*, upon an

application for a certificate of correction, that it would be a very dangerous practice for the Office to issue patents to assignees under such assignments, and that the Office was not at fault in failing to do so; and a certificate of correction was refused.

In re, Wirth, *Mitchell, Com.*, 30 Ap., 1891, C. D. Ms.

3. Patent not issued to Holder of a Territorial Grant.

A transfer of the exclusive right to a patent within and throughout a specified portion of the United States is, properly speaking, an assignment, and vests in the assignee a title to so much of the patent itself, with the right to sue infringers; but Section 4895 R. S., as interpreted by Section 4816 R. S., and as always and consistently understood by the framers of the rules of practice, gives no authority to the Commissioner to issue the patent to such territorial grantee, but only to an assignee of the entire interest or of an undivided part thereof.

Buchanan, x. p., *Mitchell, Com.*, 18 Feb., 1891, C. D. Ms.

4. Assignee's Right of Representation.

It is the common practice in the Patent Office to allow the assignee of an undivided part of an invention to be represented, if he so desires, by an attorney of his own selection; but an instrument which does not come within the definition of an assignment laid down by the Supreme Court in Waterman *v.* Mackenzie (U. S. S. C., 34 L. ed., 923, ❀) does not entitle the holder to such representation.

Hunter, x. p., *Frothingham, Act. Com.*, 23 Ap., 1891, C. D. Ms.
See Waterman *v.* Mackenzie, (5) ASSIGNMENT.

5. Presumptive Proof of Ownership.

Where a patent has been issued jointly to the inventor and to one named therein as his assignee, it will be pre-

sumed, in absence of proof to the contrary, that the assignment was properly made and entered of record in the Patent Office.

Whitcomb *v.* Coal Co., U. S. C. C. N. D. Ill., *Blodgett, J.*, 42 F. R., 652.

6. It is not obligatory, on the part of the Office, to issue a patent to an assignee; the terms of the statute are merely permissive, and, in a contest between parties claiming under different assignments, he may issue the patent to the inventor, and relegate the parties to the courts for settlement of their rights.

Speilman, x. p., *Simonds, Com.*, 23 Dec., 1891, C. D. Ms.

ASSIGNMENT.

1. The entire or any fractional interest in an invention may be conveyed, either before or after issue of a patent therefor, by any instrument of writing.

Such instrument, if executed before issue, should be recorded within three months after issue; if executed after issue, it should be recorded within three months after execution.

In default of such record, such conveyance will be void as against a subsequent *bona fide* purchaser.

Section 4898 R. S.

NOTE.—The assignment must clearly identify the application by its serial number or otherwise. See Lorentz, x. p., EXECUTORY AGREEMENT.

2. A patent may issue, in whole or in part, to an assignee; but the instrument of conveyance must have been entered for record at or before payment of the final fee.

R. S., 4895, P. O. R., 206; Wright *v.* Randall *et al.*, *Blatchford, J.*, 5 Sep., 1881, 20 O. G., 493.

3. Assignment of right to or under, or interest in a patent is effected by an instrument in writing (4898 R. S.), which may convey either (i) the whole patent, comprising the exclusive right to make, use, and vend the invention throughout the United States; or (ii) an undivided part or share of that exclusive right; or (iii) the exclusive right under the patent within and throughout a specified part of the United States.

Waterman *v.* Mackenzie *et al.*, U. S. S. C. By *Gray, J.*, 12 Feb., 1891, 54 O. G., 1562, ❁.

4. Such an instrument vests in the assignee a title in so much of the patent itself, with a right to sue infringers, alone in the first and third cases, and conjointly with the assignor in the second.

Ib. ❁.

5. Any other grant or transfer is a mere license, which gives the grantee no title in the patent and no right to sue at law in his own name for an infringement.

Ib. ❁.

6. The right to make and sell and the right to use are severable, but the modes of use are not severable.

The right to make and sell and the right to use are completely severable by the owner, and may be disposed of separately (Dorsey *v.* Bradley, 12 Blatch., 202); but, in the absence of any such expressed restriction or separation, a conveyance of the right to make and sell implies the right to use anywhere an article thus legitimately purchased (Adams *v.* Burke, 17 Wallace, 453, ❁); but a patentee cannot divide his right into modes of use, and grant to one man the right to use it in connection with or application to one thing, and to another in connection with another thing, to such an extent as that purchasers from any of these persons may

not use the fabric purchased precisely as they like, and, if they please, in violation of what the patentee had supposed were rights not granted by him.

The Washing Machine Co. *v.* Earle, U. S. C. C. E. D. Pa. By *Grier, J.*, 1861, 3 Wallace, Jr.

7. Conveyance of the right to make and sell a patented article includes the right to use it anywhere, and it also includes the right to sell it anywhere not in the ordinary course of trade.

Turnbull *v.* Weir Plow Co., *Drummond, J.*, Mar., 1880, 23 O. G., 91.

See also Curran *et al. v.* Birdsall, *Blodgett, J.*, 16 July, 1883, 27 O. G., 1319.

8. A conveyance of "all my right, title, and interest in and to" a certain patent, though properly recorded, does not include the right for two counties covered by a prior conveyance, although such prior conveyance was not recorded in the Patent Office.

Ib.

9. An instrument in writing granting all right, title, and interest in the invention, except as to a certain combination set forth in the application, is not an assignment; and an attorney appointed by a person holding such an instrument will not be recognized in the prosecution of the application (Waterman *v.* Mackenzie *et al.*, 54 O. G., 1562, ❁).

Hunter, x. p., *Frothingham, Act. Com.*, 23 Ap., 1891, 56 O. G., 929.

Compare Turnbull *v.* Weir Plow Co., (7) and (8) *supra.*

10. A patentee may not take advantage of his own wrong-doing.

Where a patentee, after selling all his rights under the patent, subsequently purchases an older patent to defeat

his assignee's rights: *Held*, that such proceeding is manifestly unjust and inequitable, even if the older patent clearly anticipates the device sold.

Curran *et al. v.* Birdsall, *Blodgett, J.*, 16 July, 1883, 27 O. G., 1219.

11. A patentee may not, as against the assignees of his entire interest, so restrict and qualify the claims of his patent as to make them void for want of novelty.

Adee *v.* Thomas, *Lacombe, J.*, 23 Jan., 1889, 47 O. G., 528.

12. Executory Agreement.

A party who bases his rights as an assignee upon an instrument recorded in the Patent Office before application was made, and which did not specifically identify the invention, will not be permitted to examine the files, because such an instrument is not an assignment, but a mere executory agreement.

Lorentz, x. p., *Simonds, Com.*, 28 Mar., 1892, 59 O. G., 158.

13. Instruments given by a married woman or by a minor must accord with the local law in the place of domicil.

Section 4898 R. S. requires that the assignment of a patent be by an instrument in writing. Where the grantor is a married woman or a minor, the ability to make the instrument, or the aids to a disability, must be sought in the laws of the respectives States regulating such rights.

Fetter *v.* Newhall, *Marble, Com.*, 21 Sep., 1883, 25 O. G., 502.

14. The assignee of an inventor who died without making his application has no standing as an applicant before the Patent Office; and this is true even where the

application sought to be made by the assignee is a division of one properly filed by the inventor.

Stevens, x. p., *Simonds, Com.*, 6 Ap., 1892, 59 O. G., 299.

Compare De La Vergne *v.* Featherstone, (1) PATENT, and Davis, x. p., (7) ATTORNEY.

CONFLICTING ASSIGNMENTS, see (2) OFFICE PRACTICE.

ASSISTANT COMMISSIONER.

Duties same in Kind as those of the Commissioner.

Petition that a rehearing be granted of a case decided by the Assistant Commissioner, the sole reason for such petition being that a petition upon the merits of the case by the Commissioner in person is desired by the petitioner: *Denied*, on the ground that the duties of the Assistant Commissioner are necessarily the same in kind as those of the Commissioner, and on the ground that those duties are directly prescribed by statute.

Hughes, x. p., *Simonds, Com.*, 9 Sep., 1891, 56 O. G., 1448.

ATTORNEY.

1. Applicant is bound by the action of his attorney.

Where applicant had requested her attorneys to take an appeal if they had any doubts as to the necessity, and they, believing that certain affidavits to be filed would result in the case being remanded to the Primary Examiner, but which the Office held not entitled to consideration, and the case became abandoned: *Held*, that by the rules of agency, applicant was bound by her attorney's omission to take an appeal, and her petition to revive was denied.

Binford, x. p., *Mitchell, Com.*, 17 Jan., 1891, C. D. Ms.

2. A petition to re-instate, under Section 4894 R. S., alleged that until quite recently applicant was not aware

of the law regarding abandonment by non-prosecution, and that applicant had been sick for about fourteen months and practically unable to do any work. *Held*, that while ignorance of the law was not sufficient to excuse the delay, the sickness might, if it stood alone, but petitioner had experienced attorneys to whom was intrusted the prosecution of his case; and as no reason appeared why they did not proceed to prosecute within the scope of their power, as they might have done at any time within two years, the unaccounted for inaction of the attorneys must be held to be the inaction of the applicant.

Tuoti, x. p., *Fisher, Act. Com.*, 27 Jan., 1891, C. D. Ms.

3. The rejection in the original application, having been deliberately acquiesced in by the attorneys, as indicated by the character of the correspondence that followed the numerous actions of the Office, and finally by the cancellation of the claim before patent was allowed, — the applicants would have been chargeable with knowledge of what their attorneys had done, even if it had not appeared affirmatively that they had such knowledge (Hatchman, x. p., 25 O. G., 979, — affirmed by the Supreme Court of the District of Columbia, 3 Mackey, 288; Anheim *v.* Finster, 32 O. G., 256; Dobson *v.* Lees, *Per Curiam*, 30 F. R., 625, — affirmed 137 U. S., 25, ❁; and Hoeveler & McTighe *v.* Verner *v.* Nicholson, 2 Gourick, 51).

Hoeveler & McTighe, x. p., *Mitchell, Com.*, 26 Mar., 1891, C. D. Ms.

4. Where neglect to take appeal at the proper time [proper stage of the original application] rested between applicant and his solicitor, and on the contrary, the rejected claim was cancelled, for the purpose of securing

issue of a patent, re-issue which revived and embodied this claim was pronounced void.

Anheim *v.* Finster, *Wheeler, J.*, 32 O. G., 256.

Of like purport, see (1) *et seq.*, DEDICATION; (5) ESTOPPEL; (10) PUBLIC RIGHTS AND OBLIGATIONS; (3), (4) RE-ISSUE; and (10) SCOPE OF PATENT.

5. Applicant's attorney may insert amended claims, in consonance with the specification, without having them verified by a special oath of applicant.

R'l'y Register M'f'g Co. *v.* N. Hudson R'l'y Co., *Nixon, J.*, 24 Feb., 1885, 32 O. G., 519.

6. Power of attorney, where recognized by assignee, does not cease with inventor's death.

Where the inventor, after assigning all his interest in the invention, died, and the Examiner refused admission of amendments presented by inventor's attorneys, on the ground that his death had revoked their power and held the application abandoned for want of proper prosecution: *Held*, that the Examiner's holdings would doubtless have been correct had there been no assignment of the invention (Eagle Co. *v.* West *et al.*, 18 Blatch., 218); but the inventor having parted with the entire interest, and it appearing that his attorneys were recognized by the assignees as their attorneys, it could not be held that the application had become abandoned, for it had been prosecuted by the only parties who had a right to prosecute it, although that fact did not appear of record until the filing of this petition. Furthermore, in the absence of any steps to the contrary by assignee of the entire interest, the attorneys appointed by the inventor are assumed to represent the interest, (Baker, x. p., 49 O. G., 1363).

Davis, x. p., *Fisher, Act. Com.*, 18 Feb., 1891, C. D. Ms.

Compare Stevens, x. p., (14) ASSIGNMENT; and De La Vergne *v.* Featherstone, (1) PATENT.

7. Revocation of Power.

The Patent Office has no means of enforcing the payment of fees due from applicants to their attorneys, or, indeed, of determining whether or not any fees are due; neither can it refuse to recognize the revocation of any power of attorney *which is not coupled with an interest.* If an attorney wishes to enforce his rights against a client, the courts are open to him.

In re, Osborne, *Fisher, Act. Com.*, 27 June, 1890, C. D. Ms.

Compare ATTORNEY'S LIEN.

ATTORNEY'S LIEN.

A lien on the inventor does not extend to an instrument which is the property of assignee.

Where it seemed that an assignment had been placed in the hands of the assignor's attorneys upon a special trust to file it in the Patent Office and to pay the fee, which had been advanced for that purpose: *Held*, that any lien which the attorneys might possess upon papers belonging to their client, the assignor, did not extend to the assignment, which belonged to the assignee, nor authorize the attorneys to refuse to discharge the special trust referred to, and that it was the duty of the attorneys, *both to the assignee and to the Office*, to forthwith cause the assignment to be presented for record.

In re, Petition of the Dayton Fire Extinguisher Co., *Mitchell, Com.*, 12 Mar., 1891, C. D. Ms.

BASIC IDEA OF A PATENTABLE INVENTION.

Where a man has suggested the basic idea of a patentable improvement, and has made it practicable to any degree, and has never abandoned it, he cannot be de-

prived of the benefit of the invention or of the title of inventor by any other person, although that other may carry out the idea more perfectly and to a greater degree of usefulness.

Riley *v.* Barnard, *Simonds, Com.*, 2 June, 1892, 59 O. G., 1919.

BURDEN OF PROOF.

1. Burden of proof rests on him who asserts an affirmative.

It is one of the primary rules of evidence that the burden of proof is on him who asserts an affirmative, and it makes no practical difference, in considering evidence such as just indicated, and so far as shifting the burden of proof is concerned, whether the various stages or all of them are established or not. Each party, by assuming to prove an affirmative and establish a yet earlier date, introduces an independent element into the case, and one for which he alone is responsible, and naturally takes upon himself the burden of *its* proof. The issue is reached, as it is in every case, when either party meets the other's allegations with a denial, and offers evidence to impeach or weaken the other's testimony. Issue is then joined upon the particular date that is denied; and this question is to be decided, like any other question of fact, by a preponderance of evidence.

Clark *v.* Broad, *Frothingham, Act. Com.*, 18 Nov., 1891, 57 O. G., 1426.

Compare Wilson *v.* Haines, (117) INTERFERENCE.

2. Burden of proof is on applicant who contests a patent.

The burden of proof is heavily on an applicant striving to overthrow a patent. This burden is only shifted when the applicant has overcome the *prima facie* case arising from the previous grant of a patent by proof beyond a

reasonable doubt. It is not enough for the applicant to charge fraud,—which is never presumed, but must always be strictly proved,—and then to demand that he be relieved from the burden of proof which the law has imposed upon him. Such a course will not shift the burden of proof.

Hansen *v.* Davis, *Mitchell, Com.*, 4 Ap., 1891, 55 O. G., 998.
Of like purport, see (118) *et seq.*, INTERFERENCE.

3. Burden on the Junior Applicant.

A formal abandonment of the earlier application in favor of a second application by the same applicant which covers substantially the same subject-matter, does not shift the burden of proof from a rival application filed subsequently to such earlier but prior to said second application.

Parmley *v.* Hockhausen, *Frothingham, Act. Com.*, 20 Oct., 1891, C. D. Ms.

Compare (5) and (6) INTERFERENCE.

4. Where, in an interference case, the contention of the junior party was that he was the originator of the improvement in controversy, and communicated the invention to the senior party prior to the senior party's application for patent, and it appearing that there was a difference of five months between the filing dates of the respective applications, and that the senior party had constructed a machine in accordance with the idea involved in the invention, while the junior party had never done so: *Held*, that these facts raised a strong presumption in favor of the prior applicant, and that the burden was fairly and strongly upon the junior party to show the origination and disclosure which he claimed.

Decision of the Examiners-in-Chief reversed, and priority awarded to Ohl.

Zerbe *v.* Ohl, *Simonds, Com.*, 21 Mar., 1892, 58 O. G., 1839.

5. Burden of invalidation rests on defendant.

Where the defendant seeks to overthrow or weaken complainant's patent by setting up anticipations whose existence and use are proven by oral testimony only, the courts not only impose the burden of proving such devices upon the defendant, but they demand proof that shall be clear, satisfactory, and beyond a reasonable doubt, and subject such evidence to the closest scrutiny.

The Washburn & Moen M'f'g Co. *et al. v.* The Beat Em All Barbed Wire Co. *et al.*, U. S. S. C. By *Brown, J.*, 29 Feb., 1892, 58 O. G., 1555, ✿.

6. Burden, — on Complainant to prove Infringement.

In combinations the doctrine of equivalents is construed most strongly against him who alleges infringement; and each party is held to his own element or device, or to a positive and exact equivalent which performs the same functions in the same manner, the burden being upon the complainant to show this.

Jones Co. *v.* Munger Co., U. S. C. of Appeals (5th Dist.) By *Locke, J.*, Nov., 1891, 58 O. G., 274, ✿.

NOTE. — For like reasons, the burden rests on a defendant who alleges lack of novelty in complainant's device (Warwick M'f'g Co. *v.* City of Buffalo, (9) INFRINGEMENT).

CAVEAT.

1. A caveat entitles the filer to notice of any application for substantially the same invention filed within one year thereafter.

Any citizen of the United States (or any applicant for citizenship who has been a resident for the space of one year next preceding) who desires time to test or mature an invention may file a description thereof in the confidential archives of the Patent Office (paying the pre-

scribed fee, $10), and will thereby be entitled to notification of any application, entered during the ensuing year, for a patent for substantially the same invention.

R. S., 4902.

For caveat privileges to foreign inventors, see (7) *infra*.

2. Caveator entitled to Immediate Notification.

On receipt by the Office of an application for patent within a year after filing of a caveat by another inventor for the same subject-matter, the notice which the statute provides shall be sent to the caveator must be sent *at once*, and not, as heretofore, be delayed until the invention shall have been favorably passed upon and the application found to be ready for allowance.

Ward, x. p., *Hall, Com.*, 6 Mar., 1889, 46 O. G., 1513.

3. The caveat does not confer any application rights.

The statute authorizing the filing of a caveat does not confer upon the caveator any right as an inventor, nor save him from the effect of negligence, nor give him any advantage over another inventor who has independently conceived the same invention and prosecuted his application with diligence. The statute simply provides, *as a matter of grace*, that the caveator shall be notified of any application which comes into the Office within a year, covering the subject-matter of his caveat. The filing of a caveat does not give the caveator the standing of an applicant with respect to what is called "constructive reduction to practice."

Elges *v.* Miller, *Hall, Com.*, 7 Mar., 1889, 46 O. G., 1514.

4. Lapse of Caveat Right.

Application for patent, as sole inventor, was filed by one of the parties who had previously lodged a caveat,

as joint inventors of the same device. The usual notice had been served on them to complete their application, as joint inventors, within three months. This they did not do; but, on the contrary, filed a formal abandonment of their interest in the caveat, and a request that the present application be proceeded with. The Examiner's requirement of evidence that applicant was the sole inventor is improper. The claims of the caveators, although one of them was the present applicant, ceased by non-filing of an application within the time required by law.

Drury, x. p., *Frothingham*, *Act. Com.*, 28 Mar., 1891, 56 O. G., 1447.

5. Copy of Caveat Refused.

Upon a petition for the file-wrapper and contents of a certain caveat, to be used as evidence in a case pending in a circuit court of the United States: *Held*, that the practice of the office was to refuse copies of caveats without the caveator's consent, and that the petition must be denied.

Spear, x. p., *Fisher*, *Act. Com.*, 28 Nov., 1890, C. D. Ms.

NOTE. — In support of the above ruling the Assistant Commissioner cited decisions of Commissioner Hall in Hopkins & Robinson M'f'g Co., x. p., C. D. 35, Ms., 250; and Harding, x. p., C. D. 37, Ms., 248; also Sec. 4902 R. S., and Rules 15 and 197 founded thereon, an interpretation of Rule 15 by the Secretary of the Interior, and a special order of Commissioner Duell, to the same purport.

6. Inspection and Copies Refused.

Upon a petition on behalf of defendants in a suit on a patent to inspect and have copies of a caveat filed by a person other than the petitioners: *Held*, denying the petition, that, while Section 4902 R. S. provides for the

filing of caveats, and limits their operative term to one year, it by no means says that the condition of secrecy shall terminate at the end of such year; and the uniform practice of the Office is to refuse inspection of a caveat filed by another person upon such a showing.

Pollok *et al.*, x. p., *Simonds*, *Com.*, 4 May, 1892, 59 O. G., 939.

7. Caveat Rights under International Convention.

The treaty entered into under the International Convention is a reciprocal one. Each of the high contracting parties covenants to grant, in future, to the subjects and citizens of the other parties certain special rights, in consideration of the granting of like special rights to *its* subjects and citizens. It is a contract operative in the future infra-territorially. It is, therefore, not self-executing; but to render it effective requires legislation for the modification of existing laws.

Opinion by Attorney-General Miller, 5 Ap., 1889.

CERTIFIED COPY.

1. A certified copy of an abandoned or of a rejected application is obtainable when required for evidence.

Whenever a reasonable suggestion of its necessity for the purposes of evidence is made by the person requesting it, the Commissioner cannot lawfully refuse to furnish a certified copy of an abandoned or a rejected application. The right to be furnished such a copy is given to the public by statute, and refusal thereof entitles the applicant to the Writ of Mandamus against the Commissioner, to compel a compliance with such request.

An attorney at law who has requested such a copy on behalf of his client and been refused, has such an

interest in the subject-matter as entitles him to commence proceedings in his own name as the relator for such writ.

The United States *v.* The Commissioner of Patents, — Supr. C. D. Columbia: *The Chief Justice and Associate Justices Cox and Merrick*, 12 Nov., 1888, 43 O. G., 1263.

2. Inspection by another party of abandoned cases in the U. S. Patent Office is not permissible; but a request for certified copies of one or more abandoned applications, accompanied by a reasonable suggestion of their necessity for the purposes of evidence, will be granted, under authority of Rule 179.

Fowler, x. p., *Mitchell, Com.*, 14 Oct., 1889, 49 O. G., 562.

Compare ABANDONED APPLICATIONS.

THE CLAIM.

1. Every United States patent is required to contain a clear, concise, and particular statement of the part, improvement, or combination which the inventor claims as his invention.

Sec. 4888 R. S.

2. Claims granted should be commensurate with the invention.

Pacholder, x. p., *Mitchell, Com.*, 26 Ap., 1889, 51 O. G., 295.

3. In a patent containing more than one claim, each claim must be distinct from every other in its subject-matter.

Every claim in an application in order to be valid must, in one sense, cover an independent invention, yet all the claims must pertain to one common device or subject of invention.

Franklin, x. p., *Leggett, Com.*, 24 July, 1873, 4 O. G., 105.

Of same tenor see Holt, x. p., (4) *infra.*

4. Each claim must define a complete and operative combination in direction of the invention.

Holt, x. p., *Dyrenforth, Act. Com.*, 26 Ap., 1884, 29 O. G., 171.
Compare Franklin, x. p., (3) *supra.*

5. Office of the Claim.

It is not sufficient that the claims contain words of reference to the specification where the invention is described ; for, under the statute, it is *the office* of the claim to set forth, specifically and definitely, the actual invention covered by the patent.

Dunning, x. p., *Butterworth, Com.*, 12 Mar., 1884, 26 O. G., 1207.

For decisions of like general tenor to the above, compare Holmes, x. p., (56), Rice, x. p., (57), and Supreme Court decision in White *v.* Dunbar, ❁ (65), *infra.*

For qualifying conditions, see Houchens, x. p., (6), and Laskey, x. p., (66) *infra.*

6. The special function of claims is to " point out " in the preceding description " the part or combination " for which a patent is sought. No comprehensive rule can be laid down determining how much of a description is permissible in the claims. It may be fairly said that each application is, to a large extent, a law unto itself in that regard. Requirement, however, of such description in the claim as to practically do away with the necesssity of looking to the specification for the major portion of the descriptive language applicable to it, has no warrant whatever in the statute.

Houchens *et al.*, *Mitchell, Com.*, 30 Sept., 1889, C. D. Ms.
Of like tenor, see Laskey, x. p., (66) *infra.*

7. The claim is the measure of the patentee's right to relief from infringement; and while the specification

may be referred to to limit the claim, it can never be made available to expand it.

McClain *v.* Ortmayer, U. S. S. C. By *Brown, J.*, 2 Nov., 1891, 35 L. ed., 800, ❁.

8. The practice of appropriating literally the claim of a later inventor, which is drawn with reference to the employment of terms found in the preceding specification, and then applying the claim so appropriated to a specification of an older date which does not contain words and expressions suitable to lead up to the language of the appropriated claim,—condemned. Patent Office officials should be upon their guard against amendments made late in the history of proceedings in an application, which are apparently inspired by the purpose of dominating inventions subsequently made by other inventors, and which are not embraced within the scope of the specification as originally filed (R'y Co. *v.* Sayles, 97 U. S., 556, ❁; Con. Elec. Lt. Co. *v.* McKeesport Lt. Co., 40 F. R., 21).

Rogers *v.* Wissinger, *Mitchell, Com.*, 7 Mar., 1891, 56 O. G., 804.

9. Every element of the claimed combination should be positively given,—Rule 37.

Every instrumentality or substance intended to be an element or ingredient of a claim must be positively brought in *as such*, and not merely inferentially included or only alluded to in naming some other part.

Holt, x. p., *Dyrenforth, Act. Com.*, 26 Ap., 1884, 29 O. G., 171.

For case illustrating a relaxation of the above general rule, see Crane, x. p., (10) *infra.*

10. Where the Examiner objected to the claims as indefinite, and required that the parts should be brought

in as "positive elements," the requirement was overruled, on the ground that it was clear that the several necessary elements of the alleged combination — whether positively included therein or only incidentally mentioned in connection therewith — were embraced in and formed necessary limiting features of the claim.

Crane, x. p., *Frothingham, Act. Com.*, 18 Nov., 1891, C. D. Ms.

NOTE. — The allowed claim, above referred to, — see patent No. 468, 791, to Thomas Crane, issued 16 Feb., 1892, — is given below. The Examiner wanted "the pivoted braces C, C'," and "the central bar I" brought in as "positive elements" of the combination.

CLAIM 1. In combination with the pivoted legs B and B', secured to the table-top by means of the pivoted braces C and C', one or more notched rods, E, secured to the legs on one side of the table with their free ends passing through the central bar I, and the locking device with the cord 1, all arranged to operate substantially as described.

For the general rule, see Holt, x. p., (9) *supra*.

11. Primary Invention, — Phraseology.

It is held that in a case of primary invention the description of the general nature of the invention which applicant gives near the beginning of the specification, taken with the words "substantially as described" or equivalent phrases, used in every one of the claims, makes the claims sufficiently specific.

Dalton, x. p., *Simonds, Com.*, 18 Feb., 1892, C. D. Ms.

For like permitted exceptions in patents for primary inventions, see (38) *et seq.*, *infra*.

12. The claim must be to the specific device, — not to functions or results.

No one can tell with any certainty what invention is actually covered by a claim which is functional in form

until it has received a judicial interpretation. It may be so absolutely functional, and therefore incapable of construction, as to be void, and the courts would so adjudge it. Hence the Office, in insisting on certainty and definiteness in claims, acts not only in protection of the public, but as a friend and adviser of the applicant.

Barrett, x. p., *Hall, Com.*, 24 Sep., 1888, C. D. 142.

Compare Ives, x. p., (29); and Lull *v.* Clark, (20″) *infra.*

13. A claim is not necessarily rendered functional by words and phrases ascribing functions to enumerated elements.

Houchens *et al.*, *Mitchell, Com.*, 30 Sep., 1889, C. D. Ms.

14. Specification [in a claim] of functions frequently promotes definiteness, by furnishing a law for determining what elements would be the equivalents in the combination of enumerated elements; but when a claim is so drawn as to ignore construction, and to thus cover any and every device which will accomplish the same result, the charge that the claim is functional is properly brought against it, inasmuch as it does not point out "the part, improvement, or combination" sought to be patented.

Raymond, x. p., *Mitchell, Com.*, 29 Oct., 1889, C. D. 41, Ms., 212.

15. An objection that the claims were functional overruled; for, while it is true that certain clauses in the claims set forth the functions entering into the combination, yet the recitals of function tended rather to define the statement of the claim than to render it indefinite, by furnishing a guide as to whether or not a substituted element would constitute an equivalent in the patented combination (Raymond, x. p., C. D. 41, Ms., 212).

Thompson & Thompson, x. p., *Frothingham, Act. Com.*, 25 Jan., 1892, C. D. Ms.

16. Whether or not the objection that a claim is functional is appealable to the Examiners-in-Chief depends largely upon the form which the objection takes. If it be an objection upon the ground that the thing covered by the claim is merely the function of the mechanism employed, the action involves "the merits," and is therefore appealable to the Examiners-in-Chief.

Lockwood, x. p., *Fisher, Act. Com.*, 19 June, 1890, C. D. Ms.

17. Phraseology.

Examiners should avoid, as far as possible, interference with an applicant's choice of words, or the form in which they are presented. The policy of the Office is rather to permit the greatest latitude of expression consistent with the subject-matter of invention; that the claim is not formulated in certain set expressions which may have had judicial sanction or have been usual in Office practice is quite immaterial. These have their advantages and serve as a general guide; but they are not in any sense exclusive, and should not be permitted to hamper an applicant in the free exercise of his judgment, so long, of course, as the claim is clear and explicit, and to means or instrumentalities, and not to mere abstractions, functions, or results.

Designolle, x. p., *Doolittle, Act. Co.n.*, 10 Nov., 1877, C. D. 10.
Compare Noyes, x. p., (9) SPECIFICATION.

18. Restatement sometimes Permissible.

It is admissible, under proper restrictions, for parties to put their claims in different forms, to prevent misconstructions of them by the public and by the courts.

Perry & Lay, x. p., *Foote, Com.*, 7 Sep., 1869, C. D. 3.

19. The first, second, and third claims having been rejected by the Examiner, because "for one and the same

thing," the objection was overruled for the reasons laid down by Commissioner Foote in Perry & Lay, x. p. (1869, C. D. 3).

Hahn, x. p., *Spear, Act. Com.*, 3 Sep., 1875, C. D. 107.

For general rule disapproving of two or more claims to the same subject-matter, see Johnson, x. p., (1) REDUNDANCY. See also Langlois, x. p., (12), Gabouri, x. p., (13), and Feister, x. p., (14), EXAMINATION.

20. Where the corresponding elements in two claims in the same application were a "shuttle" and a "reciprocating shuttle": *Held*, that the question whether or not the claims were different in legal effect was subject to a doubt which should be resolved in favor of the applicant.

Pearson, x. p., *Frothingham, Act. Com.*, 2 Ap., 1892, C. D. Ms.

20′. Different Expressions of the same Combination in five different Claims Sustained.

While the five claims in suit are all to the same devices arranged in a single combination, being only different expressions of that combination, and it may be that there is no essential difference between them, the court does not deem it necessary to consider how far they may be distinguished from each other, but holds them all valid.

The Watch Co. *v.* Robbins & Avery, U. S. C. C. Ap. (7 Cir.) Harlan, Woods & Jenkins, JJ. By *Woods, J.*, 1 Oct., 1892, 61 O. G. 721, ✱.

20″. A claim to "the so forming [substantially as described] of a self-locking shutter-hinge in two pieces, as that" certain results may follow, *held* to be a claim to mechanism; the particular mechanism covered being

determined by the description in the specification and the statement of results in the claim.

Lull *v.* Clark *et al.*, U. S. C. C. N. D. N. Y., *Blatchford, J.*, 8 Aug., 1882, 22 O. G. 1535.

Compare, of like tenor, (38) *et seq.*, *infra.*

NOTE. — (i) The claim above referred to was as follows:

The so forming of a self-locking shutter-hinge cast in two pieces that the blind or shutter hung thereon may swing open or shut in a horizontal plane and lock when open to its limit, and so that also, when locked open, the strain shall be taken off from the spindle and thrown on to the cam-arms, and thus effectually relieve the spindle from the weight or strain of the shutter, substantially as described.

NOTE (ii). — That the Office is not justified in passing faultily worded claims, because the courts aim to so construe them as to save the patent, see (29) *et seq.*, *infra.*

21. Customary Adjuncts not necessarily Enumerated.

It is the province of claims to relegate to the specification the enumeration of such details of construction as shall be found, upon examination, to be immaterial to the true scope of the actual invention. The object of enumerating these parts [in the body of the specification] is to enable persons skilled in the art to practise the invention in the form set out in the patent, but not to so limit the claim of the inventor as to make it the easy prey of the infringer.

Laskey, x. p., *Mitchell, Com.*, 6 July, 1889, 48 O. G., 539.

22. It is generally the case in machine patents that certain things not in the claims must be assumed as co-operating with those that are expressly mentioned; the correct rule, as regards combinations, would seem to be that the parts must necessarily be specified only up to that point beyond which the presence of the parts not

named will be presumed, as a matter of course, by reason of the known state of the art or from the very necessities of the case; for example, in claiming improvements in the cutting-apparatus of a harvester, it certainly cannot be necessary, in order to a valid claim, that the main frame, the axle, and the supporting-wheel or wheels should all be named with it, although, alone and disconnected from these other parts, the cutting-apparatus would be inoperative.

Wilder, x. p., *Duncan, Act. Com.*, 23 May, 1871, C. D. 125.

23. It was unnecessary to specify this connecting mechanism in the claim, since, from the very nature of the case, *some* mechanism capable of performing that function must be assumed, while the particular character of it would be immaterial. Applying that rule to the present case, it will be found that the function of the springs and knife is independent of the particular character of the mechanism by which the potato is driven through the springs and upon the knife (Wilder, x. p., 1871, C. D. 125).

Kent, x. p., *Duncan, Act. Com.*, 1871, C. D. 301.

24. The statute and the decisions of the courts require that an applicant shall fully and clearly describe his invention, and that he shall distinctly claim *the part or improvement made by him;* but when he has done this, the Office can require nothing more in that regard from him.

Skinner *et al.*, x. p., *Marble, Com.*, 1881, C. D. 12.

25. The law requires the applicant to "particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery." He is not obliged, in his claim, to specify

elements in a combination not invented or discovered by him, either generally or specifically. It is sufficient, as to those elements, to refer to his specification where they are described and their relation to the elements claimed pointed out.

Ib.

26. Such general terms as "means," "mechanism," and the like, may properly be employed (Holt, x. p., 1884, C. D. 43) to refer to mere adjunctive devices which connect or give co-operation to the various elements or features of the invention, but which are, in themselves, no actual or controlling part of it. It is because *any* means or mechanism may be used to carry out such adjunctive functions and need not be defined, that those terms can be thus employed.

Paige, x. p., *Hall, Com.*, 6 Aug., 1887, C. D. 71.
Compare Anderson, x. p., (11) EXAMINATION.

27. Patent No. 336,042, for an automatic weighing-machine, claims: —

A weighing-machine having an aperture for receiving a coin, a weighted lever, a dial and index-hand and intermediate mechanism connected with the same, and whereby the coin, when deposited in the receiver, shall operate the lever and cause the hand to indicate the weight of the person or body to be weighed.

Held, that the patent is for the machine as a whole having those parts with such other known parts necessary to constitute such a machine, and that, as such other necessary parts are described or referred to in the specification, the claim must be read with reference to them, and therefore covers an operative machine.

American Automaton Weighing-Machine Co. *v.* Blanvelt, *Wheeler, J.*, 29 Ap., 1892, 59 O. G. 2071.

NOTE. — The above claim will be recognized as referring to the machine popularly known by its printed direction: "DROP A NICKLE IN THE SLOT."

28. A non-essential step in a process may be omitted from the claim.

Where the specification closed the description of the process for treating certain moulds with the words "and then coated with a thin layer of varnish," but the applicant omitted from his claims this last step in the process, and the Examiner declined to act upon "the merits," on the ground that, in consequence of said omission, the claims did not come within the scope of the specification: *Held*, — as contended by applicant, — that inasmuch as the original statement of invention made no mention of the employment of varnish, as a final step in the process, and inasmuch as the claims, as originally filed, were not so limited, applicant was entitled to have that step treated as a non-essential one in the invention.

Koller, x. p., *Mitchell, Com.*, 7 Nov., 1889, C. D. Ms.

Of like tenor are decisions in Richardson, x. p., 1875, C. D. 54; McMurray, x. p., 1875, C. D. 134; and Barnes *v.* Snedeker, 1880, C. D. 95.

29. Claims ambiguous in phraseology, or which relate (or may be so read as to relate) to performances or functions, to abstract principles, or to results (not to specified instrumentalities), are inadmissible and ought not to be granted, notwithstanding courts — after the patent has been once granted, and notably where the invention has created a new field of industry — customarily endeavor to save the patent by construing such functionally phrased claims to mean the instrumentalities by which the functions in question are performed.

But if claims functional in form have been upheld in the courts as claims to the *devices* which perform the

functions claimed, such action of tribunals has been solely to save patents from the evils incident to official negligence, and not in justification of such improper grants.

It is the duty of the Office to obviate, as far as possible, the necessity for judicial correction of its errors, and to refuse claims of purely functional form, and even those which are *susceptible* of a functional interpretation.

The rule and reasoning in Arkell's case (1871, C. D. 263) were held applicable to the case of Luther C. Ives, and Examiner's action was affirmed.

Ives, x. p., *Paine, Com.*, 4 Dec., 1878, C. D. 134.

NOTE. — It has been repeatedly held that although the result or the function itself cannot be claimed, it may — and in not a few cases *should* — be *stated* in the claim, as that quality or characteristic which distinguishes the device from every other of the same class. For examples of such rulings, see Houchens (13), Raymond (14), Thompson (15) *supra;* and Hahn (35), Keith (36), Morley *v.* Lancaster (39), Worstwick *v.* Buffalo (40, ✱), Smith & Egge *v.* Bridgeport (41), LeRoy *v.* Tatham (47, ✱), and Corning *v.* Burden (48), *infra;* also Lockwood, (1) FUNCTION. "The patentee may not claim functions, but he may claim *means definable by functions*," Blanchard *v.* Sprague, (43) *infra.*

30. The claims refused, — because *susceptible* of a functional interpretation, — were as follows: —

1. The combination with a measure, of a registering device so arranged that the passage of the striker over the measure will operate the register, substantially as described.

31. The claims having been so amended — *see italics* — as to be incapable of a functional reading were passed to issue (see pat. 211,740; 15 O. G. 108.)

1. The combination with the *portable or hand* grain-measure A, of the alarm-mechanism *which is adapted thereto, and a tappet which is operatively connected with said registering device and arranged substantially as shown and described*, so that, in passing over the measure, the striker will operate said device, by contact with the tappet, as specified.

2. The combination with a measure, of an alarm-mechanism so arranged that the passage of the striker over the measure will operate the alarm, substantially as specified.

3. The combination with a measure and registering device, of a tappet-wheel E, so constructed and arranged that the passage of the striker over the measure will turn said tappet-wheel, substantially as and for the purpose set forth.

Ives, x. p., *Paine*, *Com.*, 4 Dec., 1878, C. D. 134.

2. The combination with the *portable or hand* grain-measure A, of the alarm-mechanism *which is attached thereto, and a tappet which* is operatively connected *with said mechanism, and arranged substantially as shown and described*, so that, in passing over the measure, the striker will operate said mechanism by contact with the tappet as specified.

3. The combination with the tappet-wheel E, of *the pins* F, *lever* H, *spring* T *hammer* J, *and bell* K, substantially as described.

NOTE. — In the refused claims, the qualifying phrases — *e. g.*, "substantially as described" — *may* be so read as to refer to the actions; in the allowed claims these phrases have explicit reference to the *instrumentalities*.

Of the same tenor are the following: —

32. It is clear, from numerous decisions of the courts and the Patent Office, that what is known as a functional claim is one that has for its object an act or a result merely, and not the means by which the act is performed or that result attained. The faultiness of such claim consists in its not being for a substantive thing, but for its mode of use or the result which it accomplishes. The language of such claim is usually in the participial form, as "producing," "operating," "determining," "so combining," "so constructing," etc.

Applicant claimed: —

Producing in cutting-presses a successive change in the point of contact of the cutting-block with the cutting-die.

This claim is for a result or for an act, and is bad. It is in the precise form condemned in Sickles *v.* Falls Co. (2 Fisher, 202), and Sangster *v.* Miller (2 Fisher, 563). The whole genus of claims for "so constructing," "so combining," "producing," "determining," and so on *ad infinitum* through the entire range of present participles, are of the same character and obnoxious to the same objection. Some of them have been saved in the courts, "*as by fire*," by the construction given to the words "substantially as described" and the like, but *not one of them should have been granted by the Office.* A patent is for the means of producing a result, not for the result as produced.

Simonds, x. p., *Fisher, Com.*, 14 Mar., 1870, C. D. 23.

33. It is certainly the duty of the Commissioner of Patents to see to it that, so far as this result is possible of achievement, none but unambiguous claims are sent forth from the Patent Office. It is not sufficient that the claim be such as by a bare possibility may be saved through a liberal construction by the courts (Simonds, x. p., *Fisher, Com.*, 1870, C. D. 23). *The ideal claim is one which admits of but a single interpretation, and that of the most literal character.*

Continental Windmill Co., x. p., *Duncan, Act. Com.*, 27 July, 1870, C. D. 74.

NOTE. — From decisions hereinafter quoted (*e. g.* (38) *et seq. infra*), it would appear that in the exceptionally rare cases of inventions which inaugurate a new art or open an entirely new field of industry, a much broader form of claim is permissible.

34. In the matter of application by Calista E. Cox, for re-issue, the Commissioner said: —

That such a claim has been sustained in the United States Courts does not remove the one presented for

Office action from the operation of the law which requires that "every such case shall be subject to revision and restriction in the same manner as original applications are."

A participial claim to "*arranging*" devices, instead of to the devices themselves, having been granted under a former more lax practice, should, even although in the mean time it has been sustained by the courts, be made to conform to the present practice, in revising the application for re-issue.

Cox, x. p., *Thacher, Act. Com.*, 10 Jan., 1873, C. D. 4.

35. On the interlocutory appeal of Ignatius Hahn from the Principal Examiner in the matter of an application for patent for an Hydraulic Universal Machine for Shearing, the Commissioner said: —

It is clear, from numerous decisions of the courts and the Office, that what is known as a functional claim is one that has for its subject the performance of *an act merely*, and not the means by which the act is executed. The faultiness of such a claim consists in its not being for a *substantive thing*, but for the result which that thing accomplishes. Its language is usually in the participial form, as "producing," "operating," "determining," "so containing," "so constructing," etc. (Simonds, C. D. 1870, 23; Cox, 3 O. G. 2). An example is also given in the case Sickles *v.* Falls Co. (2 Fisher, 202). There the claim of the patentee was as follows: "'Imparting' a co-existing movement to two reciprocating catch-pieces in the operation of trip valves." On this the Court said: "The claim in terms is for an effect or function, and therefore not patentable." On the contrary, in Renwick *v.* Pond (3 Fisher, 579), the Court held that "claiming the arrangement of a combination when the arrangement is such as to produce a given mechanical result of the combination, is not a claim to a function. The result is

not claimed irrespective of the means of producing it. The means alone is claimed, and claimed only when specially arranged to produce a given result. This is very far from claiming a function."

Guided by these definitions, I am unable to see that the claims of the present applicant are for functions. Take, for instance, the second claim, which perhaps covers broader ground than any of the others.

2. "The combination of two carriers, each capable of revolution around a central axis, and both capable of lateral movement in the main frame, substantially as and for the purpose specified."

Clearly here the subject of the claim is a combination of the elements "two carriers," and the balance of the claim is simply descriptive of the situation of the carriers and of the mechanical result to be produced when so situated. The claim is not for *revolving* two carriers around a central axis, etc. That would be for the result; and if such a claim should be sustained by the courts, as has sometimes been the case, it would be construed as covering the *means* by which said result was produced; the means having been described in the specification, and referred to in the claims by the phrase "substantially as specified."

Hahn, x. p., *Spear*, *Act. Com.*, 3 Sep., 1875, C. D. 107.

36. Of like tenor was the ruling in the case of Keith, x. p. The Examiner had improperly rejected as functional the following claims: —

4. The reciprocating *punch or bending-fork* operating to sever the wire in its descent upon the former-bed, to bend the wire into a staple over a suitable mandrel or brake, and to carry the staple so formed forward into position to be driven, etc.

5. Said bending-fork constructed with a cutting edge and with internal longitudinal grooves, whereby a staple blank is

severed, bent around a suitable mandrel, and held and guided for driving, etc.

The claims were pronounced to be in proper form, and an examination was ordered on merits.

Keith, x. p., *Doolittle, Act. Com.*, 5 Ap., 1876, C. D. 93.

37. It does not follow that because a bad patent has been granted to the patentee, one equally so should be granted to the applicant.

Blackman *v.* Murray, *Doolittle, Act. Com.*, 25 Oct., 1877, C. D. 8.

38. The invention being of *basic or fundamental rank* so as to have created a new art or to have opened up a new field of industry of which a workable embodiment was intelligibly described in the patent, and the language of the claim being such as to make it *possible* for a court to construe it to be to means or instrumentalities or to means definable by functions; the claim will be sustained, and will be interpreted so broadly as to control all substantial equivalents of later date, even although improvements on the original embodiment.

A *foundation* patent is infringed by a machine in which each of the mechanisms performs the same function as the corresponding mechanism in the patented machine in substantially the same way and with substantially the same result, even though the machine of the later inventor may contain differences in form and structure tending to simplicity and perhaps improvement.

Nat. Type Co. *et al. v.* N. Y. Type Co. *et al.*, *Lacombe, J.*, 11 Mar., 1891, 56 O. G. 661.

39. When an invention is one of a primary character, and the mechanical functions performed by the machine are, as a whole, entirely new, all subsequent machines

which employ substantially the same means to accomplish the same results are infringements, although the subsequent machine may contain improvements in the separate mechanisms which go to make up the machine.

Morley, having been the first person who succeeded in producing an automatic machine for sewing buttons of the kind in question on fabrics, is entitled to a liberal construction of the claims of his first patent.

Claims 1 and 8, below given, fairly represent the four claims (1, 2, 8, and 13) pronounced *valid* and declared to be infringed :—

1. The combination in a machine for sewing shank buttons on fabrics, of button-feeding mechanism, appliances for passing the thread through the eye of the buttons and locking the loop to the fabric, and feeding mechanism substantially as described.

8. The combination, in a machine for sewing buttons to fabrics of button-feeding and sewing appliances substantially as set forth, feeding appliances, and operating mechanism, whereby the feeding devices are moved alternately different distances so as to alternate short-button stitches with long stitches between the buttons, as specified.

Morley Mach. Co. *v.* Lancaster, U. S. S. C. By *Blatchford, J.*, 4 Feb., 1889, 129 U. S. 263, ✿.

40. A like construction was given to the claims (to means definable by functions) of Edward O. Sullivan, for the invention of a harness and mode of suspending the same, which *for the first time enables the horses to remain unharnessed until the instant of alarm and yet be so quickly attached to the fire-engine as to cause no delay in getting the engine started and to the fire.*

It would seem that the fundamental and important character of the invention alone saved it from invalidation as for an abstraction. The claim was as follows :—

The combination with a harness for a fire-engine or like apparatus, of a device for suspending said harness above the

place occupied by the horse when attached to the apparatus, substantially as and for the purpose set forth.

The Court said: It is not an abstraction that Sullivan seeks to secure, but the apparatus with which the idea is carried out. With the claim thus construed and *in view of the state of the art*, very little need be said upon the question of infringement. DECREE FOR AN INJUNCTION AND AN ACCOUNT WITH COSTS.

Worstwick M'f'g Co. *et al. v.* City of Buffalo *et al.*, *Coxe, J.*, 8 May, 1884, 27 O. G. 1239.

41. In the case of the *Pioneer Invention* of Frederick Egge, of "an apparatus for the manufacture of sheet-metal chains," complainant's first three claims (although quasi-functional in form) were sustained and given the broadest possible interpretation. Claims 2 and 3, adjudged to have been infringed, were as follows:—

2. As an improvement in the art of manufacturing chain from sheet-metal by machinery, the hereinbefore described *method of automatically adjusting* a flat link in a previously bent link preparatory to bending, which consists in *feeding forward* the flat link *endwise*, *threading* it through the eyes of the bent link intersecting its line of travel at right angles and *turning it* as it is fed along after its forward widened end has passed through said eyes; substantially as set forth.

3. As an improvement in the art of manufacturing chain from sheet-metal by machinery, the hereinbefore described *method* of *connecting* and *uniting* the links, which consists in *feeding forward* the flat and partially shaped links *flatwise* or with their broad surfaces horizontal in a path intersected at right angles by that traversed by the previously connected links, *threading* the flat links successively through the eyes of the previously bent and united links, the broad surfaces of which are vertical and at right angles to the sides of the flat links; *giving a partial turn* to the flat links, and then bending them at their middles to respectively unite with the previously bent and united link; substantially as set forth.

The Court said: *In view of the primary character of the machine as a whole*, the construction which was adopted in Morley Mach. Co. *v.* Lancaster (12 U. S., 263) is the proper one for these claims. This construction excludes the idea that the claims are for a result, or for a process, or for a method of accomplishing a result irrespective of the machinery by which the work is accomplished. They are for sets of mechanisms, and are infringed by another machine in which the same sets of mechanisms are combined, provided each mechanism, individually considered, is a proper equivalent for the corresponding mechanism in the Egge patent. *But inasmuch as Egge was the first person who produced an automatic machine for the entire manufacture of sheet-metal chain, he is entitled to a liberal construction of those claims which are not restricted to described details.*

Smith & Egge M'f'g Co. *v.* Bridgeport Chain Co., *Shipman, J.*, 25 May, 1891, 56 O. G.. 1149. See, to same purport, Le Roy *et al. v.* Tatham *et al.* By *M'Lean, J.*, Dec., 1852, 14 Howard, 156, ❋; Corning *v.* Burden. By *Grier, J.*, Dec., 1853, 15 Howard, 252, ❋.

42. The inventor having made a valuable and original invention, the one remaining thing needful is that he shall place on record such a description of it as to put the world in complete possession of it for all future time.

The instances given, and many others that might be cited, show that tribunals customarily sustain a patent for an important contribution to industrial art (even although improperly summed up) where the inventor's explanation of the invention has been sufficient to enable others to practise it by the exercise of ordinary skill and judgment, but that the lack of such an explanation has invariably been adjudged fatal to the patent. For example, compare the action of Kane, J., in Detwold *v.* Reeves, and that of Story, J., in Blanchard *v.* Sprague.

The suit of one Detwold (patentee under an assignment from the inventor, Faber Du Faur) for an injunction against the use by Reeves *et al.* of the invention described and claimed in reissued patent 23 Jan., 1845, for "a new mode of collecting, conducting, and using waste gases of a blast-furnace," was dismissed, notwithstanding the Court inclined to the belief that the invention was of great value, because the specification contained no description of a new and useful invention in such full and intelligible terms as to enable others skilled in the art to practise it.

Du Faur's claim was as follows: —

> A new method of economizing fuel, by using the waste combustible gases of the upper portion of the blast-furnace by drawing them off below the upper level of the charge and conducting them through convenient passages to other fireplaces or structures, there to be burned as fuel.

The Court said: The interests involved in the controversy are very great, and may be seriously affected by the action of the Court on the present motion. It has been contended, with great apparent force, that Mr. Faber Du Faur was really the discoverer of the true theory of the blast-furnace, so as to determine from it the point at which the carbonic oxide, having performed its chemical functions, might be withdrawn without sensible injury.

The Court, after expressing its belief that *the specification contained no intelligible and explicit information of the precise location, for any given furnaces, of the point in question, intimated that if the patentee had done this,* no one can doubt that he would have conferred a signal benefit upon the arts of the world; and if, besides this, he had described some form of structure, some material arrangement by which his discovery might be applied to use, I would be most reluctant to say that

his patent should be limited to the mere mechanical illustration, and would not cover effectually the whole ground of his discovery. *But he has not done this.* The explanation is too vague, under the varying circumstances to which the invention might be applied in practice, to vindicate for the patented discovery the broader or general character.

There is no doubt that he who has discovered some new element or property of matter may secure to himself the ownership of his discovery so soon as he has illustrated its practicability and demonstrated its value. His patent in such case will be commensurate with the principle it announces to the world, and may be as broad as the mental conception itself; but the mental conception must have been susceptible of embodiment, and must, in fact, have been embodied in some mechanical device or in some process or art. The patent must be for a *thing*, not for an idea merely. It is their application to practical use which brings such conceptions within the domain of individuals, and it is the novelty of such adaptation which constitutes it the proper subject of a patent.

But the *contract of the public* is not with him who has discovered, but with *him who makes his discovery usefully known.* If he has discovered much and discloses little; if there has been revealed to him one of the arcana of Nature, and he communicates to the world only one or more of the derivative or secondary truths, *he patents no more than he has proclaimed.* He will not be allowed afterward (when the extent of his right shall be the subject of controversy, either by expanding into a general expression what was limited before to a particular form, or by tracing out for us the line that leads back from consequences to remote causes) to initiate us inferentially into the radical mystery of his invention and then argue that he had described it by implication

from the first, and so claimed ownership of it in his patent.

The interpretation, therefore, which I am constrained to give to that part of complainant's patent which is involved in the present discussion, limits his claim to the formal arrangement without any assertion of right to any dominant principle. The defendants have, perhaps, derived instruction from his description, and may even to some extent have modelled their furnace with its appendages upon a theory which he suggested; but it does not appear to me that they are infringing or have infringed his patent.

The motion for injunction must be dismissed.

Detwold *v.* Reeves *et al.*, *Kane*, *J.*, Sep., 1851, 1 Fisher, 127.

43. The suit of Thomas Blanchard against Chandler Sprague, for the use of said Blanchard's invention (a machine for turning or cutting irregular forms; patented for fourteen years, 20 Jan., 1820; extended for fourteen additional years, 20 Jan., 1834), shows a patent sustained in spite of the functional nature of its summary, in consideration of the fact that the *specification contained a full, clear, and intelligible description of* the "Machine."

"The second article," which, by the language used, is made virtually a constituent part of his "claim," is an extremely voluminous explanation (which fills several pages) of the functions and operation of his machine. The claim proper was as follows: —

"As to the mechanical powers by which the movements are obtained, he[1] claims none of them as his invention. These movements may be affected by application of various powers indifferently. Neither does he claim as his invention the cutter-wheel, or cutters, or friction-wheel, as such, nor the use

[1] Throughout the specification the inventor speaks of himself in the third person.

of a model to guide the cutting instrument. All these are common property, and have been so for years; but he claims as his invention: The method or mode of operation in the abstract, explained in the second article, whereby the infinite variety of forms, described in general terms in this article, may be turned or wrought."

The distinguished jurist, in deciding for the plaintiff, said: —

In the first place, as to the point whether the plaintiff has sufficiently expressed in his specification *the true nature, character, and extent* of the invention which he claims, I am of opinion that he *has*. . . . Looking at the present specification and construing all its terms together, I am clearly of the opinion that it is not a patent claimed for a function; but it is claimed for *the machine* specially *described in the specification*, that it is not for a mere function, but for a function as *embodied in a particular machine*, whose mode of operation and general structure are pointed out. In the close of his specification the patentee explicitly states that —

"His invention is described and explained in the second article of his specification, to which reference is made for information of that which constitutes the principle or character of his *machine* or *invention*, and distinguishes it, as he verily believes, from all other machines, discoveries, or inventions known or used before."

Now, when we turn to this "second article," we find there described, not a mere function, but a *machine of a particular structure*, whose modes of operation are pointed out to accomplish a particular purpose, function, or end. This seems to me sufficiently expressive to define and ascertain what his invention is. It is *a particular machine constituted in this way pointed out*, for the accomplishment of a particular end or object. The patent is for a *machine*, and not for a principle or function detached from machinery. I am therefore of opinion that there ought to be a judgment for the plaintiff

for the damages agreed to by the parties. Judgment accordingly.

Blanchard *v.* Sprague, *Story, J.*, May, 1839, 3 Sumner, 535.

44. The patent granted, 18 March, 1829, to Nathaniel J. Wyeth for "a new and useful improvement in the manner of cutting ice," together with machinery and apparatus therefor, as construed by the Court in Wyeth *et al. v.* Stone, may be cited in illustration of a valid — contrasted with an invalid — claim.

Invalid Claim.	Valid Claim.
1. To cut ice of a uniform size by means of an apparatus worked by any other power than human.	2. The particular application of the principle.

The Court said: In Claim 1, the patentee claims an exclusive title to the art of cutting ice by means of any power other than human power. Such a claim is utterly unmaintainable in point of law. It is a claim for an art or principle in the abstract, and not for any particular method or machinery by which the ice is to be cut. A claim broader than the actual invention of the patentee, and utterly void. Complainant's patent therefore as to Claim 1 is a nullity.

But, besides this general claim (Claim 1), there is another claim (Claim 2).

It appears to me that the language of the summary may be, and indeed ought to be, construed (ut res magis valeat quam hereat) to mean the particular apparatus and machinery described in the specification to effect the purpose of cutting ice.

I argue that the patentee is bound to describe with reasonable certainty in what his invention consists, and what his particular claim is; but it does not seem to me that he is to be bound down to any precise form of

words, and that it is sufficient if the Court can clearly ascertain, by fair interpretation, what he intends to claim, and what his language truly imports, even though the expressions are inaccurately or imperfectly drawn.

Claim 2 was sustained; but the question of infringement was not reached, because one Todor had improperly been made a party to the bill, which was accordingly dismissed with costs.

Wyeth *et al. v.* Stone, *Joseph Story and John Davis, JJ.*, Oct., 1840, 1 Story, 270.

45. Notable instances of invalidation in the one case and of sustentation in the other case, of two patents of generic rank, — such as courts are solicitous to sustain, — were those relating to the automatic steam cut-off of Frederick E. Sickles (which was invalidated) and the breech-loading fire-arm of William C. Hicks (which was sustained).

Patent, 20 July, 1843, No. 3, 189, to F. E. Sickles, Automatic Cut-Off for Steam-Engines. Extended for seven years and re-issued.

Patent, 10 Mar., 1857, to W. C. Hicks, Impt. in Breech-Loading Fire-Arms. Re-issued, No. 3,860, 1 Mar., 1870. Fire-Arms Re-issued and extended.

INVALID CLAIM.

"*Imparting a co-existing movement* to two reciprocating catch-pieces in the operation of trip cut-off valves."

VALID CLAIM.

"1. The combination, substantially as set forth, *of the breechclosing-piece, moving longitudinally with the barrel*, the *cartridge chamber* of the butt of *the barrel and the reciprocating extracting hook* arranged in such manner that its bill enters within the periphery of the said chamber, so that it may engage with the flanges of the cartridge therein when the breech is closed by the forward movement of the closing-piece, even though the cartridge be not expanded."

The patent to F. E. Sickles contained a full description of the improvement, but was nevertheless invalid on

three independent counts, of which the only one necessary to notice here was the improper phraseology of the patentee's claim. In reference to this defect, the Court said: The claim in terms is for an effect or function, and therefore not patentable.

Judgment was given for the defendant.

Sickles *v.* Falls Co., *Nelson & Shipman, JJ.*, Oct., 1861, 2 Fisher, 202.

The "summing up," on the contrary, in Hicks' patent seems a fair illustration of claims to the permitted form of "*means definable by functions.*"

Hicks' claims are explicitly to as many groups of constituent members of the improved fire-arm, although expressed as being so arranged as to operate in a certain way. Claim 1 above given is a fair example of the three claims which were adjudged valid and to be infringed. Of these claims the Court said: Claiming the arrangement of a combination so as to produce a given mechanical result is a claim to the means and not to a result. The means alone are claimed, and claimed only when specially arranged to produce a given result. This is very far from claiming a function.

There must be a decree for the plaintiff and an account with costs.

Renwick *et al. v.* Pond, *Blatchford, J.*, June, 1872, 5 Fisher, 581.

Decisions of like tenor to the above appear in Blanchard *v.* Sprague, 3 Summer, 535; Corning *v.* Burden, 15 Howard, 254, ❁; Dolbear *et al. v.* American Bell Telephone Co., 43 O. G., 377, ❁.

46. An instructive illustration of what constitutes a valid and what an invalid claim is seen in the rulings of the United States Supreme Court in suits under the respective patents of Samuel F. B. Morse for the recording telegraph and of Alexander G. Bell for the magnetic

telephone,— two inventions of confessedly transcendent merit.

Re-issue No. 117, 13 June, 1848, to Samuel F. B. Morse, Electro-Magnetic Telegraph (original patent granted 20 June, 1840).

Letters Patent No. 174, 465, granted 7 March, 1876, to Alexander Graham Bell for improvements in Electric Telegraphy.

INVALID CLAIM.

(MORSE.)

8. I do not propose to limit myself to the specific machinery or parts of machinery described in the foregoing specification and claims; the essence of my invention being the *use of the motive of the electric or galvanic current*, which I call electro-magnetism, *however developed*, for marking or printing intelligible characters, signs, or letters, at any distances, being a new application of that power, of which I claim to be the first inventor or discoverer.

VALID CLAIM.

(BELL.)

5. The method of and apparatus for transmitting vocal or other sounds telegraphically, as *herein described*, by causing electrical undulations, similar in form to the vibrations of the air accompanying the said vocal or other sounds substantially as set forth.

The patent to Samuel F. B. Morse was sustained except as to the eighth claim, which was adjudged to be invalid, and which the patentee subsequently formally abandoned by disclaimer lodged in U. S. Patent Office on the 19th June, 1854.

In Morse's case, Mr. Chief Justice Taney, in delivering the opinion of the Court, said: In proceeding to pronounce judgment in this case, the Court is sensible not only of the importance, but of the difficulties in form of the questions which it presents for decision. The case was argued at the last term, and was continued over by the Court for the purpose of giving it a more deliberate examination....

It is to the high praise of Professor Morse that he has, by a new combination of known powers, of which electro-magnetism is one, discovered a method by which

intelligible marks or signs may be printed at a distance, and for the method or process thus discovered he is entitled to a patent.

As to the specification and claims of the complainant's patent, we perceive no well-founded objection to the description which is given of the whole invention and its separate parts, nor to his right to a patent for the first seven inventions set forth in the specification of his claims. The difficulty arises on the eighth claim. It is impossible to misunderstand the extent of this claim. He claims the exclusive right to every improvement, when the motive power is the electric or galvanic current, and the result is the marking or printing intelligible characters, signs, or letters at a distance.

If this claim can be maintained, it matters not by what process or machinery the result is accomplished. . . .

The Court is of opinion that complainant's Claim 8 is too broad, and not warranted by law.

Neilson *v.* Harford (Eng.); Wyeth *v.* Stone (1 Story, 270); Blanchard *v.* Sprague (3 Duncan, 540); Le Roy *v.* Tatham (14 Howard, ❋), cited and applied.

Decree of Court below affirmed except as to costs, and each party was directed to pay its own costs both in this Court and in the Circuit Court.

O'Reilly *et al. v.* Morse *et al.* By *Taney, Chief J.*, Dec., 1853, 15 Howard, 62, ❋.

The only claim in Bell's patent seriously contested was Claim 5, which claim was, however, sustained and declared valid and to have been infringed.

Mr. Chief Justice Waite, delivering the opinion of the Court, said: The important question that meets us at the outset is as to the scope of the fifth claim. . . . It is contended that this claim embraces the art of transferring or impressing upon a current of electricity the vibrations of air produced by the human voice in articu-

late speech, in a way that the speech will be carried to and received by the listener at a distance on the line of the current. . . . We have no hesitation in saying that if the patent can be sustained to the full extent of what is now contended for, it gives to Bell and those who claim under him, the exclusive use of his art for that purpose until the expiration of the statutory term of his patented rights. Bell discovered that it could be done by gradually changing the intensity of a continuous electric current so as to make it correspond exactly to the changes in the density of the air caused by the sound of the voice. This was his *art*. He then devised *a way* in which these changes of intensity could be made and speech actually transmitted.

We see nothing in the ruling in O'Reilly *v.* Morse (15 Howard, 62) to defeat Bell's claim. On the contrary, it is in all respects sustained by that authority. In the case of O'Reilly *v.* Morse it was decided that a claim in broad terms for the use of the motive power of the electric or galvanic current, however developed, for making or printing intelligible characters at any distance, although a new application of that power first made by Morse, was void, because it was virtually a claim for a patent for an *effect* produced by the use of electro-magnetism distinct from the process or machinery necessary to produce it; but a claim for making use of the motive power of magnetism *substantially as set forth in the foregoing description* . . . was sustained. The effect of that decision was, therefore, that the use of magnetism as a motive power without regard to the particular process with which it was connected in the patent could not be claimed, but that its use *in* that connection could.

Decree of Circuit Court, so far as it was in favor of complainant, affirmed, and so far as it was against the fifth claim of patent, 23 Jan., 1877, reversed.

Dolbear *et al. v.* Am. Bell Telephone Co. By *Waite, C. J.*, 19 Mar., 1888, 43 O. G., 377, ✽.

47. In the case of Le Roy *et al. v.* Tatham *et al.*, the Supreme Court, while, on technical grounds, failing to find for the patentees, took no exception to the claim. The Court said: —

No exclusive right can be founded on the discovery of a new power; the elements of the power are free to all; the invention is not in discovering *them*, but in applying them to useful objects. In all such cases the processes or the instrumentalities used to extract, modify, and concentrate natural agencies, constitute the invention, whether the machinery consist of details separately new and useful, or be a new and useful combination of old parts.

The patentees' claim was as follows: —

We do not claim as our invention and improvement any of the parts of the above-described machinery, independently of its arrangement and combination as above set forth. What we do claim as our invention, and desire to secure, is the combination of the following parts, above described, to wit: the core and bridge or guide-piece with the cylinder, the piston, the chamber, and the die, when used to form pipes of metal under heat and pressure, in the manner set forth or in any other manner substantially the same.

Le Roy *et al. v.* Tatham *et al.* (plaintiffs in error), U. S. S. C. By *M'Lean, J.*, Dec., 1852, 14 Howard, 156, ✿.

48. Where a claim admits of two interpretations, that interpretation will be given to it which is most favorable to the patentee.

In a case before the Supreme Court, which involved the scope and validity of the patent No. 6,792, granted 16 Oct., 1849, to Henry Burden, for "Machinery for Drawing Out or Compressing Heated Iron," the Court sustained the following claim: —

1. Having thus fully made known the nature of my said improvement, and explained and exemplified the manner in which I construct the machinery for carrying the same into

operation, what I claim as constituting my invention and desire to secure by letters-patent is: the preparing of the puddlers' balls as they are delivered from the puddling-furnace (or of similar masses of iron) by causing them to pass between a revolving cylinder and a curved segmental trough adapted thereto, constructed and operating substantially in the manner of that herein described and represented in figures 2 and 3 of the accompanying drawings, or by causing the said balls to pass between vibratory or reciprocating curved surfaces operating upon the same principle and producing a like result by analogous means.

The Court said: It is true that the patentee, after describing his machine, has set forth his claim in rather ambiguous and equivocal terms, which might be construed to mean either a process or a machine. In such case the construction given to the claim should be that which is most favorable to the patentee, *ut res magis valeat quam pereat.*[1] His patent having a title which claims a machine, and his specification describing a machine, to construe his claim as for the function, effect, or result of his machine, would certainly endanger, if not destroy, its validity. His claim cannot nullify or change his previous specification with safety to his patent. Having described a machine which will perform a certain function, he cannot claim the function itself and thereby all other machines that may be invented to perform the same function.

The patent of Burden alleges no discovery of a new process, but only that he has invented a machine, and, therefore, correctly states the nature of the invention. His specification sets forth the "particulars" of his invention in exact accordance with the title in the patent, and in clear, distinct, and proper phraseology.

The case was remanded for a *venire facias de novo* on the twofold ground of irregularities and because the Court below "erred in construing Claim 1 to be for a

[1] "That the thing [*i. e., the patent*] should rather stand than fall."

mode, process, or method, irrespective of the special mechanical device."

Corning *v.* Burden, U. S. S. C. By *Wayne*, *J.*, Dec., 1853, 15 How., 252, ✿.

49. It has been so often decided that an application may not contain claims to separate species of the same invention, that the decision of every such question has become purely one of fact.

Dewey, x. p., *Frothingham*, *Act. Com.*, 24 Oct., 1891, C. D. Ms.

50. The fact that a claim is intelligible to persons like the applicant or the attorney, to whom the device in all its details and minutiæ is already familiar, is not conclusive of its language being such as to convey a clear and exact understanding *to others*.

Kerr, x. p., *Dyrenforth*, *Act. Com.*, 26 Feb., 1884, 28 O. G., 95.

51. Were a claim permissible so totally lacking in definiteness as to oblige a careful examination of the specification to get at the gist of the invention, there would be no occasion for making a claim at all, for it would be just as well to search the description in the first instance for the invention, instead of looking at what is denominated a "claim," but which is in reality a mere reference to the description.

Ib.

52. Where the claim is so unintelligible as to mean nothing, or so indefinite as to mean anything, the law warrants a refusal to enter upon the examination until the claim has been corrected in form; but where the claim did not lack in intelligibility or definiteness, and the Examiner declined to consider the case on the merits, "for the reason that said claims failed to point out any qualities in the thing claimed which could legitimately

be considered in connection with the patentability of an article of manufacture": *Held*, upon petition of the applicant, that if Examiner was still of opinion that claimant was not entitled to a patent under the law, he should reject the claims for all the reasons pertinent to examination, so as to put the case in condition for appeal to the Examiners-in-Chief in case applicant should so elect.

Rogers, x. p., *Mitchell, Com.*, 16 Nov., 1889, 49 O. G., 1361.
Compare Ives, x. p. (1), and Rice, x. p. (2), AMBIGUITY.

53. Claims forming parts of one case cannot be to alternative structures; or, in other words, no claim can be to a modification of a structure set up in another claim in one and the same case, nor may any claim be in itself to two or more alternative forms.

Holt, x. p., *Dyrenforth, Act. Com.*, 26 Ap., 1884, 29 O. G., 171.
Compare Pierce, x. p., (7) AMENDMENT.

54. Change of Claim from the Method to the Apparatus after Final Rejection, — Refused.

Where the application as originally filed was restricted to the method: *Held*, that, after its rejection upon references, applicant could not be permitted to amend by substituting a new statement of invention and new claims covering the apparatus; that it must be held that applicant had elected, and that, under Zabel, x. p. (43 O. G., 627), an applicant who in his application has elected, through ignorance or mistake, to prosecute claims for one invention must exercise diligence in presenting his amendment correcting such error, before his application has been examined and rejected.

Kinzer, x. p., *Mitchell, Com.*, 6 Feb., 1891, C. D. Ms.

For circumstances justifying a relaxation of the above general rule, see Butterfield and Batchelor, (2) RE-OPENING.

55. The objection that a claim is alternative in form stands upon an entirely different basis from the objection or requirement that the application should be divided. Objection as to alternative forms may be quite tenable, even where both forms in the alternative claim relate to the same invention.

Wilson & Mason, x. p., *Mitchell, Com.*, 15 Mar., 1890, C. D. Ms.

56. A claim presented in application which claimed the adjustment of a certain member without specifying any *means* of adjustment, was rejected because merely functional. The claim was as follows: —

A shaft C, for holding the bevel-gear wheel the cogs of which are to be planed, adjusted to turn laterally and vertically about a point D, which is upon its axis and also on the line of travel of the planing-tool *g*, and on the apex of the conical or bevelled surface to be planed, substantially as described.

Holmes, x. p., *Thacher, Act. Com.*, 31 Aug., 1874, C. D. 87.

NOTE.—The above claim, if amended by insertion, after "adjusted," of some such expression as "by the described or equivalent means" might possibly have been passed by the Office, and if passed, would probably have been sustained by the courts. See for example, Corning *v.* Burden, ✽, (48) *supra*. But compare for Office action, Ives, x. p., (29) *supra*, and Rice, x. p., (57) *infra*.

57. A mere reference to the body of the specification by the words "substantially in the manner described" is not good practice under the statute requiring that the applicant shall "distinctly claim" his invention.

Rice, x. p., *Leggett, Com.*, 2 May, 1874, C. D. 44.

For exception, — in favor of a pioneer invention, — to the above general rule, see Dalton, x. p., (11), Nat. Type Co. *v.* N. Y. Type Co., (38), Morley Mach. Co. *v.* Lancaster, ✽, (39), Worstwick M'f'g Co. *v.* City of Buffalo (40), and Corning *v.* Burden, ✽, (48), *supra*.

58. Redundancy, Duplication, Prolixity, etc.

Where a simple invention is made the subject of numerous claims, differing in mere methods of expression, with no corresponding difference in the concrete subject-matter, the Office should insist that one claim only be allowed for a given subject-matter of invention, and that mere differences in phraseology shall not be regarded when urged in defence of a needless multiplication of claims.

Johnson, x. p., *Mitchell, Com.*, 20 Jan., 1891, 54 O. G., 505.

59. The common but reprehensible practice of unnecessarily, if not improperly, splitting up and multiplying claims, illustrated in complainant's specification, — condemned.

Bostock *v.* Goodrich, *Butler, J.*, 6 Nov., 1885, 29 O. G., 278.

See, however, (18), (19), (20), and (20′), *supra*, for cases in which a re-statement, in changed phraseology, of substantially the same invention, was permitted.

60. What Mr. Brush accomplished in 1879 and 1880 can be embraced in a brief, clear, and precise statement. What he actually did is the test by which his patents must be judged. He is entitled to what he invented, and only that. His patents can receive no broader construction because he described his inventions with irksome prolixity, and gave to the same structure a wearisome variety of names. The nomenclaturist should not seek the reward for his labors in the Patent Office. A person is not entitled to a patent because he has invented a new word. The danger and impropriety of holding a number of claims relating to the same structure, and which can be differentiated only by the most abstruse and metaphysical distinctions, seem apparent. They are calculated to embarrass inventors and to mislead the public.

Brush Elec. Co. *v.* Elec. Acc'm'r Co., U. S. C. C. S. D. N. Y., *Coxe, J.*, 23 July, 1891.

61. The question of redundancy or multiplicity of claims is one of "form," and not one which involves "the merits;" hence the proper remedy is by petition to the Commissioner.

Sawn, x. p., *Mitchell, Com.*, 9 Mar., 1891, 54 O. G., 1561.

62. Where the Examiner makes the objection that there are too many claims, he should point out the reasons for such ruling, and should designate which claims are superfluous, so that applicant may be fully advised and be able to act intelligently either in limiting their number or in persisting in their retention.

Bickley, x. p., *Fisher, Act. Com.*, 29 Mar., 1890, C. D. Ms.

See REDUNDANCY.

63. Claims in a patent for invention are not like counts in a pleading, setting forth the same cause of action in different forms of language to provide against the hazards of proof; but their object is to set forth distinctly and *concisely* just what the invention is which applicant asks to have secured to him by his patent: hence, where a simple invention is made the subject of numerous claims, some of them differing from others in mere methods of expression, with no corresponding difference in the concrete subject-matter, the Office should insist that one claim only be allowed for a given subject-matter of invention, and that mere differences in phraseology shall not be regarded when urged in defence of a needless multiplication of claims.

Johnson, x. p., *Mitchell, Com.*, 20 June, 1891, 54 O. G., 505.
Compare, however, (18) to (20), inclusive, *supra*.

64. The mere fact that the Examiner calls his action on the claims a "rejection" does not in fact render them subject for appeal to the Examiners-in-Chief, unless the reasons for rejection are such as relate to the merits

of the case: hence, where the action of the Examiner amounts, in effect, to a statement that the claims, as amended, are inaccurate and misleading, a petition to the Commissioner is proper.

Hensen, x. p., *Frothingham, Act. Com.*, 21 Aug., 1891, C. D. Ms.

65. Claims must be construed according to their terms; and where the import is plain, resort cannot be had to the specification for the purpose of enlarging their scope.

White *v.* Dunbar, U. S. S. C. By *Bradley, J.*, 119 U. S., 47, ✲.
Compare Lull *v.* Clark, (20″) *supra*, and Laskey, (66) *infra*.

66. It is the province of claims to relegate to the specification the enumeration of such details of construction as shall, upon examination, be found to be immaterial to the true scope of the actual invention. The inclusion of such merely accessory parts in the description in the specification is to enable persons skilled in the art to construct the machine in the form set out in the patent, but not to so limit the invention as to make it an easy prey to the infringer.

Laskey, x. p., *Mitchell, Com.*, 6 July, 1889, 48 O. G., 539.
Compare (22) *et seq.*, *supra*.

67. Constructive Dedication.

Nothing is better settled in the law of patents than that the patentee may claim the whole or only a part of his invention, and that if he describe and claim only a part, he is presumed to have abandoned the residue to the public. The object of the patent law in requiring the patentee to "particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery" is, not only to secure

to him all to which he is entitled, but to apprise the public of what is still open to *them*. The claim is the measure of the right to relief; and while the specification may be referred to to limit the claim, it can never be made available to expand it (Keystone Bridge Co. *v.* Phœnix Iron Co., 95 U. S., 274, ✿).

McClain *v.* Ortmayer, U. S. S. C. By *Brown*, *J.*, 2 Nov., 1891, 57 O. G., 1129, ✿.

68. Of several possible interpretations of a claim, that interpretation will be given which, all things considered, is most favorable to the patentee (*ut res magis valeat quam pereat*). The invention was held to be confined to the machine, as the process referred to was not patentable (Corning *v.* Burden, 15 Howard, 264, ✿).

Harrison, x. p., *Doolittle*, *Act. Com.*, 1876, C. D. 170.

69. When the claim is susceptible of two constructions, that one will be adopted which will preserve to the patentee his actual invention; but nothing can be held to be an infringement of a patent which does not fall within the terms the patentee himself has chosen to express his invention.

McClain *v.* Ortmayer, U. S. S. C. By *Brown*, *J.*, 2 Nov., 1891, 35 L. ed., 800, ✿.

Of like tenor, see Corning *v.* Burden, ✿, (48) *supra.*

70. Whether or not claims should be construed as covering a complete and useful article is a question relating to "the merits," to be determined in the first instance by the Primary Examiner, then by the Examiners-in-Chief on appeal, followed by appeal to the Commissioner, if necessary; these questions must be determined before a question of substantial identity of two or more of the claims is presented to the Commissioner.

Dyer, x. p., *Frothingham*, *Act. Com.*, 4 Aug., 1891. C. D. Ms.

71. Combination Claim, — Scope of.

In a patent for improvement in water-closets, a combination claim, one element of which is "two jets," is not infringed by a closet having but one jet. It has been repeatedly held that a combination is an entirety, and that a patentee cannot abandon a part as immaterial and claim the rest, but he must stand by the claims as he has made them. If less *or more* [?] than the whole of his ingredients is used by another, that other is not liable as an infringer, because he has not used the invention or discovery patented. Such is the doctrine of the Supreme Court as laid down in Schumacher *v.* Cornell (96 U. S., 549, ✽).

Smith *v.* Putnam, *Colt, J.*, U. S. C. C. Mass., 45 F. R., 202.

NOTE. — While the italicized portion of the above ruling had no bearing on the case in suit, and must be considered but an *obiter dictum* of the learned judge, it may be stated that neither in Schumacher *v.* Cornell, ✽, nor in the earlier Supreme Court decision in Vance *v.* Campbell, ✽, cited in that case, is language found which either directly or inferentially justifies the above italicized portion of the decision in Smith *v.* Putnam, nor is that portion believed to be sound in law. A patented combination of mechanical elements is *not* free to any one who, without re-arranging such elements or in any way modifying their mutual or several functions, simply adds one more or any number of new elements. The word "ingredients" employed in the Circuit Court decision seems suggestive of a chemical rather than of a mechanical combination (water-closet), and it may be conceded as true that chemical combinations are not infrequently profoundly affected (as, for example, in the minute increment of carbon in steel) by an added element. A mechanical combination, even where meritorious and patented, which incorporates without changing the combination of an earlier patent is subject to its claims. See Crehore *v.* Norton, *Nelson, J.*, 1853; Crehore *v.* Moore, Law's

Digest, 351; Foster *v.* More, Curtis, C. C. Rep.; Tilghman *v.* Procter, 19 O. G., 859, ✽; Bladen *v.* Rand, McNally & Co., 27 O. G., 99; Bell *v.* Gray, 15 O. G., 776. See also Clark *v.* Ferguson, (5) COMBINATION, and Nail, x. p., (1) COMPOSITION OF MATTER.

72. Where a patentee, on rejection of his application, had inserted in his specification limitations and restrictions, for the purpose of obtaining his patent, he cannot, after he has obtained it, claim that it shall be construed as if such limitations and restrictions were not contained in it.

Roemer *v.* Peddie *et al.*, U. S. S. C. By *Blatchford, J.*, 9 Dec., 1889, 132 U. S., 313, 49 O. G., 2151, ✽.

73. Where a patentee had modified his claim in obedience to the requirements of the Patent Office, he cannot have for it an extended construction which had been rejected by the Patent Office; and, in a suit on his patent, such claim must be limited, when it is a combination of parts, to a combination of all the elements which he has included in his claim as necessarily constituting that combination. The authorities are collected in the Supreme Court decision in Roemer *v.* Peddie (132 U. S., 313–317, ✽).

Phœnix Caster Co. *v.* Spiegel, U. S. S. C. By *Blatchford, J.*, 3 Mar., 1890, 50 O. G., 1591, ✽.

See, of like purport, Sargent *v.* Hall Safe & Lock Co., ✽, (10) PUBLIC RIGHTS AND OBLIGATIONS.

74. The use of the words "substantially as described and for the purpose set forth," in a claim, throws it back to the specification for the qualification of words otherwise general.

Brown *v.* Guild, U. S. S. C. By *Bradley, J.*, Oct. term, 1874, 23 Wallace, 181, ✽.

75. A claim which might otherwise be held bad as covering a function or a result, may be construed, when containing the words "substantially as described," in connection with the specification and be limited thereby.

Seymour *v.* Osborne, U. S. S. C. By *Clifford, J.*, Dec., 1870, 11 Wallace, 516, ❋.

NOTE (i). — The claim in question was that of W. H. Seymour, for an improvement in harvesters, and was as follows: —

A quadrant-shaped platform, arranged relatively to the cutting-apparatus, substantially as herein described, for the purpose set forth.

NOTE (ii). — For present attitude of the Patent Office toward such claims as are referred to in (74) and (75) *supra*, see (29) to (37), inclusive, and (57) *supra*, and (79) to (85), inclusive, *infra*.

76. Where an inventor was the first to enter a particular field of invention, the claim of his patent should be construed broadly to cover any similar apparatus which effects the same result in substantially the same manner.

Worstwick M'f'g Co. *v.* City of Buffalo, *Coxe, J.*, 8 May, 1884, 27 O. G., 1239.

77. Claim must be to means, not to results.

Whether an inventor is a pioneer in his line or not, he cannot make a valid claim the scope of which is so extensive as to include means substantially different from those described, even though the same results may be produced by those different means. An inventor may, however, employ language sufficiently comprehensive to include colorable variations of his invention, — mechanical equivalents thereof, and (if the state of the

art will justify it) modifications differing in form but embracing the same principles.

Demming, x. p., *Butterworth, Com.*, 12 Mar., 1884, 26 O. G., 1207.

Compare (46) *supra.*

78. Infancy of the Art.

In the case of patents which represent the infancy of an art or *the stage of its earliest practical development*, this Office is solicitous that the inventor should be accorded a breadth of claim commensurate with the extent and importance of the invention which he desires and is entitled to protect. While the Office will insist on as much definiteness in the language of the claim as the statute calls for, it will also, if it properly discharge its functions as the protector of the inventor, leave something to the salutary and benign agency of construction in the courts.

Pacholder, x. p., *Mitchell, Com.*, 26 Ap., 1889, 51 O. G., 295.

79. Maturity of the Art.

No general rule can be laid down for governing the employment, in the claims of patents, of such words as "means," "mechanism," "appliances," etc. It is the object of the law, as it is the solicitude of the Office, to protect inventors and guard their inventions. This object is best secured, in the case of patents which represent the maturity of an art, by taking care that the claims shall be drawn with all reasonable restrictions, so that they shall be valid in spite of everything that is contained in existing patents and of everything previously known or used.

Ib.

80. Basic Invention.

The invention at issue, being a broad one and of acknowledged value, is entitled to be protected by claims of adequate scope. For the first time in the art it had been made possible to produce, from a continuous web, newspapers, cut, pasted, and folded into a complete pack, without any manipulation of the paper-blank from its entry into the machine to its exit, and to print newspapers more rapidly and cheaply than heretofore. In fact, a revolution in the entire art of newspaper printing is effected by the invention, so that, viewed from this standpoint alone, the quality of it cannot be seriously underrated.

Scott *v.* Ford *et al.*, *Spear, Com.*, 30 Sep., 1878, C. D. 106.

NOTE. — The claim above referred to and approved was in language as follows : —

The combination of printing, cutting, pasting, and folding mechanisms, whereby a web of paper is printed, severed into sheets, pasted on their folding lines and folded or doubled two or more times, to form complete folded packs or signatures; all substantially as described.

81. Where an applicant seeks to secure a generic patent, he should employ, in the specification and in his generic claim or claims, comprehensive designating language applicable alike to all the forms shown and described, of the device in question.

Cook, x. p., *Mitchell, Com.*, 12 Ap., 1890, 51 O. G., 1620.

82. Generic Claims and Specific Claims.

It is abundantly decided that an applicant can show and describe as many different forms of his invention as can be covered by the generic claim (or claims), and may also claim specifically the preferred form of his invention ; but more than this he is not entitled to do. The other forms can be specifically covered only in as many distinct

patents (Eagle, x. p., 1870, C. D. 137; Howland, x. p., 1877, C. D. 120; Heaton, x. p., 1879, C. D. 95).

Ib.

83. Commissioner Fisher, in the case of Eagle, x. p., 1870, C. D. 137, established on a permanent basis the practice of the Office where an applicant seeks to claim a specific form of his invention, and in the same grant to secure by generic claim the features common to two or more figures representing modified forms of his invention. In this decision, Commissioner Fisher said:

The applicant describes a new genus, to wit, a box provided with a follower. He may fairly describe several species of this genus, and he may make any claim that is generic in its character and that includes them all. In addition to this [any representation of the genus being necessarily one of its specific forms] he may select one of the embodiments of his invention for specific claims, but he cannot [in one and the same patent] found one claim on one species, a second on another, a third on another, and so on.

The same doctrine was laid down in Howland, x. p., 1877, C. D. 120; in Heaton, x. p., 1879, C. D. 95; and in Cook, x. p., 51 O. G., 1620.

Payne, x. p., *Mitchell, Com.*, 25 July, 1890, C. D. Ms.

84. Pioneer Inventor.

Where a party is the first inventor [in the class] of the devices on which he seeks a patent, and not a mere improver upon previous inventions, he is entitled to employ general words of description in the claims, such as, "constructed, arranged, and operated as set forth," to express the co-operation of certain parts with others of the machine. The restrictions laid down in Rubens, x. p. (1869, C. D. 107), do not apply to a fundamental invention such as that now in controversy.

Knight *v.* Amman, *Duncan, Act. Com.*, 20 Feb., 1871, C. D. 34.

85. Applicant may describe a genus and several species of the genus, and he may take a generic claim covering them all; he may also select one of the embodiments of his invention for a specific claim. Other embodiments may be protected in as many separate patents.

Heaton, x. p., *Payne, Com.*, 16 Dec., 1878, 1879, C. D. 95, 15 O. G., 1054.

86. In a process claim it is only necessary to define the *steps* of the process, leaving to the specification to fully point out the manner in which such steps are carried out.

Zalinski, x. p., *Fisher, Act. Com.*, 4 Mar., 1890, C. D. Ms.

Compare Vorel, x. p., (11) PROCESS.

87. The Necessary Operation of a given Machine not claimable as a Process.

Where a structure of a special and particular form necessarily produces, by its operation, certain results, it alone can be claimed, and not the results. It is very important to discriminate between a process [properly so called] which may consist of a series of steps or acts carried on by *any* mechanical means necessary to produce them in a certain order, and a "process," so called, which amounts to nothing more than the functions of, or the effects necessarily produced by, a machine of a particular form. It is difficult to make this discrimination in all cases; and yet, where it can be made, it is a vital matter in the proper examination of an application or the grant of a valid patent.

Roloson, x. p., *Doolittle, Act. Com.*, 14 Jan., 1879, 15 O. G., 471.

Compare Corning *v.* Burden, (1) ART, and McKay *v.* Jackson, (35) INVENTION.

88. Compound or Composition of Matter.

The claim presented was: —

As a new article of manufacture, the petroleum-product hereinbefore specified and having the characteristics herein described.

The Examiner refused to entertain the claim because "not specific." Examiner's decision was reversed, and consideration of the case upon its merits was directed, because the product must be regarded as an entity, and, if new, the inventor or discoverer is entitled to all the known or hereafter discovered characteristics it may possess. It is impossible to mention all these in the claim, and to mention less would restrict the claim within too narrow limits.

Where new products are discovered incapable of being definitely described in the claims except by a general reference to the specification, the rule requiring that the applicant "shall particularly point out and distinctly claim the invention" is relaxed, the case being considered anomalous (Goodyear *v.* R. R., 2 Wallace, Jr., 365).

Tweddle, x. p., *Doolittle, Act. Com.*, 28 Oct., 1876, C. D. 221.

89. A claim for a compound consisting of certain known ingredients should enumerate them.

The above rule, which is of general application, is relaxed only in such rare and anomalous cases as Tweddle (1876, C. D. 221) and Goodyear *v.* R. R. (3 Wall., Jr., 365), in which a substance never before known and of great industrial value had been produced by a chemical process which was also new, and which could be defined only by reference to the entire specification.

Williams, x. p., *Doolittle, Act. Com.*, 31 Oct., 1876, C. D. 227.

NOTE. — The claim objected to was worded as follows: —

The hereinbefore described compound or composition of matter consisting of the ingredients mentioned, prepared in the manner and proportion substantially as described for the purpose set forth.

CLASSIFICATION.

1. Devices of which each has obtained a distinct status in an industry or trade, should be the subjects of separate applications.

Sawn, x. p., *Mitchell, Com.*, 9 Mar., 1891.

2. The creator of an art — as, for example, the inventor of the first watch — would be entitled to a patent including in it as many claims as the several distinctive elements of the mechanism; but when, in the progress of the art, the efforts of inventors have been directed to separate parts of the watch, and, at their requests, patents have been issued upon such separate parts, a corresponding classification of subjects necessarily arises.

Combs, x. p., *Duncan, Act. Com.*, 2 Aug., 1871, C. D. 209.

3. Ordinarily, two or more independent inventions should not be included in one patent.

When a part of an application relates to an independent invention, it should not be allowed to remain merely because there is no Office Classification applicable to the case. Applicant should not be granted an invalid patent because of the [imperfect] classification [of inventions] in the Office.

Martin, x. p., *Marble, Com.*, 21 Sep., 1883, 25 O. G., 502.

NOTE. — Examiner was directed to make a sub-class of MATCH-TRAYS.

4. Two or more inventions capable of independent operation may be included in one patent if capable of co-action for a single useful result.

Although distinct and independent inventions which are differently classified may not ordinarily be embraced in one application; nevertheless, when dependent upon each other and co-operating toward the production of a single result, the Office Classification, when it obstructs, must give way.

Mefford, x. p., *Butterworth*, *Com.*, 15 Nov., 1883, 25 O. G., 881.

Compare Dalton, x. p., (7) INVENTION.

5. The words "Art," "Machine," "Manufacture," "Composition of Matter," and "Improved Art," etc., — Defined.

A patent is a creature of the statute, and must be covered by its provisions. It is evident that the words "art," "machine," "manufacture," and "composition of matter," were carefully chosen to cover what were regarded as four great and distinct classes of invention. It is undoubtedly the intention of the law to distinguish as separate inventions "a new art," "a new machine," "a new manufacture," "a new composition of matter," "an improved art," "an improved machine," "an improved manufacture," "an improved composition of matter," — eight in all. These may be called the statutory classes of invention between which the lines of division are sharply drawn.

Blythe, x. p., *Butterworth*, *Com.*, 28 July, 1884. 30 O. G., 1321.

Compare Corning *v.* Burden, (1), Kelly, x. p., (2), and Dalton, x. p., (3), ART.

6. When one particular element of a machine is dependent upon and acts with the other elements

thereof to produce a single beneficial result, it may be claimed in the same application with them, without regard to the Office Classification.

Coe, x. p., *Fisher, Act. Com.*, 27 May, 1889, 48 O. G., 1119.

Compare Designolle, x. p., (17) THE CLAIM; Carter, x. p., (5), and McMahan, x. p., (31), DIVISION OF APPLICATION; and Hunter, (2) RULES AND FORMS.

NOTE. — Equally inadmissible with the crowding of two or more distinct and independent inventions into a single patent is the converse procedure of attempting to cover one indivisible subject-matter of invention under two separate patents differing only in verbiage. See, for example, Smith, x. p., (4) APPLICATION; Brush *v.* Elec. Co., (60) THE CLAIM; Langlois, x. p., (12), Gabouri, x. p., (13), and Feister, x. p., (14), EXAMINATION.

For inadmissibility of two or more patents for different uses merely of one and the same thing, see Faure, x. p., (12), and Barrett, x. p., (13), PUBLIC RIGHTS AND OBLIGATIONS.

COLLATERAL QUESTIONS.

See Hunter, Jr., *v.* Lane, (65), and Strause *v.* Cook, (84′), INTERFERENCE.

COLLUSION.

It being made to appear to the Court, by petition of strangers to the record, that a decree was obtained by collusion between complainant and defendant in a patent suit, the decree was annulled, and the cause disinissed.

Barker *v.* Todd, *Wallace, J.*, 29 Nov., 1882, 23 O. G., 438.

COMBINATION.

1. Legitimate Combination, — Defined.

To render patentable a combination of devices old in themselves, the combination must produce a result new

in itself, and distinct from any mere aggregate of the results formerly produced by any or all of the devices when acting separately.

Coes, x. p., *Leggett*, *Com.*, 29 June, 1874, 6 O. G., 1.

2. There is a combination between two or more elements if there is a concert of action between them to accomplish a result *due to their conjoint action*, even where the device is capable of separation into elements capable of performing distinct and independent functions.

McKisson *v.* Caindick, *Blatchford*, *J.*, 8 Ap., 1881, 21 O. G., 137.

3. It appearing that some of the elements of the combination claim formed a new combination of parts to secure a useful result, it became inmaterial to inquire whether all the elements of the claim are strictly in combination and not merely aggregated.

Strobridge *v.* Landers, *Blatchford*, *J.*, 3 Dec., 1881, 21 O. G., 1027.

4. In a patentable combination of elements all the parts must so enter into it that *each qualifies every other.* The combination must either form a new machine of a distinct character and functions, or must produce a result due to the joint and co-operating action of all the elements, and not to the mere adding together the separate contributions.

The Clark Pomace-Holder Co. *v.* Ferguson, *Coxe*, *J.*, 10 Jan., 1883, 24 O. G., 1090.

See, however, Strobridge *v.* Landers, (3) *supra.*

5. Considered as a generic term, a combination may be defined to be *a co-ordination of individual functions so as to constitute a common function.* Co-ordination

necessarily implies some modification of the individual function of each part as it existed prior to the combination. To be patentable, a combination must conform to the definition given above, and must also contain two other elements; namely, novelty and utility.

Marshall, x. p., *Butterworth, Com.*, 12 Nov., 1883, 25 O. G., 882.

6. In reference to a patent to one Prouty for a new and useful combination of old and well-known elements, the Supreme Court held: The patent is for a combination, and the improvements consist in arranging different portions of the plough and combining them together in the manner stated in the specification for the purpose of producing a certain effect. None of the parts referred to are new, nor is any portion less than the whole claimed as new or stated to produce any given result. The end in view is proposed to be accomplished by the union of all, arranged and combined together in the manner described.

Prouty *v.* Ruggles, U. S. S. C. By *Taney, Ch. J.*, 1842, 16 Peters, 340 U. S., 987, ✱.

See also Broughton, x. p., McArthur, Pat. Cas., 285; citing Barrett *v.* Hall, 1 Mason, 474, and Parr *v.* Little, 3 Wash., 196.

7. The separate parts of *a process* being old, the only field left for invention was either a new order in which the steps were to be applied, or some new method of using one or more of the devices by which the process was accomplished, or both these combined, so as to produce some new product or some old product in a cheaper or otherwise advantageous manner.

Downtown *v.* Yeager Milling Co., U. S. S. C. By *Woods, J.*, 7 May, 1883, 25 O. G., 697, ✱.

8. A legitimate combination may not be rejected piecemeal.

A legitimate combination, in an application for patent, should be met as such, or not at all. The practice of dissecting a machine and rejecting it by piecemeal is without sanction of either reason or law. Under such practice the Office might very soon close its doors; for the lever, the inclined plane, and the pulley are very old and very well known, and might soon become sufficient references for every possible mechanical device.

Smith, x. p., *Leggett, Com.*, 24 Ap., 1872, 1 O. G., 403.

9. The Examiners-in-Chief rejected an application for a certain process on nine distinct references: *Held*, on appeal, that as no one of the references disclosed all the steps of the process claimed, none of the references were anticipations, and the decision was reversed.

Keene, x. p., *Simonds, Com.*, 29 Jan., 1892, C. D. Ms.
Compare Smith, x. p., (8) *supra*, and Dubbs, x. p. (10) *infra.*

10. Step by Step Argument.

The patentability of an alleged process having been denied, upon the ground that a claim, by the same applicant, in a former application for a process for manufacturing asphaltum having been held destitute of patentability, it did not make a new process to practise the same operation in the treatment of crude petroleum, or of a residuum of the same free from paraffine wax: *Held* that of that proposition two things were to be said: (i) That it is never safe to determine patentability upon such a *step-by-step argument*; (ii) That the substitution of material in a process where chemical or quasi-chemical actions take place may involve a change of substance. The probabilities of the presence of patentable novelty being in applicant's favor, the decision of the Examiners-in-Chief was reversed.

Dubbs, x. p., *Simonds, Com.*, 15 June, 1892, C. D. Ms.
Compare Tweddle, x. p., (88) THE CLAIM; Crippen, x. p., COMPOUND; and Nail, x. p., (1) COMPOSITION OF MATTER.

11. An aggregation of old devices, each working out its own effect without securing some new and useful result as the joint product of the combination, does not constitute a patentable invention (Hailes *v.* Van Wormer, 20 Wallace, 353,✵; Pickering *v.* McCullough, 104 U. S., 310, ✵).

Adams *v.* Bellaire Stamping Co. *et al.*, U. S. S. C. By *Field, J.*, 16 Nov., 1891, 57 O. G., 1280, ✵.

12. The objection of incompleteness of combination, it is well settled, relates to "the merits," and is appealable to the Examiners-in-Chief.

Lockwood, x. p., *Fisher, Act. Com.*, 19 June, 1890, C. D. Ms.

COMMERCIAL SUCCESS.

Public Adoption as a Test of Patentability.

Where the question of invention is in doubt, the fact that the device has gone into general use and has displaced other devices which had previously been employed for analogous uses, is generally sufficient to turn the scale in favor of sufficiency of invention (Smith *v.* Goodyear Co., 93 U. S., 486, ✵; Hollister *v.* Benedict Co., 113 U. S., 59, ✵; Hill *v.* Biddle, 27 F. R., 560). But where an applicant has merely carried forward or made a new or more extended application of an old method, and it simply involves the expected skill of the calling, a finding that such a doubt exists would be unwarrantable, and the fact that the improved device was a commercial success, and had been adopted, to the exclusion of similar devices not having the feature sought to be patented, is immaterial.

Spielman, x. p., *Mitchell, Com.*, 19 Sep., 1890, C. D. Ms.

Compare Washburn *v.* Barbed Wire Co., ✵,(5), and McClain *v.* Ortmayer, ✵,(6), PATENTABILITY.

COMMISSIONER, ETC.

1. Powers and Duties.

The Commissioner of Patents must be governed in his practice by decisions of the Federal Courts; hence, an interference having been declared under authority of a rule (Rule 51) promulgated by the Commissioner of Patents with the approval of the Secretary of the Interior, but the Supreme Court of the District of Columbia having ruled (Mayal, x. p.) that the Commissioner has no authority of law to declare an interference between an application for re-issue and a patent granted subsequently to that sought to be re-issued: *Held*, that the said decision must hereafter control the Patent Office in the declaration of interferences so far as it applies. Rule 51 may therefore be regarded as amended by striking out its last paragraph.

Becker *v.* Throop, *Thacher, Com.*, 7 July, 1875, 8 O. G., 1.

NOTE. — In the Patent Office pamphlet of April 1, 1892, the parties between whom interferences may lie are particularized under Rule 94.

2. It is the first and highest duty of every officer connected with the Patent Office having judicial functions, when he makes a decision, to be guided by the decisions of the United States Supreme Court, and, failing an appropriate Supreme Court decision, by the decisions of the United States Circuit Courts whenever they furnish a guide for his action.

Penney *v.* Gunn, *Simonds, Com.*, 13 Aug., 1891, C. D. Ms.

Compare Reffard *v.* De Ferranti, (1) RULES AND FORMS, and Jerome, x. p., (8) APPEAL.

3. Questions of Constitutionality.

Whatever doubts may exist with reference to an act prescribing duties for the Patent Office, it remains for

this Office to treat it as a valid part of the law until the Supreme Court declares it unconstitutional.

Palmer, x. p., *Simonds, Com.*, 13 Jan., 1892, 58 O. G., 383.

4. Jurisdiction.

A rejected application, pending on appeal in the Supreme Court of the District of Columbia, is not open to review by the Commissioner of Patents.

Jerome, x. p., *Simonds, Com.*, 21 Jan., 1892, 58 O. G., 945.

5. The Commissioner the Judicial Head of the Patent Office.

It is a matter of course that there must be some head, both executive and judicial, in this Office. The Supreme Court (Com'r *v.* U. S. *ex rel.*, Howe, 1884, C. D., 429) has said that the Secretary of the Interior is not that judicial head. It follows that the Commissioner of Patents must be.

Strong, x. p., *Simonds, Com.*, 7 Oct., 1891, 57 O. G., 274.

6. Plenary Powers of the Commissioner.

Where it was insisted that it was the Commissioner's duty to look into any case to which his attention is called by appeal or otherwise, at any stage of the proceedings, where there is a reasonable ground for belief that a fraud or wrong is about to be perpetrated either by his subordinates, or by applicants or their attorneys: the Commissioner dismissed the appeal [in this particular instance] for want of merit; but held that he would be very slow to lay down any proposition, as to his duties, which is to any extent antagonistic to the view — insisted upon by counsel — that the law places upon the Commissioner the responsibility for the proper administration of the Office; and any theory of his powers which does not make them co-extensive with his responsibility must necessarily be erroneous.

Slutz & Slutz *v.* Dunning, *Mitchell, Com.*, 12 Ap., 1890, C. D. Ms.

7. Commissioner can withhold issue of patent.

A favorable decision of an Examiner or of the Board of Examiners-in-Chief upon an application for patent is not conclusive upon the Commissioner, and it does not follow thereupon that he has only the ministerial duty to perform of countersigning and sealing the patent.

