Syllabus.

sioner was right in rejecting the application of William H. Burlew for a patent in this case.

George R. West, for Burlew.

P. H. Watson, for O'Neil.

JOHN J. GREENOUGH, APPELLANT,

vs.

TERENCE CLARK, APPELLEE. INTERFERENCE.

LIMITATION OF RIGHT OF APPEAL.—No appeal from the decision of the Commissioner can be considered unless the reasons of appeal were filed within the specified time.

LIMIT OF APPEAL ABSOLUTE—MOTION TO REHEAR DOES NOT EXTEND.—After the expiration of the time set by the Commissioner, under authority of section 11, act of 1839, for filing the reasons of appeal, the right of appeal is gone, nor will the pendency of a motion to rehear the case of itself enlarge the time for filing the reasons of appeal without a special order by the Commissioner to that effect.

PETITION FOR APPEAL—FOUNDED ON REASONS OF APPEAL.—The filing of the reasons of appeal is essentially the appeal itself. The judge cannot take cognizance of a case until the aggrieved party presents to him his petition for a revision on appeal, which petition, according to the law, must be predicated upon the reasons of appeal filed with the Commissioner in due form.

NOTICE OF APPEAL—SUSPENDS PROCEEDINGS.—On receiving notice from the party of his intention to appeal, it becomes the duty of the Commissioner, and his exclusively, to fix a reasonable time for filing the reasons; within which time all further action upon the application within the Office is to be suspended, and within which time the reasons of appeal must be filed, unless for good cause shown the Commissioner directs the time to be enlarged.

TIME OF APPEAL MAY BE ENLARGED.—The power to enlarge the time for filing the reasons of appeal, and to rehear the case, remains with the Commissioner not only until the patent issues, but until it is actually delivered; after which his power over the case is exhausted.

RIGHT OF APPEAL LOST.—The time for filing the reasons of appeal having expired,

pending a motion before the Commissioner to rehear the case, the motion having been denied and a patent issued to the successful party, the right of appeal is lost.

(Before MORSELL, J., District of Columbia, March, 1853.)

MORSELL, J.

On the day and place appointed for the trial of this case, the parties appeared by their respective counsel, and Mr. Baldwin, an examiner at the Patent Office, with the models and drawings, the evidence, and all the papers relating to said case, with the decision of the Commissioner, the reasons of appeal, and the Commissioner's report.

Previously to entering upon the investigation of the merits of the matter in controversy, the counsel for the appellee objected to the jurisdiction of the judge, and moved to dismiss the appeal, upon the ground that the appeal was not taken and the reasons of appeal filed within the time limited by the Commissioner. With respect to which the facts were: On the 19th of January, 1850, notice was given to the appellant by the Commissioner that an interference was supposed to exist between his application and a caveat theretofore filed in the secret archives at the instance of the appellee, Terence Clark. On the 18th of April, 1850, the caveator filed his application for a patent. On the 27th of April, 1850, an interference was declared between the two applications, and notice of a day of hearing was given to the parties. The hearing was postponed from time to time until the first Monday in November, 1850. On the 14th of November, 1850, the Commissioner decided the question between the parties. He says: "Upon examination of the testimony adduced in this case, it is hereby decided that Terence Clark is the first inventor, and as such entitled to a patent." Notice of this decision was given to the parties, together with notice that if no appeal was taken on or before the third Monday in December then next a patent would issue to Clark. On the 11th of December, 1850, and within the time fixed for issuing of the patent to Clark, Greenough made application to the Commissioner in the nature of a petition for a rehearing. This application was pending and undecided until the 26th day of December, 1850. No new limit appears to have been expressly assigned, but the request was refused by letter of the

26th, same day as above stated. On the 15th of September, 1851, before the patent had issued, Greenough filed with the Commissioner his appeal to the chief judge of the Circuit Court of the District of Columbia. On the 8th of June, 1852, letters-patent were issued to Clark, at which time no reasons of appeal were filed. In addition to the oral remarks that were made at the time when the motion was made in this case by the counsel for the respective parties, they have since furnished me with their written arguments, embracing all that was before urged, giving fuller and more comprehensive views on the subject. The order is—first, by the counsel in support of the jurisdiction; and secondly, by the answer of the opposing counsel. I will briefly state the substance of each: It is said that it is a proceeding which concerns nobody but Greenough, and cannot affect the validity of any existing patent. (Judge Cranch's decision in the case of Pomeroy *v.* Connison, *ante*, p. 40.)

The decision of the same judge is referred to in the case of Edwin Janney (*ante*, p. 86) on the point of limitation of time to appeal and the practice of the Office.

The reply is an argument upon the construction of those parts of the acts of July 4th, 1836 and 1839, which give the right of appeal from the decision of the Commissioner, and contends that there are three classes of cases intended to be provided for—the first, under the seventh section of the act of 1836, where the applicant persists in his claim for a patent, and it is again rejected; second, where the application interferes with any other patent for which an application may be pending, or with any unexpired patent which shall have been granted; this is under the eighth section of the act of July 4th, 1836; third, in cases where a caveat has been filed and application is made within a year by some other person, which appears to interfere with the caveator's invention.

Although, it is contended, there be no express limit of time within which the appeal is to be made under the act of 1836, it is implied that it must be made within a reasonable time. The act of the 3d of March, 1839, section 11, remedies this defect by expressly providing a limit. Further, the limitation of time which the Commissioner is authorized to make is not confined solely to the filing of the reasons of appeal, because, first, that would not accomplish

the object to be obtained by the law; second, the appeal might go on at any time, without any reason being filed at all, for aught that appears in the acts of Congress.

