DIGEST OF DECISIONS

OF

LAW AND PRACTICE

IN THE

PATENT OFFICE

AND THE

UNITED STATES AND STATE COURTS

IN

PATENTS, TRADE-MARKS, COPYRIGHTS, AND LABELS

1886–1898

BY

AMOS W. HART

OF THE BAR OF THE DISTRICT OF COLUMBIA

CHICAGO
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1898

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PREFACE.

Although previous digests have been restricted to the decisions of the Commissioner of Patents alone, or to those of the courts alone, the expediency and even desirability of covering both in one volume, and under the same titles, as in the present case, is believed to need neither argument nor apology.

The period covered is a most interesting and important one in patent, trade-mark, and copyright practice.

The sources chiefly drawn upon have been the Official Gazette, the MS. or unpublished decisions of the Commissioner of Patents, and the Federal Reporter; but numerous references have been made to other authorities.

With the multiplicity of decisions cited and subjects considered therein, the simple classifications of former digests have been quite out of the question. If the present classifications shall seem at first somewhat complex and strange here and there, it should be considered as due in large measure to the necessity of the case. It is hoped the median line has been followed, in at least the majority of instances, between the inclusion of too many syllabi under one title, and the division of the same under too many titles.

The critical and historical notes to be found under numerous titles and syllabi are believed to be a desirable innovation. In many cases they may serve to link former with present practice, and in some others to dispense with the necessity of more extended research.

A. W. H.

WASHINGTON, D. C.,
May, 1898.

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DIGEST OF DECISIONS.

ABANDONMENT.

I. Of Application.
II. Of Invention, in General.
III. Of Invention, by Failure to Claim it.

I. Of Application.

1. When an application has become abandoned by statutory limitation and it is shown to the satisfaction of the commissioner that both applicant and his attorney, acting in the utmost good faith, using such care and diligence as are generally used and observed by prudent and careful men in relation to their most important business, and relying upon the ordinary and trustworthy agencies usually employed in such cases, have unsuccessfully endeavored within the time of limitation to comply with a requirement of the office, the case should be reinstated. Ex parte Pratt, 39 O. G. 1549, C. D. 1887.

2. A trustworthy and reliable employee in an attorney's office is such an agency, and if unexpectedly, through his unforeseen neglect and omission to obey the instructions of his principal, there occurs a failure, it may be said to be "unavoidable" within the meaning of the statute, all the other conditions of good faith being present. Id.

3. The office, although not inclined to extend this freedom of construction, will not, except upon greater consideration, restrict it. Id.

4. Applicant having failed to prosecute his case within two years from the date of the last action by the office, and no definite action having been determined upon by him or his attorney within the time, and the two years' limit having expired without any attempt at definite action, *held*, that applicant's showing of unavoidable delay in prosecuting his application must cover the entire period of two years. Ex parte Root, 40 O. G. 811, C. D. 1887.

5. Under section 4894, which provides for the latter class of cases, an applicant who has failed to prosecute his case for two years is permitted to revive it by establishing to the satisfaction of the commissioner of patents that the delay was unavoidable. Ex parte Barnitz, 41 O. G. 575, C. D. 1887.

6. The assignee requested postponement of official action until the application should be called up by him. *Held*, that the application must be considered as abandoned under the statute, the period of such suspension extending beyond two years. Ex parte Norton, 42 O. G. 296, C. D. 1888.

7. Amendments which do not remove objections or relieve the application from its condition as subject to appeal will not save the application from abandonment. Ex parte Edison, 45 O. G. 461, C. D. 1888.

8. Such amendments, if entered, call for no action on the part of the office, and do not change the status of the application. The application would still be in condition for appeal upon the claims which remained in the case. Id.

9. Such amendments should be accompanied by an appeal, and the *appeal* would constitute the proper action such as the condition of the application demanded. Id.

10. When an applicant, who is also patentee of an invention other than that involved in controversy, alludes in his patent to abandoned claims in a former application, the only effect that can be given to such reference is as evidence of continued interest in the subject-matter of the earlier application and of diligence in seeking to perfect and patent the invention; but such an allusion can have no effect whatever in that direction when the former application had been for nearly two years unprosecuted, and all the claims therein which had any relationship to his pending application had been deliberately stricken out and positively abandoned at the time the patent was issued. Beach v. Fowler, 48 O. G. 821, C. D. 1889.