Hull *v.* The Com'r of Patents, Supreme Court of the District of Columbia. By *Wylie, J.*, 13 Mar., 1875, 7 O. G., 559.

8. The Commissioner has power to withhold a patent even after a favorable decision by one of the lower tribunals. Such supervision is necessarily incident to his position as the head of the bureau, but is exercised only when a clear case of necessity therefor is apparent.

Strong, x. p., *Simonds, Com.*, 7 Oct., 1891, 57 O. G., 274.

Compare (9) *infra.*

9. Where the effect of action by the Commissioner, on an appeal from an Examiner, would be to review a decision of that Examiner which was favorable to the application in question, such appeal is repugnant to Rule 124, and will not lie.

Hochhausen *v.* Eichmeyer, *Simonds, Com.*, 19 Jan., 1892, 58 O. G., 521.

Compare (7) and (8) *supra.*

10. Acts of the Assistant Commissioner.

Upon petition to the Commissioner from the Assistant Commissioner: *Held*, that the law makes no provision for such an appeal, and the petition was treated as a motion for a re-hearing.

Clanton, x. p., *Fisher, Act. Com.*, 21 Mar., 1890, C. D. Ms.

See ASSISTANT COMMISSIONER.

11. Acts of Predecessor.

Where Commissioner Montgomery had re-instated an application: *Held*, that it was a judgment on the part

of the then Commissioner over which his successors have no jurisdiction; that the application thereby acquired the status of a pending application, and that all successive Commissioners were bound by the decision.

In re Strong, *Mitchell, Com.*, 16 Sep., 1890, C. D. Ms.

12. A finding of fact by a former Commissioner should not be reconsidered, unless no evidence was presented at the hearing on which a finding might be based, or unless the finding was clearly against the evidence.

Spielman, x. p., *Simonds, Com.*, 16 Sep., 1891, 56 O. G., 1707.

13. The official decisions and corrections of the Commissioner and of the Acting Commissioner are binding upon all in the Office, including the Examiners-in-Chief, until reversed by the Secretary of the Interior. There is but one course open to officers and employés in the Patent Office who deny the relation between the head of the Office and the subordinates.

In re Clymer & Riley, *Leggett, Com.*, 17 July, 1874, 6 O. G., 505.

14. Objections to the specification, accompanied by a refusal to act further on the merits until the objections have been removed, are reviewable by a petition to the Commissioner, and not by an appeal to the Examiners-in-Chief.

Cäbel, x. p., *Mitchell, Com.*, 22 Nov., 1890, 55 O. G. 863.

15. All appeals in which (under Rule 124) the party only whose claim is affected has a right to be heard, such as questions involving the merits of an invention, go to the Examiners-in-Chief, and, if decided adversely by them, to the Commissioner, and if by him decided

adversely, to the Supreme Court of the District of Columbia. All appeals in which both the Examiner and the applicant have a right to be heard go directly to the Commissioner, and from his decision there is no further appeal.

Zeidler *et al. v.* Leach *et al.*, *Mitchell, Com.*, 19 Jan., 1891, 54 O. G., 503.

16. The Commissioner will not consider an appeal to him direct from action of the Primary Examiner rejecting the application. For that reason the petition is dismissed. If, however, the Examiner has any other reasons why a patent should not be granted, he will state them prior to an appeal to the Examiners-in-Chief, so that the whole case may be brought up on appeal.

Kuhn, x. p., *Simonds, Com.*, 25 Feb., 1892, 28 O. G., 1256.

17. Examiner's refusal to entertain an application as properly a division of an earlier one, is reviewable on petition to the Commissioner, and is not appealable to the Examiners-in-Chief.

Freeman, x. p., *Frothingham, Act. Com.*, 19 Jan., 1892, 58 O. G., 522.

18. Before considering the case for final action the Assistant Commissioner called for separate reports from Examiner and Board, of reasons for their diverse grounds of like action.

In a case where the Examiners-in-Chief affirmed the rejection, but based their conclusions on other references than those cited by the Primary Examiner, and the case, having been appealed to the Commissioner on "the merits," was remanded to the Primary Examiner for consideration and report on relevancy of the references relied on by the Examiners-in-Chief, in connection with such additional evidence as should be submitted by applicant;

and where, thereupon, the Primary Examiner adhered to his original grounds of action: *Held*, that, before final determination by the Commissioner, he should be explicitly advised of the Examiners-in-Chief's reasons for their totally different grounds of action, and the case was accordingly returned to the Examiners-in-Chief.

Rogers, x. p., *Fisher, Act. Com.*, 31 Jan., 1891, C. D. Ms.

NOTE. — In the above case the Assistant Commissioner said: —

In case the Commissioner's action should be adverse to the appellant, and an appeal should be taken to the Supreme Court of the District of Columbia, all grounds appearing by the record to have been taken in the rejection of the application should be shown to the court to have been regularly passed upon by the legally constituted tribunals of the Office.

See ASSISTANT COMMISSIONER; EXAMINER; JURISDICTION; OFFICE PRACTICE.

COMMON KNOWLEDGE.

It appears, from the testimony, that it was not new, at the time of said alleged invention, to use channelled iron in making dash-frames; nor was it new to use dies for swaging or welding together two pieces of iron. All that remained to be done, in the present case as in other cases, was to adapt the form of the dies to the shape desired in the article to be acted upon by them. Dies which act upon two pieces of metal that are capable of being welded to each other, and which are brought to a welding heat, necessarily will weld them together by the impact and action of the dies. All this was old and of common knowledge, and devoid of patentable invention.

Peters *v.* Active M'f'g Co., U. S. S. C. By *Blatchford, J.*, 13 May, 1889, 47 O. G., 1219, ✽.

Compare (29) *et seq.* INVENTION; (1) *et seq.* ORDINARY RESOURCES OF THE ART; and (18) and (21) PUBLIC RIGHTS AND OBLIGATIONS.

COMPOSITION OF MATTER.

1. Effect of Added Ingredient.

A claim for a compound consisting of five different ingredients, designed as an internal remedy for a certain disease, cannot be joined with a claim covering a compound having the same ingredients as the first with the addition of another ingredient, and designed to be used as an external remedy for the same disease, if the additional ingredient in the second claim changes the character of the compound in the first claim both physically and medicinally.

It is contended, on behalf of applicant, that the two compounds are to be used simultaneously, and that they mutually contribute to produce a single beneficial result. This contention is not supported by anything in the specification. Even if there were such support, it is more than doubtful whether that would afford adequate ground for retention of both claims in the case. The mutual dependence and contribution of inventions, designated in Rule 41, cannot properly be held to mean such interdependence as obtains between two remedies for the treatment of a disease which differ in form, composition, and effect.

Nail, x. p., *Frothingham, Act. Com.*, 8 Aug., 1891, C. D. Ms.

NOTE.—It is further manifest that a contention that the ingredient added in the second claim did *not* change the character of the compound set forth in the first claim, would be equally a concession of non-patentability of the subject-matter of said second claim, for there would be an admitted lack of legitimate combination, and hence, of invention.

Compare Crehore *v.* Norton, (71), Tweddles, x. p., (88), THE CLAIM; Dubbs, x. p., (10) COMBINATION; and Crippen, x. p., COMPOUND.

2. It is improper to take two or more references to build up an anticipation of a true combination; but the position that the doctrine of aggregations does not properly apply to compositions of matter cannot be sustained. A [patentable] composition of matter is always a true combination (1 Robinson, Sec. 193).

Hammond, x. p., *Mitchell, Com.*, 31 July, 1891, C. D. Ms.

Compare Dubbs, x. p., (10) COMBINATION.

COMPOUND.

Medicinal.

A remedial compound which is nothing more than such a compound of medicinal agents as could be made by the exercise of the skill of a physician, is not patentable.

Crippen, x. p., *Fisher, Act. Com.*, 24 May, 1890, C. D. Ms.

Compare Dubbs, x. p., (10) COMBINATION; and Hammond, x. p., (2) COMPOSITION OF MATTER.

CONCEPTION.

1. The nascent or incipient invention takes its legal date from the first intelligible disclosure.

Conception must generate an idea of practically operative means, and, in its legal aspects, takes date from the day when those means were disclosed, in intelligible language or by sketches or model, to another person (1 Robinson on Pat's, 534 to 537). The point of time at which [the nascent] invention, in such sense as to merit the protection of the law, dates, is neither when the first thought of it was conceived, nor when the practical working machine is completed; but it is when the thought or conception [of the means] is practically complete, — when it has assumed such shape in the mind that it can be described and illustrated when the "embryo" has taken

some definite form in the mind and seeks deliverance, *and when this is evidenced by description or illustration.*

Cameron *v.* Brick, *Leggett, Com.*, 1 Ap., 1871, C. D. 89.
Compare Ligowski *v.* Peters *v.* Hisey, (8) INVENTION.

2. Perfection of embodiment is not essential to lay a foundation for a claim of priority (Williams *v.* Haile, 40, C. D. Ms., 532). It is sufficient, in such a case, to show a conception of the issue at the time in question.

Gosline *v.* Barney, *Mitchell, Com.*, 9 Nov., 1889, C. D. Ms.
Compare Dickson *v.* Kinsman, (142) INTERFERENCES.

CONCESSION OF PRIORITY.

Where one party to an interference makes a formal concession of priority to his opponent, and a judgment of the Examiner of Interferences is based thereon, such party is estopped from afterward claiming the conceded subject-matter. This decision, however, is made without prejudice to the right of applicant to move to vacate the judgment upon consent of parties, and upon showing that the concession was based upon a mistake of fact.

Eddy, x. p., *Simonds, Com.*, 1 Ap., 1892, 59 O. G., 298.

CONSTRUCTIVE ABANDONMENT.

A broad distinction is to be recognized between constructive abandonment of an application and constructive abandonment of the invention itself; the former may and frequently does exist without involving the latter.

Fowler, x. p., *Mitchell, Com.*, 14 Oct., 1889, 49 O. G., 562.

Compare (2) ABANDONMENT, ETC., and (1), (2), (3), FORFEITURE.

CONSTRUCTIVE DEDICATION.

Nothing is better settled in the law of patents than that the patentee may claim the whole or only a part of his invention, and that if he only claim a part, he is presumed to have abandoned the residue to the public. The object of the law in requiring the patentee to "particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery," is not only to secure to him all to which he is entitled, but to apprise the public of what is still open to *them*. *The claim is the measure of the right to relief*, and, while the specification may be referred to to limit the claim, it can never be made available to expand it (Keystone Bridge Co. *v.* Phœnix Iron Co., 95 U. S., 274, ❁).

McClain *v.* Ortmayer, U. S. S. C. By *Brown, J.*, 2 Nov., 1891, 57 O. G., 1129.❁

CONSTRUCTIVE ELECTION.

1. Estoppel.

Where the Examiner had required a division of the article and the process claims, and thereupon applicant had elected to retain the article claims, and, upon their rejection, sought to re-instate the process claims: *Held*, that applicant could not be permitted to re-instate the process claims, notwithstanding the fact that the Examiner's original action was erroneous, and that the two inventions might have been properly included in the same application. Applicant stands bound by his election.

Jameson, x. p., *Fisher, Act. Com.*, 18 Feb., 1890, C. D. Ms.

2. Where an applicant makes a full assignment of one of two applications, together with a certain inven-

tion common to both applications, he thereby conclusively elects to give the preference to the assigned application, and is estopped from asserting in the unassigned application any claims tenable under the assigned application; and it follows that the assignee is entitled to prosecute the assigned application precisely as if the other application had never been filed.

McLaughlin, x. p., *Mitchell, Com.*, 30 Jan., 1891, C. D. Ms.

Compare Curran *et al. v.* Birdsall, (10), and Adee *v.* Thomas, (11), ASSIGNMENT.

CONSTRUCTIVE LICENSE.

1. Construction, at expense of employer and with the assent of employé, of a machine embodying the invention of the latter, becomes a *Constructive License* to the former to use that particular machine.

In a case where A, while in the employ of B, constructed, at B's expense and for B's use, a machine for which A afterward secured a patent; B is entitled to the use of that particular machine without liability to A, notwithstanding the grant to A of such patent.

Dable Grain Shovel Co. *v.* Flint *et al.*, *Blodgett, J.*, 31 Mar., 1890, 52 O. G., 1537.

2. Where, in a suit for infringement, it appeared that the alleged infringing machines were constructed and put in use in the defendants' grain-elevators by the inventor himself, and with his knowledge and consent, while he was in their employ as superintendent of machinery and before his application for either patent in suit: *Held*, that, according to the expressed terms of the statute, defendants had a right to use these specific machines without paying any compensation to him or his assigns, whether asked for or not.

Ib.

NOTE. — The statute above referred to is as follows : —

Every person who purchases of the inventor or discoverer, or, with his knowledge and consent, constructs any newly invented or discovered machine, or other patentable article, prior to the application by the inventor or discoverer for a patent, or who sells or uses one so constructed, shall have the right to use, and vend to others to be used, the specific thing so made or purchased, without liability therefor.

Sec. 4899 R. S.

See also Kendall *v.* Winsor, (3) *infra*, ❁ ; Sargent *v.* Seagrave, 2 Curt. C. C.; Root *v.* Ball & Davis, 4 M'Lean, 177.

3. If the defendants had these machines constructed before the plaintiff's application for his letters patent, under the belief, authorized by him, that he consented and allowed them to do so, then they might lawfully continue to use the same after the date of plaintiff's letters-patent and the plaintiff would not recover in this action.

Kendall *v.* Winsor, U. S. S. C. By *Daniel, J.*, Dec. Term, 1858, 21 Howard, 322, ❁.

NOTE. — That the right to use those specific machines did not imply a right to use other like machines without authority from the patentee. See Vt. F'm Mach. Co. *v.* Gibson (5), *infra*.

4. Where the inventor of a self-cancelling stamp was in the employ of the Government, and notified the Government that he would make no charge [for Governmental use of the invention], if the Government adopted his recommendation and used his stamp, — for the express reason that he was in the Government employ and had used the Government machinery in perfecting his invention, and that he had never proposed, personally, to make any charge against the Government : *Held*, that his subsequent assignee could not recover [for such Governmental use].

Solomons *v.* U. S., U. S. C. Claims. By *Brewer, J.*, 8 Dec., 1890, 34 L. ed., 667.

5. The constructive license implied in the purchase from the patentee of a creamery with cans for raising cream by his process (practised by water-sealing the cans), gives the purchaser no right to practise the process by water-sealing *other* cans purchased from a different manufacturer.

Vt. F'm. Mach. Co. *v.* Gibson, *Wheeler, J.*, 46 F. R., 488.

CONSTRUCTIVE REDUCTION TO PRACTICE.

1. A patent is conclusive evidence that, in the judgment of the Office, the device claimed has passed beyond the region of experiment, and has been reduced to the practicable and useful form of a perfected invention.

Murrill *v.* Chenoweth *v.* Wheeler, *Fisher, Com.*, 4 July, 1869, C. D. 43.

See also, Duchemin *v.* Richardson, 1870, C. D. 31; Richardson *v.* Denza, 1870, C. D. 156; and Starr & Peyton *v.* Farmer, 23 O. G., 2325.

2. The doctrine that the senior applicant's application for patent clearly describing and claiming the invention is to be regarded as the legal equivalent of the reduction to practice of a completed invention, — applied as being established.

Lowe *v.* Springer *v.* Morse *v.* Granger, *Mitchell, Com.*, 9 Nov., 1889, C. D. Ms.

3. An application which eventuates in a patent constitutes a presumptive reduction to practice. In a contest for priority of invention, the presumption referred to is conclusive against all the parties to the proceeding, because each one is, by the fact of his making a claim to the improvement in dispute, estopped from denying its operativeness and completeness (Heath *v.* Hildreth, McA. Pat. Cas., 12).

Hunter *v.* Jenkin, *Simonds, Com.*, 12 Sep., 1891, 56 O. G., 1705.

4. The theory upon which Rule 114 proceeds is that the filing of an application, which is pronounced by the experts of the Patent Office to be sufficient to authorize the grant of a patent is, for interference purposes, conclusive evidence of perfected invention by the applicant at or before the filing date (Huntley *v.* Smith, 1880, C. D. 182; Starr & Peyton *v.* Farmer, 1883, C. D. 34; Lorraine *v.* Thurmond, 51 O. G., 1781).

Lindsay *v.* McDonough, *Mitchell, Com.*, 27 May, 1891, 55 O. G., 1402.

NOTE. — *L.*, in his petition, demanded award of priority, on the ground of alleged actual reduction to practice, but he presented no testimony to that effect; and, in fact, neither party presented any testimony. Judgment was, therefore, necessarily awarded in *McD.'s* favor, "*on the record*," as the senior applicant, in accordance with Rules 116 and 117.

5. An application or patent relied upon to establish a constructive reduction to practice must contain a *claim* to the invention.

Searle *v.* Frumveller *v.* Sessions, *Frothingham, Act. Com.*, 18 June, 1892, C. D. Ms.

See BURDEN OF PROOF; PRIORITY OF INVENTION; REDUCTION TO PRACTICE.

CONSTRUING CLAIMS.

1. Fair Interpretation.

A claim passed to issue by the Patent Office and acquiesced in by the patentee should not be enlarged by construction beyond the fair interpretation of its terms.

Haines *v.* McLaughlin, U. S. S. C. By *Fuller, Ch. J.*, 19 May, 1890, 34 L. ed., 290, ✽.

Compare, to same purport, Sargent *v.* Hall Safe & Lock Co., ✽, (13) PUBLIC RIGHTS AND OBLIGATIONS.

2. The claims of a patent must, wherever possible, be so construed as to uphold the patent; and, though their language may be faulty in including results as well as devices, yet, where the specific devices are set out in the drawings and specifications, the claims will be construed as for the devices there shown.

Robbins *v.* Aurora Watch Co., U. S. C. C. N. D. Ill., *Blodgett, J.*, 43 F. R., 521.

Compare, of same purport, Corning *v.* Burden, ❁, (48), and McClain *v.* Ortmayer, ❁, (69), THE CLAIM.

3. State of the Art.

Claims of patents should receive such interpretation (whether broad or restricted) as to cover the actual invention when not absolutely inconsistent with the language used by the patentee (Winans *v.* Denmead, 15 Howard, 330, ❁; Van Martyr *v.* Miller, 15 Blatchford, 562). If, upon one hand, the state of the art shows the invention to have been a narrow one, a strict interpretation will be given to the claims (M'f'g Co. *v.* Ladd, 102 U. S., 408, ❁), and *it is of no practical consequence whether such restrictions were imposed by the Patent Office or not* (Toepfer *v.* Goetz, *Blodgett, J.*, 5 July, 1887, 41 O. G., 933). If, upon the other hand, the patentee has taken a decided step in advance of the state of the art at the time his application was filed, courts will, if possible, so construe the language of his claim as to give him the full benefit of his discovery (Turril *v.* R. R. Co., 1 Wallace, 491, ❁; Rubber Co. *v.* Goodyear, 9 Wallace, 788, ❁).

The Consol. Roller Mill Co. *v.* Coombs, *Brown, J.*, 20 May, 1889, 48 O. G., 255.

Of same purport, compare (29) *et seq.* THE CLAIM.

CONSUMMATED INVENTION.

The consummated invention takes date at the point where the work of the inventor ceases and the work of the mechanic begins.

It may still need much patience and mechanical skill, and perhaps a long series of experiments, to give the conception birth in a useful working form. The true date of the [consummated] invention is at the point where the work of the inventor ceases and the work of the mechanic begins. Up to that point he was inventing, but had not *invented*, and he must have invented before the law will come to his protection.

Cameron *v.* Brick, *Leggett, Com.*, 1 Ap., 1871, C. D. 89.

See REDUCTION TO PRACTICE.

Compare Smith *v.* Dent. Vulc. Co., (1), Consol. Valve Co. *v.* Crosby Valve Co., (2), THE DECISIVE STEP. See also Goodyear *v.* Day, (133) INTERFERENCES.

See THE DECISIVE STEP; INVENTION; INVENTIVE ACTS; REDUCTION TO PRACTICE.

CO-OPERATION OF PARTS.

"Co-operation," in the Sense of the Patent Law,—Defined.

The simultaneous co-operation of the parts is not essential to a patentable combination if the parts are so arranged that the *successive* action of each *contributes* to produce some one practical result; this result, when attained, may be the product either of the simultaneous or of the successive action of all the elementary parts viewed as one entire whole. The term "co-operation" does not necessarily mean acting together or simultaneously, but it means acting unitedly to a common end.

Holmes Burg. Al. Tel. Co. *v.* Domestic Tel. Co., *Wales, J.*, 12 Ap., 1890, 51 O. G., 2083.

COTEMPORARY APPLICATIONS WHICH CONTAIN IDENTICAL SUBJECT-MATTER.

Where two applications are before the Office at the same time from the same applicant, which embrace the same subject-matter, it should not be required of the applicant that he abandon one application before claims can be allowed on the other; nor should the Examiner require erasure of claims which would be allowed if no other application awaited consideration (following Langlois, x. p., 14 O. G., 84, and Gabouri, x. p., 37 O. G., 217; and distinguished from Smith, x. p., 44 O. G., 1183).

Feister, x. p., *Mitchell*, *Com.*, 31 Oct., 1890, 53 O. G., 1089.

See Smith, x. p., (11), Langlois, x. p., (12), and Gabouri, x. p., (13), EXAMINATION.

CREATION OF AN ART.

In the inauguration of a new art, both discovery and invention, in the popular sense of these terms, may be involved, — discovery in conceiving the art, and invention in devising the means to make it useful.

What Bell claims, in his patent of March 7, 1876, is the ART of creating changes of intensity in a continuous current of electricity exactly corresponding to the changes in density in the air caused by the vibrations which accompany vocal or other sounds, and of using that electrical condition thus created for sending and receiving articulate speech telegraphically. This claim is not in opposition to the decision in Reilly *v.* Morse (15 How., 62), but is sustained by it; as Bell's claim is not for the use of a current of electricity in its natural state as it comes from the battery, but for putting a continuous current in a closed circuit into a certain specific condition suited to the transmission of vocal and other sounds, and using it in that condition for that

purpose. In doing this both discovery and invention, in the popular sense of these terms, were involved, — discovery in finding the art, and invention in devising the means to make it useful. A patent for the art does not necessarily involve a patent for the particular means for doing it, and the mention of means in the specification is only necessary to show that the art can be used to advantage. Bell's invention comprised: —

1. The *method* of transmitting vocal or other sounds telegraphically, as herein described, by causing electrical undulations similar in form to the vibrations of the air accompanying the said sounds, substantially as set forth.

2. The *apparatus* for transmitting vocal or other sounds telegraphically, as described, by causing electrical undulations, substantially as set forth.

Dolbear *et al. v.* American Bell Telephone Co., U. S. S. C. By *Waite, Ch. J.*, 19 Mar., 1888, 43 O. G., 377, ✽.

CREATIVE WORK OF THE INVENTIVE FACULTY.

With reference to Dennis C. Gately's invention of a vulcanized packing, the Supreme Court (speaking by Mr. Justice Blatchford) said: —

Within the requirements of Atlantic W'ks *v.* Brady (107 U. S., 192, ✽), we think that Gately made a substantial discovery or invention, which added to our knowledge and made a step in advance in the useful arts; and that, within the case of Hollister *v.* Benedict M'f'g Co. (113 U. S., 59, ✽), what Gately did was not *merely* the work of a skilled mechanic, who, perceiving the reason of the failure of McBurney's packing, supplied what was obviously wanting, and that the present case involves, not simply the display of the expected skill of the calling, requiring only the exercise of the ordinary faculties of reasoning upon the materials supplied by a special knowledge and the facility of manipulation which results from its habitual and intelligent practice, — but shows *the creative work of the inventive faculty.*

That the Gately packing went at once into general use, so as almost to supersede all packings made under other methods, was pregnant evidence of its novelty, value, and usefulness (Smith *v.* Goodyear Dental Vulc. Co., 93 U. S., 486, ✿; Loom Co. *v.* Higgins, 105 U. S., 580, ✿). It may also be added that the Gately packing was put upon the market at a price from fifteen to twenty per cent higher than the old packings, although it cost ten per cent less to produce it.

McGowan *et al. v.* N. Y. Belting and Packing Co., U. S. S. C. By *Blatchford, J.*, 26 Oct., 1891, 57 O. G., 845, ✿.

See Scott *v.* Ford, (80) THE CLAIM, and (1) *et seq.* UTILITY.

CROSS-EXAMINATION.

Waives Objection.

Attorney for C. — after having caused to be entered on the testimony-record, a protest against certain witnesses produced on behalf of H. and that any cross-examination would be under said protest, and that he reserved the right to demand expungement of their entire testimony — proceeded to cross-examine said witnesses. *Held*, that said *cross-examination constituted a waiver of the objection*, and that the Examiners-in-Chief did not err in refusing to strike out the testimony (Rule 154).

Creteau *v.* Hall, *Frothingham, Act. Com.*, 17 Nov., 1891, C. D. Ms.

Compare Shapleigh *v.* Chester, (1) TESTIMONY.

CROSS-REFERENCES.

1. In case of a mere improvement, the specification must particularly point out the parts to which the improvement relates, and must, by explicit language, distinguish between what is old and what is claimed as

new; and the description and the drawings, as well as the claims, should be confined to the specific improvement and such parts as necessarily co-operate with it. When applicant files two or more applications relating to the same subject-matter of invention, all showing, but only one claiming the same thing, the applications not claiming it must contain references to the applications claiming it.

P. O. R., 36 and 43.

2. Reference, in the specification of one application to a cotemporary pending application for a fuller description, is not permissible. *It cannot be assumed* that the application referred to will mature into a patent.

Borgfeldt, x. p., *Mitchell, Com.*, 23 Sep., 1889, 49 O. G., 132.

3. A reference to another pending application for a description of the machine to which the present improvement relates, does not satisfy Rule 36. Applications pending in the Office are no part of the prior art, and may not be resorted to in order to supplement a description which would otherwise be insufficient.

Chadwick, x. p., *Mitchell, Com.*, 12 Feb., 1890, 57 O. G., 124.

Compare Fowler, x. p., (1) ABANDONED APPLICATION.

DAMAGES.

1. The amount of fee which plaintiff customarily collects from his licensees may be the measure of damages against an infringer.

When the sale of a license by a patentee has been sufficient to establish a price for such licenses, that price should be the measure of his damages against an infringer; but a royalty or a license fee, to be binding on

a stranger to the licenses which established it, must be uniform.

Westcott *v.* Rude, *Woods, J.*, 1 Ap., 1884, 27 O. G., 719.

2. Fees exacted under a qualified license are not a suitable criterion for assessment of damages against an infringer.

Agreements made to secure the manufacture and introduction of a patented machine are not to be considered as unqualified licenses fixing a royalty or license fee, which can be accepted as establishing within the language of the court in Seymour *v.* McCormick (16 How. 480, ❁) the average of actual damages sustained by a patentee when his invention is used without license.

Graham *v.* Geneva M'f'g Co., *Dyer, J.*, 10 May, 1885, 32 O. G., 1603.

3. In cases of *wilful* infringement, respondent should be held to the most rigid accountability, and the measure of damages may be the profits which would have accrued to the complainants upon the quantity of goods sold by respondent.

Bigelow Carpet Co. *v.* Dobson, *McKennan, J.*, 27 Jan., 1882, 21 O. G., 1200.

4. While a license fee affords proper guidance in the ascertainment of damages, yet regard should be had also to the qualifying circumstances of the case, to the end that the finding may be for the *actual damages* sustained by the plaintiff agreeably to the principles announced by the Supreme Court in Birdsall *v.* Coolidge (93 U. S., 64, ❁).

Keller *v.* Stolzenbaugh, U. S. C. C. W. D. Pa., 43 F. R., 378.

DATE OF ISSUE.

As a U. S. Patent, to be valid, must issue not later than six months from allowance (Rev. Stat., 4885, 4935) and as preparations for printing the drawing and specification do not take place until receipt of the final fee, payment thereof should be made at least three weeks before the expiration of said six months. The Office will, it is true, on receipt of fee any time within six months after allowance, but too late for issue within the six months, save the application from forfeiture by a new letter of allowance, but it is manifestly desirable to avoid this added complication, with its chances of oversight and error.

See P. O. R., 167.

DECEASE OF INVENTOR.

1. Prosecution of Decedent's Application.

The general law governing prosecution of the case of a deceased person is seen in the following section: —

When either of the parties . . . in any suit in any court of the United States dies before final judgment, the Executor (or Administrator) of such deceased party may (in case the cause of action survives by law) prosecute or defend such suit to final judgment.

Sec. 955 R. S.

2. The application of the law to Patent Office procedures is seen in the following Section of the Revised Statutes and Patent Office Rule: —

When any person, having made any new invention or discovery for which a patent might have been granted, dies before the patent is granted, the right of applying for and obtaining the patent shall devolve on his Executor (or Administrator) in trust for the heirs, . . . and when the application is made

by such legal representative, the oath or affirmation required to be made shall be varied in form so that it can be made by such representative.

Sec. 4896 R. S.

Rubber Co. *v.* Goodyear, 9 Wallace, 788, ✽.

In case of the death of the inventor, the application will be made by, and the patent will issue to, his Executor (or Administrator). In such case the oath required by Rule 46 will be made by the Executor (or Administrator). In case of the death of the inventor during the time intervening between the filing of his application and the granting of a patent thereon, the letters patent will issue to the Executor (or Administrator) upon proper intervention by him.

Rule 25, — as amended 23 Jan., 1893.

See De La Vergne *v.* Featherstone, (11) THE PATENT.

NOTE. — Proper evidence of the executorship (or administratorship) must, of course, be filed in the case.

3. Where the record shows that, at the time of applicant's decease, there was a conveyance of the entire interest, the right to prosecute the application and to receive the patent devolves on the assignee.

Sec. 4895 R. S.

Rule 26. — N. W. Fire Extin'r Co. *et al. v.* Phil. Fire Extin'r Co. *McKennan, J.*, Ap., 1880, 6 O. G., 34; Galer *v.* Wilder, 10 Howard, 477, ✽. *Re* Samuel J. Murray, (1), Wirth, (2), ASSIGNEE; Davis, x. p., (6) ATTORNEY.

4. In case of a joint (or of a partially assigned) application there is a joinder, both of powers and interests, between the surviving applicant (or the assignee) on his own behalf, and the executor (or administrator) on behalf of the decedent's estate.

Rules 26 and 28.

Hunter, x. p., (4), Waterman *v.* Mackenzie, (5), and Whitcomb *v.* Coal Co., (6), ASSIGNEE.

THE DECISIVE STEP.

1. Patentability conferred by the Final and Perfecting Step. — Test of Public Adoption.

We do not say that the single fact that the device has gone into general use and has displaced other devices which had previously been employed for analogous uses, establishes in all cases that the device involves a patentable invention. Such a fact may, however, always be considered, and when other facts in the case leave the question in doubt, it is sufficient to turn the scale (McGowan *v.* N. Y. Belting Co., 141 U. S., 332, 57 O. G., 845, ✵.

Smith *v.* Dental Vulc. Co., U. S. S. C. By *Strong, J.*, 8 Jan., 1877, 93 U. S., 486, ✵.

2. Richardson's invention brought to a success what other inventors had essayed and partly accomplished. He used, it is true, some things which had been used before, but he added *just that* which was necessary to make the whole a practically valuable and economical apparatus. The fact that the known valves were not used, and that Richardson's valves were speedily and extensively adopted, are facts in harmony with the evidence that his valve contained just what the prior valves lacked, and go to support the conclusion at which we have arrived on the question of patentable novelty.

Consol. Valve Co. *v.* Crosby Valve Co., U. S. S. C. By *Blatchford, J.*, 19 Jan., 1885, 113 U. S., 157; 30 O. G., 991, ✵.

Compare Scott *v.* Ford, (80) CLAIM; Cameron *v.* Brick, CONSUMMATED INVENTION; McGowan *v.* N. Y. Belting Co., CREATIVE WORK OF THE INVENTIVE FACULTY; Bruce *v.* Marder, (1), and Washburn & Moen Co. *v.* Barbed Wire Co., (12), UTILITY.

DECREE OF COURT.

1. Sections 629 and 4915 R. S.

The section (4915 R. S.) under consideration having but a single object, namely, to provide a way by which an unsuccessful [but meritorious] applicant may obtain the patent through an adjudication in favor of his right thereto by a Court of Equity having cognizance of the subject-matter, and as the object of the section is single, so is the power of the court plainly limited under it to the accomplishment of that object. The prayer of a bill of complaint exhibited to the Court under and by virtue of this section, would be for a decree that the complainant has established his right to have the patent issue to him. So far may the Court go, but no farther. The Commissioner of Patents, not being an inhabitant of this judicial district (New Jersey), cannot (under Sec. 629 R. S.) be brought within its jurisdiction.

Illingworth *v.* Atha, U. S. C. C., N. J., *Green, J.*, 25 Mar., 1890, 42 F. R., 141.

See, of like purport, Butterworth *v.* Hill, (13) JURISDICTION.

2. Where patent had been refused by the Patent Office, and applicant availed himself of his remedy by bill in equity, and the Court, after notice to adverse parties and other due proceedings, had, having adjudged that the applicant was entitled to a patent for his invention, and the applicant having filed in the Patent Office a copy of the adjudication in which were specified the claims for which it authorized the Commissioner to grant a patent: *Ordered*, that, in accordance with Section 4915 R. S., a patent be issued to the applicant for his invention as specified in his claims, upon his complying with the requirements of the law.

Daniels, x. p., *Mitchell, Com.*, 10 Jan., 1891, 54 O. G., 1113.

NOTE (i). — The patent to Daniels, above referred to, was issued in obedience to a decree of the United States Circuit Court for the District of Massachusetts. Daniels' application had been in interference with an application of one Morgan, and, after issue of the patent to Daniels, Morgan's attorney filed an appeal to the Supreme Court of the United States. At the time of going to press this appeal had not reached a hearing.

NOTE (ii). — The case of Daniels, x. p., will be seen to differ from such as that of Butterworth *v.* Hill, ✱, (13) JURISDICTION, and that of Illingworth *v.* Allen, (1) *supra*, in that the Commissioner was not made by the complainant (Daniels) a party defendant to the suit. In Daniels' case the Commissioner, in putting Daniels' application in train for issue, as directed by the Court, acted in a simply ministerial capacity.

Compare Daniels *v.* Morgan, (4) JURISDICTION.

DEDICATION.

1. By Showing and Describing without Claiming.

An inventor cannot, in a subsequent patent, claim matter that was shown and described, but not claimed, in an earlier patent.

Hill & Prentice, x. p., *Marble, Com.*, 26 Ap., 1883, 24 O. G., 1176.

NOTE. — For important qualifications of the above general rule see Suffolk Co. *v.* Hayden, ✱, (6) *infra*, which permits such matter to be claimed in a later patent, providing: (i) the application therefor was filed before issue of the earlier patent, and (ii) providing the earlier patent contain an express reservation of such claim or claims for such later patent. In Scott, x. p., (12) ABANDONMENT, it was ruled that such claim may be included in a later patent *if promptly applied for*, even in the absence of express reservation in the earlier patent.

In Johnston, x. p., (2), and likewise in Mullen & Mullen, x. p., (3) *infra*, it was held that a claim to matter which had been shown or described, but neither claimed nor reserved in the earlier patent, would hold good *if for a totally distinct invention* from that claimed in the earlier patent. The general rule laid down in Hill *v.* Prentice seems qualified in still another aspect by the dictum of Commissioner Simonds in Rogers, x. p., (2) PRIOR ART, which held the Examiner to have been "in error in citing a former patent of the same applicant as a part of the prior art." The ruling of the same Commissioner in the case of Scott, *supra*, and that of Rennyson *v.* Merritt, (5) *infra*, would seem to imply that the requirement of incorporation in one application of a claim to a feature described but not claimed in a cotemporary application is directory only, and that the inadvertent omission so to do is not necessarily fatal, providing application be made promptly and in good faith and before conflicting rights have intervened. For instructive commentary on the distinction between reserved and dedicated rights, see ruling of Commissioner Mitchell in Stanford, x. p., RESERVATION, — DESIGNATION.

2. A patentee who in a prior patent showed, but did not claim, a certain invention which is distinct and separate from that claimed in said patent, and which could not have been prosecuted in that application, did not thereby necessarily dedicate that invention to the public.

Johnston, x. p., *Hall, Com.*, 20 Mar., 1889, C. D. Ms.

3. An invention — absolutely independent of that claimed in the patent — which was described and shown in the specification, but was not [expressly] reserved for claim in either a concurrent or a subsequent application, was not thereby dedicated to the public. For example; a prior patent granted to applicant for certain details in the feed-regulating mechanism of a grain-drill, *Held* to be no bar to a subsequent application for patent for an

improvement in grain-drill teeth which said prior patent disclosed but did not claim. The two inventions being independent, there was no dedication of the improvement from failure to claim it in the prior patent.

Mullen & Mullen, x. p., *Mitchell, Com.*, 28 June., 1890, 50 O. G., 637.

4. It must be remembered that the claim [by the patentee] of a specific device or combination and an omission to claim other devices or combinations apparent on the face of the patent, imply an admission that the latter are not his invention, or constitute a dedication of them to the public. This legal effect of the patent cannot be revoked unless the patentee promptly surrenders it, and proves that the specification was so framed by real inadvertence, accident, or mistake, and without any fraudulent or deceptive intention on his part. If two years' public enjoyment of an invention with the consent and allowance of the inventor is evidence of abandonment and a bar to application for a patent, a public disclaimer [disclaimer by implication] in the patent itself should be construed equally favorable to the public.

Edward Miller & Co. *v.* The Bridgeport Brass Co., U. S. S. C. By *Bradley, J.*, 9 Jan., 1882, 21 O. G., 201, ✽.

5. Where an applicant claims an improvement which is shown but not claimed in his prior patent, and the application was pending before the patent issued, the Office is not justified by existing court decisions in finding that the disclosure in the patent bars the claim in the application (Thomson *v.* Waterhouse, 30 O. G., 177).

Rennyson *v.* Merritt, *Simonds, Com.*, 29 Feb., 1892, 58 O. G., 1415.

6. Where a party, having made application for patent for certain improvements, afterwards, with his claim still on file, makes application for another but distinct

improvement in the same branch of art, in which second application he describes the former improvement, but does not in said second application claim it as original: the description in said second application and non-claim of it there is not a dedication of the first invention to the public. Judgment for complainant affirmed.

The Suffolk Co. *v.* Hayden, U. S. S. C. By *Nelson, J.*, Dec., 1865, 3 Wallace, 315, ❁.

DEFAULT.

Where, upon appeal from the denial of a motion to dissolve, and where neither party appeared at the hearing or filed a brief: *Held*, that it could not be expected that, with the limited time at his disposal, the Commissioner should investigate the intricate questions involved, with no assistance whatever from the parties or their counsel, and the decision of the Primary Examiner was therefore affirmed.

Jones *v.* Collins, *Mitchell, Com.*, 21 Jan., 1891, C. D. Ms.

DEFECTIVE PATENT.

A document issued by the Commissioner of Patents in the form and guise of a patent, but which lacked the signature of the Secretary of the Interior (by whom, or by his assistant in his absence, all patents must be signed), is *no patent* and without legal force, and, even if the defect be subsequently cured, cannot act retrospectively, but becomes effective only from the date of correction. Thus limited, such patent is in harmony with the law relating to re-issues which allows the inventor, upon surrender of his patent with a defective specification, to have a new patent for the remainder of his term.

Marsh *v.* Nichols, U. S. S. C. By *Field, J.*, 10 Dec., 1888, 46 O. G., 239, ❁.

Compare Marsh *v.* Sheppard, U. S. S. C. By *Field, J.*, 10 Dec., 1888, 128 U. S. 605, ❁.

DEFECTIVE PRINCIPLE.

A wide distinction is to be recognized between a machine defective by fault of principle and one defective by fault of construction or proportions. From the former, a subsequent successful machine is patentably different; while a machine defective only in structure or proportions may be, and often is, identical in a patentable sense, in plan, mode of operation, and function, with the subsequent practical device.

Gosline *v.* Barney, *Mitchell, Com.*, 9 Nov., 1889, C. D. Ms.

DELAY.

1. In Filing Amendment.

Where the Office had called the attention of an applicant to his right to cover in his claim certain specific matter, and advised him to amend accordingly, and the applicant, without doing so, entered into an interference contest on the broad issue, in which he was finally defeated, he cannot, after acquiescing for a long period in such award of priority and waiting nearly ten years after filing his application, return to the Office for the purpose of submitting such amendment, which, if admitted, would result in a new interference.

Gray, x. p., *Hall, Com.*, 23 Feb., 1889, 46 O. G., 1277.
Compare Spielman, x. p., (22) INTERFERENCES.

2. Where an amendment touching "the merits" is presented nearly two years after the case is in condition for appeal to the Examiners-in-Chief, and no showing or attempt at any showing whatever is made why the amendment was not presented earlier: a petition that the case be re-opened and that applicant be heard upon the amendment must be denied.

Cordrey, x. p., *Mitchell, Com.*, 6 July, 1889, 48 O. G., 397.

3. In Reduction to Practice.

Failure for more than two years after conception to do anything to reduce the invention to practice could not be excused where the only reason assigned for the inaction was engagement in other matters.

Lowe *v.* Springer *v.* Morse *v.* Granger, *Mitchell, Com.*, 9 Nov., 1889, C. D. Ms.

Of like tenor, see Ligowski *v.* Peters *v.* Hisey, (50), Hunter *v.* Jenkin, (53), and Thomson *v.* Ries, (55), INTERFERENCES.

4. Motion to amend a preliminary statement after a delay of four months and a half, — denied.

Gornall *v.* Lovejoy, *Simonds, Com.*, 12 Aug., 1891, 56 O. G., 927.

Compare Wood *v.* Parsons, (29) INTERFERENCES.

DELIBERATION.

1. Postponement of application to gain time for actual test of and for careful specification of the invention, — commended.

It is undeniably true that the limited and temporary monopoly granted to inventors was never designed for their exclusive profit or advantage: *the benefit to the public or community at large* was another, and, doubtless, *the primary object* in granting and securing that monopoly. This was, at once, the equivalent given by the public for the benefits bestowed by the genius, meditations, and skill of individuals, and the incentive to further efforts for the same important objects.

But the relations borne to the public by inventors, and the obligations they are bound to fulfil in order to secure from the former protection and the right to remuneration, by no means forbid a delay requisite for completing an invention, or for a test of its value or

success by a series of sufficient and practical experiments; nor do they forbid a discreet and reasonable forbearance to proclaim the theory or operation of a discovery during its progress to completion, and preceding an application for protection in that discovery: the former may be highly advantageous as tending to a perfection of the invention; the latter may be indispensable in order to prevent a piracy of the rights of the true inventor.

Kendall *et al. v.* Winsor, U. S. S. C. By *Daniel, J.*, Dec., 1858, 21 Howard, 322, ✱.

2. Forbearance to apply for a patent during the progress of experiments and until the party has perfected his invention and tested its value by practical experiment, affords no ground for presumption of abandonment.

Agawam Co. *v.* Jordan, U. S. S. C. By *Clifford, J.*, Dec., 1869, 7 Wallace, 583, ✱.

3. A use by the inventor [more than two years prior to application] for the purpose of testing the machine, in order, by experiment, to devise additional means for perfecting the success of its operation, is admissible; and even where, as incident to such use, the product of its operation is disposed of by sale, such profit from it does not change its character.

Smith & Griggs M'f'g Co. *v.* Sprague, U. S. S. C. By *Mathews, J.*, 123 U. S., 249, ✱.

See also City of Elizabeth *v.* The Nicholson Pavement Co., 7 Otto, 126, (4) DEDICATION, ✱.

DESCRIPTION.

See DISCLOSURE; THE SPECIFICATION.

DESCRIPTIVE CHARACTERS.

1. The different views on the drawing of a U. S. patent should be consecutively numbered. Letters and figures of reference are required to be carefully formed. They should, if possible, measure $\frac{1}{8}$ inch in height (so that they may bear reduction in the Official Gazette to $\frac{1}{2}\frac{1}{4}$ inch), and they may be much larger when there is sufficient room. They must be so placed in the close and complex parts of drawings as not to interfere with a thorough comprehension of the same, and therefore should rarely cross or intermingle with lines. When necessarily grouped around a certain part, they should be placed at a little distance, where there is available space, and be connected by short broken lines with the parts to which they refer. They must never appear upon shaded surfaces, and, when it is difficult to avoid this, a blank space must be left in the shading where the letter occurs. The same part or member appearing in different views must always be represented by the same character, and the same character must never be used to designate different parts.

P. O. R., 51 (6).

2. The parts must be sufficiently designated by letters or other symbols, to convey a clear comprehension of the device.

Brogfeldt, x. p., *Mitchell*, *Com.*, 23 Sept., 1889, 49 O. G., 132.

3. Present Rule 51 prohibits the use of the same reference symbol (letter or numeral) to designate parts which, although claimed to be equivalents, are, nevertheless, different in structure. If alternative constructions or modifications are shown, a permissible method is to employ the same letter with an appended figure or exponent, — as A, A′, A″, A‴, — thereby conforming to

the rule and at the same time suggesting the presence of similarity and the absence of sameness.

Cook, x. p., *Mitchell, Com.*, 12 Ap., 1890, 51 O. G., 1620.

4. Where "an inverted V" [∧] was used to designate a form involved in the application, and the Examiner required descriptive language instead of it: *Held*, that a valid objection to such a character could be raised only on one of two grounds, —(i) that it was not descriptive in such full, clear, and exact terms as to enable any one skilled in the art to construct the form from it (R. S., 4888), or (ii) that it cannot be properly represented in the specification by the ordinary resources of the printer; and that, as the character was an exact representation of the shape in question and could be readily printed, the position of the Examiner could not be sustained.

Krueger, x. p., *Fisher, Act. Com.*, 12 May, 1890, C. D. Ms.

5. Upon requirement of the Examiner that modified forms of certain bars should be designated by different reference letters: *Held*, that as the difference was not one of kind, but only of degree, it did not require different reference letters (Kook, x. p., 1879, C. D. 202; Emanuel, x. p., C. D. 40, Ms. 240; Wilcox, x. p., C. D. 44, Ms. 428).

Wiles & Wendell, *Frothingham, Act. Com.*, 15 Feb., 1892, C. D. Ms.

6. Rule 51 (6) is imperative that if more than one view is presented of a given article, the corresponding portions of the different figures must always be represented by the same character; but it does not require a diverse lettering of such parts or members which vary only in respect of connecting or attaching devices, which latter, so far as they differ in the different figures, are

also lettered differently. I have in this case undertaken to apply the distinctions recognized in Kook *et al.*, x. p., (1879, C. D. 202) between modifications that disclose patentable differences and modifications that disclose differences not patentable. The difficulty of doing so is recognized and is very apparent; but the rule of distinction is in that case clearly laid down, and should be applied in similar cases.

Wilcox, x. p., *Mitchell, Com.*, 21 Nov., 1890, C. D. Ms.

7. Such details as the shading of the drawing and the place and size of the reference letters, belong to the province of the Draftsman rather than the Examiner; but if they are such as to obscure the parts and thus render examination troublesome, the Examiner has a right to insist upon a correction.

Heidbrink, x. p., *Fisher, Act. Com.*, 8 Ap., 1890, C. D. Ms.

See THE DRAWING.

DEVIATION.

In reducing his patent to a practical application, a patentee is not held to follow, strictly and entirely, the mere mechanical device shown in his drawings, but he may deviate as long as he does not violate the principle involved in his patent.

Weir *v.* N. Chic. Rolling Mill Co., *Blodgett, J.*, Oct., 1880, 23 O. G., 191.

See also Hill & Prentice, x. p., *Marble, Com.*, 26 Ap., 1883, 24 O. G., 1176.

DICTUM.

Upon an application for label registration, the Examiner of trade-mark and label applications has to decide only the question whether or not the matter presented to him is registrable as a label; and any opinion which he may express as to the propriety of covering the mat-

ter by a mechanical application is purely *dictum*, and cannot bind the Examiner before whom comes the question of patentability in regular order.

Eiche, x. p., *Fisher, Act. Com.*, 26 Oct., 1889, C. D. Ms.

DISCOVERY.

A court in equity has the inherent power, on motion of the complainant, to grant him an order of inspection of the apparatus in possession of the defendant which is alleged to embody the invention in controversy, to the end that the complainant may be enabled to adduce evidence in support of the allegations of his bill.

Wilson *v.* Keely, Phil'a Court of Common Pleas, *Finletter, J.*, 16 Mar., 1888, 43 O. G., 511.

DILATORY METHODS.

1. By Examiner.

While the recommendations of the Examiners-in-Chief are not binding upon the Primary Examiner, there is, nevertheless, no good reason why an applicant should be put to the delay of a second appeal simply to have the Examiners-in-Chief formally affirm what they have already decided in substance.

Williamson, x. p., *Simonds, Com.*, 20 Aug., 1891, 56 O. G., 1060.

NOTE. — The Primary Examiner was directed to allow the application as amended in conformity with the recommendation of the Examiners-in-Chief; with permission to note on the record that his said action was made in compliance with a mandate of the Commissioner based upon said recommendation.

Of like tenor, see Donavan, x. p., (1) EXAMINATION; and Anderson, x. p., (2) EXAMINER.

2. By an Applicant. — Dilatory Tactics.

Petition for suspension of an interference, in order that the question of patentability of a newly offered claim might be considered, denied; it appearing that the same interference had been previously suspended by the same petitioner for nearly two years *for the same ostensible purpose.*

Holt *v.* Mills, *Simonds, Com.*, 19 Aug., 1891, 56 O. G., 1059.

3. To negative abandonment of an application pursuant to provisions of Section 4894, R. S., applicant was required to show, to the satisfaction of the Office: (*i*) that the failure to prosecute within two years from notice of the last action was unavoidable in *each and every part* of this period; (*ii*) that the delay of action, subsequent to the expiration of two years, was also unavoidable. (*iii*) It is a general rule of law that a party is bound by the deliberate acts of his attorney (Robinson, Sec. 435); hence the neglect imputed by applicant to his attorney, even if proven, would not excuse the delay, and therefore the alleged neglect of the attorney in this case did not render the delay unavoidable (Binford, x. p., C. D. 45, Ms. 320; Pratt, x. p., 1887, C. D. 31). It did not appear, from the showing made, that applicant's financial condition *during the whole period of delay* was such as to excuse the failure to prosecute. Petition denied, — without prejudice.

Murray, x. p., *Frothingham, Act. Com.*, 5 June, 1891, 56 O. G., 1060.

4. A petition for revival of an abandoned application should aver facts [which should be established at the hearing] showing that the delay *for the whole period,* from the last official action to the filing of the petition, was unavoidable. Petition was denied, — without prejudice.

Edison, x. p., *Frothingham, Act. Com.*, 17 June, 1891, 56 O. G., 1061.

5. An application will not be withdrawn from issue if such withdrawal will have the effect of directly or indirectly extending the time allowed by law for the payment of the final fee. — Petition denied.

Brand, x. p., *Frothingham, Act. Com.*, 18 July, 1891, 56 O. G., 1062.

Compare Donavan, x. p., (10) AMENDMENT; Epstein, x. p., (3) APPLICATION; and Price, x. p., (20) PUBLIC RIGHTS, ETC.

DILIGENCE.

1. Of two or more contestants for patent, questions of diligence affect only the earliest to conceive the nascent invention. A later conceiver has no status unless first to reduce to practice.

No matter what degree of diligence he may have manifested, the second conceiver has not even a *prima-facie* right to the patent unless he was the first to reduce to practice; and if he has anticipated the other in reduction, it is on this ground, and *this only*, that his claims are based. The law regards him with no such indulgence as it does the first conceiver. It takes no notice of the difficulties with which *he* has contended, nor of the efforts which *he* may have made to confer the benefit of the invention on the public. The *fact* that he *has* so conferred is sufficient, *in the absence of reasonable diligence on the part of the prior conceiver*. But earlier reduction avails the second conceiver nothing if the first has properly endeavored to complete [and has, in fact, completed] his own inventive act, and thus fulfilled the obligation which the law imposes upon him. Hence there can be no comparison of diligence as between rival inventors; no "race of diligence" in any sense of a competing effort to obtain a prize.

1 Robinson, 544, and cases there cited.

For evidence of completed invention afforded by application in interference, see Lindsay *v.* McDonough, (4) CONSTRUCTIVE REDUCTION TO PRACTICE.

2. No "Race of Diligence."

Respecting the matter of diligence, as bearing upon the question of priority, I do not regard it as comparative, or as it is sometimes termed a "race of diligence," where one was first to conceive and the other to reduce to practice.

Millward *v.* Barnes, *Spear, Com.*, 13 Mar., 1877, 11 O. G., 1000.

3. If the first person to adequately conceive and disclose an invention actually reduces it to practice, and connects his conception and completion by such diligence as his circumstances and the character of the invention admit of, his right to a patent cannot be defeated by any amount of diligence in coming to the Office of an inventor whose conception is of later date.

Hunter *v.* Miller, *Mitchell, Com.*, 13 Mar., 1890, 50 O. G., 1765.

4. In cases involving priority of invention, it is well settled that the party second to conceive the [nascent] invention does not prevail by virtue of his own diligence, but by reason of the lack of diligence on the part of his competitor in adapting and perfecting the invention (Merwin on Patents of Invention, Sec. 301; Lorraine *v.* Thurmond, 51 O. G., 1781).

Holmes & Holmes *v.* Coler, *Mitchell, Com.*, 21 July, 1890, C. D. Ms.

5. "Reasonable Diligence."

It has been held, in interference contests, that the "reasonable diligence" exacted of the party who was first to conceive, means only that he shall have used such efforts as a careful man would ordinarily use in attending to matters of business. That there was no *intention* to abandon makes no difference, and [for the purposes of the

interference] it makes no difference whether or not a new application is precluded by reason of the subject-matter having been in public use more than two years.

Field, x. p., *Fisher*, *Act. Com.*, 4 Jan., 1890.

NOTE. — Where question of abandonment of the invention by two years' public use arises in course of an interference proceeding, such question is placed in abeyance until after the interference contest is disposed of, upon which it becomes a purely *ex parte* question between the Office and the successful contestant.

Compare Butterfield *v.* Curtis, (18), Hunter, Jr., *v.* Lane, (65), and Cook *v.* Leach, (98), INTERFERENCES.

6. The "reasonable diligence" demanded [from the inventor who establishes first conception] to avoid forfeiture to a rival inventor, is something differing from and greater than that required of the inventor of a completed invention, in order to avoid abandonment to the public. The two things are specifically and differently stated in the statutes.

Thomson *v.* Ries, *Simonds*, *Com.*, 14 Nov., 1891, 59 O. G., 298.

7. A review of all the cases, in connection with the language of the statute, satisfies me that if the first person to conceive would prevail over his rival who has first reduced the invention to practice, he must show: (*i*) that he was using reasonable diligence in adapting and perfecting the invention when his competitor entered the field; (*ii*) that his diligence antedates the inceptive invention of his rival; (*iii*) that his diligence extends back to his own conception.

Christie *v.* Seybold, *Mitchell*, *Com.*, 10 Feb., 1891, 54 O. G., 957.

See also Gray *v.* Hale (9), *infra*.

8. The question of reasonable diligence in any particular case is dependent on various considerations, such as the nature of the invention (City of Elizabeth *v.* The Nicholson Pavement Co., 7 Otto, 126, ✿; Johnson *v.* Root, 2 Cliff. 108; White *v.* Allen, 2 Cliff. 224), and the circumstances of the inventor, etc. (Morse *v.* Clarke, 1 O. G., 275).

Hunter *v.* Miller, *Mitchell, Com.*, 13 Mar., 1890, 50 O. G., 1765.

9. Where there has been delay in application of the first inventor until after a subsequent inventor had reduced and applied, it becomes incumbent upon the former to show persistent intention to apply for patent as promptly as circumstances permitted.

Gray *v.* Hale, *Duncan, Act. Com.*, 27 May, 1871, C. D. 129.

See also Monce *v.* Adams, *Duncan, Act. Com.*, 1 O. G., 2; and Habel *v.* Tucker, *Shipman, J.*, 16 July, 1886, 36 O. G., 939.

10. Where the first to conceive did nothing for nearly two years thereafter, and failed to give a satisfactory reason for not filing his application sooner, and neither party had reduced to actual practice: *Held*, that the one who, although later in the field, had constructively reduced to practice by being the first to apply in due form for a patent was entitled to award of priority.

Bentley *v.* Wightman *v.* Sprague, *Mitchell, Com.*, 19 Mar., 1890, C. D. Ms.

Compare Christie *v.* Seybold, (7) *supra*, and (1) *et seq.* CONSTRUCTIVE REDUCTION.

11. Where there were two interferences between the same parties on applications which described the same subject-matter, and where with each inventor both process and apparatus were necessarily invented together, and consequently there was but one question at issue,—

Thomson's application (14 June, 1889) for a patent on the *apparatus* being put in interference with patent granted to Ries, 14 May, 1889; Ries' application (10 Dec., 1888) for a patent on the *process* being put in interference with patent granted to Thomson, 8 Jan., 1889, — Thomson, who was the first to conceive and disclose the incipient idea, and who made the earliest application for patent, suffered fifteen months to elapse before reduction to actual practice, and twenty months before making said application for patent. Ries' actual reduction, ante-dating both the actual and the constructive reduction of Thomson, threw the burden of diligence wholly on the latter as the first conceiver; and Thomson being adjudged not to have employed reasonable diligence, priority was awarded to Ries.

Thomson *v.* Ries, *Simonds, Com.*, 14 Nov., 1891, 59 O. G., 298.

NOTE (i). — The issues were: —

PROCESS INTERFERENCE.

The herein-described method of riveting, consisting in heating the rivet or rivet-blank electrically while in place, and then heading either or both ends of the same.

APPARATUS INTERFERENCE.

An electric riveting apparatus, consisting essentially of a metallic anvil and a metallic heading tool, and a charged electric circuit including the anvil and tool, substantially as described.

NOTE (ii). — The almost equally prolonged tardiness of Ries was not charged against him, because diligence is exacted from the senior inventor only, and therefore Ries, as junior inventor, had simply to establish first reduction. See Christie *v.* Seybold, (7) *supra*, and (1), (2), (3), (4) DILIGENCE.

12. Where an applicant had delayed for more than two years after his conception of invention [in interference] before reducing it to practice, and where it appears that he had abundant means and was busy

meanwhile upon other inventions, and the actual reduction to practice was a simple matter and one not involving great time or expense: *Held*, applicant had not been reasonably diligent.

Ib.

13. Time spent on other inventions does not excuse delay.

Time spent on other inventions does not excuse delay otherwise unreasonable (Wickersham *v.* Singer, 1 *McA. P. C.*, 645).

Hunter *v.* Jenkin, *Simonds, Com.*, 12 Sep., 1891, 56 O. G., 1705.

Compare Barnes *v.* Clinton, (3), and Wicks *v.* Dubois, (4), ABANDONED EXPERIMENTS. See also Thomson *v.* Ries, (12) *supra*, and Wickersham *v.* Singer, (14) *infra*.

14. Circumstances to extenuate Delay.

If a man be utterly destitute of money and without friends, and be incapable thereby of prosecuting an enterprise, much indulgence may be shown him; but where he has the means of carrying on sundry enterprises of a kindred sort, equally demanding money and friends, and does carry them on, his election to pursue those other enterprises will not, under the patent law, be regarded as an excuse for delay where valuable rights of others — equally meritorious with himself, and, in the outset of their successful struggles, equally poor — are to be prejudiced. An election thus made for his supposed advantage or gratification at the time must, according to the plainest principles of equity, not be invoked for the subsequent detriment of another innocent party.

Wickersham *v.* Singer, 1 *McArthur Pat. Cas.* 645.

15. The question whether due diligence was exercised depends in a great degree upon the personal circumstances of the inventor. The rule is well stated in Merwin on Patents, page 697 (see also Lowe *v.* Springer *v.* Morse *v.* Granger, 1 Gourick, 84; and Illingworth *v.* Atha, *Mitchell, Com.*, 22 Nov., 1889).

Bentley *v.* Wightman *v.* Sprague, *Mitchell, Com.*, 19 Mar., 1890, C. D. Ms.

16. In determining the question of diligence of an inventor first to conceive, the circumstances in which he was placed and the facilities at his command are always to be considered (McCormick Harvester Mach. Co. *v.* Minneapolis Harvester Works, *Nelson, J.*, 42 F. R., 152; Hunter *v.* Miller, *Mitchell, Com.*, 50 O. G., 1765).

Brahn *v.* Snow *v.* Hopkins & Bryant, *Fisher, Act. Com.*, 29 Dec., 1890, C. D. Ms.

17. Where, in an affidavit filed under Rule 75, petitioner averred that he had used "every diligence possible in putting the invention into use": *Held*, that a mere statement of this character, unaccompanied by any facts which tend to show such diligence, is not a sufficient compliance with the rule as interpreted by the Office (Gasser, x. p., 1880, C. D. 94; Saunders, x. p., 1883, C. D. 23).

Hunter, x. p., *Fisher, Act. Com.*, 23 Oct., 1889, 49 O. G., 733.

DISCLAIMER.

1. When by inadvertence, accident, or mistake, a patentee has claimed more than that of which he was the first inventor, a disclaimer may be filed, either by the original patentee or by any of his assignees. Fee, $10.

R. S., 4917.

2. Disclaimer available for Elimination only.

A disclaimer under Section 4917 R. S. cannot be used to change the character of the invention. If an amended specification or a supplementary description is required to make a claim altered by disclaimer intelligible or relevant, it may possibly present a case for surrender and re-issue, but it is clearly not adapted to a disclaimer.

Collins Co. *v.* Coes, U. S. S. C. By *Fuller, Ch. J.*, 5 Mar., 1889, 47 O. G., 523, ❁.

DISCLOSURE.

1. An oral explanation was sufficient to establish conception that disclosed an intelligible way of carrying out the invention.

Oral explanation of an invention in interference is sufficient only where the descriptive language used is such as to disclose the invention as a drawing would disclose it. The description on its face, as detailed by the witness, must show, not only that the applicant had a conception of the way of doing it, but a way so definitely thought out and explained that the listener, if skilled in the art, could hav produced the device from the description, at least in a rude form of embodiment.

Wherry *v.* Heck, *Mitchell, Com.*, 14 Oct., 1889, 49 O. G., 559.

Compare Ligowski *v.* Peters *v.* Hisey, *Simonds, Com.*, (2) *infra.*

2. Incipient Invention.

To constitute a disclosure of invention [at the nascent stage] of improvements of a known machine, it is not necessary that sketches made and shown by the inventor should have shown an organized machine. It is sufficient if the invention of the particular improvements was clearly and intelligently made known.

Ligowski *v.* Peters *v.* Hisey, *Simonds, Com.*, 17 Nov., 1891, 57 O. G., 1595.

3. The patent must contain a complete disclosure of *the thing* invented.

There is no doubt that he who has discovered some new element or property of matter may secure to himself the ownership of his discovery as soon as he has been able to illustrate its practicability and to demonstrate its value. His patent, in such case, will be commensurate with the principle it announces to the world, and may be as broad as the mental conception itself; but the mental conception must have been susceptible of embodiment, and must, in fact, *have been embodied* in some mechanical device or in some process or art. The patent must be for a *Thing*, not for an idea merely. It is the adaptation of the materials and forces of Nature to practical use which brings them within the domain of individuals, and it is the novelty of such adaptation that constitutes them the proper subjects of protection by patent. But the contract of the public is not with him who has discovered [even though he may have put his discovery to actual use], but with him who makes his discovery usefully known. If he has discovered much and disclosed little, — if there has been revealed to him one of the arcana of Nature, and he communicates to the world only one or more of its derivative or secondary truths, he patents no more than he has proclaimed. He will not be allowed afterward, when the extent of his right shall be the subject of controversy, — either by expanding into a general expression what was limited before to a particular form, or by tracing out for us the line that leads back from consequence to remote causes, — to initiate us inferentially into the radical mystery of his invention, and then argue that he had described it, by implication, from the first, and so claim ownership of it in his patent.

Detwold *v.* Reeves, *Kane, J.*, Sep., 1851, 1 Fisher, 127.

DISCOVERY.

When Patentable.

The limitation of the patent franchise to something industrially available may seem to deny to some of the more important products of the human mind what it concedes to others of lower grade; but it is not the less true, on that account, that mankind may be enriched or made happy by physical as well as by moral or political truths, which, nevertheless, go without pecuniary reward for their authors. He who devised the art of multiplication could not restrain others from using it. The miner who first found out that the deeper veins were the richer in metal could not compel his neighbor to continue digging near the surface. The more comprehensive truths of all philosophy, whatever specific name we give them, cannot be specially appropriated by any one. They are almost elements of our being. We have not reasoned them out, perhaps, and may be even unconscious of their action; yet they are about us and within us, entering into and influencing our habitual thoughts, pursuits, and modes of life, — contributing to our safety and happiness; and they belong to us as effectively as any of the gifts of heaven. Air, water, and other materials found in Nature, and the laws under which they co-operate, are the common property of mankind; and those theories of the learned which we dignify with the title of *law* partake, just so far as they are true, of the same universally diffused ownership. It is the adaptation of the materials and forces of Nature to practical use which brings them within the domain of individuals, and the novelty of such adaptations constitutes them the proper subjects of protection by patent.

Detwold *v.* Reeves, *Kane, J.*, Sep., 1851, 1 Fisher, 127.

Compare Corning *v.* Burden, (1) ART, ✽; and Dolbear *v.* Am. Bell Tel. Co., (16) INVENTION, ✽.

DIVISION OF APPLICATION.

1. Two or more distinct and independent inventions cannot be included in the same application.

The authority vested in the Commissioner of Patents to define, and in any particular case to determine, what shall be admitted for examination in a single application is inferred as a necessary attribute of his duties prescribed in Sec. 4893 R. S. The only explicit reference in the statute to subdivision and separation in distinct applications is found in Sec. 4916 R. S., which has relation to re-issue, but by parity of reasoning (Herr, x. p., 41 O. G., 470) has been held to be applicable to original applications. The language of this section is: —

The Commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented upon demand of the applicant, and upon payment of the required fee for a re-issue for each of such re-issued Letters Patent.

(R. S., 4916.)

2. In pursuance of the authority thus vested in him, the Commissioner has prescribed the following rule for guidance, alike of Examiners and attorneys: —

Rule 41. — Two or more independent inventions cannot be claimed in one application; *but where several distinct inventions are dependent upon each other and mutually contribute to produce a single result, they may be claimed in one application.*

(Rules of Practice, 1 Ap., 1892).

Interpretation of the law and of the above rule thereunder is seen in the following decisions: —

3. May be ordered at any Stage of the Application.

The requirement of division may be made at any time before the case goes to issue, if the interdependence of the inventions is not clear (Rule 42).

Robbins, x. p., *Fisher, Act. Com.*, 28 Feb., 1891, C. D. Ms.

4. Ordinarily a device which has obtained a distinct status in the industries and trade should be the subject-matter of a separate application.

Sawn, x. p., *Mitchell, Com.*, 9 Mar., 1891, 54 O. G., 1561.

See, however, for an exception to the above general rule, Westphal, x. p., (16) *infra*.

5. The rules were made for the cases that arise, not the cases for the rules.

It must be remembered that the rules were made for the cases that arise, and *not* the cases for the rules. The *spirit and prime purpose* of a system of practice must always be kept in mind, and mere details and incidentals subordinated thereto.

Carter, x. p., *Hall, Com.*, 1 Mar., 1889, 46 O. G., 1392.

See also Franklin, x. p., (17), *infra*, and McMahan, x. p., 48 O. G., 255, (31) *infra;* Designolle, (17) THE CLAIM, Coe, x. p., (6) CLASSIFICATION, and Hunter, Jr., *v.* Lane, (2) RULES AND FORMS.

6. How Determined.

While classification is desirable and necessary for the purpose of speedy examination of applications for patents, *it is not the controlling circumstance* in determining the question of division. The things to be considered are: —

Are the devices interdependent?

Are they connected in design and operation?

Are they capable of use in other relations than that in which they are shown?

Have they acquired a recognized standing in the art as subjects of separate manufacture and sale?

Bennett, x. p., *Fisher, Act. Com.*, 21 July, 1890, C. D. Ms.

7. Must be the Proximate Result.

The contribution must be the proximate, immediate, direct act of the inventions respectively, so that *their*

combined operation is a resultant operation, just as two bodies, moving in different lines impinging upon each other, move in a new direction. The result must be the proximate and direct result, and not a remote one.

Herr, x. p., *Hall, Com.*, 19 Oct., 1887, 41 O. G., 463.

8. It is the proximate result of the process and not an ultimate result, which is to be considered in disposing of questions of joinder or of division (Arnold, x. p., 42 U. S., 57, ✽).

Grecnfield, x. p., *Frothingham, Act. Com.*, 11 Dec., 1891, 58 O. G., 274.

9. Office Classification.

The law requiring that but one subject of invention be comprehended in the same patent, must always form the basis of division of an application; it is not, however, always possible or admissible to divide an application for the mere purpose of conformity to the classification of inventions adopted in the Office. The Commissioner has no arbitrary power to require applications to be divided merely for such reason.

Franklin, x. p., *Leggett, Com.*, 24 July, 1873, 4 O. G., 105.
Compare, of same tenor, Carter, x. p. (5), *supra*.

10. Where not required, — Rule 41.

Where the inventions, however distinct, are dependent upon each other, and constitute portions of one machine, a division should not be insisted upon by the Office, and that even although it may be objected that the claims sought to be incorporated are for a different invention from that constituting the subject-matter of certain other claims in such a sense that they might, if applicant so elected, be embodied in another application: such claims are not necessarily for independent inventions within the meaning of Rule 41.

Forbes, x. p., *Mitchell, Com.*, 26 Mar., 1889, 51 O. G., 297.

11. Elements in Common.

Although it appears that certain claims in an application are for a mechanism capable of use in other relations than that which forms the specific subject-matter of the application, division will not be required if those claims have elements in common with the more specific claims of the application.

Kerr, x. p., *Simonds, Com.*, 3 Mar., 1892, 58 O. G., 1553.

12. Several improvements upon the respective parts may be embraced in a single patent, provided they cooperate to effect a common result, and provided they have not become subjects of recognized distinct manufactures.

Whenever the original invention is such that it could properly be the subject of a patent, and the organism has not changed in its identity or general structure, it is believed that several improvements upon its respective parts may be embraced in one patent, providing they cooperate in affecting the whole organism, *that is, in improving it as a whole*, and provided, also, invention and art [invention and the art, — not official classification merely] have not subsequently so advanced as to segregate the improved parts as distinct subjects of invention. These separate inventions in the improvement of each respective part are connected in design and operation; they are dependent upon each other, for they are parts of a specific organism, and they mutually contribute to a single result, which is the single function of the whole. . . . Such improvements may be embodied in one patent so long as the original invention retains its distinctive character and identity *and the state of the art has not advanced so as to resolve some or all of its parts into distinct subjects of manufacture.* . . . If the improvements did not disturb the identity of the original inven-

tion, and the progress of [the] art had not subdivided its elements into *distinct and well-recognized subjects of invention and manufacture*, the improvements could all be included in one patent.

Herr, x. p., *Hall, Com.*, 19 Oct., 1887, 41 O. G., 463.

13. "Interdependence" Defined.

To justify retention in the same application, "interdependence" does not mean that the several devices sought to be claimed in the same application must be of such a character that some other device effecting the same purpose may not be substituted for one or both of them. It is necessary only that they should have interdependence with relation to the operation which they perform.

Williams, x. p., *Fisher, Act. Com.*, 6 Dec., 1890, C. D. Ms.

14. A requirement of division, on the ground that the claims covered three separate and independent inventions, overruled where, on petition to the Commissioner, it was found that the first of the three groups into which the Examiner had divided the claims included an element which was also an element in the second group, and that the second group included an element of the third group; and further, that the improvements covered by the claims were not improvements upon parts or devices which had acquired a definite status in the arts, industries, and trades.

Williamson, x. p., *Frothingham, Act. Com.*, 26 Aug., 1891, C. D. Ms.

15. Commercial Status.

Where it was sought to secure under a single patent improvements on distinct parts of a pre-existing machine, and Examiner required division: *Held*, that it is

only when such part has acquired a distinct commercial status as a subject of independent manufacture and sale, that division should be required. So long as (1) the several improvements contribute to a single result, and (2) none of the parts improved upon has a recognized independent position in the industries and trade, division should not be required.

Galley, x. p., *Mitchell, Com.*, 5 Mar., 1890, Ms.

16. Requirements Defined.

It has not been held that where different parts or sub-mechanisms are claimed in combination, and also separately, that division should be required merely because such parts or sub-mechanisms have acquired distinct places in the arts and industries, unless they may also be used in other relations than those in which they are used in the particular application under consideration (see Scheckbauch, x. p., 54 O. G., 1265).

Westphal, x. p., *Frothingham, Act. Com.*, 19 Jan., 1892, C. D. Ms.

For the general rule to which the above conditions constitute an exception, see Sawn, x. p., (4) *supra.*

17. "New Fundamental Organization."

Where the principal claims are of such a fundamental character as to indicate that unless they shall be found to be anticipated, the machine is to be regarded as new in its fundamental organization, then, in advance of examination, it must be assumed that the machine is broadly new, and that division cannot properly be required.

Hatteberg, x. p., *Mitchell, Com.*, 13 Mar., 1890, C. D. Ms.

Compare Combs, x. p., (2), CLASSIFICATION, and Culver, x. p., (18), and Stearnes, x. p., (42), *infra.*

18. Where not Required.

Where it was clear, from an examination of the specification, and especially from one of the claims, that applicant claimed the entire machine as new, and that he was not seeking a patent for mere improvements upon an old machine: *Held*, that the doctrine set forth in Stearnes, x. p. (50 O. G., 1768), did not apply, and that the question of division could not be reached until it was determined whether the broader combinations claimed were true combinations within the meaning of the law, and also whether [in view of the then state of the art] they were patentable as combinations.

Culver, x. p., *Mitchell, Com.*, 18 Sep., 1890, C. D. Ms.

Compare Hatteberg, x. p., (17) *supra*, and Stearnes, x. p., (42) *infra*.

19. New Fundamental Organization.

Where the application included claims for an insole and claims for the method of making such a shoe, and the principal claims for the shoe were of such a fundamental character as to indicate that, unless found to be anticipated, the shoe was to be regarded as new in its fundamental organization: *Held* (assuming, for the purpose of deciding the question of division, that the shoe was new), that — as it is well settled that the right in such cases carries with it sub-combinations — petition, from Examiner's requirement of division at this stage, was granted.

Kinsella, x. p., *Frothingham, Act. Com.*, 29 Aug., 1892, C. D. Ms.

20. Distinct Commercial Status.

Upon requirement of division in an application where four of the claims were drawn wholly upon a ticket-register, and the other claims were drawn entirely upon

the ticket itself, and such registers and tickets fell under separate classes in the Patent Office: *Held*, that the Office classification was not alone sufficient to control the question; but as it was obvious that the ticket could be used in other relations than that in which it was shown and described, and as it was furthermore known to have acquired a distinct status in manufacture and trade, it followed that, although the ticket and ticket-register were used together and to a certain extent mutually contributed to produce a single result, the claims for such register and ticket could not be joined in the same application.

McDuffie, x. p., *Frothingham, Act. Com.*, 4 Aug., 1892, C. D. Ms.

21. Where the subject-matter was a harness, and some of the claims related to separate parts of a harness, — for example, some of the claims related to the saddle, some to the breast-strap, and other some to the entire structure, embracing both these parts, — and the Examiner required a division of the application: *Held*, that the mere fact that parts of the harness may possibly be used with other parts of a differently constructed harness, or that the Office recognizes separate sub-classes of invention which embrace such parts when separately applied for, was not sufficient ground upon which to base requirement for division.

Wells, x. p., *Fisher, Act. Com.*, 11 Nov., 1889, C. D. Ms.

22. "Dividing Line."

Where inventions are so near the dividing line as to render impossible the determination with certainty whether, in a proper sense, co-ordination and combination exist, so as to constitute them one invention or combination, *the doubt should be resolved in favor of the*

inventor, and he should be allowed to unite them in one application, if he so elect.

Herr, x. p., *Hall, Com.*, 19 Oct., 1887, 41 O. G., 463.

23. Distinct Status in the Arts.

Where there are claims which severally cover substantially the whole mechanism comprised by the invention, or a combination of several partially independent but co-operating parts of the same and other claims each covering a part or sub-mechanism, division will not be required unless the particular part or sub-mechanism in question is capable of use in other relations, and has acquired a distinct status in the arts, manufactures, and trades.

Hine, x. p., *Simonds, Com.*, 8 Jan., 1892, 58 O. G., 385.

24. Co-acting Devices.

Where the claim covered two sets of mechanism, and the plunger and its pitman were elements of both sets, not only in operation, but also as claimed: *Held*, that the fact that each device or sub-mechanism performed a function different from the other was clearly immaterial to the question of division, and the requirement of division was overruled.

Brown & Gehrt, x. p., *Frothingham, Act. Com.*, 18 Mar., 1892.

25. Not required where one Claim in each Group included both Sub-mechanisms.

The Examiner separated the claims into five groups, and required division: *Held*, as to two of the groups, that as one claim in each group included both sub-mechanisms, division was improperly required, but that the requirement of division as to the other groups was proper, as each related to a specific improvement upon a separate part of an old machine (see Stearnes, x. p., 50

O. G., 1768; Scheckbauch, x. p., 54 O. G., 1265; and Cornely & Cornely, 46 C. D. Ms., 415).

Jackson, x. p., *Frothingham, Act. Com.*, 25 Jan., 1892, C. D. Ms.

NOTE. — In this case the Assistant Commissioner said: "While the requirement for division has been in part sustained, yet it is not improbable that claims might be drawn in such a way as to obviate, at least in part, the necessity for division."

26. Question of "Merits."

The Examiner refused to entertain the application on its "merits," and required division because,—

There is no combination between the specific means for regulating the supply of oil to the tank and the burner *per se*. Each device performs its expected and independent function (Herr, x. p., 41 O. G., 463).

This action being carried up on interlocutory appeal, the Commissioner's ruling was substantially as follows: When a claim covers a combination, it cannot be refused consideration on the ground of want of combination. The Examiner should first reject on that ground, so as to place the case in condition for appeal to the Board of Examiners-in-Chief. If the Board reverses the Examiner's action, the case goes back to the Primary Examiner for action on "merits." If, on the other hand, the Board sustains the Examiner's position as to combination, then division may be called for by the Examiner, and this question should be disposed of either by acquiescence on the part of applicant, or by the Commissioner on petition before action on "merits."

Bullard, x. p., *Hall, Com.*, 17 Dec., 1888, 45 O. G., 569.

27. Implication.

A requirement to file a divisional application implies that the article embraced is not patentable in the pending

application. In such a case Rule 44 impliedly permits a reservation clause in the existing application.

Forbes, x. p., *Mitchell, Com.*, 14 Oct., 1889, C. D. Ms.

28. "Parent" and "Divisional" Applications.

Where the earlier of two applications described an apparatus and a process, and claimed the former, and, without claiming the process, stated that it formed the subject of another application which was identified by serial number and date, and the other and the later application declared itself to be a division of the application first filed, which was also identified by serial number and date: *Held*, that the later application was, technically, a division of the earlier.

Forbes *v.* Thomson, *Mitchell, Com.*, 13 Dec., 1890, 53 O. G., 2042.

29. There are, perhaps, only two cases where claims to a process and to a product can be properly included in one patent. These cases are: —

1. When the product is entirely new, and hence the process also.

2. When the exercise of the process would produce no other product, and when the product could be produced by no other process.

Blythe, x. p., *Butterworth, Com.*, 28 July, 1884, 30 O. G., 1321. Compare Tainter, x. p., 47 O. G., 135.

30. The Examiner's requirement that the process and an apparatus therefor must be absolutely interdependent for protection in one patent, — overruled.

The requirement of the Examiner for division, on the ground that the process and apparatus cannot be mutually dependent upon each other unless each is absolutely indispensable to the exercise of the other, overruled; and *Held*, that such a construction of Rule 41 is unwarranted.

It is sufficient to justify joinder of process and apparatus if, as a matter of fact, the single result had in view by the inventor, as the proximate purpose of his invention, is contributed by both process and apparatus. In such case there is mutual contribution and interdependence within the meaning of the rule.

It appearing that the method could not be carried out in any other way than by an apparatus substantially like that claimed: *Held*, that division should not be required.

Norwood, x. p., *Mitchell, Com.*, 17 Feb., 1890, 50 O. G., 1129.

31. "Interdependence" means no more than that, in the language of Rule 41, process and apparatus are dependent upon each other, and mutually contribute to produce a single result, or that they are in their nature and operation connected together. If they sustain this relation, it is immaterial whether or not the process may possibly be carried out by some other means.

Hyde, x. p., *Fisher, Act. Com.*, 10 Aug., 1889, 50 O. G., 1293.

32. It has been held by the courts and by the Patent Office that a clear line of division exists between apparatus and process; the fact that the Office has at some periods regarded division as imperative, while at other periods it has been looked upon as optional, does not alter the fact that the *capacity* for division has always been recognized.

Chambers, x. p., 51 O. G., 1943.

33. The process, and also an apparatus for carrying out that process, may be separately claimed in one patent.

In a case where the Primary Examiner required division of the application upon the lines of "Process" and "Apparatus" before examination on the merits, his action was overruled, on the ground that there is no

provision of the statute which prevents the joinder of a process and its apparatus in the same application, and for the further reasons that the law, the decisions of the courts, and the Patent-Office rule (Rule 41) afford no warrant for such demand unless there is such a total lack of interdependence between the two matters claimed as would render them absolutely independent and distinct inventions.

McMahan, x. p., *Fisher, Act. Com.*, 10 June, 1889, 48 O. G., 255.

34. Examiners were instructed to avoid unnecessary interference with the choice of the applicant.

It may further be said that the law provides that any person who has made an invention shall receive a patent granting to him the exclusive right to make, use, and vend the same within the United States and its Territories. Under a requirement by which an invention might thus be split up into separate parts, the patent for making and vending might fall into the hands of one assignee and that for using into those of another, perhaps antagonistic. Such interference with the rights of inventors was never contemplated by the statute, and the Patent Office should take no action which would accomplish it.

Ib.

Compare Designolle, (17) THE CLAIM; Carter, (5) *supra*.

35. Although a process and an apparatus for carrying out the process are separate inventions, they are not necessarily independent inventions within the meaning of Rule 41; and when they are dependent upon each other and mutually contribute to produce a single result, they may be joined in one application. Rule 41 does not require that, in order to authorize a single patent for several distinct inventions which mutually contribute

to a single result, there must be such intimacy of interconnection and co-operation as to result in a third invention or combination.

Lord, x. p., *Mitchell, Com.*, 13 Feb., 1890, 50 O. G., 987.

36. Method — Product.

It is *not a sufficient ground for requiring division* between a claim for a method and a claim for the product produced by practising that method, that if the claims were presented in separate applications, such applications would be assigned to and examined in different divisions of the Office, *provided the method could produce no other product, and the product could be produced by no other method.*

Stanwood, x. p., *Frothingham, Act. Com.*, 18 June, 1892, C. D. Ms.

37. Process and Machine.

Where an application, as filed, discloses an apparatus and also a patentable process, and the relation between them is such that they could be joined in one application, and the apparatus only is embraced in the statement of invention and claims as originally presented, claims for the process may be subsequently incorporated, if they are seasonably presented and are supported by a supplemental oath.

Perkins, x. p., *Mitchell, Com.*, 4 Mar., 1891, 55 O. G., 139.

38. Apparatus and Process.

Appeal was taken from the decision of the Primary Examiner which required division of an application as between claims for apparatus and claims for process, which process may be practised by the apparatus, but is also capable of being practised otherwise. Both inventions pertain to the same subject-matter. No wider

range of search is required for the two than for the one. Following Lord, x. p., (50 O. G., 987), the requirement of division is overruled.

Curtis, x. p., *Simonds, Com.*, 4 Nov., 1891, 57 O. G., 1128.

39. Where method and product should be presented in separate applications.

Where the Examiner refused admission to two claims on the ground that division would be required for the reason that if the proposed claims were presented in different applications such applications would be assigned to and examined in different divisions of the Office, and it was apparent that the method set forth in one of the claims could produce only the product of the other claim, but, on the other hand, it was also apparent that the product of the second claim *could* be produced otherwise than by the method set forth in the first claim: *Held*, that the Examiner's action was proper.

Stanwood, x. p., *Frothingham, Act. Com.*, 18 June, 1892, C. D. Ms.

40. Range of Search.

Where it appeared that if claims for a method and claims for an article of manufacture were presented in separate applications, such applications would be assigned to and examined in different divisions of the Office: *Held*, that Fefel, x. p. (57 O. G., 409), and Curtis, x. p. (57 O. G., 1128), presented no grounds for overruling the requirement of division.

Greenfield, x. p., *Frothingham, Act. Com.*, 11 Dec., 1891, 58 O. G., 274.

41. Process and Product.

A requirement of division between a claim for a brush or mirror handle and back, and a claim for an alleged

process of making the same: *Sustained*, on the ground that the article and process were distinct inventions, and, if presented in separate applications, the applications would be assigned to and examined in different divisions of the Office.

Welling, x. p., *Frothingham, Act. Com.*, 15 Mar., 1892, 40 C. D. Ms., 173.

42. Distinct Specific Improvements on an Old Machine not joinable in a Single Application.

Where the machine or apparatus improved upon is old, and no claims are made professing to cover its fundamental organization, the several specific improvements are to be grouped with reference to the several single functions which they mutually contribute to discharge; and it is not enough to justify joinder in a single application that they all relate to portions of the same machine or apparatus, and in various disconnected ways tend to improve it.

Stearnes, *Mitchell, Com.*, 15 Mar., 1890, 50 O. G., 1768.

43. Independent Inventions in the same Structure.

Independent inventions, although pertaining to the same structure, cannot be joined in one application, especially when the Office classification is such as to require their examination in different divisions.

Steinhilber, *Simonds, Com.*, 17 Dec., 1891, C. D. Ms.

44. Where Division is required.

Where the article of manufacture claimed could be made by other methods than that claimed, and the method, if practised, would not necessarily eventuate in that particular article of manufacture: *Held*, that division was properly required (Peters, x. p., 48 Ms., 301).

Greenfield, x. p., *Frothingham, Act. Com.*, 11 Dec., 1891, 58 O. G., 274.

45. Two Distinct Inventions.

The Examiner properly required elimination from an application for patent for improvements in a mangle or ironing-machine, of claims for a special form of belt-shifting device shown in the same application; there being no necessary connection between applicant's ironing-machine, considered as such, and the peculiar kind of belt-shifter which he shows in his application.

Wendell, x. p., *Simonds, Com.*, 20 Ap., 1892, 59 O. G., 630.

46. After the product claim has been withdrawn, in obedience to Examiner's requirement of division, and claims to the process have been rejected, a claim to *another* product cannot be introduced in the same application.

Where the application contained claims for a process, and also a claim for an article produced by it, and, upon Examiner's requirement of division, the article-claim was stricken out; and where, after final rejection of the process-claim, applicant sought to introduce a new article-claim: *Held*, that although the new claim was not in the precise language or for the precise article originally claimed, yet its admissibility does not depend upon whether it covered the same or a different product. The only question is, did the application originally present a claim which, in one form or another, covers a product of the process claimed.

Steffin, x. p., *Fisher, Act. Com.*, 3 Nov., 1890, C. D. Ms.

47. Filing Date.

Where applicant, being required to remove from a divisional application new matter not contained in the parent application, filed a third application containing the new matter, with the statement that it was a division of the second application, and the Examiner objected to

the statement, on the ground that the subject-matter was never properly a part of the subject-matter of the second application: *Held*, overruling the Examiner, that there was no adequate reason why the applicant should not have the benefit of the filing date of the application in which his present invention was first claimed (case distinguished from Buell, x. p., 26 O. G., 437).

Hunter, x. p., *Mitchell, Com.*, 27 Feb., 1891, C. D. Ms.
Compare Fuller, x. p., (48) *infra*.

48. New Matter Inadmissible.

The subject-matter of a *divisional* application must always be a part of the subject-matter of the original application, without any additions to that original subject-matter.

Fuller, x. p., *Simonds, Com.*, 30 Jan., 1892, 58 O. G., 804.
Compare Hunter, x. p., (47) *supra*.

NOTE. — This ruling manifestly does not prevent applicant, should he so elect, combining the divisional (segregated) matter with such new matter in a *de novo* application, either in lieu of or contemporaneously with, but distinct from, such divisional application. Such *de novo* application would, however, be restricted to its own filing date, and could not date back to the day of filing of the parent application, as a divisional application can.

49. Divisible Subject-Matter.

The application under discussion held not admissible as a division of the earlier application, because its subject-matter is not reached by any claim or statement of invention contained in said earlier application.

Freeman, x. p., *Frothingham, Act. Com.*, 19 Jan., 1892, 58 O. G., 522.
See note to Fuller, x. p., (48) *supra*.

50. Description must be restricted to the divisional case.

Where an applicant acquiesces in the requirement of division, he is bound (by Rule 142) to "limit the description, drawings, and claims of the pending application to whichever invention he may elect."

Rupp, x. p., *Fisher, Act. Com.*, 19 Mar., 1890, C. D. Ms.
See note to Fuller, x. p., (48) *supra.*

51. Rejection accompanying requirement of division is improper; but if applicant waives the irregularity, he is afterward bound by it.

Where the Examiner rejects upon references, in his first letter requiring division, the applicant is not bound thereby, but may insist that the rejection be withdrawn until the question of vital form is disposed of, and may appeal to the Commissioner from a refusal to grant his request, as provided in Rule 145. But applicant has a right to waive the irregularity, and to treat the rejection precisely as if the question of vital form had been previously disposed of; and if he does so waive, he is thereafter estopped from objecting to such rejection on the ground of irregularity.

Lorimer, x. p., *Mitchell, Com.*, 24 June, 1890.
Compare Stearnes, x. p., (42) *supra.*

52. Question of division is a question of "form," is appealable to the Commissioner, and takes precedence of question of functional claim, which is a question of "merits," and is appealable to the Examiners-in-Chief.

Whether or not the process claims cover anything more than the use or function of the machine is a question for the Examiner, and the appellate tribunals acting upon "the merits" (Harrison, x. p., C. D. 42, Ms. 178); but where the question of division is also raised, it must

be settled *before* the applicant is obliged to take his appeal to the Examiners-in-Chief on the question whether or not the process amounts to a mere function of the machine.

Heuser, x. p., *Frothingham*, *Act. Com.*, 30 Ap., 1891, C. D. Ms.

53. Non-Essential Elements.

Examiner basing requirement of division on alleged immateriality of certain elements common to all the claims: *Held*, if the Commissioner were to hold, *for the purpose of division and therefore in advance of examination on "merits,"* that any of the elements of a combination were immaterial and could be ignored, it would be, in effect, holding that they were immaterial and could be ignored for any and all purposes, and would thus deprive the applicant of the substantial right of appeal to the Examiners-in-Chief in the event of an adverse decision of the Primary Examiner on the question of legitimacy of the combination; *Held further*, that it would be unsafe to assume such a state of facts, in any case, in advance of consideration of the claims upon their merits, in the regular course of procedure; and the requirement of division was overruled.

Lewis, x. p., *Frothingham*, *Act. Com.*, 21 Mar., 1892, C. D. Ms.

54. Upon the Examiner's insisting upon a requirement of division on the ground that certain elements, common to all the claims, were merely nominal elements: *Held*, that every element included in a legitimate combination is presumably essential to that combination, and it has been well settled that the question whether a combination is or is not legitimate, pertains to the "merits" of the claim; and the requirement of division was overruled.

Ib.

55. When an application containing claims for a process, and containing also claims for a described apparatus for practising the process, has been divided in compliance with the official requirements, and a patent thereafter issues for the apparatus: the Examiner is not warranted in subsequently rejecting the application for the process, on the ground that the patent for the apparatus disclosed and discovered the process. Such action is, in effect, a reversal of his decision requiring division; and if his present action be correct, division should not have been required.

Chambers, x. p., *Mitchell, Com.*, 31 May, 1890, 51 O. G., 1943.

56. Cursory Examination.

An exhaustive search cannot be made in advance of compliance with the requirement of division; but the best references which the Examiner can furnish as the result of a cursory examination should be furnished, upon request, to assist the applicant in determining what course to pursue in view of the decision of the Office that the application must be divided.

Stearnes, x. p., *Mitchell, Com.*, 15 Mar., 1890, 50 O. G., 1768.

Compare Lorimer, x. p., (51), also Culver, x. p., (18), *supra*.

57. Official Information.

Where a division was required subsequent to Examiner's first letter: *Held*, that not only should the requirement of division have been made in the first action, but *information of the state of the art should also have been given, both as to the claims which the Examiner thought examinable in the parent case, and also as to those which he was of opinion should be divided out.*

Harris, x. p., *Fisher, Act. Com.*, 4 Jan., 1890.

See Robbins, x. p., (1) DRAWING; JOINDER OF APPLICATION; CLASSIFICATION.

DOUBLE USE.

See (31) *et seq.* INVENTION.

THE DRAWING.

1. Wherever the nature of the invention admits of it, each application for a U. S. patent is required to be accompanied by a drawing of the device, of which, in case a patent is granted, a photolithographic copy (made in the Patent Office) is attached to the patent as a part of the specification.

Sec. 4889 R. S., P. O. R., 49, 50, 51, 52, 53, 54, and 55.

2. Drawings for the Patent Office are required to be made upon pure white paper or cardboard, of a thickness corresponding to 3-ply Bristol-board. The drawing is required to consist wholly of lines made with a pen, and each line is required to be sharp, distinct, and absolutely black. Where the drawing contains more than one view or figure, the several figures must be consecutively numbered. For transmission to the Office, drawings may be rolled, never creased or folded.

P. O. R., 51 (1), (3), (6), (9).

NOTE.—A mode of transmission favored by some careful attorneys is flat, protected by one or more stiff tar-boards.

3. Rule 51 clearly sets forth the character of the drawings which must be furnished by applicants; and as the Office Draftsman is an expert and is intrusted with the duty of seeing that the drawings conform to the required standard, the Commissioner has usually, if not always, felt constrained to follow the Draftsman's judgment in such matters.

Benjamin, x. p., *Fisher, Act. Com.*, 28 May, 1890, C. D. Ms.

4. The number of sheets of drawing should never exceed what is absolutely necessary. Rule 51 (5). The statute requires that the drawings shall be *signed* by applicant or his attorney, and by two witnesses. Stamped signatures are not sufficient. Sec. 4889, R. S., Rule 51 (7).

Krause, x. p., *Simonds, Com.*, 18 Sep., 1891, 56 O. G., 1708.

5. Upon the requirement of the Examiner that "each view of each part should be designated as a separate figure," and that "where two views of the same part are given, as in Fig. 8, one should be numbered 8 and the other 8 *a*": *Held*, sustaining the Examiner's action, that it is stated in Clause 6 of Rule 51, that "the different views should be consecutively numbered," and in Rule 38, that "the description will refer to the different views by figures;" and no good reason was seen for departing from these rules, nor was it apparent that compliance with them would entail any hardship upon an applicant, and that while it is true that patents have been granted in which Rule 51 has been departed from, yet such practice is not approved.

Wharton, x. p., *Frothingham, Act. Com*, 18 June, 1892, C. D. Ms.

6. When the Examiner had required further illustration of the mechanism "whereby certain conveyors were rotated at different rates of speed": *Held*, that it was clear, from an examination of the drawing, that the conveyors were to be rotated, and, from an examination of the claims, that applicant did not claim that the conveyors were rotated at different rates of speed, and that the illustration was sufficient.

Bates, x. p., *Frothingham, Act. Com.*, 16 Nov., 1891, C. D. Ms.

7. Where Examiner, having required a division, objected to certain of the figures: *Held*, that one of the figures, being connected in design and operation with the other devices shown, might therefore be allowed to remain in the case, although it might also be considered to represent a distinct invention.

Robbins, x. p., *Fisher, Act. Com.*, 28 Feb., 1891, C. D. Ms.

8. Modifications, where shown, must come within the scope of some claim.

Generally speaking, where a preferred form and modified forms of the same invention are illustrated by different figures in the drawings of an application, applicant should be required to strike out each figure (other than the one representing the preferred form) which is not the subject of a claim that is also applicable to all the represented modifications.

Payne, x. p., *Mitchell, Com.*, 25 July, 1890, C. D. Ms.

Compare Witty *v.* Caffrey, MODIFICATIONS; and Wilcox, x. p., (19) ANTICIPATION.

See also DESCRIPTIVE CHARACTERS.

9. Amendment of Drawing.

When, without direction or permission of the Office, a figure is added to the original drawings on file, it must be erased or cancelled, even although it was added in good faith.

Cordrey, x. p., *Mitchell, Com.*, 6 July, 1889, 48 O. G., 397.

10. A drawing cannot be altered to correspond with a model which has been merely filed in the case as an exhibit, and never accepted by the Office as a model under the provisions of Rule 56. Such a case comes within the principle of Kissner, x. p. (53 O. G., 919).

Austin, x. p., *Frothingham, Act. Com.*, 27 July, 1891, C. D. Ms.

11. It was not intended to hold, in Wharton, x. p. (40 O. G., 917), that a *drawing* could never be changed by addition or erasure for the purpose of correcting an error merely clerical in its nature.

Law, x. p., *Mitchell, Com.*, 10 Feb., 1891, C. D. Ms.

12. The statement, in Rule 73, that amendments must be made "on sheets of paper separate from the papers previously filed," etc., clearly applies to the specification and claims only. The statement that erasures and mutilations of the papers and records must not be made by the applicant includes drawings; but it does not necessarily mean that corrections of the drawings may never be made by erasure and new delineation, *by permission of the Office and under its superintendence*; and Rule 71 no more authorizes amendment and revision of drawings by mutilation than it authorizes amendment and revision of the specification by the same method. Rule 72 affords no warrant for withdrawal of the drawing for correction or any other purpose, except when there is a model in the case, which must remain on file.

Ib.

13. All requirements of amendment by an Examiner in a case where no accepted model is filed, whether they relate to the specification or the drawings, must (unless the contrary is stated or suggested) be assumed to imply that the amendment is to be affected, not by erasure or mutilation, — obliterating portions of original record, — but by means of such *additional* description or drawing as will effect the amendment and leave the record intact. The furnishing a tracing or a blue print of the original will not justify a relaxation of this rule. Of course in *de minimis* matters, analogous to the correction of clerical errors in manuscript, the original drawings may be

corrected, even in a case where no model is filed; the correction being superintended by the Examiner.

Crissey, x. p., *Mitchell, Com.*, 2 Feb., 1891, C. D. Ms.

14. Where the Examiner required a tracing showing the condition of the drawings as they were before certain amendments were made by the applicant: *Held*, that the requirement should not be insisted upon, as the changes were made in compliance with requirements of the Office, and the record was, therefore, clear as to what changes were made and why they were made.

Flowers, x. p., *Fisher, Act. Com.*, 22 Nov., 1890, C. D. Ms.

15. Competency of the Witnesses.

While the language of the statute, if read literally, implies that it is the drawing or the document signed by the applicant, and not his signature, which is the thing to be attested by two witnesses, yet the uniform practice of the Patent Office, so far as the Commissioner's investigations enabled him to know, has been to regard the attestation as referring to the *signature*, and accordingly as requiring two competent witnesses for each signature. Examiner was sustained in his refusal to accept the name of a member of the firm as a witness to that firm's signature as applicant's attorneys.

Kyle, x. p., *Mitchell, Com.*, 19 Ap., 1890, 51 O. G., 1621.

16. Where an application was filed to take the place of one which had been stricken from the files because signed and sworn to "in blank": *Held*, that the old sheet of drawings could not be applied to the new application.

Ayres, x. p., *Fisher, Act. Com.*, 13 May, 1890, C. D. Ms.

NOTE.—On this point the Acting Commissioner said that in a recent case the Commissioner, through a letter to the applicant, refused permission to transfer certain sheets of

drawings in an original application to a divisional application, and referred the applicant to two orders bearing on the subject published in 30 O. G., 777, and 32 O. G., 139.

17. It is a matter of extreme doubt whether an application can ever be rejected upon a reference whose construction is not specifically *described*, but reliance is placed wholly or mainly upon the illustration in the drawings.

Buhlman, x. p., *Fisher, Act. Com.*, 29 May, 1890, C. D. Ms.

For like insufficiency (as reference) to description without *drawing*, see Wilcox, x. p., (19) ANTICIPATION.

18. Section 9 of Rule 51, which forbids advertisements on the face of patent drawings, relates to the advertisements and business addresses of agents and attorneys only. There is no valid objection to the name and address of *the inventor* appearing upon the face of the drawing *when placed there merely for the purpose of illustrating his invention.*

McGee, x. p., *Mitchell, Com.*, 8 June, 1889, C. D. Ms.

For DUPLICATION see REDUNDANCY.

ELECTION.

Estoppel.

The principle recognized in general jurisprudence that a party entitled to one of two or more rights or remedies must elect which to pursue, and, having made the election with full knowledge, is bound thereby and is estopped from taking another remedy, is applicable to proceedings for patents. A party cannot occupy two inconsistent positions. Cases illustrating this general rule are very numerous: *e. g.*, Bigelow on Estoppel cites Rodermund *v.* Clark (46 N. Y., 354); Sawyer *v.* Wood (3 Johnson's Chan. Cas., 416); Littlefield *v.* Brown

(1 Wend., 398); Do. Supr. Ct. — in Error — (11 Wend., 467).

Williams & Raidabaugh, x. p., *Hall, Com.*, 9 Sep., 1887, 40 O. G., 1337.

See ESTOPPEL.

ELEMENTS.

Where the applicant's invention is such as, by simple interchange or reversion, to admit of several combinations in a single patent, he should be permitted to include them where the prior art admits of such a course.

Tobie, x. p., *Mitchell, Com.*, 6 Feb., 1890, 50 O. G., 992.

EMBRYO INVENTION.

See CONCEPTION.

EMPLOYER AND EMPLOYÉ.

1. The presumption is in favor of the employer as against the claims of a workman who has been specially employed and paid to embody the invention.

As between an employer and a party employed for a special purpose, features suggested by the employé which are merely tributary to the main invention can give to him no claim as an inventor; and even in regard to such features as amount to independent inventions, a presumption exists in favor of the employer. . . . Hall and Harrison were acting as machinists employed for a special purpose, and are therefore liable to all the presumptions of law against them by reason of such fact.

Harrison *v.* Hogan, *Marble, Com.*, 6 Sep., 1880, C. D., 191.

See also (2), (3), (4), (5), (6), and (7) *infra.*

2. Improvements made by workmen, working under the pay of an inventor and making experiments under his directions, are to be considered for the credit and benefit of such inventor.

Goodyear *v.* Day, U. S. C. C., N. J., *Dickerson, J.*, 1852. Law's Digest.

3. Claims are regarded with disfavor made by mechanics or draftsmen who have been called in to assist in the embodiment of a new idea, and, having been paid for their materials, time, and skill, turn upon their employers and claim to be independent inventors.