The eleventh section of the act of 1839 first introduces the terms "reasons of appeal," and this in the case of interfering applications. The correct grammatical construction of this section requires the interpretation that the limit is to the appeal as well as to the time the reasons are to be filed. The copulative conjunction "and" connects both clauses.

If Clark is no party, then there is no appeal. The acts of Congress in no case of interference contemplate an appeal without expressly providing for it.

The continuance of the motion for a rehearing is no excuse for not filing reasons in time. It is not analogous to a motion for a new trial in a court of common law.

The Commissioner had no authority to grant a rehearing after having once decided the case. Clark had no notice of it.

The appeal, with the reasons, not filed until after another expiration of forty days.

The decision in the case of Pomeroy *v.* Connison is argued to be inapplicable, because the party appealing, against whom the Commissioner had decided, was a patentee, in which case the judge had no jurisdiction, and of whom the judge says a remedy may be had in another forum. As to Janney's case, the judge refused to entertain jurisdiction. It was not a case of interference.

The question is, whether the right to appeal was not lost by the failure of John J. Greenough to notify the Commissioner of his appeal in this case, and to file his reasons of appeal on or before the 26th day of December, 1850, the time limited by the Commissioner.

All the conditions mentioned in the act of the 3d of March, section 11, in the cases of interference, must be complied with as prerequisites before the judge can take jurisdiction by way of appeal from the decision of the Commissioner refusing to grant a patent to the applicant. The jurisdiction which he can take is a very special, limited jurisdiction, and all the previous circumstances must exist under which it is given before it can attach;

and no other power or authority can be exercised except that which is either expressly given or which can be fairly inferred.

The words of the statute are "that in all cases where an appeal is now allowed by law from the decision of the Commissioner of Patents to the board of examiners provided for in the seventh section of the act to which this is additional, the party, instead thereof, shall have a right to appeal to the chief justice of the District Court of the United States for the District of Columbia, by giving notice thereof to the Commissioner, and filing in the office of patents, within such time as the Commissioner shall appoint, his reasons of appeal, specifically set forth in writing, and also paying into the Patent Office, to the credit of the patent fund, the sum of twenty-five dollars; and it shall be the duty of said chief justice, on petition, to hear and determine all such appeals, and to revise such decisions in a summary way, on the evidence produced before the Commissioner, at such early and convenient time as he may appoint, first notifying the Commissioner of the time and place of hearing, whose duty it shall be to give notice thereof to all parties who appear to be interested therein, in such manner as said judge shall prescribe. The Commissioner shall also lay before the said judge all the original papers and evidence in the case, together with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal, to which the revision shall be confined."

From a careful examination of the provisions of this statute, I am satisfied that the filing the reasons of appeal must be considered as essentially the appeal itself; that the judge can judicially know nothing of the case until the party aggrieved presents to him his petition for a revision on appeal. This the law does not authorize the party to do until after the decision of the case by the Commissioner against him, after he has notified the Commissioner of his appeal and after his reasons of appeal are filed.

On receiving notice from the party of his intention to appeal, it becomes the duty of the Commissioner to fix a reasonable time for filing the reasons, and to him that duty is exclusively intrusted; within this time all further action of the Commissioner as to granting a patent is to be suspended, and within this time also the reasons must be filed, unless, for good cause shown to him, he directs the time to be enlarged.

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I think the power to enlarge the time and rehear the case remains with the Commissioner until not only the patent issues, but until it is actually delivered; after which his power over the case is exhausted. I think, therefore, he had a right to entertain the motion in this case, and might have granted an enlargement of the time and a rehearing; but having refused so to do, and no reasons having been filed within the time limited, and a patent having issued, the right of appeal was lost.

Believing, therefore, that I have no jurisdiction in this case, the appeal must be, and is hereby, dismissed. All the papers and models are herewith returned.

IN RE HUGH H. FULTZ. APPEAL FROM REFUSAL TO GRANT PATENT.

UTILITY OF INVENTION—FILING AFFIDAVITS THERETO PENDING APPEAL.—Pending the decision of an appeal from the Commissioner, an applicant will be permitted, on motion, to procure and file affidavits of competent persons touching the practical utility and advantages of his invention.

EVIDENCE—INTRODUCING SAME ON APPEAL.—Section 11 of the act of 1839, read in connection with sections 7 and 8 of the law of 1836, upon which it is engrafted, gives to the applicant, on appeal to the judge, the right to support his claim by, and to be heard upon, the evidence or facts deemed by him essential to a just decision, although not produced before the Commissioner at the hearing before him.

SM—SM—EVIDENCE BEFORE THE COMMISSIONER—MERITS OF THE CASE.—The restrictive part of the section confining the judge in his decision to "the evidence adduced before the Commissioner" applies to the merits of the case.

INTERLOCUTORY ORDER BY JUDGE—ADMITTING NEW EVIDENCE.—If, therefore, a party has been denied the privilege of submitting proper proofs of his invention, it is the duty of the judge, by reasonable regulations similar to those directed by section 12, to pursue such a course as to afford an opportunity to the party to produce and lay before him on the trial his proof to support his claim.

COMMISSIONER'S REFUSAL TO ADMIT EVIDENCE, APPEALABLE—REHEARING BEFORE HIM.—If the Commissioner refuse to admit competent and material evidence offered by the applicant, the applicant may assign such refusal as a reason of appeal, and the Commissioner, in stating the grounds of his