11. A broad distinction is to be recognized between constructive abandonment of an ap-

plication and constructive abandonment of an invention. The former may exist, and frequently does exist, without involving the latter. Ex parte Fowler and Fowler, 49 O. G. 562, C. D. 1889.

12. Where it appeared that on the last day upon which an application could be prosecuted without forfeiture under Revised Statutes, section 4894, amendments apparently of no considerable importance were offered, including one or two formal corrections in the claims which had been required by the examiner, and that such 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 there was not such utter failure to prosecute within the two years as would warrant a judgment forfeiting rights. Ex parte Todd, 49 O. G. 732, C. D. 1889.

13. Where an application is filed or deposited unaccompanied by the first government fee, and applicant seeks to pay said fee after the lapse of two years from such filing or depositing, *held*, that said fee must be paid within the limit of two years from the date of such filing and depositing, or in default thereof the application is to be regarded as abandoned, under section 4894 of the Revised Statutes, in the absence of facts showing that the delay was unavoidable. Ex parte Fenno, 52 O. G. 1665, C. D. 1890.

14. When an examiner makes a definite requirement of an applicant, with a suggestion as to other things that are desired, it is the requirement, and not the suggestion, that applicant must act on within two years in order to avoid abandonment. Ex parte Hume, 56 O. G. 123, C. D. 1891.

15. Applicant filed his application September 16, 1879, and after various amendments filed a substitute specification January 25, 1885. On February 13, 1885, the examiner required division, which requirement was not finally complied with until July 20, 1891, the only action between these dates consisting of objections to the requirements by the applicant and their reiteration by the office, the last letter from the office repeating requirements being of July 25, 1889. *Held*, that the examiner's letters must be taken as satisfying section 4894 of the Revised Statutes and as saving the case from abandonment. Ex parte Hunter, 56 O. G. 999, C. D. 1891.

16. Section 4894 of the Revised Statutes, requiring that an application shall be completed and prepared for examination within two years after filing, 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. Ex parte Price, 56 O. G. 1000, C. D. 1891.

17. To negative abandonment it is necessary for applicant to show that the delay for the whole period from the last official action to the filing of the petition was unavoidable. The mere failure of applicant's attorneys to notify him of his rights after the last official action and the alleged neglect on their part to prosecute the case are not sufficient excuses. Ex parte Murray, 56 O. G. 1060, C. D. 1891.

18. A petition for the revival of an abandoned application should aver facts showing that the delay for the whole period from the last official action to the filing of the petition was unavoidable. Ex parte Edison, 56 O. G. 1061, C. D. 1891.

19. A misunderstanding of the attorneys of the different parties in interest of an invention as to their duties is not sufficient to warrant a holding that a delay of over two years in the prosecution of a case was unavoidable. Ex parte Macphail, 56 O. G. 1062, C. D. 1891.

20. W. filed an application in 1884, which became abandoned November 17, 1887, by reason of two years' lack of prosecution. In March, 1887, he had reduced the improvement to practice in public, and in January, 1889, his present application was filed. *Held*, that the reduction to practice before the abandonment of the first application and the filing of the second application within two years thereafter saved his rights from dedication to the public. Witherow v. Robert, 59 O. G. 787, C. D. 1892.

21. Where an applicant has delayed four years to meet an office requirement and seeks a revival of his abandoned application, ill health and financial reverses covering only the first year of his neglect do not form a sufficient excuse. Ex parte Clarke, 61 O. G. 286, C. D. 1892.

22. Where an applicant allowed two years to lapse without response to an office action, and his application thereby became abandoned, and he subsequently moved a revival of it on the ground of error on the part of the examiner in not originally holding his claims patentable, *held*, that a possible error by the examiner does not cure the applicant's own laches, and, it not appearing that the delay was unavoidable, the motion must be denied. Ex parte Hien, 62 O. G. 316, C. D. 1893.

23. The two years within which the law re-

quires an inventor to act if he would save his invention from abandonment relate to a *completed* invention and have no reference to the conception and maturing of the invention. Brungger v. Smith, 62 O. G. 1513, C. D. 1893.