Spofford *v.* Moore, *Fisher, Com.*, 10 Feb., 1870, C. D. 6.

4. An inventor who employs workmen to embody his invention is not to lose it because they make suggestions or alterations which are mere modifications of it or auxiliary to it.

Hale *v.* Field, *Fisher, Com.*, 16 Feb., 1870, C. D. 12.

5. Where a skilled workman is employed to embody an inventor's idea in practical form, the results are the property of such employer, unless they show that the workman has discarded the original idea and has proceeded upon a wholly distinct and separate plan.

Hisey *v.* Peters, *Simonds, Com.*, 11 Mar., 1892, 58 O. G., 1691.

6. Where an employer discloses the general idea and plan of his invention to an employé, no suggestion from the latter which does not involve a radical departure therefrom will give him any rights as an inventor. (Citing Agawam Co. *v.* Jordan, 7 Wallace, 583, ❋.)

Hayes *v.* Hopkins, *Simonds, Com.*, 19 Dec., 1891, 59 O. G., 157.

7. Where it appeared that one of the parties to the interference had been employed by the other party to put said employer's previously conceived ideas into mechanical form: *Held*, that it imposed a burden upon the employé which could be removed only by evidence of the most conclusive character; and as both the Examiner of Interferences and the Examiners-in-Chief concurred in finding that the employer was entitled to the award of priority, the further burden was imposed upon said employé of showing to the Commissioner that the former decisions were contrary to law and against the weight of evidence.

Redfield *v.* Goodson & Capehart, *Fisher*, *Act. Com.*, 13 Jan., 1891, C. D. Ms.

8. There is no presumption in favor of an employer against a workman who produces an invention while employed in the general service of the former, but who is not employed to reduce that specific invention to practice.

Hale *v.* Field, *Fisher*, *Com.*, 16 Feb., 1870, C. D. 12.

Of like purport see Hapgood *et al. v.* Hewitt, (11) and (12) *infra*.

9. In a case where A, while in the employ of B, constructed at B's expense and for B's use a machine for which A afterward secured a patent, such construction made B the owner, with the right to use that particular machine without liability to A, notwithstanding the grant to A of such patent.

Dable Grain Shovel Co. *v.* Flint *et al.*, *Blodgett*, *J.*, 31 Mar., 1890, 53 O. G., 1093.

10. Although a mechanic may be employed to devise and perfect a machine, and although the employer may clearly indicate the *result* to be attained by the ma-

chine proposed, yet if the idea of *means*, including the *general plan* and the *specific details*, was conceived and reduced to practice by the employé, the *latter*, and not the former, is the inventor, and to him the patent should be granted.

To employ a mechanic to make one machine do what three machines have done is not to disclose the general plan of a machine. A man may be profoundly impressed with the idea that a competent person can make one machine do the work of three old machines, and yet have no definite idea whatever of the *organization* by which the triple function is to be performed.

Even where the relation of the employer to the employé may entitle the former to an equitable interest in the invention and the patent therefor, it does not entitle him, on that account, to take the inventor's place as the lawful grantee..

Greenlee & Ström *v.* Roberts, *Mitchell, Com.*, 11 May, 1891, 55 O. G., 1399.

11. Persons are not deprived of the right to their inventions while in the service of others unless they have been hired and paid to exercise their inventive faculties for their employers.

Hapgood *et al. v.* Hewitt, *Gresham, J.*, 22 March, 1882, 21 O. G., 1786.

12. A contract by which one person agrees to pay a sum of money for the time, labor, and skill of another for a given period gives the employer no right to the assignment of a patent that is issued to the employé for an invention made during the period of his employment.

Ib.

EQUIVALENTS.

1. Definition.

The general principle is that in order to be considered an equivalent of another, one device must perform the same functions, and perform them substantially in the same way, as another one.

Jones Co. *v.* Munger Co., *Locke, J.*, Nov., 1891, 58 O. G., 274.

2. The use, in a claim, of the words "or equivalent devices as described," is not objectionable where their meaning is clear and unequivocal, *as where modifications or equivalents have been described in the specification.*

Walton, x. p., *Doolittle, Act. Com.*, 11 July, 1876, C. D. 162.
Of like purport, see Lockwood, x. p., (7) *infra.*

3. An applicant has the right to state that, while he prefers the form of jack illustrated in his application as an element of the combination, other clamping devices which would accomplish the same purpose could be employed. The Examiner's requirement that applicant either strike out this passage or describe and illustrate the "other forms of clamping device" referred to,—overruled.

La Borde, x. p., *Hall, Com.*, 9 July, 1888, C. D. 104.

4. It has never been held that an equivalent known at the date of the invention could be used without infringing the patent; such a holding, if generally adopted, would amount practically to destruction of the law of equivalents.

Kuhl *v.* Mueller, *Sage, J.*, 5 July, 1884, 28 O. G., 541.

5. The inventor of an improvement [in an already created art] cannot so invoke the doctrine of equivalents as to suppress all subsequent improvements, in the same

field of invention, *which are not mere colorable evasions of the earlier improvement.*

Burr *v.* Duryee, U. S. S. C. By *Grier, J.*, 28 Mar., 1864, 1 Wallace, 531, ✽.

6. The patentee of an invention, which is merely one of a train of successive improvements in an already created art, is not entitled to invoke the doctrine of equivalents; and his patent, if sustained at all, can be held to cover only the specific arrangement which it describes.

Consol. Roller Mill Co. *v.* Bernard, *Blodgett, J.*, 10 Feb., 1890, 53 O. G., 430.

NOTE. — Burr *v.* Duryee, (5) *supra*, and Rodebaugh *v.* Jackson, (10) *infra*, seem to mark some relaxation of the above general rule.

7. It is a well-established rule of the Office, that the words "or its equivalent" may not be used in a claim unless an equivalent device is described in the specification (Dolph, x. p., 89 O. G., 239; Cook, x. p., 43 C. D. Ms.).

Lockwood, x. p., *Fisher, Act. Com.*, 19 June, 1890, C. D. Ms.

See, of same purport, Walton, x. p., (2) *supra*.

8. If defendants have used plaintiff's invention, *or something substantially like it*, they are estopped from denying its utility; it is fair to presume that they would not use it if they thought it of no utility (Coleman *v.* Liesor).

McClain *v.* Ortmayer, *Blodgett, J.*, 9 Jan., 1888, 42 O. G., 724.

9. Where a patentee says that he expects, in practical operation, to use a device — as, for example, a rivet —

to accomplish a certain purpose, but does not confine himself specifically to it, any other [then known] device which would secure the result intended, would be open to him.

Ib.

Of like purport, see La Borde, (3) *supra*.

10. Though the patentee of a combination whose original [broad] claim was rejected in view of the prior state of the art, and who thereupon, in order to secure allowance, presented the limited claim seen in his patent, is held strictly to the structure described in his claim, he is not thereby shut out from the doctrine of equivalents.

Rodebaugh *v.* Jackson, *Brown, J.*, 25 Feb., 1889, 47 O. G., 650.

NOTE. — The drift of rulings such as (6) and (10) *supra*, and (10) PUBLIC RIGHTS, ETC., would appear to permit the inventor of one of a series of steps in a known art to invoke the doctrine of equivalents no further than to include devices, which fall strictly within the terms and limitations of his claim, especially when those limitations were imposed by the applicant himself after rejection, in order to secure the patent. The connection of the author (in the capacity of expert) with the above case, and with that of Sargent *v.* Hall Safe & Lock Co., ❁, enables him to state that such, practically, was the precise position of the Court in each of those cases.

ERROR OF JUDGMENT.

Where it was sought to surrender a patent for correction and have it re-issued without expense to the applicant, on the ground that certain claims in the patent were found to be anticipated, and that the Office had overlooked the anticipating patents: *Held*, that to file a disclaimer or have a re-issue would seem to be the

proper remedy, but that the case did not fall within Rule 170, as to re-issue without fee. That rule applies only to cases of *clerical* mistakes. If there was any mistake in this case upon the part of the Office, it was, so far as appeared from anything in the record, one of judgment. Whether or not claims in an application are anticipated is a matter requiring the best judgment of the Examiner, and until there is evidence to the contrary, it must be taken for granted that such judgment was exercised. Besides, it could not be said that the error, if any, was entirely the fault of the Office; for if the claims were anticipated, that fact could, by the exercise of reasonable care and diligence, have been discovered by the petitioner as well before the patent was issued as after.

Cunningham, x. p., *Fisher, Act. Com.*, 20 Aug., 1890, C. D. Ms.

Compare Edward Miller & Co. *v.* Bridgeport Brass Co., (2) RE-ISSUE, and Thompson, x. p., (1) OFFICIAL OVERSIGHT.

ESTOPPEL.

1. Although a patent may be void, *the patentee* is estopped from urging that plea as a defence to a suit by his assignee for infringement.

Adee *v.* Thomas, U. S. C. C. E. D. N. Y., *Lacombe, J.*, 25 Jan., 1890, 41 F. R., 342.

2. While applicant had an application pending, he filed a second application for improvements not shown in the first. After the second application went to patent, he continued to assert his title to broad claims upon the fundamental feature of the organization as described in the first application: *Held*, that he was under no obligation to press under the second (although first to be

patented) application — filed for the purpose of securing improvements and modifications — the broad claims originally asserted upon the first application. But if he had asserted and obtained allowance of claims under the second application which might have been based upon the structure of the first application, he would thereby have barred himself from claiming in the first application any portion of the same invention.

Schickner & Marty, x. p., *Mitchell, Com.*, 17 June, 1890, C. D. Ms.

Compare Upton, x. p., (2) DEDICATION; Suffolk Co. *v.* Hayden, (1), Washburn *v.* Barbed Wire Co., (2), (3), Two INTERFERING PATENTS TO SAME INVENTOR; Edison, x. p., (2), Brush Elec. Co. *v.* Elec. Ac. Co., (5), ORDER OF ISSUE.

3. Defendant's *use* of the patented article estops him from denying its utility.

West. Elec. Co. *v.* La Rue, U. S. S. C. By *Brown, J.*, 35 L. ed. 294, ✿.

4. If the defendants have used the plaintiff's invention, or something substantially like it, they are estopped from denying its utility. It is fair to presume that they would not have used it if they thought it of no utility.

Coleman *v.* Liesor, *Leavitt, J.*, 1859, Law's Digest, 281.

5. Where a patentee, in his application, had claimed a certain construction, and, upon rejection by the Patent Office, erased the claim: *Held*, that he was thereafter estopped from asserting such a claim.

Dodds *v.* Stoddard, *Sage, J.*, 16 July, 1883, 24 O. G., 799.

The authorities on the doctrine laid down in Dodds *v.* Stoddard, *supra*, are collected in Roemer *v.* Peddie, ✿, (72) CLAIM. See also Sargent *v.* Hall Safe and Lock Co., ✿, (10) PUBLIC RIGHTS, ETC.

For various applications of the doctrine of estoppel see Hoeveler & McTighe *v.* Verner *v.* Nicholson, Jr., (62), and Del Grande *v.* Mannie, (62′) INTERFERENCES.

EVIDENCE.

Where the Examiner of Interferences had denied a motion for leave to take testimony abroad, on the ground that the parties had filed a stipulation that the testimony should be taken in St. Louis: *Held*, that as it appeared that the testimony was material, that the party making the motion was acting in good faith and not seeking delay, and that it was impossible to compel the witness's attendance in this country, the strict term of the stipulation should not be insisted on, and that the leave prayed for should be granted.

Leeman *v.* Smith, *Fisher, Act. Com.*, 27 June, 1890, C. D. Ms.

EXAMINATION.

1. The attitude of the Office toward an applicant should be friendly, — not obstructive.

The Rules of the Office, particularly Rules 68 and 139, point out that, at all times in the investigation of an application and in the progress of appeals, it is the duty of each tribunal having jurisdiction of the case to see to it that the inventor *shall secure a patent* for whatever patentable matter may be shown in his application. As has been frequently stated by me in decisions, the Office must put itself in the attitude of a friend — not of a litigant — with the applicant, and see that he secures every right that belongs to him. I do not mean by this that it is the duty of the Examiner to become an agent or attorney for the applicant; but I think, in all cases where he is satisfied or believes that the application contains patentable matter which is not claimed, *but which he has reason to believe the applicant is seeking*

to cover, it is his duty to advise the applicant briefly and specifically, precisely as the Examiners-in-Chief and the Commissioner are authorized to do, as above stated. By acting on this principle all tribunals of the Office become friendly to the applicant, and enable him to clearly see and understand the views of the Office as to the nature and patentability of the invention described. Such practice would undoubtedly tend to lessen the correspondence and conflicts which arise between applicants or their counsel and the Office.

Donavan, *Hall, Com.*, 9 July, 1888, C. D. 100.

Compare (1) DILATORY METHODS; (2) EXAMINER; and for restriction of above to *ex parte* cases, see OFFICIAL INFORMATION and OFFICIAL SUGGESTIONS.

2. Examiner's action must not be such as would prevent applicant obtaining full investigation of his rights on appeal.

Where the claims were neither lacking in intelligibility or definiteness, and the Examiner declined to consider the merits of certain definitely stated claims for an article of manufacture, for the reason that in his opinion "said claims fail to point out any qualities in the thing claimed which could legitimately be considered in connection with the patentability of an article of manufacture," a petition, on applicant's behalf, praying that the Examiner be "directed to make the examination required by the statute, allowing or rejecting said claim," — was granted.

No requirement of amendment insisted upon, as a condition precedent to further examination, can be either legal or permissible which tends, in the minutest degree, to prevent an applicant from obtaining a full investigation of his rights on appeal.

Rogers, x. p., *Mitchell, Com.*, 16 Nov., 1889, 49 O. G., 1361.

See to same purport; Lapham, x. p., (4) AMENDMENT; and Burt, x. p., (3) *infra*.

3. The Examiner's objections should be fully stated.

It should never be considered a work of supererogation on the part of an Examiner to give an applicant such full and complete information as to objections as will enable him to judge of the propriety of complying with the demands of the Examiner or of taking a petition on appeal.

Burt, x. p., *Fisher, Act. Com.*, 4 Dec., 1889, 49 O. G., 1986.

4. Upon final rejection following a material amendment, applicant has choice of two remedies.

When, after a material amendment, the Examiner rejects without giving new reference or reasons and announces said rejection to be final; and thereafter, applicant offers another amendment, which the Examiner refuses to consider: *Held*, that, the first amendment having been of a material character, applicant was entitled to a reconsideration or to further amend at his discretion, and having elected to take the latter course, the Examiner should have incorporated the amendment and considered the same.

Griswold, x. p., *Mitchell, Com.*, 25 June, 1890, 50 O. G., 838.

5. Examiner may reject a claim, for undue breadth, but may not refuse to entertain it.

Where the Examiner had objected to a claim because of its undue breadth only, and declined to consider it upon "the merits," until it had been restricted in form: *Held*, that the reason given was a reason why the claim should be rejected, but not why an examination should be refused.

Opdyke, x. p., *Mitchell, Com.*, 2 Dec., 1889, 50 O. G., 1293.

6. On petition by applicant for certain action and for advice, the Examiner says that "so far as he is able to

understand applicant's petition, its object appears to be twofold, namely: (*i*) to compel an action upon the merits of an amendment, which" in the Examiner's opinion "involves a material departure from the invention originally disclosed, and (*ii*) to obtain an instruction to the Examiner that he shall inform applicant as to what he is entitled to and the words in which it should be embodied, and that Examiner should then allow the case on it." It has been repeatedly held by the Commissioner, that where claims are rejected, they should be rejected for all the reasons which, in the opinion of the Examiner, are applicable, in order that each case may, upon such appeal, take a decided step toward completion (Roberts', x. p., 51 O. G., 155; Wiard, x. p., 51 O. G., 155). If, in the present case, an appeal should be taken upon the question of identity with the invention originally disclosed, and the Examiners-in-Chief should reverse the decision of the Primary Examiner, the question of novelty would remain undisposed of, and further action by the Examiner would be necessitated. Such a situation is to be deprecated, and it has been the uniform ruling of the present Commissioner that *all grounds of objection should be stated*, by the Primary Examiner, *in advance of the appeal*, in order that there may be no necessity to retrace steps for the purpose of considering questions pertaining to the jurisdiction of the inferior tribunal.

As to the second point; the Examiner states that Rule 14 is distinct and reflects the settled practice in stating that the Office cannot act as counsellor for individuals. The language, however, of the rule is that "*except as to questions arising within the Office*," it cannot so act. It is true that the cases are not relatively numerous in which *unsought* advice should be tendered, but *where advice is asked, there is, ordinarily, no reason why it should not be given.* The current practice is laid down by Mr. Commissioner Hall, in Donovan, x. p., (1888, C. D. 100).

In the present case, the Examiner holds that the applicant is entitled to nothing, and such being his opinion, he can, of course, afford the applicant no aid in the way of suggestion or advice.

Bailey, x. p., *Mitchell, Com.*, 10 July, 1890, 52 O. G., 608.
Compare Donavan, x. p., (1) *supra*.

7. An application which described a process but claimed only an article of manufacture produced by said process (which claim was finally rejected on appeal), may be amended by substituting a claim to the process.

An application for a patent which claimed an article of manufacture and which described (without claiming) a process for making it, having been rejected by the Examiner, and said rejection confirmed by the Board and by the Commissioner. was, upon petition by applicant, remanded to the Examiner for examination upon "the merits," in order that, should applicant desire to appeal to the Supreme Court of the District of Columbia, the whole case might go up at once; or so that the applicant might be fully advised of the state of the art before deciding whether to adopt a claim suggested by the Examiners-in-Chief, or a suggestion made by the Commissioner that the proper form of claim was a process.

Rogers, x. p., *Mitchell, Com.*, 16 Nov., 1889, 49 O. G., 1361.

For decision of like purport, see Butterfield and Batchelor, x. p., (2) RE-OPENING OF CASE.

Compare, however, Phelps, x. p., (14) AMENDMENT; Kinzer, x. p., (54) THE CLAIM; Jameson, x. p., (8) REINSTATEMENT OF CLAIM, and numerous cases there cited.

For conditions which permit claim to process and claim to product to be included in one and the same patent, see Blythe, x. p., JOINDER OF PROCESS AND PRODUCT.

8. Where the claim is so unintelligible as to mean nothing, or so indefinite as to mean anything, the law warrants a refusal to enter upon the examination until the claim is corrected in form.

Ib.

See Barrett, x. p., (12) THE CLAIM; Burkhart, (1) OPERATIVENESS.

9. Examiner's refusal to examine an application as to patentability of invention because applicant had not, in his specification, "particularly pointed out and distinctly claimed the part, improvement, or combination which he claimed as his invention," as required in Section 4888 R. S., was sustained.

Raymond, x. p., *Mitchell, Com.*, 29 Oct., 1889, C. D. Ms.

NOTE. — Applicant's so called "claim" was to a result independent of any specified means or structure.

10. The Examiner in his second action rejected the application *finally*, not on any reference, but because he considered the claims "vague and indefinite," and based his action on ruling in Paige, x. p., 40 O. G., 807. The Assistant Commissioner directed the case to be kept open for further action, and remarked, that the Examiner seemed to have overlooked the fact that since the Paige decision there has been that of the United States Supreme Court in Morley Sewing Machine Co. *v.* Lancaster (47 O. G., 267), ✿, and those of the Commissioner in Pacholder, x. p. (40 C. D. Ms., 299); Laskey, x. p. (Ib. 350); and Weidenbusch, x. p. (Ib. 412); and that, if the Examiner's objection of vagueness and indefiniteness means that what the claims cover cannot be readily understood, it relates to a question of *form*, and hence is not a ground for final rejection; if, on the other hand, it means that the claims are too broad for allowance, it depends upon the state of the art, and is

an objection which cannot be considered apart from the state of the art.

Anderson, x. p., *Fisher, Act. Com.*, 24 Nov., 1890, C. D. Ms. Compare Crane, x. p., (8) EXAMINER.

11. The fact that the Examiner, in the progress of the case, has once allowed a claim, is no reason why he should not subsequently reject it if necessity should demand such action.

Clouser, x. p., *Fisher, Act. Com.*, 28 Nov., 1890, C. D. Ms.

12. Where applicant has two or more cotemporary applications for the same invention.

A pending application is in no-wise affected by the entry of a second or any subsequent application for the same invention by the same inventor. There is no abandonment of the earlier case, and all the applications are to be treated as if filed by independent inventors. If, however, a patent issues upon one of the applications, no claim will be allowed thereafter in the remaining case or cases which covers subject-matter set forth in the patent.

Langlois, x. p., *Spear, Com.*, 27 Feb., 1878, 14 O. G., 84.

Compare Smith, x. p., (4) THE APPLICATION; and The Suffolk Co. *v.* Hayden, ❁, (1), and The Washburn Co. *v.* The Barbed Wire Co., ❁, (2), TWO INTERFERING PATENTS TO SAME INVENTOR. See also Gabouri, x. p., (13), and Feister, x. p., (14), *infra*.

13. The bare fact that one application is pending when another is filed [by the same applicant for the same invention] constitutes no reason for refusal or rejection of the second case, providing it has reached condition for action; but after one application, which describes and claims a particular invention or a particular feature, has been passed to issue, no other application

which describes and claims the same invention or feature should be passed.

Gabouri, x. p., *Montgomery, Com.*, 31 July, 1886, 37 O. G., 217.

14. Where an applicant has two applications pending which contain substantially the same claims, the Examiner should not require formal abandonment of one application as the condition of allowing the other to proceed to issue, nor should he require the erasure of any claims which would be allowed if no other application awaited consideration (Langlois, x. p., 14 O. G., 84). The true course for the Examiner is pointed out in Gabouri, x. p., (37 O. G., 217). In the case of Smith, x. p., (44 O. G., 183) relied on by the Examiner, the Commissioner, in that case, — although holding that the Examiner ought not to be required to proceed with all the applications, allowing or rejecting them as if they were by different inventors, — *did not decide that the applicant could be required to cancel one or more claims in the allowed application, or to abandon one or more of the other applications, as a condition precedent to such allowance.*

Feister, x. p., *Mitchell, Com.*, 31 Oct., 1890, 53 O. G., 1089.

See COMMISSIONER, ETC.; EXAMINER ; OFFICE PRACTICE.

EXAMINER.

1. Ordinarily; requirement of division should precede action on the merits.

The Examiner states that the subject-matter of the amendment was such that, had it been presented in the original application, division would have been required. If such be the fact, he should, instead of incorporating the amendment and then rejecting it, have declined to incorporate it, so that, upon petition to the commis-

sioner, the question of division could have been disposed of (Regan, x. p., 188 C. D. 161).

Bailey, x. p., *Mitchell, Com.*, 10 July, 1890, 52 O. G., 608.

2. Examiner should not unnecessarily protract the examination and proceedings in the application; it should, on the contrary, be his aim to afford every facility to the applicant consistent with the rights of others.

The application, although coming before me as if it were a petition, is in fact a complaint made against the Examiner, reciting the several actions in the case which are claimed to constitute improper and oppressive practice. Without minutely inspecting the several items of the charge, I cannot resist the impression — and it is a very decided impression — that there is ground for the complaint, and it is a matter of regret, that after my predecessor had been called upon to act in this case and had made a decision, which to my mind indicates that he was clearly of the same opinion that I am compelled to entertain, the Examiner should not have taken steps to hasten rather than to protract the examination and proceedings in the application. I am not satisfied with the Examiner's explanation. Making due allowance for all obstacles, I have no doubt whatever that this case should have been in condition for allowance or for appeal to the Examiners-in-Chief, if it had been the aim of the Examiner to afford every facility to the applicant consistent with the rights of others.

Steps will be taken at once — if they have not been already taken — to put this application in condition for allowance or appeal.

Anderson, x. p., *Mitchell, Com.*, 12 June, 1889, 47 O. G., 1633.

See, of like tenor, Williamson, x. p., (1) DILATORY METHODS.

3. References should be given in detail.

On petition from applicant [objecting to want of particularity in the official letter]; the Examiner was instructed to point out the specific portions of the descriptions and drawings in the references which, in his opinion, disclose applicant's invention in whole or part, as directed in Rule 65, in order that applicant may see his way clear to withdraw or modify [or persist in ?] his claims.

Goodline, x. p., *Mitchell, Com.*, 21 Feb., 1890, C. D. Ms.

4. Newly Discovered References.

The proper course to be pursued by an Examiner, on discovering a new ground for rejection subsequent to an appeal to the Examiners-in-Chief, is to direct the attention to it of both applicant and the Examiners-in-Chief. The applicant may then elect to continue the prosecution of the appeal, or to withdraw the appeal and be heard by the Primary Examiner.

Mevey, x. p., *Mitchell, Com.*, 19 Ap., 1890, 56 O. G., 805.

Compare Roach, x. p., (5), and Robbins, x. p., (6) *infra*; Clouser, x. p., (11) EXAMINATION, and Ries, x. p., REMANDMENT TO PRIMARY EXAMINER.

As to the particularity required of applicant, see Raymond, x. p., (9) EXAMINATION, and Kalteyer *et al*, EXPLICITNESS.

5. If, subsequent to filing of the appeal, the Examiner discover a further reference, or should an additional reason for rejection come to him in any way, he should notify the applicant and the Examiners-in-Chief (Mevey, x. p., 43 Ms., 33).

Roach, x. p., *Mitchell, Com.*, 9 Oct., 1890, C. D. Ms.

6. Res Adjudicata.

Nothing done by the Examiner can be considered as *res adjudicata* until the case has passed beyond his juris-

diction, and, until the Examiner has signed the file-wrapper, he cannot be said to have rendered a favorable decision. The office of the Examiner is continuing, and no Examiner is concluded by any action of his predecessor before the case has passed to issue (Fredericks & Burns, x. p., 1887, C. D. 66).

Robbins, x. p., *Fisher, Act. Com.*, 28 Feb., 1891, C. D. Ms.
Compare Roach, x. p., (11) *infra*.

7. Examiner's statement of appeal must cover all his objections.

Where one of the objections made by the Examiner was not touched upon in his statement: *Held*, that it was not necessary to consider the objections further.

McMillen & Hurst, x. p., *Frothingham, Act. Com.*, 12 Oct., 1891, C. D. Ms.

8. It is within the province of the Examiner's duties to call applicant's attention to such irregularities and informalities in claims as, in his opinion, should be corrected.

Crane, x. p., *Frothingham, Act. Com.*, 18 Nov., 1891, C. D. Ms.

Compare Pacholder (1) and cases following it in PHRASEOLOGY. Also see Noyes, x. p., (9), and Atkinson, x. p., (11), THE SPECIFICATION.

9. Opinion on Fact.

Where, on a question of division, applicant alleges that his article cannot be produced except by his process, and the Examiner says it can, without pointing out the mode, the Examiner's position is not tenable.

Hine, x. p., *Simonds, Com.*, 14 July, 1892, 60 O. G., 576.

10. When a rejected application has passed all the stages specified in Rule 134, and the appeal has been

decided by the Primary Examiner to be regular in form, nothing remains for him to do—unless an amendment has been admitted under the appropriate provision of Rule 68 — except to furnish the Examiners-in-Chief with a written statement of the grounds of his decision and of the points involved in the appeal, with copies of the rejected claims and the references applicable thereto (Rule 135).

Roach, x. p., *Mitchell, Com.*, 9 Oct., 1890, C. D. Ms.

11. On transfer of a case to another division all duties devolve on the new Examiner.

When, after application has been twice rejected and an appeal taken, the application is transferred to another division, all duties of the Primary Examiner in connection with that case devolve on the Examiner in charge of that division.

Ib.

Compare Robbins, x. p., (6) *supra.*

See COMMISSIONER, ETC.; OFFICE PRACTICE.

EXECUTION.

Court may enforce transfer of a patent-right to satisfy a judgment debt.

A patent-right may be subjected by a bill in equity to a decree for assignment to satisfy a judgment debt of patentee. On neglect of the latter to assign as decreed, the court may appoint a trustee to execute an assignment in conformity with the statutory requirements for such transfer.

Alger *v.* Murray, U. S. S. C. By *Gray, J.*, 6 Mar., 1882, 21 O. G., 1197, ❁.

EXECUTOR.

See DECEASE OF INVENTOR.

EXECUTORY AGREEMENT.

A party who bases his rights, as an assignee, upon an instrument of writing, recorded in the Patent Office before application was made, and which does not explicitly identify a given invention, will not be permitted to examine the files, because such an instrument is not an assignment, but a mere *executory agreement.* The language in case of Wright *v.* Randall was used with reference to facts which make it exactly applicable to this case. No assignment of an unpatented invention is required, by Section 4895, R. S., to be recorded, unless it is an assignment on which a patent is to be issued to the assignee, and, in such a case, the invention must be *so identified in the assignment, by reference to a specification, or otherwise, that there can be no mistake as to what particular invention is intended* (Wright *v.* Randall, 14 Blatchford, 495; Regan Vapor Engine Co. *v.* Pacific Gas Engine Co. *et al.*, 58 O. G., 1695).

Lorentz, x. p., *Simonds, Com.*, 28 Mar., 1892, 59 O. G., 158.

EX-PARTE APPLICATION.

No counter claimant and no prior patent, publication, or practice appearing; an application which clearly describes and distinctly claims a new and useful invention entitles the applicant to a patent therefor.

Sections 4887, 4888, and 4904 Revised Statutes.

EXPERIMENT.

See Chipman *v.* Fales, (1) ABANDONED EXPERIMENTS; City of Elizabeth *v.* Nicholson Pavement Co., (9) DILIGENCE; Root *v.* Third Avenue R. R. Co., (1) PUBLIC USE; Bentley *v.* Wightman *v.* Sprague, (13) REDUCTION TO PRACTICE.

ÉXPERTS.

1. The refusal of the Court below to hear the opinion of éxperts as to the construction of the patent was proper. Éxperts may be examined as to the meaning of terms of art, on the principle of *cuique in sua arte perito credendum*, but not as to the construction of written instruments.

Corning *v.* Burden, U. S. S. C. By *Grier, J.*, 15 Howard, 252, ✿.

2. After a decision by the Examiners-in-Chief, an amendment, with nothing to support it but an affidavit by an éxpert, to the effect that the references do not anticipate applicant's invention, will not be received (see Rules 142 and 168, and case of Parker, x. p.).

Anderson, x. p., *Fisher, Act. Com.*, 18 Feb., 1890, C. D. Ms.

3. The Primary Examiner is presumed to be an éxpert, and is the proper judge of the sufficiency of description of an invention pertaining to his class of subjects.

Prochaska, x. p., *Frothingham, Act. Com.*, 31 Oct., 1891, C. D. Ms.

Compare Franklin, x. p., (3), and Holt, x. p., (4), THE CLAIM; Rogers, x. p., (8), and Raymond, x. p., (9), EXAMINATION; and Crane, x. p., (8) EXAMINER. See also Kalteyer *et al.*, x. p., EXPLICITNESS.

EXPLICITNESS.

The explicitness required in a patent claim is well illustrated by comparing with the claims originally presented by Kalteyer & Bartholomew, Jr., of the re-

vised claims substituted in conformity with a suggestion of the Commissioner.

(The qualifying words, inserted at the Commissioner's suggestion, are in italics.)

Original Claims.	Claims after Revision.
1. In the process of preparing and tempering slurry for Portland cement; the process of mixing and correcting the proportions, which consists of taking soft, damp, or wet, freshly-dug, and unprepared clay, and soft, damp, or wet, freshly-dug, and unprepared calcareous material, mixing and working the same when fresh, testing a portion thereof to ascertain the proportion of the mass, and then, if necessary, correcting the proportions by adding material, as described.	1. In the process of preparing and tempering slurry for Portland cement; the process of mixing and correcting the proportions, which consists of taking soft, damp, or wet, freshly-dug, and unprepared clay, and soft, damp, or wet, freshly-dug, and unprepared calcareous material, *in approximately the proportions herein set forth*, mixing and working the same when fresh, testing a portion thereof to ascertain the proportion of the mass, and then, if necessary, correcting the proportions by adding material, as described.
2. In the manufacture of Portland cement; the process of preparing and tempering slurry, which consists in weighing the freshly-dug clay and limy materials, mixing and working them when soft, damp, or wet, testing a portion of the mass, and, if necessary, adding material thereto, as described.	2. In the manufacture of Portland cement; the process of preparing and tempering slurry, which consists in mixing, *in proportions determined by weight*, the freshly-dug clay and limy materials, working them when soft, damp, or wet, testing a portion of the *mixed* mass *to determine proportions*, and, if necessary, adding material *to attain the desired proportions*, substantially as described.

Kalteyer *et al.*, x. p., *Simonds, Com.*, 18 Aug., 1891, 57 O. G., 1127.

Compare Franklin, x. p., (3), and Holt, x. p., (4), The Claim.

EXTENSION.

The statutory provisions to enable (under certain showings) prolongation of the term of a U. S. patent for invention, ceased 2 Mar., 1875.

R. S. 4924.

EXTENT OF USE.

Where the question is upon the patentable character of the invention, evidence that it had practically superseded all other devices of its kind, with the object of establishing patentable novelty, is not material. Where there is no invention the extent of use is not a matter of moment.

Adams *v.* Bellaire Stamping Co. *et al.*, U. S. S. C. By *Field, J.*, 16 Nov., 1891, 57 O. G., 1280, ✿.

Compare Bruce *v.* Marder, (1) UTILITY, — and cases following it.

FEES.

1. Patent Office not an Instrument of Revenue.

While it is true that a fee accompanies each application filed, it must be borne in mind that the Patent Office does not proceed on the principle of a tax-gatherer or a store-keeper, and will not, for the mere purpose of swelling the amount of its receipts, countenance promiscuous filing of applications.

Smith, x. p., *Hall, Com.*, 16 Aug., 1888, 44 O. G., 1183.

2. Where a new fee on a second appeal is not required.

Where, upon appeal to the Examiners-in-Chief, they rejected one of the claims upon the ground that it was "too indefinite and broad," — a reason for rejection not raised by the Primary Examiner, — and applicant was permitted by the Commissioner to incorporate into the case another claim in place of said claim, and the Examiner rejected the new claim as being "even more broad and indefinite" than its predecessor, but refused to take action on an appeal from that rejection until another appeal fee had been paid: *Held*, that under

the facts of the case a new fee is not required, and the appeal should be transmitted.

Thomson, x. p., *Frothingham, Act. Com.*, 10 July, 1891, C. D. Ms.

3. Money paid by actual mistake, such as a payment in excess, or when not required by law, or consequent on neglect or misinformation on the part of the Office, will be refunded; but a mere change of purpose after the payment of the money, as when a party desires to withdraw his application for a patent or for a registration of a trade-mark, or to withdraw an appeal, will not entitle a party to demand such a return.

(P. O. R., 224.)

4. Where, after Examiner's rejection of a claim upon certain references, and after reversal of his decision by the Examiners-in-Chief, the Examiner again rejected the claim, upon a newly discovered reference, and applicants, considering the new reference an anticipation, cancelled the claim: *Held*, that their petition to have the appeal fee refunded could not be granted.

Ellis & Spence, x. p., *Frothingham, Act. Com.*, 29 May, 1891, C. D. Ms.

For like action, see Cunningham, x. p., ERROR OF JUDGMENT.

5. Where an attorney advanced the registration fee for a trade-mark, and shortly after, upon learning that the applicant was insolvent, requested leave to withdraw the application and asked for return of the fee: *Held*, that the payment was constructively a payment by the applicant, and that, therefore, under the established practice, the fee could not be refunded nor the application withdrawn.

The Empire City Elec. Co., x. p., *Frothingham, Act. Com.*, 6 Aug., 1891, C. D. Ms.

For like action in similar cases, see (6), (7), (8), and (9) *infra.*

6. Where, after several actions, Examiner held that the matter was not a proper subject for design patent: *Held*, that the fee of thirty dollars could not be refunded (Bailey, x. p., 1886, C. D. 39; Baer, x. p., 42 C. D., Ms. 106; Sellers, x. p., 1870, C. D. 58).

Wilson, x. p., *Frothingham, Act. Com.*, 6 Feb., 1892, C. D. Ms.

7. Applicant filed two applications for designs which were substantially the same, one for a "tablet" and the other for "soap," and (after they had been prosecuted to rejection, and, finally, became abandoned for want of prosecution) applied for a return of the fee paid on one of them, on the ground of mistake, and that it should be repaid under Rule 224 and Carty, x. p., 44 O. G., 570: *Held*, that it was clear that both applications had been filed on the theory that both were necessary to adequate protection; it was not a payment by mistake, but an intentional payment, and therefore not a case similar to that of Carty, x. p., *supra*, where the Office held that a fee accompanying a caveat for a design should be returned. There was no authority of law for filing a caveat for a design, but there is authority for filing *applications* for designs.

Chidester, x. p., *Frothingham, Act. Com.*, 28 Mar., 1892, C. D. Ms.

8. Where, upon Examiner requiring division of a joint application, an application, intended to be a divisional one, was inadvertently made a sole application by one of the co-inventors: *Held*, that the application could not be charged to, nor its fee applied to, a joint application. In this case the Acting Commissioner said: I find that this question has been passed upon by three Com-

missioners, and that they have all decided that *where the case had gone forward to the Examiner and had received action by him*, new parties could not be substituted in place of the old (Maxheimer & Trubey, x. p., 19 C. D. Ms., 155; Wilder & Kauffer, x. p., 33 C. D. Ms., 457; Hincley, x. p., 36 C. D. Ms., 486).

Hogan, x. p., *Fisher, Act. Com.*, 9 May, 1890, C. D. Ms.

9. Where an application was filed to take the place of one which had been stricken from the files because signed and sworn to in blank: *Held*, that the fee paid on the first application could not be applied to the second application, as the case came within the principle laid down in Hogan, x. p., 9 May, 1890.

Sereno N. Ayres, x. p., *Fisher, Act. Com.*, 13 May, 1890, 51 O. G., 1944.

"FEIGNED ISSUE."

An interference may be regarded in the light of a "feigned issue" out of chancery for the determination of a particular question, and when justice requires it, other questions can, meanwhile, be allowed to remain unsettled.

Hunter, Jr. *v.* Lane, *Simonds, Com.*, 3 June, 1892, C. D. Ms.

Compare Atkinson *v.* Bentley, (6) INOPERATIVENESS, and Hunter, Jr. *v.* Lane, (65) Prowattain *v.* Holt, (111) INTERFERENCES.

FIRST INVENTOR'S RIGHTS.

Double Use.

The principle that the inventor of a machine is entitled *to* the benefit of all the uses to which it can be put, — no matter whether he had contemplated that particular use or not (Roberts *v.* Ryer, 91 U. S. 150, ✿; Stone *v.* Chicago, 104 U. S. 547), ✿, applies both to pre-

venting a mere double use of an old thing being patented, and also to giving the first inventor the exclusive use of the thing invented for all purposes and uses to which it can be put.

Dalton, x. p., *Simonds*, *Com.*, 18 Feb., 1892, C. D. Ms.
Compare, of like purport, (38) *et seq.*, THE CLAIM.

FOREIGN APPLICANT.

1. Oath of invention taken abroad, by an applicant for a United States patent, must be taken before one of the kinds of officers designated in Section 4892 R. S., to wit: any minister, *chargé d'affaires*, consul, or commercial, agent, holding commission under the government of the United States; or before a notary public of the country in which the applicant may be.

Gruson & Schumann, x. p., *Butterworth*, *Com.*, 5 Jan., 1884, 26 O. G., 274.

2. The validity of a United States patent is not made dependent on the putting the invention into use either before or after obtaining a patent, and, as it is required that a foreign patent or printed publication shall fully, clearly, and exactly describe the invention in issue before it can be considered as evidence at all, it must be held that where these requirements are complied with, the patent or publication is evidence of a perfected invention. (Deprez & Carpentier *v.* Bernstein *v.* Hunter *v.* Gaulard & Gibbs, 54 O. G., 1709).

Gueguen *v.* Westinghouse, *Mitchell*, *Com.*, 20 Mar., 1891, C. D. Ms.

3. A foreign contestant in an interference proceeding cannot set up the date of his invention or the practice thereof in a foreign country. He must rely either upon a foreign patent or printed publication, or upon the knowledge or use of the invention in the United States.

Ib.

FOREIGN PATENT.

1. The tribunals of every nation take judicial notice of the public seals of foreign states, and the seal will be presumed to have been attached by a person having custody thereof and competent to do the act.

Edison Elec. Lt. Co. *v.* U. S. Elec. Lt. Co., *Wallace, J.*, 1888, 43 O. G., 1456.

2. Rights under a Foreign Patent not recordable in the United States Patent Office.

Request to record assignment of certain foreign patents was denied. Foreign patents are not, in terms, within the statutory provisions of the United States relating to the recording of assignments, and cannot be included by implication.

Dodge & Son, x. p., *Mitchell, Com.*, 27 Nov., 1889, C. D. Ms.

3. The Commissioner has no authority, under Section 4887 R. S., to grant a U. S. patent for an invention described in an expired foreign patent, and a patent so granted is without authority of law and void.

Huber *v.* Nelson M'f'g Co., *Thayer, J.*, 38 F. R., 830.

FOREIGN USE.

Previous use of the invention abroad does not invalidate a United States patent.

In the absence of either a patent or a printed publication, the use of the invention in a foreign country, or the knowledge of such foreign use by persons residing in this country, will not defeat a U. S. patent granted to a *bona fide* inventor, who at the time, was ignorant of such foreign use or existence of the invention.

Coburn *v.* Schroeder, *Wheeler, J.*, 8 Mar., 1882, 22 O. G., 419.

See, also, Schillinger *v.* The Greenway Brewing Co., 24 O. G., 495; Illingworth *v.* Spaulding, 27 O. G., 300; and Brown *et al. v.* Bixby, 57 O. G., 123.

FOREIGN VESSEL.

The right of a U. S. patentee does not extend to a foreign vessel lawfully entering one of our ports; and the use of the improvement in the construction, fitting out, or equipment of such vessel abroad, is not an infringement of the rights of an American patentee.

Brown *v.* Duchesne, U. S. S. C. By *Taney, Ch. J.*, Dec. term, 1856, 19 Howard, 183, ✿.

FORFEITED APPLICATION.

See ABANDONMENT OF AN APPLICATION; FORFEITURE; REINSTATEMENT OF FORFEITED APPLICATION.

FORFEITURE.

1. Of Application.

Where it appeared that, upon the last day upon which an application could be prosecuted without forfeiture, amendments, apparently of no considerable importance, were offered, including one or two formal corrections which had been called for by the Examiner, and that said amendments were made in good faith for the purpose of prosecuting the application: *Held*, that the action, so far as it went, was a proper action, and that there was not such utter failure to prosecute within two years as would warrant a judgment forfeiting rights.

Todd, x. p., *Mitchell, Com.*, 21 Oct., 1889, 49 O. G., 732.

2. Where the Examiner required a model, and, thereafter, applicant took no action until more than two years had elapsed, when he filed a petition to revive the

application, and the affidavit in support of the petition set forth that petitioner had been unable, for lack of money, to prosecute his application or to procure a model; that during a portion of the time he had been sick; that he lived in a section of the country provided with few facilities for mechanical construction, and few skilled artisans; that his solicitor lived in New York, while he lived in North Carolina, and that, consequently, communication had to be carried on with said solicitor exclusively through the mails: *Held*, that the statement did not make out such a case of *unavoidable* delay as the statute requires (Waite, x. p., 39 C. D. Ms., 431).

Cushman, x. p., *Fisher, Act. Com.*, 25 Oct., 1889, C. D. Ms.

3. Assignee.

The right to renew an application which has become forfeited by failure to pay the final fee in season, is not limited to the inventor; an assignee has that right (Section 4897 R. S.).

Barrett, x. p., *Frothingham, Act. Com.*, 14 Mar., 1891, 56 O. G., 930.

4. It has been uniformly held by the Office that, under Section 4885 R. S., or otherwise, the Commissioner has no discretion to receive the final fee later than six months after notice of allowance: *Hence*, where the last day was 30 Nov., and petition alleged that the fee was duly mailed Saturday, 29 Nov., and, presumably, lay in the Patent Office or Post-Office over Sunday, and it appeared that it was not received by the Patent Office until Monday, 1 Dec., petition to have it counted as received in time was denied.

Riley, x. p., *Frothingham, Act. Com.*, 13 Ap., 1891, C. D. Ms.

See ABANDONMENT; DEDICATION; DILATORY METHODS; DILIGENCE; LACHES; PUBLIC USE.

FORM.

See MATTER OF FORM.

FUNCTION.

1. It is proper to indicate the function which the parts of a device perform, provided the parts themselves are properly included in the combination.

Lockwood, x. p., *Fisher*, *Act. Com.*, 19 June, 1890, C. D. Ms.

See also Raymond, x. p., (14), Thompson, x. p., (15), THE CLAIM.

2. While the promotion of an old device (such, for example, as a torsional spring) to suit a new sphere of action in which it performs a new function, involves invention, the transfer or adaptation of the same device to a similar sphere of action, where it performs substantially the same function, does not involve invention.

Western Elec. Co. *v.* La Rue, U. S. S. C. By *Brown*, *J.*, 13 Ap., 1891, 55 O. G., 571, ✿.

For definition of the word "function," as used in patent jurisprudence, see Corning *v.* Burden, (48) THE CLAIM.

FUNCTIONAL CLAIM.

See FUNCTION, and (29) *et seq.*, THE CLAIM.

GOVERNMENT EMPLOYÉS.

1. The Secretary of the Interior and the Commissioner of Patents are authorized to grant any officer of the Government (except officers and employés of the Patent Office) a patent for any invention of the classes mentioned in Section 4886 R. S., — when such invention is to be used in the public service, — without the payment of any fee: provided that the applicant, in his

application, shall state that the invention described therein, if patented, may be used by the Government or any of its officers or employés in the prosecution of work for the Government, *or by any other person in the United States* [*sic!*], without the payment to him [the patentee] of any royalty thereon; which stipulation shall be included in the patent.

Act 3 Mar., 1883, c. 143., U. S. Stat. XXII., p. 625.

2. No officer or employé of the Patent Office, during the period for which he holds his appointment, may acquire or take, directly or indirectly, — except by inheritance or bequest, — any right or interest in any United States patent [for invention].

Section 480 R. S.

GOVERNMENT USE.

1. A patent right cannot be made use of by the Government, any more than it could by a private individual, without license from the inventor.

McKeever *v.* The United States, U. S. Court of Claims. By *Nott, J.*, 12 May, 1879, 23 O. G., 1525. Judgment affirmed by the Supreme Court of the United States 20 Nov., 1882.✿

Compare (3) *infra.*

2. Where there was clearly a contract (expressed or implied) between the Government and the citizen, and the suit is brought entirely on that agreement, the Court of Claims has the exclusive [original] jurisdiction.

Ib.

Compare Solomons *v.* U. S., (4) CONSTRUCTIVE LICENSE.

3. The Government has no more power to appropriate a man's property invested in a patent than it has to take his property invested in real estate; nor does the mere

fact that the inventor was, at the time of the invention, in the employ of the Government transfer to it any title or interest therein.

Solomons *v.* The United States, U. S. Court of Claims. By *Brewer, J.*, 8 Dec., 1890, 34 L. ed. 667.

HEARINGS.

All hearings in the U. S. Patent Office are had on the day designated in the official notice, and, unless otherwise specified, at the hour of 10 A. M. if before the Commissioner or Assistant Commissioner, and at the hour of 1 P. M. if before the Examiner of Interferences or the Examiners-in-Chief. Hearing before a Primary Examiner is had at the day and hour designated by him.

P. O. R., 151.

IDENTITY.

Of Specific Machine.

A party who, during the original term of the patent, possessed the right to use a specific planing machine does not forfeit that right by an extension of the term of the patent (Wilson *v.* Rousseau, 4 Howard, 646, ✿); nor is the right forfeited by the substitution of fresh knives for old and wornout ones.

Wilson *v.* Simpson, U. S. S. C. By *Wayne, J.*, Dec. term, 1849, 18 Curtis, 58, ✿.

Compare (1) CONSTRUCTIVE LICENSE.

For tests of identity of subjects-matter of two patents, see Brush Elec. Ac. Co. *v.* Elec. Ac. Co. *et al.*, (10) TERM OF A U. S. PATENT.

IGNORANCE NOT PLEADABLE.

1. Ignorance of the Law, the Practice, or Accessible Facts, — not Pleadable.

Applicant and his attorney were bound to *know* what was contained in the record and also what action its condition required; nor was applicant's neglect excused by the fact that the application in question had been confounded with another of his applications.

Brown, x. p., *Frothingham, Act. Com.*, 23 May, 1892, C. D. Ms.

2. Where it was urged, on behalf of a motion for permission to amend the preliminary statement, that applicant had obtained the impression that, for the date of the [nascent] invention, he could go back only to the period at which he exhibited a drawing disclosing it: *Held* insufficient, and permission to amend denied.

Parker *v.* Jarvis, *Fisher, Act. Com.*, 28 July, 1891, C. D. Ms.

3. It must be assumed that the attorney knew that, under the statute (Sec. 4885 R. S.) and the rules (Rule 167), the final fee could be paid within six months from the date the notice was actually sent, and, in default of such payment, the case must be considered abandoned.

Farnum, x. p., *Frothingham, Act. Com.*, 7 Jan., 1892, C. D. Ms.

4. An applicant who, to save expense, employs counsel unfamiliar with interference proceedings to take testimony, cannot, — after discovering that he has not made out his case in such a manner as he might if the testimony had been taken by counsel familiar with such proceedings, — be allowed to retake the testimony (Donellan *v.* Barry, 37 C. D. Ms., 386).

Ricker *v.* Merrill, *Fisher, Act. Com.*, 24 July, 1890, C. D. Ms.

5. There is no showing that the testimony now sought to be introduced is newly discovered, or that, by the aid of competent counsel, it could not have been presented within the time originally allowed. . . . A practice which would permit a contestant to experimentally conduct his own case to a probable failure, and then, after consultation and with competent assistance, would permit him to make further endeavors to show what,—with such assistance,—he could and should have earlier shown, would be contrary to all well established rules and legal principles. Applicant's petition must be denied.

Donellan *v.* Barry, *Hall, Com.*, 37 C. D. Ms., 386.

Of same general tenor, see Jameson, x. p., (1) ESTOPPEL.

For circumstances held to justify a relaxation of above general rule, see Marx, x. p., (5), and Pennington, x. p., (7) RE-INSTATEMENT.

IMPORTATION OF PATENTED ARTICLE.

No Jurisdiction for Prevention of.

The Treasury Department has no means of preventing the importation of goods which do not copy or simulate the name or trade-mark of any domestic manufacturer, although such goods may be an infringement upon a domestic patent.

Treasury notice, *Tichenor, Assistant Secretary of the Treasury*, 26 June, 1889.

NOTE:—A use or sale of such imported goods would, of course, be actionable.

Compare (52) TRADE-MARK.

IMPROVEMENTS.

The inventor has an equal right with any one else to patent improvements upon an original invention for which he is seeking a patent.

Schickner, x. p., *Mitchell, Com.*, 17 June, 1890, C. D. Ms.

INADVERTENCE.

The question whether the facts set forth in the statement filed with a reissue application constitute "inadvertence, accident, or mistake," is one pertaining to "the merits," and is appealable, in the first instance, to the Examiners-in-Chief.

Murphy & Atkinson, x. p., *Simonds, Com.*, 10 Sep., 1891, 56 O. G., 1449.

INCIPIENT INVENTION.

See CONCEPTION; also see, INFANCY OF AN ART.

Compare INVENTION (Basic; Creative; Dominant; Embryo; Fundamental; Generic; Germinal; Pioneer; Primary).

INDIVISIBILITY.

A second patent will not be granted for substantially the same invention, from which it is distinguished only by mental figments.

Where an application was rejected on a patent granted to same applicant the application for which was pending concurrently with the present application, and it appeared that the claims of said patent and said application covered the same invention under a slightly different guise, and that the case was one in which the lines of division between the supposed different inventions existed as mental figments only, and had no corresponding existence in the concrete subjects of invention: *Held*, that the application was rightly rejected because of want of distinguishability of the invention from that claimed in the said patent.

Woodward, x. p., *Mitchell, Com.*, 30 Oct., 1890, 53 O. G., 1090.

Compare Brush Elec. Co. *v.* Elec. Ac. Co. (60) THE CLAIM; also Faure, x. p., (12), and Barrett, x. p., (14), PUB. RIGHTS, ETC.

INFANCY OF AN ART.

For germinal inventions, broad and comprehensive claims are permissible. Claims for improvements at a maturer stage of the art must be drawn subject to all reasonable restrictions.

In the case of patents which represent the infancy of an art or the stage of its earliest development, this Office is solicitous that the inventor should be accorded a breadth of claim, which is commensurate with the breadth and importance of the invention which he desires and is entitled to protect. While the Office will insist on as much definiteness in the language of the claim as the statute calls for, it will also, if it properly discharge its function as the protector of the inventor, leave something to the salutary and benignant agency of construction in the courts. It is the object of the law, and should be the solicitude of the Patent Office, to protect inventors and guard their inventions. In the case of patents which represent the maturity of an art, that object is best secured by taking care that claims for improvements in such an art be drawn with all the reasonable restrictions, so that they shall be valid in spite of everything that is contained in existing patents and of everything previously known or used.

Pacholder, x. p., *Mitchell, Com.*, 26 Ap., 1889, 51 O. G., 295.

INFRINGEMENT.

1. Any use of the invention, even though it may be a new use, constitutes an infringement.

The adaptation of a patented device to another use, where such adaptation does not involve the exercise of the inventive faculty, is an infringement, as much as

though the new machine were an exact copy of the old.

Western Elec. Co. *v.* La Rue, U. S. S. C. By *Brown, J.*, 13 Ap., 1891, 35 L. ed., 294; 55 O. G., 571, ✿.

Of same purport, see Nat. Type Co. *v.* N. Y. Type Co., (29) and cases following it, THE CLAIM; and Dalton, x. p., FIRST INVENTOR'S RIGHTS.

2. When a patent is for a combination, one element of which is a gear-wheel with a cone supported in a peculiar manner, and the defendant uses the gear-wheel with the cone, but the latter is supported differently, though the elements employed by the defendant are the equivalent of those of the complainant in the patented combination: *Held*, that the defendant takes the complainant's combination and infringes his patent.

Mundy *v.* Lidgerwood M'f'g Co., *Wheeler, J.*, 23 Ap., 1884, 27 O. G., 718.

3. Makers of separate parts of a patented device (said parts not being capable of separate use) are joint trespassers.

Where one party manufactures one portion of the device covered by a combination claim, and another party manufactures the other part of the combination, and it does not appear that the two parts are capable of separate use: *Held*, that the parties are joint infringers, and the defendants cannot protect themselves by invoking the well-stated rule that, where a patent is for a combination merely it is not infringed by a party who uses one or more of the parts, but not all, to produce the same results, either by themselves or by the aid of other devices.

Schneider *v.* Pountry, *Nixon, J.*, 30 Aug., 1884, 29 O. G., 84. See also 21 O. G., 1876; 27 O. G., 718.

4. The part manufacture of lens-holders, not themselves constituting an infringement, with intent to complete into the patented article immediately on the expiration of the patent, will not be enjoined, as complainant's monopoly exists only during the life of his patent.

White *v.* Walbridge, U. S. C. C., Vt., *Wheeler, J.*, 46 F. R., 526.

5. It constitutes an infringement to manufacture for the purpose of use, even if not actually used.

Butz Thomas Elec. Co. *v.* Jacobs Elec. Co., *Jenkins, J.*, 1 Oct., 1888, 45 O. G., 838.

6. The mere fact that a person sells an article to which a patented device may be attached does not make him an infringer, providing the article is not so constructed that the patent device and no other can be used with it.

Bliss *v.* Merrill, 1888, C. D. 182.
See also Schmidt *v.* Freese, 21 O. G., 1876.

7. To constitute infringement it must appear that all the elements of a patentable combination, or their equivalents, have been appropriated.

Saladee *v.* Racine Wagon & Carriage Co., *Dyer, J.*, 28 Ap., 1884, 27 O. G., 1133.

8. The scope of a patented invention may be so narrowed by the prior state of the art that infringement cannot be adjudged to exist, unless there has been an appropriation, in substantial form, of the construction of the identical elements which the inventor had a right to claim as new in his patent.

Ib.

9. The burden of proof is upon the defendant to show that the complainant is not the first inventor, and mere preponderance of the evidence in that direction is not enough. The proof must be of such convincing character as to satisfy the court beyond a doubt.

Warwick M'f'g Co. *v.* City of Buffalo, *Coxe, J.*, 8 May, 1884, 27 O. G., 1239.

10. Mere colorable differences or slight improvements cannot shake the right of the original inventor.

2 Gallison, 54.

11. Where the result was the same but the means employed were different, there was no infringement.

Where the defendant substituted for one element of the combination another element, whereby the same result was accomplished, but in a manner different from that described in the patent: *Held*, there was no infringement.

Schmidt *v.* Freese, *Benedict, J.*, 10 May, 1882, 21 O. G., 1876.

Compare Kuhl *v.* Miller, (6), and Coleman *v.* Liesor, (7) EQUIVALENTS.

12. Defendant can be compelled to give the name of one customer to whom he has sold the alleged infringing article.

Roberts *v.* Walley, *Coxe, J.*, Oct., 1882, 26 O. G., 107.

13. Where a device made under one patent has been adjudged to be an infringement of another patent, and where subsequently the interests in both patents became united in one person, the infringing invention may be held to be an improvement of the other as against a person infringing both patents.

Putnam *et al. v.* Keystone Bottle Stopper Co. *et al.*, *Acheson, J.*, 22 Mar., 1889, 38 F. R., 234.

14. The patentee's omission of mark does not exonerate a wilful infringer.

The court will proceed upon the hypothesis that the burden of averring and proving a failure to mark is on the defendant, and, if defendant was notified of patentee's claim, such omission of marking will not exonerate him.

Schofield *et al. v.* Dunlop *et al.*, U. S. C. C., E. D. Pa., *Butler, J.*, 9 May, 1890, 42 F. R., 323.

INHERENT RIGHTS.

1. The patent is a contract between the patentee and the general public.

The productions of my mind are, confessedly, as really property, or the subject of property, as the fabrics of my hand; indeed, they are much more exclusively my own. The patent is a contract by which I convey my invention to the commonwealth forever, in consideration of the exclusive enjoyment of it by myself during a limited period.

William H. Seward, in argument before *Nelson, J.*

2. The American Constitution does not attempt to give an inventor a right to his invention, or an author a right to his composition; it recognizes an original, pre-existing, inherent right of property in the invention, and authorizes Congress to secure to inventors the enjoyment of that right; but the right exists before the Constitution and above the Constitution, and is, as a natural right, more than that which a man can assert in almost any other kind of property.

Argument of Daniel Webster in the case of Goodyear *v.* Day.

See INVENTION; PATENT FRANCHISE; PUBLIC RIGHTS AND OBLIGATIONS.

INOPERATIVENESS.

1. A Question of "Merits."

The question of operativeness is one which goes to "the merits" of the invention, and, from rejection on this ground, appeal lies to the Examiners-in-Chief.

Ferguson, x. p., *Frothingham*, *Act. Com.*, 3 Sep., 1891, 56 O. G., 1334.

2. Inoperativeness is a ground for rejection which always implies an examination. It is, however, never ground for refusing to conduct an examination.

Robbins, x. p., *Mitchell*, *Com.*, 16 July, 1890, C. D. Ms.

3. Upon a petition from the Examiner's requirement of a model: *Held*, that as the Examiner stated that he merely wanted it as an *exhibit*, it is clear that the requirement was not made under Rule 56, and, as the applicant was unwilling to furnish the exhibit, the Examiner should reject the claims for inoperativeness (Rule 133; Ferguson, x. p., 56 O. G., 1334).

Corson, x. p., *Frothingham*, *Act. Com.*, 26 Feb., 1892, 43 C. D. Ms., 26.

4. Where the Examiner admitted the novelty of the device, but, doubting its operativeness, required evidence that it could be made to work: *Held*, that, inoperativeness being ground for rejection and appeal under Rule 133, the Examiner, when questioning the operativeness of the alleged invention, should, after reasonable time had been accorded applicant to demonstrate its operativeness, reject the application and permit an appeal to the Examiners-in-Chief.

Parrish, x. p., *Mitchell*, *Com.*, 23 Nov., 1889, C. D. Ms.

5. If there is a question in the Examiner's mind as to operativeness, and applicant declines to furnish a model, or to further illustrate or describe, or in any way demonstrate the operativeness of the [alleged] invention, it is the Examiner's duty to reject, upon the ground of inoperativeness (Corson, x. p., 43 C. D. Ms., 26; Perkins, x. p., 43 C. D. Ms., 361; Burkhardt, x. p., 44 C. D. Ms., 146).

Smith, x. p., *Fisher, Act. Com.*, 23 Dec., 1890, C. D. Ms.

6. The putting of an application in interference implies the Primary Examiner's belief that it described an operative invention; but this presumption is not a conclusive one, because cases are not wanting in the Office, in which a question of operativeness of one of the devices involved in the interference has arisen. In McDonough *v.* Gray *v.* Bell *v.* Edison, 46 O. G., 1245, Commissioner Hall distinguishes between cases involving doubt [as to operativeness] and cases in which there is no doubt. In the latter, injustice cannot be done by taking jurisdiction and disposing of the question; but it is equally clear that, when the question [of operativeness] is involved in doubt, it would constitute little less than usurpation for the Commissioner to decisively hold that one of the devices was inoperative in connection with proceedings from which no appeal can be taken.

The Commissioner suspended the interference proceedings, and remanded the case to the Primary Examiner to determine whether the alleged defect was fatal to its patentability; the Examiner's consideration of the question to be precisely as if a motion had been made by Atkinson to dissolve the interference upon the ground of the inoperativeness of Bentley's invention.

Atkinson *v.* Bentley, *Mitchell, Com.*, 4 Mar., 1891, 46 C. D. Ms., 84.

Compare Hunter, Jr. *v.* Lane, (65), Prowattain *v.* Holt, (111), and Campbell *v.* Brown, (151), INTERFERENCES, and Archer, x. p., (7) *infra*.

7. Where, on final hearing before the Commissioner, an interference is suspended and the case remanded to the Primary Examiner for consideration of the question of operativeness, that question will not be considered *inter partes*, but will be determined by the Examiner subject to the regular course of appeal in *ex parte* proceedings.—Atkinson *v.* Bentley (46 C. D. Ms., 84) explained and applied.

Archer, x. p., *Simonds, Com.*, 15 Oct., 1891, 57 O. G., 696.

Compare Atkinson *v.* Bentley, (6) *supra*, and Hunter, Jr. *v.* Lane, (65); Prowattain *v.* Holt, (111), and Campbell *v.* Brown, (151), INTERFERENCES.

INSANE PATENTEE.

Re-issue, How made.

Where the patentee has become insane, and re-issue has been applied for and allowed, the re-issue may be made in the name of the guardian, but would be valid if issued to the insane patentee.

Whitcomb *v.* Coal Co., U. S. C. C., N. D. Ill., *Blodgett, J.*, 42 F. R., 652.

INTERFERENCES.

1. An interference in the United States Patent Office is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties who claim substantially the same patentable invention.

Sec. 4904 R. S.; P. O. R., 93.

2. The "issue" of an interference should be as broad as, but no broader than, the broadest claim to be included under it.

Zeitinger *v.* Reynolds *v.* McIntire, *Frothingham, Act. Com.*, 7 Nov., 1891, 57 O. G., 1279. See also Metz *v.* Crane *et al.*, *Frothingham, Act. Com.*, 27 Nov., 1891.

3. An interference proceeding looks to *subject-matter* rather than to parties.

Snyder *v.* Kanneberg, *Frothingham, Act, Com.*, 17 Mar., 1892, 58 O. G., 1840.

NOTE. — In the above case, testimony on behalf of the patentees, *S. & B.*, in contest with an applicant, *K.*, showed that the thing patented as the joint invention of *S.* and *B.*, was, in fact, the sole invention of *S.* Thereupon *S.* made application as sole inventor, and moved for a new interference of the three parties, *S.* and *B.*, *S. solus*, and *K.* This being refused by the Examiner, on the ground that "a party could not be put in interference with himself," the Assistant Commissioner, on petition from *S.*, granted the motion, for the reasons above given.

4. In award of priority in interference contests, the *crucial test* is *to whom is the world indebted for use of the invention in an available form.*

Boyd *v.* Cherry, 4 McCreary, 70, 1 Robinson, 554. See also Gill *v.* Scott, *Marble, Com.*, 4 June, 1883, 23 O. G., 2511; Green *v.* Hall, *Hall, Com.*, 6 Mar., 1889, 46 O. G., 1515.

5. The several parties to an interference are presumed to have invented in the chronological order of their completed applications clearly describing the device in controversy, and the burden of proof is held to rest upon the party who seeks to establish a different state of facts.

Sec. 4904 R. S.; P. O. R., 116.

6. The law recognizes an invention only when it reaches the condition of a working device, and awards priority to him who [either constructively or actually] is the first to reduce the invention to practice; subject only to the claims of an earlier discloser of the [nascent] invention who, with reasonable diligence, was perfecting the invention, and who succeeds in doing so.

Sawyer & Mann *v.* Edison, *Marble, Com.*, 8 Oct., 1883, 25 O. G., 597. See also Voelker *v.* Gray *v.* Edison *v.* Bell, *Butterworth, Com.*, 30 O. G., 1092.

7. In an interference proceeding, the first discloser of the [nascent] invention establishes his right to award of priority on proving either one of two states of facts: —

(a) Actual reduction to practice of the invention in controversy, followed by application for patent without unreasonable delay after the invention has been claimed or disclosed by another, and within two years following such reduction.

(b) Reasonable and persistent diligence in perfecting the invention and in filing the application in controversy.

Monce *v.* Adams, *Duncan, Act. Com.*, 24 Ap., 1872, 1 O. G., 1. See also Millward *v.* Barnes, *Spear, Com.*, 13 Mar., 1877, 11 O. G., 1060; Starr & Peyton *v.* Farmer, *Marble, Com.*, 28 Ap., 1883, 23 O. G., 2325; Christie *v.* Seybold, *Mitchell, Com.*, 10 Feb., 1891, 54 O. G., 957.

8. Where neither party makes a clear showing of the required facts, priority will be awarded in accordance with the preponderance of evidence, however slight it may be.

Buckingham *v.* Jones, *Simonds, Com.*, 16 Sep., 1891, 58 O. G., 1413. See also Doane *v.* Johnson, *Simonds, Com.*, 9 Oct., 1891. 58 O. G., 1414.

9. At the outset of every interference proceeding each party is "required to file, on or before a day which is fixed by the Office, a concise preliminary statement, under oath," giving the dates of his original conception and of his earliest disclosure, and stating whether the invention had been reduced to actual practice, and, if it had, the date, place, manner, and extent thereof.

P. O. R., 110; Washburn *v.* Hadfield, *Simonds, Com.*, 57 O. G., 1719.

10. A party in interference who neglects to file a preliminary statement or who, having filed such a statement, neglects to take testimony, is restricted to the date and fact of his application.

P. O. R., 115.

11. Where, however, such application has grown out of a caveat filed by the same party and he files a preliminary statement, but omits to take testimony, a certified copy of such caveat may be produced at the hearing in evidence of conception as far back as the date of caveat-filing.

P. O. R., 207, and P. O. R., 154 (3).

12. Where one of the parties has already obtained a patent, that fact will not prevent an interference, for, although the Commissioner has no power to cancel a patent, he may grant another patent for the same invention to one whom he adjudges to be the first inventor, thus placing both claimants in position for final adjudication of their conflicting claims in a court of equity.

Sec. 4918 R. S.; P. O. R., 93.

13. Where, in an interference issue, the contest is between an application for patent by one party and a patent already granted to another party, the applicant, in order to prevail, must present a case both as to first disclosure and as to reasonable and persistent diligence that does not admit of a reasonable doubt (U. S. Stamping Co. v. Jewett et al., 18 Blatch., 489; Duffy v. Reynolds et al, 24 F. R., 355; Fisk v. Church, 5 Fisher, 540; Taylor v. Wood, 12 Blatch., 110; Drill Co. v. Simpson, 37 O. G., 218), and must — anterior to patentee's reduction to practice (actual or "constructive") — have himself reduced the invention to practice in the form of an operative machine or process.

Duchemin *v.* Richardson, *Fisher, Com.*, 1870, C. D. 31. See also Richardson *v.* Denza, *Fisher, Com.*, 1870, C. D. 156; McCulloch *v.* Watkins, *Spear, Act. Com.*, 8 O. G., 1074; Busha *v.* Phelps & Edmunds *et al.*, *Doolittle, Act. Com.*, 9 O. G., 1010; Packard *v.* Sandford, *Paine, Com.*, 16 O. G., 1182; Stephenson *v.* Goodell, *Duell, Com.*, 9 O. G., 1195; Hunter *v.* Jenkin, *Simonds, Com.*, 50 O. G., 1705; Eveston *v.* Richardson, *Simonds, Com.*, 57 O. G., 1425; Sargent *v.* Burge, *Spear, Com.*, 11 O. G., 1055; Christie *v.* Seybold, *Mitchell, Com.*, 54 O. G., 957.

14. In an interference issue between an application and a patent issued before the date of such application, the burden of proof rests upon the applicant to make out such a case as would warrant a cancellation of the patent by the Office if jurisdiction existed for that purpose.

Gosline *v.* Barney, *Mitchell, Com.*, 9 Nov., 1889, C. D. Ms.

See also, Deprez & Carpenter *v.* Bernstein *v.* Hunter *v.* Gaulard & Gibbs (118), *infra.*

15. In order to overcome an already granted patent, a subsequent applicant must establish : —

(1) Actual reduction of the invention to practice in public, prior to the patentee's first reduction ("actual" or "constructive"), and within two years preceding his own application.

(2) { (*i*) If applicant shows earliest conception, he must establish persistent diligence in reduction, and in his application for patent.
(*ii*) If, on the other hand, the patentee was first to conceive, applicant can prevail only by reason of lack of reasonable diligence on the part of the patentee.

Burr *v.* Duryee, U. S. S. C., *by Grier, J.*, 28 Mar., 1864, 68 U. S. 591. ❀ See also Murrill *v.* Chenoweth *v.* Wheeler, *Fisher, Com.*, 14 July, 1869, C. D. 43; Duchemin *v.* Richardson, *Fisher, Com.*, 7 Ap., 1870, C. D. 31; Richardson *v.* Denza, *Fisher, Com.*, 9 Nov., 1870, C. D. 156; Stephenson *v.* Goodell, *Duell, Com.*, 3 June, 1876, 9 O. G., 1195; Busha *v.* Phelps, *Doolittle, Act. Com.*, 18 Aug., 1876, 9 O. G., 1010; Peyton *v.* Farmer, *Teller, Sec. Int.*, 22 Mar., 1883, 23 O. G., 2325; Christie *v.* Seybold, *Mitchell Com.*, 10 Feb., 1891, 54 O. G., 957.

16. A patent issued inadvertently while another application for the same invention was pending is, as against such application, to be treated, for the purposes of interference, as an application still pending. Decision of Commissioner Leggett cited and applied, — that when two conflicting applications are pending in the Office at the same time and, by official mistake, a patent is issued to

one of them without declaration of an interference between them, the rights of the parties will be determined on the same ground as if both were applicants: the one who has obtained a patent will derive no advantage from it in the controversy, neither will the other be prejudiced by it (Brookfield & Hemingray v. Brooke, — citing Hamilton v. Foster, 1869, C. D. 30, — Leggett, Com., 4 O. G., 81.)

Boyer, x. p., *Mitchell, Com.*, 49 O. G., 1985.

17. Abandonment — of the Invention — of the Application.

W filed his original application 1884; reduced the invention to actual practice, Mar., 1887; forfeited the original application by neglect to prosecute Nov., 1887; filed second application for the same invention Jan., 1889.

Held, that *W*, having been the first to conceive, and, having, with due diligence, reduced to actual practice before the original application became abandoned, the filing of a second application before the two years' public use had accrued, saved his rights from dedication to the public, and — priority having been awarded over *R*, whose first appearance on the scene was by taking a Belgian patent in 1885 — *W* was adjudged entitled to the patent.

Witherow *v.* Robert, *Simonds, Com.*, 22 Ap., 1892, 59 O. G., 787.

18. Abandonment and public use are questions to be determined *ex parte*, and not in an interference proceeding.

Butterfield *v.* Curtis, *Fisher, Act. Com.*, 15 Feb., 1890, C. D. Ms.

19. Evidence of acts of one of the parties performed abroad must be excluded from consideration on a question of priority.

Brown & Taplin *v.* Bixby, *Simonds, Com.*, 21 Sep., 1891, 57 O. G., 123.

20. Adding New Parties.

Rule 129 provides that, after taking of testimony, new parties shall not be added without a special order from the Commissioner, and, in the absence of sufficient reasons for adding new parties, such an order will be refused.

Lane *v.* Sturgess, Smith & Pettigrew, *Mitchell, Com.*, 21 Jan., 1891, C. D. Ms.

21. Request of Primary Examiner for an order of suspension of interference for the purpose of adding a new party — *Refused*, in view of the fact that the testimony had all been taken, and of the further fact that the junior party to the interference had opposed the Examiner's request.

Daugherty *v.* Strut, *Frothingham, Act. Com.*, 20 Nov., 1891, C. D. Ms.

22. All the grounds of contention must be presented at the original hearing.

A party who, although fully apprised of his opponent's contentions, rests his case upon one ground of defence, cannot, after a decision is made against him, have a rehearing simply to make a different defence.

Spielman, x. p., *Simonds, Com.*, 23 Dec., 1891, C. D. Ms.

23. Amendment of an Application in Interference.

The cases of Ry. Co. *v.* Sayles (97 U. S., 554), and Con. Elec. Lt. Co. *v.* McKeesport Lt. Co. (40 F. R., 21), should certainly place all Patent Office officials upon their guard against amendments made late in the history of proceedings upon an application, which are apparently inspired by the purpose of dominating inventions subse-

quently made by other inventors and not embraced within the scope of the application as originally filed.

Rogers *v.* Wissinger, *Mitchell, Com.*, 7 Mar., 1891, 56 O. G., 804.

Compare Wood *v.* Parsons, (29) *infra*.

24. Rule 109 gives no authority to file an amendment of an application involved in an interference claiming anything except an "invention claimed by another party thereto."

Hunter *v.* Knight, *Mitchell, Com.*, 3 Ap., 1890, C. D. Ms.

25. Rule 130 expressly provides that amendments to the specification will not be received during the pendency of an interference except as provided for in Rules 106, 107, and 109. The language "claimed by another party" in Rule 109 refers to claims to features of conceded patentability, not to claims rejected for want of patentability.

Crandall *v.* Sholes, *Mitchell, Com.*, 27 May, 1890, C. D. Ms.

26. Preliminary Statement. — Correction of Dates.

Where the failure to set up the proper dates in the preliminary statement was fairly attributable to the party's ignorance of the English language, and not chargeable to any fault or neglect of applicant or of his attorney: *Held*, that the Examiner of Interferences properly allowed the statement to be amended.

Schmiedl *v.* Walden, 23 Dec., 1890, C. D. Ms.

See also Washburn *v.* Hadfield, (1), and Baxter, x. p., (2) PRELIMINARY STATEMENT; also (27), (28), (29), and (113) *infra*.

27. Rule 113, which provides for amendment of a preliminary statement, makes it a condition precedent to such amendment, that the error sought to be corrected should have arisen "through inadvertence or mistake,"

and, following such rule, the decisions have been practically uniform, that where ordinary care and prudence in the fixing of dates have been wanting, amendment would not thereafter be permitted (Cleusen *v.* Fowler, 1886, C. D. 35; Heermans *v.* Eichbaum, 41 C. D. Ms., 391; Lamb *v.* Spiro, 42 C. D. Ms., 445; Hunter *v.* Brill, 44 C. D. Ms., 156).

Bell *v.* Overman, *Fisher, Act. Com.*, 2 Jan., 1891, C. D. Ms. Compare Parker *v.* Jarvis, (28) *infra.*

28. Where it was urged, on behalf of a motion for permission to amend the preliminary statement, that applicant had obtained the impression that for the date of the [nascent] invention he could go back only to the period at which he produced a drawing disclosing the invention, but it did not appear how he had obtained that impression: *Held* insufficient, because it had not been shown but that, with reasonable diligence, the exact truth as to the date which applicant might have set up would have been ascertained by him. — Case distinguished from Buckingham *v.* Jones (34 C. D. Ms., 178), in which Jones, who was permitted to amend, alleged as excuse an impression similar to that of applicant in this case, but had set up an indefinite date of conception as before a given date, under the impression that such statement afforded a sufficient foundation for subsequent evidence of what had been done before that date.

Parker *v.* Jarvis, *Fisher, Act. Com.*, 28 Feb., 1891, C. D. Ms. Compare Bell *v.* Overman, (27) *supra.*

29. Where the assignee knew that applicant made his preliminary statement from memory, but, apparently, made no effort to assure himself of the accuracy of the dates set up *until after he had become acquainted with his opponent's case*, during an examination about two months later, when he, thereupon, moved for leave to file a

preliminary statement: *Held*, that the Examiner of Interferences had rightly denied the motion on the ground taken by him, that the omissions and mistakes in the first preliminary statement were directly chargeable to the carelessness, indifference, and want of attention on the part of the assignee.

Wood *v.* Parsons, *Frothingham*, *Act. Com.*, 11 Jan., 1892, C. D. Ms.

Compare Rogers *v.* Wissinger, (23) *supra*.

30. Application for extension of time for taking testimony must be made promptly.

Where a party to an interference had had due notice as to when his testimony was to close and as to taking testimony by the other side, but took no steps toward taking of his testimony until nearly two months after his time had expired, under a grant of further time by Examiner of Interferences, based on said party's allegations of incapacity to take earlier action by reason of sickness, poverty, interruptions to his business from excessive rains and floods, and length of time required for him to communicate with his counsel: *Held*, that the extension was granted by the Examiner of Interferences on insufficient grounds, and that testimony must be refused. Case of Shinn *v.* McElroy (43 C. D. Ms., 113), — on which the Examiner of Interferences largely relied, — not thought to be in point.

Hayes *v.* Sagendorph *v.* Hawes, *Fisher*, *Act. Com.*, 16 Oct., 1890, C. D. Ms.

31. Burden of Proof.

Where the Examiners-in-Chief decided in favor of the junior applicant, on the ground that it appeared most probable, from the evidence, that he had originated the conception of the improvement, including the matter in

controversy, and that he communicated it to the senior applicant, who had no previous conception of the matter: *Held*, — reversing the Examiners-in-Chief, — that it is not conducive either to the promotion of sound practice before the Office or to the ends of justice, to decide upon the mere balancing of probabilities in favor of a latter applicant, who practically accuses the earlier applicant of theft of the invention and perjury in connection with the application.

Bruce *v.* Traver, *Mitchell, Com.*, 10 June, 1890, C. D. Ms.

32. Neither party having reduced the invention to practice in a machine for use prior to filing his application: *Held*, that the party who filed his application second in time had the burden of showing, by a fair preponderance of evidence, one of two states of facts, to wit: either (i), that he was the first to conceive and had used due diligence in adapting and perfecting the invention, or (ii), that he communicated the invention to the other applicant in such a sense that the latter is not an original inventor.

Illingworth *v.* Atha, *Mitchell, Com.*, 22 Nov., 1889, C. D. Ms.

33. The claims must conflict.

Applications interfere only where they *claim*, in whole or part, the same invention (Gold and Silver Ore Separating Co. *v.* U. S. Disintegrating Co., 6 Blatch., 307).

Dodd *v.* Reading, *Simonds, Com.*, 18 Sep., 1891, 58 O. G., 1413.

34. The junior applicant cannot relieve himself of the burden of proof by showing that his application in interference is a division of an earlier application filed by him, if said earlier application, although disclosing, contained no claim or statement of invention leading to the interference issue.

Van Depoele *v.* Daft, *Simonds, Com.*, 15 Jan., 1892, 58 O. G., 520.

35. Interference not conclusive as to Matter excluded by Office.

The general rule of conclusiveness of an award in interference as to all that might have been in the issue, does not apply to a claim which the Office had refused admittance into the interference on the ground that it was not patentable to the opposite party.

Crandall *v.* Sholes, *Mitchell, Com.*, 27 May, 1890, C. D. Ms.

Compare Rogers *v.* Wissinger, (23) *supra*, and Prowattain *v.* Holt, (111) *infra*.

36. The right cannot be usurped by mere diligence of a later inventor.

An inventor who was the earliest to conceive, disclose, and reduce to practice, and who proves connection of completion with conception by such diligence as his circumstances and the character of the invention admit of, cannot be defeated in his right to the patent by any amount of diligence, in coming to the Patent Office, of an inventor whose conception was of later date.

Hunter *v.* Miller, *Mitchell, Com.*, 13 Mar., 1890, 50 O. G., 1765.

37. Where neither party had reduced to actual practice, award of priority was given to the junior applicant because he had established earliest conception and reasonable diligence in application for patent.

Doane *v.* Johnson, *Simonds, Com.*, 9 Oct., 1891, 58 O. G., 1414.

See (38) *infra* for fuller statement of above ruling.

38. Earliest Conception. — Reasonable Diligence.

J was, *by a few days*, the "senior applicant," having filed on the 11th, whereas *D's* application was not filed until the 14th, of Jan., 1889. Neither party proved

any "actual reduction" before filing of his application, but *D*, at the time of filing, had under way a machine containing the invention, which was completed 26 Jan., 1889. On both sides, the testimony as to "conception" was about equally meagre and unsatisfactory. *D*, however, seemed to have established, for April, 1888, conception of the invention, at least as fully as his competitor *J* did for the following September. In consideration of the above showings, the finding of the Board of Examiners-in-Chief for *D* was affirmed.

Ib.

39. Interpretation of Specification.

Where, in an interference between a patent and an application, the Examiner construed the patent by a specimen that had been used as an exhibit when the patentee's application was pending: *Held*, that it was of little consequence how the Examiner construed the patent or what means he used to aid in such construction; but if the specimen so filed had been used to construe the specification and claims of the application in interference, a different question might have been presented.

Prowattain *v.* Holt, *Fisher, Act. Com.*, 3 Jan., 1891, C. D. Ms.

40. Copy of the Application of an earlier Contestant no longer in Interference, refused.

After an interference proceeding between the applications of *A* and *B*, and a decision in favor of *A*; *A*'s application was placed in interference with application of *F*, that had been filed during the pendency of the interference between *A* and *B*: *Held*, on petition of *F*, that he could not be furnished with copies of the drawings or of the contents of the file-wrapper of *B*'s application.

Fuller, x. p., *Frothingham, Act. Com.*, 9 Jan., 1892, C. D. Ms.

40′. In a case similar to above it was held that petitioner was no more entitled to a copy of *B's* specification and drawing than any other person not a party to the first interference.

In re Henry A. Smith, *Frothingham, Act. Com.*, 28 Jan., 1892, C. D. Ms.

41. Date of Application.

A renewal application promptly filed in place of allowed application forfeited for non-payment of final fee, is, for purposes of interference, a continuation of the earlier application, and *takes its filing date therefrom.*

Duchemin *v.* Priester *et al.*, *Simonds, Com.*, 1 Mar., 1892, 58 O. G., 1416.

42. In an interference case the important point is to fix the earliest date of [the nascent ?] invention, and an issue is joined when the allegations of either party are met by the other's denial and opposing testimony. The question of date is then to be decided, like any other question of fact, upon a preponderance of evidence.

Clark *v.* Broad, *Frothingham, Act. Com.*, 18 Nov., 1891, 57 O. G., 1426.

43. Defeated party's Right to a Claim not involved in the Interference.

Where, after judgment of priority upon the record, the defeated party refused to erase a certain claim included in the interference, alleging, as a reason, that it embraced subject-matter not disclosed by the other contestant, and no motion to dissolve had been made as to said claim: *Held*, that *it was too late for the Examiner to pass upon the question whether or not applicant should be allowed the claim*. *Held*, however, that applicant might make a motion to vacate the judgment in inter-

ference so far as related to subject-matter not common to both parties, and that, if the facts were found to be as alleged, proper relief might be afforded.

Booth, x. p., *Fisher, Act. Com.*, 7 Dec., 1889, 49 O. G., 1841.

Compare (44), (45), (46), (47), (48), (49), and (86) *infra*, and

(12) APPEAL.

44. Where, after the application of defeated party had been returned, in due course, to the Primary Examiner, who, in accordance with Rule 132, finally rejected all applicant's claims that had been involved in interference: *Held*, upon appeal, that there was no error in the action of the Examiner in applying the rule to the case, but, it appearing that certain claims of applicant had been improperly included in interference, motion might be made for vacation of judgment in interference *as to those claims*, and, if granted, the case would be remanded to the Primary Examiner, who would allow such claims unless there was some valid reason for their rejection other than the decision in the interference cause (Booth, x. p., 49 O. G., 1841).

Erlich, x. p., *Mitchell, Com.*, 15 Nov. 1890, C. D. Ms.

Compare Erlich *v.* Van Horn, (45); and instructions of Commissioner of Patents, (49) *infra*.

45. Where, after judgment upon the record, the defeated party refused to erase a certain claim included in the interference, alleging, as a reason, that it embraced subject-matter not disclosed by the other contestant, but had made no motion to dissolve as to such claim: *Held*, that it was too late [in the proceedings] for the Examiner to pass upon such question in that manner, but that applicant might move to vacate the judgment so far as it related to subject-matter not common to the devices of both parties, and that, if the facts were as alleged, proper relief might be afforded.

Erlich *v.* Van Horn, *Mitchell, Com.*, 12 Dec., 1890, 54 O. G., 506.

46. It was contended, in an argument on the part of Howe, that the defeated party in an interference contest cannot thereafter have allowed to him, as a part of the application in interference, a claim or claims which [although not expressly involved in the interference] would dominate the victorious party's device. *That* proposition is held not to be sound. The victor in an interference contest is entitled to claim everything coming fairly within the issue upon which he has been victorious; but to say that, if a specification present two features of invention only one of which is involved in an interference contest, a judgment upon that feature carries with it the fate of both, is to state a proposition whose unsoundness is demonstrated by the mere statement.

Ellis *v.* Lee *v.* Howe, *Simonds, Com.*, 5 Mar., 1892, C. D. Ms.

47. In an interference between *A* and *B*, the "issue" was in the language of *A's* claim, and one of the steps of the process was expressed in language sufficiently broad to cover any method of cooling cream. But *A* disclosed only one method of cooling, and *B's* specific claim was to a method different from *A's* and which could not be claimed by *A*. Judgment on the interference issue was rendered in favor of *A*. *B* moved for vacation of judgment on his specific claim, and, his said motion being refused, appealed. *Held*, that, during the progress of the interference, *B* was constructively making a claim as broad as the issue, and that the specific claim, which the other party could not make, was merely awaiting the result of the interference. The interference having been decided in *A's* favor, *B* was precluded from making the broad claim, and, in fact, was in the same position as if he had actually made such claim and it had been subsequently cancelled; but that, in view of the decision of the Commissioner as to the construction of Rule 132

[see (49), *infra*], there seemed to be no good ground for refusing to vacate the judgment as far as said specific claim of *B* is concerned.

Sharples *v.* De Laval, *Frothingham, Act. Com.*, 12 Mar., 1892, C. D. Ms.

48. Where, after judgment on the record in an interference proceeding and expiration of the limit of appeal and the return of the files and papers to the Primary Examiner, that officer advised the defeated party that "all his claims involved in the interference stood finally rejected," and applicant appealed from that action by a petition direct to the Commissioner: *Held*, that, under the recent instructions of the Commissioner to the Primary Examiner as to the construction of Rule 132 (56 O. G., 141), if the rejection included claims that could not be based upon the structures of the prevailing party and the claims were patentable, *they should not be rejected,—but allowed.* If, however, the Examiner was still of opinion that the claims in question were concluded by the interference proceeding, applicant could bring motion to vacate the judgment in conformity with the practice outlined in said instructions, and, should the motion be granted, the case would be remanded to the Examiner for action on the merits as to these specific claims.

Hunter, x. p., *Frothingham, Act. Com.*, 1 July, 1891, C. D. Ms.

NOTE. — The instructions of Commissioner Mitchell — see (49), *infra* — and such rulings as above based thereupon —see italics — appear to mark a change in the practice, as laid down in (43), (44), and (45), *supra*, in the direction of giving the Examiner greater freedom of immediate action in favor of a patentable claim of the defeated party which had been improperly put in interference.

49. Examiner's Duties under Rule 132 Defined.

Rule 132 was established for the purpose of imposing the duty of making a formal rejection of the interfering claims in the application of the defeated party, but not for the purpose of prescribing the extent and measure of that duty.

The Examiner, after rejecting all those claims of the defeated party which are or which *could be made* by the prevailing party, may properly allow to the former such other claims as are held to be patentable.

No claim should be allowed to the defeated party which could, by any latitude of construction, be held to embrace matter common to the structures of both parties to the interference.

The cases of Booth, x. p. (49 O. G., 1841), and Ehrlich *v.* Van Horn (54 O. G., 506) are to be regarded as precedents establishing the practice of obtaining relief when the defeated party believes that the Examiner has erred by treating claims limited to his specific structure as if they were concluded by the interference proceeding.

Instructions of *Commissioner Mitchell* to Primary Examiner, 22 June, 1891, 56 O. G., 141.

50. Delay. — Other Engagements.

Applicant delayed application for five years after conception, being all this time possessed of adequate means and *busy upon a similar device: Held*, not an exercise of reasonable diligence in adapting and perfecting the invention.

Ligowski *v.* Peters *v.* Hisey, *Simonds, Com.*, 15 Oct., 1891, 57 O. G., 1592.

51. Reasonable Diligence, Definition of.

Reasonable or due diligence in reducing an invention to practice depends, in every case, on two things, viz.:

(i) The nature of the invention; (ii) the personal circumstances of the inventor. In other words, in determining the question of diligence of the inventor first to conceive, the circumstances in which he is placed and the facilities at his command are always to be considered (McCormick Harvesting Mach. Co. *v.* Minneapolis Harvesting Mach. Wks., 42 F. R., 152; Hunter *v.* Miller, 50 O. G., 1765). Furthermore, reasonable diligence is established by satisfactory proof of affirmative action, and — within limits — by excuses for inaction (Ecaubert *v.* Hofmann, 52 O. G., 2107).

Sessions *v.* Sewall, *Frothingham, Act. Com.*, 22 Aug., 1891. C. D. Ms.

52. In a contest of priority of invention, the reasonable diligence required [of him on whom the burden of proof rests] applies alike to actual reduction to practice and to the constructive reduction to practice involved in an application.

Hunter *v.* Jenkin, *Simonds, Com.*, 15 Sep., 1891, 56 O. G., 1705.

53. *Time spent on other inventions* does not excuse delay otherwise unreasonable.

Hunter *v.* Jenkin, *Simonds, Com.*, 12 Sep., 1891, 56 O. G., 1705.

Compare Ligowski *v.* Peters *v.* Hisey, (50) *supra;* Thomson *v.* Ries, (55) *infra;* and Lowe *v.* Springer *v.* Morse *v.* Granger, (4) DELAY.

54. ***M*** conceived the principle of the invention in June, 1888, and reduced to practice in June, 1889. ***W*** established conception as early 1 Jan., 1889, and reduction to practice in same month: *Held*, that although ***M*** justified his delay from Sep., 1888 (when he claims — but fails to satisfactorily establish — reduction to

practice), up to 1 March, 1889, by reason of illness, yet, having failed to justify his subsequent delay of over two months, or to satisfy the Office that he would have made any effort to reduce to practice if he had not been ill; decision of the Examiners-in-Chief was overruled and the priority was awarded to *W.*

Morgan *v.* Wheeler, *Mitchell, Com.*, 27 Ap., 1891, C. D. Ms.

55. *T* conceived May, 1886, and reduced to practice Aug., 1888. *R* conceived latter part of 1886, reduced to practice July, 1888, and was first to make application for patent. *T* was evidently possessed of abundant means, and when [twenty-seven months after conception] he did reduce the invention to practice, it took him but a few hours to produce — from machinery which he had on hand — the requisite apparatus and effect that reduction: *Held*, that, under the circumstances, involving a delay of more than two years, with abundant means and opportunities at hand, and *busy meanwhile about other kindred inventions*, *T* [the party first to conceive] did not exercise reasonable diligence. Decision of the Examiners-in-Chief reversed, and priority awarded to *R.*

Thomson *v.* Ries, *Simonds, Com.*, 14 Nov., 1891, 59 O. G., 298.

NOTE. — The above ruling seems in full agreement with the drift of recent decisions. *T's* pre-occupation in developing "other kindred inventions" aggravated rather than palliated his *laches* in the case at issue.

Compare Ligowski *v.* Peters *v.* Hisey, (50), and Hunter *v.* Jenkin, (53) *supra;* also Barnes *v.* Clinton, (3), Wicks *v.* Dubois, (4), ABANDONED EXPERIMENTS; and Millward *v.* Barnes, (2), and Wickersham *v.* Singer, (14), DILIGENCE.

56. The "diligence" required in a contested case different from and greater than that required in an *ex parte* case.

The reasonable diligence in completing an invention demanded from an inventor in a contest over priority of invention is something different from the diligence in applying for patent for a completed invention which prevents abandonment to the public. The two things are differently and specifically stated in the statutes. The spirit and meaning of the statutes would seem to call for a higher degree of diligence in adapting and perfecting an invention once conceived of, in order to create a right to a patent, than is necessary in dealing with a completed invention in order to negative the finding of an abandonment to the public.

Thomson *v.* Ries, *Simonds, Com.*, 14 Nov., 1891, 59 O. G., 298.

57. A delay, in filing the application, of nearly four years after the date of conception: *Held*, not to have been an exercise of reasonable diligence, where, in the mean time, applicants were using machines which could have been readily adapted for the practice of the process in controversy.

Scott *v.* Bettendorf & Bettendorf, *Simonds, Com.*, 18 Mar., 1892, C. D. Ms.

58. Disclaimer, When Filable.

Where the Examiner of Interferences declined to transmit for examination by the Primary Examiner a disclaimer offered by one of the parties because not made before the date fixed for filing his preliminary statement, —as required by Rule 107: *Held*, that the Examiner of Interferences was correct in holding that the rule makes no distinction between interferences which involve a

conflict between co-extensive claims, and interferences which involve a conflict between generic claims and subordinate specific claims in respect of the period within which disclaimer may be made.

Clark *v.* Lord *v.* Grimes, *Mitchell, Com.*, 22 Ap., 1890, 51 O. G., 1943.

Compare (59), *infra.*

59. Where a disclaimer is tendered by one of the parties unaccompanied by any motion in the case, it is an *ex parte* question, but if a motion is made to suspend the interference pending the filing of a disclaimer or the determination of the question whether a disclaimer ought to be permitted, the case is, as to such motion, a contested one, and notice should be given as in other cases.

Diescher *v.* Walker *v.* Diescher & McGill, *Mitchell, Com.*, 24 June, 1890, 52 O. G., 549.

60. Where a party, on trial of an interference, gives notice that reference will be made to proceedings and testimony of a former interference between the parties, the whole record will be presumed to be meant unless the notice distinctly specifies a particular part of the record and the purpose for which its admission is sought.

Wilson *v.* Haines, *Simonds, Com.*, 10 Oct., 1891, 57 O. G., 1278.

61. Duties of Courts and of the Office distinguished.

The duty of a court, in conducting an interference proceeding, is judicial and is not administrative. The duties of the Patent Office, in conducting a similar proceeding, are both judicial and administrative. The court compares claims, and, if they are alike, "may adjudge and declare either of the patents void, in whole or in part," and then its duty is done. The Patent Office must not only determine between actually conflicting

claims, but it must also protect the public from more than one patent upon the same invention. Hence, it declares the interference, not between claims, but between applications which contain conflicting claims, or between an application and an unexpired patent, — as the case may be (Rule 94).

Reed *v.* Landman, *Mitchell, Com.*, 26 May, 1891, C. D. Ms.

62. Implied Admission.

Where, in an interference between a patent and an application, it was contended that the applicant was estopped from asserting himself the original and first inventor of the subject-matter at issue, because his application contained a reference to the patent in question: *Held*, that it was simply a reference to an existing patent for the purpose of suggesting how the material prepared by the patented process was packed, and that, whatever its effect in tending to discredit his present claim to be the original and first inventor of the invention set forth in the patent, it could not operate to prevent him from being heard to prove that he was the original inventor. Similar questions arose in Mead *v.* Brown, 48 O.G., 397; and Kohler *v.* Kohler & Chambers, 43 O. G., 247.

Del Grande *v.* Mannie, *Mitchell, Com.*, 19 July, 1890, C. D. Ms.

63. Estoppel.

Where it was contended that a party to an interference proceeding was estopped from claiming the invention in controversy, on the ground that the subject-matter had been claimed by him in the original application and rejected, and the rejection acquiesced in in order to obtain the original patent: *Held*, that it is well settled that claims contained in re-issued letters-patent which were asserted upon the application for the original

patent, but whose rejection was acquiesced in, will not be maintained by the courts, and therefore should not be allowed by the Office (Leggett *v.* Avery, 101 U. S., 256, ❁ ; Mahn *v.* Harwood, 112 U. S., 354, ❁); but *the question whether a party is estopped has no bearing upon the question who was the original and first inventor of the invention in controversy.*

Hoveler & McTighe *v.* Verner *v.* Nicholson, Jr., *Mitchell, Com.*, 14 July, 1890, C. D. Ms.

64. On dissolving an interference all parties should be notified, and limit of appeal set. — Practice.

Where interference had been dissolved by the Commissioner between a patent of one of the parties and the application of one of the other parties, and the Primary Examiner, of his own motion and without notice to the other parties, dissolved the interference as to them also, and one of them petitioned to have the Primary Examiner or the Examiner of Interferences advised that such attempted dissolution was illegal and void, and that the interference be resumed and proceeded with in due course: *Held*, that,— without questioning the Examiner's right to dissolve the interference on his own motion,— the proper course would seem to have been for him to have given all the interested parties notice of his decision and to have set a limit of appeal therefrom, in order that they might be heard by the Commissioner if they so desired: *Also held*, that in view of the action taken by the Primary Examiner and the Examiner of Interferences, the petition was, in effect, a motion to vacate the decision of the latter as to said other parties, and that such a motion should have been brought before the Examiner of Interferences in the first instance, and that notice thereof should have been served on each of the interested parties.

Fuller, x. p., *Frothingham, Act. Com.*, 23 Dec., 1891, C. D. Ms.

65. Feigned Issue.

It is not necessary that all questions pertaining to an application for patent should be finally settled and determined before an issue as to priority of invention can be properly formulated and tried. An interference may be regarded in the light of a "feigned issue" out of chancery for the determination of a particular question, and, when justice requires it, other questions can meanwhile be allowed to remain unsettled.

Hunter, Jr. *v.* Lane, *Simonds, Com.*, 3 June, 1892, C. D. Ms.

NOTE. — As proceedings in application for patent may be suspended *pro tem*, to await the issue of an interference contest, so, in turn, an interference procedure itself is sometimes suspended for the settlement of a question arising in the case; see Atkinson *v.* Bentley, (6) INOPERATIVENESS; and Prowattain *v.* Holt, (111) *infra*. The general practice, however, is to reserve consideration of collateral questions until after final judgment on the interference. See Strause *v.* Cook, (84′), and Arencibias *v.* Durkee, (90) *infra*.

66. Interfering generic Claim and specific Claim.

Where the claim of one applicant includes the claim of another applicant in such a sense that the broader claim could be predicated upon the subject-matter of the narrower claim, an interference exists, under the rule laid down in Upton, x. p., 1884, C. D., 26.

Dewey *v.* Thomson, *Mitchell, Com.*, 13 Ap., 1890, C. D. Ms.

Compare Edison *v.* Heysinger, (66′), and Reed *v.* Landman, (67) *infra*.

66′. Non-interfering broad and narrow Claims.

Where the declaration of interference appeared to have been made on the ground that the claims of one party, if granted, would be subordinate to those of the other party: *Held*, that that was not the question to be

determined in an interference proceeding; that interferences are not to be declared or denied because the claim of one party may or may not cover an infringement upon the invention of the other, but solely upon the ground that each party claims, substantially, the same invention.

Edison *v.* Heysinger, *Fisher, Act. Com.*, 17 Ap., 1890, C. D. Ms.

Compare Reed *v.* Landman, (67) and (68) *infra.*

67. Generic and specific Claims for substantially the same Invention.

Two applications for patent on substantially the same invention conflict, and will be put in interference, although claimed generically in the application of one party and only specifically in the application of the other party (Mullen & Mullen, x. p., 50 O. G., 837; Lord, x. p., 50 O. G., 987).

Reed *v.* Landman, *Mitchell, Com.*, 26 May, 1891, C. D. Ms.

Compare Dewey *v.* Thomson, (66), and Edison *v.* Heysinger, (66′) *supra;* and Edison *v.* Stanley, (69) *infra.*

68. Non-interfering generic and specific Claims.

Where a patentee, claiming specifically, would be entitled to all of his claims (even if he held the position of an applicant only) in spite of the judgment of priority in favor of his opponent, the fact that the claim of his opponent could dominate his, is no sufficient reason for declaring or for continuing an interference. Rule 75 provides for precisely such a case and unmistakably states that, on applicant filing a proper oath, the unexpired patent shall cease to be a bar.

Ib.

NOTE. — In his application of precedents to the above case, the Commissioner referred to the case of Upton, x. p., as follows:

The case of Upton, x. p., (1884, C. D. 26) was relied upon by the Examiner, as authorizing a different conclusion to that to which I have come therein, but I feel certain that it was not the intention of the Commissioner (Butterworth) to override Rule 74 (now Rule 75), which was then, as it is now, a part of the law governing the conduct of the Patent Office.

69. Genus and Species.

In the case of an article of manufacture, where an applicant has claimed a genus, and a patentee a species clearly coming within this genus, and the applicant has recited *the same species* in his application as being *within that genus*, there is an interference in fact.

Edison *v.* Stanley, *Simonds, Com.*, 3 Oct., 1891, 57 O. G., 273.

Of like general purport, see Short *v.* Sprague, 56 O. G., 1708; Zeitinger *v.* Reynolds *v.* McIntire, 57 O. G., 1279; and Commissioner's Instructions, (49) *supra.*

See, however, McDougall *v.* Phinney, 56 O. G., 928.

70. Omission from the motion of one of the grounds of appeal constitutes a waiver of that ground.

It has long been held by the Office that parties are concluded by the judgments against them, not only as to those issues which were expressly involved, but *also as to those which might, with reasonable diligence, have been brought forward at the same time.* (Harlowe *v.* Guernsey, 1875, C. D. 47; Whiteley *v.* McCormick, 1876, C. D. 228). These rulings are based upon the decision of the Supreme Court of the United States in Beloit *v.* Morgan, 7 Wallace, 619, ✱. Hence, where Examiner had denied issues, 1, 2, 4 and 6, and the party appealed on issue 4 only, his omission of issues, 1, 2 and 6 constituted a virtual acquiescence in and a waiver of his right to appeal from the Examiner's action on those issues.

Hotchkiss *v.* Smith & Post, *Fisher, Act. Com.*, 13 Aug., 1890, C. D. Ms.

71. Identity, Test of.

Where, in an interference, it appeared that *A* could not make the thing described and claimed by *B*, and that *B* did not make the thing described and claimed by *A*, and that the construction called for by *B's* claim did not, of necessity, embody that called for by *A's* claim: *Held*, that *B's* device did not necessarily infringe *A's* claim nor was it dominated by it, and, such being the case, there was no interference, even under the doctrine laid down in Upton, x. p., (27 O. G., 99).

Jeune *v.* Booth, *Mitchell, Com.*, 7 Mar., 1891, C. D. Ms.

Compare Rogers *v.* Wissinger, (23) *supra*; and Gould *v.* Case, (72) *infra*.

72. Subject-matter claimed must conflict.

Where two claims cover the same or equivalent elements, there is an interference, regardless of mere modes of expression used, but where the claims of one party are limited to specific constructions which the other does not and *cannot claim*, it must be held that there is no interference in fact.

Gould *v.* Crane, *Mitchell, Com.*, 28 Mar., 1891, C. D. Ms.

Compare Jeune *v.* Booth, (71) *supra*.

73. Inadvertent Issue of Patent.

Where a patent had, by inadvertence on the part of the Office, been issued to a party whose case should have been put in interference with a cotemporary application of another party: *Held*, that both the parties stood on the footing of applicants.

Scott *v.* Bettendorf & Bettendorf, *Simonds, Com.*, 18 Mar., 1892, C. D. Ms.

See, of same purport, Marston, x. p., (197) *infra*.

74. Unreasonable delay is not to be presumed against any applicant. It must be conclusively proven.

Ib.

Of like general tenor to above, see Scott, x. p., (12) ABANDONMENT OF THE INVENTION.

75. International Union for Protection of Industrial Property.

Petition was received on behalf of party to an interference, residing abroad, which requested —

(1) Permission to renew a motion to dissolve, which had been dismissed on appeal. (2) To file a preliminary statement accompanying the petition. (3) To file what purported to be an exemplified copy of an original application filed on behalf of petitioner in Great Britain; and (4) that said exemplified copy be received as an application "under the provisions of the International Union for the Protection of Industrial Property." *Held*, that, in view of the advanced stage in the proceedings: (1) The renewal of the motion to dissolve must be denied; (2) request of permission to file preliminary statement can reach the Commissioner only on petition from adverse action of Examiner of Interferences, — to whom petition must be first presented; (3) that the alleged exemplified copy of British application might be filed for what it was worth; but (4) that with respect to the request that said copy be received as an [interfering] application under the provisions of the International Union, that it would be improper for the Commissioner, at this stage, to express an opinion as to its value as evidence in the interference proceedings.

Mason *v.* Thompson, *Frothingham, Act. Com.*, 9 Dec., 1891, C. D. Ms.

76. Non-interfering claims may be withdrawn and be incorporated in a separate application.

When two applications (or an application and an unexpired patent) have been placed in interference, there may be found three classes of interrelated claims referred to in the declaration of interference, viz.: (1) conflicting claims directly in interference; (2) claims which conflict in the sense that they are involved in the result of the interference; (3) claims which are neither in interference nor involved in the result of interference. Claims which come under the third head may immediately be divided out and be embraced in another application, upon compliance with Rule 106. Such claims are not for the same invention as are either those directly or involved in interference, and may therefore be separated out without prejudice either to the public or to the opposing party.

Reed *v.* Landman, *Mitchell, Com.*, 26 May, 1891, C. D. Ms.

77. The "issue" must be as broad as the broadest claim.

In declaring an interference it is improper to include a broad claim in a narrow issue. *The issue should be as broad as the broadest claim involved therein.*

Short *v.* Sprague, *Simonds, Com.*, 19 Sep., 1891, 56 O. G., 1708.

Compare Zeitinger *v.* Reynolds *v.* McIntire, (78), and Metz *v.* Crane *et al.* (79) *infra.*

78. The "issue" of an interference should be *as broad as, but no broader than*, the broadest claim to be included under it.

Zeitinger *v.* Reynolds *v.* McIntire, *Frothingham, Act. Com.*, 7 Nov., 1891, 57 O. G., 1279.

79. The objectionable practice of making the "issues" of interferences broader than any claim included thereunder, or broader than are patentable, in view of the state of the art, condemned.

Metz *v.* Crane *et al.*, *Frothirgham, Act. Com.*, 27 Nov., 1891, 58 O. G., 947.

80. Joint Ownership.

The question of joint ownership does not properly arise in an interference contest; it is a question purely *ex parte* between the Office and the alleged joint inventors.

Redfield *v.* Goodson & Capehart, *Fisher, Act. Com.*, 13 Jan., 1891, C. D. Ms.

Of same general purport, see Snyder *v.* Kanneberg, (182) *infra*.

81. Laches.

J filed his application in April, 1886, and set up a conception in March, 1886. *L & W* filed their application in July, 1886, and (in their preliminary statement) set up conception in Sep., 1885, and reduction to practice in July, 1886, and testified that, after some experiments in Nov., 1885, they did very little on the invention, as they "considered that the problem was practically solved," and they "had to await the result of the work in practice before any further modification was deemed necessary," and that the matter of applying for a patent was delayed because they "considered the device was but a modification of another device for which they had received a patent in Nov., 1886": *Held*, that there was no evidence that the junior party [*L & W*] did anything toward adapting and perfecting the invention from Nov., 1885, to June, 1886; on the contrary, the evidence shows that they thought they had solved the

problem, — not by reason of their experiments in Nov., 1885, but by reason of what had been done in the line of the invention as covered by their said patent, — and, as it did not appear that the invention was an intricate one, or that the parties were lacking in means or facilities for reducing to practice, it must be held that they were not using due diligence in adapting and perfecting the invention, and priority was therefore awarded to the senior applicant, *J*.

Lemp & Wiglitman *v.* Johnson, *Frothingham, Act. Com.*, 27 Jan,, 1892, C. D. Ms.

Of same purport, see Monce *v.* Adams, (1) PRIORITY.

82. Misleading Issue. — Summary Dissolution.

The interference having been declared upon a misleading and improper issue, embracing a claim which, if incorporated into a patent, would be liable to invalidation by the courts (Carr *v.* Rice, 4 Blatchford, 200; Edgarton *v.* M'f'g Co., 10 Bissell, 402), and there being a question whether, on a redeclaration on an amended issue, such issue would not be broader than the claims of the patent now in interference (Reed *v.* Landman, 55 O. G., 1275); the Assistant Commissioner, on appeal by one of the parties, deemed it advisable to exercise the supervisory power vested in the Commissioner, and to summarily dissolve the interference.

Stuart *v.* Elliott *v.* Pattison *v.* Demayer, *Frothingham, Act. Com.*, 23 Ap., 1892, C. D. Ms.

83. Motion to Dissolve.

Where, after expiration of the usual limit for appeal from decision of the Examiner of Interferences, the defeated party requested that the application of the successful party be withdrawn from issue and remanded to the Primary Examiner for consideration upon a supposed erroneous omission of a certain patent from the

interference: *Held*, that it was a matter which could have been properly considered only within the time prescribed by the rule (within twenty days after approval of the preliminary statements), or, if not made within such time, upon a showing of sufficient reason why the motion was not made before.

Parry & Parry *v.* Black, *Fisher, Act. Com.*, 19 June, 1890, C. D. Ms.

Compare Laurent-Cely *v.* Payen, (84) *infra.*

84. Under Rule 122, it is the province of the Examiner of Interferences to determine, subject to appeal to the Commissioner, whether a motion to dissolve shall be "transmitted." It is for the Primary Examiner to determine the action on the motion when it has been transmitted, and it was an error for him to dismiss it as irregular and premature.

Laurent-Cely *v.* Payen, *Mitchell, Com.*, 8 Ap., 1890, 51 O. G., 621.

Compare Parry & Parry *v.* Black, (83) *supra.*

84. Collateral Questions.

The question to be decided in an interference proceeding is, which, of two or more parties, is the prior inventor, and an affidavit, or any testimony taken for the purpose of showing a want of interference in fact, is irrelevant and entitled to no weight in determining the controversy. If, however, in taking the testimony, there should incidently appear facts which indicate that the interference was not properly declared, such facts may be urged before the Commissioner when the case goes before him on final hearing, but the practice of the Office is, after testimony has been taken and the case set down for hearing, to allow it to take its usual course.

Strause *v.* Cook, *Fisher, Act. Com.*, 3 May, 1890, C. D. Ms.

Compare Hunter, Jr. *v.* Lane, (65) *supra*, and cases there cited.

85. Motions to dissolve an interference — such as contemplated by Rule 122 — are not based upon grounds arising out of the testimony taken upon questions of priority, but upon grounds which appear from the record to have existed before that time.

Cook *v.* Leech, *Fisher, Act. Com.*, 24 Mar., 1890, 42 C. D. Ms., 370.

86. Under the rules, as they now stand, the only period during which a party may file a motion to dissolve the interference and demand that if in proper form it be transmitted to the Primary Examiner, is during the period between the approval of the preliminary statements and the twentieth day thereafter. If an intervening party files a motion to dissolve before the twenty days begin to run, he should show, by the face of the proceedings, or otherwise, that the hearing can be had under such circumstances as would make it just to hold the parties to the result of the contest, as *res adjudicata.*

Laurent-Cely *v.* Payen, *Mitchell, Com.*, 8 Ap., 1890, C. D. Ms.

Compare Ehrlich *v.* Van Horn, (44), and Parry & Parry *v.* Black, (83) *supra.*

87. Motion by Defeated Party.

Where, in an interference proceeding, some of the parties urged that *S* had no standing to make a motion to dissolve, because judgment of priority had already been rendered against him on the record: *Held*, that he should not be prejudiced by that fact, because the rule does not now permit parties in interference to have access to each other's cases until after the preliminary statements have been opened, and, as it is the custom of the Office to immediately render judgment against a party whose preliminary statement does not overcome the record date of his competitor, *S* was not in a posi-

tion to make the motion [intelligently] until after judgment had been rendered against him.

Sprague *v.* Van Depoele *v.* Hunter *v.* Knight, *Fisher, Act. Com.*, 17 Ap., 1890, 44 C. D. Ms., 24.

88. Rule 122 provides that motions to dissolve an interference should, if possible, be made not later than twenty days after receipt and approval of the preliminary statements, and, in administering this rule, it has long been held by the Office that if a motion to dissolve is made after the time fixed by the rule, some good and sufficient reason must be given why it was not sooner made. The only reason given for the delay is that the party having the burden of proof had not taken his testimony in chief within the time fixed by the Office, and that, therefore, appellant had assumed that he did not intend to take it, and did not send for or obtain a copy of the file-wrapper and contents of appellee's application: *Held*, that the reason given was insufficient.

Cornwall *v.* O'Neill, *Fisher, Act. Com.*, 11 Aug., 1890, C. D. Ms.

89. Motion after Limit of Appeal.

When, the limit of appeal from Examiner of Interferences having expired, he has lost jurisdiction of the case, the Commissioner may be moved for leave to file a motion to dissolve the interference. This motion should be accompanied by an affidavit stating the facts relied upon both in excuse of delay and in justification of granting the motion at a date later than that specified in Rule 114. Should the facts relied upon appear to the Commissioner sufficient, permission will be granted, and, the jurisdiction of the Examiner of Interferences being restored, he will transmit the motion to the Primary Examiner (see Rules 109 and 122), and, in case the motion is granted, will make the proper order of vaca-

tion of judgment in the same manner as if the motion had been filed within the time originally limited for appeal.

Garrison *v.* Hubner, *Mitchell, Com.*, 10 July, 1890, C. D. Ms.
Compare Parry & Parry *v.* Black, (83) *supra.*

90. It is contrary to the practice of the Office, after part of the testimony has been taken, to suspend an interference proceeding for the purpose of considering questions relating to dissolution (Cook *v.* Leech, 42 C. D. Ms., 370; Strause *v.* Cook, 43 C. D. Ms., 65).

Arencibias *v.* Durkee, *Fisher, Act. Com.*, 6 Dec., 1890 C. D. Ms.
Compare Hunter, Jr., *v.* Lane, (65) *supra.*

91. Where some of *A's* claims were drawn so broadly as, in terms, to include the device of *D*, but, when the inventions covered by the several applications were understood, it became clear that the claims did not relate to the same subject-matter and that the "interference" was purely one of *words: Held*, that there was no interference in fact, and that the Primary Examiner's refusal to dissolve the interference must be overruled (Shepard *v.* Mann, 42 C. D. Ms., 248; Hotchkiss *v.* Smith & Post, 43 C. D. Ms., 338; Sprague *v.* Van Depoele *v.* Hunter *v.* Knight, 44 C. D. Ms., 24).

Ib.
Compare Snyder *v.* Kanneberg, (182) *infra.*

92. Duty of prompt Examination of Opponent's case.

Under Rule 122, it is the duty of parties to an interference, *so soon as the cases of their opponents are open to them*, to take steps to ascertain whether or not the interference has been properly declared, and any motion for dissolution, on the ground of improper declaration, should be presented not later than twenty days after the approval

of the preliminary statements. Any delay beyond that time, in so moving, must have an adequate excuse.

Van Depoele *v.* Smith, *Fisher, Act. Com.*, 2 Jan., 1891, C. D. Ms.

93. Motion (by consent) prior to Preliminary Statements, and on proper showing, — granted.

Where, in an interference proceeding, the Examiner of Interferences refused to transmit, before the time for filing preliminary statements, so much of a motion to dissolve as was based on alleged want of interference in fact, because the other party had not the right to inspect the moving party's application, but transmitted to the Primary Examiner the other grounds of motion, which were thereupon denied by him, and counsel for both parties signed a stipulation to the effect (1) that the moving party's application had been submitted to the other party's counsel, and (2) that the question of interference in fact should be determined by the Commissioner in deciding the appeal; the Commissioner considered the question and held that there was no interference in fact.

Gould *v.* Case, *Mitchell, Com.*, 28 Mar., 1891, C. D. Ms.

Compare Jeune *v.* Booth, (71) *supra.*

94. Where the parties filed a stipulation that the testimony of one of them, which had been taken, and which explained the construction embodied in his application, could be considered by the Examiner of Interferences in hearing and determining a motion to dissolve: *Held*, that the construction of the device must be ascertained from the application and not from the testimony (Cook *v.* Leech, 42 C. D. Ms., 370).

Van Depoele *v.* Knight *v.* Brill *v.* Hunter, *Frothingham, Act. Com.*, 30 Ap., 1891, C. D. Ms.

95. It is well settled that, before a motion to dissolve made after testimony has begun to be taken will be

considered, a showing of conclusive reasons why the motion was not earlier presented must appear.

Ib.

96. A party who has moved for dissolution on one of the grounds set forth in Rule 122, and taken a petition to the Commissioner from the Examiner's decision, is not thereby estopped from subsequently moving for dissolution upon another ground *developed by the progress of the interference.*

Prowattain *v.* Holt, *Mitchell, Com.*, 14 Ap., 1891, C. D. Ms.
Compare Reynolds *v.* Haberman, (97) *infra.*

97. There is nothing in the rules that limits the questions to be discussed upon a motion to dissolve to those which have not previously been considered by the Examiner. One object to be secured by the motion to dissolve is to enable the Examiner to decide *inter partes* what he had previously decided without a hearing.

Reynolds *v.* Haberman, *Mitchell, Com.*, 23 Sep., 1889, 49 O. G., 130.

98. Reserved Question.—Practice.

Whatever appears, incidentally from the testimony, to bar the [prevailing] party's right to a patent is, under a well-established practice of the Office, not to be considered on a motion to dissolve; but the various tribunals [of the Office] passing upon the question of priority, are required to indicate to the Commissioner the existence of such a bar [against either party], so that, when the case comes to him in due course, he may—either in advance of or subsequent to the judgment on priority—refer that question to the Primary Examiner (Rule 126). Inasmuch, however, as, in its last analysis, the question of patentability becomes solely a question between the general public and the prevailing party to the interference,

the usual practice with the Commissioner is, to defer questions of patentability until after judgment of priority has been rendered. The question then becomes a purely *ex parte* one with which the defeated parties to the interference have nothing to do.

Cook *v.* Leech, *Fisher, Act. Com.*, 24 Mar., 1890, 42 C. D. Ms., 370.

99. Upon a petition from a decision of the Examiner denying a motion to dissolve the interference, the petitioner contending that his petition could lie because there had been such irregularity in declaring the interference as would preclude a proper determination of the question of priority, and, in support thereof, showed that his opponent's claim in the interference was not a part of his original application, and that, at the time of the declaration of interference, the claim had not been sustained by any supplemental oath: *Held*, that the proper amendment should have been made and the proper supplementary oath filed before the interference was declared, and, therefore, petitioner was technically right as to the practice; but that, under Rule 124, he was not entitled to be heard thereupon by means of a petition [to the Commissioner in person].

Lichenstein *v.* Crawford, *Simonds, Cqm.*, 18 May, 1892, C. D. Ms.

NOTE. — According to Rule 124, appeal — at that stage of the proceedings — lay, in the first place, to the Examiners-in-Chief, after due notice to the opposing party as required in Rule 153.

100. Exception to Rule 122.

Where a motion to dissolve an interference on the ground of non-patentability is made more than twenty days after the approval of the preliminary statements, it is not an abuse of discretion on the part of the Examiner

of Interferences to grant such a motion where it appears that *no testimony had been taken*, so that the case had not advanced beyond the stage which interference proceedings customarily reach within the first twenty days after approval of the preliminary statements.

Reynolds *v.* Haberman, *Mitchell, Com.*, 23 Sep., 1889, 49 O. G., 130.

To like purport, see Forslund *v.* Matthews, (101) *infra.*

101. Appeal from Primary Examiner [direct] to Commissioner to dissolve an interference on a plea of non-patentability cannot be entertained.

Forslund *v.* Matthews, *Simonds, Com.*, 14 Dec., 1891, 57 O. G., 1720.

NOTE. — Non-patentability being a question of "merits," appeal on that ground could reach the Commissioner only in his judicial capacity after adverse decision by the Board of Examiners-in-Chief. See (100) *supra.*

102. Motion to extend.

A motion to extend the time for taking testimony is one addressed to the sound discretion of the Examiner of Interferences, and it has been frequently held that the Commissioner will not interpose in such cases unless it should appear that the Interference Examiner abused his discretion or that his action was contrary to law (Adams *v.* House & House, 40 C. D. Ms., 226).

Patterson *v.* Colby, *Fisher, Act. Com.*, 9 May, 1890, C. D. Ms.

103. Motion to re-open.

When it was claimed that, after a hearing had before the Examiner of Interferences, one of the parties had, "in the presence of a public official of high standing," made oath to statements contradictory of his testimony in the present case and which appeared to be material,

and moreover, that one of his important witnesses had stated that his own testimony was false, a motion to re-open the case was granted, to the extent of taking testimony, *pro et con.*, on the charges made.

Creteau *v.* Hall, *Mitchell, Com.*, 28 Nov., 1890, C. D. Ms.

104. A motion seeking to re-open an interference must be brought, in the first instance, before the Examiner of Interferences.

Bowen *v.* Bradley, *Simonds, Com.*, 8 Jan., 1892, 58 O. G., 386.

105. Motion to suspend.

A request from the Primary Examiner that an interference be suspended and returned to him, for the purpose of adding a new party thereto; *Denied*, because (1) the effect of adding a new party at that stage of the proceedings would be practically to re-instate the senior-party, who had allowed his rights to lapse by neglecting to take testimony within the allotted time, and because (2) there would [after final adjudication of the present interference] be ample opportunity for a second interference between the junior party and a third party.

Wein *v.* Northrup, *Simonds, Com.*, 3 Mar., 1892, 58 O. G., 1416.

106. Motion denied to suspend interference for admission of testimony that had been, at all times within petitioner's reach.

Where, after decision by Examiners-in-Chief in an interference proceeding, defeated party made a motion for suspension of interference to permit certain testimony to be taken, on the ground that the interpretation of the issue adopted by the Examiners-in-Chief "was a surprise to him," and it appeared that the testimony now sought to be introduced had been, with exercise of a reasonable

diligence, at all times within petitioner's reach: *Held*, that the motion must be refused.

Adams *v.* Kinzer, *Mitchell, Com.*, 17 Nov., 1890, C. D. Ms.

107. Natural Probabilities.

Where parties to an interference flatly contradict each other upon a material point, the preponderance of evidence may be determined by reference to surrounding circumstances and the natural probabilities.

Ligowski *v.* Peters *v.* Hisey, *Simonds, Com.*, 15 Oct., 1891, 57 O. G., 1593.

Of like purport, see Voelker *v.* Gray *v.* Edison *v.* Bell, (10) ANTICIPATION. See also Wilson *v.* Haines, (117), and Doane *v.* Johnson, (137) *infra*.

108. New Testimony after Judgment.

No new testimony can be taken or considered after judgment unless, upon proper proceedings, it should appear that there was good reason for setting aside the judgment and for permitting such testimony to be taken.

Parry & Parry *v.* Black, *Fisher, Act. Com.*, 17 June, 1890, C. D. Ms.

Compare Van Depoele *v.* Deecker, (169) *infra*.

109. Official Suggestions. — Practice.

A petition from the action of the Examiner amounting, in substance, to a refusal to inform applicant of the subject-matter of the "issue" in a proposed interference, in order that he might amend so as to include it in his claims: *Denied*, it not being [now] the practice of the Office to suggest claims to an applicant in order to create a possible interference.

Wheeden, x. p., *Frothingham, Act. Com.*, 18 June, 1892, 60 O. G., 1191.

NOTE. — The Assistant Commissioner referred to the ruling in the case of McNeil *v.* Borton & Wilcox (see (110) *infra*), as conclusive of the above case, but added: *After issue of patent upon the other application, an interference may probably be instituted between the patent and the present application, provided a proper claim be made.*

110. *M* having been advised by the Examiner that a certain claim, which he (the Examiner) quoted, had been adjudged patentable in a pending case, and that said claim might (under Rule 48) be included in *M's* application; *M*, thereupon, filed an amendment containing said claim, which, having been admitted, interference was declared between *M's* application and that of *B & W*, the pending case referred to. The Examiner sought to justify his said action on the ground that he had the power and that it was his duty to communicate the claim in question in order that *M*, should he prove priority, might secure a patent for whatever patentable subject-matter was embraced in his application, — citing Donovan, x. p. (44 O. G., 697), in defence of this position: *Held*, that if an interference already exists between the claims of two different parties there is no necessity for such a doctrine, and that, while it is undoubtedly true that it is the duty of the Office to place itself in the attitude of a friend, and not that of a litigant, with the applicant, and while this doctrine is one that should be [freely] followed in *ex parte* cases like that of Donovan, yet there is no such practice of the Office as warrants extension of the doctrine for the purpose of creating interferences, and th..t, therefore, the action of the Examiner was irregular.

McNeil *v.* Borton & Wilcox, *Frothingham, Act. Com.*, 6 May, 1892, C. D. Ms.

Compare Donovan, x. p., (1) EXAMINATION; and Wheeden, x. p., (109) *supra*.

111. Patentability of "Issue."

When a motion to dissolve an interference between a patent and an application is made, upon the ground of lack of patentability of the "issue," the question to be determined by the Office is not whether the subject-matter of the "issue" was patentable to the patentee, for that [as far as Patent Office action can affect it] was determined by passing of his application to issue, but whether or not it is patentable to the *applicant*.

Prowattain *v.* Holt, *Fisher, Act. Com.*, 31 Jan., 1891, C. D. Ms.

Compare Atkinson *v.* Bentley, (6) INOPERATIVENESS; and Hunter, Jr. *v.* Lane, (65) *supra*.

112. Preliminary Statement.

To give an applicant any standing in an interference, it is requisite that the date of disclosure given in his preliminary statement antedate the applications already included in the interference.

Freeman *v.* Hunter *v.* Zippernowski & Deri *v.* Edison, *Fisher, Act. Com.*, 24 May, 1890, C. D. Ms.

113. Preliminary Statement.—The Inventive Acts.

The principal object of a preliminary statement is to fix the relative times of the *inventive acts* of the several contestants. Rule 110 requires, among other things, that the dates of the inventive acts, which relate to the subject-matter of the invention set forth in the declaration of interference, shall be given. If, however, a party to the interference has doubts as to whether the subject-matter of his application is properly involved in the "issue" as declared, then, in place of the terms "the invention set forth in the declaration of interference," he may say, "*the invention contained in the claims of my*

application (or patent) *declared to be involved in this interference*" (see note to Form 35 (a), Rules of Practice).

Haug *v.* Du Bois, *Frothingham, Act. Com.*, 15 June, 1891, C. D. Ms.

114. Preliminary Statement. — Failure to File.

Upon appeal from decision of the Examiner of Interferences denying motion to re-open interference and permit filing of preliminary statement after judgment had been entered against appellant: *Held*, that it was, in effect, a motion to vacate and set aside the decision as to priority, and it was, therefore, necessary for appellant to make out such a "showing" as would entitle him to a new trial in equity. That the failure to file the preliminary statement within the prescribed time was not to be excused by the fact that applicant did not have the means to prosecute the interference, for it appeared that he was represented by skilled attorneys, and the expense of filing such a statement would have been very slight; nor did it appear that his attorney had been asked or had refused to file such statement.

Thayer *v.* Ellinwood *v.* Huss *v.* Storey *v.* Scribner, *Frothingham, Act. Com.*, 15 Ap., 1892, C. D. Ms.

115. Preliminary Statement. — Constructive Reduction to Practice.

Applicant sought to amend his preliminary statement by inserting a statement that, in a prior application, he had shown in the drawings and described in the specification the matter involved in the interference: *Held*, that as it did not appear that any claim was made in the prior application, to the "issue" in the interference proceeding, applicant could derive no possible benefit from having the proposed amendment inserted in the preliminary statement so far as the question of a constructive reduction to practice was concerned, and the

decision of the Examiner of Interferences holding that the proposed amendment was "unnecessary, immaterial, and useless," was sustained.

Searle *v.* Frumveller *v.* Sessions, *Frothingham, Act. Com.*, 18 June, 1892, C. D. Ms.

116. *The utmost care and diligence*, rather than mere reasonable care and diligence, are required in the making of a preliminary statement.

Henderson *v.* Noakes, *Simonds, Com.*, 8 June, 1892, 59 O. G., 1762.

117. Preponderance of Evidence.

In doubtful cases the question of priority of invention is determined by a fair preponderance of evidence, and doubts raised as to accuracy of witnesses on minor points will not be permitted to disturb it.

Wilson *v.* Haines, *Simonds, Com.*, 10 Oct., 1891, 57 O. G., 1278.

Of like purport, see Ligowski *v.* Peters *v.* Hisey, (107) *supra;* and Doane *v.* Johnson, 137 *infra.*

118. Contest between a Patent and a subsequently filed Application.

Where one of the parties to an interference is a patentee, the burden of proof is heavily upon his opponent, and, unless the evidence is such as would be held sufficient by a court to invalidate the patent already granted, the decision will be in favor of the patentee.

Deprez & Carpentier *v.* Bernstein *v.* Hunter *v.* Gaulard & Gibbs, *Mitchell, Com.*, 24 Feb., 1891, 54 O. G., 1715.

Of like general purport, see (119) *et seq., infra.*

119. The party upon whom rests the burden of proof of showing that he used reasonable diligence in adapting and perfecting the invention and reducing it to practice,

must also have made one or more of the invented articles in form adapted to use, not necessarily the best form or a perfect form, but a form that would do useful work.

Atkins *v.* Fox., *Mitchell, Com.*, 9 Jan., 1891, C. D. Ms.

120. Where one of the contestants for priority has a patent for the invention in dispute, and the other is an applicant for a patent, the latter, in order to prevail, must present a case, both as to conception and as to reasonable diligence, which does not admit of a reasonable doubt.

Edison *v.* Swan, *Simonds, Com.*, 22 June, 1892, 60 O. G., 158.

121. Where a motion for a rehearing of a decision in favor of the patentee in an interference between an application and a patent was made, upon the ground that the Commissioner had erred in holding that applicant's structure did not represent a practically completed invention prior to the issue of the patent, and affidavits were filed to the effect that a person skilled in the art could have completed the invention: *Held*, that in such case the least the law requires [of the contending applicant] is a *full* reduction to practice, and if that stage was not reached, it is of no purpose to urge that it could have been reached by taking a further step which would not involve invention. In many cases, — and, perhaps, in a majority of cases, — where there was a failure to reduce to practice, the omitted step did not call for further invention, but it *did* call for diligence, and *such diligence as would give to the world the completed thing in a useful form*, and that diligence being wanting in Wilson's case, there was a failure to reduce to practice.

Wilson *v.* Beekman, *Mitchell, Com.*, 16 Sep., 1890, C. D. Ms.

NOTE. — The above able and instructive ruling follows the customary practice of tribunals in treating only the *res adjudicata*. To have overcome Beekman's position as patentee,

Wilson, whose date of application was subsequent to the issue of Beekman's patent, would have had, if necessary, to prove actual successful reduction to practice of the invention, prior to Beekman's reduction, — either actual or "constructive." It was, however, sufficient, as against Wilson, that he had not attained successful practice of the invention even when Beekman's patent issued. That, however (at the last analysis), the determining date is that of the patentee's "reduction," — his own act, not that of the grant, a governmental act, — would seem to have been conclusively established in numerous rulings, some of them by the same learned Commissioner. A few of these rulings are indicated below: Richardson *v.* Denza; Duchemin *v.* Richardson, and Starr & Peyton *v.* Farmer, (1), Hunter *v.* Jenkin, Lowe *v.* Springer, (2) and (3), Lindsey *v.* McDonough, (4), CONSTRUCTIVE REDUCTION TO PRACTICE; Monce *v.* Adams, (1), and Busha *v.* Phelps *et al.*, (5), PRIORITY; Millward *v.* Barnes, (1), Packard *v.* Sandford, (6), Lorraine *v.* Thurmond, (9), Murrill *v.* Chenowith *v.* Wheeler, (10), and Parkhurst *v.* Kinsman, (14), REDUCTION TO PRACTICE; and Hansen *v.* Davis, (124) *infra*. See also Law's Digest, pp. 427 *et seq.*

122. In an interference between an applicant (*G*) and the patentee (*H*), the latter had, upon his conception of the basic idea in May, 1887, formed a company for the manufacture of wheels, in the making of which the device in question was to have been used; made patterns in September; finished the device in October, and put it in operation by the first of November: *Held*, that although *G* had conceived and reduced to practice in August, he had not sustained the burden of proof, for — as it was not claimed that four months was too long to get the factory into working order, and it appeared that it was *H's* intention to employ the device when the factory should be completed — the question of diligence should be determined in his favor.

Grant *v.* Harris, *Mitchell, Com.*, 29 Ap., 1891, C. D. Ms.

123. An applicant should not be detained in the Office to contest priority with a patentee unless he makes a claim which sets forth all the steps and stages [of the process] specified in the claim or claims of the patent; nor should the Office subject a patentee to the expense of an interference unless it is prepared to allow the applicant a claim corresponding to that already granted to the patentee.

Withrow *v.* Robert, *Mitchell, Com.*, 23 May, 1890, C. D. Ms.

124. The grant of a patent vests in the patentee certain rights. It establishes certain presumptions (not conclusive, but rebuttable), among which are: (1) that the patentee was an original inventor; (2) that he was the first inventor; (3) that the invention was new and useful; (4) that it had not been known or used in this country, nor patented nor described in any printed publication either in this or any foreign country, before it was invented by the patentee; (5) that it had not been abandoned or dedicated to the public; (6) that it had not been in public use or sale within the United States for more than two years prior to the application; [(7) that the patent contains a description whereby one skilled in the art can practise the improvement without the necessity of invention on his part; and (8) that it contains a concise particularization of the part, improvement, or combination which he claims as his invention]. The burden of proof is upon any one who attempts to show that any one of these presumptions is incorrect, and it is only after such person has, by proof beyond a reasonable doubt, overcome the patentee's *prima facie* case arising from the previous grant of a patent, that he is entitled to have the burden of proof shifted to the patentee.

Hansen *v.* Davis, *Mitchell, Com.*, 4 Ap., 1891, C. D. Ms.

125. An interference should not be declared between an unexpired patent which shows and claims one species of invention and a subsequent application disclosing another and different species, but making a claim of sufficient scope to include the device claimed in said patent.

Reed *v.* Landman, *Mitchell, Com.*, 26 May, 1891, C. D. Ms.

126. *McD's* only date was his "record date," viz.: that of his application, — 15 May, 1889. *L's* dates, alleged in his preliminary statement, were: conception 1 June, 1889,; disclosure and reduction to practice 1 July, 1889. His record dates were: application 5 Nov., 1889; and his patent 11 Mar., 1890. *L* acquired no advantage by the issue of his patent while *McD's* application was pending (Marston, x. p., 21 O. G., 633). Neither party having taken any testimony, award was necessarily made *on the record* (Rules 116 and 117) and in favor of *McD*, he being the senior applicant. The petitioner (*L*) averred that the mere filing of an application for patent is not a reduction to practice of the invention, and that the inventor entitled to a patent is he who first reduces it to actual practice, although he may be the last to conceive and the last to file application for patent. The accuracy of *L's* interpretation of the law was denied, and the Commissioner said that it must be assumed that *McD's* allowed application discloses, in a practical and operative form, the invention specified in the interference issue, and cited and applied the ruling of Commissioner Marble, in the case of Starr & Peyton *v.* Farmer (1883 C. D., 34), where he said: —

"The issue is priority of invention. Reduction to [actual] practice may be better evidence of invention than an application, and it may be a necessary element of title in some or all cases, but the evidence furnished

by the application is all that is required by law to establish the existence of the invention, at least as early as the date of filing, for the purposes of examination and for the purpose of granting a patent thereon, and until that evidence is overthrown and some prior invention brought to view, the applicant is not called upon to furnish any better."

It results that it is immaterial whether or not *McD* reduced the invention to [actual] practice prior to the date of his application. The Office records show that he had perfected his invention before the earliest date alleged on behalf of *L*.

Lindsay *v.* McDonough, *Mitchell, Com.*, 27 May, 1891, 55 O. G. 1402.

127. An application for a patent which eventuates in the grant of a patent is a constructive and presumptive reduction to practice. In a contest for priority of invention the presumption referred to is conclusive against all the parties to the proceeding, because each one is, by the fact of his making a claim to the improvement in dispute, estopped from denying its operativeness and completeness.

Hunter *v.* Jenkin, *Simonds, Com.*, 12 Sep., 1891, 56 O. G., 1705.

128. Where one of the contestants has a patent for the invention in dispute, and the other is an applicant for a patent, the latter, in order to prevail, must present a case, both as to conception and as to reasonable diligence, which does not admit of a reasonable doubt.

Ib.

129. The burden, as to priority of invention, in an issue between a patent and an application, is upon the applicant to make out such a case as would warrant

cancellation of the patent by the Office if jurisdiction existed for that purpose.

Gosline *v.* Barney, *Mitchell, Com.*, 9 Nov.. 1889. C. D. Ms.

130. Since patents are now re-issued strictly for the same inventions covered by the original patents, and since the surrender of the original patent does not take effect until the issue of the amended patent, it seems that the same presumptions apply to the application for the re-issue of patent as to the patent itself, and that the proof required of a contesting applicant is the same in either case.

Hansen *v.* Davis, *Mitchell, Com.*, 4 Ap., 1891, C. D. Ms.

131. In an interference contest where neither party establishes a perfectly clear case on the evidence, the presumption is in favor of a party having a patent, as against one who has not, and the latter, in order to prevail, needs to establish his case by proof which does not admit of a reasonable doubt.

Weston *v.* Richardson, *Simonds, Com.*, 17 Oct., 1891, 57 O. G., 1425.

132. Where an applicant for patent seeks to overcome a patent already granted he must make out a case, both as to conception and diligence in reduction to practice, which does not admit of a reasonable doubt (Hunter *v.* Jenkin, 56 O. G., 1705).

Hunter *v.* Van Depoele, *Simonds, Com.*, 15 Dec., 1891, 57 O. G., 1720.

See also Dillon *v.* Kimball *et al.*, 58 O. G., 384.

133. The law gives the patent to him to whose ingenuity and perseverance the world is indebted for the invention in available form.

It is not necessary for the validity of a patent that the patentee should have been the first who conceived

the practicability of the thing patented, but who, though making important experiments, was unable to bring them to any successful or patentable result. He who reduces speculation to practice; whose experiments result in discovery; and who puts the public into *practical and useful possession* of the compound, art, machine, or product, is entitled to the patent.

Goodyear *v.* Day, *Grier, J.*, Mar., 1852, 2 Wallace, Jr., 283.

134. There is no evidence, in this case, that leaves the shadow of a doubt that, for all the benefit conferred upon the public by the introduction of a sewing machine, they are indebted to Elias Howe. A machine, in order to anticipate a subsequent discovery [for which a patent has issued] must have been perfected, — that is, made so as to be of practical utility, and not be merely experimental and ending in experiment. Until of practical utility, public attention is not called to the invention; it does not give to the public that which it lays hold of as beneficial. If an invention is an experiment only and ends in experiment and is laid aside as unsuccessful, — however far it may have been advanced, however many ideas have been combined in it which, subsequently taken up, might, when perfected, have made a good machine, still, not being perfected, — it has not come before the public as a useful thing, and is, therefore, entirely inoperative as affecting the rights of those coming afterward. Though a prior inventor has gone to a certain extent, if he fall short of making a complete machine, practically useful, those who come after him may secure to themselves the advantages of his invention. The first inventor gave nothing to the public: his so called invention was an idea only, never carried out in a machine that could anticipate one subsequently invented.

Howe *v.* Underwood, *Sprague, J.*, 24 Feb., 1854, 1 Fisher, 161.

135. Patents cannot be put in interference with one another in the Patent Office.

There can be no doubt that an interference cannot be declared in the Patent Office between two patents, and it is more than possible that the objection to such a procedure is not overcome by the fact that an application is also involved in the same controversy. When, however, an interference had been declared between two patents and an application, and one of the patents had dropped out of the race by reason of judgment entered against the patentee, under Rule 114, for failure to file a preliminary statement: *Held*, that no useful purpose would be served by dissolving the interference on that ground [viz., that two of the original contestants were patentees].

Haish *v.* Rosado *v.* Aishton, *Mitchell, Com.*, 31 May, 1890, C. D. Ms.

NOTE. — A patentee's remedy against the grantee of a conflicting patent is by suit in equity, — see Sec. 4918. See, also, Foster *v.* Lindsay, 3 Dill., 127.

136. The Preliminary Statement.

Each party to an interference is required to file a concise preliminary statement (under oath), on or before a date fixed by the Office, showing (1) Date of his original conception of the invention defined in the declaration of interference. (2) Statement of whether, and at what date, he made any drawing, sketch, or model. (3) *When, where, and under what circumstances the invention was first disclosed, and to what person or persons.* (4) Whether, and at what date, the invention was reduced to practice, and the extent of its use.

P. O. R., 110.

137. Where official definition of the "issue" is defective.

If there is any doubt as to the scope of the interference issue, each applicant should confine his preliminary statement to the invention contained in those claims of his application which are declared to be involved in the interference, and not attempt to frame the statement to cover two or more possible constructions of the "Issue."

Haug *v.* Dubois, *Frothingham, Act. Com.*, 15 June, 1891, 56 O. G., 1061.

See PRELIMINARY STATEMENT.

138. Preponderance of Evidence.

Where neither party made a clear showing of the required facts, priority is awarded in accordance with the preponderance of evidence, however slight it may be.

Doane *v.* Johnson. Jr., *Simonds, Com.*, 9 Oct., 1891, 58 O. G., 1414.

Of like purport, see Ligowski *v.* Peters *v.* Hisey (107), and Wilson *v.* Haines, (117) *supra.*

139. Where actual reduction to practice is wanting and the testimony of both parties as to conception and disclosure is of like meagre and unsatisfactory character, the earlier date of disclosure will prevail. On this understanding, the decision of the Board of Examiners-in-Chief was affirmed and priority was awarded to Doane.

Ib.

140. Neither party made an actual reduction to practice before his application was filed. *J* was in the Office first, and presented some testimony tending to corroborate his claim to earliest conception. He did not

present a strong case, but that of his opponent, *B*, was certainly less strong. Decision of the Examiners-in-Chief in favor of *J* was affirmed.

Buckingham *v.* Jones, *Simonds, Com.*, 16 Sep., 1891, 58 O. G., 1413.

141. *B's* date of conception was practically 30 May, 1885. *J* testified to a conception and disclosure occurring earlier in the same month, and there was some testimony tending to corroborate his statement in that regard. Besides this, somewhat problematical, position as the earlier discloser, *J*, by his date of filing, sixteen days in advance of *B*, held the position of senior applicant. Neither, before the date of his application, had made an actual reduction to practice. There was no testimony for either side that was strongly decisive, and the decision admittedly went upon the ground of giving it to that side which had the least weakness. On this showing the Examiner of Interferences and the Examiners-in-Chief alike awarded priority to *J*.

Ib.

142. Priority, — Test of. — The Rule and the Exception.

The rule is well settled that he is the true inventor and the party entitled to a patent who first reduces the invention to practice, unless another, first to conceive, was using reasonable diligence.

Dickson *v.* Kinsman, *Marble, Com.*, 14 Oct., 1880, 18 O. G., 1225.

NOTE. — The object of the law being to encourage invention, the presumption is necessarily in favor of him to whom the public is indebted for its earliest knowledge of the thing invented in tangible and available form (Monce *v.* Adams, (1), Christie *v.* Seybold, (2), Disston *v.* Emerson, (3), Manny *v.*

Easley, (7), and Lorraine *v.* Thurmond, (8), PRIORITY. See also Sessions *v.* Sewall, (51) and (144), INTERFERENCES). This presumption remains unless overcome by one who can show earlier claims to that necessary premise of invention, — *the original creative thought*, — and who can show reasonable and persistent diligence in completing and in making application for patent for the invention (Edison *v.* Foote & Randall, and Parkhurst *v.* Kinsman, (2) PRIORITY). Some decisions — approaching the question from another point of view — reverse the above (which is also the usual) statement of the rule and the exception; see Hunter *v.* Jenkin, (143) *infra*.

For an instructive presentation of the entire question see the decision of the Supreme Court of the United States in Smith *v.* Nichols, (3) SCOPE OF PATENT.

143. Priority — The Rule and Exception.

The general rule is that he who is the first to conceive of an invention is entitled to a patent for it if he reduces the same to practice with reasonable diligence; but if he does not reduce to practice [and that] with reasonable diligence, he who was subsequent to conceive, but first to reduce to practice, will prevail.

Hunter *v.* Jenkin, *Simonds, Com.*, 12 Sep., 1891, 56 O. G., 1705.

NOTE. — Decisions, such as Dickson *v.* Kinsman, (142), and Hunter *v.* Jenkin, (143) *supra*, that approach the same truth from different points of view, may, perhaps, be conveniently summarized by stating that — inasmuch as an invention has no legal status until embodiment in an available form (Detwold *v.* Reeves, (1) INVENTION) — the *prima facie* presumption of priority necessarily belongs to and remains with him who was first to give the world such an embodiment, until the appearance on the scene of another inventor, in whose favor the presumption shifts on his establishing an earlier date for the creative thought.

144. The settled rule of law is that whoever perfects a machine is entitled to the patent and is the real inventor, although others may have previously had the idea and may have made some experiments toward putting it in practice (Agawam Co. *v.* Jordan, 7 Wallace, 583, ✽). An exception, however, to this rule is recognized in cases where the first to conceive is diligent in adapting and perfecting the invention [and *does* perfect it] and, in all controverted cases, it must first be ascertained whether the rule or the exception to the rule is applicable to the facts involved in the controversy (White *v.* Allen, 2 Clifford, 224; Lorraine *v.* Thurmond, 51 O. G., 1781; Ecaubert *v.* Hofman, 52 O. G., 2107).

Sessions *v.* Sewall, *Frothingham, Act. Com.*, 22 Aug., 1891, C. D. Ms.

As to "the Rule and the Exception," compare (142) and (143) *supra*, and notes thereto. Also compare Howe *v.* Underwood, (134) *supra*; and Edison *v.* Foote *v.* Randall, and cases there cited; see also (12) REDUCTION TO PRACTICE.

145. In interference contests, questions of priority take precedence of questions of abandonment.

Where, pending a question of abandonment, the application has been renewed and thereafter placed in interference: *Held*, that whatever might prove to be the condition of the application as to the question of abandonment, the interests of the public would be best conserved by having the question of priority first determined, but that, if applicant were successful in the interference, the attention of the Commissioner should be called to the question of abandonment before issuing the patent.

Young, x. p., *Frothingham, Act. Com.*, 24 Dec., 1891, C. D. Ms.

Compare Hunter, Jr. *v.* Lane, FEIGNED ISSUE.

146. Process and Apparatus.

Whether a process and an apparatus [for use therein and hence, includable in a single patent] are to be

regarded as independent or dependent inventions, all agree that they are separate and distinct inventions; (Atwood, x. p. 1888, C. D. 74) so that claims for the one cannot conflict with claims for the other.

Crane *v.* Meriam, *Mitchell, Com.*, 31 May, 1890, C. D. Ms.

147. The action of the Examiner denying a motion by a party to an interference to have a certain process patent to another party to the interference included, and which was conceded by the Examiner to cover a method having the same purpose in view as the subject-matter of the interference, but which interference related to an organized apparatus: *Sustained*, inasmuch as a claim for a process and a claim for an apparatus for carrying out the process do not conflict (Atwood, x. p. 44, O. G., 341 and Crane *v.* Meriam, 31 O. G., 1783).

McTighe *v.* Hunter *v.* Kennedy, *Frothingham, Act. Com.*, 16 Dec., 1891, C. D. Ms.

148. Questions of Interference and Questions of Infringement, Defined and Distinguished.

Where it appeared that the interference had been declared, — not between claims which conflicted in the sense that they covered the same subject-matter, but, — in the sense that devices made under a patent granted to one of the parties would infringe a patent granted to the other party: *Held*, that such an issue [in an interference proceeding] is not contemplated by the statute; that the law does not intend that prospective infringements shall be a test of interference between applications for patents. It only intends that the test shall be, — Do the applications contain [and claim] the same substantial invention.

Hotchkiss *v.* Smith & Post, *Fisher, Act. Com.*, 25 June, 1890, C. D. Ms.

Compare Crane *v.* Meriam (146), and McTighe *v.* Hunter *v.* Kennedy (147), *supra*.

149. Question of Abandonment. — Duty of the Examiner.

Where, upon awarding priority to one of several parties to an interference, on evidence which showed conception, disclosure, and reduction to practice by the prevailing party in 1883, but a failure to file his application until 1888, and it appeared that an article covered by the claims had been for a long time made by hand; the Examiner was directed, before allowing the application, to consider whether the invention had been abandoned.

Eberson *v.* Shea *v.* Reece *v.* Thomson & Phelps, *Frothingham*, *Act. Com.*, 14 Aug., 1891, C. D. Ms.

Compare Young, x. p., (145) *supra*, Deprez & Carpentier (150) *infra*, and Hunter, Jr. *v.* Lane, FEIGNED ISSUE.

150. Where a case that has been involved in interference is before the Examiner for consideration *ex parte*, and he is of opinion that the testimony in the interference record presents a fair presumptive showing of public use [such as works abandonment], he should act accordingly and without any expression of opinion thereon from the Commissioner in advance.

Deprez & Carpentier, x. p., *Frothingham*, *Act Com.*, 27 Aug., 1891, C. D. Ms.

151. Question of abandonment should not interrupt interference proceedings.

Where the question of public use arises in an interference proceeding, the progress of the interference should not be interrupted for the purpose of determining such question, unless for extraordinary and amply sufficient reasons.

Campbell *v.* Brown, *Simonds*, *Com.*, 16 Sept., 1891, 56 O. G., 1565.

152. When the question of public use arises in an interference proceeding, the progress of the interference should not be interrupted for the purpose of determining such questions unless for extraordinary and amply sufficient reasons. The rules and practice of the Office afford ample opportunity for determining such [purely *ex parte*] questions at the proper time.

Ib.

For a like postponement of questions of inoperativeness, see Archer, x. p., (7) INOPERATIVENESS. For postponement to determine question of patentability, compare Fiske, x. p., (191) *infra*.

153. Recommendation by Examiner that public use proceedings be instituted as laid down in Barrickle, x. p. (1886, C. D. 39): *Denied*, because predicated on a communication which fell short of establishing a *prima facie* case (Finch, x. p., 1887, C. D. 96; Deprez, x. p., 48 C. D. Ms., 80).

Beatly, x. p., *Simonds, Com.*, 10 Sep., 1891, 56 O. G., 1563.

154. Identity a question of "Merits."

Upon a petition from Examiner's refusal to declare an interference between one of applicant's rejected claims and the claim in a patent: *Held*, that as the petitioner assumed that the claims were identical, it was a question of "merits," and his remedy was, therefore, an appeal to the Board of Examiners-in-Chief.

McDougall, x. p., *Frothingham, Act. Com.*, 30 Jan., 1892, C. D. Ms.

155. The objection to a certain patent being included in an interference, for the reason that its claims purported to cover a method, while the interference "issue" related merely to an apparatus, raises a question which

relates to the "merits," and is to be passed upon, in the first instance, by the Primary Examiner.

McTighe *v.* Hunter *v.* Spencer, *Frothingham, Act. Com.*, 17 May, 1892, C. D. Ms.

156. From a refusal of the Examiner to dissolve an interference on a motion that amounts to a denial of patentability, appeal to the Commissioner is improper.

Mason *v.* Thompson, *Frothingham, Act. Com.*, 24 Aug., 1891, C. D. Ms.

157. No appeal lies to the Commissioner from a refusal of the Examiners-in-Chief to direct the attention of the Commissioner in a decision in an interference case to certain patents alleged by one of the contestants to constitute a statutory bar.

Schmiedl *v.* Walden, *Simonds, Com.*, 10 Sep., 1891, 56 O. G., 1563.

158. Where an application in interference had shown without claiming the "issue." — Remedy.

After the admission of an amendment under Rule 109, the Examiner redeclared the interference: *Held*, that, whether or not the interference proceeding be given a new number, it was evident that what the Primary Examiner had done was merely to redeclare the interference. It was not an interference *de novo*.

Jeune *v.* Brown *v.* Booth, *Frothingham, Act. Com.*, 9 Jan., 1892, C. D. Ms.

159. Non-reduction to actual Practice. — Failure to Claim the "Issue."

In June, 1881, one *M* conceived an improvement in tow-boats and illustrated the same by drawing and model. Subsequently an improvement having the same general features was conceived by one *P*. In Jan., 1882, *P* filed

an application for patent with a single broad claim. In Ap., 1882, *M* filed an application with several claims, of which *neither covered the feature common to both applications.* In May, 1882, a patent with the aforesaid broad claim issued to *P.* In June, 1882, a patent having four claims, neither of them conflicting with *P*, issued to *M.* In Jan., 1883, *M* filed a second application that described a tow-boat, which again comprised features common to both *M* and *P.* In Sep., 1889, *M*, under a division of his January application, presented a broad claim, that was at first rejected on, and subsequently put in interference with *P's* patent. *At the date of P's application M had never put the device into actual practice.*

Decision of the Examiners-in-Chief, which awarded priority to *P*, was affirmed.

McDougall *v.* Phinney, *Simonds, Com.*, 13 Aug., 1891, 56 O. G., 928.

Compare Edison *v.* Stanley, 57 O. G., 273.

160. Of two or more interfering applicants, he is entitled to the right, who, having been the first to disclose the fundamental idea, has reduced the invention to practice and has described the same in a seasonably presented application for patent, with sufficient perspicuity to enable a person skilled in the art to put it in execution; but, when the contest is between an applicant and a patentee, such applicant is required in addition to proving earliest disclosure, to show that he had used reasonable diligence and that he had put the invention into actual practice, before the date of the patentee's reduction to practice (either actual or constructive), and with such completeness and publicity that, had it been more than two years before application, the invention would have become public property.

Duchemin *v.* Richardson, *Fisher, Com.*, 1870, C. D., 31.

See, also, Richardson *v.* Denza, 1870, C. D., 156; McCulloch

v. Watkin, *Spear, Act. Com.*, 1 Nov., 1875, 8 O. G., 1074; Busha *v.* Phelps & Edmunds, *et al.*, *Doolittle, Act. Com.*, 18 May, 1876, 9 O. G., 1010; Stephenson *v.* Goodell, *Duell, Com.*, 3 June, 1876, 9 O. G., 1195, 1196; Packard *v.* Sandford, 12 Dec., 1879, *Paine, Com.*, 16 O. G., 1182; Dickson *v.* Kinsman, *Marble, Com.*, 14 Oct., 1880, 18 O. G., 1225; Starr & Peyton *v.* Farmer, Teller, Sec. Int., 28 Ap., 1882, 23 O. G., 2327; Law's Digest, pp. 427 *et seq.*

161. As between two or more interfering applications, an invention is complete when the thought conceived is *embodied* in some practical and operative form. The question is not when was the invention completed so as to compete commercially with others, but when was it completed as an operative invention.

Sawyer & Mann *v.* Edison, *Marble, Com.*, 8 Oct., 1883, 25 O. G., 597.

162. The discovery must have been embodied in an operative machine.

It is not he who first notices a phenomenon who is the inventor, but he who recognizes the value of it and draws advantages from it; nearly all scientific facts have been seen and were discussed before they were utilized. He who discovers the thing anew and *makes a machine of it* is the real inventor.

DuMoncel, Electricity as a Motive Power, p. 179.

163. The crucial test is, to whom is the public indebted for possession of the invention.

Boyd *v.* Cherry, 4 McCreary, 70; 1 Robinson on Patents, 554.

See, also, Gill *v.* Scott, 23 O. G., 2511 and Green *v.* Hall *v.* Siemens *v.* Field, *Hall, Com.*, 6 Mar., 1889, 46 O. G., 1515.

164. Reinstatement of Interference.

Where an interference between two applications and a patent had been dissolved by the Primary Examiner upon the ground that one of the applicants, being also one of the joint patentees, was one and the same party in law: *Held*, that the Examiner's conclusions were not justified by the ground stated, and the interference was reinstated.

Blanvelty *v.* Stone *v.* Stone & Pitt, *Simonds*, *Com.*, 25 Sep., 1891, C. D. Ms.

Of like general purport, see (181) *et seq.*, *infra*.

165. Reinstatement of an Omitted Party.

Where, by an official oversight, a party had been omitted upon resumption of the interference proceedings: *Held*, that, an error having been committed by the Office, it could. of its own motion, have reinstated the party, and that it was equally within the power of the Office to vacate the judgment and reinstate the party omitted, upon petition from him and without notice to the other parties.

Freeman *v.* Hunter *v.* Zippernowski & Deri *v.* Edison, *Fisher*, *Act. Com.*, 24 May, 1890, C. D. Ms.

Compare Rogers *v.* Wissinger, (23) *supra*, and (166) *infra*, and Crandall *v.* Sholes, (25) *supra*.

166. Remedy for Official Error.

A contestant who believes that error has been committed by the Office in applying Rule 114, may seek correction of the same, either by a motion to vacate judgment before the Examiner of Interferences or by an appeal to the Examiners-in-Chief.

Rogers *v.* Wissinger, *Mitchell*, *Com.*, 5 Ap., 1890, C. D. Ms.

Compare Crandall *v.* Sholes (25), and Freeman *v.* Hunter *v.* Zippernowski & Deri *v.* Edison, (165) *supra*.

167. Renewal Application in Interference; Filing, Date of.

A party's renewal application properly filed in place of his successful application forfeited for nonpayment of the final fee is, for purposes of interference a continuation of the earlier application and takes its filing date therefrom.

Duchemin *v.* Priester & Schutz, *Simonds, Com.*, 1 Mar., 1892, 58 O. G., 1416.

168. Reopening of Interference, Where granted.

Where an assignee's attorney, before going abroad, substituted another attorney in a number of interferences in which his client was a party, but, — by reason of his oversight in not executing a power in a particular case, — his client's assignees, who had become solely interested in the invention, were in ignorance of the condition of the case until notified that judgment had been rendered against their assignor for failure to take testimony: *Held*, that it appeared that the assignees were acting in good faith, and that the Examiner of Interferences did right in granting a motion to reopen, although it might be true that there had been negligence upon the part of assignor's attorney.

Shinn *v.* McElroy, *Fisher, Act. Com.*, 12 May, 1890, C. D. Ms.

169. Reopening of Interference. — When Refused.

Upon appeal from a refusal by the Examiner of Interferences to set aside judgment rendered against *A* and reopen the interference for the purpose of enabling him to take additional testimony, — the ground of said refusal being that the evidence which *A* desired to take was not newly discovered, and that, with reasonable attention and diligence, it could have been procured before the hearing: *Held*, that cases of this kind are to be governed

by the principles which govern the grant of new trials in the courts, and the decision of the Examiner of Interferences was sustained.

Van Depoele *v.* Deecker, *Fisher, Act. Com.*, 7 Ap., 1890, C. D. Ms.

Compare Parry & Parry *v.* Black, (108) *supra.*

170. An application for re-opening of an interference for the introduction of new testimony must show that the petitioner could not, with reasonable diligence, have obtained prior to the former hearing the testimony sought to be introduced. Furthermore, if the newly discovered evidence would not change the result which has been arrived at, the interference should not be re-opened.

Bowen *v.* Bradley, *Simonds, Com.*, 18 Sep., 1891, 56 O. G., 1707.

171. Sufficient "Showing" of Diligence.

It is not a sufficient showing of diligence to state that "every attempt was made that could reasonably be made" to discover the testimony, or that the party had been "diligent" in so doing; *the particular efforts and attempts* to discover the testimony must be set forth, from which the trier may be able to judge for himself whether the degree of diligence necessary for granting the motion to take additional testimony had been established.

Kanneberg *v.* Snyder & Belding, *Frothingham, Act. Com.*, 31 Oct., 1891, C. D. Ms.

172. Where, in an interference proceeding between *A, B,* and *C; A,* knowing or believing that *B* could antedate him [on the broad claim], made no contest beyond filing a statement, and consequently the interference was contested by *B* and *C* alone, and priority was

awarded to *B*; and where *A* afterward persisted in certain claims — under narrower "issues" — which were thrown into interference with the application of *C*: *Held*, that *A's* election to withdraw from the contest on the broader "issue" did not preclude him from contesting the narrower issues, for he was under no obligation to contend for what he knew he was not entitled to in order to preserve his footing to contest for that which, so far as the Office knows, he may all along have believed himself to be the first inventor of.

Smith *v.* Bentley, *Mitchell, Com.*, 9 Ap., 1890, C. D. Ms.

173. Res Adjudicata.

The question whether an interference may again be litigated when a prior adjudication has been had between the same parties, involving the same invention, has often arisen in connection with hearings in the Patent Office, and for many years the propriety of disposing of such a question upon a motion to dissolve seems to have been unquestioned (Abraham *v.* Fletcher, 1869, C. D. 50; Harlow *v.* Guernsey, 1875, C. D. 47; Richel *v.* De Sanno, 1876, C. D. 203; Whiteley *v.* McCormick, 1876, C. D. 208). And where Office action such as in Unger *v.* Saxlehner (35 C. D. Ms., 430) seemed to the Examiner to establish a different practice: *Held*, that in that case the Commissioner (Hall) intended only to decide that, upon the facts of that particular case, the proper course was to treat the prior judgment as evidence to be weighed upon the final hearing in connection with the proofs in the case at issue.

Hunter *v.* Knight, *Mitchell, Com.*, 3 Ap., 1890, C. D. Ms.

174. Res Adjudicata. — Ignorance of Law or Practice not pleadable.

An applicant who, to save expense, employs counsel unfamiliar with interference proceedings to take testi-

mony, cannot, after discovering that he has not made out his case in such a manner as he might if the testimony had been taken by counsel familiar with such proceedings, be allowed to retake his testimony.

Ricker *v.* Merrill, *Fisher, Act. Com.*, 24 July, 1890, C. D. Ms.

NOTE. — In the above case the Examiner of Interferences had denied the motion upon the authority of Donellan *v.* Barry, 37 C. D. Ms., 386, in which Commissioner Hall said: —

"There is no showing that the testimony now sought to be introduced is newly discovered, or that, by the aid of competent counsel, it could not have been presented within the time originally allowed. . . . A practice which would permit a contestant to experimentally conduct his own case to a probable failure, and then, after consultation and with competent assistance, would permit him to make further endeavors to show what, with such assistance, he could and should have earlier shown, would be contrary to all well-established rules and legal principles."

For circumstances justifying some relaxation of the above doctrine where the case was an *ex parte* one, see ruling by Commissioner Mitchell in case of Marx, x. p., 21 July, 1891,

(5) RE-INSTATEMENT OF CLAIM.

Compare 1 *et seq.*, IGNORANCE NOT PLEADABLE.

175. Right to demand an Interference.

Until an applicant has acquired the standing of one entitled to a patent — as between himself and the public — he has no standing to demand an interference with any other applicant or with a patentee.

Abbey, x. p., *Mitchell, Com.*, 14 Mar., 1890, C. D. Ms.

176. Rule 128. — Practice.

When an interference is suspended under Rule 128, the claims deemed to be anticipated should be rejected by the Primary Examiner, and the files and papers should not be returned to the Examiner of Interferences until it has been determined whether the appellate tribu-

nals will sustain the Primary Examiner in rejecting the claims, or until there has been such delay on the part of the applicant in taking appeal as to authorize the Office either to dissolve the interference, or to issue a patent to the opposing party.

Westinghouse *v.* Thomson, *Mitchell, Com.*, 26 June, 1891, C. D. Ms.

177. Secondary Evidence, — When admissible.

Where a motion was made by the opposing party to strike out certain testimony as to the construction of a machine not itself put in evidence, upon the ground that "such testimony constituted mere secondary evidence, and that, no proof having been brought forward that the alleged machine could not be found, a sufficient basis for the introduction of such evidence had not been laid," and the Examiner of Interferences had ruled that as the testimony disclosed that the whereabouts of the machine was unknown, its non-production as primary evidence was sufficiently accounted for, and the decision of the Examiner of Interferences had been affirmed on appeal; a motion for rehearing by the opposing party was denied on the ground that the answers to the several questions showed that it would have been unavailing to have made a search for the machine. Leave was, however, granted to urge the matters presented by the motion at the final hearing before the Commissioner.

Wiselogel *v.* Morse; Morse *v.* Wiselogel, *Mitchell, Com.*, 10 Nov., 1890, C. D. Ms.

178. Skilled Assistant.

Where, in an interference proceeding, it was contended that, by reason of certain modifications and extensions made by *A's* draftsman, that person, and not *A*, was the real inventor of the feature in the interference issue: *Held*, that the scope of the invention between *A* and

his skilled assistant was to be determined just as it would be determined if that particular question, and no other, were in issue, and priority was awarded to *A* (Agawam Co. *v.* Jordan, 7 Wallace, 583, ✽).

Shreve *v.* Evans, 12 Aug., 1891, C. D. Ms.

Compare cases cited under EMPLOYER AND EMPLOYÉ.

179. Constructive Waiver.

The Examiners-in-Chief did not err in refusing to strike out the testimony of witnesses upon the ground that no notice had been given that said witnesses were to be examined where the opposing counsel was present at the examination and *cross-examined* said witnesses (citing Rule 154).

Creteau *v.* Hall, *Frothingham, Act. Com.*, 17 Nov., 1891, C. D. Ms.

NOTE (i). — The passage referred to in Rule 154 is —

If the opposing party shall attend the examination of witnesses not named in the notice, and shall either cross-examine said witnesses *or* fail to object to their examination, he shall be deemed to have waived his right to object to such examination for want of notice.

NOTE (ii). — The appeal was based principally on the Board's refusal to strike out certain testimony on behalf of Hall. Creteau's counsel had entered a protest and non-waiver on the testimony-record, but, inasmuch as he proceeded to cross-examine, that act was construed to be a waiver of his objection.

180. In an interference proceeding test of inventorship is not in suggestion of the object sought, but in production of the means to accomplish it.

It is not enough that one of the parties engaged in interference with Bell's patent should have conceived it possible to construct a device that would produce the result sought. The conception must not be of the re-

sult to be attained, but of the means, which is the patentable thing, to produce that result.

Voelker *v.* Gray *v.* Edison *v.* Bell, *Butterworth, Com.*, 30 O. G., 1092.

181. The Subject-Matter must conflict.

An interference should not be declared between an unexpired patent which shows and claims one species of an invention and a subsequent application disclosing another and different species, even although the latter contains a claim of sufficient scope to include the species contained in the unexpired patent. Rule 75 provides for precisely such a case and unmistakably states that, on applicant filing the proper antedating oath, the unexpired patent ceases to be a bar. The showing, however, of the oath should of course be complete and satisfactory and should satisfy the Examiner that the facts testified to establish completed invention before the filing of the application upon which the patent was granted (Donovan, x. p., 52 O. G., 309; Hurlburt, x. p., 52 O. G., 1062).

Reed *v.* Landman, *Mitchell, Com.*, 26 May, 1891, 55 O. G., 1275.

See AFFIDAVIT TO OVERCOME REFERENCES.

182. An Interference looks to Subjects-Matter rather than to Parties.

An interference looks to subject-matter rather than to parties. For all purposes of interference, a sole application filed by one of two or more joint patentees for the same invention as that for which the joint patent issued, is as independent thereof as though filed by a third party. The evidence for *S & B*, which showed *S* (as between *S* and *B*) to be sole inventor is not conclusive in a subsequent interference between an application by *S* as sole inventor and the application of a third party *K*. As between *S* and *K*, the decision in the previous inter-

ference could only show that *S & B* had failed to establish a *joint* invention as against *K*, but could not affect the claims of *S* as sole inventor.

Snyder *v.* Kanneberg, *Frothingham, Act. Com.*, 17 Mar., 1892, 58 O. G., 1840.

See Kanneberg *v.* Snyder & Belding (171), *supra;* also, Sprague *v.* Van Depoele *v.* Hunter *v.* Knight, (185) and (186) and Rogers *v.* Wissinger, (187) *infra.*

183. The *Claims* must conflict.

Interference can exist only between conflicting claims for the same invention. There is nothing in Upton, x. p. (1884, C. D., 26), that affords any warrant for the view that claims can conflict which are not for the same invention, either generically or specifically.

Crane *v.* Meriam, *Mitchell, Com.*, 31 May, 1890, C. D. Ms.

Of like purport, see Rogers *v.* Wissinger, (23); Dodd *v.* Reading, (33); Edison *v.* Heisinger, (66); Jeune *v.* Booth, (71); McTighe *v.* Hunter *v.* Kennedy, (147), and Hotchkiss *v.* Smith & Post, (148) *supra*, and cases (184), (185), (186), (187), (188) and (189) *infra.* See, however, Dewey *v.* Thomson, (66); Reed *v.* Landman, (67), Edison *v.* Stanley, (69), and Gould *v.* Case, (72) *supra.*

184. Official Suggestion in *Inter Partes* Cases, — Forbidden.

It is not the business of the Office, unless directed to such course by the claims of the parties, to search out matter which may be common but which is not disclosed or claimed by *both* parties in such a manner as to bring the common matter in conflict.

Sprague *v.* Van Depoele *v.* Hunter *v.* Knight, *Fisher, Act. Com.*, 24 July, 1890, C. D. Ms.

NOTE (i). — The above dictum (which is substantially a reiteration of the doctrine laid down in the Patent Office Rule

75 and given a specific application in the case of Upton, x. p., 27 O. G., 99) marks an important departure from the practice which permitted official suggestions whereby an applicant who had described but not claimed matter which, if properly set forth in his claim, would have brought his case into interference with a cotemporary application, was given the opportunity to revise his application for that purpose.

NOTE (ii). —The doctrine laid down in Sprague *v.* Van Depoele *v.* Hunter *v.* Knight, *supra*, and in Ricker *v.* Merrill, (174) *supra*, for all *inter partes* cases; such rulings as that in Wallis, x. p., (3) RE-OPENING OF CASE, and, above all, the restriction of remedy by Re-issue made by the Supreme Court in Edward Miller and Co. *v.* The Bridgeport Brass Co., (2) RE-ISSUE, have combined to *greatly increase the importance of care, judgment, and familiarity with the law and practice of those into whose hands is committed the preparation and prosecution of original applications for patents.*

185. The decision in Upton, x. p., (27 O. G., 99) explicitly states that the subject-matter *claimed* must conflict and, under recent decisions, the doctrine of that case has been held to require that the claims should be co-extensive in scope, or, at least, that the claim of one party should include that of the other party in such a sense that the broader claim can be predicated upon the subject-matter embraced in the narrower claim (Bechman *v.* Johnson, 41 C. D. Ms., 372; Dewey *v.* Thomson, 43 C. D. Ms. 44).

Ib.

Compare Reed *v.* Landman, (181), and Snyder *v.* Kanneberg, (182), *supra*, and Rogers *v.* Wissinger, (187), *infra*.

186. It is not held, — in any decision of which I am aware, — that the claim of one party can include that of another, so as to bring them into interference, when

the structures upon which the claims are based are entirely dissimilar and effect different purposes by different ends.

Ib.

187. The question whether interference in fact exists depends, not merely upon the language employed in the respective claims, but whether, in addition to similarity in phraseology, there is an interference between the *subjects-matter* of the respective claims. If, when construed in the light of their respective specifications, the claims involved in an interference are found to relate to different subjects-matter then, although the phraseology may be the same, the claims are different in a patentable sense.

Rogers *v.* Wissinger, *Mitchell, Com.*, 7 Mar., 1891, 56 O. G., 804.

Compare Jeune *v.* Booth, (71), Snyder *v.* Kanneberg, (182), and Sprague *v.* Van Depoele *v.* Hunter *v.* Knight, (185), and (186), *supra.*

188. Interferences in the Patent Office, like interferences in the Courts, exist only where the claimed inventions conflict.

Reed *v.* Landman, *Mitchell, Com.*, 26 May, 1891, 55 O. G., 1275.

189. It may be considered as settled that, in determining the question of interference, the Office is to look beyond mere words of the claims and consider whether or not they interfere *in substance* (G. & S. Ore Sep. Co. *v.* U. S. Ore Disintegrating Co., 6 Blatch., 309).

Penney *v.* Gunn, *Simonds, Com.*, 13 Aug., 1891, C. D. Ms.

190. Preliminary Statement, — Extension of Time for.

The provision of Rule 104 which gives the Examiner of Interferences discretion to dispense with service on

the opposing party of notice of motion to extend time for filing the preliminary statement does not contemplate a case where such service can be reasonably effected and it should not be exercised in such a case.

Stuart *v.* Elliott *v.* Pattison, *Simonds*, *Com.*, 20 Oct., 1892, C. D. Ms.

191. Suspension to determine Patentability of a Claim in Interference.

Where notice of a motion to stay an interference — in order that the patentability of one of the claims involved in the "issue" might be determined before proceeding with the interference — had not been given to the opposite party: *Held*, that, under Rule 153 such motion must be dismissed but, it appearing that the last Office-action on one of the claims was a distinct rejection on a reference: *Also held*, that, although it might be said that the declaration of interference implied patentability, yet applicant was entitled, under Rule 65, to a favorable decision as to the question of patentability before an interference was declared and, therefore, that the interference must be suspended until the Examiner decided whether or not so much of the invention as was declared to be in interference was patentable and announced his decision to the applicant; but that he should not delay the interference proceedings in order to allow applicant to appeal from his decision rejecting any of the claims not involved in the interference. As to those claims, applicant's remedy was to be found in Rule 106.

Fiske, x. p., *Mitchell*, *Com.*, 3 Oct., 1890, C. D. Ms.

NOTE. — Rule 106 permits withdrawal of and embodiment in one or more new applications all claims not involved in interference.

Compare Archer, x. p., (7) INOPERATIVENESS, and Beatly, x. p., (152), *supra*.

192. Testimony taken abroad. — Rule 158.

The Examiner of Interferences granted *R's* motion to take testimony abroad, under Rule 158, and denied *F's* motion for a modified order directing that the testimony be taken orally rather than by written interrogatories and cross-interrogatories as the rule provides: *Held*, sustaining the Examiner of Interferences, that nothing short of the mutual consent of all the interested parties can avoid the strict letter of the rule.

Raffard *v.* De Ferranti, *Frothingham, Act. Com.*, 13 June, 1892, C. D. Ms.

193. Two Years Public Use.

When the defeated party filed a protest against issue of a patent to the prevailing party alleging want of novelty and two years public use, the case was remanded to the Primary Examiner to consider the question of public use, which question had not been before him, the Assistant Commissioner not considering the doubt as to patentability sufficient to exercise jurisdiction on that point.

Still *v.* Hobler & Peck, *Frothingham, Act. Com.*, 24 Oct., 1891, C. D. Ms.

194. Veil of Secrecy.

While each party is in ignorance of the character of his opponent's invention the interference is declared, and if one of the parties (before either party is entitled to have the veil of secrecy lifted) tenders a disclaimer, the Office determines whether the interference shall continue.

Diescher *v.* Walker *v.* Diescher & McGill, *Mitchell, Com.*, 24 June, 1890, 52 O. G., 459.

195. Control of Witnesses.

It would be a dangerous practice for the Office to attempt to decide in advance what is proper and what

is not proper cross-examination, owing to the great latitude that is allowed in conducting such proceedings. Should the witness refuse to answer a certain question on cross-examination, and counsel thought it a material and proper one to be asked, then he would have, at the proper time, the right to move for a suppression of the deposition (Milligan *v.* Neidringhaus, 1887, C. D. 1; Houston *v.* Barker *et al.*, 1888, C. D. 173). Furthermore, there are precedents, in like cases, for filing a motion before the United States Court of the district where the testimony is being taken, in order to determine whether the witness shall answer a certain question or whether or not a certain line of cross-examination shall be pursued. This course was followed during the taking of testimony in the interference entitled Osgood *v.* Badger *v.* Bennett, No. 10,215, and the court (*Colt, J.*) ordered that the witness need not answer certain cross-interrogations or certain questions relating to a line of cross-examination. See also record of Hisey in the interference. Ligowski *v.* Peters *v.* Hisey, No. 14,006.

Brown *v.* Unz, *Frothingham, Act. Com.*, 4 Aug., 1891, C. D. Ms.

For powers of the Commissioner of Patents in respect to testimony and witnesses, see Wright *v.* Daggett, WITNESSES.

196. The Commissioner of Patents has no power in the matter of taking testimony of witnesses, and has no control over the taking of their depositions nor over their conduct while such depositions are being taken. The whole matter is left in the hands of the Federal Court of the district in which the testimony is being taken, and either of the parties has full authority to apply to the district judge for orders compelling the attendance and controlling the conduct of witnesses (Wright *v.* Daggett, 1888, C. D. 116).

Ib.

197. The rights of one party to an interference are not to be prejudiced by inadvertent issue of the patent to the other party.

Where there have been two conflicting applications, and a patent has been inadvertently granted to one applicant without notice to the other, an interference may be declared *nunc pro tunc*[1] between the application and the patent, under authority of the first clause in Rule 93.

Marston, x. p., *Stockbridge, Act. Com.*, 4 Feb., 1882, 21 O. G., 633.

198. A Drawing as Proof of the incipient Invention.

An invention relating to machinery may be exhibited as well in a drawing as in a model, so as to lay the foundation to a claim to priority, if sufficiently plain to enable those skilled in the art to understand it.

Webster *v.* Higgins, U. S. S. C. By *Bradley, J.*, 8 May, 1882, 21 O. G., 2031, ✱.

199. Decision once given cannot be permitted to be disturbed by new evidence that had been purposely withheld.

A degree of conclusiveness attaches to a correct decision based upon the record and the evidence, which cannot be permitted to be disturbed by a motion which, after the party's admission of wilful and deliberate omission to take evidence, simply asks, after trial, that the very evidence which might have been originally taken may now be introduced. If such a motion could prevail there would be no end to interference proceedings.

Beardsley *v.* Moeslein, *Hall, Com.*, 6 Mar., 1889, 46 O. G., 1640.

200. Review of Action.

Where, after a decision of priority in favor of the applicant, in an interference between an application and

[1] Now as then.

a patent, and pending an appeal before the Examiners-in-Chief, the patentee moved that the case be referred back to the Primary Examiner for investigation as to the novelty of the issue when considered broadly in accordance with its terms, or for the reforming of the issue, or for such other proceedings as may seem proper: *Held*, in view of the advanced stage to which the proceedings had progressed, that the motion must be denied, with leave, however, to call it up at the final hearing before the Commissioner.

Adams *v.* Kinzer, *Mitchell, Com.*, 16 Sep., 1890, C. D. Ms.

INTERFERING PATENTS.

1. Relief in Equity.

In a suit, under Section 4918 R. S., to set aside a patent on the ground of interference with plaintiff's prior patent, defendant may lay the foundation for affirmative relief on an answer alleging the validity of his own patent and the invalidity of plaintiff's patent.

Elec. Ac. Co. *v.* Brush Elec. Co., U. S. C. C., N. D. O., *Brown, J.*, 26 Dec., 1890, 44 F. R., 602.

2. It is well-settled law that two patents interfere, within the meaning of the Section 4918 R. S., only when they *claim* (in whole or part) the *same invention* (Gold & Silver Ore Separating Co. *v.* U. S. Disintegrating Ore Co., 6 Blatch., 307; Reed *v.* Landman, 55 O. G., 1275; Morris *v.* Mfg. Co., 20 F. R., 121; Pentlarge *v.* Bushing Co., 20 F. R., 314; Elec. Ac. Co. *v.* Brush Elec. Co., 44 F. R., 602; Mowry *v.* Whitney, 14 Wall., 434, *). Hence, a bill in equity, under said section, for relief against a patent, alleged to interfere with patents owned by complainant, cannot be sustained, where the answer denies such interference, if it appears that the claims of the respective patents do not cover the same invention.

In the case of Garrett *v.* Siebert (98 U. S., 75, ✿) the answer did not deny, but rather admitted, an interference of the patents, and it is therefore not an authority against the general doctrine which the courts have laid down upon this point.

Nathan Mfg. Co. *v.* Craig, U. S. C. C. Mass., *Colt, J.*, 12 Feb., 1892, 49 F. R., 370.

INTERPRETATION.

Of two possible interpretations of a patent, preference is given to an interpretation that will sustain it.

In construing a patent, courts should proceed in a liberal spirit, so as to sustain the patent and the construction claimed by the patentee, if it can be done consistently with the language he has employed; and this applies to a reissue as much as to an original patent.

Judgment affirmed.

Klein *v.* Russell, U. S. S. C. By *Swayne, J.*, Oct. term, 1873, 19 Wallace, 433, ✿.

For applications of the above doctrine, see (48) *et seq.*, THE CLAIM.

NOTE (i).—The suit was on a re-issued patent to one Russell for a "Process for Treating Leather." The claims on which suit was brought were:—

1. The employment of fat liquor in the treatment of leather, substantially as described.

2. The process, substantially as herein described, of treating bark-tanned lamb or sheep skin by means of a compound composed and described essentially as specified.

NOTE (ii).—Courts have repeatedly intimated that their sustentation of claims which require (to avoid invalidation) "*a liberal construction*," is not to be construed into an approval of the Patent Office action in granting them. See (29) *et seq.*, THE CLAIM and, (2), CONSTRUING CLAIMS.

INVALIDATED REISSUE.

1. Restoration to Original Form.

The reissue having been adjudged invalid, patentee sought to restore the patent to its condition as originally granted, by filing in the Patent Office a disclaimer, as provided for in Section 4917 R. S., by which ("with the exception of six consecutive words not affecting its meaning") the specification was restored to its original form. The court, remarking the evident purpose of the patentee to abandon the reissued and resume the original patent, said: "We are of the opinion that this could *not* be done by a disclaimer. It is not competent for the patentee or his assignees, by merely disclaiming all the changes made in reissuing, to revive and restore the original patent. This could be done only — if it could be done at all — by surrender of the reissued patent and grant of another reissue." Decree of the Circuit Court dismissing the bill, was affirmed.

McMurray *et al. v.* Mallory, U. S. S. C. By *Woods, J.*, 24 Mar., 1884, 27 O. G., 915, ❀.

2. When the patent, in its original form, was valid, but the reissue based thereon is invalid, there is no good reason why a second reissue, embracing the valid claim alone of the original patent, would not be valid.

Giant Powder Co. *v.* Safety Powder Co., *Sawyer, J.*, 18 Feb., 1884, 27 O. G., 99.

NOTE. — For conditions of favorable action on an application for re-issue, see (2) *et seq.*, RE-ISSUE.

INVENTION.

1. Patentable Invention defined.

There is no doubt that he who has discovered some new element or property of matter may secure to him-

self the ownership of his discovery so soon as he has been able to illustrate its practicability and to demonstrate its value. His patent, in such case, will be commensurate with the principle it announces to the world, and may be as broad as the mental conception itself. But the mental conception must have been susceptible of embodiment, and must, in fact, have been embodied in some mechanical device, or in some process or art. The patent must be for a *thing*, not for an idea merely.

Detwold *v.* Reeves, *Kane, J.*, Sept. 1851, 1 Fisher, 127.

2. Patentable invention relates to a new *means* for a useful result.

The plan of an invention includes the idea of means as well as the result to be attained. The idea of means is present in the definite conception of the organized machine, but the idea of means is not present in the suggestion that it is desirable to make a single new machine that will take the place of three old ones. He is the true inventor who conceives of a way of accomplishing the result sought for and *who embodies it in an operative form.*

Greenlee & Strom *v.* Roberts, *Mitchell, Com.*, 11 May, 1891, C. D. Ms.

GENERIC INVENTIONS.

3. The creator of a new art may claim the means and also the process, irrespective of the particular means.

If the Bell patent were for a mere arrangement or combination of old devices to produce a somewhat better result in a known art, then, no doubt, a person who substituted a new element not known at the date of the patent, might escape the charge of infringement; but Bell discovered a new art, — that of transmitting speech by electricity, — and has a right to hold the broadest claim for it which can be permitted in any case, not to

the abstract right of sending sounds by telegraph without any regard to means, but to all means and processes which he has both invented and claimed.

Am. Bell Tel. Co. *v.* Spencer, *Lowell, J.*, 27 June, 1881, 20 O. G., 299.

4. There can be no patent for a mere principle; the discoverer of a scientific fact or a natural force cannot have a patent for that; but if he, for the first time, invents a process by which a certain effect of one of the forces of nature is made useful to mankind, and fully describes and claims that process, and also describes a mode of apparatus by which it may be usefully applied, he is entitled to a patent for the process of which he is the first inventor, and is not restricted to any particular form of apparatus by which he carries out the process. Another, who afterwards invents an improved [or different] form of apparatus embodying the same process, may indeed obtain a patent for his improvement; but he has no right to use the process, either in his own or any other form of apparatus, without consent of the first inventor of the process.

Am. Bell Tel. Co. *v.* Dolbear, *Gray and Lowell, JJ.*, 24 Jan., 1883, 23 O. G., 535.

See also *Kane, J.*, in Detwold *v.* Reeves, DISCOVERY.

5. As was said in Spencer's case (Bell *v.* Spencer, 20 O. G., 299) Bell discovered a new art, — that of transmitting speech by electricity, — and has a right to hold the broadest claim for it which can be permitted in any case; and the invention is nothing less than a transfer to a wire, of electrical vibrations like those which a sound has produced in the air; and his patent, while not covering the abstract principle, without regard to means of transmitting speech by electricity, yet is not limited to a particular form of apparatus, but includes

the process or method, the essential elements of which are the production of what the patentee calls "undulatory" vibrations of electricity to correspond with those of the air, and transmitting them to a receiving instrument capable of echoing them.

Ib.

6. Where the invention is of a primary character and the mechanical functions performed by the machines are, as a whole, entirely new, all subsequent machines which employ substantially the same means to accomplish the same results are infringements; although the subsequent machines may contain improvements in the separate mechanisms which go to make up the machine.

Morley Sewing Machine Co. *v.* Lancaster, U. S. S. C. By *Blatchford, J.*, 4 Feb., 1889, 47 O. G., 267,❁.

7. Primary Invention. — Claims.

Where applicant is working in a new field and no reference is cited to impugn the novelty of the invention, he is not only entitled to great breadth in construing of his claims [by the courts], but he is entitled to liberality in the framing of his claims [before the Patent Office].

Dalton, x. p., *Simonds, Com.*, 18 Feb., 1892, C. D. Ms.

Compare Mefford, x. p., (4) CLASSIFICATION.

8. Conception, — Evidence of.

On a motion for a rehearing, it was contended that error lay in holding that certain sketches disclosed the inventions in controversy, for the reason that they "did not show an organized machine:" *Held*, that it was not necessary that they should, for if — as found by the court in McCormick Co. *v.* Harvester Wks. (42 F. R. 152) — oral explanations of a contemplated improvement in the presence of a machine to which these improve-

ments are to be applied, is sufficient evidence on such a point, much more is it sufficient to make sketches of the contemplated improvements in the presence of the machine, as was done in this case.

Ligowski *v.* Peters *v.* Hisey, *Simonds, Com.*, 17 Nov., 1881, C. D. Ms.

Compare (1) CONCEPTION; (21), (22), (23), (24), (25), (26), (27), (28), THE CLAIM; and (11), (12), THE SPECIFICATION.

9. It is the last step that wins.

In the law of patents, it is the last step that wins; and the courts will sustain a patent in favor of the last of a series of inventors all of whom were groping to attain a certain result which only the last one of the number seemed able to grasp.

The Washburn & Moen M'f'g Co. *v.* The Beat Em All Barbed Wire Co. *et al.*, U. S. S. C. By *Brown, J.*, 29 Feb., 1892, 58 O. G., 1555, ✿.

10. Utility as a Test.

No one of the seven references suggests the improvement which has been *arrived at* by applicant, and their very multiplicity, when all had fallen short of the result which he has practically attained, is evidence of patentable invention on his part, for, when a number of inventors had been reaching out for a desirable end and all had fallen just a little short of its attainment, that state of facts is practically conclusive evidence that he who attains the whole measure of success does so by doing something which was not obvious and which involved patentable invention.

Decision of the Examiners-in-Chief was reversed and patent ordered to issue to Shannon.

Shannon, x. p., *Simonds, Com.*, 21 Oct., 1891, 59 O. G., 297.

See, of like tenor, Bruce *v.* Warder, (1) and cases following, UTILITY, and Washburn *v.* Barbed Wire Co., (9) *supra.*

11. A practical inventor who succeeds in making a machine that will operate upon the principles embodied in his apparatus, and is the first to disclose it to the world, should not find himself forestalled by a theorist, and be compelled to occupy the position of an infringer when he was the first person in a position to teach the world how to make the machine.

Bausset, x. p., *Mitchell, Com.*, 7 Mar., 1890, C. D. Ms.

12. Where the results in the patented process cited as a reference by the Examiner were obtained by the use of bisulphide of carbon, which was lost in the operation: *Held*, that if applicant's simple improvement had been perfectly obvious, as contended by the Examiners-in-Chief, the patentee of the reference would hardly have gone to the expense of using and losing the bisulphide of carbon. Decision of Examiners-in-Chief reversed.

Sommer, x. p., *Simonds, Com.*, 9 Oct., 1891, C. D. Ms.

NOTE. — The aim of applicant was to produce a certain "Viscid Fatty Compound," and the peculiarities of his process are set forth in his specification in the language following: —

The minute but injurious formation of chlorhydric acid is neutralized by some inorganic neutralizing agent, — which may be oxide of calcium or oxide of magnesium in form of a very fine powder, or hydroxide of sodium (or of potassium or ammonium) in a concentrated solution, or that of calcium in powder, or crystallized carbonate of sodium in form of a coarse powder, or the carbonate of sodium (or of potassium or ammonium) in a concentrated solution, or a soap of sodium, potassium, calcium, magnesium, or aluminum in powder or in oily solution. — After the compound has stood for several days (or longer if possible) the upper portion is decanted or drawn off from the sediment; but beyond this "*voluntary* separation" no effort is made to remove any excess of the neutralizing agent nor any of the chlorhydric acid derivatives of neutralizing action.

13. Where a step in the process was not disclosed in the references, and persons having a practical acquaint-

ance with the art made affidavits attributing to the process valuable results in saving of time and securing homogeneity of product: *Held*, reversing the decision of the Examiners-in-Chief, that there was evidence of useful novelty indicating the exercise of invention, — and claim was allowed.

Grant, x. p., *Simonds*, *Com.*, 23 Sep., 1891, C. D. Ms.
Compare Hoe *v.* Cottrell, (8) UTILITY.

14. Theoretical compared with consummated Invention.

Patents are granted on the condition of disclosure of a practical way of accomplishing a result which the applicant has achieved. So long as everything rests wholly in theory, and so long as everything remains to be demonstrated, nothing has been done which is patentable.

Bausset, x. p., *Mitchell*, *Com.*, 7 Mar., 1890, C. D. Ms.
Of like purport, see (30) *infra*.

15. Generic Invention.

Joseph F. Glidden held to have been the first and original inventor of the improvement in wire-fences claimed by him, which consisted of "a coiled barb locked and held in place by intertwisted wires," and the patent therefor — No. 157,124 — held to be valid and to have been infringed.

The Washburn & Moen M'f'g Co. *et al. v.* The Beat Em All Barbed Wire Co. *et al.*, U. S. S. C. By *Brown*, *J.*, 29 Feb., 1892, 58 O. G., 1555, ✱.

16. There may be a patent for a process irrespective of any particular means, but the specification must describe some one means of carrying it out.

A patent for a process, irrespective of the particular mode or form of apparatus for carrying it into effect,

is admissible under the patent laws of the United States. But, to sustain such a patent, the patentee should be the first and original inventor of the process, should claim it in his patent, and, if the means of carrying it out are not obvious to an ordinary mechanic skilled in the art, his specification should describe some mode of carrying it out which would produce a useful result.

Detwold *v.* Reeves, *Kane J.*, Sep., 1851, 1 Fisher, 127.

17. The Examiners-in-Chief having rejected a process claim because it differed from a claim allowed in a prior application of the same inventor only by the addition of a step, which consisted in removing, as fast as formed, portions of the product whose presence obstructed the process: *Held*, that, as the claim under consideration must have been allowed if the other claim had not been before the Office in the earlier application, an equitable treatment of the matter required the two claims to be considered as relating to distinct improvements in the same general subject-matter, and the claim was allowed.

Manhes, x. p., *Simonds*, *Com.*, 27 Oct., 1891, C. D. Ms.

Of like general tenor, see Houston, x. p., (5), and Rogers, x. p., (6), PROCESS.

18. An improvement may be patented, but, during the lifetime of the original patent, can be used only subject to its claims.

If a subsequent inventor discovers a new mode of carrying out a patented process, though he may have a patent for such a new mode, he will not be entitled to use the process without consent of the patentee thereof.

Tilghman *v.* Procter, U. S. S C. By *Bradley*, *J.*, 21 Jan., 1881, 19 O. G., 859, ✱.

19. Test of Completed Invention.

A good mechanic of proper skill in matters of the kind can take Bell's patent and, by following the speci-

fication strictly, can, without more instruction, construct an apparatus which, when used in the way pointed out, will do all that is claimed the method or process will do. Some witnesses have testified that they were unable to do it. This shows that they, with the particular apparatus they had and the skill they employed in its use, were not successful, not that others, with another apparatus, perhaps more carefully constructed or more skilfully applied, would necessarily fail. As was said in Loom Co *v.* Higgins (105 U. S., 580 and 586, ✿), when the question is whether a thing can be done or not, it is always easy to find persons ready to show *how not to do it.*

Dolbear *et al. v.* Am. Bell Tel. Co., U. S. S. C. By *Waite, Ch. J.*, 19 Mar., 1888, 43 O. G., 347, ✿.

SPECIFIC INVENTIONS.

20. An improvement on a combination is the subject of a patent, but, at the same time, the improvement cannot be used without the consent of the original patentee.

Foster *v.* Moore, *Curtis, J.*, 1 Curtis, C. C. Rep., 279; Law's Digest, 351.

21. Whenever the changes in the arrangement of a machine or invention and its consequences, taken together, are considerable, there is sufficient invention to support a patent; when the change, however minute, leads to consequences and results of great practical utility, this condition is satisfied.

Walsh, *ex parte*, Supreme Ct., District Col., 1857, Law's Digest, 423.

22. Later inventors, who devise different means for accomplishing the several steps of the method, are entitled only to patents for improvements upon the method

or means of the first inventor subject to his paramount right to the method itself.

Bell *v.* Gray, *Paine, Com.*, 6 Mar., 1879, 15 O. G., 776.

23. Where one patentee has invented a combination for a particular purpose, the field is open to another to invent a combination of the same parts differently arranged and effecting the same result by a different mode of operation.

Ry. Register M'f'g Co. *v.* 3rd Av. R. R. Co., *Wallace, J.*, 19 Oct., 1887, 42 O. G., 379.

24. The prior state of the art and the express language of the specification combine to restrict the claim to the use of a stencil made by the electric pen. Thus construed, it is not infringed by the defendant's device. Defendant's "cyclostyle" shows another step in the art. It is as much an improvement on Edison's method as that was an improvement on what preceded it.

Edison *v.* Claber, *Coxe, J.*, 5 Ap., 1889, 47 O. G., 1486.

25. The complainant, having come into an already created and flourishing art at so late a date and after others had covered the same ground which he attempted to cover, is not entitled to invoke the doctrine of equivalents in regard to his mechanism, in any respect; his patents therefore, if sustained at all, can only be for the special devices which characterize his particular contribution to the art separate and apart from those which the machines of both complainant and defendant possess in common with the art.

Consolidated Roller Mill Co. *v.* Barnard & Leas M'f'g Co., *Blodgett, J.*, 10 Feb., 1890, 53 O. G., 430.

26. The patentee of an invention which is merely one of a train of successive improvements in an already

created art, is not entitled to invoke the doctrine of equivalents, and his patent, if sustained at all, can be held to cover only the specific arrangement which it describes.

Ib.

For qualifications of above doctrine, see Burr *v.* Duryee, (5) EQUIVALENTS. See also Rodebaugh *v.* Jackson, (10) EQUIVALENTS and *Note*.

27. The origin of the invention is immaterial.

The invention, if new and useful to the public, may be the result either of long experiment and profound research, or of a sudden and lucky thought, or of a mere accidental discovery. Luck, labor, or inspiration gives an equal right.

Tindall, L. C. J., Eng.; see, to same purport, Vollrath *v.* Comstock, (5) ART. Compare Gibford, x. p. (34), *infra*.

THE BORDER LINE BETWEEN INVENTION AND SKILL.

28. Invention, — How determined.

The line dividing invention from non-invention is very dim, and cases lying near it often present great difficulty. In deciding them, judges have occasionally used expressions which may seem extravagant and calculated to mislead. Some of those expressions would almost justify a doubt whether a majority of the patents issued are valid, and others whether any of them are invalid. The decisions are, however, generally harmonious and establish a number of fundamental conclusions, thus: it is definitely agreed and established that, when a change in the method of making an article of manufacture produces a different and beneficial result — although the difference may exist merely in improving or cheapening the article — and the change and its advantages *had not heretofore been seen or*

made by others interested in seeing and making it, — there is sufficient evidence of invention to sustain a patent.

Zinsser *v.* Kremer, U. S. C. C., N. J., *Butler, J.*, 12 June, 1889.

28′. It is often no easy task to draw the true line of distinction between invention, the product of original thought, and mere obvious manual changes following the beaten track of mechanical experience: but it is obvious there *is* a limit beyond [within ?] which mere changes cannot and ought not to receive the protection of letters-patent.

Kirby *v.* Beardsley, *Shipman, J.*, Sep., 1867, 3 Fisher, 265.

29. It is opposed to the true interests, alike of inventors and of the public, for the Patent Office to adopt a lower standard of invention than that recognized by the courts. In applying this rule, however, great care should of course be taken. Judge Shipman remarks, in Kirby *v.* Beardsley (3 Fisher, 365): *To give the inventor the benefit of any doubt* as to originality or creative thought, was to nourish inventive enterprise by lending encouragement to every degree of merit (*Wirt, Att.-Gen.*, 2 Op., 52, Myers Fed. Dec. 453). This is the more important because simple contrivances, the offspring of simple and even involuntary thoughts, often produce great and beneficial results, while complex and elaborate ones, the product of long and profound cogitation, not infrequently prove comparatively or wholly abortive. But it is obvious that there is a limit beyond [within ?] which mere changes cannot and ought not to receive protection. The test must be kept in view which was laid down by the Supreme Court of the United States in Dunbar *v.* Myers (11 O. G., 35, ❁), that invention or discovery is the requirement which constitutes the foundation of the right to obtain a patent; and it was

decided by that court, more than a quarter of a century ago, that unless more ingenuity and skill were required in making or applying a given improvement than are possessed by an ordinary mechanic acquainted with the business, there is an absence of that degree of skill and ingenuity which constitutes the essential element of every invention.

Blackman *v.* Murray, *Doolittle, Act. Com.*, 25 Oct., 1877, C. D. 8.

Compare (30) *et seq., infra.*

29′. Williams' improvement (Improvement in Cloth & Rubber Gaiter Overshoes, pat., 10 Sep., 1872, No. 131,201) approaches *the border-line of invention*, and it is very likely that, upon the testimony in the case, it would generally have been held patentable by the Circuit Courts before the recent decisions of the Supreme Court on the subject of invention. The tendency of these decisions is to confine patents within narrower limits than formerly. They especially demand that a device which is merely an improvement upon a pre-existing one, must, in order to be patentable, contain a new idea and perform some new function, and not present changes in degree only, or simply new or more extended applications of the original thought (Smith *v.* Nichols, 21 Wallace, 112, ❁; Burt *et al. v.* Evory, 113 U. S., 349; 50 O. G., 1294, ❁).

Williams *v.* Goodyear, U. S. C. C. Ct., *Shipman, J.*, 2 Feb., 1892, 49 F. R., 245; 58 O. G., 1257.

Note. — In the above case comparison with pre-existing devices reduced the invention to the single point of useful novelty of making the water-tight or "bellows" flaps *integral* with the vamp and quarter, in lieu of the separately formed and attached gores or gussets previously employed.

29″. "That Impalpable Something."

To say that the act of invention is the production of something new and useful does not solve the difficulty of giving an accurate definition, since the question of what is new, as distinguished from that which is a colorable variation of what is old, is usually the very question at issue. To say that it involves "an operation of the intellect," that it is "a production of intuition," or of "something akin to genius," as distinguished from the exercise of mere mechanical skill, draws one somewhat nearer to an appreciation of the true distinction, but it does not adequately express the idea. The truth is, the word cannot be defined in such a manner as to afford any substantial aid in determining whether a particular device involves an exercise of the inventive faculty or not. In a given case we may be able to say that there is present invention of a very high order; in another we can see that there is lacking *that impalpable something* which distinguishes invention from mere mechanical skill. Courts adopting fixed principles as a guide have, by a process of exclusion, determined that certain variations in old devices do, and that others do not, involve invention; but whether the variation relied upon in a particular case [belongs to one or the other of these categories] cannot be answered by applying the test of any general definition.

McClain *v.* Ortmayer, U. S. S. C. By *Brown, J.*, 2 Nov., 1891, 35 L. ed., 800, ✽.

LACK OF PATENTABLE INVENTION IS ILLUSTRATED IN THE FOLLOWING CASES.

30. Abortive Experiments.

A conception of the mind is not an invention until represented in some physical form: unsuccessful experi-

ments or projects abandoned by the inventor are equally destitute of that character.

Clark Thread Co. *v.* Willimantic Linen Co. *et al.*, U. S. S. C. By *Bradley, J.*, 25 May, 1891, 56 O. G., 395, ✿.

Of like purport, see (15) *supra.*

31. It is not enough that an applicant, ranging through the field of experiment, unconsciously stumbles upon that which is nearly related and very similar to the device in controversy. The conception must not be of the result to be obtained, but the *means* (which is the patentable thing) to produce that result.

Voelker *v.* Gray *v.* Edison *v.* Bell, *Butterworth, Com.*, 3 Mar., 1885, 30 O. G., 1092.

32. Use of expedients known to the art is not invention.

The result attained, being but a display of the expected skill of the calling, and involving only the exercise of the ordinary faculties of reasoning upon the materials, supplied by a special knowledge and the facility of manipulation which results from its habitual and intelligent practice, is in no sense the creative work of that inventive faculty which it is the purpose of the Constitution and the patent laws to encourage and reward.

Hollister *v.* Benedict M'f'g Co., U. S. S. C. By *Matthews, J.*, 5 Jan., 1885, 113 U. S., 59, ✿.

33. Mechanical Faculty. — Inventive Faculty.

It is not sufficient that an applicant shall have made a new and useful article or machine, he must have made an *invention* or *discovery*. It is well known that the mechanics, artisans, and laborers of the world are continually making an infinite number of new and useful contrivances, changes, and modifications in the affairs

of life, and yet they do not dream of protecting them, for the reason that they are not the result of the exercise of the inventive faculty, but simply of the mechanical faculty.

Dovin, x. p., *Hall, Com.*, 15 Oct., 1888, C. D. 166.

34. The statute does not say that any person who has made any new and useful machine, etc., will be entitled to a patent, but that any person who has *invented* a new art, machine, etc., is so entitled; the courts have uniformly held that the thing said to be new and useful must be the result of *invention*. A new change or modification; or a new shop device, which any intelligent artisan or mechanic would suggest or make upon knowing the necessity or requirement, is not an invention within the meaning of the patent law.

Gibford, x. p., *Hall, Com.*, 3 Dec., 1888, C. D., 168.

35. Mere mechanical operations, like the looping and drawing of threads to form stitches in sewing, either by machinery or by hand, do not amount to arts or processes, in a legal sense, and such operations, apart from the means of performing them, do not appear to be within the reach of protection by the patent laws. Hence, where a person has invented a machine for sewing together the soles and uppers of boots and shoes by a stitch without any welt, the stitch and the manner of forming it producing a well-known seam in a well-known manner, in a different place, heretofore inaccessible by any means that had been discovered, and the inventor had taken out separate patents for the machine, the process and the product: *Held*, that the entire invention lay in the machine, and that the patents for the process and product were invalid for lack of invention.

MacKay *v.* Jackman, *Wheeler, J.*, 15 Ap., 1882, 22 O. G., 85.

See also Forncrook *v.* Root, 27 O. G., 774; Morris *v.* McMillan, 29 O. G., 951, ✽.

36. One person receiving from another a full and accurate description of a new and useful improvement cannot appropriate it to himself, and a patent obtained by him therefor will be void.

Atlantic Works *v.* Brady, U. S. S. C. By *Bradley, J.*, 5 Mar., 1882, 23 O. G., 1330,❁.

37. A difference of construction, perfectly obvious to any competent mechanic, does not constitute a patentable invention.

National Wire Mattress Co. *v.* N. Y. Braided Wire Mattress Co., *Butler, J.*, 19 May, 1884, 28 O. G , 96.

38. When the claim was for a blank from which an old article had been made, and the only improvement suggested was a more convenient form of handling and packing for transportation, the purchaser to form the article from the blank in the old way: *Held*, that this could not be regarded as an improvement in an art or manufacture such as contemplated in the statute.

Forncrook *v.* Root, *Matthews, J.*, Nov., 1884, 29 O. G., 774.

39. The only field of invention left for the patent to cover was the application of the old and familiar arrangement of shafts, cog-wheels, and auxiliary engine to a capstan instead of to a windlass. It is plain that no such ingenuity as merited the issue of a patent was required for this improvement, but only the ordinary judgment and skill of a trained mechanic: *Held*, that the patent was void.

Morris *v.* McMillan, U. S. S. C. By *Woods, J.*, 17 Nov., 1884, 29 O. G., 951, ❁.

40. Merely putting rollers under an article to make it movable when without the rollers it would not be movable, does not involve patentable invention.

Hendy *v.* Golden State Works, U. S. S. C. By *Blatchford, J.*, 14 May, 1888, 43 O. G., 1117,❁.

41. The state of the art showing that dies could be used to compress and finish articles of vulcanizable gum and to compress plastic material surrounding a metal core or skeleton, in making articles of harness-trimmings, it required no exercise of invention to use dies to compress and finish similar articles in which vulcanizable gum was used to envelop a metal core.

Rubber & Celluloid Co. *v.* India Rubber Co., *Wallace, J.*, 23 May, 1888, 44 O. G., 343.

42. Two 17-year patents were granted as follows:

Patent No. 336,242: An improvement in the art of decorating surfaces to be ornamented, which consists in applying thereto, by pins or screws passing through holes in the tile, ornamented tiles of appropriate patterns and glazed to their bases; substantially as, etc.

No. 336,243: An improvement in the art of decorating metallic or other surfaces, a medallion-tile formed with a rabbet on its edge and glazed into the rabbet, in combination with a perforated plate suited to the contour of the projecting medallion and with suitable backing to the tile attached to said perforated plate; substantially as, etc.

Held, both patents may describe tiles which present a very pleasing and artistic appearance to the eye; but it does not follow from this that it required, in the sense of the patent-law, the exercise of the inventive faculty to produce them. The patents are manifestly void for want of invention.

Lowe *v.* Barstow Stove Co. and Low *v.* Magic Furnace Co., *Colt, J.*, 18 Dec., 1888, 48 O. G., 262.

43. Claim to means for lubricating pulleys within the tunnel of a cable-railway, lacks invention and is not patentable in view of the well-known use of tubes to carry oil to inaccessible journals.

Nat. Cable Ry. Co. *v.* Mt. Adams Ry. Co., *Jackson, J.*, 24 May, 1889, 48 O. G., 1400.

44. The elements of the alleged combination being old in themselves, and their operation as associated being only that of their well-known separate operation in older machines, there is no patentable combination, although there may be some convenience in bringing these parts together and making a more compact machine. Such a change is merely mechanical and *does not rise into the realm of invention.*

Ide *v.* Ball Engine Co., *Blodgett, J.*, 22 July, 1889, 49 O. G., 283.

45. Where it appeared that a turnover seam was an old and well-known substitute for the ordinary seam in making garments, and that such seam had been used in hat-sweats, as shown in a prior patent, as a substitute for the ordinary seam and for the purpose of protecting the hat from perspiration: *Held*, not to be invention to unite, in a hat-sweat, the tacking-slip to the leather band by a turn-over seam, instead of by the ordinary seam in which the stitches perforate the outer face of the band.

Hat-Sweat M'f'g Co. *v.* Davis Sewing Mach. Co., *Wallace, J.*, 12 Oct., 1889, 49 O. G., 1214.

46. Where the employment of a device to effect a certain purpose was such as would naturally suggest itself to any mechanic, and the device was used, in the new relation, to perform an office exactly analogous to that in which it had been frequently formerly employed: *Held*, such employment of said device did not constitute invention.

Day *v.* Fair Haven Ry. Co., U. S. S. C. By *Fuller, Ch. J.*, 11 Nov., 1889, 49 O. G., 1364, ❁.

47. Patents should not be granted for trifling improvements, such as would spontaneously occur to any skilful mechanic.

The design of the patent laws is to reward those who make some substantial discovery or invention which adds to our knowledge and makes a step in advance in the useful arts. It was never their object to grant a monopoly for any trifling device, for every shadow of a shade of an idea, such as would naturally and spontaneously occur to any skilful mechanic or operator in the ordinary progress of manufactures.

Atlantic Works *v.* Brady, U. S. S. C. By *Bradley, J.*, 5 Mar., 1883, 23 O. G., 1330, ✽.

48. Packages of wool, feathers, and plug-tobacco have been put up into small packages made into a larger package, and the whole compressed; in view of which, no invention is displayed in treating hair in the same way.

King *v.* Gallum, U. S. S. C. By *Woods, J.*, 29 Oct., 1883, 25 O. G., 980, ✽.

49. The application of an old process or machine to a similar or analogous subject, with no change in the manner of applying it, and no result substantially distinct in its nature, will not sustain a patent even if the new form of result has not before been contemplated.

Pa. R. R. Co. *v.* Locomotive Safety Truck Co., U. S. S. C. By *Gray, J.*, 3 Mar., 1884, 27 O. G., 207, ✽.

50. Use of Matters of common Knowledge not Invention.

The court will take judicial notice of matters of common knowledge, such as a strap used by the driver at the front of an omnibus to open and close the rear door, devices for opening or closing valves at a distance in

steam and hydraulic apparatus, and devices used at railway switches for opening and closing the rails.

Although the patentee may be entitled to the merit of being the first to conceive of the convenience and utility of the mechanism in question for accomplishing a certain purpose, his right to a patent must rest upon the novelty of the means he has contrived to carry his idea into practical operation.

To do that which any competent mechanic familiar with devices well known in the art could have done readily and successfully upon the mere suggestion of the purpose which it was desirable to effect, does not constitute invention.

Aaron *v.* Manhattan Ry. Co., U. S. S. C. By *Blatchford, J.*, 11 Nov., 1889, 49 O. G., 1365, ❁.

51. Mere changes of material accompanied by the expected skill of the mechanic is not a patentable invention.

Where the only change involved is a change of material [substitution of cotton for jute as a material to be employed in the manufacture of bagging], accompanied by the expected skill of the calling in effecting the substitution and making it efficient, and notwithstanding that the result was reached only after careful experiment, and proved a commercial success, such result is not patentable.

Odesheimer, x. p., *Mitchell, Com.*, 27 Nov., 1889, 49 O. G., 1693.

52. It does not constitute invention to stir by a well-known and simple mechanical device [revolving blades driven by a power-shaft] a liquid which had before been stirred by hand.

Marchand *v.* Emken, U. S. S. C. By *Blatchford, J.*, 25 Nov, 1889, 49 O. G., 1841, ❁.

53. Mere utility and novelty in the common meaning of those terms not sufficient. ***There must be invention or discovery.***

This court has repeatedly held that, under the Constitution and the Acts of Congress, a person, to be entitled to a patent, must have invented or discovered some new and useful art, machine, manufacture, or composition of matter, or some new and useful improvement thereof, and that it is not enough that a thing shall be new in the sense that, in the shape or form in which it is produced, it shall not have been before known and that it shall be useful, but that the thing produced must amount to an invention or discovery. The cases on this subject are collected in Thompson *v.* Boisselier (114 U. S., 1, 11, 12, ✻). To them may be added Stephenson *v.* Brooklyn R. R. Co. (114 U. S., 149, ✻); Yale Lock Co. *v.* Greenleaf (117 U. S. 544, ✻); Gardner *v.* Herz (118 U. S., 180, ✻); Pomace Holder Co. *v.* Ferguson (119 U. S., 335, ✻); Hendy *v.* Miner's Iron Works (127 U. S., 370, ✻); Holland *v.* Shipley (127 U. S., 396, ✻); Patterson Plow Co. *v.* Kingman (129 U. S., 294, ✻); Brown *v.* Dist. of Columbia (130 U. S., 87, ✻); Day *v.* Fairhaven Ry. Co. (132 U. S., 98, ✻); Watson *v.* Cin'ti Ry. Co. (132 U. S., 161, ✻); Marchand *v.* Emken (132 U. S., 195, ✻); Royer *v.* Roth (132 U. S., 201, ✻).

The decree of the Circuit Court is reversed, and the case is remanded to that court with a direction to dismiss the bill with costs.

Hill *et al. v.* Wooster, U. S. S. C. By *Blatchford, J.*, 13 Jan., 1890, 50 O. G., 560, ✻.

Of like purport, see Hollister *v.* M'f'g Co., 113 U. S., 59, ✻.

54. A mere carrying forward or more extended application of an original idea — a mere improvement in degree — is not invention.

Where certain parts of a water-tight shoe were old, a simple change in the form and arrangement of such

parts, subserving the same purpose as like parts of shoes constructed under earlier patents, and without causing any new function to be performed, does not constitute invention.

Burt *et al v.* Evory, U. S. S. C. By *Lamar, J.*, 3 Feb., 1890, 50 O. G., 1294, ✿.

55. The application of an old process or machine to a similar or analogous subject, with no change in the manner of applying it and no result substantially distinct in its nature, will not sustain a patent, even though the new result had not before been contemplated.

Howe Machine Co. *v.* National Needle Co., U. S. S. C. By *Fuller, Ch. J.*, 24 Mar., 1890, 51 O. G., 475, ✿. Also see St. Germain *v.* Brunswick, U. S. S. C. By *Fuller, Ch. J.*, 28 Ap., 1890, 51 O. G., 1129, ✿.

56. The patentee having [in the manufacture of feather-dusters] merely applied the old process of dressing feathers, to feathers other than those to which it was commonly applied, simply accomplished by common reasoning from existing known facts, a result such as any one skilled in the art and desiring a cheap article would be likely to reach, although others had not in fact reached it: *Held*, that this did not amount to invention (Hollister *v.* Benedict M'f'g Co., 113 U. S., 59, ✿).

The American Split Feather Duster Co. *v.* Levy, *Butler, J.*, 13 June, 1890, 52 O. G., 1807.

57. In view of the testimony as to the state of the art: *Held*, that it required no invention to make a single die to cut dough on a flat surface into any particular shape desired, whether the shape of a bretzel or any other shape.

Butler *et al. v.* Steckel *et al.*, U. S. S. C. By *Blatchford, J.*, 3 Nov., 1890, 53 O. G., 1090.

58. To make a suspender-end of flat cord in substantially the same way that suspender-ends of round cord had been made, for the purpose of securing other articles of wearing apparel than trousers, does not involve invention.

Shenfield *v.* Nashawannuck M'f'g Co., U. S. S. C. By *Fuller, Ch. J.*, 23 Nov., 1890, 53 O. G., 1092, ✿.

59. The judgment of the Circuit Court awarding damages reversed and the case remanded for new trial, because said court, on the evidence presented, should have directed a verdict for the defendant on the ground that the patent was void; the patentee having merely used the same device which had before been used by other persons between one side of an interposed barrier and the other, with the same mechanical effect as when used without the barrier, and therefore the case was one merely of double use.

Inasmuch as the mechanical operation and effect of the patented devices were the same whether there was a grating or other barrier or not: *Held*, that there was no patentable combination between said devices and the grating. The case was one of mere aggregation.

County of Fond du Lac *v.* May, U. S. S. C. By *Blatchford, J.*, 15 Dec., 1890, 53 O. G., 1884, ✿.

60. It is a familiar rule that the application of an old process, or machine, or apparatus to a similar or analogous subject, *with no change in the manner of application, and no result substantially distinct in its nature*, will not sustain a patent, although the new form of result may not have before been contemplated.

St. Germain *v.* Brunswick, U. S. S. C. By *Fuller, Ch. J.*, 28 Ap., 1890, 34 L. ed., 122, ✿.

61. Not every new and useful application of an old constructive idea amounts to patentable invention. For

instance; the Supreme Court has held, in one case, that, a diagonal brace being old in structures generally, it was not patentable to use such a brace for holding a track-clearer in place (Day *v.* Fairhaven & W. Ry. Co:, 132 U. S., 98, ✿). The same court has held that, a shifting device being old in mechanism generally, the application of the same to a machine for fulling raw hides constitutes no invention (Royer *v.* Roth, 132 U. S., 201, ✿). It has more than once laid down the principle that it is *not invention "to combine old devices in a new article without producing any new mode of operation"* (Burt *v.* Evory, 133, U. S., 349, ✿).

Vanstone, x. p., *Simonds, Com.*, 30 Oct., 1891, C. D. Ms.

62. A combination is not patentable whose result is the necessary and obvious result having nothing in it of *the unknown or unexpected*, which is generally *the factor that determines for patentability in an otherwise doubtful case.*

Rutherford, x. p., *Simonds, Com.*, 14 Oct., 1891, C. D. Ms.

63. The tying and banding of bales of merchandise being a matter of common knowledge and shown by specific references, the pressing and baling of a well-known vegetable matter unaccompanied by any chemical action, must be considered simply in its mechanical aspect, and, being so considered: *Held*, that there was no substantial difference between using whisps of hay as a binder for pressed manure and using such whisps as binders for the vegetable matter of the application, although, in the latter case, the whisps were more irregularly distributed.

Towers, x. p., *Simonds, Com.*, 10 Oct., 1891, C. D. Ms.

64. The employment of alkalies to check or neutralize acidity, being a common and well-known expedient

in the industrial arts, the addition to a particular liquid of an alkali merely for the purpose of neutralizing its acid constituents is not patentable.

Sommer, x. p., *Simonds, Com.*, 9 Oct., 1891, C. D.Ms.

65. Where applicant had brought together in one structure a number of features which were old when considered singly, and also in sub-combinations, and the specification read like the specification for the erection of a building and was as destitute of any suggestion of novelty outrunning mere mechanical skill, — patentability denied.

Hamilton, x. p., *Simonds, Com.*, 4 Nov., 1891, C. D. Ms.

66. An improvement which, although new and useful, and a refinement upon the previous forms, is simply an extension of the old idea, is not patentable.

Edison, x. p., *Simonds, Com.*, 5 Dec., 1891, C. D. Ms.

67. Mere changes, such as modifications of the form of the raker's seat to enable him to face the falling grain, pertain to the simple, well known, and common property of the art.

A construction whereby a seat may be moved on a fixed centre, freely or rigidly, so that its front may be presented at any angle most convenient to the worker, is no more patentable than revolving the seat-board of a piano-stool or changing the position of a common chair on the floor of a parlor.

Decree entered dismissing the bill, — with costs.

Kirby *v.* Beardsley, *Shipman, J.*, Sep., 1867, 3 Fish., 265.

68. It being old to bind the cut edges of cloth, either for ornament or to prevent ravelling, and also to make dress shirts by securing a linen bosom to the body of the shirt by a row of stitches passing through the edge

of the bosom: *Held*, that attaching the bosom to the shirt by a separate line of stitches through the binding involves nothing which, under a most liberal construction, could be held to be an exercise of the inventive faculty. In view of the simplicity of this device, we find it impossible to escape the conviction that plaintiffs are laboring under a strong bias of self-interest in asserting that this improvement was "the result of careful and prolonged study and experiment." We think this case must be added to the already long list of those reported in the decisions of this court wherein the patentee has sought to obtain the monopoly of a large manufacture by a trifling deviation from ordinary and accepted methods.

Cluet *et al. v.* Chaflin *et al.*, U. S. S. C. By *Brown, J.*, 11 May, 1891, 55 O. G., 999, ✿.

69. There is not, in the matter described and exhibited in either the specification or claims, any invention within the meaning of that word as developed in recent decisions of this court (Hollister *v.* Benedict M'f'g Co., 113 U. S., 59, ✿; Thompson *v.* Boisselier, 114 U. S., 11, ✿; Howe Mach. Co. *v.* Nat. Needle Co., 134 U. S., 388, ✿; McClain *v.* Ortmayer, 141 U. S., ✿ 57 O. G. 1129, ✿); and, for that reason, the patent, alike in its original form and as it now appears in the re-issue, must be pronounced void. . . . By either of the processes described the tension was placed largely upon the strip of cloth instead of solely upon the thread. But this was no new idea, it is as old as pantaloons themselves. It has been illustrated in the experience of every boy, for, in his sports, he not infrequently tears his pantaloons, and his good mother, not content with sewing the torn ends together, and thus holding them by the direct strength of the thread, was wont to place underneath a piece of cloth, and fasten it to the main body of the

garment for some distance on either side of the tear. . . Surely, when this idea is so well known and has been so practically illustrated for generations, it cannot be that there was any exercise of the skill of the inventor in applying the same process to any part of the pantaloons. Action of the court below, dismissing the bill, was affirmed.

Pat. Clothing Co. *v.* Glover *et al.*, U. S. S. C. By *Brewer, J.*, 16 Nov., 1891, 57 O. G., 1281,✿.

70. The application of an old process or machine to a new but analogous purpose does not involve invention, even if the new result had not before been contemplated. Where a patent sued upon describes a method which differs only in degree, and not in kind, from a previously employed method, and where the utmost that can be said of the patented process is that it produces a somewhat more perfect article: *Held*, that the patented method involves no novelty within the meaning of the patent law.

Ansonia Brass & Copper Co. *v.* Elec. Supply Co., U. S. S. C. By *Brown, J.*, 14 Mar., 1892, 58 O. G., 1692,✿.

71. Where it appeared that all that applicant professed to do was to take an old and well-known bolt and nut, and screw them together in the ordinary way, and then take an old and well-known chisel and make an incision in the bolt lengthwise and nearest the upper surface of the nut, in order to prevent rotation: *Held*, that applicant had displayed only the expected skill of the calling, and accomplished what a skilful mechanic would do whenever required.

Shields, x. p., *Mitchell, Com.*, 5 Jan., 1891, 54 O. G., 587.

72. Mere application to a new use, but without a new organization or adaptation of parts, does not constitute patentable invention.

Decision of Primary Examiner and of Examiners-in-Chief affirmed that there is nothing of patentable invention in using a time-fuse in connection with a flash-light, the same having been used in connection with time-signals as well as in exploding expedients generally where it was an object to gain time. Neither is there anything patentable in putting up a specified charge of an explosive in a case or cartridge, nor in aggregating both features in a single vendible commodity, although it may possess commercial advantages.

White, x. p., *Mitchell, Com.*, 12 Sep., 1890, 54 O. G., 387.

73. The patent — covering an improvement in mere workmanship or finish over a device which had been in public and business use for more than two years prior to the filing of the application — was pronounced invalid.

International Tooth Crown Co. *v.* Gaylord *et al.*, U. S. S. C. By *Brown, J.*, 27 Ap., 1891, 55 O. G., 864, ✿.

74. A mere carrying forward of the original conception of an earlier patent, — a new and more extended application of it, — involving only change of form, proportions, or degree, — the substitution of equivalents doing the same thing as did the original invention by substantially the same means, although with better effects, — is not such an invention as will sustain a patent. It is the invention of what is new, and not the arrival at comparative superiority or greater excellence in that which is already known, which the law

protects by letters-patent. Decree of Circuit Court dismissing bill affirmed.

Smith *v.* Nichols, U. S. S. C. By *Swayne, J.*, Oct. term, 1874, 21 Wallacc, 112, ❁.

See INVENTIVE ACTS; NOVELTY; PATENTABILITY; PUBLIC ADOPTION; REDUCTION TO PRACTICE; UTILITY.

INVENTIVE ACTS.

1. The true date of the invention is at the point where the work of the inventor ceases and the work of the mechanic begins. Before that time applicant was inventing but had not yet *invented.*

Camcron *et al. v.* Brick, *Leggett, Com.*, 1871, C. D., 89.

2. Rule 110 requires, among other things, that the dates of the *inventive acts* which relate to the subject-matter of the invention set forth in the declaration of interference, shall be given by each party thereto.

Haug *v.* Dubois, *Frothingham, Act. Com.*, 15 June, 1891, C. D. Ms.

3. The "inventive acts," of which each party to an interference is required to furnish a sworn statement, are —

(1) The date of original conception of the invention set forth in the declaration of interference.

(2) The date upon which a drawing [if any] of the invention was made.

(3) The date upon which a model [if any] of the invention was made.

(4) The date upon which the invention was first disclosed to others.

(5) The date [if any] of reduction to practice of the invention.

(6) The extent of use [if any] of the invention.

If a drawing or model has not been made or if the invention has not been disclosed to others prior to applicant's application, or has not been reduced to actual practice, the fact or facts must be stated.

P. O. R., 110.

See (1) DILIGENCE, AND (9) REDUCTION TO PRACTICE.

JOINDER OF INVENTIONS.

1. Office-classification, — State of the Art.

The creator of an art — as, for example, the inventor of the first watch — would be entitled to a patent including, in as many claims, the several distinctive elements of its mechanism; but when, in the progress of the art, the efforts of inventors have been directed to the separate parts of the watch and, at their requests, patents have been issued upon such separate parts, a corresponding classification of subjects necessarily arises in the Office, and must be observed in considering any subsequent application relating to the general class.

Combs, x. p., *Duncan, Act. Com.*, 2 Aug., 1871, C. D., 219.

2. Under an Original Application. — Under a reissue.

Because an apparatus patent cannot be reissued to cover a process, or *vice versa*, it does not follow that an original patent cannot be granted to cover both apparatus and process. A reissue patent is limited to the precise invention covered or intended to be covered by the original patent, but an original application may cover different inventions provided they are connected in design and operation; and the Supreme Court has been very careful to exclude a contrary inference (Heald *v.* Rice, U. S. S. C. By *Matthews, J.*, 6 Mar., 1882, 21 O. G., 1443, ❁).

Harrison, x. p., *Mitchell, Com.*, 15 Feb., 1890, C. D. Ms.

Of like purport, see Myers, x. p., (21) AMENDMENT; Noyes x. p., (9) SPECIFICATION.

3. Joinder of separately classified Devices.

Where a lamp, specially designed for photographers, had, attached to it, an apparatus for feeding a magnesium spray to the flame for the purpose of sudden and intense illumination: *Held*, that said feeding device constituted with such camera a *unitary invention*, and that, therefore, all the parts could be included in a single application.

Jljinsky, x. p., *Fisher, Act. Com.*, 24 Aug., 1889, 48 O. G., 1399.

4. Improper Joinder.

Telescopes having obtained a distinct status in the arts and manufactures: *Held*, that improvements in the special construction of telescopes adapted to their use generally, should not be joined with claims for a detachably connected sight for ordnance of which a telescope is an element.

Jljinsky, x. p., *Mitchell, Com.*, 23 Dec., 1889, C. D. Ms.

5. Capacity for Joint Use.

That two or more inventions capable of joint use, although not always used conjointly, may be joined in the same patent, is beyond question (Hoag *v.* Emerson, 5 Howard, 437, ✿). It does not, however, follow, in all cases, that the Patent Office must or will permit such inventions to be joined. Such permission will, however, ordinarily be given if no wider range of search is required for all than for one.

Fefel, x. p., *Simonds, Com.*, 9 Oct., 1891, 571 O. G., 409.

See, however: Herr, x. p., 41 O. G., 463; Carter, x. p., 46 O. G., 1392; McMahan, x. p., 48 O. G., 255; Norwood, x. p., 50 O. G., 1129; Hyde, x. p., 50 O. G., 1293, DIVISION; Jljinsky, x. p., (4), *supra*, and Patent Office Rule 41.

6. Although several distinct inventions which are dependent upon each other and mutually contribute to produce a single result may be claimed in one application, yet independent inventions (even when associated in the same structure) cannot be joined in one application, especially when the Office classification is such as to require their examination in different divisions.

Steinhilber, x. p., *Simonds, Com.*, 17 Dec., 1891, 57 O. G., 1720.

For various conditions precedent to joinder of two or more distinct inventions in a single patent, see cases cited in (5) *supra*, and cases (7) *et seq.*, *infra*.

7. Generic and Specific Inventions.

Several specific devices embodying the same general features of construction may be retained in a single application, provided a generic claim is made which will cover each and which is patentable.

Howland, x. p., *Doolittle, Act. Com.*, 3 Nov., 1887, 12 O. G., 889.

8. Where a generic claim of such scope and character as to indicate *the same basis of invention* for each device cannot be maintained there is such diversity as to require a division of the application.

Ib.

9. Although they may all be retained [in the description], applicant is not at liberty to make [in one and the same patent] specific claim to more than one of the devices.

Ib.

Of like purport, see Eagle, x. p., (5) THE APPLICATION.

10. A generic claim may be joined in an application with a specific claim for one of the constructions covered by the generic claim.

Heaton, x. p., *Paine, Com.*, 7 Ap., 1879, 15 O. G., 1054.

11. An applicant may *elect the specific claim* to be joined with the generic claim in one application. When the applicant, in his specification, describes one construction as the substance of his invention, and only refers to the other as a modification, he thereby elects to take the first, and cannot, in the same application, claim the modified form.

Ib.

12. Where an applicant makes oath that he is the inventor of the thing described and claimed, but his claims are *all generic* and applicable equally to both the forms shown, his oath, while it shows that he invented the genus, does not show that he invented the species referred to as a modification of the invention, and, *under that oath*, he cannot by amendment claim such modification.

Ib.

13. Besides the generic claim for the general construction the application should contain a specific claim for the preferred form.

An applicant can show and describe as many different forms of his invention as can be covered by a generic claim, and may also claim, specifically, the preferred form of his invention; but more than this [in one and the same patent] he is not entitled to do. If applicant can comprehend, in some form of expression, the patentable novelty which is common to all the forms shown and described, he is entitled to employ that expression to cover the generic invention (Eagle, x. p., 1870, C. D., 137; Howland, x. p., 1877, C. D., 120; Heaton, x. p., 1879, C. D., 95).

Cook, x. p., *Mitchell, Com.*, 12 Ap., 1890, 51 O. G., 1620.

14. Equivalents.

An inventor is always entitled to equivalents, that is to say, to devices which operate in substantially the same way to accomplish substantially the same result. He cannot in one and the same patent control diverse forms beyond what the law of equivalents gives him.

Ib.

15. When necessary for protection of a given invention, the Office classification must give way.

Where one particular element of a machine is dependent upon its co-operation with the other elements thereof to produce a certain result, it may, under Rule 41, be claimed under the same application with them *without regard to the Office Classification.*

Coe, x. p., *Fisher, Act. Com.*, 27 May, 1889, 48 O. G., 1119.

JOINDER OF MACHINE AND PRODUCT.

Permissible only where Machine is essential for that Product and can produce no other Product.

If the machine and the manufacture are so related that the former cannot operate without producing the latter, and the latter can only be produced by the former, both may be included [and each distinctly claimed] in a single patent. This is an exception to the general rule which forbids joinder of the machine and its product in one and the same application.

Winterlich, x. p., *Paine, Com.*, 1871, C. D., 171.

Of same tenor, see Morningstar, x. p., *Mitchell, Com.*, 14 Dec., 1889.

JOINDER OF PROCESS AND APPARATUS.

1. Of several possible Apparatus only one claimable in same Patent with the Process.

But one substantive apparatus for carrying out the process can be claimed in the same application with the process claims.

Bayne, x. p., *Mitchell, Com.*, 21 Feb., 1890, C. D. Ms.

2. Although the present practice permits the joinder, in proper cases, of apparatus and process, it places limitations upon amendments to applications for inventions in one class which seek to incorporate inventions of the other.

Carpenter, x. p., *Mitchell, Com.*, 13 June, 1891, C. D. Ms.

3. An application confined to the apparatus cannot be withdrawn from issue for the purpose of inserting a claim to the process, although the process claim might have been included in the original application.

Adams, x. p., *Frothingham, Act. Com.*, 29 June, 1891, C. D. Ms.

JOINDER OF PROCESS AND PRODUCT.

There are, perhaps, only two cases where claims to a process and a product of that process can properly be included in one patent; those cases are: (i) when the product is entirely new, and hence the process also; (ii) when the exercise of the process would produce no other product, and when the product could be produced by no other process.

Blythe, x. p., *Butterworth, Com.*, 28 July, 1884, 30 O. G., 1321.

See also Tainter, x. p., 47 O. G., 137.

See CLASSIFICATION; DIVISION; PROCESS.

JOINT INVENTION.

A mere suggestion, not acted upon by the person making it, but carried out and perfected by another, will not entitle the former to be considered a joint inventor; nor is it necessary that exactly the same idea should have occurred to two persons at the same time, and that they should work out together the embodiment of this idea in a perfected machine, to constitute them joint inventors. If an idea is suggested to one, and he even goes so far as to construct a machine embodying the idea, but it is not a completed and working machine, and another person takes hold of it, and by their joint labors — one suggesting one thing and the other another — a perfect machine is made, a joint patent may properly issue to them. If, on the other hand, one person invents a distinct part of a machine, and another person invents another distinct and independent part of the same machine, then each should obtain a patent for his own invention.

Warden *v.* Fisher, *Br wn, J.*, 21 O. G., 1957.

See also Arnold *v.* Bishop, *Cranch, Ch. J.*, Sup. C. Dist. of Col., 1841.

JOINT OWNERS.

The right of joint owners of a patent to operate separately has been variously interpreted by rulings of different authorities, which (in default of adjudication by the Supreme Court) are here given. Decisions favoring liberty of independent action appear to preponderate.

1. Joint owners of a patent may operate independently.

A part owner of a patent may, in the absence of any contract, assign his interest in it, or any fractional part thereof; or he may, either alone or in company with

others, purchase or make as many machines as he pleases, and may sell them to others with the right to use or sell them; but he has no power to control the action of nor to exercise any supervision over a co-proprietor, nor to compel a contribution of profits or losses, nor to enforce a partition of the right; nor is either party under any obligation to make the property profitable. Such parties must be regarded as having interests which are distinct and separate in their nature, though derived from the same instrument; and having the same interests, with the right to use them separately, they cannot, by any legal use of them, incur any obligation to each other.

Vose *v.* Singer, Supreme Court of Massachusetts, 1864, *Chapman, J.*, Allen's Mass. Rep., 225.

2. If one joint owner of a patent appropriates any portion of the exclusive right or common property to his separate use or benefit, by either the use or the sale of a patented machine, he does what is in principle the same as the conversion of the joint property by a tenant in common, which authorizes his co-tenant to maintain trover.

Persons interested in a patent are simply joint owners, or tenants in common, of the rights and property secured by the patent; and their rights, powers, and duties, as respects each other, are substantially those of the joint owners of a chattel.

One joint owner can legally grant, assign, license, or sell only in respect to his own share or right. He cannot sell and give a good title to his co-owner's right, for the same reason that one joint owner of a chattel cannot transfer the share of his co-proprietor.

Pitts *v.* Hall, *Nelson & Conclin, JJ.*, Oct., 1854, 3 Blatch., 201.

3. Owners of a patent are tenants in common, and each, as an incident of his ownership, has the right to use the patent or to manufacture under it. But neither can be compelled by his co-owner to join in such use or work, or be liable for the losses which may occur, or to account for the profits which may arise from such use.

DeWitt *v.* Elmira Nobles M'f'g Co., 12 N. Y. Supr., 201.

4. Where there are several patentees, they are tenants in common. One of them has no superiority of right over another. One of them can manufacture and use the article patented without the consent of the others.

Dunham *v.* Ind. & St. Louis R. R., U. S. C. C., N. D. Ill., *Drummond, J.*, June, 1876, 7 Biss., 223; 2 Bann. & Ard., 327.

5. Joint owners of a patent-right are not co-partners, and, in the absence of any express contract, each is at liberty to use his moiety as he may think fit without liability to an accounting to the other for profits or losses.

Vose *v.* Singer, *Chapman, J.*, 4 Allen (Mass.), 226; DeWitt *v.* Elmira Nobles M'f'g Co., 12 N. Y. Supr., 301.

6. One of two joint owners can legally grant, assign, license, or sell his own share or right in the patent.

May *v.* Chaffee, 5 Fish. 160; 2 Dillon, 385.

7. Where a party owning less than the whole right makes a grant or license, he shall be answerable to the others, rather than that the other patentees shall look to the grantee or licensee.

Dunham *v.* Ind. & St. Louis R. R., 7 Biss. 223; 2 Bann. & Ard., 327.

JURISDICTION.

1. The official decisions and directions of the Commissioner and Acting Commissioner are binding upon all in the Patent Office until reversed by the Secretary of the Interior; but when a rule of the Patent Office (although promulgated by the Commissioner of Patents and approved by the Secretary of the Interior) is found to be in conflict with a decision of a United States court, the office practice must conform to such decision.

Clymer *v.* Riley, *Leggett, Com.*, 17 July, 1874, 6 O. G., 505. See also Becker *v.* Throop, *Thacher, Com.*, 8 O. G., 1.

2. Judicial decisions of the Commissioner of Patents are not appealable to the Secretary of the Interior.

Workman *v.* McNaught, *Paine, Com.*, 25 Ap., 1879, 16 O. G., 216.

3. It appearing that what was intended to be a complete system of remedies by appeal from the decisions of the Commissioner has been provided by the same statute which provides for the directory power of the Secretary: *Held*, that, in the absence of any express provision for appeal to the Secretary, an inferential right of appeal is excluded.

Applying the above rule of construction to the commissioner's decisions in cases of interference: *Held*, that they are not subject to the directory power of the Secretary either by contemporaneous dictation or by appeal and reversal, described as direction.

U. S., *ex rel.* R. Hoe & Co. and George C. Gill *v.* Benjamin Butterworth, Commissioner of Patents, Supr. Ct., Dist. Col. By *James, J.*, Mar., 1884, 27 O. G., 519.

4. The provision of the statute, giving the Secretary the power of directing, is general, and the provisions

relating to the duties and powers of the Commissioner are specific. It is the latter which must control. When the sections of the statutes are considered together, it must be held that the Commissioner must perform his duties under the direction of the Secretary, except when he is already directed by the superior directory power of the Legislature.

Upon the above consideration it is furthermore held that the appellate proceedings and reversal by the Secretary in the case at hand were unauthorized, and therefore a nullity; and that consequently the Commissioner of Patents, having finally adjudicated that the relators are entitled to a patent, improperly refuses to issue the same, and ordered that the writ of peremptory mandamus shall issue.

The duties of the Commissioner of Patents are in part administrative and in part of a judicial nature. In his judicial capacity he acts as the direct representative and expounder of the law subject to no appeal except to the tribunals expressly designated by the statute.

Daniels *v.* Morgan, *Mitchell, Com.*, 1 May, 1889, 47 O. G., 811.

5. While the Secretary of the Interior has a supervising jurisdiction over the Patent Office to the extent of prescribing proper rules for the business of that Office, and to the extent of enforcing a due observance of such rules, yet, over the acts of the head of that Office involving the exercise of *judicial* functions conferred upon him by law, the Secretary has no jurisdiction.

Petithomme *v.* Bedbury, *Chandler, Act. Sec. Int.*, 25 June, 1890, 52 O. G., 805.

6. A peddler is not exempt from municipal license fees by reason of the articles vended being patented ones.

A state may require the taking out of a license for the sale of a manufactured article, and the fact that the

article is produced under a patent will not defeat this power; but a state (or other municipal body) may not discriminate against a non-resident manufacturer as such.

Webber *v.* The State of Virginia, U. S. S. C. By *Field, J.*, 2 May, 1881, 20 O. G., 369, ✽.

7. A city ordinance prescribed a tax upon peddlers, etc. The defendant was convicted of selling from door to door without a license, a patented article: *Held*, that the patent did not prohibit the municipality from imposing such a tax.

People *v.* Russell, Supreme Ct., Mich., *Cooley, Ch. J.*, 3 Jan., 1883, 25 O. G., 504.

8. State laws which impose disabilities on sale or other disposal of patents are void.

The Act of February 18, 1873, entitled "An Act to Regulate the Sale of Patent Rights in the State of Nebraska and prevent Frauds Connected therewith" (and which sought to impose special disabilities on the sale of patent rights) is in conflict with the Constitution and laws of the United States and void.

Wilch *v.* Phelps, Supreme Ct., Nebraska, *Lake, Ch. J.*, 23 Mar., 1883, 25 O. G., 981.

9. Secretary of the Interior.

A decision of the Commissioner of Patents denying an interfering party's motion to amend his preliminary statement, is a judicial rather than a ministerial act, and, consequently, one over which the Secretary of the Interior has no appellate jurisdiction (citing Petithomme *v.* Bedbury, 52 O. G., 605).

Noakes, x. p., *Noble, Sec.*, 15 July, 1892, 60 O. G., 575.

10. When the sections of the statute are construed together, it is held that when there are two interfering patents, the Circuit Court of the district whereof the defendant is an inhabitant or where he may be found is the court having cognizance, and where an original application for a patent has been refused and a remedy is sought in equity, and the process is to be served on the Commissioner of Patents, then the Supreme Court of the District of Columbia is the tribunal to entertain the suit.

Prentiss *v.* Ellsworth, the late Commissioner of Patents, *Randall, J.*, 11 Ap., 1846, 27 O. G., 623.

11. An objection to the jurisdiction of the Circuit Court in Pennsylvania is that it has no mode of enforcing obedience to its decree, since the Circuit Courts outside of the District of Columbia have no authority to issue a writ of mandamus to an officer of the United States in that district commanding him to do a ministerial act.

Ib.

12. The Federal Courts have exclusive jurisdiction in all causes arising under the Patent and Copyright Laws without reference to the amount involved.

Miller *v.* Carpenter, *Jackson, J.*, 7 May, 1888, 43 O. G., 1118.

See, also, St. Paul Plow Wks. *v.* Starling, U. S. S. C. By *Gray, J.*, 14 May, 1888, 43 O. G., 1350, ✱.

Also see ORIGINATION OF CIRCUIT COURTS OF APPEALS.

13. Courts outside of the District of Columbia have no mandatory jurisdiction over the Commissioner of Patents.

On appeal of the Commissioner of Patents, from a decision of U. S. Circuit Court for District of Vermont,

made under Sec. 4915, R. S., adjudging Samuel Hill and Benjamin B. Prentice entitled to a patent for their improvement in milk-coolers, and directing the said Commissioner to issue the same: *Held*, that by Sec. 739, R. S., as well as by Act March 3, 1875, Chapter 137, Sec. 1, it is provided that, "no civil suit shall be brought before any Circuit or District Court of the United States against an inhabitant of the United States, by any original process, in any other district than that of which he is an inhabitant, or in which he may be found at the time of serving the writ." We entertain no doubt that this statute applies to suits brought under Sec. 4915. The official residence of the Commissioner of Patents being in the Patent Office in the District of Columbia, and the subpœna having been served on him there, and he having refused to appear in the case, we are of the opinion that the court was without jurisdiction, and had no authority to enter the decree which has been appealed from, and the decree is accordingly reversed and the bill dismissed, without prejudice, for want of jurisdiction.

Butterworth, Commissioner of Patents *v.* Hill, U. S. S. C. By *Waite, Ch. J.*, 30 Mar., 1885, 31 O. G., 1043, ✽. See, also, U. S., *ex rel.* R. Hoe & Co. *et al.*, 27 O. G., 519 and 623; Butterworth, Commissioner of Patents (Hoe *et al.*) *v.* U. S., *ex rel.*, U. S. S. C. By *Matthews, J.*, 3 Nov., 1884, 29 O. G., 615, ✽.

Compare, however, Daniels, x. p. (16), *infra*.

14. A court outside the District of Columbia has no such jurisdiction over the Commissioner of Patents (the Commissioner's official residence being in said district) as to make him a party or compel his attendance in a suit outside of said district.

Illingworth *v.* Atha *et al.*, U. S. C. C., N. J., 42 F. R., 141.

15. The rule (144), while limiting the power of the Commissioner to review an action taken by his prede-

cessor in his executive capacity, is not binding upon him in the discharge of his judicial duties.

Daniels *v.* Morgan, *Mitchell, Com.*, 1 May, 1889, 47 O. G., 111.

16. The action taken by Mitchell, Commissioner, in the case of Daniels, x. p. (see DECREE OF COURT) shows that the Commissioner will obey a mandate from a U. S. Circuit Court upon a suit in which he has not been made a party and which calls for merely ministerial action on his part.

Daniels, x. p., 10 Jan., 1891, 54 O. G., 1113.

17. This was a bill to restrain the publication of a libel that injuriously affects complainant's business.

Is the fact that the statement was made with reference to a patented article sufficient to oust the State court of jurisdiction, although both parties are citizens of Missouri? I think not. The right of action does not grow out of the Patent law, but is given by the common law (Benton *v.* Pratt, 2 Wend., 385; White *v.* Merritt, 7 N. Y., 352; Townsh. Sland & Lib., § 206). That the statement made affects the sale of a patented device is purely accidental. In no aspect of the case can the question of infringement be the sole or even the cardinal issue.

Complainants being in the wrong forum, injunction was refused.

Flint *et al. v.* Hutchinson Smoke Burner Co., U. S. C. C., E. D. Mo., *Thayer, J.*, 4 May, 1889, 38 F. R., 546.

18. Slander of Right to make, vend, etc., a certain Device.

Where complainants' bill alleged that they were the owners of a patented device, and that defendants owned a similar patent, and had published and were about

to publish a notice that complainants' device was an infringement of defendants' patent; that such allegation was false and was known by defendants to be false; that said allegation was made maliciously and with intent to injure complainants' business; and complainants prayed for an injunction to restrain such further publication: *Held*, that the question of infringement was not the sole, nor even the principal issue in such a case; and that — as has been several times held — the State courts were not ousted of their ordinary jurisdiction merely because trial of the case may involve the determination of some question under the Patent law; that complainants were in the wrong forum, and that, for that reason, — and without prejudice to the merits of the case, — injunction must be refused.

Ib.

JURY.

1. Questions of Fact.

Whether a patented invention is one of "a primary character" and the patent "a pioneer patent," and whether, on a proper construction of the patent, defendant's machine infringed its claims, are questions for the jury to determine.

Royer *v.* Schultz Belting Co., U. S. S. C. By *Blatchford, J.*, 5 May, 1890, 34 L. ed., 214, ✽.

2. In a suit for infringement of a patent for invention, the question of anticipation is a question of fact, and is exclusively for the jury to determine.

Haines *v.* McLaughlin, U. S. S. C. By *Fuller, Ch. J.*, 19 May, 1890, 34 L. ed., 290, ✽.

LACHES.

An unexplained delay of over seven years in bringing suit for infringement of a patent deprives the complain-

ants of the right to a preliminary injunction and perhaps to an account. Further infringements will, however, be prevented by an injunction, notwithstanding previous laches.

Price *et al. v.* Joliet Steel Co., *Gresham, J.*, May, 1891, 56 O. G., 664.

See ABANDONMENT, DILIGENCE, FORFEITURE, INTERFERENCES.

LICENSE.

1. A license to manufacture at a certain place is a personal license not transferable.

Searles *v.* Bouton, *Wheeler, J.*, Oct., 1881, 21 O. G., 1784.

2. A license will not carry the right to any one but the licensee personally, unless there are express words to show an intent to extend the right to an executor, administrator, or assignee.

Oliver, Finny & Co. *v.* Rumford Chemical Wks., U. S. S. C. By *Blatchford, J.*, 29 Oct., 1883, 25 O. G., 784, ✱. See, also, Keller *et al. v.* Stolzenbach *et al.*, (3) *infra*.

3. During the existence of a partnership between two persons, one of them invented a machine upon which a patent was granted to him. The firm paid the fees and costs of procuring the patent and the expenses of an experimental trial of the invention, and also paid the expenses of some litigation which ensued. It appeared, however, that all the outlay by the firm was more than repaid by the benefits arising from the use of the invention in the partnership business: *Held*, that upon these facts no implied license arises to the member of the firm not the inventor, to make, vend, and use the patented machine after the dissolution of the partnership.

Keller *et al. v.* Stolzenbach *et al.*, *Acheson, J.*, 20 Mar., 1884, 27 O. G., 209.

4. Rights of, — How enforced.

A grant under a patent which excludes either the right to make, the right to use, or the right to sell, is not a grant of the entire patent-right, and is, therefore, only a license. Complaints of infringement of a patent-right can be enforced *only* through or in the name of the owner of the patent; the name of the licensee — if necessary to protect the rights of all parties — being joined with that of the owner as plaintiff.

Waterman *v.* McKenzie, U. S. S. C. (by *Gray, J.*), 34 L. ed., 923, ✱.

5. Revocation.

When a license contains no power of revocation the licensor cannot annul it without assent of the licensee; but must proceed at law for any breach of the contract.

Chace *v.* Cox, *Butler, J.*, 19 June, 1890, 41 F. R., 475.

NOTE. — In a grant of exclusive license within and throughout the United States, or any portion thereof, it is customary to insert in license contracts two clauses for the protection, one of the licensor, and the other of the licensee, viz.: (i) That the licensee's payments shall, in no one year, fall short of a specified *minimum*; (ii) That the licensor shall take prompt legal action against piratical users within the licensee's territory.

See ASSIGNMENT; CONSTRUCTIVE LICENSE.

LIMITATION OF TERM OF A UNITED STATES PATENT BY EXPIRATION OF FOREIGN PATENT.

Section 4887 of the Revised Statutes, which limits the term of the United States patent for an invention previously patented abroad to that of the foreign patent having the shortest term (which has been variously construed by different judges of circuit), is now definitely construed in decisions of the United States Supreme Court.

(1) Section 4887 R. S. must be held to mean that the subsequently granted United States patent "shall be so limited as to expire at the same time with the term expressed on the face of the foreign patent which had the then shortest time to run." There is nothing in the statute which admits of the view that the declaration of the United States patent is to be limited by anything but the duration of the legal term of the foreign patent in force at the time of issuing of the United States patent, or that it is to be limited by any lapsing or forfeiture of any portion of the term of such patent by means of the operation of a condition subsequent, according to the foreign statute.

(2) Where the term of grant in the written instrument which constituted the previously issued foreign patent was five years, which it was entirely within the patentee's option, by payment of an additional fee, to extend to fifteen years from the original grant; the effect of such instrument upon the duration of the United States patent is precisely that of a foreign patent granted for fifteen years.

Carl Pohl *et al. v.* Anchor Brewing Co., 33 U. S., 953, ✱.

See, however, (1) *et seq.*, TERM OF A U. S. PATENT.

LIMITATION OF TIME FOR ACTION FOR INFRINGEMENT OF PATENTS.

1. In the absence of any Federal Statute, and likewise of any conclusive decision of the Supreme Court which bears on the question, authorities are divided, but preponderate in denying any such limitation (estoppel) either generally for the United States or locally, under any law of the State in which the action is brought.

May *v.* Logan and Seneca Counties, Ohio, *Jackson & Welker, JJ.*, 22 Mar., 1887, 41 O. G., 1387; 3 Robinson on Patents, 173–179. See, however, Sec. 721 R. S.; and Hayden *v.* The Oriental Mills, *Lowell, J.*, 12 Mar., 1883, 24 O. G., 601.

2. A state statute of limitations is not pleadable in bar of an action at law for infringement of a patent. In this case the court said: In the absence of any decision of the Supreme Court on the question we are disposed to adhere to the rule laid down by Judge Grier (Parker *v.* Hallock, 2 Fish., 543), and the more so in view of similar rulings in other circuits (May *v.* Buchanan Co., 29 Fed. Rep., 469; May *v.* Cass Co., 30 Fed. Rep., 762; May *v.* Ralls Co., 31 Fed. Rep., 473).

McGinnis *v.* Erie Co., *McKennan & Acheson, JJ.*, 29 Dec., 1890, 55 O. G., 718.

LIMITATION OF TIME FOR APPEAL TO SUPREME COURT.

An appeal from the final decree of a Circuit Court must be taken within two years from the entry of such decree or it will not be entertained.

Fowler *v.* Hamill, U. S. S. C. By *Fuller, Ch. J.*, 18 Ap., 1891, 55 O. G., 715,✱.

MANDAMUS.

See DECREE OF COURT.

MANUFACTURE. — SALE. — USE.

1. A patented article purchased of the patentee or one owning under him may be used or be sold for use (not in the ordinary course of trade) anywhere.

Whatever may be the rule where patentees subdivide their patents [territorially], as to the exclusive right to make or sell within a given territory, we hold that, in the class of machines or implements which we have described (Hat-Felting Machines, 16 Wallace, 545; Planing Machines, 1 Wallace, 340; Water-proof Fabric, 22 Howard, 221, etc.), when they are once lawfully made

and sold, there is no restriction upon their use to be implied for the benefit of the patentee or his assignees or licensees.

Adams *v.* Burke, U. S. S. C. By *Miller, J.*, 8 Dec., 1873, 17 Wallace, 455, ✽.

2. Sale of the patented article, in the ordinary course of trade, outside the territorial limits to which the right of sale is restricted by the patentee's grant, is unwarranted.

Hatch *v.* Adams, *McKennan, J.*, 20 Oct., 1884, 29 O. G., 776.

Unconditional sale of a patented article confers the whole title therein, and impliedly warrants full ownership on the part of the vendor; title so passed even where the sale was in a foreign country, is good everywhere and carries the right to use, or sell for use, anywhere.

Holliday *v.* Matheson, *Wheeler, J.*, 9 Dec., 1884, 30 O. G., 452.

See TERRITORIAL RIGHTS.

MARKING.

1. Patentees are required to mark each article made or vended under their patent (or when this is impracticable, to mark the package or wrapper) with the word "patented," and the day and year of the grant; but infringers who have been duly notified, are liable, notwithstanding omission of such marking.

R. S., 4900.

2. When, from the small size of the article or other cause, it is difficult or impracticable to mark it with the word "patented" and date of patent, the law is

complied with by marking the wrapper in which the goods are exposed for sale.

Sessions *v.* Romadka, U. S. C. C., E. D. Wis., *Dyer, J.*, 26 July, 1884, 28 O. G., 721.

See PENALTY.

3. *Wilful* infringers are not absolved by the patentee's neglect to mark.

The court will proceed upon the hypothesis that the burden of averring and proving a failure to mark is on the defendant, the plaintiff not being held to proof of marking, in the first instance; but where defendant has shown an instance of plaintiff's failure to mark, the burden falls upon the plaintiff to show that defendant was notified, before suit was brought, that he was infringing.

Schofield *v.* Dunlop, U. S. C. C., E. D. Pa., *Butler, J.*, 9 May, 1890, 52 O. G., 1369, 42 F. R., 323.

4. Burden of Proof.

It is only after defendant has proved that the patented article was not marked with the required notice that it is incumbent on the complainant to prove that defendant had knowledge of the patent.

Ib.

MATERIAL.

See NEW MATERIAL.

MATERIALITY.

See (4) EXAMINATION; (6) RE-OPENING OF CASE; SUBSTANTIAL AMENDMENT.

MATTER OF FORM.

In reference to petition "for an order on the Primary Examiner requiring him to dispose of claims 2

and 3 on their "merits," the Commissioner said: The Examiner has not yet formally rejected the claims, but has twice objected to the use of the word "*moieties.*" If all that applicant means or intends to mean by his use of the word "*moieties,*" is parts of equal size, it is easy for him to use those words and avoid what is believed to be an ambiguity. The Examiner's action pertains to a matter of form, and therefore he *objects* instead of *rejects*.

Petzold, x. p., *Simonds, Com.*, 12 Feb., 1892, 58 O. G., 1091.

MATURED INVENTION.

See Stephenson *v.* Goodell, (1), Sawyer *v.* Edison, (4), Dolbear *v.* Am. Bell Tel. Co., (5), and Bury *v.* Thompson, (2), Reduction to Practice.

MATURITY OF AN ART.

See Infancy of an Art.

"MEANS," "MECHANISM," ETC.

1. Comprehensive Expressions.— When and in what way permissible.

Such expressions as "*means*" and "*mechanism*" are generally objectionable as being indefinite. They are always objectionable where, by their use, the claim does not distinguish what is believed to be new. It is not, however, intended by this to intimate that any particular expression or form of words is always to be excluded from a claim, — that, for example, such expressions as "means" and "mechanism" may never be employed. On the contrary, if such words, coupled with the necessary words of qualification, ever *express the exact invention, or* if they refer to *merely adjunctive devices*, readily understood, they are not objectionable. Comprehensive

terms and phrases are quite proper (Demming, x. p., 26 O. G., 1207), if they are clear, that is, if they distinctly express the invention and are warranted by the specification.

Holt, x. p., *Dyrenforth, Act. Com.*, 26 Ap., 1884, 29 O. G., 171.

2. Where, in a claim, the language qualifying the word "means" referred to function, and contained no limitation whatever in respect to construction or mode of operation as distinguished from the result, and the word "means" designated that portion of the claim in which the novelty resided: *Held*, that such a claim was indefinite and should not be allowed.

Pacholder, x. p., *Mitchell, Com.*, 26 Ap., 1889, 51 O. G., 295.

3. Where, in a claim, the language following the words "means" and "mechanism," was employed to set forth function, but *contained limiting or qualifying words other than those which set forth the result accomplished*: *Held*, that such a claim was not vague or indefinite.

Ib.

4. **Where the Examiner rejected several claims** on the ground that the words "*mechanical connections*" used therein covered more in some claims than in others, and that therefore the claims were faulty, under the decision in Stanbridge, x. p. (43 O. G., 1345): *Held*, that the objection did not go to the merits, and was besides not tenable, because, within the scope of the claims against which the objection was raised, the devices described as "mechanical connections" could be clearly distinguished in the several claims, and there could, therefore, be no doubt as to what the term was intended to cover.

Clouser, x. p., *Fisher, Act. Com.*, 28 Nov., 1890, C. D. Ms.

Compare Nordenfelt, x. p., (5), and Jacobson, (6) *infra*; and Noyes, x. p, (9) SPECIFICATION.

See also Laskey, x. p., (21), Wilder, (22), and Skinner, x. p., (24), CLAIM, CUSTOMARY ADJUNCTS; Designolle, x. p., (17) CLAIM; and Kent, x. p., 1871, C. D. 301; Richardson, x. p., 1875, C. D. 54; McMurray, x. p., 1875, C. D. 134; Barnes *v.* Snedeker, 1880, C. D. 95; Pearson, x. p., (1 and 3) PIONEER INVENTION.

See, however, Rogers, x. p., (8 and 9), and Raymond, x. p., (10), EXAMINATION.

5. The question whether or not a pioneer inventor is entitled to claims covering his invention broadly by the use of such terms as "means" and "mechanism," is one which is to be determined by a consideration of the state of the art rather than by objections to the form of the claims. Such questions of form are subordinate to the question of patentability, and *no form of claim is to be prescribed which will prevent an applicant from obtaining claims to amply protect his invention within limits set by the state of the art.*

Nordenfelt, x. p., *Fisher, Act. Com.*, 11 Feb., 1890.

6. Where the Examiner maintained that the term "means" alone could not be used to designate an element of a combination which might be omitted from the claim without impairing its validity in any respect, and relied upon Anders *v.* Gilliland (1881, C. D. 1); Deming, x. p. (1881, C. D. 71); Pacholder, x. p. (39 C. D. Ms., 473); and Stoughton, x. p. (43 O. G., 1345): *Held*, that the Examiner's proposition was utterly untenable, and that in each of the cases cited, where the term "means" was held to be objectionable, the thing covered by the term was of the essence of the invention, and not a mere subsidiary device. The Supreme Court, in Morley Sewing Mach. Co. *et al. v.* Lancaster (47 O. G., 267), sustained claims which fairly bristled with the words "means" and "mechanism," applied not only to sub-

sidiary, but also to the principal features of the invention covered by them.

Jacobson & Jacobson, x. p., *Fisher, Act. Com.*, 3 Jan., 1890.

Compare Clouser, (4) *supra*, and cases there cited; also Pearson, x. p., (1) PIONEER INVENTION.

MECHANICAL SKILL.

1. As distinguished from Invention.

Where an application was rejected on a reference and applicant based his right to a patent upon the ground that his device could be applied more readily and in less time than the device in the reference patent and other well-known devices, and that it could be more cheaply made because composed of less metal: *Held*, that, although the device might be better than any other, yet the result and mode of operation were substantially the same as in the device cited, and the applicant, in the production of the improved form, had brought into play the skill of the mechanic only.

Forg, x. p., *Mitchell, Com.*, 25 July, 1890, C. D. Ms.

2. A patent for improvements upon the subject-matter of a prior patent is void, — even although made by the original patentee, — where the improvements consisted only of such modifications and changes as the use of the original form would suggest to any skilled mechanic, and which therefore did not require the exercise of invention.

Root *v.* Sioux City Cable Ry. Co., *Shiras, J.*, U. S. C. C., N. D. Ia., 42 F. R., 412.

3. A combination of old elements does not constitute patentable invention, which merely shows great industry in acquiring knowledge of what others had done, good judgment in selecting and combining the same, and

mechanical skill in their application, but which presents no discoverable trace of original thought; and is an improvement in degree merely upon earlier patents, patentable.

Busell Co. *v.* Stevens. By *Lamar, J.*, 15 Dec., 1890, U. S. S. C., 34 L. ed., 719, ❁.

Compare Voelker *v.* Gray *v.* Edison *v.* Bell, (31) *et seq.*, INVENTION; and Torrance, (1) *et seq.*, ORDINARY RESOURCES OF THE ART.

"THE MERITS."

1. Questions involving "the merits" are questions concerning the meritorious or unmeritorious attitude of an alleged invention to the antecedent rights of the public; or, in other words, all questions other than questions of "form" arising between the applicant and the Office. All questions which under Rule 124 the party only whose claim is affected has a right to be heard, are questions of "merits," and can reach the Commissioner only in his judicial capacity on appeal from the Examiners-in-Chief. All questions in which both the Examiner and the applicant have a right to be heard are questions of "form," and are appealable direct to the Commissioner acting in his executive capacity.

Zeidler *et al. v.* Leech *et al.*, *Mitchell, Com.*, 19 Jan., 1891, 541 O. G., 503.

2. Where the question as to the lawful scope of a claim is a question involving "the merits" and not one of form merely, it is to be disposed of by the Primary Examiner, subject to appeal to the Examiners-in-Chief.

Ambler, x. p., *Mitchell, Com.*, 31 Oct., 1889, C. D. Ms.

3. The question of inoperativeness is one which goes to "the merits" of the invention, and from a rejection on this ground an appeal lies to the Examiners-in-Chief.

Ferguson, x. p., *Frothingham, Act. Com.*, 3 Sep., 1891, 56 O. G., 1334.

4. Statutory bar is a question of "merits."

On a petition from the action of the Examiner rejecting an application on the ground that the grant of a patent would be in violation of the Act of 10 Feb., 1891, to prevent counterfeiting, etc.: *Held*, that the action was in effect a rejection, upon the ground that the subject-matter was not patentable by reason of an alleged statutory bar, and, therefore, clearly a question relating to the "merits," and the petition was dismissed.

Thompson, x. p., *Frothingham, Acc. Com.*, 24 Oct., 1891, C. D. Ms.

5. Upon petition that the Examiner be instructed to examine the case "as a proper subject for a patent under the head of a 'manufacture'": *Held*, that it was a question relating to the "merits," and therefore not properly [on petition] before the Commissioner.

Porter, x. p., *Frothingham, Act. Com.*, 6 June, 1892, C. D. Ms.

MINORS. — MARRIED WOMEN. — WARDS, ETC.

Either as inventor or as assignee, a married woman or a minor may apply for and become possessor of a patent; but their ability to dispose of such right or possession will be subject to the laws governing such procedures where the transaction takes place.

R. S., 721 and 722; Fetter *v.* Newhall, U. S. C. C., S. D. N. Y., *Wheeler, J.*, 29 Aug., 1883, 25 O. G., 502.

MODELS.

1. Applications complete in all other respects are now admitted and filed whether accompanied by models or not. A model is neither required nor admitted unless called for by the Examiner in charge.

R. S. 4891; P. O. R. 56.

2. To accompany Application.

Unless filed because a requirement of the Office, a model forms no part of the application record, and cannot be endorsed on the file-wrapper.

Beaumel, x. p., *Frothingham, Act. Com.*, 30 Ap., 1891, 56 O.G., 1208.

3. Where applicant presented a model with his application without being called for by the Office, and the Examiner refused to endorse it upon the file-wrapper as a part of the application, on the ground that he had no authority, in any case, to enter upon the file-wrapper of an application the date of the reception of a model until after it had been called for in the manner and for the purposes stated in Rule 56; petition praying that the Examiner be overruled denied.

Ib.

4. Examiner having allowed a claim, one of whose elements was the "plug valve" which he now pronounces inoperative, his requirement, at this stage, for a model is overruled. The case is remanded for action under Rule 133.

Ferguson, x. p., *Frothingham, Act. Com.*, 3 Sep., 1891, 56 O. G., 1334.

5. Where, after calling for a model, the Examiner states that it could not be accepted, but that [nevertheless] the application had been examined in connection with it as an exhibit employed as a guide by which to criticise the drawings and specification: *Held*, that the law knows of but one kind of model as a source of information to the Office, and that is such a model as complies with the rules, and if it is not such a model,

only confusion can result from references to it in the record.

Crissey, x. p., *Mitchell, Com.*, 12 Feb., 1891, C. D. Ms.

6. When Returnable.

Where a model had been called for but its receipt and application to the case under consideration had never been entered on the file-wrapper, as required by Rule 56, and the Examiner had stated that he did not consider a model was necessary: *Held*, that it had not been regularly filed, and, therefore, applicant's request for its return should be granted.

Hunter, x. p., *Frothingham, Act. Com.*, 17 June, 1892, 60 O. G., 1477.

7. It is a well-settled law that a model alone, designed and intended as such, even though it be a working model, is not a reduction to practice.

Green *v.* Hall *v.* Siemens *v.* Field, *Hall, Com.*, 6 Mar., 1889, 46 O. G., 1515.

8. A model or drawing, although (as was held in Loom Co. *v.* Higgins, 105 U. S., 580, ✱) a sufficient foundation for a claim to priority of conception, must be followed up with reasonable diligence and with actual reduction to practice, in order to establish full title to priority.

Green *v.* Hall *v.* Siemens *v.* Field, *Mitchell, Com.*, 10 June, 1889, 47 O. G., 1631.

See PRIORITY and REDUCTION TO PRACTICE.

MODIFICATIONS.

Modifications suggested in the specification must be shown in the drawings.

Examinations are conducted, in the main, by an inspection of the drawings. It is, therefore, not only

proper, but necessary that each drawing shall disclose, as fully as possible, the invention, and also the substantial modifications thereof, in order to avoid injustice to the public and to other patentees by the issue of two patents for the same thing.

Witty *v.* Caffery, x. p., *Butterworth, Com.*, 25 Nov., 1884, 29 O. G., 862.

MULTIPLICITY OF CLAIMS, see REDUNDANCY.

MORTGAGED PATENT.

Mortgagee's Rights and Powers.

The recording of a mortgage of a patent-right in the Patent Office is equivalent to a delivery of possession, and makes the title of the mortgagee complete toward all other persons as well as against the mortgagor, and the mortgagee thereby becomes the only person who can sue for an infringement of the patent.

Waterman *v.* Mackenzie, U. S. S. C. By *Gray, J.*, 2 Feb., 1890, L. ed. 923,✱.

MOTION.

1. To dissolve Interference.

There is no rule which requires that the facts upon which a motion to dissolve an interference is based should be stated in the motion. If, however, facts are relied upon other than those disclosed by the record, they should be stated in order to receive consideration.

There is nothing in the rules that limits the questions to be discussed upon a motion to dissolve an interference, to those which have not been previously considered by the Primary Examiner. One object to be secured by such motions is to enable the Examiner to decide *inter partes* what he had previously decided without a hearing.

Law *v.* Wolf, *Mitchell, Com.*, 9 June, 1891, 55 O. G., 1527.

2. After Judgment.

A motion after judgment must be made with such promptness that it can be heard before expiration of limit set for appeal, because otherwise the tribunal which rendered the judgment would not have jurisdiction at the day of hearing (Holton *et al.* *v.* Merrow, 41 C. D. Ms., 457; Rule 114).

Meyrose *v.* Jahn, *Frothingham, Act. Com.*, 28 Mar., 1891, 56 O. G., 1447.

3. To strike from Record.

Until the proper court has been applied to to heal the defect, the Office will not act upon a motion to strike from the record of a case pending before it the deposition of a witness because he refused to answer a proper question on cross-examination; but it will, in a proper case, give the moving party a reasonable time to make the proper application to court within whose jurisdiction the testimony was taken.

NOTE. — Thirty days from the date of this decision were allowed for such application to court and the completion of Robert P. Frist's testimony; the other dates and times in the case being correspondingly extended.

Reuter *v.* Frist, *Simonds, Com.*, 7 Jan., 1892, 58 O. G., 386.

Compare (195) and (196) INTERFERENCES.

See dicta under captions WAIVER and WITNESSES.

See also Brunger *v.* Smith, *Colt, J.*, 58 O. G., 388.

MULTIFARIOUSNESS.

If a bill charge infringement of separate patents in one machine, it will not be rendered multifarious by the mere fact that the several i entions relate to different and distinct parts of the machine.

Deering *v.* Winona Harvester Wks. *et al.*, U. S. C. C., D. Min., *Nelson, J.*, 19 June, 1885, 32 O. G., 654.

NASCENT INVENTION.

See CONCEPTION.

NAME.

Where the applicant employed in the specification the words "Forbes Combined Slide-Hinge Joint," to designate a feature which he believed himself to have invented, *but there was no evidence that such name was known in the art: Held*, that the Examiner was correct in requiring the words to be eliminated. If the use of such an expression is permissible in a specification, it is only when the machine or mechanism referred to has become known by such name in the prior art.

Forbes, x. p., *Mitchell, Com.*, 14 Oct., 1889, C. D. Ms.

NAME OF APPLICANT.

See SIGNATURE. See also McGee, x. p., (18) DRAWING.

NECESSARY FUNCTIONS OF THE MACHINE.

1. An objection that the claims are for the necessary functions of the mechanism described is not a question of form but of merits, and, therefore, an appeal lies to the Examiners-in-Chief.

Zalinski, x. p., *Fisher, Act. Com.*, 4 Mar., 1890, C. D. Ms.

2. Where Examiner objected that the claims were for the necessary functions of the mechanism described, but made no examination upon the merits: *Held*, that unless descriptions and claims are of such a character that the inventions covered by them cannot be understood, an examination into the state of the art should be made so that applicant can have the benefit of it in case it becomes necessary to appeal.

3. One claim covered a hammer, and another an alleged method carried out in the ordinary use of the

hammer: *Held*, overruling a requirement of division, that the case was not one requiring division, but one involving the question whether the claim covering the tool could be joined with one for a mode of using it; that the subject-matter of both claims could be examined in the same division, and that the case fell within the doctrine in Lord, x. p., 50 O. G., 938, and Norwood, x. p., 50 O. G., 1129.

Woltentarsky, x. p., *Frothingham, Act. Com.*, 26 Feb., 1892, C. D. Ms.

Compare Mackay *v.* Jackman, (35) INVENTION.

NEW MATERIAL.

1. While mere change of material in a fabric may not involve invention, and consequently not be patentable, yet where it is sought and accomplished for the purpose of producing a new effect or for accomplishing a new and improved result, then it becomes more than a mere change of material and may be patentable.

Love, x. p., *Leggett, Com.*, 4 Nov., 1871, C. D., 276.

See, however, Hotchkiss *v.* Greenwood, (3) *infra*, ✱.

2. Patent was sought on a claim for an alleged useful novelty depending on the use of a certain material. The question to be decided is whether it is a *mere* change of material, — whether all the advantages attained are such as were known in advance would be attained by selection of the tissue in question. The answer must be that it (limbered and perforated bladder tissue) is a mere change of material, and that its new use has no quality not indicated by its known character. The decision of Board of absence of patentable novelty, affirmed.

Foss, x. p., *Simonds, Com.*, 12 Sep., 1891, 56 O. G., 1564. Reiterated on rehearing, 23 Nov., 1891, 57 O. G., 1277.

3. The use of clay to make a particular kind of door-knob being known, and clay having been used to make door-knobs of other kinds, and *the practicability of using it for this kind of knob being obvious to an ordinary mechanic acquainted with the business*, is not the subject of letters-patent.

Hotchkiss *v.* Greenwood. U. S. S. C. By *Nelson, J.*, Dec., 1850, 18 Curtis, 615, ✽.

4. Where substantially the only difference between the application and the reference was that the material used by one was pure lead where the other used one part tin and nine parts lead: *Held*, that the change in material did not amount to invention.

Harrington, x. p., *Simonds, Com.*, 16 Jan., 1892, C. D. Ms. Compare Ainbach, x. p., *infra.*

5. All the steps of the process being old, the substitution of one well-known variety of cement for another that is also well-known as a binding material, in carrying out the process, does not amount to invention unless the character of the substituted material is such that its use in the present relation involved something more than mere selection.

Ainbach, x. p., *Frothingham, Act. Com.*, 25 Jan., 1892, C. D. Ms.

For Supreme Court decision of like purport, see Hotchkiss *v.* Greenwood, ✽ (3) *et seq., supra.* For an instance, where the material employed constituted an element of patentability, see Love, x. p., (1) *supra.* For a general exposition of the subject, see decision of *Simonds, Com.*, in the case of Foss, x. p., (2) *supra.*

6. Where the alleged invention consisted principally in the substitution of cotton for jute in the manufacture of bagging: *Held*, (following Brown *v.* Dist. of Col.,

130 U. S., 87, ✱) that, notwithstanding the experiments and trials made by the applicant and the advantages and commercial success of the alleged invention, all that applicant did was to substitute one well-known material for another and to apply to the substituted material the resources of the weaver's art, and that such substitution and application were not the creative work of the inventive faculty such as the patent laws were formed to encourage and reward.

Odenheimer, x. p., *Mitchell, Com.*, 27 Nov., 1889.

7. To support a patent there must have been something more than a mere substitution of one material for another, which substitution neither involved a change of method nor developed novelty in use, even though the substitution resulted in a superior article.

Florsheim *et al. v.* Schilling, U. S. S. C. By *Lamar, J.*, 10 Nov., 1890, 53 O. G., 1737, ✱.

8. Although patentable novelty may inhere in a machine or a process, or both, whereby a useful fiber is produced from some natural object, — e. g., "pine-needles," — the product itself is not a subject for patent. A contrary ruling would result in granting to one inventor the exclusive use of one species of fiber, to another, that of another species, and so on indefinitely; separate patents might thus be obtained upon the fibrous constituents of each of the various trees of the forest, plants of the earth. etc., which, being natural products, are no more the subjects of patents when eliminated from their surroundings, than wheat that had been cut by some new method of reaping could be patented as wheat cut by such a process.

Latimer, x. p., *Hall, Com.*, 12 Mar., 1889, 46 O. G., 1638.

See (28) *et seq.*, INVENTION.

See also Johnston, x. p., (2) ORDINARY RESOURCES OF THE ART.

"NEW MATTER."

1. The expression is not appropriate in actions on original applications.

Examiner having refused to permit description or exhibition of more than one "knocker," because, as only a single knocker had been mentioned or described in the application as filed, such additional knocker would be "new matter;" the objection was overruled because the term "new matter" in the statute and the Rules of Practice had reference to re-issues only.

Holt, x. p., *Dyrenforth, Act. Com.*, 26 Ap., 1884, 29 O. G., 171.

Of like tenor, see Noyes, x. p., (13) SPECIFICATION; and Myers, x. p., (21) AMENDMENT.

2. The rights of the applicant must stand or fall upon his original application. Only such changes may be made as are authorized by the drawing, model, or specification as filed in connection with the application. A drawing may not be altered so as to exhibit features neither disclosed in the drawing nor described in the specification as originally presented. Amendments cannot be received on the ground that they represent features contained in a model that was never filed.

Kissner, x. p., *Mitchell, Com.*, 30 Oct., 1890, C. D. Ms.

See also Edison, x. p., (9) *infra*.

Compare, however, Holt, x. p., *supra;* Myers, x. p., (21) AMENDMENT; and Noyes, x. p., (13) SPECIFICATION.

For ruling that in an original application an omitted device is not "new matter," if it was described in an earlier application by the same inventor, see Scott, x. p., (10) ABANDONMENT; and Rennyson *v.* Merritt, (5) DEDICATION.

3. A new claim justified by subject-matter found in the original specification may be introduced into a

pending application if said claim be fortified by a supplemental oath, as required in Rule 70; but new subject-matter — either with or without a corresponding claim — may not be introduced, or, if it has been introduced, cannot be permitted to remain in an application (Con. Elec. Lt. Co. *v.* McKeesport Lt. Co., 40 Fed. Rep., 21). Had the new subject-matter in the present case been accompanied by a claim based thereupon, the appeal must have been to the Examiners-in-Chief, but, as no such claim was made, the question was properly on petition to the Commissioner. The decision of the Primary Examiner is affirmed and the petition dismissed.

Burson, x. p., *Simonds, Com.*, 26 Feb., 1892, 58 O. G., 1414.

4. Where a claim was made on amendment with the object of putting the application in interference with a patent on which it had been rejected, and the Examiner refused to entertain the claim because subject-matter not contained in the original application: *Held*, that the question of new matter is appealable to the Examiners-in-Chief, and must be disposed of in applicant's favor before an interference can be declared.

Rasor, x. p., *Mitchell, Com.*, 28 Sep., 1889, C. D. Ms.

5. If the Examiner is of the opinion that the proposed process claim, seasonably presented, covers new matter, he should incorporate the claim and reject it, in order that an appeal may be taken to the Examiners-in-Chief.

Perkins, x. p., *Mitchell, Com.*, 4 Mar., 1891, 55 O. G., 139.

6. Examiner's Duties.

When claims are presented which appear to the Examiner to involve new matter, his proper course is to admit the claims into the case and to reject them upon that ground.

Stone, x. p., *Fisher, Act. Com.*, 17 Mar., 1890, C. D. Ms.

7. Under Rule 133, the question whether or not a proposed amendment constitutes new matter, is one of "merits," from which an appeal in the first instance lies to the Examiners-in-Chief and not to the Commissioner.

Edison, x. p., *Mitchell, Com.*, 15 Ap., 1890, C. D. Ms.

8. Among the leading cases relating to the doctrine of "New Matter" in connection with original applications, are the following: C. & N. W. R. R. Co. *v.* Sayles, 97 U. S., 554, ❁; Eagleton M'f'g Co. *v.* West Bradley & Carey M'f'g Co., 111 U. S., 490, ❁ and Consol. Elec. Lt. Co. *v.* McKeesport Lt. Co., 49 O. G., 1536.

Ib.

9. Upon a petition from the Examiner's decision that certain matter described in a substitute specification was new matter and inadmissible: *Held*, that, no question of division having been raised, the Examiner should have incorporated the amendment and have rejected the claim as covering new matter (Bailey, x. p., 52 O. G., 608; Turner, Van Beck & Brown, x. p., 56 O. G., 1708).

Tittle, x. p., *Frothingham, Act. Com.*, 6 Feb., 1892, C. D. Ms.

10. After an amendment supposed to contain new matter has been once incorporated in the application, Rule 70 is no longer applicable. The question whether or not said amendment really contains new matter then becomes one involving the "merits," and hence is appealable to the Examiners-in-Chief.

Nicolin *et al.*, x. p., *Frothingham, Act Com.*, 26 May, 1891, 56 O. G., 1565.

See Fuller, x. p., (45) DIVISIONAL APPLICATION.

NEW PARTIES.

See Hogan, x. p., (8), FEES, and Dougherty *v.* Street, (21) INTERFERENCES.

NEW SPHERE OF ACTION.

Distinguished from a mere "Double Use."

The promotion of an old device to a *new sphere of action* in which it performs a *new function*, involves invention; but the transfer or adaptation of the same device to a similar sphere of action where it performs substantially the same function, does not involve invention.

Western Elec. Co. *v.* La Rue, U. S. S. C. By *Brown, J.*, 13 Ap., 1891, 55 O. G., 571, ✿.

Of like purport, see Ansonia Co. *v.* Supply Co., ✿ (2) PATENTABILITY.

See ADAPTATION; DOUBLE USE.

NON-INVENTION.

Analogous Use.

The state of the art showing that dies could be used to compress and finish articles of vulcanizable gum and, in like manner, to compress plastic material surrounding a metal core or skeleton in making articles of harness trimming; it required no exercise of invention to use dies to compress and finish similar articles in which a vulcanizable gum was used to envelop a metal core.

The Rubber and Celluloid Harness Trimming Co. *v.* The India Rubber Comb Co., U. S. C. C., S. D. N. Y. *Wallace, J.*, 23 May, 1888, 44 O. G., 343.

See (30) *et seq.*, INVENTION; (1) *et seq.*, MECHANICAL SKILL; and (1) *et seq.*, ORDINARY RESOURCES OF THE ART.

NOTARY.

Where the notary taking depositions in an interference case was an employé of a company holding the interest

of one of the parties, and also appeared as a witness in the case, the other party having formally objected at the proper time to the taking of the testimony before him: *Held*, that, on motion to that effect, the testimony must be stricken from the record.

Vanness *v.* Shettler, *Simonds, Com.*, 31 Oct., 1891, 57 O. G. 843.

NOVELTY.

1. The fact that an invention is of great utility and has gone largely into use goes far to show that the inventor had discovered and put to use what others skilled in the art had overlooked, and that it would have been found out before if ordinary skill in that art could have discovered it.

Bruce *v.* Marder, *Wheeler, J.*, 22 Feb., 1882, 10 F. R., 750.

2. Invention is displayed by simplification accompanied with reconstruction producing useful results.

Invention is as often displayed in simplifying and cheapening mechanical constructions as in the discovery of new machines. When a machine consisting of fourteen or fifteen elements is so reconstructed as to accomplish the same or better results with seven or eight of these elements, invention is displayed and a useful result is obtained, and that result is new so far as concerns the more complicated machine. In such a case the complicated machine would not be a sufficient reference on which to reject the improved construction.

Sampson, x. p., *Leggett, Com.*, 4 Nov., 1871, C. D. 277.

3. An incomplete and practically inoperative device does not furnish sufficient grounds for rejecting an operative one, though the two devices may have some features in common.

Mason, x. p., *Leggett, Com.*, 27 Nov., 1872, 2 O. G., 644.

4. The application of a known device may be deemed novel if it lies so far out of the beaten track as not to be suggested by the former use of it.

Cheesebrough, x. p., *Fisher, Com.*, 11 May, 1869, C. D. 18.

5. Where the patent covers an entirety it cannot be defeated by showing that the several component parts are old in other connections. It must appear that they have existed together in the same relation.

Parks *v.* Booth, U. S. S. C. By *Clifford, J.*, Oct. 1880, 26 L. ed., 54; 12 Otto., 96, ❁.

6. A patent cannot be introduced in evidence to impeach the novelty of the plaintiff's invention if it has not been set up in the answer.

Am. Saddle Co. *v.* Hogg, 1 Holmes, 133.

7. Evidence of want of novelty cannot be introduced in the general issue without thirty days' notice.

Blanchard *v.* Putnam, U. S. S. C. By *Clifford, J.*, 29 Nov., 1869, 8 Wall., 420, ❁.

8. Notice of defence of want of novelty should be set up in the answer with sufficient particularity to enable the plaintiff to know what he has to meet.

Brown *v.* Hall, *Blatchford, J.*, 10 Ap., 1869, 6 Blatch., 401.

9. Evidence to sustain a want of novelty must be strong and conclusive to sustain a judgment setting aside the patent.

Whitney *v.* Mowry, U. S. S. C. By *Strong, J.*, 22 Ap., 1872, 2 Bond, 45; 14 Wall., 434, ❁.

10. The presumption of novelty is in favor of a patent, and is strengthened by running a long time without successful challenge.

Proctor *v.* Brill, *Butler, J.*, 15 Oct., 1880, 4 F. R., 415.

11. Omission followed by reorganization may constitute patentable novelty, but mere omission does not.

McRoy, x. p., *Fisher*, *Com.*, 4 Sep., 1869, C. D. 58.

12. Patentee may not, for some special use not involving invention, virtually prolong a monopoly which at the conclusion of the original term, falls of right to the public.

Camille A. Faure, inventor and patentee of the well-known secondary battery which bears his name, sought (in an application for patent filed 25 May, 1887) to virtually prolong the monopoly of such battery for a special use (propulsion of vehicles) beyond the 17 years of the original grant made on 3 Jan., 1882. The scope of the additional patent sought for was indicated in his first claim, which was, in substance, as follows: —

> The combination of a moving vehicle propelled by rotary motion imparted to a shaft or axle, a secondary battery of the "Faure Type," an electro-magnetic motor electrically connected to said battery, and a mechanical connection from a moving part of said motor to said axle, substantially as described.

The application was refused because lacking in the essence of patentable invention; each one of the four elements being conceded to be old, and, as thus associated, discharging only their old and well-known separate functions, and because the sole benefits were due — as applicant himself admits — to the excellencies and capabilities of that special form of battery of which the inventor was, through his original patent, the sole beneficiary, and of which, at the expiration of that patent, the public were the indisputable heirs; benefits from which they could not be lawfully or equitably debarred by subsequent patents seeking to monopolize uses which,

although special, are at the same time recognized by persons skilled in the art appertaining to it.

Faure, x. p., *Mitchell, Com.*, 52 O. G., 752.

NOTE. — The above decision of the Commissioner of Patents was affirmed by the Supreme Court of the District of Columbia, 7 July, 1890 (52 O. G., 754), in the following ruling: —

"Where an applicant for Letters-patent claimed to have invented 'an improvement upon devices for propelling vehicles by electrical energy through storage-batteries carried by the vehicles moved, and not connected with any arrangement of wires outside of the carriage,' and it appeared that one constituent of the alleged new invention was a secondary or storage battery upon which applicant had received letters-patent prior to the filing of the present application, and it further appeared that the mechanical arrangements for applying the power were old, and that the result, viz., the movement of a vehicle by electrical storage-batteries [carried upon it] was old: *Held*, that a patent for said improvement was rightly refused — for want of invention — by the Patent Office, although said patented storage-battery of applicant was superior to all others of its kind for the purpose, and rendered the device commercially practicable. *Held further*, that otherwise the monopoly granted upon applicant's said storage-battery would be prolonged."

Supr. Ct. of Dist. of Col. in Gen. Term, appeal by Camille A. Faure from decision of the Com'r of Patents, *Bingham, Ch. J., Hayner & James, Assoc. Justices*, 7 July, 1890, 52 O. G., 754.

13. To secure a bolting-cloth upon its frame by means of bars or wires attached to its edges, held to be anticipated by corsets made with stays or wires secured to the lined edges of the cloth.

Schoenberg, x. p., *Fisher, Com.*, 11 Ap., 1870, C. D. 36.

14. A wind-mill consisting of a wheel with cones so arranged upon the arms that on one side the bases are presented to the wind and the points on the other, is an anticipation of a water-wheel with blades which on one

side of the shaft present their broad side to the waves and their edges to the other.

Glasgow, x. p., *Fisher*, *Com.*, 14 Ap., 1870, C. D. 40.

15. Such a "combination" as applicant proposes *has not the remotest, shadowy ghost of novelty or invention about it.* Such combination of colors has been common ever since the day of Jacob's speckled cattle. The mere substitution of aniline colors for others is an act possessing no feature of invention, for aniline colors have become so common that they are in use in almost every family in the country.

Landenberger, x. p., *Leggett*, *Com.*, 10 Jan., 1871, C. D. 179.

16. A device [to take up the "sag"] which is old and well-known when applied to bridges is not novel when applied to gates and for the same purpose.

Holmes *et al.*, *Duncan*, *Act. Com.*, 5 July, 1871, C. D. 205.

17. To cast the handle of a screw-driver upon the tang of the blade does not possess the merit of novelty, since it is common to attach the handles of knives and other implements in the same way. It is also, common to cast such handles hollow, and a screw-driver so constructed is not new as "an article of manufacture."

Clark, x. p., *Leggett*, *Com.*, 6 Mar., 1873, 3 O. G., 239.

See ANTICIPATION; INVENTION.

OATH.

Form for American Inventor.

In applications for patents for inventions which have not been patented abroad, it will be deemed a sufficient compliance with Rule 46, if the American inventor

makes oath that the invention has not been patented to himself or others with his knowledge or consent, in any foreign country.

Order No. 562, *Mitchell, Com.*, 2 July, 1889.

OBITER DICTUM.

See DICTUM.

OFFICE CLASSIFICATION.

Office Classification subordinate to the Proper Issues of the Case.

While the Office classification is a factor to be considered in determining the question of division, it is not absolutely controlling. It must yield to the well-known and well-established rule that process and product or apparatus and product *may* be contained in the same application when they bear such an intimate relation to each other as to constitute practically one invention (Foster, x. p., C. D. 40 Ms., 411; Eades, x. p., C. D. 41 Ms., 13; Whitaker, x. p., C. D. 41 Ms., 396; Morningstar, x. p., C. D., 41 Ms. 399; Rood & Rood, x. p., C. D. 41 Ms., 406; Richardson, x. p., C. D. 41 Ms., 421).

Osborne, x. p., *Fisher, Act. Com.*, 24 Nov., 1890, C. D. Ms.

Compare Carter, x. p., (5), Bennett, x. p., (6), Franklin, x. p., (9), Forbes, x. p., (10), Kerr, x. p., (11), Herr, x. p., (12), Williams, x. p., (13), Williamson, x. p., (14), Gally, x. p., (15), Westphal, x. p., (16), Halteberg, x. p., (17), *et seq.*, DIVISION OF APPLICATION.

OFFICE PRACTICE.

1. New Ground of Rejection.

The proper course to be pursued by an Examiner, on discovering a new ground of rejection subsequent to an appeal to the Examiners-in-Chief, is to direct the atten-

tion to it both of the applicant and the Examiners-in-Chief. The applicant may then elect to continue the prosecution of the appeal, or to withdraw the appeal and be heard by the Primary Examiner.

Mevey x. p., *Mitchell, Com.*, 19 Ap., 1890, 56 O. G., 805.

2. Conflicting Assignments.

The statute (R. S., 4895) authorizing the Commissioner to issue a patent to an assignee of record is not mandatory, and, in case of contest between two parties each claiming to hold valid title by assignment, the Commissioner may in his discretion issue the patent to the inventor.

Spielman, x. p., *Simonds, Com.*, 23 Dec., 1891, 58 O. G., 141.

3. Two Applications by same Applicant.

Where an applicant has two applications pending in the same class of machines, the earlier of which is involved in an interference, and where it is apparent that none of the claims of the later application could made be in either of the applications in interference, and that no judgment that might be rendered in the interference proceedings could in any way affect the claims of such later application: *Held*, that the interference was no bar to the later application.

Woodward, x. p., *Frothingham, Act. Com.*, 4 Mar., 1892, 58 O. G., 1554.

See COMMISSIONER; ETC.; EXAMINER; EXAMINATION.

OFFICIAL ERRORS.

Patent re-issued to rectify Mistake of Office without Charge to Applicant.

Where an amendment was presented containing an additional claim, and the applicant was advised, on inquiry after allowance, that the case as allowed con-

tained the claim, but, by error of the Examiner, it was not entered and the patent issued without it, and the patent having been returned for correction: *Held*, that the error being such as might, under suitable circumstances, properly have been corrected by re-issue had it been due to inadvertence or accident on the part of the applicant, and it having long been the practice of the Office to grant re-issues in such cases (Cochrane, x. p., 1869, C. D. 60; Havemeyer, x. p., 1870, C. D. 6; and Rule 170), and the error having arisen through the fault of the Office; that, in accordance with the action of the Commissioner in the parallel case of Andrew Jackson, Patent No. 287,028, 23 Oct., 1883, Re-issue No. 10,440, 29 Jan., 1884, the patent should be re-issued upon the original papers and drawings without any expense to the patentee.

Thompson, x. p., *Fisher, Act. Com.*, 16 Aug., 1890, C. D. Ms.

Compare Cunningham, x. p., 20 Aug., 1890, (1) ERROR OF JUDGMENT.

OFFICIAL INFORMATION.

A petition from the action of the Examiner which amounted, in substance, to a refusal to inform the applicant of the subject-matter of the issue in a proposed interference: *Denied.*

Wheeden, x. p., *Frothingham, Act. Com.*, 18 June, 1892, 60 O. G., 1191.

See (109) and (194) INTERFERENCES.

OFFICIAL SUGGESTIONS.

Are proper, but are not binding on Applicant.

It is not improper for the Examiner to call the applicant's attention to such portions of the specification and claims as, in his opinion, would be improved by amendment, but, having called the applicant's attention to

such matters, he has performed his whole duty in the premises, providing no law or rule be violated by permitting the specification and claims to remain as they were framed by the applicant.

Wharton, x. p., *Frothingham*, *Act. Com.*, 18 June, 1892, C. D. Ms.

OMISSION.

1. Omission followed by re-organization may constitute invention, but mere omission cannot.

McRoy, x. p., *Fisher*, *Com.*, 4 Sep., 1869, C. D. 58.

2. The omission of one step of an old process with an improved result constitutes a new process.

Lawther *v.* Hamilton, U. S. S. C. By *Bradley*, J., 9 Jan., 1888, 42 O. G., 487, ✿.

3. A construction of a machine so that a less number of parts will perform all the functions of the greater, may be invention of a high order; but the omission of a part with a corresponding omission in function, the retained parts doing just what they did before in the combination, cannot be other than a mere matter of judgment, depending merely upon whether it is desirable to have the machine do all or less than it did before.

McClain *v.* Ortmayer, *Blodgett*, *J.*, 9 Jan., 1888, 42 O. G., 724.

See REARRANGEMENT; REORGANIZATION.

OPERATIVENESS.

1. Examiner is the proper judge of operativeness.

Upon the contention that an application cannot be rejected on the ground of inoperativeness unless the Examiner fully understands its subject-matter: *Held*, that the Examiner must be considered to have acted upon such matter as he did understand it. Until or in

default of a description in the specification of a workable device in terms intelligible to the Examiner, his rejection is proper, and should be adhered to until reversed on appeal.

Burkhart, x. p., *Fisher, Act. Com.*, 25 Aug., 1890, C. D. Ms.

Compare Rogers, x. p., *Mitchell, Com.*, 16 Nov., 1889, (8)

EXAMINATION.

NOTE. — The above ruling is obviously grounded in sound reason and the necessities of the case. A patent is a grant, by the sovereign power, of right or possession in something to the exclusion of everybody else. Everybody else has, therefore, a right to know explicitly the exact metes and bounds of that from which he is excluded. The doctrine is, moreover, clearly deducible from the law, thus: Sec. 4886 R.S. authorizes grant of a patent for "any new and USEFUL art, machine, manufacture, or composition of matter." Sec. 4888 R. S. requires that the inventor shall file such a description as shall enable an expert to "*construct* and *use*" the device; and Sec. 4893 R. S. empowers the Commissioner to "cause an examination to be made" of the thus described invention, and to judge whether it is "*sufficiently useful and important*" to justify the grant of a patent.

2. Burden of Proof of Operativeness on the Applicant.

Whether or not a device is operative is a matter of judgment upon the case as presented, and, instead of the burden of proof being upon the Office to show inoperativeness, it is the duty of the applicant, if challenged by the Office, to furnish proof of operativeness, either by a practical demonstration or otherwise.

Ib.

ORDER OF COURT.

See DECREE OF COURT.

ORDER OF ISSUE.

1. In the case of an application for patent for a specific improvement on an invention broadly covered by a separate application (whether by the same or a different applicant), it has been ruled (Upton, x. p.), that the spirit of the law and public policy are opposed to the issue of a patent for the specific improvement in advance of the patent which dominates it. This ruling is in language as follows:—

Neither the spirit of the law nor public policy sanctions the granting of patents with specific claims while applications with generic claims are still pending, the objection being that (whether the application with the generic claims belongs to the same party who has a specific claim under the genus, or is an application of a different party) a patent covering by a generic claim, if a subsequent patent, improperly extends the monopoly.

Upton, x. p., *Butterworth, Com.*, 21 Mar., 1884, 27 O. G., 99.

2. Ordinarily a specific patent precludes a subsequent generic patent to same inventor.

To grant a patent on an application claiming an invention broadly or generically after a patent has been granted to the same inventor for the same invention embodied in the same structure but more restrictedly stated, would be, in effect, to grant a reissue of the previous patent and, at the same time, to extend its term.

Edison, x. p., *Mitchell, Com.*, 6 Jan., 1891, 54 O. G., 263.

Compare (1, 2, 3) TWO PATENTS TO SAME INVENTOR, also (1) DEDICATION, and accompanying notes.

3. Where a subsequent patent with a claim which holds a generic relation to the subject-matter of the earlier patent is sought by the *same* applicant, an addi-

tional objection arises from the fact that the omission to claim a certain invention in an issued patent will ordinarily be held to imply a dedication of that invention to the public, who may thereby be induced to embark in undertakings predicated on such assumption, and to whom the subsequent issue of the patent with a broad claim will operate as a surprise (Edward Miller & Co. *v.* The Bridgeport Brass Co., 21 O. G., 201). This particular objection, however, is overcome if a clause was incorporated in the earlier patent which warned the public of applicant's purpose to embody such a generic claim in a later patent (Holmes Elec. Prot. Co. *v.* Met. Burglar Alarm Co., *Coxe, J.*, 33 F. R., 254). Of course in cases such as Upton, x. p., where the party filing the broad claim was not the patentee of the specific claim, no presumption of dedication arises and the objection last named disappears.

Ib.

NOTE. — Equitable considerations, however, made manifest in the adjudication of special cases since that of Upton (*supra*), have necessitated important qualifications of the general rule there laid down, thus: —

In a case where the application for the patent for the primary invention was detained in the Office by circumstances beyond control of the inventor, — such, for example, as an interference proceeding, — and he had, in a later or simultaneous application for a specific embodiment of said invention which had passed to patent, given public notice of such contemporaneous foundation application, it would do violence to the spirit and purpose of the patent law that he should suffer for conditions for which he was in no wise responsible. As was said by *Com. Mitchell* in Edison, x. p., 27 Nov., 1889, 49 O. G., 1693: If the difficulty is not inherent in the patent system, then it must be due to some defect in the administration of that system. The *inventor*, certainly, should not suffer by reason either of a defective system, or a defective administration of a satisfactory system.

4. The complainant, Chas. F. Brush, has two patents for as many specific embodiments of the invention, for which the patent sued on (and whose generic claim dominates said embodiments) was issued to him *four years later.* The later, although broader, patent was sustained, in view of the facts: (a) The application for the generic patent antedated by about two years those for the specific embodiments. (b) It was detained in the office by circumstances (interference procedures) *beyond applicant's control.* (c) *Public notices of those facts were incorporated in the specifications of the specific patents.* In summing up for this case, the Court said: —

It is true that (in these specific patents) the broad invention was described, but it is equally true that it was not claimed. It was hardly possible for the patentee to describe the subsidiary invention without disclosing his main invention. Having thus disclosed it, had he permitted the subordinate patents to issue without warning or reservation, and, after the broad invention became public property, had filed an application for what he had thus relinquished to others, it is probable that he would have been informed, either in the Patent Office or in the courts, that his application came too late. But that is not the case. Before his applications for the subordinate inventions he had applied for the superior one. In the former he expressly informed the public that they were but divisions of the latter. He could do no more. The delay in the Patent Office cannot be charged to him. Even had he been responsible for issue of the divisional patents before the principal patent, — and he was not, — the fact of such prior issue in no way misled the public. They never for a moment acquired the right to use the broad invention. An infringer with the statement on the face of patent No. 260,653 before him, would scarcely have the hardihood to assert, that he supposed the broad invention was

released. No court would listen to such a plea. The claims of that patent did not protect Mr. Brush in the use of the broad invention. A person who did not use an etagére-shaped plate could, if no other patent prevented, use the broad invention with perfect impunity. The patent No. 337,299 was intended to prevent such use. The court has not been able to discover an authority holding a broad patent invalid under such circumstances.

The Brush Elec. Co. *v.* The Elec. Ac. Co., *Coxe, J.*, 23 July, 1891, 56 O. G., 1334.

5. An important exception to the general rule laid down in Upton, x. p. (27 O. G., 99) is seen where, on sufficient showing (Rule 75), a patent is allowed (without declaration of interference) to issue with a generic claim which dominates a generically allied but specifically different device (which is only specifically claimed) in an already issued patent to another inventor.

Reed *v.* Landman, *Mitchell, Com.*, 26 May, 1891, C. D. Ms.
Compare Edison *v.* Heysinger, (66) INTERFERENCES.

ORDINARY RESOURCES OF THE ART.

1. Not Patentable.

Any one who can practise the art of marbleizing is entitled to apply it to any old and well-known article, unless there are special difficulties in applying the marbleized coating which calls for the exercise of inventive skill or ingenuity.

NOTE. — The Commissioner gave the following as some of the more recent decisions applying to cases in which the device, although new in a commercial sense, contains no novelty in a patentable sense: Stephenson *v.* Brooklyn R. R. Co., 114 U. S.,

149, ✿ ; Yale Lock Co. *v.* Greenleaf, 117 U. S., 554, ✿; Gardner *v.* Herz, 118 U. S. 180, ✿ ; Pomace Holder Co. *v.* Ferguson, 119 U. S. 335, ✿; Hendy *v.* Miners' Iron Works, 127 U. S., 370, ✿ ; Holland *v.* Shipley, 127 U. S., 396, ✿ ; Pattee Plow Co. *v* Kingman, 129 U. S., 294, ✿ ; Brown *v.* Dist. of Col., 130 U. S., 87, ✿ ; Day *v.* Fairhaven Ry. Co., 132 U. S. 161, ✿ ; Marchand *v.* Emken, 132 U. S., 195, ✿ ; Royer *v.* Roth, 132 U. S., 201, ✿ ; Hill *v.* Wooster, 132 U. S., 693.

Torrance, x. p., *Mitchell, Com.*, 2 Ap., 1891, C. D. Ms.

Compare COMMON KNOWLEDGE, (28) *et seq.*, INVENTION, (19) PROCESS; and (18) and (21), PUBLIC RIGHTS AND OBLIGATIONS.

2. Substitution of New Material.

Where the patentee of a grinding-wheel filed an application in which he claimed, in effect, the union of a grinding-wheel of the specific form shown in his patent with a specific composition set forth therein, and which consisted of the substitution of a soft for a hard "binder:" *Held*, that although by such substitution in this specific form of wheel he had reached an important result, yet, in view of the fact that both compositions were old in grinding-wheels of the common form, the substitution of material must be held to be an obvious one for the purpose intended, and consequently not patentable.

Johnston, x. p., *Frothingham, Act. Com.*, 31 Aug., 1891, C. D. Ms.

Compare Latimer, x. p., (1), Hotchkiss *v.* Greenwood, (3), Foss, x. p., (4), NEW MATERIAL.

NOTE. — On a re-hearing of this case (see Johnston, x. p., (3) PATENTABILITY), the above decision was sustained as to the claim in which the water-supply was not brought distinctly

into the combination, but was reversed as to the other, and a patent allowed.

Of numerous decisions to same purport, see Forg, (1) *et seq*, MECHANICAL SKILL; and Voelker *v.* Gray *v.* Edison *v.* Bell, (31) *et seq.*, INVENTION.

ORGANIZATION OF COURTS OF APPEAL.

By Act of Congress of March 3, 1891, nine Federal Courts of Appeals, holding annual sessions, were created, — one court being assigned to each judicial circuit, — each court being composed of the (Chief or the Associate) Justice assigned to the respective circuit and two other judges, making three in all, of which any two constitute a quorum (Sec. 3). The said courts are invested with *final appellate jurisdiction in all cases arising under the patent laws*, appealed from the District or Circuit Courts of their respective circuits (Sec. 6).

An Act to establish Circuit Courts of Appeals and to define and regulate, in certain cases, the jurisdiction of the courts of the United States, and for other purposes. Approved March 3, 1891. PUB. Doc., 118; 61 O. G., 1019.

THE PATENT.

To whom Issuable.

1. A patent is an instrument whereby some exclusive right is granted by the sovereign power to the person named therein, and, in the United States, is the creature of statute. A patent for an invention then is a GRANT, and must have a grantor and a grantee. It must grant the franchise or monopoly to a person [or party] named and who is capable of taking. The Statutes of the United States recognize only three classes of persons to whom a patent for an invention can issue, viz.: —

(1) To the inventor himself (4886 R. S.).

(2) To an assignee (either *in toto* or in joint interest with the inventor) on an assignment made and recorded before the issue of the patent (4895 R. S.).

(3) In event of decease of the inventor before issue, to the Administrator [or Executor] in trust for the heirs (4896 R. S.).

The De La Vergne Refrig. Mach. Co. *v.* Featherstone *et al.*, *Blodgeti, J.*, 29 Feb., 1892, 58 O. G., 1842.

2. A U. S. patent for an invention is a grant, presumably to the first and true inventor or inventors (whether citizen or alien), his, or their heirs or assigns, for the term of 17 years, of the exclusive right to make, use, and vend a [specific] invention or discovery throughout the United States and the Territories thereof, and is not a grant of a monopoly in the prohibited sense, — that is, one which restrains others from the exercise of a right or liberty which they had before the grant was made. It is a contract between the public and the patentee, to be supported on the ground of mutual considerations, and, being essentially a *bargain*, is to be construed like other contracts to which there are two parties, each having rights and interests involved in its stipulations. In this respect, the public, as party of the first part, through the medium of the Government, makes the grant above mentioned, while the inventor, as party of the second part, divulges his secret and causes benefit to flow to the public in two forms: first, by immediate practice of the invention under the patent, and, secondly, by the practice of (or opportunity to practise) the invention when free to the public on the expiration of the patent. To guard against the inventor's concealment of the process by which the invention is practised, and to guard against its loss, he is required to deposit in the Patent Office a written description of

the invention sufficiently clear and explicit to enable others to practise the same therefrom.

C. A. Yale Cigar M'f'g Co. *v.* C. A. Yale, *Dryenforth, Act. Com.*, 19 July, 1884, 30 O. G., 1183.

3. The Commissioner of Patents has charge and direction of the issue of two kinds of patents for invention, —*mechanical patents* and *design patents*. A mechanical patent covers a concrete invention, one in the nature of a manufacturing art, a machine, an article of manufacture, or a composition of matter, and is issued for the term of 17 years. A design patent covers an abstract invention, one in the nature of a configuration of a manufacture [or of an artistically designed figure for attachment to an article of manufacture]. Design patents are issued for 3½, 7, or 14 years.

Ib.

NOTE. — In this treatise, the word "patent" (or "U. S. patent") standing alone, means a mechanical patent.

4. Patents for inventions are different in origin and principle from patents for land.

A patent for land has, in the legislation of Congress, a two-fold operation. It conveys a title which had previously remained in the United States, or, when issued upon the recognition and confirmation of a claim to a previously existing title, it is evidence of record to the existence of that title, or of equities respecting the land requiring recognition by a quitclaim from the Government. It always imports that the Government conveys or has previously conveyed interests in the lands, — something which it at the time owns or which its predecessor once owned (Langdeau *v.* Hanes, 21 Wall., 531). A patent for an invention rests upon a totally different basis. It conveys nothing which the Government owns

or which it or its predecessors ever owned. The invention is the product of the inventor's brain, and, if made known, would be subject to the use of any one if that use were not secured to him. Such security is afforded to him by the issue of the patent, which, legalizing the inventor's exclusive right, may be said to create a property interest in that particular invention. Until the issue of a patent for it, there is no property-right in it; that is to say, there is no such right as the inventor can enforce. Until then, there is no *exclusive* power over its use, which is one of the elements of property in anything capable of ownership.

Marsh *v.* Nichols, U. S. S. C. By *Field, J.*, 10 Dec., 1888, 46 O. G., 239, ✽.

5. A United States patent is granted — for 17 years — to the first inventor of a new and useful art, machine, manufacture, or composition of matter, or an improvement thereof, not heretofore known in the United States nor published nor patented elsewhere.

R. S., 4886.

6. A U. S. Patent the creation of Statute.

An inventor has no right to a patent for his invention at common law. He has no natural exclusive right to his invention. To hold that he has is to hold to the impossible proposition that a dozen different men may each have an exclusive right to the same thing. The records of this Office show that the same thing is invented over and over again by different persons. The inventor's right is founded wholly upon statute. It is a right founded wholly upon conditions.

Nickola, x. p., *Simonds, Com.*, 27 Nov., 1891, 57 O. G., 1475.

Compare Robinson on the Law of Patents for Useful Inventions. pp. 59 *et seq.*

7. The patent system of the United States is, in many respects, radically different from that of any other country. Inferentially, at least, the purpose of the Constitution appears to have been to recognize property in a new invention as a right belonging to the inventor, not a favor conferred by the Government. This is its language: "The Congress shall have power to promote the progress of science and the useful arts by securing, for limited times, to authors and inventors, the exclusive right to *their* respective writings and discoveries."

President Ulysses S. Grant, Ex. Doc. 27.

8. The American Constitution does not attempt to give an inventor a right to his invention, or an author a right to his composition; it recognizes an original pre-existent, inherent right of property in such invention or composition, and authorizes Congress to secure to the inventor or author the enjoyment of that right; but the right exists before the Constitution and above the Constitution, and it is, as a natural right, more than that which a man can assert in almost any other kinds of property.

Daniel Webster, Argument in case of Goodyear *v.* Day.

9. It is evident that a patent issued under the system inaugurated by the Statute of 4 July, 1836 (that is to say, after an inquisition or examination made by skilful and sworn public officers appointed for the purpose of protecting the public against false claims or useless inventions), is entitled to much more respect, as evidence of novelty and utility, than those formerly issued without any such investigation. Consequently, such a patent may be, and generally is, received as *prima facie* evidence of the truth of the facts asserted in it. And in cases where the evidence is nicely balanced, it may have weight with a jury in making up their decision as to the plaintiff's right.

If so it is not easy to perceive why a defendant who uses a machine protected by a separate patent should not have the benefit of a like presumption in his favor arising from a like investigation of the value of *his* invention. It goes at least to show that he has acted in good faith, and is not a *wanton* infringer. If complainant's patent, in a doubtful case, may have some weight in turning the scale in his favor, it is but just that the defendant should have the same benefit from his, *valeat quantum valeat*. The parties should contend on an equal field and be allowed to use the same weapons.

Corning *v.* Burden, U. S. S. C. By *Wayne, J.*, Dec., 1853, 15 How., 252, ✽.

10. *The date of the application*, and not the date of the patent, controls in determining the legal effect to be given to two patents issued at different dates to the same inventor, and the order in which they are to be considered.

The Washburn & Moen M'f'g Co. *et al. v.* The Beat Em All Barbed Wire Co. *et al.* By *Brown, J.*, 29 Feb., 1892, 58 O. G., 1555, ✽.

11. A patent to a dead man is void.

A [so-called] "patent" issued in the name of an applicant who died while his application was pending and before issue, is void for want of a grantee.

In the case of the decedent James Boyle there was no grantee. The person named as grantee or patentee was dead at the time of the grant, and therefore there was no person to take the thing granted, and hence the grant never took effect.

The De La Vergne Refrig. Mach. Co. *v.* Featherstone *et al.*, *Blodgett, J.*, 29 Feb., 1892, 58 O. G., 1842.

Compare Stevens, x. p., (19) ASSIGNMENT; and Davis, x. p., (7) ATTORNEY.

See GOVERNMENT USE; INHERENT RIGHT; LIMITATION OF TERM; PUBLIC RIGHTS AND OBLIGATIONS.

PATENTABILITY.

1. Office action must conform to decisions of the courts.

In determining what does or what does not amount to a patentable invention in cases where the references do not disclose every feature of the alleged invention sought to be patented, recourse to the decisions of the courts, wherein such questions are considered, is necessary.

Jones, x. p., *Frothingham, Act. Com.*, 21 Dec., 1891, C. D. Ms.

2. An adaptation of an Old Device to a New Purpose which required inventive skill — patentable.

If an old device or process be put to a new use which is not analogous to the old one, and where the adaptation of the old device to the new use is of such a character as to require the exercise of inventive skill to produce it, such new use is patentable.

Ansonia Co. *v.* Supply Co. U. S. S. C. By *Brown, J.*, 14 Mar., 1892, 58 O. G., 1692, ✽.

3. Old Elements.—Combination.

Upon a rehearing of Johnston, x. p. (Johnston, x. p., (2) ORDINARY RESOURCES OF THE ART): *Held*, that the union of a grinding-wheel which disintegrates under a less heat than will draw the temper of steel, and of a water-supply, originated with the applicant, and that, by it, a new and useful result was attained; therefore that the union was patentable, reversing the former decision as to one of the claims, but sustaining it as to the other, in which the water-supply was not brought distinctly into the combination.

Johnston, x. p. (Re-hearing), *Simonds, Com.*, 18 Nov., 1891, C. D. Ms.

4. Useful Novelty.

A conceded difference of construction between the device claimed and the references cited, together with a clear advantage as a result of it, constitutes patentable novelty.

Scriven, x. p., *Simonds, Com.*, 9 Sep., 1891, 57 O. G., 1128.
Compare Schadi, x. p., (12) *infra.*

5. Public Adoption as a Test of Useful Novelty.

It appearing that the first general use of the device in question came from its publication by the patentee, and the court being in doubt whether the exact device had ever been hit upon by a prior inventor: *Held*, that the doubt should be resolved in favor of the patentee.

Washburn & Moen M'f'g Co. *v.* The Beat Em All Barbed Wire Co., U. S. S. C. By *Brown, J.*, 27 Feb., 1892, 58 O. G., 1555, ❁.

6. It is true that the affixing barbs to a fence-wire does not apparently give a wide scope to the ingenuity of the inventor; but, from the crude device of Hunt to the perfected wire of Glidden, each patent has marked a step of progress in the art. The inventions of Hunt and Smith appear to have been scarcely more than tentative, and never to have gone into general use. Between the Kelly fence and the Glidden fence the difference seems not a radical one, but, slight as it may seem to be, it was apparently THIS which made the barbed wire fence a practical and commercial success. The sales of the Kelly patent appear never to have exceeded 3000 tons per annum, while plaintiff's manufacture and sales of the Glidden device (substituting a sharp barb for a blunt one) rose rapidly from 50 tons in 1874 to 44,000 tons in 1886, while those of its licensees in 1887 reached the enormous amount of 173,000 tons.

Indeed, one who has travelled on the Western plains of this continent cannot have failed to notice the very large amount of territory inclosed by these fences which otherwise, owing to the great scarcity of wood, would have been left unprotected.

Under such circumstances, courts have not been reluctant to sustain a patent to the man who has turned a failure into a success. In the law of patents it is the last step that wins. It may seem strange that, considering the important results obtained by Kelly in his patent, it did not occur to him to substitute a coiled wire in place of a diamond-shaped prong, but evidently it did not; and the man to whom it did ought not to be denied the quality of inventor. There are many instances in the reported decisions of this court where a monopoly has been sustained in favor of the last of a series of inventors, all of whom were groping to attain a certain result which only the last one of the number seemed able to grasp.

Ib. ❁

Compare McClain *v.* Ortmayer, (7) *infra;* ❁ Spielman, x. p., COMMERCIAL SUCCESS.

7. While this court has held, in a number of cases, that, in a doubtful case, the fact that a patented article had gone into general use is evidence of its utility, it is not *conclusive* even of that, — much less of its patentable novelty. That the extent to which a patented device has gone into use is an unsafe criterion even of its actual utility, is evident from the well-known fact that the general introduction of an article is as often effected by extensive and judicious advertising, activity in putting the goods upon the market, and large commissions to dealers, as by the intrinsic merit of the article itself.

McClain *v.* Ortmayer, U. S. S. C. By *Brown, J.*, 2 Nov., 1891, 35 L. ed., 800, ❁.

8. Slight change satisfying a long felt want,— patentable.

Whenever, in an art, machine, manufacture, or composition of matter, a change, however minute, is made which is not obvious and which results in marked advantages, a patentable invention has been produced; and when such a change had remained unmade for a considerable time, in spite of inducements to make it by reason of its value, that is evidence approaching the conclusive that the change was not obvious.

Champney, x. p., *Simonds, Com.*, 13 June, 1892, 60 O. G., 1051.

Compare Smith *v.* Goodyear Dent. Vulc. Co., (1) ❁; Consol. Valve Co. *v.* Crosby, (2); ❁ THE DECISIVE STEP; Edison Elec. Co. *v.* The U. S. Elec. L't'g Co., (1) SUCCESS AS A TEST; also Loom Co. *v.* Higgins, (9) ❁; *infra.*

9. Patentability of a device that satisfied a long-felt want and answered all reasonable requirements.

In determining what constitutes invention and what is a new and useful result, a new function or a new sphere of action, the court will give weight to facts showing: —

(1) That the improvement, though desired for years, was not secured until brought out by the patentee.

(2) That the product of the new machine or process displaced, wholly or in a great degree, prior products.

(3) That while, from lack of cheapness or of adaptation, the prior products had been unsuitable, the new product answered all reasonable expectations.

Loom Co. *v.* Higgins, 105 U. S., 580, ❁. See, also, McClain *v.* Otmayer, 141 U. S., 419, ❁; and "The Barbed Wire Case," 143 U. S., 275, ❁; Watson *v.* Stevens *et al.*, U. S. C. C. of Appeals, 1st Circuit (before Gray, Colt, and Putnam, JJ.). By *Putnam, J.*, 6 Sep., 1892, 60 O. G., 1884, ❁.

10. Prior Art.

Strong doubt existing whether a certain feature of construction reached beyond mere mechanical skill, but lack of analogy appearing in the prior art, applicant was given the benefit of the doubt and application allowed.

Warner, x. p., *Simonds, Com.*, 28 Dec., 1891, C. D. Ms.

11. In deciding the question of patentability it is necessary to determine what differences, if any, there are of structure, of mode of operation, or of result, between the alleged invention for which a patent is sought and the state of the art as disclosed by the references.

Jones, x. p., *Frothingham, Act. Com.*, 21 Dec., 1891, C. D. Ms.

12. Reference must be positive, — not inferential merely.

Where the improvement was a very simple one, consisting in locating an ordinary circular enlargement of a lengthwise slot, at the foot of the slot instead of at the top, and the reference was a patent in which it was stated that "a circular enlargement is sometimes made in the slot *B* near one end or the other end, but this is not claimed here as original:" *Held*, that the word "near" meant near, and nothing else; that it did not mean at the end of the slot; and that the patented device would not work if the circular enlargement were made at the end of the slot, while, on the other hand, applicant's improvement was not practicable unless the enlargement was at the end.

Schade, x. p., *Simonds, Com.*, 18 Mar., 1892, C. D. Ms.
Compare Scriven, x. p., (4) *supra*.

13. Difference from known devices must be one of kind, not of degree merely.

Where the patent sued upon describes a method which differs only in degree, and not in kind, from a previously employed method, and where the utmost that can be said of the patented process is that it produces a somewhat more perfect article than was previously produced: *Held*, that the patented method involves no novelty within the meaning of the patent law.

Ansonia Co. *v.* Supply Co., U. S. S. C. By *Brown, J.*, 14 Mar., 1892, 58 O. G., 1692, ✿.

14. New use for analogous purpose not patentable.

The application of an old process or machine to a new and analogous purpose does not involve invention, even if the new result had not been contemplated.

Ib.

15. Where several inventors are striving for the same end, and all of them fall a little short of its attainment, the existence of that state of facts is practically conclusive evidence that he who attains the whole measure of success does so by doing something that was not obvious and that involved patentable novelty.

Shannon, x. p., *Simonds, Com.*, 21 Oct., 1891, 59 O. G., 297.

16. Benefit of the Doubt.

Where clear differences of construction between the device claimed and the references cited against it are such that a doubt is raised as to whether they constitute patentable invention, the applicant should have the benefit of it.

Fanshawe, x. p., *Simonds, Com.*, 10 Sep., 1891, 57 O. G., 1127.

17. Where invention is in doubt, the grant of a United States patent constitutes a presumption in favor of the patentable novelty of the device.

Where the question of invention is closely balanced, the presumption in favor of the patentee, arising from his recognition as an inventor by the United States Patent Office, will incline the court to sustain his patent.

Watson *v.* Stevens *et al.*, U. S. C. C. of Appeals, 1st Circuit (before Justices Gray, Colt, and Putnam). By *Putnam, J.*, 6 Sep., 1892, 60 O. G., 1884, ✿.

18. Reorganization and Simplification.

In one possible view of the claim it appeared as a mere aggregation of elements shown in the references, but regarded from another point of view there could be seen to be a useful and valuable reorganization and simplification which comprised a feature (rocking arm) that performed a double function: *Held*, that, although one might doubt whether applicant's improvement involved patentable invention, yet, on the other hand, the organization and simplicity are actually apparent, the double function of the rocking arm is clearly apparent, and the doubt should be resolved in favor of the applicant.

Prince, Jr., x. p., *Simonds, Com.*, 7 July, 1892, C. D. Ms.
See, of like purport, Ennis, x. p., PATENTABLE NOVELTY.

19. When Invention doubtful, — Protracted Nonuser, fatal.

The entire field of invention (nursery chairs) shown by the exhibits in the case, seems a dreary one nowhere enlivened by a single exhibition of the genius of invention, or even of "the happy thought" which, under the patent laws, sometimes answers in its place. . . . It

appears, by the evidence of the plaintiff, that although at the time he testified he had owned the patent for seven years, he had never put on the market a chair constructed to conform to it. A novelty which remains unused so many years in the hands of an extensive manufacturer exclusively engaged in the special trade to which it relates must be presumed, at best, to involve a very low degree of the useful novelty which the Patent Code of the United States requires. The bill was dismissed.

Waite *v.* Robinson *et al.*, U. S. C. C., D. Mass., *Putnam, J.*, 15 Sep., 1892, 60 O. G., 1888.

20. Antedating Reference.

The mere fact that an applicant can antedate a reference patent does not necessarily clothe his improvement with patentable quality.

White, x. p., *Mitchell, Com.*, 12 Sep., 1890, 54 O. G., 387.

21. Medicinal Compound.

Examiner rejected because mischievous or of doubtful utility: *Held*, if an article is incapable of any use whatever except a dangerous or an immoral one it is not patentable; but, if it be capable of *any* beneficial use it is patentable regardless of the fact that it may be used by ignorant persons to produce a harmful result, or by wicked persons to produce an immoral result. While, however, denying the Examiner's ground of rejection, it is suggested that the case may nevertheless be open to *the objection that the compound sought to be monopolized may be within the scope of the ordinary skill of the physician in prescribing remedies familiar to his profession.*

Crippen, x. p., *Fisher, Act. Com.*, 18 Feb., 1890, C. D. Ms.
Compare Nat. Aut. Device Co. *v.* Lloyd *et al.*, (23) *infra.*

22. Electrical (alleged) curative Device.

Before an apparatus for applying electricity as a curative agent can be patented as an electrical device, it must be clear that the effects are the result of electrical treatment by means of the apparatus and not the effects of expectant attention or imagination.

Sauche, x. p., *Frothingham, Act. Com.*, 24 Mar., 1892, C. D. Ms.

Compare Crippen, x. p., (21) *supra.*

23. Patent for a Gambling Apparatus adjudged invalid.

In an action for infringement of a patent for a "Toy Automatic Race Course," injunction, *pendente lite*, refused on the ground that it was not certain that it was a *useful* invention within the meaning of the patent law, inasmuch as the proofs showed that the only use it had been put to was for gambling purposes. The United States law authorizes the issue of a patent only for a new and *useful* invention, and in an early case on that subject (Bedford *v.* Hunt, 1 Mason, 302) it was held that the word "useful," as used in the statute, means such an invention as may be applied to some beneficial use in society in contradistinction to an invention which is injurious to the morals, health, or good order of society and the principle thus enunciated has been uniformly applied ever since.

National Automatic Device Co, *v.* Lloyd *et al.*, U. S. C. C., N. D. Ill. *Blodgett, J.*, 40 F. R., 89.

24. Patents should not, it seems, be granted for mere systems of keeping accounts or of penmanship and the like.

Dick, x. p., *Thacher, Act. Com.*, 26 July, 1872, 2 O. G., 148.

PATENTABLE COMBINATION.

In a patentable combination of old elements all must co-act with a new and beneficial result.

In a patentable combination of old elements, all the constituents must so enter into it as that each qualifies every other. It must form either a new machine of a distinct character and function, or produce a result due to the joint and co-operating action of all the elements, and which is not the mere adding together of separate contributions. The combination of old devices into a so-called new article, without producing any new mode of operation, is not invention (Pickering *v.* McCullough, 104 U. S., 310,✿).

Florsheim *et al. v.* Schilling, U. S. S. C. By *Lamar, J.*, 10 Nov., 1890, 53 O. G., 1737, ✿.

Compare Cocs, x. p., (1) *et seq.*, COMBINATION; also Railway Register M'f'g Co. *v.* 3d Ave. R. R. Co., (23) INVENTION.

PATENTABLE NOVELTY.

Simplification and Reorganization.

Where applicant's exact combination was not found in any of the references, and his combination was practically a simplification and reorganization of the construction in one of the references: *Held*, upon the showing made, that it was not clear that this simplification and reorganization did not involve invention, and the decision of the Examiners-in-Chief denying patentable novelty was reversed.

Ennis, x. p., *Simonds, Com.*, 22 Mar., 1892, C. D. Ms.
Compare Prince, Jr., x. p., (18) PATENTABILITY.

"PATENT MEDICINES."

A remedial compound which is nothing more than such a compound of medicinal agents as could be made by the exercise of the skill of a physician, is not patentable.

Crippen, x. p., *Fisher, Act. Com.*, 24 May, 1890, C. D. Ms.

NOTE. — It is, perhaps, almost needless to say that the phrase "*Patent Medicine*" ordinarily applied to remedial nostrums generally is a complete misnomer. Of the innumerable "proprietary preparations" seen in every modern drug-store, very few are patented, for two valid reasons, either of them sufficient, namely: —

(1) A patent would necessarily divulge the ingredients, a thing which no concocter of proprietary merchandise was ever known voluntarily to do.

(2) Although our statutes do not expressly exclude medicinal compounds (as the patent laws of some countries do), the records show that but few applications therefor eventuate in patents, for reasons akin to those set forth in the case of Crippen, x. p., above cited.

Compare Sauche, x. p., (22) PATENTABILITY; and McClain *v.* Ortmayer, (2), ✽, PUBLIC ADOPTION.

PENALTY.

1. A penalty of "not less" than $100, with cost of suit, is incurred by the marker of *each* unpatented article with the word "Patent" or like phrase with intent to deceive the public, or by one who makes unauthorized use of a patentee's mark.

R. S. 4901.

2. If a person marks an unpatented article with the word "patent," the public are thereby liable to be deceived as to the character and value of the article. The act is a species of counterfeiting. This being so,

the presumption is, until the contrary appears, that the mark was placed upon the article with intention to deceive. *Falsehood is a badge of fraud.*

Oliphant *v.* Salem Mills Co., *Deady, J.*, 1878, 5 Sawyer, 128.

3. Where it is sought to recover a penalty for improperly stamping an article as patented, the penalty is incurred if he who affixes the stamp does so in entire ignorance of whether the article is patented or not.

Thompkins *v.* Butterfield, *Nelson, J.*, 1 Oct., 1885, 33 O. G., 758.

4. Under the statute anybody is privileged to bring an action against the marker of an unpatented article with the word "patent." If the jury find that the person who marked such articles did so with deceptive intent, then all other questions are impertinent, and it is the duty of the jury to find a verdict of guilty. The jury have a right to infer from the evidence whether this is a patented or unpatented article, and the fact that there is no evidence of a patent is to be taken into consideration.

Kass *v.* Hawlowetz, *Brown, J.*, 10 Ap., 1885, 33 O. G., 1135; and 33 O. G., 1499.

See also Hawlowetz *v.* Kass, *Wallace, J.*, 24 Nov., 1885.

PETITION, see JURISDICTION; PRACTICE IN THE PATENT OFFICE.

PERFECTING INVENTIONS.

The law, while it requires that the original projector be diligent in perfecting his invention, is indulgent of some delay in seeking the Patent Office due to the inventor's desire to overcome all defects and to test the truth of his theory.

Where an inventor of a device as important as that in controversy, who has been diligent in reducing his

invention to practice, and in attempts to bring his machine to the knowledge of the public has merely paused, before applying for his patent, for a period of nineteen months after completing his working drawings, and ten months after he completed his machine; I cannot say that there were such *laches* as should deprive him of the reward which ordinarily attends priority of invention. Our inventors are more apt, I suppose, to go into the Patent Office with incomplete inventions than to wait too long after experiment has achieved perfection. A decision which should compel haste in applying for patents before actual practice has tested the truth of the inventor's theory and has overcome difficulties in the operation of mechanism, would, I think, be productive of more injury than a decision which, while compelling diligence in perfecting the invention, was indulgent of some delay in seeking the Patent Office.

Hubel *v.* Dick and Hubel *v.* Tucker, *Shipman, J.*, 16 July, 1886, 36 O. G., 939.

See also City of Elizabeth *v.* Nicholason Pavement Co., 24 U. S., 1000; and 97 U. S., 126, ✱; and Hunter *v.* Miller, *Mitchell, Com.*, 13 Mar., 1890, 50 O. G., 1765.

See ABANDONMENT; CONSUMMATED INVENTION; DILIGENCE; INTERFERENCE; INVENTION; INVENTIVE ACTS; PUBLIC USE; REDUCTION TO PRACTICE.

PERSONAL NAME.

1. Arbitrary use of applicant's name to designate a class of manufacture forbidden.

Where the applicant employed in the specification the words "Forbes Combined Slide Hinge-Joint," to designate a certain slide joint of which he believed himself the inventor, and which was a part of the machine for which he sought a patent, but there was no proof that

the joint had become known in the art by that name: *Held*, that the Examiner was correct in requiring the name to be eliminated. If the use of such an expression is ever permissible, it is only when the machine or mechanism referred to has become commonly known by such name in the prior art.

Forbes, x. p., *Mitchell, Com.*, 14 Oct., 1889, C. D. Ms.

2. Where, in the petition and in the preamble of the specification, the inventor's name was used to designate the alleged invention, and *it did not appear that the machines alluded to were commonly known in the art or trade by the name referred to: Held*, that the utmost that could be allowed under such circumstances was that the applicant should be permitted to say that the machine of which his present invention is an improvement is the one for which an application for letters-patent has been filed by himself.

Ib.

Compare Street, x. p., (6) PHRASEOLOGY.

PETITION.

1. Where applicant believes that the Examiner has improperly declined to incorporate matter within the recommendation of the Examiners-in-Chief, his remedy is by petition to the Commissioner (Holt, x. p., 1887, C. D. 4).

Roberts, x. p., *Mitchell, Com.*, 18 Dec., 1890, C. D. Ms.

2. Should be explicit.

A petition under Rule 145 should set forth "concisely and clearly" the action complained of, and, if it does not, it cannot be amended by presenting in the brief what should have been presented in the petition, for the

reason that the Examiner's statement is filed in reply to the petition.

Wilson, x. p., *Mitchell, Com.*, 17 Mar., 1891, C. D. Ms.

PHRASEOLOGY.

1. Latitude of Choice permitted.

There is a permissible latitude of choice in the use of language which may be safely accorded to the inventor or his solicitor without violating the statute, and without detriment to that branch of the public service which has for its object, not only to grant letters-patent for new inventions, but, to grant them at the earliest possible date.

Pacholder, x. p., *Mitchell, Com.*, 26 Ap., 1889, 51 O. G., 295.

Compare, of like purport, Myers, x. p., (21) AMENDMENT; Gray & Reynolds, x. p., (2) APPLICANT; Holt, x. p., (1) NEW MATTER; and Noyes, x. p., (9) SPECIFICATION.

2. Applicant may describe his invention in his own way.

Where the terms employed by applicant are not misleading, the mere fact that the Examiner regards other terms as more desirable is not a sufficient reason for insisting upon them, although the latter may be of more general acceptation.

Wharton, x. p., *Frothingham, Act. Com.*, 18 June, 1892, C. D. Ms.

3. Applicant's Phraseology sustained.

An objection that there was no such device as a "projection," and that the trigger was operated by a "stud" not a "lever:" *Overruled*, as it was clear that, by the word "projection" was meant "lever," and that the stud was a part of the lever.

Thompson & Thompsou, x. p., *Frothingham, Act. Com.*, 25 Jan.. 1892, C. D. Ms.

4. Question of Form subordinate to Question of Right.

An applicant cannot be rightfully denied adequate protection for his invention merely because *the form* of his claim differs from what is considered to be that of an ideal process-claim (Painter, x. p., 57 O. G., 999).

Vorel, x. p., *Frothingham, Act. Com.*, 15 Feb., 1892, C. D. Ms.

Compare Noyes, x. p., (9) SPECIFICATION; Cheeseborough, x. p., (6) RE-OPENING OF CASE.

5. Inventor's rights should not be prejudiced by imperfections of the English language.

When a man has made a new and useful invention, his right to a patent for it, or his right to a claim properly defining it, is not to be determined by the limitations of the English language.

Painter, x. p., *Simonds, Com.*, 9 Nov., 1891, 57 O. G., 999.

Compare Ambler, x. p., (2) PIONEER INVENTION.

6. Arbitrary Name refused.—Trade-mark.

The Examiner objected to the use of a term which was purely arbitrary and had no accepted meaning, but the applicant believed it advisable for the material to have a name, and that he was the proper person to name it: *Held*, sustaining the objection,—if applicant desired a trade-mark for the term, he should apply for it in the proper way.

Street, x. p., *Frothingham, Act. Com.*, 23 Feb., 1892, C. D. Ms.

Compare Forbes, x. p., (1), (2) PERSONAL NAME.

7. A Matter of "Form."

The Primary Examiner is not estopped from objecting to the description of a device by the fact that the Examiners-in-Chief had, upon appeal, allowed the claim covering the device; for the Examiner's objection, being

one of form, was not properly before the Examiners-in-Chief for consideration on appeal.

Robbins, x. p., *Frothingham, Act. Com.*, 21 Aug., 1891, C. D. Ms.

8. Structure of Claim.

The Examiner objected to the claims on the ground that they "comprise merely a catalogue of the various parts without setting forth their structures, connection, and relation:" *Held*, that the criticism appeared to be substantially correct, and it would probably be for applicant's best interest to revise them in accordance with the suggestion contained therein; but, as the objection did not appear to be vital, if applicant wished the claims to remain in that form he should not be denied them, except for reasons on which a rejection might be based.

Wharton, x. p., *Frothingham, Act. Com.*, 18 June, 1892, C. D. Ms.

PIONEER INVENTION.

1. Permissible Language, — "Means;" "Mechanism."

The decisions indicate that the question whether or not a pioneer inventor is entitled to claims covering his invention broadly by the use of such terms as "means" and "mechanism" is one which is to be determined with reference to the prior state of the art, and that no requirements as to form should be insisted upon which would prevent an applicant from obtaining claims commensurate with his invention in view of such prior art. (See Laskey, x. p., 48 O. G., 539; Ambler, x. p., C. D. 41 Ms. 209; Nordenfelt, C. D. 42 Ms. 141; and Sewing M. Co. *v.* Lancaster, 129 U. S., 263; 32 L. ed., 715, ✽).

Pearson, x. p., *Frothingham, Act. Com.*, 2 Ap., 1892, C. D. Ms.

Compare Nordenfelt, x. p., (5) "MEANS;" also Clouser, x. p., (4) "MEANS," and other cases there cited.

2. "Mechanism."

Where the Examiner admitted that the invention did not reside in the *word* "mechanism," but insisted that, so far as the claims indicated, the word "mechanism" designated that portion of the claims in which the novelty resided, and that, inasmuch as there were no qualifying words setting forth construction or mode of operation, the claims were indefinite: *Held*, that the question was not free from difficulty; that it was extremely doubtful whether the claims should be interpreted in the light of the doctrine as announced with reference to the 13th claim in the case of Pacholder, x. p., (51 O. G., 295), or whether they should be interpreted in the light of the doctrine as announced in the cases cited in par. 15, *supra*, and inasmuch as the case was so near the border line between the doctrines as announced in the cases cited, and as the issue raised between the Examiner and the applicant was so nearly allied to questions relating to the "*merits*" of the case; *further held* that the more advisable course was to direct the Examiner to reject the claims if they were, in his opinion, too broad in view of the state of the art, or if they merely covered a result, than to compel applicant to limit his claims to such an extent as to make his invention an easy prey to the infringer. The claims were held to be intelligible.

Ib.

3. Where no references are found, the petitioner is entitled to the application of whatever rule is appropriate to pioneer inventions, and no questions of form are to be antecedently insisted upon which are inconsistent with the allowance of the broadest claims to which the creator of a new machine or art is entitled. Such a case distinguished from Demming, x. p., (26 O. G., 1207).

Ambler, x. p., *Mitchell, Com.*, 31 Oct., 1889, C. D. Ms.

Compare Dalton (7) INVENTION.

4. Broad Construction, — how affected by Ambiguity.

Claims ambiguous in their phraseology or to performances, functions, results, to abstract ideas or principles without reference to specified instrumentalities, are inadmissible and ought not to be granted.

Sangster *v.* Miller, *Nelson, J.*, 2 Fish., 563. See, also, Continental Windmill Co., x. p., *Duncan, Act. Com.*, 27 July, 1870, C. D. 74; Barrett, x. p., 1888, C. D. 142; Rubens & Co., x. p., *Fisher, Com.*, 6 Dec., 1869, C. D. 107; Sherwood *v.* Searles, *Fisher, Com.*, 20 Dec., 1869, C. D. 112; Simonds, x. p., *Fisher, Com.*, 14 Mar., 1870, C. D. 23.

5. Yet, rather than invalidate or weaken a patent for an important invention, courts have usually, — where the language of the claim makes it at all possible, — endeavored to construe such claim, in the first place, to mean the instrumentalities or devices described in the specifications, and, in the second place, to accord it such scope as to dominate all substantially equivalent devices even though improvements on the original.

Dolbear *et al. v.* Am. Bell Telephone Co., 19 March, 1888, 43 O. G., 377, ❁.

See, also, Lull *v.* Clark *et al.*, *Blatchford, J.*, 8 Aug., 1882, 22 O. G., 1535; Morley Machine Co. *v.* Lancaster, 4 Feb., 1889, 129 U. S., 263, ❁; Smith and Egge M'f'g Co. *v.* Bridgeport Chain Co., *Shipman, J.*, 56 O. G., 1451; Worswick M'f'g Co. *v.* City of Buffalo, *Coxe, J.*, 8 May, 1884, 27 O. G., 1239.

See, however, O'Reilly *v.* Morse, 15 Howard, 1862, and Detwold *v.* Reeves, *Kane, J.*, Sep., 1851, 1 Fish., 127.

PLEADING.

1. Averments in Bill.

A bill for infringement of letters-patent must state that the invention had not been in public use or on sale for more than two years before the application therefor.

It is not sufficient to state that it was not in public use or on sale with the consent of the inventor (following Blessing *v.* Copper Wks., 34 F. R., 753).

Coop *v.* Savage, etc., U. S. C. C., S. D. N. Y., *Shipman, J.*, 47 F. R., 899.

2. Demurrer, — General and Special.

While an averment in the bill that the patentee was "the first inventor of the improvement, and that it had not been known or used before his said invention," is sufficient to withstand a general demurrer, yet the omission of an averment that it had not been previously patented or described in a printed publication, is a defect in form, which may, however, be reached by special demurrer and should be remedied by amendment.

Ib.

3. Scandalous Answer.

An answer which alleges that complainant's patent "was obtained by trick, artifice, and deception, and with the knowledge of the Commissioner," said allegation being made after a judgment in defendant's favor in interference proceedings concerning that identical invention, is not scandalous or impertinent.

Acaubert *v.* Appleton, U. S. C. C., S. D. N. Y., *Coxe, J.*, 47 F. R., 893.

4. Multifariousness.

A bill which claims relief because of an alleged interference between the patents of the complainant and the defendant, and also because of defendant's alleged infringement of complainant's patent, is not multifarious.

Stonemetz Co. *v.* Brown Co., U. S. C. C., W. D. Pa., *Reed, J.*, 46 F. R., 72.

POWER OF ATTORNEY.

Underlying Principle of Equity.

L and *J* have a joint application for a certain improvement on which there is at present no attorney of record.

L has a subsequently filed sole application for the same improvement with attorneys duly appointed.

J, — together with *C*, an assignee of *L*, — now present a paper appointing as attorney, in the former of these applications, an agent who has never before appeared in either.

The underlying principle of equity warrants the approval of the power of attorney presented by *J* and *C*, and it is accordingly approved and accepted.

L. W. Benjamin and J. S. Bailey, x. p., *Simonds, Com.*, 1 Mar., 1892, 59 O. G., 298.

See ATTORNEY.

PRACTICAL DEMONSTRATION.

1. Applicant's Choice of two Courses.

Where Examiner's requirement that a working model or other practical demonstration of petitioner's alleged invention be furnished seemed reasonable and proper: *Held*, that there were only two courses open to the petitioner, — he should either make a demonstration of the operativeness of his invention, or demand a rejection from the Examiner upon the ground of inoperativeness.

Corson, x. p., *Fisher, Act. Com.*, 19 Ap., 1890, C. D. Ms.

Compare Street, x. p., ANALYSIS; also Perkins, x. p., (2) *infra*.

2. To negative Inoperativeness.

An objection that the mechanism disclosed is inoperative can be enforced in either of two ways. The Exam-

iner can either reject on the ground of inoperativeness subject to appeal to the Examiners-in-Chief, which is the best course, or he may require a practical demonstration. Applicant's objection that it would not be possible for him to make a practicable demonstration without infringing certain patents was not received as a valid excuse. The Assistant Commissioner was not willing to admit that such a demonstration would be held by the courts to constitute an infringement.

Perkins, x. p., *Fisher, Act. Com.*, 28 June, 1890, C. D. Ms.
Compare Corson, x. p., (1) *supra.*

3. When required.

Mere difficulty in examination is not sufficient ground for compelling an applicant to incur the expense of a model. The policy of the Office is *not to require a model* except when it is practically impossible to examine a given case without one.

Daudeteau x. p., *Fisher, Act. Com.*, 25 June, 1890.
Compare Corson, x. p., (1) *supra.*

PRACTICE IN THE PATENT OFFICE.

1. Objections that a claim is drawn to a bad combination, or that it is for an aggregation, or that it does not involve invention, pertain to "the merits," and an appeal lies to the Examiners-in-Chief.

Objections that a claim is indefinite, or that certain claims are substantially identical, pertain to "form," and a petition lies to the Commissioner.

The following practice is prescribed in the treatment of *ex parte* cases: —

(1) The first action (unless there are vital objecti s as to form) should state *all the objections* to every part of the application, and *the best references should be cited.*

(2) The application as a whole should not be rejected, but only the claims thereof.

(3) Rejection should be in plain, unmistakable terms, and the word "*reject*" should be used.

(4) Final rejection should not be given until all matters of form are settled.

(5) Final rejection should not be given until all the non-allowable claims are ready for such action.

Eastman, x. p., *Simonds, Com.*, 9 Oct., 1891, 57 O. G., 410.

2. Wherever practicable, Office action should be predicated on the Statutes and the Rules of Practice.

Interferences arise and are declared under the Statutes and the Rules of Practice [not under decisions], and, although the decision in Upton, x. p., is a very celebrated one, the practice of referring to it in declaring interferences which has heretofore obtained, to a limited extent, is one which is not to be commended, and should be wholly discontinued.

Boetney *v.* Curtis *v.* Kutsche, *Mitchell, Com.*, 1 Dec., 1890, C. D. Ms.

3. Change of Practice.

Where a decision of the Patent Office or other tribunal cannot be reconciled with the ruling of a superior tribunal or one of its own earlier rulings on the same state of facts, such decision, in accordance with a well-known principle of law, must be taken to mark a change in the practice to which subsequent actions must necessarily conform; this is very notably the case when such departure is taken with the object of making the Patent Office procedures conformable with some ruling of a United States Court, or with the provisions of some new Federal statute. This latter aspect of the case was clearly stated by Commissioner Simonds in case of Penny *v.* Gunn (13 Aug., 1891). Illustrations of this fundamental principle of law are given by Blackstone in such passages as: "Of two repugnant clauses in a will, the latter shall stand" (2 Com. 381); and, "Where the common law and

a statute differ, the common law gives place to the statute, and an old statute gives place to a new one; and this upon a general principle of universal law that '*leges posteriores priores contrarias abrogant*,' consonant to which it was laid down by a law of the Twelve Tables of Rome that '*quod populus postremum jussit id jus ratum esto.*'"

1 *Blackstone, Com.*, 89.

See COMMISSIONER, ETC.; EXAMINATION; EXAMINER; OFFICE PRACTICE.

THE PRELIMINARY STATEMENT.

1. Return to Applicant — refused.

Where a preliminary statement had been filed by the senior party to an interference, but not used for the reason that the junior party's statement failed to overcome the filing date of the senior party's application, a petition requesting a return of the preliminary statement was denied without prejudice, because the rules require that a preliminary statement shall be filed, but make no provision for their return.

NOTE. — The Assistant Commissioner remarked, however, that in a case like the one under discussion there seemed no reason for the Rule 112 requiring retention of the preliminary statement; but that, as no brief had been filed and no argument made in support of the petition, it might be that, upon a full discussion of the question, other considerations might be presented which might lead to a modification of his views.

Baxter, x. p., *Frothingham, Act. Com.*, 10 June, 1891, C. D. Ms.

See 26, 27, 28, 29 INTERFERENCE.

2. Amendment Refused.

In discussing debatable questions it sometimes becomes profitable in a high degree to recur to fundamental prin-

ciples. Human tribunals do not proceed on the theory that they do exact justice to every suitor. That result is only possible to Omniscience. Human tribunals proceed on the theory that they do substantial justice in the great majority of cases. Certain well-known laws are based on that theory, with the full knowledge that they sometimes necessarily work injustice. . . . A preliminary statement in an interference case is based on the same kind of theory. It is a thing healthful for general application, but it must sometimes work a hardship in a particular case. But if, after the junior party has taken his testimony, the senior party, who has already once amended his preliminary statement, can again amend his preliminary statement by the addition of facts presumably within his knowledge at the time when the statement was originally filed, the rule requiring preliminary statements might as well be abrogated, and this irrespective of the question whether the new averment be true or false.

Washburn *v.* Hadfield, *Simonds, Com.*, 10 Dec., 1891, 57 O. G., 1719.

3. Motion to amend a preliminary statement after a delay of four months and a half, denied.

Gornall *v.* Lovejoy, *Simonds, Com.*, 12 Aug., 1891, 56 O. G., 927.

See EXAMINER; COMMISSIONER; INTERFERENCE.

PRESUMPTIVE PATENTABILITY.

In the absence of satisfactory evidence to the contrary, the subject-matter of every patent is presumed to be useful and patentable.

Mesker *et al. v.* Thuener, *Thayer, J.*, 30 Oct., 1889, U. S. Cir. Ct., E. D. Mo., 42 F. R., 329.

PRESUMPTIVE REDUCTION TO PRACTICE, see CONSTRUCTIVE REDUCTION TO PRACTICE.

PRIOR ART.

1. In pointing out the advantages of his invention, the applicant may refer generally to defects of pre-existing devices, but is forbidden to particularize such devices by name.

In the cases of Dodge, x. p. (Dec., 1889, M. S. 36), and Williams, x. p. (1872, C. D. 46), each applicant had undertaken to show the superiority of his own invention by comparing it with other inventions which were indicated directly by name, and by pointing out the respects in which they had wholly or partially failed. Elimination of such references was properly demanded; but a broad distinction is to be made between statements derogatory to the inventions of others clearly designated by the name of the inventor, or otherwise, and that permissible criticism of the prior art generally which an applicant may deem necessary in order to appropriately set forth the advantages growing out of his own invention. It may be difficult to draw the line; but the line must be drawn, and it must be held that, within reasonable limits, an applicant may, in pointing out the advantages of his invention, point out also what he regards as the defects or deficiencies common to the structures representing the unimproved art.

Shaw, x. p., *Mitchell, Com.*, 12 Feb., 1890, 50 O. G., 1129.
Compare Wiles & Wendell *et al.*, (5) *infra*.

2. Former Patent of Applicant.

Where the Examiner cited against applicant's application filed 21 June, 1888, a patent issued to him 10 July, 1888: *Held*, that it was error to treat a patent to the same party as a part of "the prior art."

Rogers, x. p., *Simonds, Com.*, 9 Mar., 1892, C. D. Ms.
Compare Hill & Prentice, x. p., (1) DEDICATION.

3. History of the prior art permissible to show that the changes were not obvious.

The subject-matter was a glove, and it was found that, while the advantage attained by applicant was fairly apparent, it also needed but little effort to find the claim met by the prior art, but the fact that the trouble which the improvement was designed to cure was one that had been made apparent by common experience, and was of such a nature that it would have been cured long ago if the mode of effecting the cure had been obvious and easily apparent, was held to make strongly in applicant's favor, and the claim was allowed. The difference over the prior art which applicant had obtained was not considered a large difference, but, nevertheless, capable of definition and highly useful in character.

Lee, x. p., *Simonds, Com.*, 15 June, 1892, C. D. Ms.

4. Where the change in form and proportion over the prior art brought with it substantial advantages, and the history of the development of the art showed that those changes were not obvious: *Held*, that the invention was patentable.

Condict, Jr., x. p., *Simonds, Com.*, 3 June, 1892, C. D. Ms.

5. General comparison with prior state of the art proper.

The Examiner required that, if applicant undertook to set forth the prior art, he should set forth the advantages of his machine over pre-existing ones nearest his construction: *Held*, that the Examiner's requirement was proper, as it did not appear that he intended the statement to be based on a certain specified patent.

Wiles & Wendell, x. p., *Frothingham, Act. Com.*, 15 Feb., 1892, C. D. Ms.

PRIORITY IN THE INVENTION.

1. The law favors that inventor to whom the public is indebted for the thing invented in working form.

The policy of the patent-law is to reward the man from whom the public actually derives the benefit received, unless, in fact, another, prior in conceiving the invention, was proceeding to give it to the world [and did so give it] with no greater delay than what was imposed by circumstances beyond his control.

Mouce *v.* Adams, *Duncan, Act. Com.*, 14 Ap., 1872, 1 O. G., 1.

2. The first to conceive is held to be the true inventor if he follows up the conception by diligent embodiment of the invention in an operative machine.

Invention is not the work of the hands but of the brain. The man who first conceived the complete idea of the improvement and gave evidence of the fact by representing the device on paper [or in a model], or by a clear and undisputed oral explanation, is the first inventor, but to perfect his rights of priority, the law requires that he shall either have been the first to file an application, or if he was not the first to file application, that he shall have used due diligence in so doing or in embodying his idea in a practical working machine.

Edison *v.* Foote & Randall, *Leggett, Com.*, 25 Mar., 1871, C. D. 80.

3. The primary object of the patent laws is to encourage invention, but just the opposite effect is produced if an inventor is to understand that after he has completed an invention, obtained his patent upon it, and been to the expense of bringing it before the public demonstrating its practicability, and creating a demand for it, he may then be ousted from his rights in it by

some person who invented the same thing before he did, but, for want of confidence in it or other cause, put it aside, and left him to the expense of introducing it to the world and showing its value.

Disston *v.* Emerson, *Leggett, Com.*, 6 June, 1871, C. D. 162.

4. But exception from this rule is made in favor of the one last to mature the invention if he had been the first to conceive and had used reasonable diligence.

Monce *v.* Adams, 1 O. G., 1.

5. The patentee, having put the public in complete possession of the invention in his specification, has fulfilled his part of the contract.

The grant of a patent having once been perfected, the inventor has fulfilled his part of the contract by thus placing the public in possession of a complete knowledge of the invention, and it matters not whether or not he has reduced the invention to [actual] practice, for the grant itself supplies the place of such embodiment, and, in order to enable an applicant to succeed in defeating the title already conferred, he must show: (a) that he was first to conceive of the nascent invention; (b) that he was using reasonable diligence in reducing the same to practice; and (c) that he had actually embodied the invention in working form at the date of his competitor's reduction to practice [either actual or constructive].

Burr *v.* Duryee, U. S. S. C. By *Grier, J.*, 28 Mar., 1864, 68 U. S., 531; see, also, Busha *v.* Phelps, *Doolittle, Act. Com.*, 18 Aug., 1876, 9 O. G., 1010; Stephenson *v.* Goodell, *Duell, Com.*, 3 June, 1876, 9 O. G., 1195; Dickson *v.* Kinsman, 18 O. G., 1225.

Compare Lorraine *v.* Thurmond (8) *infra*.

6. Proof that an invention was made in this country prior to the date of the foreign patent is sufficient to establish priority in an interference.

Chambers *v.* Duncan, *Doolittle, Act. Com.*, 16 Feb., 1877, 10 O. G., 787.

7. *A* was first to conceive and first to apply for a patent. *B* was first to reduce to practice, and, for nearly a year prior to *A's* application had been making and selling articles embodying the invention. Several years of neglect on the part of *A* had intervened between his conception and application, including the period after *B* entered the field: *Held*, *B* was the first inventor and entitled to a patent, although a patent had previously been granted to *A*.

Manny *v.* Easley *v.* Greenwood, *Mitchell, Com.*, 16 Aug., 1890, 51 O. G., 1617.

8. Actual reduction to practice is not the only competent evidence of perfection and adaptation to use; the inventor's act in being the first to enter the Office, with an allowable application, is regarded in law as such an efficient and crowning step as to give it the standing of an invention so perfected and adapted.

Lorraine *v.* Thurmond, *Mitchell, Com.*, 4 June, 1890, 51 O. G., 1781.

9. The general rule is that he who is the first to conceive of an invention is entitled to a patent for it if he reduces the same to practice with reasonable diligence; but, if he does not reduce to practice with reasonable diligence, he who is subsequent to conceive but first to reduce to practice will prevail (Reed *v.* Cutter, 1 Story, 590).

Hunter *v.* Jenkin, *Simonds, Com.*, 12 Sep., 1891, 56 O. G., 1705.

10. The perfected invention may be abandoned to the public, but cannot be forfeited to a subsequent inventor.

He is the prior inventor and is entitled to the patent for an invention who first embodies it in a complete,

practical, working utensil and exhibits it in public, though another afterward reduces it to practice and applies for a patent before him. After such an embodiment of an invention, delay in applying for a patent can operate only as an abandonment of the invention to the public; it is not forfeited thereby in favor of a subsequent inventor.

Rice *v.* Winchester, *Leggett, Com.*, 3 Ap., 1873, 3 O. G., 348.

11. When a prior inventor has carried his invention as far as a subsequent one has carried his before applying for a patent, the prior inventor must have perfected his invention if the latter has, and it is either true that the invention is not perfected in law or else that the last inventor is anticipated.

Gray *v.* Hale, *Duncan, Act. Com.*, 27 May, 1871, C. D. 129.

12. Preponderance of Evidence.

The question of priority of invention is determined by a fair preponderance of evidence, and doubts raised as to accuracy of witnesses upon certain minor points are not sufficient to overcome it.

Wilson *v.* Haines, *Simonds, Com.*, 10 Oct., 1891, 57 O. G., 1278.

13. Foreign Patent to same Applicant.

In an interference between an application and a patent, where the applicant relies on a description in a foreign patent granted to him, and it is clear that the invention therein described has the advantage of priority: *Held*, that if the application, when limited to that which is set forth in said foreign patent, contains anything patentable over the prior art, applicant's right to a patent thereon is in no way affected by the patent

in interference (quoting and construing former decision, 54 O. G., 1711).

Deprez *et al. v.* Bernstein *v.* Hunter *v.* Gaulard *et al.*, *Mitchell, Com.*, 31 July, 1891, 18 O. G., 1553.

14. Foreign Transactions.

It is now settled that, as a rule, what transpires abroad is not to be considered in deciding the question of priority of invention, and where it was contended that *A* having shown a conception in this country to begin with, his subsequent actions, although performed abroad, could be considered in evidence: *Held*, that whether or not the proposition be sound in general, it could not have effect in a case where the Office had denied his opponents an opportunity to take testimony abroad to show the character of the transactions there, on the ground that such testimony would be immaterial.

Ligowski *v.* Peters *v.* Hisey, *Simonds, Com.*, 15 Oct., 1891, C. D. Ms.

NOTE. — The only things excepted from the above general rule are foreign patents and printed publications.

See CONCEPTION; CONSTRUCTIVE REDUCTION TO PRACTICE; DILIGENCE; INTERFERENCE; REDUCTION TO PRACTICE.

PRIOR PUBLICATION.

1. To invalidate a patent, a prior publication must set forth the invention as completely as required in the specification of a patent.

When the defence relied on is that the patented invention had been described in a printed publication before the patentee's invention thereof, the sufficiency of the publication as an anticipation must be determined by the rule laid down in the case of Seymour *v.* Osborne (11 Wallace, 516,*), and that of Cohn *v.* U. S. Corset Co. (93 U. S., 696,*). The construction put, in those

cases, upon the words "described in any printed publication in this or any foreign country," appearing in Section 7 of the Act of 1836 (5 Stat., 117), in reference to the same subject, is equally applicable to the similar expression made use of in Section 24 of the Act 1870. But the description relied on must be in such full, clear, and exact terms as to enable any person skilled in the art or science to which it relates to make, construct, and practise the invention.

Downtown *v.* Yeager, U. S. S. C. By *Woods, J.*, 7 May, 1883, 25 O. G., 697, ✽.

See Borden, x. p., *infra;* and Parker *v.* Stiles, (1) ANTICIPATION.

2. An unpublished drawing is not sufficient reference.

It would seem that the merit of novelty should not be denied to a device upon reference to a mere (unpublished) drawing not accompanied by an explanation.

Robbins, x. p., *Thacher, Act. Com.*, 12 Nov., 1872, 3 O. G., 292.

3. A *published* drawing which completely discloses the invention may be cited as reference.

Even without any description, if a published drawing fully and clearly exhibits and discloses an invention sought to be patented, it is an adequate and complete reference in itself alone, and is to be considered as a "publication."

Borden, x. p., *Butterworth, Com.*, 17 Jan., 1884, 26 O. G., 439.

NOTE (i.) — On this difficult question authorities differ, but (assuming the rule for granted patents applies equally to applications) seem to preponderate in denying that a drawing alone, no matter how complete, and even if published, can constitute sufficient reference. See Parker *v.* Stiles, (1), Thayer *v.* Hart, (5), New Process Fermentation Co. *v.* Koch, and Seymour *v.*

Osborne, ❁, (8), Parsons *v.* Colgate, Judson *v.* Cope, Reeves *v.* Keystone Bridge Co., and Atterbury, x. p., (9), and Buhlman, x. p., (25), ANTICIPATION.

NOTE (ii).— It will scarcely be contended that a good model is inferior, as evidence, to a drawing, yet tribunals invariably refuse to recognize a model alone as an anticipation of a completed invention. Stephenson *v.* Goodell, and Millward *v.* Barnes, (1), Bury *v.* Thompson, (2), Schmiedl *v.* Booth, (3), Packard *v.* Sandford, (6), REDUCTION TO PRACTICE; Green *v.* Hall *v.* Siemens *v.* Field, (6 and 7) MODEL.

PRIVILEGED APPLICATIONS.

What are and what are not.

Congress, by requiring all applications for patents to be filed in the Patent Office, and then directing that all applications which are discovered to interfere with caveats shall be deposited in the confidential archives (Sec. 4902 R. S.), makes such applications privileged, and amounts to an implied declaration that all other applications shall not be privileged.

Edison Elec. Lt. Co. *v.* U. S. Elec. Lighting Co., U. S. C. C., S. D. N. Y., *Lacombe, J.*, 5 Jan., 1891, 45 F. R., 55.

PROCESS.

1. "Process," under the Patent Law, defined.

A process is a mode of treatment of certain materials to produce a given result. It is an act or a series of acts performed upon the subject-matter to be transformed or reduced to a different state or thing.

Cochrane *v.* Deener, U. S. S. C. By *Bradley, J.*, Oct. term, 1876, 24 U. S. (4 Otto), 780, ❁.

Compare Corning *v.* Burden, ❁, (1) ART.

2. It is of the very essence of a patentable process that it shall exist and be capable of conception and

operation independently of the apparatus by which it may be carried out.

Crane *v.* Meriam, *Mitchell, Com.*, 31 May, 1890, C. D. Ms.

3. Result.

The result which it produces is a test always to be applied when a question of invention is to be considered, and the law ordinarily presumes the existence of the inventive faculty when a great advantage results from the operation of a particular process.

Goodwin, x. p., *Fisher, Act. Com.*, 10 June, 1890, C. D. Ms.

4. A process, new in one step of it, is patentable.

If one of the steps in a process consisting of a combination of process-steps is novel for the purpose in hand, it gives novelty to the process considered as a whole, and, although the process may be a very simple one, simplicity does not negative invention, and marked utility in result coupled with novel process-step, is evidence of patentability.

Kalteyer & Bartholomew, x. p., *Simonds, Com.*, 18 Aug., 1891, 57 O. G., 1127.

5. Where the separate heating of certain vapors was specified in each of the process-claims as one of the steps in the process, and none of the references disclosed that step: *Held*, that a patent could be refused only for the reason that that step had no special utility, and that such a finding would be unwarranted upon the showing made, as it would be largely a matter of mere assumption. The Examiners-in-Chief reversed.

Huston x. p., *Simonds, Com.*, 26 Ap., 1892, C. D. Ms.

Of like tenor, see Manhes, (17) INVENTION.

6. Functions of a Machine, — When not mere.

The Examiner's objection that the process-claim was "thought to be simply to the necessary functions of the

machine shown for carrying out the so-called 'process': " *Overruled*, on the ground that it did not appear that every one of the steps specified in the first claim could not be practised by the use of other instrumentalities than those specifically described in applicant's specification.

Rogers, x. p., *Simonds, Com.*, 9 Mar., 1892, C. D. Ms.

7. Process defined and distinguished from the mere Function of an Apparatus.

The objection that the alleged "process" was the mere function of the special apparatus described cannot be sustained where it is manifest that the process, as set forth in the claims, is not dependent upon any special mechanism.

Chisholm & Chisholm, x. p., *Mitchell, Com.*, 13 Jan., 1890, C. D. Ms.

8. Change of Form.

While it is the rule that mere changes in form and proportion do not amount to patentable invention, yet it is true, as once said by Chief Justice Marshall, that—"It is not every change of form and proportion which is declared to be no discovery, but that which is simply a change of form or proportion and nothing more. If, by changing the form and proportion, a new effect is produced, there is not simply a change of form and proportion but a change of principle also" (Davis *v.* Palmer, 2 Brock., 298).

Condict, Jr., x. p., *Simonds, Com.*, 3 June, 1892, C. D. Ms.

9. A part of the objection of the Examiners-in-Chief to the allowance of a patent was that "the process here is purely a mechanical process. The material acted on is not changed in character by the process. All that is done to it by the process is to assemble sheets of it and

fold the sheets when assembled:" *Held*, that it is not necessary that a patentable process should change the character of the material acted on. It is enough, in this regard, if it change the form of that material into one of greater convenience.

Scott, x. p., *Simonds, Com.*, 11 May, 1892, C. D. Ms.

10. Materials.

Where the Primary Examiner had held that the process disclosed in a reference was substantially the same as applicant's, for the reason that a process must be entirely independent of the materials treated; that is, that if the steps of two processes appear to be the same, it makes no difference that the materials subjected to the process are different: *Held*, that, as the Examiners-in-Chief did not seem to have adopted this view of the Primary Examiner, it was not necessary to discuss the matter further than to say that the action of different substances under the same treatment is so different that, in many instances, the substances treated are material factors to be considered in determining whether a process is patentable. or whether two processes are the same or different.

Goodwin, x. p., *Fisher, Act. Com.*, 10 June, 1890, C. D. Ms.

11. Naming Ingredients, — When proper.

Upon an objection that certain claims for a process of tanning were not proper process claims, because they enumerated the constituent parts of the different liquors to which the skins were subjected: *Held*, that if there be no way of properly distinguishing the liquors from those before employed in the art to which the invention appertained, except by naming their ingredients, there seemed no good reason for denying the applicant the right to so define them, in so far as the question was one of form. In view of the fact of the well-known

difficulty of determining what is and what is not a patentable process, and what is or is not an equivalent in a chemical process, I am unable to hold, as a matter of law, that it is improper to set forth, in a process of the character that this purports to be, the constituent parts of the different liquors that may be used in carrying out the steps of the process.

Vorcl, x. p., *Frothingham, Act. Com.*, 15 Feb., 1892, C. D. Ms.
Compare Zalinski, x. p., (87) THE CLAIM.

12. In Atwoood, x. p. (1888, C. D. 74), it was expressly decided that the relation between process and apparatus is not that which exists between genus and species, but that they are "wholly separate and distinct inventions."

Crane *v.* Meriam, *Mitchell, Com.*, 31 May, 1890, 51 O. G., 1783.

13. Patentable Process distinguished from the mere Functions of a Machine.

A "process," *eo nomine*, is not made the subject of a patent in our Acts of Congress. It is included under the general term "useful art." An art may require one or more processes or machines in order to produce a certain result or a certain manufacture. The term "machine" includes every mechanical device, and every combination of mechanical powers or devices, to perform some function or to produce a certain effect or result. But where the result or effect is produced by chemical action, or by the operation or application of some element or power of nature, or by the application of one substance to another, such modes, methods, or applications are called processes. A new process is usually the result of discovery; a machine, of invention. The arts of tanning, dyeing, making water-proof cloth, vulcanizing india-rubber, smelting ores, and numerous

others, are usually carried on by processes, as distinguished from machines. *One* may *discover* a new and useful improvement in the process of tanning irrespective of any particular form of machinery or mechanical device. *Another* may *invent* a labor-saving machine or apparatus by which this operation or process may be facilitated, and each may be entitled to his patent. As, for instance, *A* has *discovered* that, by exposing india-rubber to a certain degree of heat, in combination with certain metallic salts, he can produce a valuable product or manufacture; he is entitled to a patent for his discovery, as a process or improvement in the art, *irrespective of any machine or mechanical device.* *B*, on the contrary, may *invent* a new furnace, or stove, or steam-apparatus, by which this process may be carried on with much saving of labor and fuel; and he will be entitled to a patent for his machine as an improvement in the art. Yet *A* could not have a patent for a machine, nor *B* for a process; each would have a patent for the means or method of producing a certain result or effect, but not for the result or effect produced.

The term "process" includes all methods or means which are not necessarily effected by or dependent on any particular mechanism or apparatus.

Substantially from Corning *et al. v.* Burden, Dec., 1853, U. S. S. C. By *Wayne, J.*, 20 U. S., 503, 15 How., 252, ❁.

NOTE. — An instructive elucidation and partial extension of the definition of "art," given in Corning *v.* Burden, ❁, appears in the decision of the Supreme Court in the case of Dolbear *et al. v.* American Bell Telephone Company, 19 Mar., 1888, 33 O. G., 377, (19) INVENTION (*Generic*), ❁. See also decision and comment of Commissioner *Simonds* in Dalton, x. p., 18 Feb., 1892, (3) ART.

14. Where the process could be carried into effect by the described machine, *but was not dependent upon it,*

both the process generally and that particular machine may be included and separately claimed in one patent.

Where the application, as filed, discloses an apparatus, and also a patentable process, and the relation between them is such that they could be joined in one application, and the apparatus only is embraced in the statement of invention or in the claims, as originally presented, there is no reason why claims for the process may not be incorporated if seasonably presented and supported by a supplemental oath. Such amendment and oath should, however, be seasonably presented, for the option accorded to applicant carries with it the responsibility of timely election and the obligation to stand by such election when decisively made.

Lillie, x. p., *Mitchell, Com.*, 6 Dec., 1890, 53 O. G., 2041.

15. Where it appeared that the process embraced in applicant's claim was such that it could be performed by machines other than that disclosed in the application, that it could be performed by hand, and that the said process was invented before the said machine was carried out: *Held*, that such process was patentable and was not a mere function of the machine, notwithstanding applicant has a pending application for patent for the machine (following Young, x. p., 46 O. G., 1635; and distinguished from McKay *v.* Jackman, 22 O. G., 86, and from Mosler Safe Co. *v.* Mosler & Co., 43 O. G., 999).

Kerr, x. p., *Fisher, Act. Com.*, 12 Aug., 1890, 53 O. G., 919.

16. If a subsequent inventor discovers a new mode of carrying out a patented process, though he may have a patent for such a new mode, he will not be entitled to use the process without consent of the patentee thereof.

Tilghman *v.* Procter, U. S. S. C. By *Bradley, J.*, 21 Jan., 1881, 19 O. G., 859, ✿.

17. Where the inventor of a machine was also entitled to a claim for the process, the issue of the patent without such claim was a dedication of the process to the public.

It is, of course, difficult to say that a man can have invented a process of which he was not cognizant; but, in the case supposed, the inventor's attention may have been so occupied with the mechanical construction of his machine, that, for the time being, — by reason of his ignorance or otherwise, — he failed to know that he had invented also a new process, and, if his unconsciousness should not be removed and he should come to the Office and apply for a patent without describing, defining, or claiming his process, and should take out his patent accordingly, he would probably thereby dedicate the process to the public as unconsciously as he had invented it, and be thus debarred from thereafter asserting a claim thereto.

Young, x. p., *Hall, Com.*, 18 Dec., 1888, 46 O. G., 1635.

18. It being conceded that a process is not patentable which is *merely* the effect or function of a specific mechanism, the question necessarily arises, in every case, whether the process claimed is capable of being performed by a machine differently organized from that described, or even without an organized machine, — by mere tools or by hand. Ordinarily, the necessary effects or operations of a specific mechanism are not "processes" or "methods" *within the meaning of the patent law.* A "method" or "process" such as the law recognizes as patentable must have an existence independent of the machine or appliances by which it is carried out to its result. It must be a method or process that could be carried out by hand or by various kinds or forms of mechanisms or appliances (Horr, x. p., 41 O. G., 463).

19. New Matter.

If the Examiner is of opinion that the proposed process claim covers new matter, that is to say, that, in his opinion, it either lacks identity with or that it involves a departure from the invention originally presented: (see Rule 133) he should receive the claim for consideration, and should reject it on the ground of such departure or non-identity in order that appeal may be taken to the Examiners-in-Chief (see Regan, x. p., 45 O. G., 589; Bailey, x. p., 52 O. G., 605).

Perkins, x. p., *Mitchell, Com.*, 1 Mar., 1891, 55 O. G., 139.

20. Supplemental Oath.

Where an application, as filed, discloses an apparatus and also a patentable process, and the relation between them is such that they could be joined in one application, and the apparatus only is embraced in the statement of invention and claims as originally presented, claims for the process may be subsequently incorporated if seasonably presented *and supported by a supplemental oath.*

Ib.

21. Seasonable Presentation.

The question whether the process claim was seasonably presented is an executive one, and, when that question is intended to be raised, the Examiner should refuse to incorporate and thus lay a basis for *petition to the Commissioner*.

Ib.

PATENTABILITY WAS DENIED IN THE FOLLOWING CASES.

22. If a so-called "process" is dependent on a particular apparatus it is but its legitimate function and is not patentable.

Harrison, x. p., *Doolittle, Act. Com.*, 5 Aug., 1876, C. D. 170.

23. Aggregation of Processes.

A process which embraces an old process of preparing a [certain] material and supplements it with an old method of utilizing such materials to produce an old and well-known result, is not patentable. Mere aggregation of processes, of which each accomplishes, independently of the other, its well-known result, is not patentable, any more than a mere aggregation of mechanical devices.

Gent, x. p., *Mitchell, Com.*, 4 Nov., 1889, C. D. Ms.

24. A process which indicates exercise of ordinary judgment merely, — not patentable.

A process that involves merely the use of a well-known mould and an equally well-known composition, and the exercise of ordinary judgment in their manipulation, and regulation of the temperature of each, is not a patentable invention.

Higgins, x. p., *Frothingham, Act. Com.*, 31 Aug., 1891, C. D. Ms.

Compare Torrance, x. p., (1) ORDINARY RESOURCES OF THE ART.

PRODUCT.

1. Patentable product defined.

One of the requirements of a patentable product is that it can be distinguished in the market from others of the same general character, and this is a question which relates to the "merits" and is not the subject for a petition to the Commissioner.

Reed, x. p., *Frothingham, Act. Com.*, 15 June, 1891, C. D. Ms.

Compare Eberson *v.* Shea *et al.*, (2) *infra*.

2. An old product not patentable because produced by new means.

It is obvious that if an article has been made by hand and has been in public use or on sale for two years, a

patent for the same article made by a machine would be invalid. A product is not patentable unless it possesses "a novelty of its own independent of the new devices, or processes, or arts by which it was produced" (Draper *v.* Hudson, 1 Holmes, 208; Wooster *v.* Calhoun, 11 Blatch., 215).

Eberson *v.* Shea *v.* Reece *v.* Thomson & Phelps, *Frothingham, Act. Com.*, 14 Aug., 1891, C. D. Ms.

Compare Reed, x. p., (1) *supra.*

PROLIXITY.

A specification comprising two separate descriptions of the same subject-matter of invention that are substantially alike, except that one contains references to the drawings, is unnecessarily prolix.

Kinney, x. p., *Frothingham, Act. Com.*, 14 May, 1892, 60 O. G., 737.

See REDUNDANCY.

PROTEST.

See Creteau *v.* Hall, CROSS-EXAMINATION.

PUBLIC ADOPTION.

1. Resolves doubt in inventor's favor.

When the question of patentable novelty in a device sued upon is not free from doubt, a general and extensive use by the public will incline the court to resolve the doubt in favor of the patent.

Topliff *v.* Topliff *et al.*, U. S. S. C. By *Brown, J.*, 25 Ap., 1892, 59 O. G., 1256, ✱.

See, of like tenor, Shannon, (10), (11), Sommer, (12), INVENTION; and Bruce *v.* Marder, (1) *et seq.*, UTILITY.

2. Public Adoption not always a safe test of Intrinsic Worth. Caution necessary in applying it. "Proprietary Medicines."

While this court has held in a number of cases, even so late as McGowan *v.* N. Y. Belting and Packing Co. (141 U. S. 322, ✱), decided at the present term, that in a doubtful case the fact that a patented article had gone into general use is evidence of its utility, such use is not conclusive even of that, — much less of its patentable novelty. That the extent to which a patented device has gone into use is an unsafe criterion of its actual utility, is evident from the fact that the general introduction of manufactured articles is as often effected by extensive and judicious advertising, activity in putting the goods upon the market, and large commissions to dealers, as by the intrinsic merit of the articles themselves. The popularity of a proprietary medicine, for instance, would be an unsafe criterion of its real value, since it is a notorious fact that the extent to which such preparations are sold is very largely dependent upon the liberality with which they are advertised, and the attractive manner in which they are put up and exposed to the eye of the purchaser.

McClain *v.* Ortmayer. By *Brown. J.*, 2 Nov., 1891, 57 O. G., 1129, ✱.

Compare Washburn & Moen M'f'g Co. *v.* The Beat Em All Barbed Wire Fence Co., (7) PATENTABILITY.

PUBLIC RIGHTS AND OBLIGATIONS.

1. The public and the inventor meet on the understanding that one has a secret to communicate and the other a favor to confer in return. Hence, the monopoly granted is a temporary one, and hence, also, a full revelation of the invention is required.

The clearest insight into the peculiarities of this species of property is obtained by considering it as the

result of a contract entered into by the Executive (as representative of the public) with the patentee. The parties meet on the understanding that one has a secret to communicate, the other a favor to confer in return (Coryton, 41). Hence, all laws of this description grant only a temporary monopoly; they offer a compromise between the inventor and the rest of the community by which each party surrenders something, and for which it is proposed that he shall receive an equivalent (Phillips, 22). The right of the public is to be put into immediate possession of a complete knowledge of the invention, and it is the duty of the patentee to give this knowledge; the right of the patentee is to enjoy, unmolested, the exclusive use of the invention during the life of his patent, and it is the duty of the public to secure him in this right by the ordinary forms of legal protection and redress. These reciprocal rights and obligations are to be assured to the respective parties only by imposing upon each the necessity of fully, literally, and promptly discharging *its* legal duty to the other; in other words, by interpreting each side of the contract against its promisor and in favor of its promisee.

Robinson, "The Law of Patents for Useful Inventions," i. 29.

2. A patent is a contract between the public and the inventor of a new and useful art or manufacture, whereby, in consideration of a complete disclosure of the invention, the exclusive right thereto, for a limited period, is guaranteed to the inventor and his representatives.

Whitney *v.* Emmett, *Baldwin, J.*, 319

3. In determining the question of inventorship the public has rights, and discretion should be exercised to prevent the placing of unnecessary restrictions upon

artisans in a legitimate use of their mechanical skill and ingenuity.

Smith, x. p., *Thacher, Com.*, 11 Dec., 1872, 2 O. G., 647.

4. In considering a case under Section 4894 R. S., it is necessary to exercise great care lest it be found that, showing too great leniency to an applicant, the interests of the public at large or of other private individuals have suffered. The interest of the general public must be considered as well as the private rights of the individual.

Klenha, x. p., *Butterworth, Com.*, 22 Sep., 1884, 28 O. G., 1272; see also Voelker *v.* Gray *v.* Edison *v.* Bell, *Butler, J.*, 3 Mar., 1885, 30 O. G., 1092.

5. A motion for re-opening a case or for a new trial, in the United States Patent Office, is not to be determined by the same rules as prevail in courts of law. The questions here to be decided are, who is the first inventor, (and whether a patent should issue to *any* one, and if so, to whom). In order to determine these questions it is necessary that the testimony material to establish who is the first inventor and who first reduced the invention to practice should be received *at any time before the patent issues.*

Eccard *v.* Drawbaugh, *Marble, Com.*, 5 July, 1883, 24 O. G., 301.

6. The history of the case [Graham's application for patent for fire-extinguisher] shows that a great public wrong had been put upon the inventor, and that the object of the act was to repair the injustice to the only persons to whom, in an historical point of view, justice could be rendered; the Act of Congress was intended as one of national gratitude.

Fire Extinguisher M'f'g Co. *v.* Graham, *Hughes, J.*, 17 May, 1883, 24 O. G., 798.

7. When an applicant seeks to overthrow a patent granted to one who, though a junior in date of conception, has yet shown diligence in filing his application and reducing his invention to practice, the former must, in view of the importance of the invention [not merely to the patentee but to the general public], show entire freedom from *laches*.

Voelker *v.* Gray *et al.*, *Butterworth, Com.*, 30 O. G., 1091.

8. As between the public and the inventor who first reduces his invention to practice, there is no obligation to diligence resting upon the inventor; it is only when another inventor appears that such obligations arise. If he forgets [neglects] or abandons the invention after a reduction to practice in private and before public use, his competitor may claim the patent. If he forgets or abandons it after public use, his competitor can take no patent, but the forfeiture will inure to the benefit or the public. A delay in application for a patent of less than two years, even after public use of the invention, is in itself no evidence of abandonment: the law authorizes such delay. Still less is a delay of two years before public use evidence of such abandonment.

Packard *v.* Sandford, *Paine, Com.*, 12 Dec., 1879, 16 O. G., 1182.

See, however, ruling of Commissioner Mitchell in Christie *v.* Seybold, 54 O. G., 957.

9. The patentee must be held strictly to limitations that, after rejection by the Office, had been introduced by himself in order to secure the patent.

When a claim that had been presented in complainant's original application, which would have been broad enough to cover the machine used by defendants, was rejected on reference to the prior art, and applicant

thereupon cancelled said claim and substituted the more limited claim seen in his patent, said claim cannot be so enlarged by judicial construction as to cover what was thus rejected. . . . Where, after official rejection, the patentee's claim was limited to the specific device described, in which the lever for operating the dog-bar locked when in the vertical position, and defendant's lever was so arranged as not to lock in that position: *Held*, to be no infringement.

Rodebaugh *v.* Jackson, *Brown, J.*, 25 Feb., 1889, 47 O. G., 660.

10. In patents for combinations of mechanism, limitations imposed by the inventor, especially such as were introduced in an application after it had been persistently rejected, must be strictly construed against the inventor and in favor of the public, and be looked upon in the nature of disclaimers.

Sargent *v.* Hall Safe & Lock Co., U. S. S. C. By *Blatchford, J.*, 30 Mar., 1385, 31 O. G., 661, ✱.

See also Mott Iron Wks. *v.* Standard M'f'g Co., ACQUIESCENCE; Hill & Prentice, x. p. (1); Miller *v.* Brass Co. (4), DEDICATION; and Shaw *v.* Pearson, 58 O. G., 948, WAIVER.

11. The purpose of the patent-law is to benefit the public as well as to protect the inventor, and the inventor who reduces the invention to practice in such a complete way that he at once perfects it as an invention and at the same time practically demonstrates its utility, is clearly to be preferred to one who merely made hints and suggestions to others, but failed himself to act upon them.

Green *v.* Hall *v.* Siemens *v.* Field, *Hall, Com.*, 6 Mar., 1889, 46 O. G., 1515.

12. The public should not (by supplementary grants or otherwise) be prejudiced in their right, at the expiration of the patent, to whatever it covered.

Camille A. Faure, patentee of the well-known secondary battery which bears his name, sought, in an application for patent (filed May 25th, 1887), to prolong the monopoly for a special use (propulsion of vehicles) beyond the seventeen years of his original patent (granted January 3d, 1882). The application was refused because lacking in the essence of patentable invention; the combination claimed in the new application depending for its useful novelty wholly on the special form of battery of which he was for the seventeen years of his original patent the sole beneficiary, and of which, at the expiration of that patent, the public were the indisputable heirs; they could not lawfully nor equitably be debarred by subsequent patents seeking to monopolize uses which, although special, are, at the same time recognized by persons skilled in the art, as pertaining to it.

Faure, x. p., *Mitchell, Com.*, 52 O. G., 752.

The above decision by Commissioner Mitchell was confirmed by the Supreme Court of the District of Columbia. See Appeal of C. A. Faure, (13) *infra*.

13. Special Use of a Patented Invention — Not patentable.

Where an applicant for letters-patent claimed to have invented an improvement upon devices for propelling vehicles by electrical energy through storage-batteries carried by the vehicles moved and not connected with any arrangement, of wires outside of the carriage, and it appeared that one constituent of the alleged new invention was a secondary or storage-battery upon which applicant had received letters-patent prior to the filing of the present application, and it further appeared that the mechanical arrangements for applying the power were old, and that the result, viz., the movement of a vehicle by electrical storage-batteries [carried upon it], was old: *Held*, that a patent for said improvement was

rightly refused (for want of invention) by the Patent Office, although said patented storage-battery of applicant was superior to all others of its kind for the purpose, and rendered the device commercially practicable: *Held, further*, that otherwise the monopoly granted upon applicant's said storage-battery would be prolonged.

Supreme Ct. of Dist. of Col., in Gen. Term, Appeal from dec. of the Commissioner of Patents, by Camille A. Faure (Bingham, Ch. J., Hagner and James, Associate JJ.) By *Hagner, J.*, 7 July, 1890, 52 O. G., 754.

Compare with Reed *v.* Landman (14), and Barrett, x. p., (15) *infra.*

14. The Patent Office must not only determine between actually conflicting claims, but it must also protect the public from more than one patent upon the same invention.

Reed *v.* Landman, *Mitchell, Com.*, 26 May, 1891, 55 O. G., 1275.

15. It is not permissible to allow claims appearing in a patent to be transferred to a subsequent application by the same inventor. Such a course would extend the monopoly beyond the period of time allowed by the statute.

Barrett, x. p., *Frothingham, Act. Com.*, 14 Mar., 1891, 56 O. G. 930.

Compare with Faure, (12) and (13) *supra.*

16. I have never been able to satisfy myself that public policy will permit the Office to allow an assignee to prosecute an application wholly from sight of the inventor if the latter wishes to keep himself informed as to the proceedings. The Examiner was directed to permit the inspection asked for.

McLaughlin, x. p., *Mitchell, Com.*, 3 Ap., 1891, 55 O. G., 864.

17. An inventor has no right to withhold from the public any material fact involved in a discovery or invention for which he holds a patent, and Section 4908 R. S. will not protect a witness from answering a question notwithstanding the effect of his answer would be to make such a disclosure.

Dornan *v.* Keefer, *Butler, J.*, 58 O. G., 1093.

18. So long as the claims presented are held to be unpatentable, applicant has no right either to the institution or continuance of an interference; but, in order to afford him an opportunity to have his claims adjudged patentable, on appeal, the Office may, and sometimes does, delay the issue of a patent to the other party. Such delay, however, when granted, *is wholly in the interest of the public*, and if the applicant whose claims stand rejected does not move promptly to appeal, applications, which would otherwise be detained to await a possible interference, will be permitted to go to issue.

Abel *et al. v.* Maxim *v.* Noble, *Mitchell, Com.*, 20 June, 1891, 56 O. G., 139.

See, also, Westinghouse *v.* Thomson, 56 O. G., 142.

19. Right to inspect for "Record Date" a pending application referred to in a patent.

Upon a request to inspect so much of a pending application as was referred to in the printed specification of a patent which contained a statement that said patent was a division of said application: *Held*, that, although it would seem to savor of injustice and to be contrary to sound principle to permit a patentee to set out in his patent that by reason of a certain record he is entitled to a certain record date of invention, and yet to deny access to the record for the verification of the statement, and that, as the public is compelled to respect the right of the patentee before suit is brought, it would seem to

be entitled, when a patent has been granted, to know its official history; yet, as such a conclusion would be in direct conflict with the practice of the Patent Office during its whole history, the remedy of the petitioner, if any, should come *through the interposition of a court*, and not through the decision of a Commissioner which would constitute an innovation upon the practice of all his predecessors.

Pennie & Goldsborough, x. p., *Mitchell, Com.*, 15 June, 1891, C. D. Ms.

Compare ABANDONED APPLICATIONS; CERTIFIED COPY.

20. Demands of Public Policy.

Section 4894 R. S., requiring that an applicant shall put his case in condition for examination within two years after filing, and shall not allow two years to elapse without prosecution of it after any Office action thereon, gives ample time to the applicant, and public policy demands that this Office shall consider it as exhausting the liberality which the law requires as regards forfeitures.

Price, x. p., *Simonds, Com.*, 11 NOV., 1891, 57 O. G., 1000.

Compare Cordrey, (2) DELAY; also Holt *v.* Mills (2), and Murray, x. p. (3) DILATORY METHODS.

21. Limitation of Patent by Prior Art.

In the absence from the record of references showing exactly certain features which were old, it was held, by the Supreme Court in Phillips *v.* Detroit, 111 U. S., 604, (28 L. ed., 532, ✱), that the rights of the public demand that judicial notice shall be taken of what is well-known to be old.

Jones, x. p., *Frothingham, Act. Com.*, 21 Dec., 1891, C. D. Ms.

Compare COMMON KNOWLEDGE; (28) *et seq.*, INVENTION; and (1) *et seq.*, ORDINARY RESOURCES OF THE ART.

22. Whatever may prove to be the condition of an application in respect to abandonment, the interests of the public, where the case is involved in interference, are best subserved by having the question of priority first determined, but if the applicant prove successful in the interference, the attention of the Commissioner should be called to the question of abandonment before issuing the patent.

Young, x. p., *Frothingham, Act. Com.*, 24 Dec., 1891, C. D. Ms. Compare Hunter, Jr. *v.* Lane, FEIGNED ISSUE.

23. It is undoubtedly true that the limited and temporary monopoly granted to inventors was never designed for their exclusive profit or advantage; the benefit to the public or community at large was another, and, doubtless, the primary object in granting and securing that monopoly. This was, at once, the equivalent given by the public for benefits bestowed by the genius and meditations and skill of individuals, and the incentive to further efforts for the same important objects.

Kendall *v.* Winsor, U. S. S. C. By *Daniel, J.*, Dec. term, 1858, 21 Howard, 322,✽.

24. The true policy and end of the patent laws enacted under this Government are disclosed in that article of the Constitution (Art. 1, Sec. 8, Cl. 8), the source of all these laws, viz., to be "to promote the progress of science and the useful arts."

Ib.

ABANDONMENT (3, 4, 7); ABANDONMENT OF APPLICATION (3); DILIGENCE; INTERFERENCE; REDUCTION TO PRACTICE; SCOPE OF PATENT.

PUBLIC RECORD.

Applications which have not matured into a patent are not a part of the public record.

See Fowler, x. p., (1) ABANDONED APPLICATIONS; U. S. *v.* The Com. of Pats., (1) CERTIFIED COPY; Borgfelt, x. p., (1), Chadwick, x. p., (2), CROSS-REFERENCES; and Pennie & Goldsborough, x. p., (19) PUBLIC RIGHTS, ETC.

PUBLIC USE.

1. A use for over two years prior to application, which was wholly or mainly for trade or profit, constitutes an abandonment of the invention to the public, but use wholly or chiefly for experiment does not.

The inventor's rights are not prejudiced by experiments whose purpose is to discover whether the invention be both practicable and valuable, and whether any and, if any, what additional means are required for perfecting it; furthermore, the nature of the invention may be such as to require experimental tests to be public ones, and such use in public may be for a period even longer than two years; and where, as an incident to such use, the product of its operation is disposed of by sale, such profits by its use do not change its character; but where, on the other hand, its use is mainly for the purpose of trade and profit, and the experiment is merely incidental to that, a continuance of such use for more than two years before application for patent will constitute abandonment; *the principal, and not the incident, must give character to the use.* The use implied as excepted out of the statutory prohibition is one which may be properly characterized substantially for the purpose of experiment. Where the substantial use is not for that purpose, and has been open to the public for more than two years prior to the application, it comes within the

statutory prohibition (Smith *v.* Sprague, 123 U. S., 249, ✱). Tested by the rule thus stated, the proofs adduced by the complainant, Henry Root, do not show a use substantially for experiment, but show such a public and commercial use of the invention as must defeat the patent. The facts are in marked contrast with those in the case of City of Elizabeth *v.* Nicholson Pavement Co. (97 U. S., 126,✱); there the use was solely for experiment. In the language of the Supreme Court in that case; "Nicholson wished to experiment on his pavement; he believed it to be a good thing, but he was not sure, and the only mode in which he could test it was to place a specimen of it in a public roadway. He did this at his own expense and with the consent of the owners of the road. He wanted to know whether his pavement would stand and whether it would resist decay. Its character for durability could not be ascertained without its being subjected to use for a considerable time. He subjected it to such use in good faith for the purpose of ascertaining whether it was what it claimed to be."

Root *v.* Third Ave. R. R. Co., *Wallace, J.*, 5 Feb., 1889, 46 O. G., 1398.

For final affirmation, by the United States Supreme Court, of the above decision, see (2) *infra.*

2. We think that the present case does not fall within the principles laid down in Elizabeth *v.* Pavement Co. The plaintiff did not file a caveat, and there is no evidence that he did not intend to abandon his right to a patent. It does not appear that any part of the structure was made at his own expense, or that he put it down in order to ascertain its durability or its liability to decay, or that what he says he noticed in the spring of 1879 led him to make any further examination in that respect, or to test further the fear which he says he had at that time,

or that what he then saw led him to think that the structure was weak or undesirable. It cannot be fairly said from the proofs that the plaintiff was engaged in good faith, from the time the road was put into operation, in testing the working of the structure he afterward patented. He made no experiments with a view to alterations; and we are of opinion, on the evidence, that sufficient time elapsed to test the durability of the structure, and still permit him to apply for his patent within the two years. He did nothing and said nothing which indicated that he was keeping the invention under his own control (Elizabeth *v.* Pavement Co., 97 U. S., 126, ✱; Smith & Griggs M'f'g Co. *v.* Sprague, 123 U. S., 249, ✱; Hall *v.* Macneale, 107 U. S., 90, ✱; Egbert *v.* Lippmann, 104 U. S., 333, ✱).

Without examining any other of the defences raised, we are of opinion that the bill must be dismissed, for the reason stated by the Circuit Court.

Decree affirmed.

Root *v.* Third Avenue R. R. Co., Appeal from U. S. C. C., S. D., N. Y. (*Wallace, J.*), U. S. S. C. By *Blatchford, J.*, 21 Nov., 1892, 61 O. G., 1947.

For instance of experimental use, compare City of Elizabeth *v.* Nicholson Pavement Co., (9) DILIGENCE.

3. Public Use and Sale.

In case of a sale and public use of a machine subsequently patented, such sale and use being more than two years before the date of the application, it being shown that such sale was for experimental purposes, then, upon the question of the reasonableness of the use in point of duration, every presumption should be made in favor of the inventor.

Innis *v.* The Oil City Boiler Wks., U. S. C. C., W. D. Pa., *Acheson, J.*, 29 Jan., 1885, 80 O. G., 998.

4. The invalidating two years' public use of the statute does not require the knowledge, allowance, or consent of the inventor (Andrews *v.* Hovey, 123 U. S., 267,*, and 124 U. S., 694,*).

Drawbaugh, x. p., *Simonds, Com.*, 28 Oct., 1891, 57 O. G., 693.

See ABANDONMENT; DILIGENCE; REDUCTION TO PRACTICE.

PUNCTUATION.

In the printing of a specification for issue, the punctuation in applicant's claims must be *strictly followed*, and that in the body of the specification must not be departed from except to cure a manifest absurdity.

Order 789, *Simonds, Com.*, 26 Nov., 1892.

"RACE OF DILIGENCE."

See (1), (2), (3), (4), DILIGENCE. See, also, (11) REDUCTION TO PRACTICE, and cases there cited.

RE-ALLOWANCE.

1. Before Forfeiture.

When a renewal application was made, the renewal fee paid by applicant, and the case re-allowed by the Examiner before the original application had become forfeited: *Held*, following the practice as announced in Manny, x. p. (44 O. G., 700), that there was no authority of law for the filing of said renewal application or for the acceptance of the renewal fee, and, consequently, there was no authority of law for the re-allowance, and that the application should be returned to the Issue

Division to await action of the applicant as an allowed case.

Nicholson, x. p., *Mitchell, Com.*, 17 June, 1890, 52 O. G., 310.

2. Failure to receive Notice of Allowance.

A petition alleging that a notice of allowance, duly sent, had not been received, and praying that another notice be sent and the petitioner be allowed to pay his final fee and receive his patent, denied. The statute is peremptory that if the final fee is not *paid* within the prescribed time, the patent shall be withheld. It would seem that the statute conclusively assumes that the notice sent was received, and apparently assumes that a failure to hear for months from the Office with reference to an application would lead to such inquiry as would prevent any injury resulting from failure to receive the notice sent.

Eames, x. p., *Mitchell, Com.*, 6 Feb., 1890, C. D. Ms.

RE-APPEAL.

1. It is a well-established practice of the Office that an Examiner is not bound by a suggestion made by the Examiners-in-Chief. This was expressly stated by the Commissioner in Holt, x. p. (1887, C. D. 5), and in Pearson, x. p., Ib. 37. If a claim suggested by the Examiners-in-Chief is rejected by the Primary Examiner, the appellant's remedy is by re-appeal.

Simpson, x. p., *Fisher, Act. Com.*, 21 Nov., 1890, C. D. Ms.

2. The Primary Examiner is not bound by a recommendation contained in decision of Examiners-in-Chief (Dysart, x. p., 34 O. G., 1390; Pearson, x. p., 40 O. G., 244). Rule 139 (b) clearly implies that the Primary Examiner may reach a judgment different from that of the Examiners-in-Chief on points embraced in their

recommendation, and that a further appeal may be rendered necessary, either to the Examiners-in-Chief or to the Commissioner, according to the nature of the question presented. Such a recommendation, whatever its moral force, cannot cut off the right of the applicant to demand the independent judgment of the Primary Examiner.

Heyer, x. p., *Mitchell, Com.*, 29 Nov., 1890, C. D. Ms.
See Thomson, x. p., (2) FEES.

RE-ARRANGEMENT.

A re-arrangement of old elements which usefully reverses their customary action is patentable.

A lathe in which the block revolves rapidly and the tool-stock so slowly that at each revolution of it a block is finished, is not answered by one in which the rate of these motions is reversed.

Urmston, x. p., *Fisher, Com.*, 16 Feb., 1870, C. D. 13.
See RE-ORGANIZATION.

RE-COMBINATION.

The defendants had the same right to re-combine the same parts that the complainants had, so long as they do not use the same combination.

Pattee *v.* Moline Plow Co., *Blodgett, J.*, Oct., 1881, 22 O. G., 173.

See RE-ORGANIZATION.

RE-CONSIDERATION.

Examiner's Duties.

Where, after a material amendment, the Examiner rejects without giving either reasons or new references and announces such rejection to be final, and, thereafter,

applicant offers another amendment which the Examiner refuses to consider: *Held*, that, the amendment having been of a material character, applicant was entitled to a reconsideration or to further amend if he so preferred, and, having elected the latter course, the Examiner should have incorporated this new amendment and considered the same.

Griswold, x. p., *Mitchell, Com.*, 25 Jan., 1890, 50 O. G., 838.

RECORDING.

In recording assignments, the Patent Office acts in a merely ministerial capacity and has no authority to enter upon a judicial inquiry as to their validity.

Backus' Co., x. p., *Simonds, Com.*, 8 Jan., 1892, 58 O. G., 385.

The statutes give no authority for recording, or otherwise noting on the records of the Patent Office, a protest against the validity of a previously recorded assignment.

Ib.

Compare Samuel J. Murray, (2) ASSIGNEE; and Dodge & Son, (2) FOREIGN PATENTS.

REDUCTION TO PRACTICE.

1. Actual reduction to practice is accomplished only by a full-size operative machine. A model, no matter how complete, is not sufficient.

Reduction to practice can be effected only by the material embodiment of the invention in the form [and of the dimensions] in which it is ultimately designed for use. It may be stated, as a legal proposition of general application, deducible from the decisions of the courts and the Patent Office, that complete invention is arrived at when the ideas, theories, and speculations of the inven-

tor have been put into such form, capable of operation, that a public use or sale of the device so constructed (not simply an experimental use), if made more than two years before the filing of an application, would constitute a bar to the granting of a patent. To satisfy the requirements of the law the inventor must have produced a full-size operative machine; a model, no matter how complete in details of construction, is not sufficient.

Stephenson *v.* Goodell, *Duell, Com.* 3 June, 1875, 9 O. G., 1195.

See also Millward *v.* Barnes, 11 O. G., 1160; and for distinction, on the one hand, between use wholly (or mainly) experimental and, on the other hand, such business use as (if made more than two years before application) would give the invention to the public, see City of Elizabeth *v.* Nicholson Pavement Co., 95 U. S., 126,✱; Smith *v.* Sprague, 123 U. S., 249,✱; and Root *v.* Third Avenue R. R. Co., 46 O. G., 1393, and 61 O. G., 1947. ✱

2. Definition.

In the case of a mechanical device, reduction to practice [aside from the constructive reduction involved in an application for patent] consists in the construction of *the actual thing, of dimensions suitable for practical use,* and, in case of any doubt of the practical operativeness of the device, it must have been tried sufficiently to establish its practicability.

Bury *v.* Thompson, *Simonds, Com.*, 21 Aug., 1891, C. D. Ms.

3. An Operative Machine of Full Size.

In the invention of a machine, actual reduction to practice consists in the making of a machine of a size adapted for actual work, and proof of some kind — *preferably by means of actual trial* — that the machine will work practically and successfully.

Schmiedl *v.* Booth, *Simonds, Com.*, 25 June, 1892, C. D. Ms.

4. It is not necessary to prove commercial success.

An invention is complete when the thought conceived is embodied in some practical and operative form. It may never prove to be profitable because of other ways devised for accomplishing the same end. The question is not when was the invention completed so as to compete commercially with others, but when was it completed as an operative invention.

Sawyer & Man *v.* Edison, *Marble, Com.*, 8 Oct., 1883, 25 O. G., 597.

5. The invention need not have been brought to the highest degree of efficiency.

The law does not require that a discoverer or inventor, in order to get a patent for a process, must have succeeded in bringing his art to the highest degree of perfection. It is enough if he describes his method with sufficient clearness and precision to enable those skilled in the matter to understand what the process is, and if he points out some practical way of putting it into operation.

Dolbear *et al. v.* American Bell Tel. Co., U. S. S. C. By *Waite, Ch. J.*, 19 Mar., 1888, 43 O. G., 377, ✱.

6. Actual reduction to practice is reached by a single successfully operating and full-sized machine.

Reduction to practice may be effected by means of an experimental working machine as well as in any other way; if the result is a success, the work is as clearly a lawful reduction to practice as if attained by the use of the fiftieth instead of the first working machine, and, if followed within two years by an application for a patent, will accrue to the benefit of the inventor.

Packard *v.* Sandford, *Paine, Com.*, 12 Dec., 1879, 16 O. G., 1182.

7. A single instance of public use for more than two years prior to the application for patent constitutes a surrender of the invention to the public.

The Clark Pomace-Holder Co. *v.* Ferguson, *Coxe, J.*, 10 Jan., 1883, 24 O. G., 1090.

8. *A* was first to conceive and first to apply for a patent. *B* was first to reduce to practice, and, for nearly a year prior to *A's* application, had been making and selling articles embodying the invention. Several years of neglect on the part of *A* had intervened between his conception and application, including the period after *B* had entered the field: *Held*, *B* was the first inventor and entitled to the patent, although a patent had been previously granted to *A*.

Manny *v.* Easley *v.* Greenwood, *Mitchell, Com.*, 16 May, 1890, 51 O. G., 1617.

9. The inventor's act in being the first to enter the Office with an allowable application constitutes a "constructive reduction to practice."

Actual reduction to practice is not the only competent evidence of perfection and adaptation to use; the inventor's act in [being the first to enter the Office with] an allowable application is to be regarded in law as such an efficient and crowning step as to give it the standing of an invention so perfected and adapted.

Lorraine *v.* Thurmond, *Mitchell, Com.*, 4 June, 1890, 51 O. G., 1781.

10. Constructive Reduction to Practice.

To invalidate a patent, it must be proven that the invention had been reduced to practice before the date of the patentee's invention, the patent itself being "held in law to constitute a constructive reduction to practice," and to "relate back to the date of the original

disclosure," providing the specification in the patent is such as to enable one skilled in the art to put the invention in practice.

Murrill *v.* Wheeler *v.* Chenoweth, *Fisher, Com.*, 14 July, 1869, C. D. 43.

See, also, Starr & Peyton *v.* Farmer, *Marble, Com.*, 22 Mar., 1883, 23 O. G., 2325; Morse *v.* Clark, *Leggett, Com.*, 23 Mar., 1872, 1 O. G., 275.

11. Futile Experiments nugatory.

The only office of diligence in reducing to practice is to connect reduction to practice with the original conception and disclosure. If the goal of actual reduction to practice was not *reached*, all efforts in that direction are nugatory and futile, and the respective parties must stand upon their filing dates and their diligence in coming to the Patent Office with theoretically complete inventions.

Bentley *v.* Wightman *v.* Sprague, *Mitchell, Com.*, 19 Mar., 1890, C. D. Ms.

NOTE. — Numerous rulings, such as those of Commissioner Mitchell in Holmes & Holmes *v.* Coler, 21 July, 1890, and Christie *v.* Seybold, 19 Feb., 1891, may be taken to have now fully established the principle which makes the question of diligence applicable only to the inventor who was first to conceive. See, to like purport, Gray *v.* Hale, 1871, C. D. 129; Monce *v.* Adams, 1 O. G., 2; Millward *v.* Barnes, 11 O. G., 1060; Habel *v.* Tucker, 36 O. G., 139; Lorraine *v.* Thurmond, 51 O. G., 1781; Merwin on Patents, Sec. 301; and 1 Robinson on Patents, 544. See also Edison *v.* Foote *v.* Randall (12) *infra*.

12. In case of two or more interfering applicants, the one who is first to disclose the idea is held to be the rightful claimant; providing he had with reasonable diligence reduced the invention to practice, although one later to conceive may have been the first to reduce to practice and the first to make application for patent.

In default of such reduction to practice by the originator, his inchoate right lapses, and his claim is forfeited to the next earliest discloser who can show the required diligence followed by reduction to practice.

Edison *v.* Foote & Randall, *Leggett, Com.*, 25 Mar., 1871, C. D. 80.

See, also, Corsett & Lowe *v.* White, *Leggett, Com.*, 1 June, 1871, C. D. 154; Diston *v.* Emerson, *Leggett, Com.*, 1 June, 1871, C. D. 162; Monce *v.* Adams, *Duncan, Act. Com.*, 10. G., 1.

13. It is not a valid defence against a patent granted in compliance with the forms of law, to show that the invention had never been reduced to actual practice.

Starr & Peyton *v.* Farmer, *Marble, Com.*, 22 Mar., 1883, 23 O. G., 2325.

14. To defeat a patent already issued, it is not enough that another conceived the possibility of effecting what the patentee accomplished. To constitute a prior invention, the party alleged to have produced it must have proceeded so far as to have reduced his idea to practice and to have embodied it in some distinct form. *It must have been carried into actual operation.*

Parkhurst *v.* Kinsman, *Nelson, J.*, Oct., 1849, 1 Blatchford, 488.

See ABANDONED EXPERIMENT; CONSTRUCTIVE REDUCTION TO PRACTICE; CONSUMMATED INVENTION; MODELS; PRIORITY; PUBLIC RIGHTS.

REDUNDANCY.

1. Duplication of Claim.

Where a simple invention is made the subject of numerous claims differing in mere methods of expression with no corresponding difference in the concrete subject-matter, the Office should insist that one claim only be allowed for a given subject-matter of invention, and that

mere differences in phraseology shall not be regarded when urged in defence of a needless multiplication of claims. Where the terms of a claim are clear and distinct, as they always should be, no necessity arises for repeating such claims in different forms of language, and subjecting the Office and the courts [and the *public?*] to great labor in scrutinizing them, and to doubt and annoyance as to their limitations and construction.

Johnson, x. p., *Mitchell, Com.*, 20 Jan., 1891, 54 O. G., 505.

Of like tenor see ruling of *Coxe, J.*, in Brush Elec. Co. *v.* Elec. As. Co., (60) THE CLAIM.

For important exceptions to the above general rule, see Perry & Lay, x. p., (19) and Hahn, x. p., (20) THE CLAIM.

2. A Question of Form.

The question of the redundancy or multiplicity of claims is a question of form and properly reviewable by the Commissioner on petition (Sawn, x. p., 54 O. G., 1561).

Thompson & Thompson, x. p., *Frothingham, Act. Com.*, 25 Jan., 1892, C. D. Ms.

3. Applicant's remedy is by petition to the Commissioner.

In a question of redundancy of claims, the matter to be determined is, not whether the several claims standing alone would be patentable against the public, — for it is conceivable that each one of the claims, standing alone, would be an entirely valid claim, — yet sound policy would require that not all of them should be allowed. Where the Examiner objected to certain claims on the ground of redundancy, and cited Rodwell, x. p. (C. D. 44, Ms. 149), in support of his position that applicant's remedy was by appeal to the Examiners-in-Chief: *Held*, that the practice generally does not accord with that

decision (see Perry & Lay, x. p., 1869, C. D. 3; Hahn, x. p., 1875, C. D. 109; Shippen, x. p., 1875, C. D. 126; and Woodruff, x. p., 1880, C. D. 90); and the better practice would seem to be for the Examiner to state definitely which of the claims he regards as coming within the objection of redundancy, and to give the applicant his election to say which of the claims so related should be prosecuted, and that, thereupon, applicant, if dissatisfied with the Examiner's decision, should petition the Commissioner for relief.

Sawn, x. p., *Mitchell, Com.*, 9 Mar., 1891, 54 O. G., 1561.

4. Upon petition from Primary Examiner's objection to certain claims that they were not substantially different from certain other claims in the application: *Held*, after pointing out certain differences, and the evident endeavor of applicant to obtain claims that will protect his invention from interchanges and reversal of elements which might be made by persons disposed to infringe, that in view of these differences, however slight they may be, it must be held that Claims 1 and 4 are not the same in scope as Claims 2 and 3 respectively, and, if there is anything in these differences, applicant ought to be allowed to claim it (Tobie, x. p., 50 O. G., 992).

Mulligan, x. p., *Frothingham, Act. Com.*, 29 May, 1891, C. D. Ms.

5. Objection of, — overruled.

On objection of redundancy overruled where Claim 2 included an element in addition to the elements in Claim 1, and Claim 3 included an element in addition to the elements in Claim 2.

Thompson & Thompson, x. p., *Frothingham, Act. Com.*, 25 Jan., 1892, C. D. Ms.

Compare (18), (19), (20), (20'), (58), (59), (60), (61), (62), and (63) THE CLAIM.

REFERENCES.

1. Pertinency.

Where a reference related to an art so far removed from that to which the application related, and had for its object a purpose so essentially different that the somewhat analogous construction became of very little consequence: *Held*, that as a reference it was without pertinence.

Ferry, x. p., *Mitchell, Com.*, 5 Mar., 1891, C. D. Ms.

2. An affidavit filed under Rule 75, to be effective in overcoming references cited by the Office, must be supported by proved *facts*; mere declarations, although accompanied by petitioner's oath, are not sufficient.

Hunter, x.p., *Fisher, Act. Com.*, 23 Oct., 1889, 49 O. G., 733.

3. Such an affidavit is not required to cover the same ground as a preliminary statement. It is necessary only to satisfy the Examiner that applicant's invention preceded the date of filing of the application of a cited patent. Such affidavits are not open to inspection either by the public or by parties in interference.

Gasser, x. p., *Paine, Com.*, 28 Feb., 1880, C. D. 94; 17 O. G., 507.

See also Saunders, x. p., 1883, C. D. 23; and Donovan, x. p., 52 O. G., 309.

See AFFIDAVITS TO OVERCOME REFERENCE; ANTICIPATION; PRIOR PUBLICATION.

RE-HEARING.

1. A motion for re-hearing in the United States Patent Office ought to be governed, as far as practicable, by the rules which, in courts, govern new trials.

Spielman, x. p., *Simonds, Com.*, 16 Sep., 1891, 56 O. G., 1707.

2. The granting or refusal, absolute or conditional, of a re-hearing in equity, — as of a new trial at law, — rests in the discretion of the court in which the case has been heard or tried, and is not the subject of appeal.

Roemer *v.* Newman, U. S. S. C. By *Bradley, J.*, 11 Nov., 1889, 49 O. G., 1535,*.

3. Error of Fact.

The question upon a motion for re-hearing on the ground of error of fact, is not whether the trier erred in deciding against the weight of the evidence, but whether there was any substantial ground for the conclusion reached at the original hearing.

Shafer *v.* Fraser, *Frothingham, Act. Com.*, 23 Jan., 1892, C. D. Ms.

4. Mistakes of Judgment.

Where, upon a motion for re-hearing, it was urged, *inter alia*, that there was an error in applying to mistakes of judgment in the conduct of a pending and original application the same strictness which the courts exercise in proceedings after the patent has been granted, and that the spirit and purpose of the patent laws were sacrificed to official routine: *Held*, that the allegation of error was answered by the simple consideration that there was applied to the applicant's case the same rule which has been applied by the Patent Office to similar cases for more than ten years past. It may be further said that there must be an end somewhere to the prosecution of an application, and *the Office, in consideration of the large amount of work imposed upon it and the constant struggle to keep from falling hopelessly in arrears, is fully justified in placing restrictions upon the power to bring up for consideration matters which it had good reason to suppose had been finally disposed of.*

Jameson, x. p., *Fisher, Act. Com.*, 14 July, 1890, C. D. Ms.

NOTE. — The italicized portion in the above decision would seem to imply belief of the Assistant Commissioner that the difficulty was, to an important extent, ministerial, and that the inadequacy of examining force (due to insufficiency of the annual appropriations) alone prevents the more just and liberal practice approved by the Commissioner (Mitchell) in person, in the case of Myers, x. p., (49 O. G., 131) (21) AMENDMENT, so lately as 24 Sep., 1889, and still more recently by the same Commissioner, in the case of Harrison, x. p., 15 Feb., 1890; RIGHTS UNDER ORIGINAL AND UNDER RE-ISSUE APPLICATIONS COMPARED. Of same tenor was the decision of Commissioner Leggett in the case of Noyes, x. p., 1872, C. D. 118. Finally, a like liberal and even indulgent treatment of original applications was (6 March, 1882) enjoined by the United States Supreme Court in the case of Heald *v.* Rice, 21 O. G., 1443, ✽.

5. Predecessor's Decisions.

Rule 144 was exhaustively considered by the present Commissioner in Daniels *v.* Morgan, 47 O. G., 811; and Green *v.* Hall *v.* Siemens *v.* Field, 47 O. G., 1631. In both cases it was held that the Commissioner has a right to re-hear a case decided by his predecessor, provided it is one which presents such a state of facts as would [in his opinion] warrant a new trial in an action at law, as for example:

(1) Where the finding is unsupported by the evidence; or
(2) Is manifestly the result of prejudice, bias, or passion; or where,
(3) The facts being conceded, there had been a clear error or mistake in the application to them of the rules of law.

Brown, x. p., *Fisher, Act. Com.*, 29 May, 1890, C. D. Ms.

6. Denied.

The fact that the petitioner for a re-hearing had been present and heard without taking exception, warrants

denial of a re-hearing on the ground of irregularity of original procedure.

Spielman, x. p., *Simonds, Com.*, 19 Feb., 1892, C. D. Ms.

7. Insufficient Showing.

The granting of a re-hearing is not warranted by simply raising a doubt as to whether the present trier might not have come to a different conclusion upon the case as originally presented.

Bausset, x. p., *Simonds, Com.*, 9 Ap., 1892, C. D. Ms.

RE-INSTATEMENT OF FORFEITED APPLICATION.

1. In petitions to revive applications, it is necessary to set the excuses out in detail, so as to enable the Office to judge whether the delay was unavoidable.

Krieg, x. p., *Mitchell, Com.*, 6 Feb., 1891, C. D. Ms.

2. Where the applicant's ordinary expenses largely exceeded his income, and he was financially unable to prosecute his case during two years after last Office action: *Held*, that the delay was unavoidable and petition to revive was granted.

Close, x. p., *Fisher, Act. Com.*, 11 Dec., 1890, C. D. Ms.

3. Poverty and business troubles held insufficient to revive an abandoned application where the last action was a decision by the Commissioner requiring division, and it did not appear why applicant had not directed his attorney to file an amendment cancelling the claims to be divided out, and asking for action on the merits of the remaining claims.

Davis, x. p., *Simonds, Com.*, 20 Aug., 1891, C. D. Ms.

4. Where the file-wrapper bore the endorsement "notice of allowance, Aug. 17, 1889," and the file con-

tained a duplicate of the notice bearing the same date: *Held*, that petition for re-allowance of the application forfeited for non-payment of the final fee, on the ground that no notice had been received, could not be granted (Eames, x. p., 2 Gourick, 12).

Nobs, x. p., *Fisher, Act. Com.*, 10 May, 1890, C. D. Ms.

5. Where a letter containing an amendment was addressed to the Commissioner of Patents and duly mailed some two months prior to the expiration of the two years' limit: *Held*, that, as the applicant had a right to assume that the letter would and did reach the Office, and as he did not know otherwise until the two years' limit had expired, the delay was unavoidable and the application should be revived.

Knowles, x. p., 6 Nov., 1889, C. D. Ms.

6. Where it appeared that an amendment, duly addressed to the Commissioner, had been deposited in a post office in Wisconsin, in time, in the regular course of mail, to have been delivered in the Patent Office before the expiration of the two years, but, through some failure of the mail, the amendment was not received until too late, a petition to revive was granted (Pratt, x. p., 39 O. G., 1549).

Wallace, x. p., *Fisher, Act. Com.*, 6 Dec., 1890, C. D. Ms.

See ABANDONED APPLICATION; APPLICATION; REVIVAL OF APPLICATION.

RE-INSTATEMENT OF AN INTERFERENCE.

1. When, in an interference proceeding, the Commissioner upon reconsideration vacates a former decision of abandonment, the re-instatement of the interference which had been dissolved by reason of the former deci-

sion follows as a necessary consequence, and an appeal from the action of the Examiner of Interferences in so re-instating it, will not lie.

Young *v.* Case, *Simonds, Com.*, 26 Jan., 1892, 58 O. G., 945.

2. When one effect of suspending an interference to add a new party would be to practically re-instate a party thereto who had allowed his rights to lapse by neglecting to take his testimony within the limited time, a request to suspend will be denied.

Wein *v.* Northrop, *Simonds, Com.*, 3 Mar., 1892, 58 O. G., 1416.

Compare (164) *et seq.*, INTERFERENCES.

RE-INSTATEMENT OF A WITHDRAWN CLAIM.

1. Re-instatement before final rejection permissible.

The applicant should not be precluded from inserting a claim because he had previously presented and cancelled a claim having the same scope, said claim not having been finally rejected.

Pierce, x. p., *Frothingham, Act. Com.*, 6 June, 1892, C. D. Ms.

2. Granted on sufficient showing.

Where, upon division being required, counsel directed the method claims erased, and, thereafter, the remaining claims were rejected, and, *within a few days after rejection*, counsel states that the action was a surprise to him, that he was not aware that he had filed any amendment, and that, if any had been filed, it was a mistake and he desired to withdraw it; *Held*, that the case came within exceptions to the rule (Rule 68 (2)), that an election was binding, and that the applicant's claims in this case should be re-instated upon filing an amendment in the

ordinary form asking a re-instatement of the matter erased.

Lyon *et al.*, x. p., *Fisher, Act. Com.*, 25 Feb., 1890.

3. Under Rule 165 an application will not be withdrawn from issue to permit applicant to re-insert therein a claim originally presented but voluntarily erased.

Wood, x. p., *Simonds, Com.*, 4 Jan., 1892, 58 O. G., 273.
See, however, Pierce, x. p., (1) *supra.*

4. A petition to be allowed to withdraw application from issue for further amendment granted where it appeared that applicant had prosecuted his application without an attorney, and, being ignorant of the patent law and not knowing the value of a claim, had failed to notice that his allowed claims did not cover all he was entitled to, and who, on discovering the insufficiency of his allowed claims, at once appointed an attorney, and asked that the case be withdrawn from issue and presented other claims for consideration.

Marx, x. p., *Mitchell, Com.*, 21 July, 1890, C. D. Ms.
Compare with Rieker *v.* Merrill, *Fisher, Act. Com.*, 24 July, 1890, Ms., (174) INTERFERENCE, in which (being a *contested* case) relief, similar to that granted in the *ex parte* case of Marx, was denied.

Compare also with Wallis, x. p., *Fisher, Act. Com.*, 25 Feb., 1890, Ms., (3) RE-OPENING OF CASE, in which, although an *ex parte* case, relief was denied because there was no special showing to justify it.

5. Ordinarily; a claim withdrawn to secure allowance cannot be re-instated after allowance.

The petitioner having, for a stated purpose and to secure early allowance, erased the claim which stood in the way of allowance, an allowance having accordingly been declared, and having subsequently changed his

mind and asked permission to withdraw the case from issue for re-instatement of said claim, and having failed to show that his case was one of special hardship, or that said erasure was made from inadvertence, accident, or mistake, — the petition was denied.

Potter, x. p., *Fisher, Act. Com.*, 14 Aug., 1890, 53 O. G., 760.

6. Where an applicant, desiring to have his case go to issue without the delay of appealing a rejected claim to the Examiners-in-Chief, withdrew the claim, which was thereupon erased and the case passed to issue: *Held*, that he could not, upon a subsequent change of mind, be permitted to withdraw the case from issue and re-instate the claim so withdrawn. Before a claim, deliberately erased, can be re-instated some good showing must be made of inadvertence, accident, or mistake in erasing the claim, or of especial hardship to the inventor.

Ib.

See Rules 142 and 68; and Roemer *v.* Peddee *et al.*, ✽ (72) CLAIMS; Sargent *v.* Hall, ✽, (10) PUBLIC RIGHTS AND OBLIGATIONS; Pennington, x. p., (7) and (9) *infra*.

Compare, however, Lyon, x. p., (2), Marx, (4) *supra*; and Welling, x. p., (38) DIVISION.

7. Re-instatement, in parent application, of claims that had been eliminated on requirement of division, — denied.

Where division had been required of an application that contained claims for both an article and a process, and applicant erased the claims for the article, expressly reserving the right to prosecute them in a separate application, and, after the process claims had been rejected, sought to re-instate the article claims, — erasing the claims for the method: *Held*, that applicant was *bound by his election* and could not be allowed to re-instate the article claims.

Pennington. x. p., *Fisher, Act. Com.*, 3 Jan., 1890, C. D. Ms.

NOTE (i). — In this case, however, the Assistant Commissioner remarked: It is not meant to hold that claims once erased from an application can never be restored; on the contrary, in Welling, x. p., 15 Mar., 1892 (C. D. Ms. 173), it was held that they could be restored if any special reason was shown for such indulgence on the part of the Office.

NOTE (ii). — Applicant's proper remedy was by a separate application.

Compare Welling, x. p., (38) DIVISION.

8. Where the Examiner had required a division of process and article claims and, after the process claims were erased, rejected the article claims: *Held*, that applicant could not be permitted to re-instate the process claims notwithstanding the fact that the Examiner's original action was erroneous, and the two inventions might have been properly included in the same application. *Applicant stands bound by his election.*

Jameson, x. p., *Fisher, Act. Com.*, 18 Feb., 1890, C. D. Ms.

NOTE. — For circumstances under which relief was, in like manner, denied, compare Donovan, x. p., (9), (10), Myers, x. p., (21) AMENDMENT; Wallis, x. p., (3) RE-OPENING; Pennington, x. p., (9) RE-INSTATEMENT OF WITHDRAWN CLAIM.

For circumstances under which relief was or would be granted, compare Noyes, x. p., (9) SPECIFICATION; Rogers, x. p., (2) EXAMINATION; Pennington, x. p., (7), Lyon, x. p., (2), Marx, x. p., (5) RE-INSTATEMENT; Welling, x. p., (38) DIVISION; and Pennington, (9) *infra.*

9. The Examiner's failure to furnish petitioner with sufficient information as to the state of the art to enable him to determine which branch of the case he should have pursued, is not [at this late stage in the proceedings] a sufficient reason for re-instating the claim. When petitioner wants to re-instate claims which he had stricken out, *the time to urge want of compliance with the rules was*

at the time division was required, and not several months after.

Pennington, x. p., *Fisher, Act. Com.*, 21 Feb., 1890, C. D. Ms.

10. Upon requirement of division of an application containing claims both for a process and the article manufactured, the applicant cancelled all matter and claims relating to the article: *Held*, that a petition to re-instate a claim to the article after allowance of certain process claims, must be denied for want of proper showing, inasmuch as certain affidavits filed to show such public use as would preclude filing a new application did not set forth facts from which the trier could ascertain whether or not public use had taken place, but merely the petitioner's conclusions; and, moreover, it did not appear that applicant could not properly file a divisional application for the article which would date back to the parent application.

Steffin, x. p., *Frothingham, Act. Com.*, 17 Feb., 1892, C. D. Ms.

11. To justify the re-instatement of a claim that had been deliberately erased before final rejection, it is necessary to show inadvertence, accident, or mistake, or irreparable injury, even if presented for the purpose of taking an appeal.

Auchu, x. p., *Frothingham, Act. Com.*, 23 Feb., 1892, C. D. Ms.

See, however, Pierce, x. p., (1) RE-INSTATEMENT OF WITHDRAWN CLAIM.

12. Re-instatement of claim withdrawn by associate attorney, — refused.

It is not sufficient ground for withdrawing an application from issue to re-instate a claim that its withdrawal from the case was done by the associate attorney who did not understand the invention, and that applicant only knew within a few days of its having been stricken out,

and that he believed it to be of very great importance and as fully marking the invention over the references.

Eilers, x. p., *Frothingham, Act. Com.*, 4 Feb., 1892, C. D. Ms.

Compare (1) *et seq.*, ATTORNEY.

See, however, Stutz *v.* Armstrong, (6) RE-ISSUE.

13. Where a patentee, in his original application, had claimed a certain construction, and, upon rejection by the Patent Office, erased the claim, and his patent accordingly issued without it: *Held*, that he was thereafter estopped from asserting such a claim, and such claim in the re-issued patent was void.

Dodds *v.* Stoddard, *Sage, J.*, 6 July, 1883, 24 O. G., 799.

RE-ISSUE.

THE LAW.

1. A patent with a defective specification may be surrendered and be re-issued (for the residue of the original term) in an amended form.

Whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, . . . if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the Commissioner shall, on surrender of such patent and the payment of the duty required by law, cause a new patent for the same invention and in accordance with the corrected specification, to be issued to the patentee . . . for the unexpired term of the original patent. Such surrender shall take effect upon the issue of the amended patent. The Commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant and upon payment of the required fee for a re-issue for each of such re-issued letters-patent. . . . No new matter shall be introduced into the specification, nor, in case of a machine patent,

shall the model or drawings be amended except each by the other; but when there is neither model nor drawing, amendments may be made upon proofs satisfactory to the Commissioner that such new matter was a part of the original invention, and was omitted by inadvertence, accident, or mistake.

Sec. 4916 R. S.

DEDICATION.

2. Ordinarily; omission in an original application to claim matters that were described and might have been claimed must be construed a dedication of them to the public.

Suit was brought in a Circuit Court, in the District of Connecticut, to restrain infringement of a patent, etc. The patent was for an alleged improvement in lamps, and was originally granted for fourteen years, 16 Oct., 1860; was re-issued May, 1873; was extended for seven years longer in Oct., 1874; and the extended patent was, fifteen years after the original grant, revised, surrendered, and, for a second time, re-issued with new and important claims. Judgment having been denied and the case being appealed by complainant, the Supreme Court said: The invention as originally claimed had proved to be a failure, but after being changed to a form which the patentee, in his original specification, had professed to avoid and dispense with, proved to be a great commercial success, and both plaintiff and defendant made such lamps in large quantities. Fifteen years after the original patent was granted, the patentee, or rather his assignee, discovers that the improved lamp was really a part of the original invention, and that, by inadvertence and mistake, the patentee had omitted to claim it. We think, however, that the court below was clearly right in holding that the invention specified in the second claim of the re-issued patent, which is the one in question here,

is not the same invention which was described and claimed in the original patent. These after-thoughts, developed by the subsequent course of improvement, and intended, by an expansion of claims, to sweep into one net all the appliances necessary to monopolize a profitable manufacture, are obnoxious to grave animadversion. The pretence, in this case, that there was an inadvertence and oversight which had escaped the notice of the patentee for fifteen years is too bald for credence. He simply appealed from the judgment of the Office in 1860 to its judgment in 1876; from the Commissioner and Examiners of that date to the Commissioners of this.

Edward Miller & Co. *v.* The Bridgeport Brass Co., U. S. S. C. By *Bradley, J.*, 9 Jan., 1882, 21 O. G., 201. ✱.

3. Acceptance of Original Patent. — Estoppel.

If applicant accepted the original patent containing limitations imposed by the Patent Office, and which narrowed the scope of the invention from that first described and claimed in the application, the undue restriction of the claim cannot properly be attributed to "inadvertence, accident, or mistake," within the meaning of the statute.

Smith, x. p., *Frothingham, Act. Com.*, 20 Nov., 1891, C. D. Ms.

Compare, of like general purport, (1) *et seq.*, DEDICATION; (5) ESTOPPEL; (10) PUBLIC RIGHTS AND OBLIGATIONS; and (10) SCOPE OF PATENT.

For qualifications of above general rule, see (5), (6), and (7) *infra*.

4. Attorney's action binding.

The rejection in the original application having been deliberately acquiesced in by the attorneys, as indicated by the character of the correspondence that followed the numerous actions of the Office, and, finally, by the

cancellation of the claim before patent was allowed, the applicants would have been chargeable with knowledge of what their attorneys had done even if it had not appeared affirmatively that they had such knowledge (Hatchman, x. p., 25 O. G., 979). Affirmed by the Supreme Court of the District of Columbia, 3 Mackey, 288; Arnheim *v.* Finster, 32 O. G., 256; Dobson *v.* Lees, *per curiam*, 30 F. R., 625. Affirmed, 137 U. S., 25; 34 L. ed., 652,* ; Hoeveler & McTighe *v.* Verner *v.* Nicholson, 2 Gourick, 51).

Hoveler & McTighe, x. p., *Mitchell, Com.*, 26 Mar., 1891, C. D. Ms.

See, of like tenor, Binford, x. p., (1), and Tuoti, x. p., (2)

ATTORNEY.

See, however, Stutz *v.* Armstrong, (6) *infra.*

5. There is no warrant for the suggestion that what is described and shown in the original specification and drawings is necessarily to be regarded as so dedicated to the public, or that, if not claimed in the original, it cannot be claimed in a re-issue.

Selden *v.* Stockwell, *Blatchford, J.*, 5 Sep., 1881, 20 O. G., 1377.

6. A claim erased from the original application through mistake of solicitor, may be re-instated in the re-issue.

Where it appears, from the original papers in the case, that a certain feature was within the contemplation of the inventor as a valuable element in the patentable combination, and it is proved that a claim embracing such feature was erased from the original application through a misunderstanding of the invention by the solicitors: *Held*, that the Commissioner of Patents committed no error in granting a re-issue containing a claim embracing such feature.

Stutz *v.* Armstrong, *Acheson, J.*, 4 July, 1884, 28 O. G., 367.

Compare Hoveler & McTighe, (4) *supra.*

7. "Inadvertence, Accident or Mistake."

A clear mistake inadvertently committed in the wording of a claim is necessary, without reference to the length of time, to make valid the enlargement of a claim on a re-issue of the patent.

Yale Lock M'f'g Co. *v.* Berkshire Nat. Bank, U. S. S. C. By *Blatchford, J.*, 5 May, 1890, 34 L. ed. 168, ✱.

8. The question whether the facts set forth in the statement filed with a re-issue application constitute "inadvertence, accident, or mistake," is one pertaining to "*the merits*," and is appealable, in the first instance, to the Examiners-in-Chief.

Murphy & Atkinson, x. p., *Simonds, Com.*, 10 Sep., 1891, 56 O. G,, 1449.

9. "Inoperative or Invalid."

The words "inoperative or invalid," in the statute authorizing re-issues, mean inoperative or invalid in whole or in part, and, consequently, the words "*not fully operative*" would conform to the true intent of the law, if the law required an oath, which it does not. In the matter of applications for re-issue, there is no law requiring the applicant to take oath on the subject of the invalidity of the original patent.

Hartshorn *v.* Eagle Co., *Lowell, J.*, 11 Oct., 1883, 25 O. G., 1191.

10. Where the claim is not expanded, — delay is immaterial.

Re-issue No. 9148 held to be valid notwithstanding the application for it was nearly ten years subsequent to the date of original issue, that no facts in excuse for this apparent *laches* are shown or claimed to exist, and that the specification of the re-issued patent has seven claims where that of the original patent had only one; because

the claims of the re-issued patent are, separately, within the original claim, and all combined are no more than its legal equivalent (Am. Boring Co. *v.* Sheldon, 33 O. G., cited and applied).

Reed *et al. v.* Chase *et al.*, *Matthews, J.*, 14 Aug., 1885, 25 Fed. Rep., 94.

11. If separable claims of re-issue cover the same invention as the original and no more, such claims would seem to be as valid as the original and would be infringed by whatever would infringe that.

Am. Diamond Rock Boring Co. *v.* Sheldon, *Wheeler, J.*, 9 Dec., 1885, 33 O. G., 1598.

12. A claim may be enlarged by re-issue, but where such enlargement is sought, the rule of *laches* will be strictly applied. — "Error of Judgment" explained.

A claim may, it is true, be enlarged in a re-issued patent, but, in such case, the rule of *laches* should be strictly applied; no one should be relieved who has slept upon his rights, and has thus led the public to rely on the implied disclaimer involved in the terms of the original patent. If a patentee who has no corrections to suggest in his specification except to make his claim broader and more comprehensive, uses due diligence in returning to the Patent Office, and says, "I omitted this," or "My solicitor did not understand that," his application may be entertained, and on a proper showing, correction may be made; but it must be remembered that *the claim of a specific device or combination and an omission to claim other devices or combinations apparent on the face of the patent, imply an admission that the latter are not his invention or constitute a dedication of them to the public.* This legal effect of the patent cannot be revoked unless the patentee promptly surrenders it and proves that the specification was so framed by real inad-

vertence, accident, or mistake, without any fraudulent or deceptive intention on his part. If two years' public enjoyment of an invention with the consent and allowance of the inventor is evidence of abandonment and a bar to application for a patent, a public disclaimer in the patent itself should be construed equally favorable to the public. While, as before stated, we do not deny that a claim may be enlarged in a re-issue patent, we are of the opinion that this can be done only when an actual mistake has occurred, not from mere error of judgment (for that may be rectified by appeal), but a real *bona fide* mistake, inadvertently committed, such as the court of chancery in cases within its ordinary jurisdiction would correct.

Edward Miller & Co. *v.* The Bridgeport Brass Co., U. S. S. C. By *Bradley, J.*, 9 Jan., 1882, 21 O. G., 201, ✱.

NOTE. — An earlier paragraph in the above decision would seem to suggest that the patentee may have neglected his proper remedy by omitting to appeal during the pendency of the application, and inasmuch as "an error" of the patentee's "judgment" manifestly could not "be rectified by appeal," *error of official judgment only can have been here intended.* It would hence seem that the patentee may correct *his own* oversights and errors of judgment, even to the extent of broadening his claim, providing he proceeds to do this promptly on discovery of the mistake and before conflicting rights have had time to intervene.

See, also, Dodds *v.* Stoddard, (5) ESTOPPEL; and Hartshorn *v.* Eagle Co., (20) and Odell *v.* Stout, (33) *infra.*

13. Judge Lowell (in Jones v. Barker) referred to the fact that Mr. Justice Bradley, speaking for the Supreme Court, in Miller v. Bridgeport Brass Co., emphasized the danger and injustice of enlargements and the necessity of prompt application for them,

before new inventions have been made or new enterprises set on foot. He (Bradley, J.,) intimates that two years (in analogy to the law of forfeiture) would be the utmost possible limit of time; but "as he (Lowell, J.,) understood the opinion," even anything like two years would be inadmissible in ordinary cases.

Jones *v.* Barker, *Lowell, J.*, 24 Mar., 1882, 11 F. R., 597.
See also Lee, x. p., *Marble, Com.*, 23 Dec., 1882, 23 O. G., 342.

14. Ordinarily; in seeking by re-issue to rectify a defective patent, a delay of more time than would be reasonably sufficient to read the patent and ascertain its need of amendment should be accounted *laches* in a case where enlargement of the claim is the only amendment.

Hartshorn *v.* Eagle Co., *Lowell, J.*, 11 Oct., 1883, 25 O. G., 1191.

15. The presumption is in favor of the validity of a re-issue applied for and obtained in less than two years after the issue of the original patent.

Alaska Refrig. Co. *v.* Wisconsin Refrig. Co., *Blodgett, J.*, 18 July, 1891, 57 O. G., 125.

See also Miller *v.* Bridgeport Brass Co.,❁ : James *v.* Campbell, ❁ , and Stutz *v.* Armstrong, (16) *infra.*
Compare, however, Hartshorn *v.* Eagle Co., (14) *supra.*

16. The fact that a re-issue application was filed within two years after the grant of the original patent, while it may not be conclusive against the charge of unreasonable delay, is entitled to some consideration in view of that provision of the patent law by which nothing less than two full years' public use of an invention is a bar to an application for a patent.

Stutz *v.* Armstrong, *Acheson, J.*, 4 July, 1884, 23 O. G., 367.

17. In determining whether an inventor is guilty of inexcusable delay, the fact that the correction of a mistake by re-issue was before any adverse rights had accrued is a consideration of paramount importance, and it ought to count something in his favor that, being of foreign birth and education, and of alien tongue, he encountered difficulties in acquiring a knowledge of our language and laws.

Ib.

18. Where application for re-issue seeks *expansion* of the claim, ordinarily a delay of more than two years would require special circumstances for its excuse.

No invariable rule can be laid down as to what is a reasonable time within which the patentee must seek for correction of a claim which he considers too narrow. It is for the court to judge in each case, and it will exercise proper liberality toward the patentee; but as the law charges him with notice of what the patent contains, he will be held to reasonable diligence. By analogy to the rule as to the effect of public use before an application for a patent, a delay of more than two years would, in general, require special circumstances for its excuse.

Mahn *v.* Harwood, U. S. S. C. By *Bradley, J.*, 1 Dec., 1884, 30 O. G., 657,✽.

19. The settled rule is, where the claim is *expanded*, that a delay for more than two years in applying for re-issue invalidates the re-issue, unless such delay is accounted for and excused by special circumstances. It is a question of law, arising on the face of the bill, when such delay is not therein explained. Averment in the bill that Examiner had decided that applicant had satisfactorily explained the delay is not enough. The very question for judicial review is whether the

Patent Office decided rightly, and the special circumstances held to have excused delay should have been set out in the bill. Decree of Circuit Court dismissing bill for want of equity affirmed.

Woolensak *v.* Reiher, U. S. S. C. By *Matthews, J.*, 4 May, 1885, 31 O. G., 1301, ✱.

20. The re-issue, 31 Oct., 1876, of a patent whose original grant bore date 24 Sep., 1867, sustained, on the ground that the circumstances of the long delay (seven years and eight months) in making application for re-issue were unusual and grew out of an actual mistake, discovered by testimony given in court seven years after the original grant.

Hartshorn *v.* Eagle Co., *Lowell, J.*, 11 Oct., 1883, 25 O. G., 1191.

21. Ill health ending in insanity excuses delay.

Where the original patent was granted in Dec., 1877, and re-issue was not applied for until Aug., 1880: *Held*, that the delay was excused by the fact that the inventor was in poor health and, at times, mentally deranged during the years 1878 and 1879, so that he was, much of the time, unfit to attend to business, and finally, in the spring of 1880, became wholly insane and continued so until 1884.

Whitcomb *v.* Coal Co., U. S. C. C., N. D. Ill. By *Blodgett, J.*, 42 F. R., 652.

22. If a re-issue be sought to enlarge a claim, a delay of two years from the original grant in applying therefor will ordinarily, though not always, be treated as evidence of abandonment of the new matter to the public.

Topliff *v.* Topliff *et al.*, U. S. S. C. By *Brown, J.*, 25 Ap., 1892, 59 O. G., 1256, ✱.

23. Where, date of filing of an application for a re-issue was more than 14 years after the grant of the original patent, and applicant contended, *inter alia*, that he did not discover the alleged errors until certain claims of the original patent had been held by the Circuit Court not to cover a certain feature which he desired to cover by the re-issue: *Held*, that, under the decisions in Woollensak *v.* Reiher (115 U. S., 99), ❋, and Mahn *v.* Harwood (112 U. S., 354), ❋, the long delay in making the discovery was inexcusable.

Smith, x. p., *Frothingham, Act. Com.*, 20 Nov., 1891, C. D. Ms.

24. Filing date of an Application for Re-issue.

An application for re-issue, complete except as to the abstract of title required by Rule 86, will be restricted, as to filing date, to the day the abstract of title was filed, although an order for the abstract was made and the necessary funds were deposited the day the application was filed, and the delay was caused by the time taken by the Office to file the order; but such delay should not count against the applicant as far as the question of diligence in filing the application is concerned.

Flagg, x. p., *Frothingham, Act. Com.*, 9 Nov., 1891, C. D. Ms.

25. Revision of specification permissible.

The statute allows the revision and correction of the specification on an application for re-issue. In Carew *v.* Fabric Co. (3 Cliff. 356), it was held that "an applicant for re-issue may re-describe his invention and include in his description and claims, not only what was well described before, but also what is *suggested* in the original drawings, specifications, or [where one was filed] the model.

Whitcomb *v.* Coal Co., U. S. C. C., N. D. Ill., *Blodgett, J.*, 42 F. R., 652.

26. When it can be seen that the Patentee seeks, by apt words of description, to secure what he has honestly invented, and nothing more, the court should hesitate to regard with favor the accusation now so freely made against re-issued patents.

Crandall *v.* Parker, *Coxe, J.*, 7 July, 1884, 28 O. G., 369.

27. The law provides for and allows re-issues for the corrections but not for alterations.

Doane & Wellington *v.* Smith, *Wheeler, J.*, 27 Dec., 1882, 1883, C. D. 328; 47 O. G., 202.

28. *Uses and results*, not set forth in the original, may be stated and described in the re-issue.

An inventor is entitled to all the uses to which his invention can be applied, and to all the beneficial results which legitimately follow the use of his instrumentalities, as shown by the statement of his invention and the figures used to illustrate it; and such uses and results may be stated and described in an application for re-issue by the inventor, without subjecting him to the imputation of incorporating new matter.

Putnam *v.* Yerrington, *Nixon, J.*, 28 Mar., 1876, 9 O. G., 689.

29. There was nothing in Morse's re-issue (No. 117, 1848) to justify the charge that the invention therein described is not the same with the one intended to be secured by the original patent. The re-issue was made by the proper lawful authority, and it was the duty of the Commissioner of Patents to see that it did not cover more than the original invention. It must be presumed, therefore, that it does not until the contrary appears. Variations from the description given in the former specification do not necessarily imply that it is for a different discovery. The right to surrender the old

patent and receive another in its place was given for the purpose of enabling the patentee to give a more perfect description of his invention, when any mistake or oversight was committed in his first. *It necessarily, therefore, varies from it.*

O'Reilly *et al. v.* Morse *et al.* By *Taney, Ch. J.*, Dec., 1853, 15 Howard, 62, ❁.

30. Enlarged Claim.

It is the obvious intent of the statute that a re-issue may be had for an enlarged claim provided it is evident that there has been a mistake and that the applicant has been guilty of no want of reasonable diligence in discovering it, and that no third persons have meanwhile acquired rights to manufacture or sell what he had failed to claim.

Topliff *v.* Topliff *et al.*, U. S. S. C. By *Brown, J.*, 25 Ap., 1892, 59 O. G., 1256, ❁.

31. "Different Invention."

An invention embodied in a given structure and restrictedly claimed does not [necessarily] become a different *invention* when claimed more broadly or generically.

Edison, x. p., *Mitchell, Com.*, 6 Jan., 1891, 54 O. G., 263.

32. The Supreme Court has never so construed the Statute (R. S., Sec. 4916), which authorizes re-issues, as to deny to the patentee, on application *made in due time and before adverse rights have accrued*, the right to obtain a re-issue broad enough to cover his entire invention, as originally described and as he *intended* to claim it.

Walker *v.* City of Terre Haute, *Gresham, J.*, 29 Oct., 1890, 54 O. G., 507.

33. Claim may be enlarged if patentee move promptly and before the rights of others have intervened.

There is no rule fixing the precise time within which application for re-issue may be made. What is a reasonable time is a question, when re-issue is attacked, to be decided by the court upon the case presented. The rule is equitable, and therefore flexible, to be applied according to equity. Upon the authority of James *v.* Campbell, and other decisions of the Supreme Court, it is clear that the claim of a patent may be enlarged by re-issue if the patentee move promptly and before rights of others have intervened; and the delay in this case — six months — was not unreasonable.

Odell *v.* Stout, *Sage, J.*, Oct., 1884, 29 O. G., 862.

34. Where an applicant has by "inadvertence" claimed less than he was entitled to claim, he may have a re-issue with enlarged claims (citing Topliff *v.* Topliff *et al.*, 59 O. G., 1257). The "*inadvertence*" upon which applicant relied was simply that he had taken a claim of less breadth than he was entitled to in his original patent. The original specification makes a suitable disclosure on which the claims now presented might be based. Neither of these claims was presented in the original case, but there was no statement distinctly negativing the idea that applicant had a right to make them. In the period between the original issue and the present application no evidence appears of the manufacture, sale, or use of the invention by others than the inventor and his assigns. Decision of Examiners-in-Chief reversed.

Stanley, x. p., *Simonds, Com.*, 22 July, 1892, 60 O. G., 735.

35. The re-issue of patents with expanded or equivocal claims where the original was clearly neither "inoperative" nor "insufficient," is a great abuse of the

privilege granted by the statute, and productive of great injury to the public. This privilege was not given to the patentee or his assignee in order that the patent may be rendered more elastic or expansive, and therefore more available for the suppression of all other inventions.

Burr *v.* Duryee, U. S. S. C. By *Grier*, *J.*, 28 Mar., 1864, 68 U. S., ✽.

36. A patent for a machine cannot be broadened, on re-issue, to cover a process described, but not claimed, in the original patent. If *the process* was patentable it should have been included in the original patent.

New *v.* Warren, *Wheeler*, *J.*, 22 July, 1882, 22 O. G., 587.

NOTE. — Or in a seasonably presented application for a separate patent on the process.

37. The right to expand a claim by re-issue exists for a reasonable time after the original patent is granted, provided the limits of the original *invention* are not exceeded, and provided the error arose by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention. After the expiration of a reasonable time, no claim may be allowed which exceeds in scope the original claim, even though the latter stated the actual invention too restrictedly. It has now become familiar law that the latter rule must be applied to an application for re-issue filed nearly four years after the granting of the original patent.

Pepper, x. p., *Mitchell*, *Com.*, 26 May, 1891, C. D. Ms.

For definition of a reasonable limit of time, see Jones *v.* Barker, (13), and Odell *v.* Stout, (33) *supra*.

MUST RELATE TO THE SAME INVENTION.

38. When the claims of a re-issued patent involve a total abandonment of the principles which, in the origi-

nal patent, were stated to be those of the invention, the re-issued patent is invalid.

The Parker & Whipple Co. *v.* The Yale Lock Co., *Shipman, J.*, 2 Oct., 1883, 25 O. G., 390.

39. It is well settled that only "*the same invention*" can be covered by the re-issue patent. It is equally well settled that the meaning of said phrase has been established to be *whatever invention was described in the original letters-patent, and appears therein to have been intended to be secured thereby* (Parker & Whipple Co. *v.* Yale Lock Co., 123 U. S., 87,✽; Hoskin *v.* Fisher, 125 U. S., 217,✽; Flower *v.* Detroit, 127 U. S., 563; and Pattee Plow Co. *v.* Kingman, 129 U. S., 294, ✽.

Smith, x. p., *Frothingham, Act. Com.*, 20 Nov., 1891, C. D. Ms.

40. Where it appeared that a patent was granted in 1872 and that the re-issue application was made in 1881, and that no question of inoperativeness or invalidity was raised during that period, and where the sole object of the re-issue was to expand and multiply the claims so as to cover patents issued subsequently to the original: *Held*, that the re-issued patent was invalid because the new claims were not for the same invention set forth in the claims of the original patent. In such a case, the delay of nearly nine years is fatal, especially as no inadvertence, accident, or mistake appears such as would authorize a re-issue with new claims.

Elec. Gas-Lighting Co. *v.* Boston Elec. Co., U. S. S. C., 6 Ap., 1891, 55 O. G., 429, ✽.

41. The rule should be;—liberality in the case of original applications;—strict construction in the case of application for re-issue.

To accord the same latitude in applications for re-issue as in original applications would open a wide door to

fraud. A patentee, if allowed to interpolate new uses, new descriptive matter, new names, etc., might, by frequent re-issues, keep full pace with the advancement of the art to which his patent appertains, and might appropriate to his own use improvements and inventions made by others. The rule should be, liberality with original applications, strict construction with applications for re-issue. In departing from the exact form of the original statement, the application should show good reason therefor.

Noyes, x. p., *Leggett, Com.*, 1872, C. D. 118.

42. Norton's re-issue for an improved post-office stamp for printing the post-mark and cancelling the postage-stamp at one blow: *Held*, to be void for the reason of not being for the same invention specified in the original.

James *v.* Campbell, U. S. S. C. By *Bradley, J.*, 9 Jan., 1882, 21 O. G., 337, ❁.

43. In such case, the court ought not to be required to explore the history of the art to ascertain what the patentee *might* have claimed. He is bound by his statement of what his invention was.

Ib.

44. If a patent fully and clearly describes and claims a specific invention, complete in itself so as not to be "inoperative or invalid by reason of a defective or insufficient specification," a re-issue cannot be had for the purpose of expanding and generalizing the claim so as to embrace any invention not specified in the original. Burr *v.* Duryee (68 U. S.), reaffirmed and applied.

Ib.

45. Rectification of Claims that were narrower than the Actual Invention.

It may be regarded as the settled rule of the Supreme Court that the power to re-issue may be exercised when

the patent is inoperative either from the fact that the specification was defective or insufficient, *or* from the fact that the claims were narrower than the patentee's actual invention, provided the error arose from "inadvertence, accident, or mistake," and the patentee is guilty of no fraud or deception; but that such right is subject to the following qualifications:—

(1) That the re-issue shall be for the same invention as the original patent.

(2) That due diligence was exercised in discovering the mistake.

(3) That, if the re-issue be sought for the purpose of enlarging the claim, a lapse of two years from the original grant will ordinarily — though not always — be treated as evidence of abandonment of the new matter to the public to the same extent that a failure by the inventor to apply for a patent within two years from the public sale or use of his invention is regarded by the statute as conclusive evidence of abandonment of the invention to the public.

(4) That, unless otherwise manifest from the record, the court will not review Commissioner's action on question of inadvertence.

Topliff *v.* Topliff, U. S. S. C. By *Brown, J.*, 2 May, 1892, 36 L. ed., 499, ❁.

RE-ISSUE IN DIVISIONS.

46. A re-issue is not void because one division of the re-issue is identical with the original patent.

Inter. Terra Cotta L. Co. *v.* Maurer, U. S. C. C., S. D. N. Y., *Coxe, J.*, 44 F. R., 118.

47. Amendment of original drawing inadmissible.

Where, in an application for re-issue, the drawings presented by applicant were, in all respects, the same as those in the patent, and the Examiner required the addition of a new figure to show a part of the machine in section, which the applicant declined to add, upon the

ground that, being a re-issue application, any amendment of the drawings is prohibited by the statute: *Held*, that (no model having accompanied the original application) a strict interpretation of the statute (4916 R. S.) would forbid any amendment of the drawings, and, while it might be true that the statute might be more liberally interpreted so as to include amendments required by the *Examiners* still there is room for doubt, and the Office would not be justified in forcing an applicant to incorporate an amendment which might possibly result in having his re-issue patent declared void.

Rogers, x. p., *Fisher*, *Act. Com.*, 19 Mar., 1890, C. D. Ms.

48. The Rule in Parker & Whipple Co. *v.* Yale Lock Co. (123 U. S., 87; 25 O. G., 290). Re-affirmed, that a Patent Office model alone is not to be considered the basis for a re-issue in which a change of the [scope of the] invention of the original patent is sought.

Flower *et al. v.* City of Detroit, U. S. S. C. By *Blatchford, J.*, 14 May, 1888, 43 O. G., 1348, ✽.

49. Invalidity of a claim in a re-issue does not impair the validity of a claim repeated from one in the original grant and separately stated in the re-issue.

Schillinger *v.* Greenway, *Blatchford, J.*, 11 July, 1883, 24 O. G., 495.

50. Where an original patent is valid, but the re-issue based thereon is invalid, there is no good reason why a second re-issue, embracing the valid claim alone of the original patent, would not be valid.

Giant Powder Co. *v.* Safety Powder Co., *Sawyer, J.*, 18 Feb., 1884, 27 O. G., 99.

51. No action can be sustained under a re-issued patent for damages for alleged infringement committed before the date of re-issue.

Moffitt *v.* Garr, *Leavitt, J.*, Ap., 1860, 1 Fisher, 610.

REJECTION.

1. Grounds of.

Either a description [such as would enable an expert to practice the invention by the exercise of ordinary judgment and skill] in a patent or a printed publication antedating claimant's disclosure, or public use of the invention in the United States antedating his application by more than two years, if discovered before grant, justifies its refusal, or, if after the grant, its invalidation.

Sec. 4887 R. S.; Sec. 4920 R. S.

2. Should embrace all objections.

Rejection, in whole or part, of an application should embrace all objections, both those relating to form and those relating to substance, in order that the entire merits of the application may be determined on a single appeal to the Examiners-in-Chief.

Wiard, x. p., *Mitchell, Com.*, 19 Mar., 1890, 51 O. G., 155.

3. When a claim is criticised in matter of form only, such criticism should be put into the form of an *objection* and not a rejection. Claims should be rejected only upon grounds which are appealable to the Examiners-in-Chief.

Pfingst & Bemis, x. p., *Fisher, Act. Com.*, 24 Mar., 1890, C. D. Ms.

4. Upon a petition from rejection of a claim presented by amendment: (1) on the ground of being new matter; but also (2) from Examiner's neglect to take timely action on the merits of the claim: *Held*, that on the first point the remedy was by appeal to the Examiners-in-Chief under Rule 133; but on the second point the petition was sustained; it was the Examiner's duty, in rejecting the claim, to reject it for all the reasons which,

in his opinion, are applicable (Bailey, x. p., 52 O. G., 608. See also Roberts, x. p., 51 O. G., 155; and Wiard. x. p., 51 O. G., 155).

Blanchard, x. p., *Frothingham, Act. Com.*, 16 Dec., 1891, C. D. Ms.

5. Indefiniteness. — "Merits."

Upon petition from rejection by Examiner of a claim for indefiniteness, and where the language in the Examiner's statement showed that his real objection was inoperativeness, because of the absence of a necessary feature and want of novelty: *Held*, that they were proper grounds for rejection on "the merits," but not for indefiniteness, and the objection as to indefiniteness overruled, without prejudice as to rejection for inoperativeness or in view of the prior art.

Perkins, x. p., *Simonds, Com.*, 29 Dec., 1891, C. D. Ms.

6. New Matter. — Appeal to Examiners-in-Chief.

Where the objection of inoperativeness was removed by amendment, but the Examiner finally rejected the application upon the ground that the amendment constituted "new matter not shown or described in the application as originally filed:" *Held*, upon petition to the Commissioner, that appeal should have been taken to the Examiners-in-Chief, and although it seemed that the amendment set forth an operative invention "by material and obvious changes," yet that question was for the Examiner to decide, subject to appeal to the Examiners-in-Chief.

Kinn, x. p., *Mitchell, Com.*, 28 Feb., 1891, C. D. Ms.

7. Surmise not a proper ground for rejection.

Although it may be suspected that the device in a reference has, possibly, the action that applicant's device

has, such a suspicion is not a proper basis for rejection. To treat such a suspicion as a certainty would be to read something into a patent in view of later developments.

Aldersley, x. p., *Simonds, Com.*, 17 Feb., 1892, C. D. Ms.

NOTE. — In this case the Commissioner reversed the Board's action which rejected Claim 2, but expressed the opinion that "applicant's original Claim 2 limited and specified his actual improvement better than the Claim 2 above quoted," and the Examiner in charge was recommended to adopt the same "in accordance with applicant's proposed amendment of this date."

8. References, Applicant's Right to demand.

Examiner having rejected the application for lack of novelty, but cited no references; applicant petitioned that the Examiner be instructed to either allow the case or to reject, as provided under the rules, by the citation of references: *Held*, that as it did not appear improbable that the device might be patentable if a certain scale on one of its sides were new, for that reason, if for no other reason, the applicant should, if possible, be given a reference showing that that particular scale was old, so as to enable him to judge of the propriety of further prosecuting the case by way of appeal.

Seeman, x. p., *Frothingham, Act. Com.*, 13 Oct., 1891, C. D. Ms.

9. Application of References to specific Claims, — Rule 66.

Where Examiner's letter advised applicant what elements of the various combinations claimed by him might be found in the prior art, and then said, "In view of these references the case is believed to possess no patentable novelty, and the claims are believed not to embrace patentable combinations," and applicant peti-

tioned, asking Commissioner "to rule that the Examiner shall apply the references to the claims:" *Held*, that there is no rule of the Office requiring that an "Examiner shall apply the references to the claims," and that that part of Rule 66 which requires the anticipated claims to be specified was observed in the Examiner's letter by the use of the words "the claims are not believed to embrace patentable combinations," as that meant all of the claims; and that it must be held that the Examiner had said enough to inform an experienced attorney of the substantial nature of the objections he had made. Petition denied.

Bowen, x. p., *Simonds, Com.*, 28 Dec., 1891, C. D. Ms.

10. Newly discovered References.

On discovering new ground for rejection after an appeal has been taken, the Examiner's proper course is to direct the attention to it of both applicant and the Examiners-in-Chief. The applicant, thereupon, may elect either —

(1) To continue the prosecution of the appeal, in which case, the Examiners-in-Chief render their decision, affirming or reversing the decision of the Primary Examiner *upon the "points" upon which the appeal has been taken*, considering all other matters referred to by the Examiner in a separate statement annexed to their decision, or, in case of waiver by the applicant, including them in their decision; or, on the other hand,

(2) Applicant may withdraw the appeal and, on complying with the rules, may be heard by the Primary Examiner with reference to said newly discovered ground of rejection in the same manner as if it had been discovered and cited before the appeal was taken.

Mevey, x. p., *Mitchell, Com.*, 19 Ap., 1891, C. D. Ms.

11. Second rejection not final if based on a new reference or ground of objection.

Where the first rejection was based entirely upon a prior patent and the second rejection was based on the

objection that the subject-matter of the claims was merely the result of the substitution of equivalents: *Held*, that, the second letter raised a ground of rejection which was not raised in the first letter, and that therefore the claims were not ready for final rejection.

Anderson, x. p., *Fisher*, *Act. Com.*, 24 Nov. 1890, C. D. Ms.

REMANDMENT.

To Primary Examiner.

Where an objection was raised before the Examiners-in-Chief by a passage in the Primary Examiner's statement: *Held*, upon a petition to re-open, that, the objection not having been raised by the Examiner when the case was before him, applicant should be afforded opportunity to contest it or to offer amendments calculated to remove it, and the petition was granted.

Ries, x. p., *Mitchell*, *Com.*, 23 Mar., 1891, C. D. Ms.
Compare Mevey, (4) EXAMINER.

RENEWAL OF ALLOWANCE.

1. Every patent is required to bear date as of a day not later than six months from the time at which it was passed and allowed and notice thereof was sent to the applicant or his agent; and if the final fee is not paid within that period the patent shall be withheld.

R. S., 4885.

NOTE. — If final fee is received within six months after original allowance but too late for the patent to *issue* within that time, the Office customarily renews the allowance so as to secure a valid issue.

2. There is no statute or rule by which an allowed application, on which at or before the expiration of six months the final fee remains unpaid, will be saved from

forfeiture by the fact of a new application for the same invention having been previously filed.

Manny, x. p., *Hall, Com.*, 16 July, 1888, 44 O. G., 700.

3. In case of an allowed application in which renewal fees were paid but in which the final Government fees for issue of patent on the original application were not paid before the lapse of six months from allowance; the action of the officer in charge, in permitting the filing of renewal and accepting a renewal fee, was in contravention of law and of the ruling in Manny, x. p. (44 O. G., 700), and was rescinded, and the application was directed to be placed among allowed and forfeited cases and the applicant to be notified thereof.

Nicholson, x. p., *Mitchell, Com.*, 17 June, 1890, 52 O. G., 310.

4. Nevertheless a *new* application may be made for the same invention at any time within two years after the allowance of the original application.

R. S., 4897.

See also Thomson *v.* Waterhouse, (1) RENEWED APPLICATION.

5. In presenting a renewal (under authority of R. S., sec. 4897, and of Patent Office Rules 175 and 176) of an application that, after having been allowed, had been forfeited by reason of non-payment of the final fee, the applicant has a right to present new claims if he desires.

Barrett, x. p., *Simonds, Com.*, 16 Sep., 1891, 56 O. G., 1564.

RENEWED APPLICATION.

1. An application, in lieu of one forfeited by non-payment of final fee may (within 18 months thereafter), be filed by any party in interest, and dates back to original application.

Sec. 4897, R. S., permits *any person having an interest in an application* that has been allowed and become forfeited by non-payment of the final fee, to file a new application for patent for the same invention, at any time within two years after such allowance. Such new application is held to be a continuation of the original application to the extent that it relates back to and *adopts its date.*

Delay in renewing under the statute may, however, raise a presumption of abandonment, and this should be met by applicant's oath to facts which negative such presumption.

Thomson *v.* Waterhouse, *Butterworth, Com.*, 31 Dec., 1884, 30 O. G., 177.

2. New Claims may be presented.

In renewing an application, the applicant has the right to present new claims, if he desires.

Barrett, x. p., *Simonds, Com.*, 16 Sep., 1891, 56 O. G., 1564.

RE-OPENING OF CASE.

1. For new claims, must take place prior to appeal.

It is not "sufficient cause" for re-opening a case under Rule 142, that applicant would have presented the claims sooner had he not been of the opinion that the claims already in the case were clearly patentable, and would be allowed, on reconsideration, by the Examiner; and that he did not present them after final rejection and before appeal to the Examiners-in-Chief because he thought they would follow their usual custom and suggest more limited claims, if of opinion that the broad claims appealed were not patentable.

Sailor, x. p., *Frothingham, Act. Com.*, 4 Feb., 1892, C. D. Ms.

2. To enable presentation of claim to product after rejection of claim to process.

Where the process for making an explosive cartridge was considered the same as a patented process for treating lime to keep it pure and unslacked, the decision of Examiners-in-Chief rejecting a claim for the method was sustained, but, at the same time, the case was re-opened for the introduction of a claim for the cartridge, stating its contents and how the same was enclosed therein.

Butterfield & Batchelor, x. p., *Simonds*, *Com.*, 28 Jan., 1892, C. D. Ms.

Of like purport, see Rogers, x. p., (7) EXAMINATION.

Compare, however, Kinzer, x. p., (54) THE CLAIM; Phelps, x. p., (14) AMENDMENT; and Jamieson, x. p., (8) RE-INSTATEMENT OF CLAIM.

3. After allowance.

Under Rule 78, amendments are not permitted after the case has passed to issue unless some special "*showing*" is made which would warrant the re-opening of the case in order that justice may be done to the applicant, and unless, also, some explanation is given of the delay in presenting the amendment.

Wallis, x. p., *Fisher*, *Act. Com.*, 25 Feb., 1890, C. D. Ms.

4. By Examiner's incorporation of additional claims.

Where the Examiner refused to forward an appeal filed more than two years after final rejection but within two years after his admission of an amendment presenting additional claims: *Held*, that, under the provisions of Rule 68, it is only such amendments as cancel claims, or present those rejected in better form for consideration on appeal, that may be admitted, after such action upon an application as will entitle applicant to an appeal to the Board without "a showing, duly verified, of good

and sufficient reasons why they were not earlier presented;" hence, an amendment that presents additional claims is clearly one touching the merits of the application, and, even though the Examiner stated that the claims were admitted "for the purpose of appeal," the incorporation into the case of such claims amounted, in effect, to a re-opening of the case.

Egly, x. p., *Frothingham, Act. Com.*, 4 Feb., 1892, C. D. Ms.

5. After final rejection.

Where, after final rejection, applicant submitted an additional claim which the Examiner admitted without protest and without the "showing" required by the second clause of Rule 68: *Held*, that the admission of the new claim amounted to a re-opening of the case, and that it was therefore error to thereafter refuse admission to an amendment comprising a new specification and new claims on the ground that the application was under final rejection.

Johnston, x. p., *Frothingham, Act. Com.*, 18 Mar., 1892, C. D. Ms.

6. On mere change of phraseology, — denied.

Where the right of appeal to the Commissioner from the action of the Examiners-in-Chief affirming the Primary Examiner's rejection of certain claims, remained, a petition to re-open the case and substitute new claims in place of those rejected: *Denied* because the two sets of claims were substantially equivalent, and there was therefore no reason for causing the Examiner and Examiners-in-Chief to pass upon the claims proposed.

Cheesebrough, x. p., *Simonds, Com.*, 21 Aug., 1891, C. D. Ms.

Compare Gibbs, x. p., (2) and Johnson, x. p., (15) AMENDMENT.

7. Before the Primary Examiner.

Where the Examiner urged that, under Rule 142, a case which had been decided by the Examiners-in-Chief will not be re-opened except for the consideration of matter not already adjudicated: *Held*, that the power of the Examiners-in-Chief to recommend the granting of a patent on grounds not involved in the appeal is not so limited that they cannot recommend the allowance of a claim that has already been acted upon.

Roberts, x. p., *Mitchell, Com.*, 18 Dec., 1890, C. D. Ms.

8. Where, in pursuance of the recommendation of the Examiners-in-Chief under Rule 139 (a), the applicant presented two claims, one in the form recommended and the other varying slightly therefrom, and the Examiner held that the second claim fell without the recommendation, and that, taking the amendment as a whole, he was not authorized to open the case: *Held*, that the principle laid down in Holt, x. p. (1887, C. D. 4), would seem to exclude such rigor and strictness of interpretation as the Examiner applied to the recommendation of the Examiners-in-Chief, and, as the second claim could fairly be said to be within the contemplation of the recommendation, it was the Examiner's duty to have incorporated it for consideration.

Ib.

9. By act of the Examiner.

Rule 142 has been interpreted to mean that a case will not be re-opened for further action by the applicant without authority from the Commissioner, but the understanding has not been universal that the rule was intended to prevent an Examiner from citing newly discovered references without like authority.

Sutton x. p., *Mitchell, Com.*, 15 June, 1891, C. D. Ms.

NOTE. — The Commissioner quoted the last paragraph of Rule 142, and said, that from a careful scrutiny of the paragraph it would seem to be inconsistent with the exercise of a right by the Examiner to re-open the case without authority, and such a requirement would seem to be even in the interest of the public; but inasmuch as applicant's waiver of the irregularity prevented the question from arising in the case, and as the paragraph referred to is a recent one and appears for the first time in the last edition of the Rules, and as its relation to cases like the present had never received judicial consideration, and as no conclusion should be pronounced on the subject unless after much more thought and investigation than he was then able to give it, he purposely refrained from deciding that question at this time.

10. A motion for re-opening a case or for a new trial in the Patent Office is not to be determined by the same rules which obtain in courts of law. The questions here to be decided are: Who is the prior inventor, and [whether to any one, and if to any one] to whom the patent should issue. In order to determine these questions it is necessary that the testimony material to establish who was the prior inventor, and by whom [and how long before his application] the invention was first reduced to practice, should be received at any time before the patent issues.

Eccard *v.* Drawbaugh, *Marble, Com.*, 5 July, 1883, 14 O. G., 301.

11. The primary test in determining a motion to take additional testimony after a case has been closed is whether the testimony was accessible or capable of being produced at the proper time by the exercise of diligence on the part of the party seeking its introduction. It is not sufficient for the party making the motion to show that he has used ordinary diligence in

the matter. He must show conclusively that he left no stone unturned in the preparation of his case, and that he was zealous and diligent in a high degree. The question of materiality is not the first to be considered, and, if it becomes a question at all, it is one of secondary consideration.

Schmiedl *v.* Booth, *Simonds, Com.*, 24 Oct., 1891, 57 O. G., 695.

See also Edison *v.* Maxim *v.* Swan, 57 O. G., 696.

RE-OPENING OF INTERFERENCE.

Petitions of Gray and McDonough to re-open the interferences [between applications for patent for "vocal telegraphy"], and to set aside the decisions and final judgment therein: *Denied* because the showing was deemed insufficient to justify the Commissioner in setting aside former decisions and decrees, and because there was no ground for belief that another trial might change the verdict.

McDonough *v.* Gray *v.* Bell *v.* Edison, *Hall, Com.*, 23 Feb., 1889, 46 O. G., 1245.

RE-ORGANIZATION.

Omission followed by re-organization may constitute patentable novelty, but mere omission does not.

McRoy, x. p., *Fisher, Com.*, 4 Sep., 1869, C. D. 5.

See OMISSION.

REPEAL OF A PATENT.

1. United States Courts have the power to adjudge either one of two conflicting patents void in whole or in part, or to declare it inoperative or invalid in any partic-

ular part of the United States, but only to the extent of affecting the parties litigant, and not in prejudice of the right of surrender and re-issue in valid form. On the other hand, a successful suit to vacate a patent by the Government terminates the existence of the patent itself, and opens the alleged invention to the whole world.

Section 4918, R. S., permits a patentee to bring suit against the owner of an interfering patent, and authorizes the court to declare and adjudge either of the conflicting patents void in whole, or in part, or inoperative, or invalid in any particular part of the United States, according to the interests of the parties in the patent or in the invention patented; but not in prejudice of the rights of any except parties to the suit and those deriving title under them subsequent to the rendition of such judgment. Section 4920 gives a like remedy to the defendant in a suit for infringement who (having, in the general issue, impleaded ground for the voidance of the complainant's patent) makes good his plea. But the right given to the defendant to make this defence is a right given to him personally and to him alone, and the effect of a successful defence of this character by one defendant is simply to establish the fact that, as between him and the patentee, no right of action exists, for the reasons set up in such defence. But the patentee is not prevented, by any such decision, from suing any number of other supposed infringers and putting each to an expensive defence, in which they all, or some of them, may be defeated, and compelled to pay, because they are not in the possession of the evidence on which the other defendant succeeded in establishing his defence. On the other hand, the suit of the Government, if successful, declares the patent itself void, sets it aside as of no force, vacates it or recalls it, and puts an end to all suits which the patentee can bring against anybody. It opens to the

entire world the use of the invention or discovery in regard to which the patentee had asserted a monopoly. There is nothing in the statutory provisions expressing an intention of limiting the power of the United States to get rid of a patent obtained from it by fraud or deceit; and, although the legislature may have given to private individuals a more limited form of relief, we think the argument is not sound that this specific provision was intended to supersede the affirmative relief to which the United States is entitled, to obtain the cancellation or vacation of an instrument obtained from it by fraud, — an instrument which affects the whole public whose protection from fraud is eminently the duty of the United States. The decree of the Circuit Court, dismissing the bill of plaintiff, is reversed.

The United States *v.* Am. Bell Tel. Co., 45 O. G., 1311, ❋.

2. Suit to vacate or cancel a patent must be brought in the name of the United States through the Attorney-General.

The accepted procedure for impeachment and vacation of an improperly granted patent appears in the case above cited. Suit in equity, in the name of the United States, was brought in the U. S. Circuit Court for the District of Massachusetts, against the American Bell Telephone Company, a corporation organized under the laws of the State of Massachusetts, and against Alexander Graham Bell, a resident of the District of Columbia. The action was instituted by George M. Stearns, the United States District Attorney for that district, by the direction of George A. Jenks, the Solicitor-General of the United States, the Solicitor-General acting as its Attorney-General in this matter, because the latter officer was under a disability to prosecute this suit.

Ib.

See VACATION OF PATENTS.

RESERVATION, — DESIGNATION.

1. Where an application comprises several inventions that are inadmissible in a single grant, applicant may reserve either one of them for consideration under said application.

If several inventions, claimed in a single application, be of such a nature that a single patent may not be issued to cover them, the inventor will be required to limit the description, drawing, and claim of the pending application to whichever invention he may elect. The other inventions may be made the subjects of separate applications, which must conform to the rules applicable to original applications. If the independence of the inventions be clear, such limitation will be made before any action on the merits; otherwise it may be made at any time before final action thereon, in the discretion of the Examiner.

P. O. R. 42.

2. When an applicant files two or more applications relating to the same subject-matter of invention, all showing, but only one claiming the same thing, the applications not claiming it must contain references to the application claiming it.

P. O. R. 43.

3. When it was desired to reserve certain claims for a cotemporary application, applicant was required to designate the particular application by stating its date of filing and its serial number.

Suffolk Co. *v.* Hayden, U. S. S. C. By *Nelson, J.*, 3 Wall., 315.
See, also, 21 O. G., 337, ✱; 25 O. G., 1190; 26 O. G., 273.

4. Cross reference admissible to cotemporary application.

A reservation for a future application of subject-matter disclosed but not claimed in a pending application, but which subject-matter might be claimed there, will not be permitted in the pending application.

P. O. R. 42.

5. A clause in a patent giving notice that the patentee reserves the right to constitute features shown in certain figures of the drawing the subject of a second application, is sufficiently specific if said application was filed before said patent issued, and was identified by its date of filing and serial number.

Rohu, x. p., 25 O. G., 1190; qualified by *dictum* in Finch, x. p., 26 O. G., 273.

See DIVISION OF APPLICATIONS.

REVERSAL: see NOVELTY; REVIVAL OF APPLICATION: see RE-INSTATEMENT OF APPLICATION.

6. Reservation in Office-record, but not in the published specification, of matter described, but not claimed, in the issued patent, — insufficient.

Where an application was rejected upon a prior patent to same applicant, in which the device claimed in the rejected application was disclosed and described, and applicant contended that, in spite of the rule laid down in Mullen & Mullen, x. p., 50 O. G., 837, he was not barred by the fact that he neither applied contemporaneously nor reserved the right to apply subsequently; (1) Because he reserved the right in connection with an amendment filed in the case; and (2) because of the recent decision in Sugar Apparatus M'f'g Co. *v.* Yaryan M'f'g Co., 43 F. R., 140: *Held*, (1) that the better opinion seems to be that, while the reservation in the record

rebuts such presumption of abandonment as would arise out of the act of cancellation, it does not do away with the necessity of either applying contemporaneously or of making an explicit reservation in the patent itself (Holmes Elec. Co. *v.* Metrop. Burg. Alarm Co., 33 F. R., 254; Derby, x. p., 26 O. G., 1208); and (2) that the Sugar Appts. M'f'g Co. *v.* Yaryan M'f'g Co, *supra*, was not in point, for, in that case, the matter stricken out of the claims before the issue of the first patent *was entirely eliminated from the specification*, so that the patent, on its face, did not show or describe anything which was made subject-matter of the second application, and a patent was accordingly allowed to issue thereon.

Stanford, x. p., *Mitchell, Com.*, 7 Feb., 1891, C. D. Ms.

NOTE. — In this case the Commissioner said: "I am impressed somewhat by the argument made which is based upon the decision of the Supreme Court in Webster Loom Co. *v.* Higgins, 105 U. S., 580, ✽. In that case it was held that an application on which a patent has issued is a public record which every one is presumed to know. Upon this decision applicant bases a contention that a reservation in the record is just as effective as a reservation contained in the patent granted. In view of what seems to me to be the trend of all the authoritative decisions that are directly in point, I do not see my way clear to adopt the view thus urged. I venture to express the hope, however, that if the applicant has confidence in his position, he will appeal to the Supreme Court of the District of Columbia and obtain an authoritative decision upon the question."

Compare Hill & Prentice, (1) DEDICATION, and numerous cases there cited.

RESTORATION OF INVALIDATED RE-ISSUE TO ORIGINAL FORM.

See Giant Powder Co. *v.* Safety Powder Co., (50) RE-ISSUE.

REVOCATION OF A PATENT.

See REPEAL OF A PATENT.

RIGHT OF ACTION.

Section 4903 R. S.

Applicant's right of action, at any time within two years after rejection, being statutory under Section 4903 R. S., cannot be abridged by any rule of the Patent Office; and the last clause of Rule 171 means that, in presenting his application for re-hearing, applicant may either insist on his original claim or he may erase or modify it as he may see fit.

Irwin, x. p., *Fisher, Act. Com.*, 19 Feb., 1890, C. D. Ms.

RIGHT TO USE AND RIGHT TO SELL.

Where a patentee has assigned his right to manufacture, sell, and use within a limited district, an instrument, machine, or other manufactured product, a purchaser of such instrument or machine, where rightfully bought within the prescribed limits, acquires, by such purchase, the right to use it anywhere, without reference to other assignments of territorial rights by the same patentee.

The right to the *use* of such machines or instruments stands on a different ground from the right to make and sell them, and inheres in the nature of a contract of purchase, which carries no implied limitation of the right of use within a given locality.

Adams *v.* Burke, U. S. S. C. By *Miller, J.*, Oct., 1873, 17 Wall., 453, ✽.

See also Standard Fold. Bed Co. *v.* Keeler, U. S. C. C., Mass., 20 Feb., 1889.

RIGHTS OF GENERIC INVENTOR AND OF AN IMPROVER.

1. An improver upon an original patent has no right to use the original, nor has the original patentee a right to use the improvement without license.

Peters C. C. 399.,

See also Crehore *v.* Norton, *Nelson, J.*, 1853.

2. The patentee of an improvement holds his right to use it in subordination to the claims of the generic inventor.

The original inventor of a class has to break ground and to encounter prejudice; its eventual success incites competition, and it is but fair that subsequent improvers should pay tribute to the originator.

Carr, x. p., 1874, C. D. 11.

3. Later inventors who devise different means for accomplishing the same steps of the method, are entitled only to patents for improvements upon the method or the means of the first inventor, subject to his possession of and right to the invention itself.

Bell *v.* Gray *et al*, 15 O. G., 776.

See also 27 O. G., 99.

4. Where a result similar to that of the patent has been once obtained by one kind of a joint, the invention of a special joint for producing the same result does not make the patent cover a function. The field is still open for others to make other joints to be used in the same place for accomplishing the same results.

Pattee *v.* Motive Plow Co., 22 O. G., 173.

5. During pendency of application for patent for a generic invention, patent for improvement thereupon must be withheld from issue.

Neither the spirit of the law nor public policy sanctions the granting of patents with specific claims while applications with generic claims are still pending, the objection being that, — whether the application with the generic claim belongs to the same party who has a specific claim under the genus, or is an application of a different party, — a patent covering by a generic claim, if a subsequent patent, improperly extends [prolongs] the monopoly.

Upton, x. p., 27 O. G., 99.
See, however, (1) *et seq.*, ORDER OF ISSUE.

REVIVAL OF FORFEITED APPLICATION.

Where there was no evidence that the Patent Office had received an amendment [prepared by applicant's attorney] before the expiration of two years from the last Office action: *Held*, that there was a failure to prosecute within the meaning of Sec. 4894, R. S., but *also, held*, that under said section and in the light of the facts, the case might be treated as one in which the failure to prosecute was unavoidable, and the application was accordingly revived.

Humans, x. p., *Fisher, Act. Com.*, 20 Oct., 1890, C. D. Ms.
See RE-INSTATEMENT OF FORFEITED APPLICATION.

RÔLE OF AN INVENTOR.

A person does not assume the rôle of an inventor until he has devised *the means* whereby his ideas are to be made available to the public.

Wicks *v.* Du Bois, *Doolittle, Act. Com.*, 16 Feb., 1877, 11 O. G., 244.

RULE AND EXCEPTION.

For "THE RULE AND THE EXCEPTION," see Dickson *v.* Kinsman, (142) INTERFERENCES, and citations following it.

RULES AND FORMS.

1. The rules of practice governing procedures in the United States Patent Office are made by the Commissioner of Patents subject to the approval of the Secretary of the Interior.

R. S. 483.

2. Conformability to those of the Federal Courts.

While it is the policy of the Patent Office to follow the rules of the Federal courts as far as those rules may be adapted to meet the peculiar conditions of practice in the Patent Office, it was never intended that the Office should not pass such rules for the proper conduct of its business and for the protection of parties before it as best meet its requirements.

Raffard *v.* de Ferranti, *Frothingham, Act. Com.*, 13 June, 1892, C. D. Ms.

3. When obstructive, must give way, — Rule 229.

After the 20 days allowed by Rule 109 for filing amendments, had expired, *L* offered a claim in the exact language of the interference-issue: *Held*, that *L's* application having been through a prior interference, and the Office having learned thereby that he had invented what was specified in the pending issue, before *H*, his present opponent, claimed [in his preliminary statement] to have invented the same, and that it would be a *stifling of justice in its rules and forms* to permit *H* to take a patent for a thing that, upon showings in the possession of the Office, he was not the inventor of; and that while Rule 109 states what the applicant may do, the case was one which called upon *the Office* to do something of its own motion; that Rule 229 recognizes such actions, and that the Examiner should incorporate the proposed claim as a part of *L's* application whereby it would become

involved in the interference. *Also, held*, that whether *L* was or was not entitled to make the claim in that particular application, or should file a new application, were questions which could be disposed of *ex parte* after the question of priority between *L* and *H* was finally decided.

Hunter, Jr. *v.* Lane, *Simonds, Com.*, 3 June, 1892, C. D. Ms.

Compare Designolle, x. p., (17) THE CLAIM; Coe, x. p., (6) CLASSIFICATION; Carter, x. p., (5), and McMahan, x. p., (31), DIVISION.

4. Rule 142, — intended as a check both on Examiner and Applicant.

In a case appealed to the Examiners-in-Chief, they affirmed the Primary Examiner's action except as to one claim. The Primary Examiner thereupon re-opened the case and rejected that claim, on a reference he had previously given for other claims at an earlier stage of the case, but which was not relied upon by him at the time the case was appealed and was not before the Examiners-in-Chief: *Held*, that the Primary Examiner's action was irregular. Rule 142 provides that cases which have been heard and decided by the Examiners-in-Chief will not be opened by the Primary Examiner without the approval of the Commissioner; and this rule is not, as the Examiner seemed to think, prohibitory only of opening for the purpose of admitting an amendment proposed by applicant, but that it is also intended as a check on the Examiner, and to direct that after decision by an appellate tribunal he shall not re-open a case without the approval of the Commissioner. Applicant's petition that the case be passed to issue was, however, refused, and, should the Examiner insist on rejection, the question of anticipation as to that claim can reach the Commissioner only on appeal from the Examiners-in-Chief.

Horr, x. p., *Fisher, Act. Com.*, 25 Aug., 1890.

5. It must be remembered that the *rules* were *made for the cases which arise*, and not the cases for the rules; the spirit and prime purpose of the system of practice must always be kept in mind, and mere details and incidentals subordinated thereto. The case now before me appears to be one not specifically provided for in the Rules, and the claim under consideration is one involving a vital question of form, and also one of merits, and hence falls partly under the effect of two rules of practice, but wholly within the scope of neither. Under such circumstances the claim must be disposed of in accordance with the general spirit and equity of the practice. The rights of the applicant must also be considered and protected.

Carter, x. p., *Hall, Com.*, 1 Mar., 1889, 46 O. G., 1391.

See CLASSIFICATION; DILATORY METHODS; DIVISION OF APPLICATION; REVIVAL OF APPLICATION.

SCOPE OF CLAIMS.

1. A patentee is not limited to the literal import of his description of his invention, but, in construction, he may make such modifications of it as do not involve a departure from its principle or a material change in its mode of operation. A patentee may, however, certainly restrict the comprehensiveness of his patent-right by the tenor of his claims.

Grier *v.* Castle, *McKennan, J.*, 10 Aug., 1883, 24 O. G., 1176.

2. Whether or not the claims are so limited in scope as to distinguish their subject-matter from that of the reference, can only be determined upon a consideration of such reference and of the previous state of the art. This duty devolves upon the Examiners-in-Chief upon appeal, and not upon the Commissioner antecedently to such appeal.

Miller, x. p., *Fisher, Act. Com.*, 30 Ap., 1890, C. D. Ms.

SCOPE OF PATENT.

1. The inventor of a machine is entitled to the benefit of all the uses to which it can be put, no matter whether he had conceived the idea of such use or not.

Challoner *v.* Perkins, *Simonds, Com.*, 30 June, 1892, 60 O. G., 296.

2. It is no new invention to use an old machine for a new purpose. The inventor of a machine is entitled to all the uses to which it can be put, no matter whether he had conceived the idea of such use or not. Invention, such as will sustain a patent, is not attained by a new use or by a mere carrying forward of new or more extended application of the original thought, a change only in form, proportion, or degree, doing substantially the same thing in the same way by substantially the same means, with better results.

Smith *v.* Nichols, U. S. S. C. By *Swayne, J.*, Oct. term, 1874, 1 Wall., 112; 22 U. S., 566, ✽.

3. Invention is a mental act, but to be subject of patent it must be shown to be of practical utility by a *material embodiment.*

A patentable invention is a *mental* result. The machine, process, or product is but its material reflex or embodiment. It must be new and shown to be of practical utility. A new idea may be engrafted upon an old invention, be distinct from the conception that preceded it, and be an improvement. In such case it is patentable. The prior patentee cannot use it without the consent of the improver, and the latter cannot use the original invention without the consent of the former. But a mere carrying forward or a new or more extended application of the original thought, a change only in form, proportions, or degree, or the substitution

of equivalents, doing substantially the same thing in the same way by substantially the same means, with better results, is not such invention as will sustain the patent.

Ib.

4. The pioneer inventor will be secured in the fruits of what he invented and covered by his patent, even against a subsequent inventor who, though he may have greatly improved it, uses still the original invention which lies at the foundation of the art.

The Consol. Roll. Mill Co. *v.* Combs, *Brown, J.*, 20 May, 1889, 48 O. G., 255.

5. A patentee will not be permitted to say that certain elements of his claim are material and others immaterial, but where the language of the claim is susceptible of different shades of meaning, the court will aim to give it a liberal or a strict construction according to the relation of the invention to the [prior] art, and to preserve to the patentee that which the inventor actually contributed to the art, if this can be done consistently with the language he himself has chosen.

By the strictly literal interpretation of claims pertaining to the class of inventions adjudicated on in Rodebaugh *v.* Jackson (37 Fed. Rep., 882), and Sargeant *v.* Hall Safe & Lock Co. (114 U. S., 85), nothing more was intended than that where, under the state of the art and the action of the Patent Office, a patentee of a combination has modified and limited his claims, he shall be held strictly to his combination as he has described it. It has always been the law that a patentee is limited by his claims, even though his invention be broader, and that if he include a certain element in a combination he is not at liberty to say that such element is immaterial (Vance *v.* Campbell, 1 Black, 427,*).

Nevertheless, what shall be considered an infringement must depend largely upon the state of the art as it existed at the time the patent was issued, and it must be borne in mind that a combination patent covers not only the elements named, but also such as may be substituted therefor and are known as mechanical equivalents; but what shall be deemed a mechanical equivalent depends largely on the state of the [prior] art in each particular case. When we find a court using language which indicates that the patentee should be strictly limited to the terms of his claim and to the restrictions and the provisos he has inserted therein, we generally find that the invention is only a trifling deviation from or improvement upon what has gone before. When, upon the other hand, the case shows the doctrine of mechanical equivalents to be asserted and liberally applied, it will usually appear that the patent is a pioneer, or at least a marked improvement upon any device which had previously existed. The prime object in construing a patent should be to reserve to the patentee his actual invention if this can be done consistently with the language he has himself chosen. Occasionally it will happen that the patentee will, by inadvertence or mistake, claim less than he is entitled to, and the courts will be powerless to help him; but their disposition is, and should be, to deal liberally with those who have made valuable contributions to the industrial arts. Indeed, the general principle is sustained by abundance of authority that claims of patents should receive such interpretation as will enlarge or restrict them so as to cover the actual invention, when not absolutely inconsistent with the language used by the patentee (Wimans *v.* Denmead, 15 How., 330, * ; Van Martyr *v.* Muller, 15 Blatch., 562). If, upon the one hand, the state of the art shows the invention to have been a narrow one, a strict interpretation will be given (M'f'g Co. *v.* Ladd,

102 U. S., 408, ❁), and it is of no practical consequence whether such restrictions are imposed by the Patent Office or not (Toepfer *v.* Goetz, 41 O. G., 933). If, on the other hand, the patentee has taken a decided step in advance of the then state of the art, the courts will, if possible, so construe the language of his claim as to give him the full benefit of his improvement (Turrill *v.* R. R. Co., U. S. S. C. By *Clifford, J.*, 11 Ap., 1864, 1 Wall., 491,❁. Rubber Co. *v.* Goodyear, U. S. S. C. By *Swayne, J.*, 14 Feb., 1870, 9 Wall., 788,❁.

Ib.

6. Foundation Invention.

That the machines manufactured and sold by the defendants may be lighter, smaller, cheaper, more easily operated and more efficient; and that they may be a decided improvement on the Mergenthaler machine, and may, as such, commend themselves more readily to the public; that they are themselves patented, and that, if put in open competition with the earlier machines, they would prove more attractive to purchasers and users — each of which points is pressed with great force by the defendants — is wholly immaterial, if the complainant's main contention is a sound one, viz.: That the Mergenthaler "Linotype" is covered by a foundation patent; that it embodies *a combination wholly new in the printing art, and one which marks the first great step in advance taken for over four hundred years*, and which, though susceptible, as all foundation inventions are, of subsequent improvement, has yet demonstrated its ability practically and efficiently to perform the work which it was designed to do. If, upon the case now presented, it appears that Mergenthaler is a pioneer inventor, he is to be secured the fruits of what he invented and covered by his patent, even as against a subsequent inventor, who — though he may have greatly improved it — uses still *the origi-*

nal invention which lies at the foundation of the art (see cases cited in notes to section 894, Robinson on Patents).

The complainant corporations have apparently endeavored to advertise and promote the sale of their machines both here and abroad. In 1889, and again in 1890, a machine of Mergenthaler's attracted the notice of the Franklin Institute, which is claimed to be a scientific society of high standing, and which awarded two medals in recognition of its ingenuity. Certainly there is no reason to suppose that that branch of the printing art which has occasion to use such machines has for years been ignorant of the fact that an invention of the character described was claimed by Mergenthaler, was being put into practical use, and was offered to the public; but although such invention met a public need, was manifestly of great utility, apparently solved a problem that had been waiting solution for hundreds of years, and seemed destined to work a revolution in the methods of composition for the press, no one undertook to trespass upon the rights secured by the claim of the patent until the defendants' machine was put upon the market within a few months past. The complainants gave due warning by written notice to the defendants (or to those having a common interest with them) that any attempt to manufacture and sell machines such as that of the defendants' would be resisted in the courts, and promptly, upon the exhibition of such machines for sale here, this suit was begun.

There is sufficient here to fortify complainant's contention, especially as there seems so little real question about either the scope or validity of the patent, or the infringement by defendants' machine of the claim above quoted.

National Typographic Co. *et al. v.* Typograph Co. *et al.*, U. S. C. C., S. D. N. Y., *Lacombe, J.*, 11 Mar., 1891.

7. The scope of a patented invention may be so narrowed by the prior state of the art that infringement cannot be adjudged to exist unless there has been an appropriation in substantial form of construction of the identical elements which the inventor had a right to claim as new in his patent.

Saladee *v.* Racine Wagon & Carriage Co., *Dyer, J.*, 28 Ap., 1884, 20 Fed. Rep., 686.

8. Estoppel.

Where a patentee declares upon a combination of elements which he asserts constitutes the novelty of his invention, he cannot, in his proofs, abandon a part of such combination and maintain his claim to the rest, even although he may have brought into his claim more than is necessary to the successful working of his device.

McClain *v.* Ortmayer, U. S. S. C. By *Brown, J.*, 2 Nov., 1891, 35 L. ed., 800, ❁.

9. In an action against the United States, alleging a contract, and seeking to recover royalty for the use of a mail-bag alleged to be covered by plaintiff's patent, which claimed "a mail-bag having a bottom with turned up circumferential flange, and having sides overlapping said flange, and secured thereto by two or more rows of metal-headed rivets, substantially as described," and the same description applied to the Government bag except that only one row of rivets was used: *Held*, that an essential element of the patented combination — the additional row or rows of rivets — was absent. This, at first glance, seems a very narrow construction of the patent, but, if this patent can stand at all it must be upon very narrow grounds. . . . We do not think the

device patentable, but, if patentable, it is not found in defendant's mail-bags. Petition dismissed.

Thomson *v.* The United States, U. S. Court of Claims, No. 16,611, 14 Dec., 1891.

10. The application having been made for an improved rubber boot as distinguished from a shoe, and the whole course of proceedings in the Patent Office having been conducted on that theory, the patentee is estopped from claiming that the patent covers a rubber shoe.

Williams *v.* Goodyear Co., U. S. C. C., Ct. By *Shipman, J.*, 2 Feb., 1892, 49 F. R., 245, 58 O. G., 1257.

NOTE. — The claim in suit (Claim 1, Pat. No. 166,669) was as follows: —

"The improved boot, composed of textile fabric and rubber, having an inner upper cut to fit the last or foot, and an outer upper cut longer than the inner upper with the surplus portion thereof overlapped; substantially as described."

The applicant, having been referred to a shoe, had claimed useful novelty in his 'combined foot and leg covering,' — that is to say, a boot as distinguished from a shoe or covering for the foot only, — and had pressed his application to allowance on those grounds."

Compare Rodebaugh *v.* Jackson, (9), Sargent *v.* Hall Safe & Lock Co., ❁, (10) PUB. RIGHTS AND OBLIGATIONS; Roemer *v.* Peddie, ❁, (72) THE CLAIM.

See INFRINGEMENT; INVENTION; PUBLIC RIGHTS AND OBLIGATIONS; STATE OF THE ART.

SEASONABLE PRESENTATION.

The question whether the process claim was seasonably presented is an executive one, and, where that question is intended to be raised, the Examiner should refuse to incorporate, and thus lay a basis for a petition to the Commissioner.

Perkins, x. p., *Mitchell, Com.*, 4 Mar., 1891, 55 O. G., 139.

SECOND APPEAL.

See (2) FEE.

SECRECY.

Pending Application.

Because an applicant has been necessitated to introduce the record of an application in an interference procedure, it does not follow that the Office should allow any and every one to obtain copies of said application. It is a familiar legal principle that matters of necessity are not to be extended beyond the limits of that necessity (P. O. R. 15; U. S. Elec. Lt. Co. *v.* Com. of Pats., 54 O. G., 267).

Dyer, x. p., *Simonds, Com.*, 11 Sep., 1891, 56 O. G., 1564.

Compare Fowler, x. p., (1) ABANDONED APPLICATIONS; U. S. *v.* Com'r of Patents, (1) CERTIFIED COPY.

SENIORITY.

Determined by date of filing *claim* at issue.

R. although the earlier applicant, was treated as the junior inventor because anticipated by *M* in the date of filing of *the claim* in interference.

Rennyson *v.* Merritt, *Simonds, Com.*, 29 Feb., 1892, 58 O. G., 1415.

See BURDEN OF PROOF; INTERFERENCE; PRIORITY.

SIGNATURE.

Rule 40 requires applicant to subscribe to his specification and affidavit with his full name. The law recognizes but one Christian name, and that the first one. Middle names or initials are mere matters of orna-

ment, and their insertion or omission is immaterial (see Gaines *et al. v.* Stiles, 14 Pet., 332).

Gentry, x. p., *Hall, Com.*, 26 July, 1888, C. D. 115; 44 O. G., 822.

SIGNED AND SWORN TO "IN BLANK."

An application that had been signed and sworn to "in blank," ordered stricken from the files.

Where applicant prayed to be allowed to withdraw his case from issue for the purpose of re-presenting it, on the ground that the specification and claim were insufficient and had never been signed by him, and it was evident, not only from his statement, but on the face of the papers, that the application had been signed and sworn to in blank, it was directed that the application be stricken from the files.

Ayres, x. p., *Fisher, Act. Com.*, 3 Jan., 1890, 51 O. G., 1944.

SILENCE.

Silence on the part of the plaintiffs or their assignor and delay in seeking relief, where it did not beguile defendants into a continuation of business or into renewed or large expenditures, does not constitute an estoppel to injunction, but may preclude a claim to past profits.

N. Y. Grape Sugar Co. *v.* Buffalo Grape Sugar Co., *Shipman, J.*, 20 Nov., 1883, 25 O. G., 1076.

SIMPLICITY.

1. Does not negative invention.

Applicant's process of preparing and tempering slurry for Portland cement is a very simple one, but simplicity does not negative invention. It is really a combination

of process steps, one of which consists in testing a portion of the mass after the materials are mixed in order to determine the proportions, and no reference cited describes a test of this kind at this stage (Fermentation Co. *v.* Mans, 122 U. S., 413). That the results of this simple process are useful in a high degree sufficiently appears. This marked utility in result, coupled with this novel process step, is, in my opinion, sufficient evidence of patentability.

Kalteyer, *et al.*, x. p., *Simonds, Com.*, 18 Aug., 1891, 57 O. G., 1127.

2. The allegation that an improvement claimed to be patentable was so simple as to be perfectly obvious, is negatived by the fact that up to the time of its discovery a more expensive compound was in general use.

Sommer, x. p., *Simonds, Com.*, 9 Oct., 1891, 58 O. G., 1255.

3. As a patentable characteristic.

As compared with the references, applicant has *reduced a mechanical idea to its simplest possible terms*, — so simple indeed that it seems almost strange that the two prior inventors should have gone so far around to reach the common result; but they did thus go around, — *two of them did it*, — and I cannot be sure that, in the attainment of the simplicity reached by applicant, he did not exercise the inventive faculty. Simplicity may indicate rather than negative invention. The adverse decision of the Examiners-in-Chief is therefore reversed.

Luse, x. p., *Simonds, Com.*, 17 Nov., 1891, 58 O. G., 1414.

See PUBLIC ADOPTION; OMISSION; SUCCESS AS A TEST; UTILITY.

SIMPLIFICATION.

See NOVELTY; OMISSION; SIMPLICITY.

"SKILLED IN THE ART."

Definition.

By the words "skilled in the art" as used in the statute, is not meant extraordinary ability but merely fair or ordinary expertness in that particular line.

Kerr, x. p., *Dyrenforth, Act. Com.*, 26 Feb., 1884, 28 O. G., 95.

SOLICITOR.

Power to act ceases at applicants' death.

Authority delegated to an attorney, solicitor, or agent ceases with the death of the applicant, and any steps relating to the application or issue thereafter taken by such agent are without authority and void (Eagleton M'f'g Co. *v.* West Bradley & Cary M'f'g Co., 111 U. S., 149, ✱).

The De La Vergne Refrig. Mach. Co. *v.* Featherstone *et al.* *Blodgett, J.*, 29 Feb., 1892, 58 O. G., 1842.

See ATTORNEY; DECEASED INVENTOR.

SPECIES.

"Species" of a generic invention defined.

In a patent for a machine, "species" (in the plural) may be practically defined as two or more devices for effecting the same purpose and having a common characteristic.

Amjourn, x. p., *Simonds, Com.*, 3 Mar., 1892, C. D. Ms.

THE SPECIFICATION.

1. The specification must set forth the invention in such full, clear, and exact terms, — describing the best mode known to the applicant of carrying out the practice of the invention, — as to enable one skilled in the

art to which it appertains to compound and use it without making experiments of his own.

Wood *v.* Underhill, U. S. S. C. By *Taney, Ch. J.*, Jan., 1847, 5 Howard, 3, ❋.

Of like tenor, see R. S. 4888.

2. The patentee is bound to disclose in his specification the best method of making his machine that was known to him at the time of making the application.

Page *v.* Ferry, *Wilkins, J.*, Oct., 1857, 1 Fish., 298.

3. But failure to describe the best means for making a patented device will not invalidate a patent, unless done with fraudulent intent.

Magic Ruffle Co. *v.* Douglass, *Shipman, J.*, Feb., 1863, 2 Fish., 330.

4. The specification must be complete. No defects can be obviated by extraneous evidence at the trial; but the utmost precision in the description of a machine is not essential. Parts of machinery and processes generally known [in the art] need not be described. Nor is it essential to state the proportions or velocities of the parts; size or velocity makes no difference in the principle.

Brooks *v.* Bicknell, 3 McLean, 441.

5. If an improvement in a well-known appendage to a machine is fully described in a specification, it is not necessary to show the ordinary mode of attaching the appendage to such a machine. The patent is to be read as if the machine and its appendage were present or in the mind of the reader, and he a person skilled in the art.

Webster Loom Co. *v.* Higgins, U. S. S. C. By *Bradley, J.*, 8 May, 1882, 21 O. G., 2031, ❋.

6. The contract of the public is not with him who has first discovered [merely], but with him who also makes his discovery usefully known. If he has discovered much and discloses little, communicates to the world only one of the mere derivative truths of the principle he has discovered, he patents no more than he has proclaimed. He will not be allowed afterward, when the extent of his right shall be the subject of controversy, to expand into a general expression what was before limited to a particular form, and argue that he had described the whole by implication from the part.

Detwold *v.* Reeves, *Kane, J.*, Sep., 1851, 1 Fisher, 127.

7. An objection to the validity of a patent because of an insufficient specification, raised in argument but not set up as a defence in the answer, cannot be considered.

Rubber Co. *v.* Goodyear, U. S. S. C. By *Swayne, J.*, 14 Feb., 1870, 9 Wall. 807, ❁.

See, also, Wonson *v.* Peterson, *Shipley, J.*, 11 Mar., 1878, 3 O. G., 548.

8. A patent claim must be construed in the light of the specification.

Evans *v.* Kelly, *Drummond, J.*, Jan., 1880, 23 O. G., 192.

9. Examiner should interfere as little as possible with the language chosen by the applicant in describing his invention.

In applications for patents, the Examiner should interfere as little as possible with the language chosen by the applicant in describing his invention. The largest latitude should be allowed. In applications for re-issue, on the contrary, a different rule does and should prevail. To accord the same latitude as in original applications would open a wide door to fraud. A patentee, if allowed

to interpolate new uses, new descriptive matter, new names, etc., might, by frequent re-issues, keep full pace with the advancement of the art to which his patent appertains, and might appropriate to his own use improvements and inventions made by others; the rule should be, liberality with original applications, strict construction with applications for re-issue.

Noyes, x. p., *Leggett, Com.*, 1872, C. D. 118.

Of like purport, see Myers, x. p., (21) AMENDMENT; Holt, x. p., (1) NEW MATTER; and Pacholder, x. p., (1) PHRASEOLOGY.

Compare also Lapham, x. p., (4) AMENDMENT; and Rogers, x. p., (2) EXAMINATION.

See, however, Bromley, x. p., *infra*. and Raymond, x. p., (11) THE CLAIM.

10. Applicant in trying to "*confine his description to the specific improvement and such parts as necessarily co-operate with it*," enjoined in Rule 36, must not disregard the requirement of Rule 34 that the specification shall be couched "in such *full, clear, concise,* and *exact* terms" as to enable any person skilled in the art to make, construct, compound, and use the invention.

Bromley, x. p., *Mitchell, Com.*, 18 Oct., 1889, C. D. Ms.

11. All that the law requires of an inventor, so far as the description of his device in his application is concerned, is that it shall be sufficiently full, clear, and exact to enable a person skilled in the art to practise the same. Even though the description is slightly defective, yet, if it contains all that is necessary to enable a skilled reader to practise the invention by correcting the defect, it is sufficient.

Atkinson *v.* Bentley, *Mitchell, Com.*, 29 May, 1891, C. D. Ms.

12. One illustration sufficient.

Where the invention was applicable to and might be used in connection with a large variety of devices and apparatus: *Held*, that, for that reason if for no other, it was desirable to confine the illustration of such adaptability to one of such devices or apparatus; its adaptability to the others being obvious.

Soden, x. p., *Frothingham, Act. Com.*, 15 Oct., 1891, C. D. Ms.

13. Sufficiency of Illustration, — Examiner proper Judge of.

The question of the proper illustration of an invention is held to be largely within the sound judgment and discretion of the Examiner, who is presumed to be an expert, and it is the practice of the Office not to interfere in such cases unless the Examiner is manifestly in error.

Prochaska, x. p., *Frothingham, Act. Com.*, 31 Oct., 1891, C. D. Ms.

SPIRIT OF THE LAW.

See (56) INTERFERENCES; (1) *et seq.*, ORDER OF ISSUE; and (5) RULES AND FORMS.

STATE OF THE ART.

1. The patentee has, in his description, the right to assume that those who desire to understand all the conditions under which his invention could be operated are acquainted with the preceding state of the art immediately relating thereto.

Tompkins *v.* Gage, *Shipman, J.*, 26 Oct., 1865, 5 Blatch., 396.

2. Matter introduced to show the state of the art in construing the patent cannot be permitted to defeat the suit by antedating the invention, when that issue was not raised by the pleadings.

Middletown Tool Co. *v.* Judd, *Shipman, J.*, Feb., 1867, 3 Fish., 141.

3. A prior patent, not admissible in evidence on the question of novelty of complainant's invention because of no allegation to that effect in the answer, may be properly put in evidence to show the state of the art and to restrict the claim.

Delong *v.* Bickford, *Coxe, J.*, 22 July, 1882, 22 O. G., 2242.

4. Evidence of the state of the art showing the prior existence of analogous devices for substantially the same purpose, but not fully exhibiting the device patented, operates to narrow the field for the exercise of inventive faculty and to limit the range of the patent.

Washburn & Moen M'f'g Co. *v.* Haish, *Blodgett, J.*, 14 Oct., 1879, 10 Biss., 65; 18 O. G., 465.

5. Proof of the state of the art is admissible in equity cases without any averment in the answer touching the subject, and in actions at law without having given the notice required for admission of evidence to invalidate a patent, in order to distinguish what is new and to aid the court in construing the patent.

Dunbar *v.* Myers, U. S. S. C. By *Clifford, J.*, 18 Dec., 1876. 4 Otto, 187.

6. Testimony of witnesses examined in a case as to alleged prior use by parties not set up in the answer, can only be considered by the court for the purpose of showing the state of the art at the time of the patentee's invention. The same rule would apply to printed publications by which it is sought to anticipate the invention.

Gier *v.* Goetinger, *Swing, J.*, Oct., 1874, 7 O. G., 563.

7. The testimony of witnesses of whose names no notice was given by the complainants is admissible to show the state of the art, but will receive no considera-

tion upon the question whether there had been a prior knowledge and use of the invention.

La Baw *v.* Hawkins, *Nixon, J.*, 6 O. G., 724.

8. Letters-patent No. 229,127: *Held*, to be limited by the prior state of the art, and as limited not infringed.

Kampfe *v.* Aloe, *Shipman, J.*, 25 Ap., 1888, 44 O. G., 1292.

9. In view of the prior art, which shows that it is old to crimp in and fold the ends of boxes of pasteboard and other stiff material, and also that it is old to turn the edge of metallic cylindrical vessels or packages: *Held*, that if the first claim of the Hoff patent can be supported at all, it can only be for the formation of the *entire* bottom of the crimped material and the resultant increase of thickness. The Hoff patent is not infringed by a coal-hod whose bottom is only partially formed by crushing in of the body-metal and closing the remaining aperture by a cap.

Hoff *et al. v.* Iron Clad M'f'g Co., d: 30 Mar., 1891, 55 O. G., 139,❋.

10. In a suit for infringement of letters-patent, where complainant calls an expert witness to point out resemblances between the patent and the alleged infringing device, and asks him to interpret the claims of the patent in so doing, he cannot be required to refrain from considering the prior state of the art in giving his testimony.

Am. Linoleum M'f'g Co. *v.* Nairn Linoleum Co., *Lacombe, J.*, 22 Dec., 1890, 55 O. G., 142.

See INFRINGEMENT; INVENTION; PATENTABILITY; SCOPE OF PATENT.

STATUTES OF LIMITATIONS.

A State Statute of Limitations is not pleadable in bar of an action at law for infringement of a patent (following McGinnis *v.* Erie Co., 45 Fed. Rep., 91).

Cal. Art. Stone Paving Co. *v.* Starr *et al.*, *Hawley, J.*, 14 Dec., 1891, 58 O. G., 1094.

See also Brickill *et al. v.* City of Hartford *et al.*, *Shipman, J.*, 6 Feb., 1892, 58 O. G., 1417.

"STEP BY STEP ARGUMENT."

Danger of, in Citation of prior Art.

The patentability of a process having been denied upon the ground that a claim by the same applicant in a former application for a process of manufacturing asphaltum from crude petroleum or a residuum thereof, having been held destitute of patentability, it did not make a new process to practise the same operation in the treatment of crude petroleum or a residuum of the same free from paraffin wax: *Held*, that of that proposition two things were to be said: (1) that it is never safe to determine patentability, upon such a step-by-step argument, and (2) that the substitution of material in a process where chemical or *quasi* chemical actions take place may evolve a change of substance. The probabilities as to the presence or absence of patentable novelty being in applicant's favor, the decision of the Examiners-in-Chief was reversed.

Dubbs, x. p., *Simonds, Com.*, 15 June, 1892, C. D. Ms.

Compare Smith, x. p., (8), and Keene, x. p., (9) COMBINATION.

STIPULATION.

No stipulation can be interpreted so as to require a party to do impossible things, nor should its observance

be rigidly enforced where the testimony desired cannot be so readily obtained by an action strictly in accordance with the stipulation as by one not in strict accordance with it.

Leeman *v.* Smith, *Fisher, Act. Com.*, 27 June, 1890, C. D. Ms.

SUBSTANTIAL AMENDMENT.

Where question involves "the merits," appeal lies to Examiners-in-Chief.

In determining whether a certain amendment of a rejected claim is sufficiently "*substantial*" to entitle applicant to two actions therein, the Commissioner will not [at that stage of the proceedings] pass judgment on the bearing of the official references, as to do so would be to decide a question pertaining to the merits of the application, which can be considered by him only on an appeal from an adverse decision of the Examiners-in-Chief.

Arnold, x. p., *Mitchell, Com.*, 6 Feb., 1890, C. D. Ms.

Compare, of same tenor, Gibbs, x. p., (2), Lapham, x. p., (5) AMENDMENT.

SUCCESS AS A TEST.

1. Accomplishment of a result that had been long unsuccessfully sought.

The patent of Thos. A. Edison, 27 Jan., 1880, related to an Incandescent Electric Lamp which consists essentially of incoming and outgoing conductors united by a carbon filament of high resistance within a vacuum in a glass receiver through which the conductors pass. The invention was consummated by Edison in the year 1879 after many months of experiment with different materials under different conditions. He had devised a platinum lamp in which success was thought to lie, but

its cost ($1.50) rendered it unavailable for ordinary use. He continued his experiments. At length he made the discovery that carbon would stand a high temperature, even when very attenuated, without undergoing disintegration, if operated in a high vacuum. This fact he utilized, producing a lamp having a filamentary carbon burner in a nearly perfect vacuum.

Experts, called for the U. S. Elec. L't'g Co., in the progress of the case, testified that such change of material involved no invention, because the use as a substitute for platinum, of carbon of any size operated in a vacuum, would be obvious to any one skilled in the art. To this the judges could not assent. They said: —

Sawyer and Man were skilled in the art, but, even after they had learned how to force out the occluded gases and withdraw them from the lamp-chamber, they turned away from the vacuum thus ready to their hands, feeling no doubt that they were following the teachings of the art in seeking stability, by the use, not of vacuum, but of a nitrogen atmosphere.

Edison was skilled in the art, but, after he had secured the nearly perfect vacuum of the French patent, secured against leaking by the all-glass globe of Geissler and Crookes, it was only after months of patient and persistent experiment that he found, in the substitution for his platinum of a filament of carbon, the success he had long sought for but not till then attained.

Edison Elec. Co. (respondent) *v.* The U. S. Elec. L't'g Co. (appellant), U. S. C. C. of Appeals, *La Combe* and *Shipman, JJ.*, 4 Oct., 1892, ✱.

2. "It is the last step that wins."

Courts will sustain a patent to a man who has taken the final step which has turned a failure into a success. *In the law of patents, it is the last step that wins.*

Washburn & Moen M'f'g Co. *v.* The Beat Em All Barbed

Wire Co., U. S. S. C. By *Brown, J.*, 27 Feb., 1892, 58 O. G., 1555, ✱.

Of like purport to the above ruling, see McClain *v.* Ortmayer, ✱, (6), and Chamfrey, x. p., (8) PATENTABILITY; Spielman, x. p., COMMERCIAL SUCCESS; Smith *v.* Goodyear Dental Vulc. Co., ✱, (1), The Consol. Valve Co. *v.* The Crosby Valve Co., (2), and Magowan *v.* N. Y. Belting Co., ✱, (11), THE DECISIVE STEP; Bruce *v.* Marder, (1), Renwick *v.* Pond, (3), Dederick *v.* Cassell, (4), Shuter *v.* Davis, (5), Hoe *v.* Cotterell (7), (8), Brown M'f'g Co. *v.* Deere & Co., (9), and Pullman Pal. Car Co. *v.* Boston & Albany R. R. Co., (10) UTILITY; Shannon, x. p. (10) INVENTION; Boyd *v.* Cherry, Gill *v.* Scott, and Green *v.* Hall, all (163) INTERFERENCES; and 1 Robinson on the Law of Patents, 554 *et seq.*

SUGGESTION.

1. To overcome an already granted patent the incipient idea must have been followed by a conception of a means or mode of carrying it out, and that by a publicly known reduction of the same to *actual practice*.

Coffin *v.* Ogden *et al.*, U. S. S. C. By *Swayne, J.*, Oct., 1873, 21 U. S., 821, ✱.

2. Mere conversations about the practicability of an improvement, or suggestions as to the manner in which it might be carried out or accomplished, will not of themselves defeat the claims to originality of him who perfects the idea and secures a patent, but information to the patentee sufficient to have enabled him to construct the thing itself would.

Judson *v.* Moore, *Leavitt, J.*, 1 Bond, 285.

3. A mere suggestion that a given result may be obtained is not patentable, and does not anticipate a patent producing such result.

Graham *v.* Gammon, *Blodgett, J.*, July, 1877, 7 Biss., 490.

4. An invention is not the less novel because the patentee developed it from ideas which were suggested to him by others.

Roberts *v.* Dickey, *Strong, J.*, 4 Brewster, 260.

5. Where an idea is suggested by one and utilized by another, — *semble*, that a joint patent should be taken out.

Thomas *v.* Weeks, *Thompson, J.*, May 1827, 2 Paine, 92.

See CONCEPTION; INTERFERENCES; INVENTION; JOINT INVENTION; REDUCTION TO PRACTICE.

SUGGESTION OF COURT.

Should be admitted for examination.

Where, upon an appeal to the Supreme Court of the District of Columbia, the court affirmed the adverse decision of the Commissioner, but made suggestions in supposed accord with which claims were subsequently presented, which the Examiner refused to entertain, because —

(1) The suggestion of the court was not sufficiently definite and clear; and (2) The construction suggested could not be claimed, as it was not disclosed in either the specification or drawings:

Held, that the Examiner should admit the claims for examination and, if of opinion that they were not allowable, reject them, so that petitioner could take an appeal to the Examiners-in-Chief.

Stone, x. p., *Fisher, Act. Com.*, 17 Mar., 1890, C. D. Ms.

SUPERFLUOUS CLAIMS.

The objection of redundancy does not go to the form of claims, but to their substance, and the general question presented is whether some of the claims are not the

same in scope as certain others. The question may properly be considered by the Examiners-in-Chief upon appeal, and an Examiner is not justified in refusing to act upon the merits until the number of claims is reduced.

Rodwell, x. p., *Fisher, Act. Com.*, 29 Aug., 1890, Ms.

Compare, however, Sawn, x. p., (3) REDUNDANCY; Bickley, x. p., (62) THE CLAIM.

SUPPLEMENTAL OATH.

1. Purpose and Limitations.

The office of a supplemental oath, as set forth in Rule 48, is to justify the introduction, by amendment, of a claim not substantially embraced either in the original statement of invention or in any claim originally presented. It affords, however, no justification for the introduction of matter by way of amendment which was neither described nor disclosed in the invention as filed.

Steward *v.* Ellis *v.* Lee *v.* Howe, *Mitchell, Com.*, 16 Dec., 1889, 49 O. G., 1883.

Cited and applied by Commissioner Mitchell in Edison, x. p., 15 Ap., 1890, C. D. Ms.

2. Where not required.

The fact that the claim under consideration is broader than the claim which was before made is not sufficient to warrant the requirement of a supplemental oath, provided such claim is within the scope of the case as originally presented (Hood & Starn, x. p., 39 C. D. Ms., 450; Ransom, x. p., 42 C. D. Ms., 402; and Ry. Reg. M'f'g Co. *v.* N. Hudson Ry. Co., 1885, C. D. 45).

Newman, x. p., *Fisher, Act. Com.*, 18 Feb., 1891, C. D. Ms.

3. An ex parte Question.

The question whether a supplemental oath shall or shall not be required is *ex parte* in its nature, and not open to argument on the part of an opposing interference contestant.

Rennyson *v.* Merritt, *Simonds, Com.*, 29 Feb., 1892, 58 O. G., 1415.

SUPREME COURT.

1. A Finding of Fact.

In an action at law the Supreme Court will not review, on the evidence, a finding of fact of the Circuit Court that plaintiff's invention was not anticipated by earlier patents.

Plow Works *v.* Starling, U. S. S. C. By *Blatchford, J.*, 35 L. ed., 404, ✱.

2. It is clearly the duty of the Patent Office to be guided by the decisions of the Supreme Court whenever that court has furnished a precedent.

Drawbaugh, x. p., *Simonds, Com.*, 28 Oct., 1891, 57 O. G., 693.

See COMMISSIONER, ETC.; OFFICE PRACTICE.

SURPLUSAGE.

May be corrected by certificate.

Where it was urged, as a ground for re-issue, that the statement of invention [preamble] described certain matter as being of the applicant's invention, when such matter had been stricken out during the progress of the application through the Office, and no claim therefor appeared in the patent: *Held*, that such error [although objectionable and to be avoided] does not render the patent inoperative or invalid, because the scope of the

patent must be determined by the claims taken in connection with the specification, and, in construing the patent, the matter referred to would be treated as mere surplusage. If desired, the error can be sufficiently corrected by a certificate [endorsed upon the letters-patent as prescribed in Rule 170].

Cunningham, x. p., *Fisher, Act. Com.*, 20 Aug., 1890, C. D. Ms.

SYMBOLS.

See DESCRIPTIVE CHARACTERS.

TERM OF A UNITED STATES PATENT.

1. Effect of earliest expiring foreign patent.

The foreclosure of a United States patent, consequent on conditions, as to term, of a previously granted foreign patent to the same inventor for the same invention, is derived from the last clause of Section 4887, Revised Statutes of the United States, which is in the following language:—

> Every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term.
>
> Sec. 4887 R. S.

The judicial applications of the clause appear in the following rulings:—

2. Letters-patent No. 197,314, granted to John J. Bate, 20 Nov., 1877, for the term of seventeen years, did not expire with the original term of five years of his Canadian patent, but continued in force to the end of the term of fifteen years of the extended Canadian patent, to wit, to 9 Jan., 1892, said Canadian patent

having never ceased to exist, but having been in force *continuously* from 9 Jan., 1877.

Bate Refrig. Co. *v.* Hammond *et al.*, U. S. S. C. By *Blatchford, J.*, 21 Jan., 1889, 46 O. G., 689, ✽.

3. Where the Canadian statute under which the extension of the Canadian patent was granted was in force when the United States patent was issued, and also when that patent was applied for, and where, by the Canadian statute, the extension of the patent for Canada was a matter entirely of right, at the option of the patentee on his payment of a required fee, and where the fifteen years term of the Canadian patent has been continuous and without interruption, the United States patent does not expire before the end of the fifteen years' duration of the Canadian patent.

Ib., ✽.

4. The provisions of the Act of 1870, and of section 4887, Revised Statutes, mean that the United States patent shall not expire so long as the foreign patent continues to exist, not, however, extending beyond the seventeen years of the United States grant.

Ib.,✽.

5. While it may be proper that the United States patent should contain a notice of the existence of such earlier expiring foreign patent, omission of such notice does not of itself constitute ground for invalidation of such United States patent.

Ib., ✽.

For rulings further explanatory of the same doctrine, see (6) *et seq.*, *infra*.

6. There is nothing in the statute (Section 4887, R. S.) which admits of the view that the duration of the United

States patent is to be limited by anything but the duration of the legal term of the foreign patent in force at the time of the issuing of the United States patent, or that the United States patent is to be limited by any lapsing or forfeiture of any portion of the term of such foreign patent by means of the operation of a condition-subsequent growing out of foreign statute.

Pohl *et al. v.* The Anchor Brewing Co., U. S. S. C. By *Blatchford, J.*, 24 Mar., 1890, 51 O. G., 156, ✱.

7. Section 4887 of the Revised Statutes is to be read as if it said that the United States patent is to be so limited as to expire at the same time with the expiration of the term of the foreign patent.

Ib., ✱.

8. The ground of the decision in the case of Bate Refrigerating Co. *v.* Hammond *et al.*, (46 O. G., 689; 129 U. S., 151), was that the term of the Canadian patent was, by the Canadian statute, at all times, a term of fifteen years' duration made continuous and uninterrupted by the action of the patentee of his own right and at his own option.

Ib., ✱.

9. Where a foreign statute, under which patents of that country carried with them a right of extension, was in force after the time of the application for or issuance of a United States patent, and where, under such statute, extension, in the absence of certain unfulfilled conditions, was a matter entirely of right at patentee's option on payment of a required fee, the (fifteen years) term of such foreign patent being, by the affirmative action of the foreign grant in renewing it, continuous and uninterrupted: *Held*, that the United States patent does not expire before the end of the

(fifteen years) duration of such foreign patent, although, before the expiration of the first five years, the foreign patent may, in fact, have lapsed or become forfeited by the non-observance of a condition-subsequent, or by the happening of a subsequent condition imposed by a statute of the country granting such foreign patent (The rulings of the Supreme Court in Bate *v.* Hammond,✽, and in Pohl *v.* Anchor Co.,✽, *supra*, cited and applied).

Edison Elec. Lt. Co. *v.* Perkins Elec. Lamp Co., U. S. C. C., D. Ct., *Shipman, J.*, 20 May, 1890, 52 O. G., 1370.

10. The above decision of the C. C. D. Ct. was affirmed and made final by a U. S. C. C. of Appeals, *Lacombe* and *Shipman, JJ.*, 4 Oct., 1892,✽.

11. Identity of Foreign Patent.

Whether or not the foreign patent possesses such identity with complainant's domestic patent as to bring the latter under the restrictions of Clause 2, Sec. 4887, R. S., depends on the answer to the following questions:

(i) As to the principal invention in each; is the thing patented abroad the same, in all essential particulars, as the thing patented here?

(ii) Would the home patent be infringed by a structure made in accordance with the provisions of the foreign patent?

In cases where these questions are answered in the affirmative, the United States patent falls with the date of cessation of the foreign patent having the earliest expiring term; it will not be saved by the fact that it contains improvements not found in the foreign patent (Siemens *v.* Sellers, 123 U. S., 276,✽; Com. Co. *v.* Fairbanks Co., 135 U. S., 176,✽).

Brush Elec. Co. *v.* Elec. Accumulator Co. *et al.*, *Coxe, J.*, 23 July, 1891, 56 O. G., 1884.

TERRITORIAL RIGHTS.

1. Right to Sell.—Right to Use.

The purchaser of a patented article from the owner of the right for a certain territory has no right to sell the article, *in the ordinary course of trade*, in territory of which another owns the exclusive right.

Standard Folding Bed Co. *v.* Keeler, U. S. C. C., Mich., *Brown, J.*, 20 Feb., 1889, 37 F. R., 354.

2. Precedent Rights.

In a case where the patentee had conveyed to *A* all his right, title, and interest within and throughout a specified territory, a subsequent purchaser *B*, of the patented article, who has notice of such prior assignment, takes subject to the rights of *A*, and cannot use the article within *A's* territory. The distinction, which seems to be broad and plain, between the case at bar and Adams *v.* Burke (84 U. S., 453, ✱), consists in the facts that the assignment here, under which the plaintiff, *A*, holds, is *first in order of time* and confers upon him the entire monopoly of the patent within his territory, and that the later assignment, under which the defendant, *B*, holds, is subject to this; while in Adams *v.* Burke the defendant's purchase antedating the assignment under which complainant held and sued, defendant's right of use could not be affected thereby.

Sheldon Axle Co. *v.* Standard Axle Works, U. S. C. C., E. D. Penn., *Butler, J.*, 21 Feb., 1889, 37 F. R., 789.

See ASSIGNEE; MANUFACTURE; SALE; USE.

TESTIMONY.

1. Witness having been withheld from cross-examination, his direct testimony was suppressed.

Where Examiner had adjourned the hearing at the point where a witness had been tendered for cross-

examination, and the party who offered the witness thereafter neglected to produce him for cross-examination, the entire testimony of that witness was suppressed.

Shapleigh *v.* Chester, &c. Co., U. S. C. C., E. D. Pa., *Hanford, J.*, 47 F. R., 848.

Compare Cretèau *v.* Hall, (179) INTERFERENCES.

2. Copies of, must be filed not less than one week before day of hearing, — Rule 162.

It is error for the Examiner of Interferences to permit the testimony to be filed on the day of hearing. Under Rule 162 copies must be filed not less than one week before the day of hearing.

Barrenburg *v.* Loeber, *Mitchell, Com.*, 8 Feb., 1890, C. D. Ms.

See CROSS-EXAMINATION; INTERFERENCE; PRIORITY.

TITLE OF PATENT.

While an applicant will be allowed, within reasonable limits, to say what the title of his patent shall be, he has not an absolute right in this or any similar matter of detail, and it is the province of this Office to determine whether any title given to an invention is one which satisfies Section 4884 of the Revised Statutes.

Nickola, x. p., *Simonds, Com.*, 27 Nov., 1891, 57 O. G., 1425.

TRANSFER OF CLAIMS FROM A FORFEITED TO A PENDING APPLICATION.

Where a mode of relief is provided for by statute the steps thereby provided should be followed.

Where an apparatus and a process in which it was employed were separately applied for and both applications were allowed but the application claiming the apparatus was withdrawn by the Office and put in an interference which was decided in favor of the applica-

tion so withdrawn, and the application was again allowed, but, pending these proceedings, the six months within which to pay the final fee on the companion application (covering the process) had been suffered to expire because it was, at that time, deemed (in view of the then prevailing decisions regarding such matters) inadvisable to issue the method case at an earlier date than the apparatus case, and the practice of the Office having, meanwhile, been changed, so that method claims and apparatus claims could be allowed in the same application; applicant sought to have the method claims which had been allowed in the (since forfeited) application placed in the pending application for the apparatus: *Held*, (intentionally refraining from deciding what action might be taken if both applications were still pending before the Office) that, section 4897, R. S., having provided a given remedy, the steps provided by the statute should be followed, not necessarily because otherwise the Office would lose a fee, but because the statute, having prescribed a method of relief, seems to impliedly prohibit relief by other methods.

Hopkinson, x. p., *Mitchell, Com.*, 24 Sep., 1890, 54 O. G., 264.

NOTE. — Sec. 4897, R. S., permits a new application to be filed any time within two years after original allowance.

TWO INTERFERING PATENTS TO SAME INVENTOR.

1. Precedence given to the Earlier Patent.

The contention of defendant was not sustained that the patent of 11 Sep., 1860, covered the same invention as did the earlier patent, — granted 1 Dec., 1857, — on a later application. But, even had defendant's allegation been correct, his conclusion would have been erroneous:

it is the *later* patent, not the earlier one, that would be void.

The Suffolk Co. *v.* Hayden, U. S. S. C. By *Nelson, J.*, Dec., 1835, 3 Wallace, 315, ❁.

NOTE (i). — For conditions under which the date of *application* (not that of grant) would determine the order of precedence, see Washburn *v.* Barbed Wire Co., (2, 3), *infra*.

NOTE (ii). — As in neither Suffolk Co. *v.* Hayden nor in Washburn *v.* Barbed Wire Co. was defendant's contention of identity between the subject-matter of complainant's patents sustained by the court, its ruling in each case, as to order of precedence, must, it would seem, be taken as a mere *obiter dictum*, and not as a decision based on issues actually involved in the respective cases.

2. Precedence given to Later Patent if on an Earlier Application.

The date of the application [an act of the inventor] and not the date of the patent-grant [an official act] controls in determining the legal effect to be given to two patents issued at different dates to the same inventor and the order in which they are to be considered.

Washburn & Moen M'f'g Co. *v.* The Beat Em All Barbed Wire Co., U. S. S. C. By *Brown. J.*, 27 Feb., 1892, 58 O. G., 1555, ❁.

Compare The Suffolk Co. *v.* Hayden, (1) *supra*.

3. Where dates of Applications determine Order of Precedence.

Where two applications were filed at different times (27 Oct., 1873, and 14 Mar., 1874), for different improvements in wire-fences by one and the same inventor, and patent on the later application issued first (12 May, 1874) and where patentee, after securing a patent (24 Nov., 1874) on the earlier application, surrendered pat-

ent on later application, and (8 Feb., 1876) obtained a re-issue of said patent with a broad claim dominating the device and claim of the patent on his earlier application, which re-issue was subsequently (4 June, 1883; Washburn & Moen M'f'g Co. *v.* Tucks, 16 F. R., 661) adjudged invalid on each and every one of several grounds, one of said grounds being that the feature claimed in said re-issue was substantially covered in the patent already granted on said earlier application, and where, in suit brought upon this patent (pat. of 24 Nov., 1874) defendant sought to have said patent set aside on several contentions, one contention being that, inasmuch as the earlier patent, as re-issued, covered the feature sued upon, and as said re-issue had been declared invalid, the later patent necessarily fell with it: *Held*, sustaining the patent because, although of later issue, it was on an earlier application, and in such cases priority depends on date of application not on date of grant.

Washburn & Moen M'f'g Co. *v.* The Beat Em All Barbed Wire Co., U. S. S. C. By *Brown, J.*, 27 Feb., 1892, 58 O. G., 1555, ✽.

NOTE (i).—The above decision of the Supreme Court proclaims, either directly or inferentially, that:

(1) He who introduces THAT which (however seemingly trifling and obvious) converts what had been a series of failures into a brilliant and operative success, is entitled to a patent.

(2) The claim or claims of a patent (whether in original or re-issued form) must be founded on subject-matter of the original application.

And that, where an applicant has, pending at the same time, two or more applications for improvements in the same art which entitle him to a generic claim and one or more specific claims:

(3) One patent can be in no wise affected by another (although in same art and to same inventor but with different subject-matter) upon a later application even although the patent upon such later application should issue earlier.

(4) A specific patent on same subject-matter must not antedate the generic patent (Suffolk Co. *v.* Hayden. 3 Wallace, 315).

(5) A claim in a later patent to a device described — without reservation — in an earlier patent to the same inventor, is void.

NOTE (ii). — The claims referred to were as follows:

Claim of patent of 24 Nov., 1874, in suit.

(Sustained, and adjudged to be infringed.)

"A twisted fence-wire having the transverse spur-wire D bent at its middle portion about one of the wire-strands a of said fence-wire and clamped in position and place by the other wire-strand z, twisted upon its fellow; substantially as specified."

Claim of re-issue of 8 Feb., 1876.

(Previously sued upon and adjudged invalid.)

"In combination with a fence-wire; a barb formed of a short piece of pointed wire secured in place upon the fence-wire by coiling between its ends, forming two projecting points; substantially as specified."

NOTE (iii). — So far as appears, the very broad and fundamental claim of 8 Feb., 1876, would have been sustained had it formed part of patent of 24 Nov., 1874, or of a sufficiently prompt re-issue thereof.

Compare (2) ORDER OF ISSUE; also (1) *et seq.*, and accompanying notes, DEDICATION.

UTILITY.

1. The fact that an invention is of great utility and has gone largely into use goes far to show that the inventor had discovered and put to use what others skilled in the art had overlooked, and what would probably have been found out before if ordinary skill in that art could have discovered it.

Bruce *v.* Marder, *Wheeler, J.*, Oct., 1881, 22 O. G., 1039.

2. When devices, however well known in other machines or for other purposes, have never been employed

in a given machine, or for purposes suggestive of the new application, legitimate combinations may be formed embodying such old devices.

Underwocd, x. p., *Fisher, Com.*, 3 June, 1870, C. D. 52.

3. The invention of Hicks involved only slight changes in what existed before, *but those changes brought success.* When the idea of Hicks was once embodied in practice it was easy to adapt it to any form of flange. When a cartridge on the *exterior* rim was used it required only ordinary mechanical skill to take Hicks' invention and apply it to such a flange, making the spring in the hook instead of in the flange. The change embodies Hicks' invention, although it may contain some patentable improvements.

Renwick *v.* Pond, *Blatchford, J.*, June, 1872, 5 Fisher, 581.
Of like tenor, see Nat. Typo. Co. *v.* N. Y. Typo. Co., (29) *et seq.*, THE CLAIM; and Shannon (10, 11), *et seq.*, INVENTION.

4. It is no answer to a patent to say that the combination required no invention, that any mechanic might have selected the parts and combined them. The fact that no mechanic *did* before select and combine the parts and produce such a machine, notwithstanding the great need for it, is a sufficient answer to such a suggestion.

Dederick *v.* Cassell, *Butler, J.*, 6 Oct., 1881, 20 O. G., 1233.

5. As between patentable invention and mechanical skill, the circumstance that the value of the new article was immediately recognized, and that it supplied a want long felt but not before met, should have due weight in favor of the sufficiency of invention.

Shuter *v.* Davis, *Wallace, J.*, 25 May, 1883, 24 O. G., 303.

6. A change made in an old device which, though simple, is effective and produces a new and useful result: *Held*, to involve the exercise of invention.

Sewing Machine Co. *v.* Frame, *Butler, J.*, 19 May, 1884, 28 O. G., 96.

7. In determining the question whether there was an invention in any particular combination, the important part is to ascertain whether novelty or utility existed. It is true that these requisites may result from mere mechanical skill, and a new and useful combination may be formed by the mere mechanical addition of an old element to an old set of members; but when a device has a new mode of operation which accomplishes beneficial results, courts look with favor upon it, and are not exacting as to the degree of inventive skill which was required to produce the result. There must be some, but a little will suffice.

Hoe *v.* Cottrell, *Shipman, J.*, 23 Mar., 1880, 18 O. G., 59.

8. Although, from the standpoint of after-time, it might seem difficult to see that a particular combination of old elements should have required the exercise of invention, still, the fact that, in the multiplicity of prior machines in the same line of invention, a combination of such value had not been hit upon, and that, when introduced, its utility was universally recognized, renders it evident that, in order to make such a combination, changes were necessary which the skill of the mechanic would not suggest, and that the work was practically more difficult than, to a theorist, it might now seem to be.

Ib.

9. The fact that not only the defendants in this case, but other large manufacturers of cultivators, have at

once adopted the same auxiliary lifting devices shown in complainant's patent, is evidence of the popular acceptance of this as a practical solution of many of the difficulties which had been encountered in attempts to use the older devices, and that it is such a change and improvement as required more than mere mechanical skill and is therefore such as to bring the device fairly within the domain of the patent law.

Brown M'f'g Co. *v.* Deere & Co., *Blodgett, J.*, 4 Aug., 1884, 28 O. G., 1187.

10. The patentee (George M. Pullman) undertook to overcome the difficulties incident to a vestibule-connection between cars, and he accomplished this by means of flexible or adjustable joints to permit of sufficient movement between individual passenger-cars. When a patented improvement possessed such marked utility and came so speedily and universally into public use as did the Pullman Vestibule System: *Held*, that the court should hesitate to declare the patent invalid for want of novelty, because these circumstances tended strongly to prove invention.

Pullman Palace Car Co. *v.* Boston & Albany R. R. Co., *Colt, J.*, 9 Oct., 1890, 53 O. G., 1255.

11. Useful Novelty evidenced by extensive public Adoption.

The fact that the invention went at once into such extensive public use as almost to supersede all packings made under other methods, was pregnant evidence of its novelty, value, and usefulness.

McGowan *v.* N. Y. Belting Co., U. S. S. C. By *Blatchford, J.*, 26 Oct., 1891, ✱.

12. In the law of patents, it is the last step that wins, and the courts will sustain a patent in favor of the last

of a series of inventors all of whom were groping to attain a certain result, which only the last one of the number seemed able to grasp.

The Washburn & Moen M'f'g Co. *et al. v.* The Beat Em All Barbed Wire Co. *et al.*, U. S. S. C. By *Brown, J.*, 27 Feb., 1892, 58 O. G., 1555, ❁.

13. Patentability accorded to a change (even though slight) which accomplishes a useful result that had long been unsuccessfully striven for.

Where there had been several unsuccessful attempts to produce an article satisfactory to the trade, and plaintiff, who had been experimenting with the subject for years, finally produced a device which, when patented, was at once largely adopted and went into and remains in general use: *Held*, there was sufficient evidence of novelty and utility to support a patent. The Supreme Court cited its previous decision given in McGowan *v.* Packing Co., (58 O. G., 845, ❁).

Gandy *et al. v.* Main Belting Co. *et al.*, U. S. S. C. By *Brown, J.*, 7 Mar., 1892, 59 O. G., 1106, ❁.

NOTE. — Plaintiff's claim in suit was:

The improved article of manufacture consisting of a hard, even-surfaced, rigid, impervious, non-elastic belt, composed of cotton-canvas or duck, having its warp-thread larger than the weft, both warp and weft being hard spun, the fabric tight woven, and folded, stitched, and saturated with linseed oil.

Among numerous decisions of like tenor, see The Washburn & Moen M'f'g Co. *v.* The Beat Em All Barbed Fence Wire Co., ❁, (12) *supra*, and cases cited in that suit.

14. Public Adoption.

Where the question of patentable novelty in a device sued upon is not free from doubt, a general and exten-

sive use by the public will incline the court to resolve the doubt in favor of the patent.

Topliff *v.* Topliff *et al.* Topliff *et al. v.* Topliff, U. S. S. C. By *Brown, J.*, 25 Ap., 1892, 59 O. G., 1257, ✱.

15. Doubt resolved in Applicant's favor.

Where the references showed the practice of methods which apparently differed from that of the applicant in mere mechanical details only, and applicant's success seemed attributable *wholly* to putting old ideas into practice more intelligently than had been done before, and the Examiners-in-Chief said that "the particulars or conditions on which the applicant places his claim for novelty and invention are merely the acts of the intelligent ore-worker exercising the expected skill of his calling in working the old process: *Held*, that it could not be denied that there seemed fair ground for saying just this thing, but the proposition was negatived by the fact that men of the highest intelligence and skill and familiar with the whole art, both here and abroad, had in vain sought the success that was attained by the applicant, and hence, upon equitable consideration of the whole case, the doubt was resolved in favor of the inventor and the decision of the Examiners-in-Chief was reversed.

Blair, A. P., *Simonds, Com.*, 17 Nov., 1891, C. D. Ms.

UTILIZATION.

1. The grant of a U. S. patent imposes no obligations to work the invention.

The right of patentee to proceed against an infringer is not dependent on his own manufacture or use of the thing patented or that the invention has been a source of profit to him. An accounting and assessment of dam-

ages will be ordered in proof that the defendants have made profits (Walker on Pats., sec. 579; Colgate *v.* Tel. Co., 17 Blatch., 308).

Wirt *v.* Hicks, *Shipman, J.*, 16 Ap., 1891, 56 O. G., 662.

2. While the patentee's monopoly is not dependent on his working the invention, his neglect to work it may bear on question of value.

The patentee may let his invention lie in the Patent Office without use, and no one else would have the right to use such invention, because it is the patentee's property; but while this is true, as a matter of law, still, in ascertaining whether the machine is capable of use, it may be important to know that the inventor had never made or used the machine, because the presumption is, that a person obtains a patent for something practical, and not for a mere experiment. It need not be a very useful or profitable machine, but it must be capable of some use not mischievous, injurious, or immoral.

Pitts *v.* Wemple, *Drummond, J.*, Dec., 1855, 1 Biss., 87.

VACATION OF A PATENT.

A bill in equity lies to set aside letters-patent improperly granted, but only between the sovereignty making the grant and the grantee. To vacate a patent granted by the United States, suit must be brought in its name through its proper law officer.

The United States *v.* Gunning, *Wallace, J.*, Nov., 1883, 26 O. G., 356.

See REPEAL OF PATENTS.

VALIDITY.

Prima Facie Presumption.

The fact that the patent has been unquestioned for more than five years, during which time the machines

have been put on the market and largely advertised and over a million dollars have been invested in their manufacture, — even if there has been no prior adjudication in its favor, — sufficiently fortifies the *prima facie* presumption of the validity of the patent.

Nat. Typ. Co. *et al. v.* N. Y. Typ. Co. *et al.*, *Lacombe, J.*, 11 Mar., 1891, 56 O. G., 661.

VEIL OF SECRECY.

See (1) ABANDONED APPLICATION; (1) CAVEAT; (109) and (194) INTERFERENCES.

WAIVER.

1. By withdrawing a rejected claim, applicant waives the right to subsequently assert it.

Where an applicant before the Patent Office originally presents broad claims, and, being rejected upon them by reference to patents already granted, amends his specification and claims, and is granted a patent upon the amended claims, he waives the broad claims of his first application and cannot afterward, in an action for infringement, broaden the scope of his invention by claiming that it was made before the anticipating patents issued.

Shaw Stocking Co. *v.* Pearson, *Colt, J.*, 10 Nov., 1891, 58 O. G., 949.

Among numerous applications of this doctrine, see Roemer *v.* Peddie, ✱, (73) THE CLAIM; Dodds *v.* Stoddard, (5) ESTOPPEL; Hoeveler *et al. v.* Verner *et al.*, (62ª), and Del Grande *v.* Mannie, (62) INTERFERENCE; and Sargent *v.* Hall Safe & Lock Co., ✱, (10) PUBLIC RIGHTS, ETC.

2. Prosecution constitutes a waiver.

After reversal by Examiners-in-Chief of the Primary Examiner's rejection, the latter, — without first obtaining

the Commissioner's permission, as required by Rule 142,—again rejected the application on new references. Thereupon, applicants requested a reconsideration and final action, and submitted a brief complaining of the delay of having their application rejected in piecemeal. The Examiner then repeated his action and made the rejection final. Thereupon applicants petitioned for redress, on the ground of irregularity of Examiner's action in re-opening the case without authority: *Held*, that applicants, by their request for reconsideration, waived whatever right they had under Rule 142, and petition was denied.

Sutton, x. p., *Mitchell, Com.*, 15 June, 1891, C. D. Ms.

For Constructive Waiver, see Creteau *v.* Hall, CROSS-EXAMINATION.

WAIVER OF OBJECTION TO TESTIMONY.

See Hotchkiss *v.* Smith &c. Post, (70), Creteau *v.* Hall, (179) INTERFERENCES.

WIFE AS A WITNESS.

1. In questions arising in the United States Patent Office, husband and wife are incompetent as witnesses for or against each other, and this rule is co-extensive with the territorial jurisdiction of the United States, and is unaffected by any of the local statutes of the respective states.

Cornish *v.* Rein *v.* Rappel, *Hall, Com.*, 9 June, 1888, 43 O. G., 1453.

See also Workman *v.* McNaught, *Paine, Com.*, 25 Apr., 1879, 16 O. G., 216.

2. A wife is not a competent witness in proceedings before the Patent Office where her husband is a real party in interest and her testimony is offered on his behalf.

Dobeck *v.* Novotny, *Simonds, Com.*, 30 Jan., 1892, 58 O. G., 804.

WITHDRAWAL FROM ISSUE.

1. To add a claim;—granted.

While it is a general rule that applications which have been allowed will not be recalled for the purpose of amendment, an exception to the rule must be recognized in cases where great hardship or irreparable injury would otherwise result. Especially is this true since, under modern decisions of the courts, the right of reissue has become so restricted that any failure to obtain in the first application full protection of an invention is, in a vast majority of cases, without remedy. Hence, where the claim sought to be incorporated is so specially pertinent to the subject-matter of the application and so inseparable in its nature from the particular invention sought to be patented that, if allowed in another application, there would be grave doubt whether the patent therefor would be valid, amendment after allowance should be permitted.

Myers, x. p., *Mitchell, Com.*, 24 Sep., 1889, 49 O. G., 131.

2. To add a claim;—denied.

Where the petition for withdrawal of an application from issue for the purpose of adding another claim was filed after the expiration of six months from allowance, and applicant alleged that the claim had been omitted by oversight of attorney, and that applicant had not noticed the omission until about a month previous, when he, *for the first time*, read a copy of his application: *Held*, that the showing did not bring the case within the exception to the general rule laid down in Myers, x. p., 49 O. G., 131, and the petition was denied.

Craigie x. p., *Fisher, Act. Com.*, 20 Dec., 1890, 45 C. D. Ms., 80.

3. For Amendment.

For the character of the showing required to warrant withdrawal of case from issue for the insertion of a proposed amendment, reference is made to Meyers, x. p., 49 O. G., 131; and Craigie, x. p., 45 C. D. Ms. 80.

Morgan, x. p., *Fisher, Act. Com.*, 8 Jan., 1891, C. D. Ms.

4. When inadmissible.

Where petitioner, — who was negotiating for the sale of his inventions abroad, — requested that his U. S. applications be withdrawn from issue for a period of thirty days, in order to preserve to the purchasers the rights in all foreign countries: *Held*, denying the petition, that the Commissioner has no authority, directly or indirectly, to extend the time for paying the final fee to a period later than six months, and that that would be the effect if the petition were granted. Rule 165 only provides for a new notice of allowance when applications are withdrawn from issue for further action on the part of the Office.

Simonson, x. p., *Mitchell, Com.*, 30 Sep., 1890, 53 O. G., 1571.

5. For Change of Date, — denied.

A petition requesting that the application be withdrawn from issue or suspended under Rule 166, for the purpose of having patent issue at the same time with another pending application: *Denied*, because it would have the effect of extending the time for paying the final fee to a period later than six months from the allowance which resulted from proceedings according to law, and that the case was not distinguishable in principle from that of Simonson, x. p., 53 O. G., 1571.

Brand, x. p., *Frothingham, Act. Com.*, 18 July, 1891, C. D. Ms.

6. To correct a Clerical Error.

Amendments after being placed on the issue docket, not affecting the merits of the application but intended to correct merely formal matters, may be admitted under Rule 78. When, however, such claims affect the merits, they cannot be made without withdrawing the case from issue. Such withdrawal will only be permitted on a proper showing (Myers, x. p., 49 O. G., 131; Meyer, x. p., 54 O. G., 265).

Cornelius, x. p., *Frothingham, Act. Com.*, 6 Ap., 1891, 56 O. G., 929.

WITHHOLDING ISSUE OF PATENT.

The Commissioner has the power to withhold a patent even after a favorable decision by one of the lower tribunals. Such a supervisory interference will not be exercised however, unless a clear case of necessity therefor is apparent.

Strong, x. p., *Simonds, Com.*, 7 Oct., 1891, 57 O. G., 274.

See COMMISSIONER.

WITNESSES.

It is to be remembered that the Commissioner of Patents has no power in the matter of taking testimony of witnesses, and no control over the taking of their depositions, nor over their conduct while such depositions are being taken. The whole matter is left in the hands of the Federal courts of the district in which the testimony is being taken, and either party has full authority to apply to the district judge for orders compelling the attendance and controlling the conduct of witnesses.

Wright *v.* Daggett, *Hall, Com.*, 9 Aug., 1888, 44 O. G., 943, 1888, C. D. 116.

See 195 and 196 INTERFERENCES.

See, also, Osgood *v.* Badger *et al.*, 44 O. G., 1066, and Blunger *v.* Smith, 57 O. G., 273.

"WORD OF LIMITATION."

In a deed [or a grant] to a person not then living, "*his heirs and assigns;*" the word "heirs" [or "assigns"] is "a word of limitation" not of "purchase." There being no grantee, there was no grant, and there are no heirs or assigns (5 McLean, 202).

The De La Vergne Refrig. Mach. Co. *v.* Featherstone *et al.*, *Blodgett, J.*, 29 Feb., 1892, 58 O. G., 1842.

Compare DECEASED APPLICANT.

CHAPTER III.

DECISIONS RELATING TO PATENTS FOR DESIGNS.

DESIGNS.

1. A design patent is allowed to any originator of a new shape or configuration of any article of manufacture, or of a new ornamental or useful design, pattern or picture, to be worked into, or printed, or painted, or cast, or otherwise attached *to any article of manufacture*. Government fee ($10, $15, or $30), dependent on the length of term ($3\frac{1}{2}$, 7, or 14 years) applicant elects to demand.

R. S. 4929, 4934.

2. A patentable design relates only to an artistically devised figure for attachment to or impressment upon some article of manufacture.

Upon an application to patent a design for the exterior of a country house: *Held*, rejecting the application, that the word "manufacture" as used in sec. 4929, R. S., relating to patents for designs is to be construed to have the same meaning as the same word in prior statutes relating to mechanical patents, and must be limited to something for attachment to or impressment on a manufactured article, and any "construction" that would make it include a dwelling house or any other article of "realty" would involve a departure from the received significance of the word as employed in statutes relating to patents for mechanical devices, and must therefore be pronounced wholly inadmissible.

Lewis, x. p., *Mitchell, Com.*, 14 Mar., 1891, 54 O. G., 1890.
Compare Roy & Nourse, (11) TRADE-MARK.

3. The kinds of subjects which may respectively be protected by a copyright, or by a design patent, have been distinguished and defined as follows:—

An engraved or printed design, issued as an object of art, having a value in itself, and intended for sale as such, properly comes within the provisions of the copyright law; but when — however artistically executed — it is not produced for sale as a work of art, but is designed to be *affixed in the manner of a label to a manufactured article*, it then plainly falls under the act relating to patents for designs, and, consequently, cannot be protected by copyright.

Bishop, Com. of Pats., Aug., 1859.

See, also, Norton, x. p., (7) *infra.*

4. A design patent has reference only to configuration or figure.

A design is merely a delineation of form or figure, either plain or solid, a shape or configuration. The character of the material, the color, or the mechanical structure in which a design finds expression, forms no part of it, and is of no possible importance in describing the design itself.

Traitel, x. p., *Butterworth, Com.*, 12 Nov., 1883, 25 O. G., 783.

5. A configuration presents a suitable subject for a design patent if it *appeals to the eye.*

The validity of a patent for a design does not depend upon the exercise of the "inventive faculty of the mind" in the sense in which that expression is used in connection with inventions which relate strictly to the useful arts. The policy which protects a design is akin to that which protects the work of an artist by copyright. The design may be simple and not show a wide departure

from other designs, yet, if it produce a different impression upon the eye, it will be protected.

Untermeyer *v.* Freund, *Coxe, J.*, 15 Jan., 1889, 47 O. G., 527.

6. The fact that an article is useful does not make it less patentable as a design if it is *new as a design*.

Kraus *v.* Fitzpatrick, *Wheeler, J.*, 24 Feb., 1888, 42 O. G., 1292.

7. The expression "useful" in patents for designs has a different meaning to the same word as applied to an invention. A design is useful when, by it rendering the article of merchandise attractive, it *serves to distinguish it from other like articles in the market.*

The term "useful" (in the law authorizing grant of patents for designs) is used in contradistinction to mischievous. A design, if not mischievous, is useful if it is attractive; and utility may consist in such a shape [ornamentation] or configuration of a given article that persons needing it will purchase it because of such shape [ornamentation] or configuration in preference to other articles for the same purpose, but different in shape [ornamentation] or configuration. [Where the design relates wholly to configuration] it is not necessary that it should be ornamental (although it may be) to entitle the applicant to a patent therefor.

Norton, x. p., *Marble, Com.*, 16 June, 1882, 22 O. G., 1205.

8. A design patent has no reference to mechanical functions.

Matter descriptive of the mechanical functions of a device must be omitted from a design application.

Ib.

9. Form.

An objection to descriptive phrases in the specification of a design application, as being matter which tends to indicate mechanical functions rather than design, goes to the *form* of the specification rather than to its "merits," and is properly brought to the Commissioner on petition.

Herrick, x. p., *Fisher, Act. Com.*, 23 May, 1890, Ms.

10. The design in its entirety and its segregable parts may be separately claimed.

The claims in a patent for design must be restricted to the entire design and distinctive, segregable, integral parts thereof.

Pope, x. p., *Marble, Com.*, 30 June, 1883, 25 O. G., 290.

11. Must be unitary.

The practice of allowing two or more forms to be included in a single design patent would result in confusion in the Office and ought not to be permitted.

Hess & Hess, x. p., *Frothingham, Act. Com.*, 21 Aug., 1891, 56 O. G., 1334.

12. Only one design can be the subject of a single design patent, and where applicant's specification attempts to cover more than this it is properly held defective.

Petzold, x. p., *Simonds, Com.*, 18 Nov., 1891, 57 O. G., 1277.

13. The language of the sections 4837 and 4929 of the Revised Statutes is general and implies that the permission of two years' public use before application for patent includes patents for designs.

Fenton on Design Patents, 68.

14. Previous public Use.

Original designs, like inventions and discoveries, are patentable, unless they have been in public use or on sale for more than two years prior to application for patent or have been abandoned (Root *v.* Ball, 4 McLean, 177; Booth *v.* Garelly, 1 Blatchford, 247).

Anderson *v.* Eiler, *Reed, J.*, 22 June, 1891, 57 O. G., 410.

15. The word "manufacture," as used in sec. 4929, R. S.: *Held*, not to include such a generic term as "table-ware." A *class* of goods cannot receive protection under the design act.

Proeger, x. p., *Frothingham, Act. Com.*, 15 Oct., 1891, 57 O. G., 546.

Compare Wilkinson, x. p., (17) *infra*.

16. What may be included in.

In application for a design patent, a claim merely for a portion of the design capable of being attached to or connected with different forms to make up an entire whole, is inadmissible. The claims must be restricted to the entire design and distinctive, *segregable*, integral parts thereof.

Pope, x. p., *Marble, Com.*, 30 June, 1883, 25 O. G., 290.

17. The different articles constituting a "set" may be included under a single design patent, but extraneous and merely adjunctive parts should be omitted from drawing or be represented by dotted outline only.

In an application for a design patent, the design consisted in "the peculiar and novel shape and ornamentation of the bowl;" and the drawings, consisting of six figures, showed "the application of the bowl to the several articles usually included in a tea-set," and the Examiner required applicant to point out which one of

the figures showed his design and to eliminate the others and revise the specification accordingly: *Held*, that the evident object in illustrating the design as applied to the different articles of a tea-set was, as in Hess & Hess, x. p., (56 O. G., 1334), to deter infringers. The action of Examiner sustained, with the suggestion that, as the leading feature of the design was the bowl portion of the vessel, a figure of drawing showing the design having a conventional top and bottom portion of the vessel dotted in, would be a sufficient compliance with the requirement of the Office.

Wilkinson, x. p., *Frothingham, Act. Com.*, 17 June, 1892, C. D. Ms.

NOTE. — In answer to applicant's contention that the Office permitted the illustration of many forms of letters and numerals in patents for designs for fonts of type, the Acting Commissioner said that such a design is not sought for one particular type, but for a *font* of type, the completed article being a *font of type*, and it might be held that the design for a single letter is a design for an impression, and that, therefore, the rule would not apply to an article of manufacture.

18. Words and Numerals.

Upon petition from the action of the Examiner requiring certain words and figures to be erased from the drawing and specification in an application for a design for a spoon: *Held*, that if the words and figures objected to were not a part of the design, the action of the Examiner should be affirmed, without prejudice, however, of applicant's right to make them a part of his design; but if they were a part of the design, or applicant should thereafter make them a part thereof, the objection should take the form of a rejection.

Van Slyke, x. p., *Frothingham, Act. Com.*, 6 June, 1892, 60 O. G., 893.

NOTE. — The Acting Commissioner said, incidentally, that he was inclined to the view that it would not be advisable to lay down, as a general proposition of law, that words and figures may never form a part of the subject-matter of a design-patent.

19. Where it appeared from the specification that certain words and figures shown on the face of the design in the drawing did not constitute an essential feature of the design: *Held*, that the patent should not be permitted to seem to make them so, and that they should be erased.

Requa, x. p., *Simonds, Com.*, 12 May, 92, 60 O. G., 295.

20. A mere miniature of a well-known object or article is not patentable.

A design for jewelry-pins consisting of a piece of metal in the shape of a spoon or fork two inches long, precisely similar in appearance to common spoons or forks six inches long, lacks the novelty necessary to support a patent.

Foster *v.* Crosin, *Gray, J.*, 18 Oct., 1890, U. S. C. C., R. I., 44 F. R., 62.

21. Must display artistic invention.

A design is not patentable where the difference between it and a prior existing design is a mere matter of preference calling for no exercise of inventive thought, which, although manifested in a different way, is as necessary in the case of a design patent as of a mechanical patent.

Crouch, x. p., *Mitchell, Com.*, 7 Mar., 1891, C. D. Ms.

NOTE. — In this case, the drawing was merely a representation in miniature of a well-known object.

22. Damages for infringement, — How assessed.

The Act of Congress (4 Feb., 1887) fixing a liability of $250 against every infringer of a design patent is within the authority conferred by the eighth clause of section 8 of Article 1 of the Constitution, and is, therefore, valid. The act requires that an infringer shall be further liable for all profits in excess of $250 made from the sale of the article or articles to which the design is applied: *Held*, that the court cannot limit the damages to the profits due merely to the design, but must take into account all the profits realized on the sale of the article made thereunder.

Untermeyer *v.* Freund, *Coxe, J.*, 18 Ap., 1892, 59 O. G., 1923.

23. Refundment of fee refused.

Where the Examiner advised applicant for a design patent that his design as claimed was not patentable, and suggested that the application might be amended, but, instead of amending it, applicant requested permission to withdraw it and receive back his fee: *Held*, that the request could not be granted.

Baer, x. p., *Mitchell, Com.*, 5 Feb., 1890, C. D. Ms.

CHAPTER IV.

DECISIONS RELATING TO TRADE-MARKS AND LABELS.

TRADE-MARKS.

1. The Act of 3 Mar., 1881, "To authorize the Registration of Trade-Marks and to protect the same," is understood to be founded on what is known as "the Commerce Clause;" viz., that clause of the Constitution of the United States, which says:

The Congress shall have power to regulate commerce with foreign nations, and among the several states, and with the Indian tribes.

Art. 1, Sec. 8, Cl. 3, CONST.

See Palmer, x. p., (2) LABELS.

2. A trade-mark registration is not a grant; neither is it a contract. It is *a mere record* permitted to an owner of a trade-mark that has been used in commerce with foreign nations or Indian tribes, who is domiciled in the United States or located in some foreign country which affords similar privileges to our citizens, of which record a certificate is given by the Commissioner of Patents. It is true that the registration is *prima facie* evidence of ownership, but in this it is only like other records.

C. A. Yale Cigar M'f'g Co. *v.* C. A. Yale, *Dyrenforth, Act. Com.*, 19 July, 1884, 30 O. G., 1183.

3. A trade-mark is a common-law right.

The decision of the Supreme Court in trade-mark cases (100 U. S., 82) in reference to registration does not affect the jurisdiction of Federal Courts in matters

relating to trade-marks where the jurisdiction is otherwise secured by reason of diverse citizenship of the parties, since *properiy in trade-marks comes from the common law, and not from the statute.*

Battle *et al. v.* Findlay *et al.*, U. S. C. C., E. D. La., *Billings*, *J.*, 8 Ap., 1892, 60 O. G., 2072.

Compare Harris Drug Co. *v.* Stucky, (4), and Gravely *v.* Gravely, (9) TRADE-MARKS.

4. Trade-mark rights not dependent on statutory regulations.

The right to trade-marks and the remedies for their protection exist independently of statutory regulations; and, therefore, the fact that section 3, Act of 3 Mar., 1881, fails to enumerate descriptive words in the list of limitations on the right to registry of trade-marks, does not by implication validate a trade-mark consisting of such words.

Harris Drug Co. *v.* Stucky, U. S. C. C., W. D. Pa., *Reed*, *J.*, 46 F. R., 624.

5. The rule reaffirmed that if a manufacturer has applied a new and distinctive label to designate his goods, and has so used it, that his goods are identified by it; a court of equity will restrain another party from adopting and using one so similar that its use is likely to lead to confusion by purchasers exercising the ordinary degree of caution which purchasers are in the habit of exercising with respect to such goods. Complainant was the first to use for beer a label in which the name of the kind of beer appeared in white letters on a diagonal red band. Respondent used a diagonal red label: *Held*, to be a strong case of similarity likely to deceive, and injunction granted (McLean *v.* Fleming, 96 U. S., 245, ✽).

Anhauser-Busch Brewing Ass'n *v.* Clarke, *Morris*, *J.*, Jan., 1886, 34 O. G., 562.

6. A trade-mark becomes the exclusive property only of the person or firm that has first appropriated it and used it to indicate the origin, ownership, and quality of the article to which it is attached. The value of the trade-mark rests wholly on the reputation of the article and upon the implied guarantee of the former that the latter is of a certain recognized quality. The object is to prevent one person selling his goods as those of another of established reputation, to the injury of that other.

Avery & Sons *v.* Meikle & Co., 27 O. G., 1027.

7 Only the Fac-simile of the Trade-mark admissible for Registration.

The Act of March 3, 1881, under which the Office acts in registering trade-marks provides that the applicant shall cause to be "recorded in the Patent Office," along with other things, a description of the trade-mark itself, with *fac-similes* thereof, and a statement of the mode in which the same is applied and fixed to goods. So far as the trade-mark is to be represented or shown it is to be by "*fac-simile*," the mode of application being indicated by "a statement." Rule 9 of trade-mark rules provides that where the trade-mark can be represented by a *fac-simile* that conforms to the rules for drawings for mechanical patents, such a drawing may be furnished by the applicant. A *fac-simile* is an exact counterpart of an original; and a *fac-simile* represented by a drawing is an exact counterpart of an original so far as the nature of a drawing admits. A close adherence to the language of the statute would seem to require that, in each case, the trade-mark and nothing but the trade-mark should be represented by the drawing. The cases are very rare in which such registration requires or should permit the representation of any other matter.

Hudson, x. p., *Mitchell, Com.*, 15 May, 1891, 55 O. G., 1401.

FEATURE CLAIMED TO BE ESSENTIAL MUST BE THE CONSPICUOUS FEATURE.

8. The feature claimed to be "The Essential Feature" must be so conspicuous as to strike the eye of a purchaser.

Where a trade-mark presented for registration consisted of a complex design showing a horse-shoe bearing the word "STANDARD" with a trefoil or clover-leaf within the shoe and three conventional acorns surmounting it, and the applicant described these several elements but stated that the essential feature of the trade-mark was "the figure of an acorn": *Held*, sustaining the Examiner's objection to the statement as to "the essential feature:" that *the essential feature of a trade-mark is not that which the registrant elects to designate as such, but that which would strike the public mind as its most salient feature and as lending character to the entire mark.* It cannot be said of a trade-mark consisting of three acorns that its essential feature is "an acorn," much less can it be said that one acorn constitutes the essential feature where a horse-shoe is part of the mark which certainly would strike the eye of the observer as quite as essential as the acorns.

Metropolitan Watch Co., x. p., *Mitchell, Com.*, 4 Oct., 1890.

9. A mark does not become a trade-mark until attached to a vendible article and the article put on the market.

Where, in a trade-mark interference between a registrant and an applicant, the evidence showed that the applicant had stamped, wrapped, and boxed a certain amount of "clover" soap, but did not show that he had put on the market or had sold any soap so marked, and the Examiner of Interferences awarded priority to the registrant: *Held*, that the law as to trade-marks seems

to be that a mark does not become a trade-mark until it is put upon a vendible article which, in turn, is put upon the market. This point is fully discussed in Schneider *et al. v.* Williams (44 O. G.), 1400, in which it is held that one of the three steps necessary to secure a title in a mark as a trade-mark is that the article be put on the market. McAndrew *v.* Bassett, De Gex, J. & S., 386, and Maxwell *v.* Hogg, L. R., 2 Ch. App. Cas., 314, set forth the same doctrine; and, such being the case, the decision below should be affirmed.

Procter & Gamble *v.* Columbia M'f'g Co., *Mitchell, Com.*, 10 Oct., 1890, Ms.

"THE COMMERCE CLAUSE."

10. Registration confers *prima facie* ownership.

Whoever is the first to adopt and use the mark in the United States, in either domestic or foreign trade, is, under the common-law, the owner of such mark on his class of goods.

The fact of the use of the mark in commerce with foreign nations or with Indian tribes gives the lawful owner a right to certificate of registration, which registration confers upon the registrant certain benefits, the principal one of which is *prima facie* ownership.

In a contest between two interfering applicants, or between an applicant and a registrant, the right belongs to the one who, as a party to a suit in a court of equity, would be adjudged the owner of the trade-mark.

The common-law owner of a trade-mark is entitled to registration whenever he shall show use "in commerce with foreign nations or with one or more Indian tribes," and he cannot be deprived of his right to registration by reason of the [subsequent] use of the mark in foreign trade by another, even though the mark has been registered by that other.

Maintowoc M'f'g Co. *v.* Dickson, *Frothingham, Act. Com.*, 18 Nov., 1891, 57 O. G., 1721.

NON-REGISTRABLE MARKS.

11. The language of the statutes and of the courts renders it clear that the things to which trade-marks may be affixed, so as to be protected and registered, are what are ordinarily termed in law "goods," "wares," and "merchandise,"—that is, articles of ordinary commerce, such as may be transported from one country to another in contradistinction to those fixed species of property which the law includes under the term "real estate;" hence, where applicants sought to register a mark used by them in their real estate business by painting or stencilling it on their sign-boards, and by printing it on their business-cards, stationery, circulars, etc.: *Held*, that it was not a proper subject for registration.

Roy & Nourse, *Fisher*, x. p., *Act. Com.*, 14 Feb., 1891, C. D. Ms.
Compare Lewis, x. p., (2) DESIGNS.

12. Laws of the United States guaranteeing exclusive right in trade-marks have reference only to such marks when used in foreign commerce.

Where, in an action for the infringement of a trade-mark duly registered under the Act of 3 Mar., 1881, the bill did not assert that the defendants had used the trade-mark in foreign commerce, and the proof did not show a single instance of such use on their part: *Held*, that under these circumstances, since the parties to the suit are citizens of the same state, and since *the only right guaranteed to complainants by the laws of the United States is the right to use exclusively their registered trade-marks in foreign commerce*, the court was without jurisdiction, and that the bill must be dismissed.

Gravely *v.* Gravely, U. S. C. C., W. D. Va., *Bond, J.*, 42 F. R. 265.

Compare Battle *et al. v.* Friday *et al.*, (1) TRADE-MARK.

13. The "tribe" or "nation" must be *specified*.

The original oath to the declaration contained, *inter alia*, the statement that "said trade-mark is used . . . in commerce between the United States and foreign nations or Indian tribes (particularly with the tribes located in the Indian Terri' ry.);" and upon the Examiner requiring a substitute oath setting forth "commerce with some particular foreign nation or Indian tribe," applicant filed a supplemental oath in which he gave the name of a certain Indian tribe, and stated that the oath was in addition to his prior declaration, which he thereby made a part of the supplemental oath the same as if fully repeated in it: *Held*, that under Rule 12, which provides that the declaration cannot be amended, it was proper for the Examiner to require an entire new oath (Strasburger & Co., 1881, C. D. 23, and cases therein cited).

Schotten & Co., *Frothingham, Act. Com.*, 13 June, 1892, 60 O. G., 576.

REGISTRABLE MARKS.

14. Applicant was registrant of the word "LACE" as a trade-mark on a certain class of goods, and sought to register broadly any representation of lace without restricting himself to the specific representation of lace shown in his application. Examiner refused registration: *Held*, that it was, perhaps, doubtful whether applicant was entitled to register a trade-mark so broad as that for which he sought registration, in view of the recent decision of the Supreme Court (N. Y. Belting & Packing Co. *v.* N. J. Car-Spring & Rubber Co., 54 O. G., 135, ✽); but, in view of the fact that if registration were allowed, applicant would, in a court of competent jurisdiction, only be entitled to protection to the extent of what may be adjudged his lawful trade-mark, he should be given the benefit of the doubt, and registra-

tion was accordingly ordered. (The Commissioner also considered Peper, x. p., 1879, C. D. 221; Morrison *v.* Cass, *Shipman, J.*, 2 O. G., 544; Am. Lub. Oil Co., x. p., 9 O. G., 687; and Weaver, x. p., 10 O. G., 1.)

Woodbury, x. p., *Mitchell, Com.*, 15 Feb., 1891, C. D. Ms.

15. "Pigs in Clover."

Preliminary injunction granted restraining defendant, his agents, servants, and workmen, from marking, stamping, or designating in any manner, games, toys, or any article of manufacture, with the words "PIGS IN CLOVER," or any material part thereof, or any word or designation that could be mistaken therefor, and from making games, toys, or puzzles, of the size, shape, or appearance of the exhibit, which may, in any manner, be mistaken therefor.

Lyman *v.* Barnes, U. S. C. C., N. D. Ill., *Blodgett, J.*, 15 Ap., 1889, 47 O. G., 660.

16. Arbitrary Words.

Where, in an application to register the word "SILK" as a trade-mark for soap and soap-powders, the record showed that the word was an arbitrary selection and not intended to be applied to a soap especially designed for washing silk goods: *Held*, that the term was purely fanciful, as used, and that the authorities are clear that where such is the case the trade-mark may be registered.

Ross, x. p., *Fisher, Act. Com.*, 10 July, 1890, C. D. Ms.

17. "Cramp Cure," — Figure of a Boy.

An application for registration of a trade-mark stated that it consisted "essentially of the illustration of a boy in a position indicating suffering from cramps." Immediately below the figure of the boy were the words "Cramp Cure": *Held*, that the trade-mark consisted in

the design of the suffering boy, which the application stated to be the essential feature, and that the words "Cramp Cure" formed no part thereof. Also held that the words "Cramp Cure," being descriptive of the purpose and character of the medicine, could not be appropriated as a trade-mark by the manufacturers of a remedy for the disease.

Harris Drug Co. *v.* Stucky, U. S. C. C., W. D. Pa., *Reed, J.*, 46 F. R., 624.

18. Geographical Name.

It appearing that the party, seeking to register the word "BERLIN" as a trade-mark for the kind of cotton goods known as *silesia*, had for some time used the mark; that he had no connection with the city bearing the name sought to be registered; that it was not shown that such a place was well-known as producing the article to which the mark was to be applied, and that, therefore, no one would be deceived or wronged: *Held*, that the mark was entitled to registration (following Dover Stamping Co., x. p., 51 O. G., 1784; and Jenkins, x. p., 53 O. G., 759; where it was held that geographical names used in a purely arbitrary or fanciful sense may be lawful trade-marks).

Hyde & Son, x. p., *Fisher, Act. Com.*, 19 Jan., 1891, C. D. Ms.

19. The burden of showing that the place bearing the geographical name is noted for the production or sale of the class of articles to which the name is to be applied, is upon the Office, not upon the applicant; and, in case of doubt, the benefit of the doubt should be given to the applicant.

Ib.

20. Benefit of the Doubt.

Where the Examiner refused registration of the words "GINGER CHAMPAGNE," as a trade-mark for effervescent

or carbonated mineral water and ginger, upon the ground that they were merely descriptive of applicant's merchandise: *Held*, following Stoughton *v.* Woodward (39 F. R., 902), that applicant should have the benefit of the doubt, and registration was granted.

Manitou Mineral Water Co., *Mitchell, Com.*, 19 Sep., 1890, C. D. Ms.

21. Use of a surname.

In order to justify the exclusive use by a person or corporation of another man's name or a portrait, as against the man who bears the name or is represented by the portrait; some contract, relation, or estoppel must be found to exist operating to deprive the latter of what would otherwise be his right.

Richmond *v.* Richmond Nervine Co., *Mitchell, Com.*, 21 June, 1890, Ms.

22. It is well settled that no person can acquire, by adoption, such an interest in the name of another as to prevent that other from using his own name in a fair and honest manner in the ordinary course of business; and that, to justify such use, as against the man who bears the name, some contract relation or estoppel must be found to exist, operating to deprive the latter of what would otherwise be his right (see Rogers *v.* Rogers, Am. Trade-Mark Cases, 999; Skinner *v.* Oaks, Ib., 459; Richmond *v.* Richmond Nervine Co., 52 O. G., 307).

Finlay & Brunswig, x. p., *Frothingham, Act. Com.*, 25 Feb., 1892, C. D. Ms.

NOTE. — The Assistant Commissioner, said: "The present case is to be carefully distinguished from that class of cases wherein the name of a distinguished person is used, in a fanciful and arbitrary sense, to designate ownership or origin of the article to which it is applied, *e. g.*, '*Henry Clay*' for cigars."

23. Descriptive name, *when combined with a picture*, admissible.

The words "WARREN HOSE-SUPPORTER," when used alone, may not constitute a valid trade-mark, but when used in connection with a cut of a hose-supporter engaged with a stocking, and placed, as labels, on boxes containing hose-supporters, the mark, in its entirety, is sufficiently arbitrary to fairly denote the origin of the goods and is entitled to protection as a trade-mark.

Frost *v.* Rindskopf, U. S. C. C., E. D. N. Y., *Wheeler, J.*, 42 F. R., 408.

PROHIBITED SUBJECTS OF TRADE OR OTHER COMMERCIAL MARKS.

24. The prohibition in the following sections is understood to include trade-marks, labels, advertisements, and printed designs.

Section 2 of the Act of Feb. 5th, 1867, makes it unlawful to design, engrave, print, or in any manner make or execute, or to utter, issue, distribute, circulate, or use any business or professional card, notice, placard, circular, handbill, or advertisement, in the likeness or similitude of any bond, certificate of indebtedness, certificate of deposit, coupon, United States note, Treasury note, circulating note, fractional note, postage stamp note, or other obligation or security of the United States, or of any banking association organized or acting under the laws thereof, which has been or may be issued under or authorized by any act of Congress heretofore passed or which may hereafter be passed. And any person or persons offending against the provisions of this section shall be subject to a penalty of one hundred dollars, to be recovered by an action of debt, one-half to the use of the informer.

Section 3 of the same Act makes it unlawful to write, print, or otherwise *impress* upon any bond, certificate of indebtedness, or other instrument specified in the last preceding section, any

business or professional card, notice, or advertisement, or any notice or advertisement of any goods, wares, or merchandise, or of any drug or medicine, or of any invention or patent, or of any other matter or thing whatsoever; and any person or persons offending against the provisions of this section shall be subject to a penalty of one hundred dollars, to be recovered by an action of debt, one-half to the use of the informer.

Act approved 5 Feb., 1867, — Prohibiting use or imitation of U. S. bank-notes, etc., for advertising purposes.

25. "Red Cross" for medicines.

Where applicants sought to register a trade-mark which consisted of a red cross, Greek in form, on black ground in a diamond shaped border and accompanied by the words, "RED CROSS," and the application stated that applicants had "used it as a trade-mark on their medicinal compounds since 20 Oct., 1887, and in commerce with Canada," and the Examiner rejected the application because "the name 'red cross' and the symbol of a red Greek cross have been adopted by the celebrated 'International Red Cross Society,' and are used upon its hospital-supplies, medicines, etc.," and because "the employment of the name or symbol would simply be regarded as an attempt to make profit out of the reputation of that society:" *Held*, that such a trade-mark would naturally lead the purchaser to suppose that he was purchasing an article which, even if not manufactured by the Red Cross Society, had at least its sanction or endorsement, and that such a trade-mark is, irrespective of its intent, in the nature of a false representation calculated to mislead the public (Manhattan Med. Co. *v.* Wood, U. S. S. C. By *Field, J.*, 2 Ap., 1883, 108 U. S., 218,❁). Decision of the Examiner affirmed and registration refused.

Chidester Chem. Co., x. p., *Mitchell, Com.*, 3 Aug., 1889.

Compare (32) and (33) *infra*.

26. "Old Sleuth," — series of publications.

Where the plaintiff, who had been using the name "OLD SLEUTH" to designate a series of books published by them, sought to enjoin defendants from using the word "SLEUTH" on the titlepage of certain stories which they published, it was held that the word "sleuth," being a word having a place and meaning in the language, cannot be appropriated as a trade-mark.

Munro *v.* Beadle, Supreme Court of New York, *Ingraham, J.*, 11 Oct., 1888, 46 O. G., 448.

Compare Munro *v.* Smith *et al.*, (14) COPYRIGHT, where the same complainant (Munro) attempted unsuccessfully, under his copyright, to restrain the use in a similar publication of a picture (different from his own) of "Old Sleuth the Detective."

NOTE. — Decision in Munro *v.* Beadle permits the inference that a purely fanciful word may be registered as a trade-mark for a published serial or a series of publications.

A VERBAL TRADE-MARK MUST NOT BE DESCRIPTIVE.

27. "Indurated Fibre."

The words "INDURATED FIBRE" as applied to wares made of wood-pulp which has been condensed and subjected to baths in linseed oil and resin, and baked, designate wood-fibre which has been subjected to a hardening process, and refer to ingredients, quality, and characteristics. These words are not so arbitrary and fanciful as to authorize a preliminary injunction in an action to restrain their use as an infringement of a trade-mark.

Indurated Fibre Co. *v.* Amoskeag Indurated Fibre Ware Co., U. S. C. C. D. Mass., *Colt, J.*, 21 Jan., 1889, 37 F. R., 695.

28. "Headache Capsules."

The word-phrase "HEADACHE-CAPSULES," as applied to a medicine for curing headache, refused registration

on the ground that they have no fanciful or arbitrary character, but constitute ordinary descriptive language.

Lichty, x. p., *Mitchell, Com.*, 6 May, 1891, C. D. Ms.

NOTE. — In this case, the Examiner had cited Heyman x. p., 1880, C. D. 194, and Brigham, x. p., 1881, C. D. 38, and the Commissioner said, "To these may be added the following cases where registration has been refused on the same grounds as those taken by the Examiner in the present case. C. L. Hathaway & Sons, 1871, C. D. 97; R. J. Roberts, 1871, C. D. 113; S. Palmer, 1871, C. D. 289; Blakesley & Co., 1871, C. D. 142; Alden, x. p., 1878, C. D. 142; The Safety Powder Co, 1879, C. D. 117; Ames, x. p., 1883, C. D. 10; Kipling, x. p., 1883, C. D. 54. The law, as set forth in these decisions is believed to be in accordance with what is said by the courts in Town *v.* Stetson, 3 Daly, 53; Larrabee *v.* Lewis, 25 Alb. L. J., 203; Gintner *v.* Kinney Tobacco Co., 12 F. R., 782; Ayer *v.* Rushton, 7 Daly, 9; Hect *v.* Porter, 6 Pac. C. L. J., 569; Canal Co. *v.* Clark, 13 Wall., 322, ❋, and other decisions.

29. "Tablet."

Registration of the word "TABLET," as a trade-mark for snuff, denied, on the ground that it was descriptive of snuff compressed into tablets and would operate to prevent the sale of snuff in tablet form by others.

Reed, x. p., *Mitchell, Com.*, 24 Sep., 1890, C. D. Ms.

30. Subject-matter of an expired Design Patent not Registrable.

A group of figures or characters embossed on the spool-head to indicate the grade of thread had been the subject of a design patent owned by complainant who, on said patent's expiration, sought to enjoin the use of such an embossed inscription by a competitor on the plea that it had acquired value as a trade-mark. The plea was denied and bill dismissed *because the inscription did*

not appear to possess the qualifications required in a trade-mark and consequently complainant's monopoly ceased at the expiration of his design patent.

Coats *v.* Merrick Thread Co., U. S. C. C., N. Y., *Wheeler, J.*, 28 Sep., 1888, 36 F. R., 324.

NOTE.—The fact that the embossed inscription in question was descriptive rather than arbitrary would seem to have unfitted it for claim as subject of trade-mark right (Canal Co. *v.* Clark, 13 Wall., 322, ✽), but the court thought it sufficient to cite the long-standing and general use of such inscriptions on thread-spools.

MISLEADING MARKS NOT REGISTRABLE.

31. "Cherry-Cocktail."

Registration of the compound word "CHERRY-COCKTAIL" as a trade-mark for "*Temperance or non-Alcoholic Beverages;*" *Denied*, on the ground that the word "cocktail" denotes a beverage containing alcohol, and its use upon non-alcoholic beverages, being misleading, would make it an unlawful trade-mark even if true that there is no such beverage known as "*cherry*" cocktail. *Also held*, that, if it were doubtful whether or not the public would be thus deceived, the doubt should be resolved against the applicant, it being held that *a doubtful trade-mark is bad.*

Rowe, x. p., *Frothingham, Act. Com.*, 2 May, 1892, C. D. Ms.

32. "Liebig's Diarrhœa Cordial."

The words "LIEBIG'S DIARRHŒA CORDIAL" refused registration as a trade-mark on the ground that the name "Liebig" would naturally lead the purchaser to suppose that he was purchasing an article which, if not manufactured by the distinguished chemist, was prepared after his formula, or at least had his sanction or endorse-

ment, and would be, irrespective of intent, in the nature of a false representation.

Finlay & Brunswig, x. p., *Frothingham*, *Act. Com.*, 25 Feb., 1892, C. D. Ms.

33. Misleading Name.

Applicant, having been refused registration of a name because descriptive, filed thereupon an amendment to his application in which it was stated that the word was not descriptive inasmuch as there was nothing in the compound which had any relation whatever either to the word used or to the tree known by it: *Held*, sustaining Examiner's action and refusing registration, because the mark, when applied to the compound or so-called "balsam" of the applicant would be in the nature of a misrepresentation or fraud upon the public. The Patent Office will refuse registration of a trade-mark which is liable to deceive the public with reference to the contents of bottles, boxes, etc., to which it is applied.

Johnson, x. p., *Frothingham*, *Act. Com.*, 13 Aug., 1892, C. D. Ms.

34. Registration refused for an already appropriated mark.

A trade-mark for soaps consisting of "the word 'YUCCA,' arranged over the representation of the yucca plant," refused upon reference to a registered mark for soaps which consisted essentially of "a representation, in elevation, of a 'Spanish bayonet plant,'" it appearing that the two names referred to the same plant, and that the distinguishing and most notable feature of each mark was a representation of a yucca plant, and that, consequently, the use of the mark sought to be registered would have a tendency to deceive and mislead purchasers using ordinary caution.

Bogardus, x. p., *Frothingham*, *Act. Com.*, 26 Mar., 1892, C. D. Ms.

35. "Taylor." — "Old Taylor."

The word "Taylor" being registered as a trade-mark for use on a certain class of goods, registration of the words "Old Taylor," for use on the same class of goods, refused, on the ground that the word "Taylor" was the distinguishing and most notable characteristic of not only the registered trade-mark, but also of that sought to be registered, and that therefore the latter would have a tendency to deceive and mislead purchasers having ordinary caution.

Taylor, x. p., *Frothingham, Act. Com.*, 31 Oct., 1891, C. D. Ms.

35′. Imitative Marks.

It is well settled that the right of registration does not extend to trade-marks the use of which would infringe pre-existing trade-marks. *Imitative marks infringe* not only when they contain the entire mark previously adopted, but also *when they contain enough of the prominent features of the prior mark to be likely to cause purchasers using ordinary caution to be misled.*

Ib.

36. Fraud. — Competition.

The law does not visit with its reprobation a fair competition in trade; its tendency is rather to discourage monopolies, except where protected by statute, and to build up new enterprises from which the public is likely to derive a benefit. It is only when such competition is based upon fraud that the law will interfere.

The Brown Chem. Co. *v.* Meyer *et al.*, U. S. S. C. By *Brown, J.*, 6 Ap., 1891, 55 O. G., 287, ✱.

37. Reference.

A rejected trade-mark application is no more a reference for a trade-mark application than is a rejected mechanical application for a mechanical application.

Ross, x. p., *Fisher, Act. Com.*, 10 July, 1890, C. D. Ms.

38. Same Descriptive Properties.

"Roofing Composition and Materials" and "Mixed Paints and Roofing Composition:" *Held*, to be merchandise of substantially the same descriptive properties (Kyle & Co., x. p., 57 O. G., 274), and registration denied where the mark applied to the latter merchandise so nearly resembled a registered mark applied to the first as to be calculated to deceive purchasers exercising ordinary caution.

Beaver M'f'g Co., x. p., *Frothingham, Act. Com.*, 6 June, 1892, C. D. Ms.

39. Issue to assignee,—how effected.

A trade-mark registration may be applied for by the owner, whether such owner acquired his title by original adoption or by subsequent assignment, but a certificate of registration of a trade-mark will not be issued to the assignee of the applicant, although the assignment may have been recorded prior to the issue of the certificate of registration.

Bassett, x. p., *Mitchell, Com.*, 12 May, 1891, 55 O. G., 997.

40. A trade-mark that has been used in a particular business should be deemed to have passed with a transfer of the business.

Atlantic Milling Co. *v.* Robinson, *Wallace, J.*, 6 May, 1884, 27 O. G., 1322.

INTERFERING TRADE-MARK APPLICATIONS.

41. Where, upon a motion to dissolve an interference declared between conflicting applications for registration of a trade-mark, it was contended that the only question in such an interference is that of priority in application for registration: *Held*, sustaining the Primary Examiner's refusal to dissolve, that, where a conflict appears to

exist between such applications, Rule 13 must be applied, which provides: "In case of conflicting applications for registration, or in any dispute as to the right to use, which may arise between an applicant and a prior registrant, the Office will declare an interference, in order that the parties may have opportunity to prove priority of adoption or right." See also sec. 3, Act of 3 Mar., 1881.

Langdon & Batcheller *v.* Thomson, *Mitchell, Com.*, 31 May, 1890.

Compare Richmond *v.* Richmond Nervine Co., *infra.*

42. In trade-mark interferences the question is the same as would arise in a court of equity if one of the parties were seeking to enjoin the other from using the trade-mark in controversy; hence the right to registration belongs to the party who should prevail in such a litigation.

Richmond *v.* Richmond Nervine Co., *Mitchell, Com.*, 21 June, 1890, C. D. Ms.

Compare Langdon & Batcheller *v.* Thomson, *supra.*

TRADE-MARK INFRINGEMENTS.

43. Trade-mark is infringed by one liable to deceive an ordinary purchaser.

As to what facts constitute infringement of a trade-mark or of a trade reputation, no rule can be formulated that will embrace every act of infringement, and a comparison with the original of the alleged imitation is of primary importance. The resemblance need not be such as would mislead an expert or such as would not easily be detected if each case must depend mainly on itself. It is enough if such resemblance exists as would lead an ordinary purchaser to suppose that he was buying the genuine article and not an imitation. If the differences

are only colorable and there is no reason for the resemblances except the purpose of deceiving the purchaser, the court will presume a fraud was intended.

Avery & Sons *v.* Meikle & Co., Ky. Ct. of Appeals. By *Hargis, Ch. J.*, 27 Mar., 1883, 27 O. G., 1027.

44. It is not incumbent upon the complainants to show that their trade-mark has been copied in every particular; it is sufficient if it has been imitated to an extent sufficient to deceive purchasers, and to cause the article to which it has been applied to pass as their article.

Atlantic Milling Co. *v.* Robinson, *Wallace, J.*, 6 May, 1884, 27 O. G., 1322.

45. False Suggestion.

Where in a suit to restrain the unlawful use of the trade-mark or symbol "SAPOLIO" it appears that, when persons called at defendant's store and asked for Sapolio soap, his salesman would (without any statement or explanation) hand out a package which did not bear the name of "Sapolio" at all, but on which "Pride of the Kitchen" was plainly marked, the size and shape of the package and appearance of wrapper being moreover entirely unlike the article sold as Sapolio: the court cited Celluloid M'f'g Co. *v.* Cellonite M'f'g Co., *Bradley, J.*, (32 F. R., 97,) and: *Held*, that *any act or thing done to induce the belief that one article was in fact the other was unfair and unlawful*, and granted an injunction.

Morgan, Sons & Co. *v.* Wendover, *Green, J.*, U. S. C. C., N. Y., 43 F. R., 420.

46. Degree of Resemblance.

A trade-mark for underwear, consisting of the conventional representation of a "Sun" surrounded by rays and

having a distinctly marked human face, and, frequently though not necessarily, bearing the words: "Warmth is Life," is not infringed by a symbol having an imperfect outline somewhat resembling sun-rays, but whose characteristic feature is a circle inclosing a monogram, the label never bearing the words "Warmth is Life," but always having the name of the manufacturing company using it.

Jaros Hygienic Underwear Co. *v.* Simons, U. S. C. C., Mass., *Colt, J.*, 15 Feb., 1892, 49 F. R., 276.

47. There must be, between the genuine and alleged deceptive marks, such similarity or resemblance of form, color, symbols, designs, and such identity of words and their arrangement, as to have a direct tendency of misleading buyers who exercise the usual amount of prudence and caution; and there must also be such a distinctive individuality in the mark employed by the counterfeiter as to procure for him the benefit of the deception resulting from the general resemblance between the genuine and counterfeit labels and trade-marks.

Colladay *v.* Baird, *Ludlow, J.*, Court of Common Pleas of Phila., p. 257, Cox Am. T. M. Cas.

48. To entitle the owner of a trade-mark to an injunction to prevent its use by another person, there must be, in the [alleged] copy, such a general resemblance of the form, words, and symbols in the original as to mislead the public. A sufficient distinctive individuality must be presented so as to secure for the person himself the benefit of that deception which general resemblance is calculated to produce. *The court will not interfere where ordinary attention will enable purchasers to discriminate,* nor where the ordinary mass of purchasers, paying the usual attention, in buying the article in question, would not be deceived.

Rowley *v.* Houghton, *Ludlow, J.*, p. 486, Cox Am. T. M. Cas.

49. To have a word or words claimed as a trade-mark protected by injunction from use by another, it should appear the defendant's use of them was with intent to deceive or mislead the public.

Larrabee & Co. *v.* Lewis, Supreme Court of Georgia, Nov., 1881, p. 560, Price and Stewart Am. T. M. Cas.

REGISTRATION FEES.

50. Transfer of trade-mark fee, — refused.

A filed an application for registration of a trade-mark, but registration was refused him as his oath did not show that he had exclusive title to the mark; thereupon *B*, a foreign company and the true owner, filed a petition to register the mark, and requested that the fee paid by *A*, who was *B's* agent, be applied to *B's* application: *Held*, that there was no authority for the transfer of a fee from one application for a trade-mark which has received examination, to a new application presented by another person, as in the present instance.

Coventry Machinist Co., x. p., *Frothingham, Act. Com.*, 23 Feb., 1892, 59 O. G., 1923.

NOTE. — Subsequently, *B* petitioned for return of the fee paid by *A*, upon the ground that it was paid by mistake under a supposition that *A* was the proper person to sign for registration in this country, but the Assistant Commissioner denied the petition, holding that the mistake, if any, was *a mistake of* LAW *and not one of fact*, and that, *A's* application having been rejected on its "merits," the fee could not be refunded.

This decision was made 12 May, 1892, and appears in 59 O. G., 1923.

51. Fee not refunded.

There is no authority, either in the law or in the regulations of the Patent Office, for re-payment of fees paid in trade-mark cases where registration is refused.

Thayer, x. p., *Chandler, 1st Assist. Sec. of Int.*, 28 Jan., 1891, 54 O. G., 957.

United States Coat of Arms, — not registrable.

Where it was admitted that the mark was substantially the coat of arms of the United States, and would be accepted as such by the ordinary mind, registration was refused, upon the ground that it was against public policy to register a coat of arms of any state or nation.

Schmachtenberg, x. p., *Frothingham, Act. Com.*, 8 Oct., 1892, C. D. Ms.

When the subject-matter of the application was clearly anticipated by a mark registered [by another] under the Act of 1870, and Examiner refused to declare an interference because of the nullity of such prior registration, and also refused registration to the second applicant because the prior registry made the mark an anticipation: *Held*, that the proper course for the Office in such a case is to give the applicant who had filed under the law of 1870, notice that an application is pending with which his registry, if it were under the existing act, would interfere, and allow him sixty days to make an application.

Am. Lead Pencil Co., x. p., *Simonds, Com.*, 27 Sep., 1892, C. D. Ms.

NOTE. — The Supreme Court having pronounced the Trade-Mark Act of 1870 unconstitutional, all registrations under it became null and void.

INFRINGING IMPORTS. FOREIGN TRADE-MARKS.

52. Act of Congress approved 1 Oct., 1890, section 7, enjoins collectors and other officers of customs to refuse entry from abroad of merchandise so marked as to copy or simulate the name or the trade-mark of any domestic manufacture or manufacturer, and the Secretary of the Treasury (in regulations promulgated 31 Oct., 1890) invites proprietors of such marks and names to furnish

the department with copies thereof, and instructs officers of the department to keep the same on record, and to exercise care to prevent the entry at the custom-house of any article of foreign manufacture that copies or simulates such mark or name.

Records of Treasury Department, 31 Oct., 1890.

53. Foreign Applicants.

The United States Government guarantees to furnish foreign applicants such protection, and such protection only, as their respective governments accord to them.

Haggenmacher, x. p., *Simonds, Com.*, 27 June, 1892, 60 O. G., 438.

54. Foreigner's Rights.—Test.

A citizen of Switzerland located and having a place of business at Buda-Pesth in Austria, cannot register in the United States a trade-mark which is of a character specially excepted from protection under the laws of Austria, viz., an arbitrary word-symbol. The location or place of business, and not the citizenship, is the test.

Ib.

55. Foreign Commerce.

The fact that an applicant was the first to use the mark in foreign commerce does not entitle him to register it, if it appears that he is not presumptively the owner of the mark at common law (see Manitowoc M'f'g Co. *v.* Dickerman, 57 O. G., 1721).

Empire Mill Co., x. p., *Frothingham, Act. Com.*, 24 Dec., 1891.

LABELS.

1. The dictum of the United States Supreme Court in the case of Higgins v. Keuffel, may be summarized as follows:

Under the terms of the Act of 18 June, 1874, which authorizes registration of commercial labels, this kind of right is, except in the particulars specified in the said act, subject to the requirements of the general copyright law on which it is engrafted.

In the case at bar these requirements had not been complied with, and the decree of the court below dismissing the suit was therefore affirmed.

Higgins *et al. v.* Keuffel *et al.*, U. S. S. C. By *Field, J.*, 11 May, 1891, 55 O. G., 1139, ✽.

NOTE. — A full compliance with the Copyright Act would seem to include: (a) registration precedent to publication; (b) evidence of intellectual labor, either literary or artistic; (c) the imprinting of the date of registration on each label in commercial use. To the above, the Label Act itself adds another requirement, viz.: The "print," "picture," or "figure" to be registered as a label must *not* be registrable as a trade-mark; see Sec. 3, Act 18 June, 1874.

2. Purport and Limitations of the Act of 18 July, 1874.

The cases of Higgins *v.* Keuffel (140 U. S., 428; 35 L. ed., 470; 55 O. G., 1139, ✽), and the Trade-Mark cases (100 U. S., 82, ✽), therein cited, are understood to establish the following propositions: —

(1) That section 3 of Act of 18 July, 1874, in order to be valid, must be based upon some part of the Constitution of the United States.

(2) Such basis, if it exists, must be found either in "*the Commerce Clause*" or in "*the Author's and Inventor's Clause*" of the Constitution.

(3) It is not found in the Commerce Clause, because it lacks the limitations inherent in said Commerce Clause.

(4) The constitutional basis for said act, if it exists, is in the Author's and Inventor's Clause.

As the Supreme Court is not understood to have definitely pronounced the above act unconstitutional, it remains for this Office to treat it as valid and as being *a part of the copyright law.*

Palmer, x. p., *Simonds, Com.*, 13 Jan. 1892, 58 O. G., 383.

3. Requirements for Registration.

A label, in order to be entitled to registry, under the copyright law, in the Patent Office, needs to possess as much artistic [or literary ?] excellence as would entitle it to copyright in the Office of the Librarian of Congress, if it were not something "designed to be used for any other articles of manufacture" than "pictorial illustrations or works connected with the fine arts."

Ib.

4. Proper subject for registration illustrated.

Where applicant presented for registry as a label a piece of paper, about seven inches long by three and a half inches wide, bearing a picture of a hammock, to which the label applied and its accessories, attached at one end to the fragment of a branch of a tree and at the other to a fragment of the side of a house, with certain descriptive matter in words, the whole, so far described, being printed upon a white ground, which was, in effect, an oval panel in a section of the hammock, that hammock-section being printed in three different colors, presumably to denote the color and arrangement of the strands of the hammock: *Held*, that the design appeared to fall within the narrow limits fixed by the statute to be a proper subject for registration as a label.

Ib.

5. Qualifications for copyright registration and for label registration distinguished.

The difference between a copyright and a label is that in the copyright act the words "engraving," "cut," and "print" are applied only to pictorial illustrations or works in the fine arts, and matter pertaining to them is entered in the office of the Librarian of Congress, whereas, by the word "print" or "label" as employed in the Label Act, is understood only such a label or print (not appropriable as a trade-mark) as is to be used on an article of manufacture, and the Commissioner of Patents is charged with the control and supervision of the entry or registry of such print or label.

C. A. Yale Cigar M'f'g Co. *v.* C. A. Yale, *Dyrenforth, Act. Com.*, 19 July, 1884, 30 O. G., 1183.

Compare decision of *Bishop, Com.*, in (3) DESIGNS.

6. Proper and improper subjects for label registration illustrated.

Where, in the label sought to be registered, it was clear that, while the part thereof which contained fanciful or arbitrary matter within the meaning of the trade-mark law (viz., an illustration of a mountainous sea-coast, etc.) might possess such a degree of artistic merit as would entitle it to be registered as under the copyright law [if not designed for attachment to an article of merchandise; see *Bishop, Com.*, Aug., 1859 (3) DESIGN; Norton, x. p., *Marble, Com.*, 16 June, 1882, 22 O. G., 1205], yet it was *not* a pictorial representation *of the article for which it was designed to be used*, and it therefore fell *without* the narrow margin allowed for the registry of labels, under the copyright law, in the Patent Office, which is permitted by the decision in Palmer, x. p. (58 O. G., 383).

Whitman & Son, x. p., *Frothingham, Act. Com.*, 24 Feb., 1892, C. D. Ms.

NOTE (i). — In this case the Assistant Commissioner stated that he was authorized to state that the Commissioner concurred in the conclusion reached.

NOTE (ii). — From the italicized portions of above decision it may be inferred that the picture in question might have been registered as a trade-mark.

7. Requirements for Registration.

Upon a motion for re-hearing of Whitman & Son, x. p., in view of the change of the practice indicated in the case of Palmer, x. p.: *Held*, denying the motion, that it was held in the Palmer case that "a pictorial representation descriptive of the fabric of the hammock to which the label applies" was proper subject-matter for registration as a label. It was not, however, intended to decide in that case, nor was it in fact held therein, that a mere arbitrary or fanciful design having no special relation to the article of merchandise it was intended for, would be a proper subject for registration as a label. In Palmer's case the label consisted of matter not fanciful or arbitrary in the sense of the trade-mark law, but *illustrative of the article to which it was to be applied*, besides having such a degree of artistic excellence as to entitle it to protection under the copyright law.

Ib.

8. A label consisting of an engraving showing steps at the front of a house, with a kneeling female figure in the act of scrubbing the steps, and having the words "Ecker's Stone Mineral Soap" in ornamental letters upon the design, and below the engraving a description, printed in ordinary type, of the uses to which the soap could be put and for which it is particularly designed, cannot properly be registered in the Patent Office under the Act of 18 June, 1874, in view of the decision of the

Supreme Court in Higgins *v.* Keuffel, U. S. S. C. By *Field, J.*, 11 May, 1891, 55 O. G., 1139, 35 L. ed., 470, ✿.

Ecker, &c. Co., x. p., *Frothingham, Act. Com.*, 20 Nov., 1891, C. D. Ms.

9. A label consisting of the name of the article contained in the bottle or package to which it is applied, a statement of the uses of the article, directions for applying it, the price at which it is sold, and the name and address of the firm by which it is prepared, and which exhibits *no attempt at art or literary merit*, was not entitled to registration under the recent decision of the Supreme Court in Higgins *et al. v.* Keuffel *et al.*, 55 O. G., 1139, and registration was denied.

Eldridge & Co., x. p., *Mitchell, Com.*, 27 May, 1891, 55 O. G., 1278.

10. The words "Silver Shine" sought to be protected, being a fanciful one coined by applicant and not being descriptive, was proper subject of protection as a trade-mark.

It is the settled practice of the Office to consider the words "not a trade-mark," in the statute approved 18 June, 1874, referring to the registration of labels, as applying to anything appearing on a label susceptible of appropriation as a trade-mark. Label registration was refused.

Ruckstuhl, x. p, *Simonds, Com.*, 4 Aug., 1891, 56 O. G., 927.

11. Decree was denied to complaint of infringement of right to exclusive use of a representation of a horseshoe with no letters on it. It might have been protected as a trade-mark.

Lorillard & Co. *v.* Drummond Tobacco Co., 22 O. G., 1203.

12. Trade-mark in label must be registered.

The doctrine of The Wilcox & Gibbs S. M. Co. *v.* Marble, 1882, C. D. 445, was overruled by the Supreme Court of the District of Columbia (Moodie *v.* Butterworth, 1885, C. D. 1), and the settled doctrine of the Office now is that labels containing or constituting trade-marks cannot be registered as labels until the trade-mark matter has already been registered in accordance with the statute regulating the registration of trade-marks (Simpson & Sons, x. p., 1876, C. D. 148; Moodie, x. p., 1884, C. D. 35; Moodie *v.* Butterworth, *supra*; Wiesel, x. p., 1886, C. D. 22; Columbia S. M. Co., 41 Ms. C. D. 228; Snook & Halbe, 40 Ms. C. D. 423).

Diamond Laboratory Co., x. p., *Mitchell, Com.*, 23 July, 1890, C. D. Ms.

NOTE. — In above case the Commissioner said that, if there remained some possible doubt upon the whole case whether the trade-mark had been registered for a class of articles including that for which the label was intended, he thought the applicant should have the benefit of the doubt. 2 Gourick, 53.

13. Lacking the requisite "merit," — both artistic and literary.

Examiner refused to register the label, under the provisions of the Act of 1874, in view of the decisions in Higgins *v.* Keuffel (55 O. G., 1139, ✱); Eldridge & Co., x. p., (55 O. G., 1278); and Palmer, x. p., (58 O. G., 383): *Held*, that the label had not that degree [either] of art or of literary merit which would entitle it to registry under the act above referred to, and that, therefore, it did not fall within that narrow margin allowed for registration of labels under the Copyright Law, which is permitted by the decision of the Supreme Court in the case of Higgins *v.* Keuffel, *supra*.

Racine Basket M'f'g Co., x. p., *Frothingham, Act. Com.*, 7 Oct., 1892, C. D. Ms.

NOTE. — The label above referred to was to be used for baskets, and had, for its principal features —

The words "Racine Basket" placed prominently on top, and, in the central part, applicant's registered trade-mark. Following this, and occupying the lower half of the label, was certain advertising matter in different sized type, which did not convey any information regarding the use of the baskets, and did not illustrate the baskets in any manner. These features were on a clouded background within an ornamental border.

14. Why not registrable, — although artistic.

Although it may be true that the thing which applicant presents for registry, as a label, is artistic, yet, if it is clear that it is merely fanciful and arbitrary, and is not descriptive of the contents of the package to which it is to be applied [it falls within the provisions for trade-marks, and hence, under the Label Act of 1874], it follows that it does not come within the narrow margin allowed for the registry of labels.

Baltz Brewing Co., x. p., *Simonds, Com.*, Oct. 26, 1892, C. D. Ms.

15. Subject-matter.

Where the matter presented for registration as a label was a dial for use upon a watchman's clock, of which it was a necessary and material part and in which it performed a given function: *Held*, that it was not a label proper, and registration must be refused.

Newman, x. p., *Fisher, Act. Com.*, 13 Feb., 1891, C. D. Ms.

APPENDIX A.

COPYRIGHTS.

1. The statutes providing for copyright registration (in common with those for label registration and those for grant of patents for inventions, whether artistic or industrial) are derived from the "Authors' and Inventors' Clause" (Cl. 8, Sec. 8, Art. 1) of the Constitution of the United States.

All records, certificates, and other matters relating to the registration of copyrights are under the control of the Librarian of Congress, subject to the supervision of the Joint Committee of Congress on the Library.

Sec. 4949, R. S.

Compare (1) TRADE-MARKS, and (2) LABELS.

2. A United States copyright is the grant to the author or proprietor (if a citizen of the United States) of any book, map, chart, dramatic or musical composition, or of any engraving, cut, or print, if a work of the fine arts, — or of any photograph or negative thereof, or of any painting, drawing, chromo, statue, statuary, or of a model or design intended to be perfected as a work of the fine arts, — (his heirs or assigns), for a term of years (extensible upon suitable request), of the sole liberty of printing, reprinting, publishing, copying, finishing, and vending the same, and, in case of a dramatic composition, of publicly performing or representing, or

causing to be performed or represented by others, with all rights of translation or dramatization of works.

C. A. Yale Cigar M'f'g Co. *v.* C. A. Yale, *Dyrenforth*, *Act. Com.*, 19 July, 1884, 30 O. G., 1183.

NOTE. — Since the above decision was rendered, U. S. Copyright privileges have been extended to citizens of countries granting like privileges to U. S. citizens. See (22) *infra*.

Compare decision of *Bishop*, *Com.*, (3) DESIGNS.

3. Where a report of judicial opinions is the result of intellectual labor, it may be copyrighted.

Although there can be no copyright in the opinions of judges or in the work done by them in their official capacity as judges, yet one who prepares and publishes a report thereof may obtain a copyright for the publication, and will be protected in matter which is the result of his intellectual labor.

Callaghan *v.* Myers, *Blatchford*, *J.*, 17 Dec., 1888, 46 O. G., 565.

4. Photographs may be protected by copyright.

No doubt is entertained that the constitutional provision is broad enough to cover an act authorizing copyright of photographs so far as they are representative of original intellectual conceptions of the author.

Burrow-Giles Lith. Co. *v.* Sarony, U. S. S. C. By *Miller*, *J.*, 17 Mar., 1884, 27 O. G., 413, ✱.

See (4) DESIGNS.

5. The Filing Title.

A copyright whose title recorded with the Librarian of Congress is "Under the Gas-Light: A Romantic Panorama of the Streets and Houses of New York," is not infringed by a drama entitled "Under the Gas-Light: A Drama of Life and Love in these Times."

The registered title might have been simply "Under the Gas-Light," and would then have been infringed; but when two names or descriptive terms are incorporated in the title, each becomes an integral part of it, and it may as reasonably be contended that one part of the title can be dropped out as that the other can be.

Daly *v.* Brady *et al.*, *Wallace, J.*, 19 June, 1889, 39 F. R., 265.

Compare Munro *v.* Beadle, (26) TRADE-MARKS; and Munro *v.* Smith *et al.*, (14) *infra*.

6. Statutory Notice, — Phraseology.

It is sufficient if the notice of copyright inscribed on the photograph read "1889, Copyrighted by B. J. Falk, New York," instead of "Copyrighted 1889, by B. J. Falk," as required by the literal directions of the statute.

Falk *v.* Schumacher, U. S. C. C., S. D. N. Y. By *Coxe, J.*, 12 Nov., 1891, 48 F. R., 222.

7. In an action for infringement of a copyright for a photograph, in order to sustain the defence that the copy which defendant reproduced was without the statutory notice of copyright, it is not sufficient that it was without the statutory notice when it came into defendant's possession, but it must be shown that it lacked such notice when it left plaintiff's possession.

Falk *v.* Gast. Lith. & Engr. Co., U. S. C. C., S. D. N. Y., *Coxe, J.*, 30 Nov., 1891, 48 F. R., 262.

8. Defective Notice.

The owner of a copyright had issued several editions, in some of which the notice read "Entered according to Act of Congress" (omitting the year and by whom entered), and other editions in which the notice read "Copyright 1880" (omitting by whom): *Held*, that the

requirements of the statute were *not* complied with, and that no action could be sustained.

Thompson *v.* Hubbard, U. S. S. C. By *Blatchford, J.*, 13 May, 1889, 131 U. S., 123.

9. Firm Name.

A person doing business under a conventional or fictitious firm name may obtain a valid copyright under that name.

Scribner *v.* Allen, U. S. C. C., S. D. N. Y., *Shipman, J.*, 16 Mar., 1892, 49 F. R., 854.

10. How Transferred.

An undivided interest in a copyright may be assigned by instrument in writing, and an inchoate right to a copyright may be transferred by parole, prior to the taking of the copyright.

Black *et al. v.* Allen Co., U. S. C. C., S. D. N. Y., *Shipman, J.*, 42 F. R., 618.

11. A copyrighted book published, by the consent and under the license of the author, as a part of a foreign encyclopædia whose other portions are not protected by the copyright laws of the United States, does not thereby become public property, and cannot, without the consent of the author, be used in a reprint of the encyclopædia.

Ib.

12. If proven that the alien publishers of the foreign encyclopædia procured copyrighted articles from citizens of the United States for the express purpose of preventing the work from being reprinted in the United States,

that would in no wise affect their right to protect their copyright in the courts of the United States.

Ib.

13. An imported copy in a foreign language infringes the United States Copyright.

The fact that a book is published in a language other than English does not relieve it from infringement of the United States copyright. Hence, where the owner of the Norwegian copyright of a book which was also copyrighted in this country sent a copy thereof in the Norwegian language to a party in this country: *Held*, that it could not be delivered without consent of the owners of the United States copyright.

U. S. Treasury Department — Synopsis 10,269.

14. Copyright of complainant's pamphlets and magazines containing pictures of "Old Sleuth:" *Held*, not infringed by defendants' books having a picture of "Old Sleuth the Detective" on the cover, where the variations were sufficient to make the pictures very different, although it was probably true that the defendants got from the plaintiff the idea of having such a picture.

Munro *v.* Smith *et al.*, *Shipman, J.*, 5 May, 1890, U. S. C. C., S. D. N. Y., 42 F. R., 266.

Compare Munro *v.* Beadle, (26) TRADE-MARKS; Daly *v.* Brady *et al.*, (5) *supra.*

15. Penalty for False Notice.

Where a number of chromos (for which no copyright had been secured) all bearing the word "copyrighted," in violation of sec. 4963, R. S., were struck off each day on several succeeding days, such chromos being in facsimile, except that each day's issue had printed thereon, by way of advertisement, the name of a firm different

from that appearing on every other day's issue: *Held*, that the penalty [$100] was recoverable for *each issue*.

Taft *v.* Stevens Lith. and Engr. Co., *Thayer, J.*, 39 F. R., 781.

NOTE. — It appeared in evidence that there had been 25 issues of 2000 copies each on 25 consecutive days, = $2,500 penalty.

16. Details of a copyrighted work need not be separately copyrighted.

Separate copyright of each map contained in a statistical atlas is unnecessary, for they are all protected by a copyright of the entire work.

Black *et al. v.* Allen Co., U. S. C. C., S. D. N. Y., *Shipman, J.*, 42 F. R., 618, C. D. Ms.

17. Copyrightable Dramatic Composition defined.

It is essential to a dramatic composition, within the meaning of the Copyright Act, that it should *tell some story*. The plot may be simple. It may be but the narrative or representation of a single transaction; but it must repeat or mimic some action, speech, emotion, passion, or character, real or imaginary; and when it does, it is the IDEAS thus expressed which become subject of copyright.

Fuller *v.* Bemis, U. S. C. C., S. D. N. Y., 18 June, 1892, C. D. Ms.

18. Merely mechanical movements by which effects are produced on the stage are not subjects of copyright where they convey no ideas whose arrangement makes up a dramatic composition, and where they were devised to convey to the spectator no other idea than that a comely woman is illustrating the poetry of motion in a singularly graceful fashion: *Held*, that the idea might be pleasing, but that it could hardly be called dramatic.

Ib.

19. Systems not subjects of Copyright.

The copyright of a book describing a new system of stenography does not protect the system when considered simply as a system apart from the language by which it is explained, so as to make the illustration by another person of the same system in a different book, employing totally different language, an infringement.

Griggs *v.* Perrin, *Coxe, J.*, 3 Feb., 1892, 49 F. R., 15.
Compare Dick. x. p. (24) PATENTABILITY.

20. The time for commencement of publication is not limited by any law or regulation, but the courts have held that it should take place within a reasonable time after registration.

Cir. issued by *Ainsworth R. Spofford, Librarian of Congress*, Aug., 1892.

21. Importation of Copyrighted Articles. — Regulations by the Secretary of the Treasury.

In pursuance of the provisions of the Act entitled "An Act to amend title 60, chapter 3, of the Revised Statutes of the United States relating to Copyrights," approved 3 March, 1891, and more especially of section 4 of said Act, the following regulations are hereby prescribed : —

(1) Copyrighted books and articles, the importation of which is prohibited by section 4956 of the Revised Statutes, as amended by section 3 of said Act, shall not be admitted to entry. Such books and articles, if imported, *with* the previous consent of the proprietor of the copyright, shall be seized by the Collector of Customs, who shall take the proper steps for the forfeiture of the goods to the United States under section 3082 Revised Statutes.

(2) Copyrighted books and articles imported contrary to said prohibition and *without* the previous consent of the proprietor of the copyright (being primarily subject to forfeiture

to the proprietor of the copyright), shall be detained by the collector, who shall forthwith notify such proprietor, in order to ascertain whether said collector shall institute proceedings for the enforcement of said proprietor's right to the forfeiture. If the proprietor institutes such proceedings and obtains the decree of forfeiture, the goods shall be delivered to him upon payment of the expenses incurred in the detention and storage and the duties accrued thereon. If such proprietor shall fail to institute such proceedings within sixty days from the date of notice, or shall declare in writing that he abandons his right to the forfeiture, then the director shall proceed as in the case of articles imported *with* the previous consent of the proprietor.

(3) Copyrighted articles, the importation of which is not prohibited (but which, by virtue of section 4965 of the Revised Statutes, as amended by section 8 of said Act, are forfeited to the proprietor of the copyright when imported without his previous consent, and which are moreover, subject to the forfeiture of $1 or $10 per copy, as the case may be, one half thereof to the said proprietor and the other half to the use of the United States), shall be taken possession of by the collector, who shall take the necessary steps for securing to the United States half of the sum so forfeited, and shall keep the goods in his possession until a decree of forfeiture is obtained and the half of the sum so forfeited, as well as the duties and charges accrued, are paid; whereupon he shall deliver the goods [and forfeit moieties] to the proprietor of the copyright.

In case of failure to obtain a decree, the goods shall be admitted to entry.

Instructions of Secretary of the Treasury to U. S. Collectors *et al.*, 3 July, 1891.

22. International Copyright Regulations.

International copyright arrangements between the United States and foreign countries now include Great Britain and her possessions, France, Belgium, Germany, and Switzerland. For an American citizen to secure copyright in Great Britain three conditions are necessary: (1) The title should be entered at Stationers Hall, London; fee, 5 shillings sterling, and 5 shillings addi-

tional if a certified copy of entry is required. (2) The work must be published in Great Britain (or in her dominions) simultaneously with its publication in the United States. (3) Five copies of the publication are required, — one for the British Museum and four (on demand of the guild of Stationers) for four other libraries. French copyright may be secured by a foreigner by depositing two copies of the publication at the Ministry of the Interior in Paris (no fee nor entry of title required). To secure copyright in Belgium a foreigner must register his work at the Department of Agriculture, Industry, and Public Works at Brussels (no fee). In Switzerland: Fee, 2 franks (registration not obligatory).

Circular issued Aug., 1892, by *A. R. .. ord, Librarian of Congress.*

APPENDIX B.

UPWARD of sixty countries now have statutory provisions for the grant of patents for inventions, including: —

AFRICA.

	Sole term. Years.	Maximum term. Years.
Cape Colony		14
Congo Free State		20
Liberia		20
Mauritius	14	
Natal	14	
Orange Free State		14
Transvaal		14
Tunis		15

AMERICA.

United States (after examination as to novelty, etc. — Patents for medicinal preparations customarily refused)	17	
Argentine Republic (medicines excluded)		15
Bolivia		10
Brazil		15
British Guiana		14
" Honduras		14
Canada (after examination as to novelty, etc.)		15
Chili		20
Guatemala		15
Mexico	20	
Newfoundland		14
Peru (medicines excluded)		10
United States of Columbia		20
Uruguay (medicines excluded)		9
Venezuela (medicines excluded)		15

ASIA.

Ceylon		14
Hong Kong		14
India (including Aden, Andaman Islands, Burmah, Laccadive Islands, Nicobar Islands)		14
Japan (to natives only)		15
North Borneo		14
Straits Settlements	14	

	Sole term. Years.	Maximum term. Years.
ATLANTIC.		
St. Helena	14	
AUSTRALASIA.		
New South Wales	14	
New Zealand		14
Queensland		14
South Australia		14
Tasmania		14
Victoria		14
West Australia		14
EUROPE.		
Austria-Hungary (edibles, beverages, and medicines excluded)		15
Belgium		20
British Islands		14
Finland		12
France (including Algeria, Cochin China, Congo, Gaboon, Guadeloupe, French Guiana, La Reunion, Madagascar, Martinique, Mazotte, Micquelon, Nassi Bé, New Caledonia, St. Pierre, Senegal, Tahiti, and Tonquin. — Medicines excluded)		15
Germany and dependencies (after examination as to novelty, etc. — Edibles, beverages, and medicines excluded)		15
Italy and dependencies (medicines excluded)		15
Luxembourg		15
Malta		14
Norway		15
Portugal (including Azores, Cape Verde, Portuguese Guiana, and Madeira. — Edibles, beverages, and medicines excluded)		15
Russia and dependencies (medicines and munitions of war excluded)		10
Spain (including the Balearic, Canary, Cuba, Philippine and Porto Rico Islands. — Medicines excluded)		20
Sweden (after examination as to novelty, etc.)		15
Switzerland		15
Turkey (medicines excluded)		15
OCEANICA.		
Fiji Islands	14	
Sandwich Islands	10	
WEST INDIES.		
Bahamas		14
Barbadoes		14
Bermudas		14
Jamaica (with Turks Island)	14	
Leeward Islands	14	
Trinidad (with Tobago)	14	

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