24. There is a material difference between the abandonment of an invention and the abandonment of an application for letters patent thereon by failure to comply with section 4894 of the Revised Statutes. The first gives the invention to the public, and, once done, the act is irretrievable; but, besides the power conferred upon the commissioner of patents to relieve an applicant from an abandonment of his application under the statute, a new application may be filed for the invention so long as the invention itself has not been abandoned. *Western Electric Co. v. Sperry Electric Co., 65 O. G. 597, C. D. 1893.

25. Where after final rejection the applicant replies that the last action of the office is not understood, *held*, that such response is not such as the condition of the case requires. The office will not scrutinize the record to find a way of saving an application from abandonment that has already been pending for more than eleven years, especially where the art during that period has rapidly developed and where the grant of a patent upon claims now in the case might be a menace to meritorious and more diligent inventors. Ex parte Hunter, 66 O. G. 1449, C. D. 1894.

26. Where it appears that at no time while the case has been before the office has it been placed by the examiner in condition for appeal to the examiners-in-chief upon its merits, *held*, that although the action of the appellant had been irregular the case has not become abandoned under second paragraph of rule 171. Ex parte Blessing, 71 O. G. 1027, C. D. 1895.

27. The fact that an inventor is dead and that his executor has not asserted his rights does not deprive an application of standing before the office. It cannot be considered abandoned until the expiration of the time allowed by law for amendments. Decker v. Loosley, 77 O. G. 2140, C. D. 1896.

28. Re-issue cases are abandoned after two years of inactivity, like other cases, by operation of section 4894. (Ex parte Galusha, C. D. 1873, 55, overruled.) Ex parte Messinger, 78 O. G. 1003, C. D. 1897.

29. Where a letter of abandonment not containing the consent of the assignee is accepted upon the representation that it was impossible to communicate with such assignee and obtain his consent, but where the assignee afterward appears and objects to the abandonment, *held*, that the abandonment must be considered void and of no effect. Ex parte Weidemann, 81 O. G. 2245, C. D. 1897.

30. The tacitly favorable action of one examiner upon a question of abandonment should at least be persuasive upon his successor. Ex parte Burson, 81 O. G. 2246, C. D. 1897.

II. Of Invention, in General.

31. The law governing the questions of dedication or abandonment of a patented invention is that in force at the date of the application for the original patent. *Beedle v. Bennett, 39 O. G. 1326, C. D. 1887.

32. A delay of more than two years in making application for a patent after an experimental use by the inventor of the particular invention will, under certain circumstances, rebut presumptions of dedication or abandonment which might arise under the law in force at the time of the application. *Id.

33. The process was invented in 1877. An application for patent was filed some four years later. *Held*, the invention was not abandoned by the delay. *United States Electric Lighting Co. v. Consolidated Electric Light Co., 33 Fed. Rep. 869 (1888).

34. The fact of the abandonment of the manufacture prior to the date of the complainant's invention of asphalt blocks composed of a composition containing the same ingredients as the alleged infringing blocks, presumably because the blocks were not a commercial success, proves nothing, it not appearing that the composition of matter produced by the practice of the complainant's process had ever been tested to prove its possession of new or useful qualities which similar compositions had not before possessed. *Van Camp v. Maryland Pavement Co., 43 O. G. 884, C. D. 1888.

35. An invention may exist in a state of conception or experiment, or in a state of completion and reduction to practice. In its former state it may be abandoned; but whether abandoned or not the subject is not taken out of the field of invention so as to prevent other inventors pursuing the same invention. When, however, the completed invention, reduced to practice, subject of knowledge and use, is abandoned by the inventor, whether before or after patent, it is abandoned to the public and is no longer the subject of new or original invention. *Webster v. Sanford, 44 O. G. 567, C. D. 1888.

36. It is not to be conceded that the inventions represented in the abandoned applications of the patent office are the property of the public. Until the invention has been two years in public use or on sale the inventor has lost no part of his inchoate property in his invention, either through failure to complete his application or to prosecute his completed application within the period of two years prescribed by the Revised Statutes, section 4894. Ex parte Fowler & Fowler, 49 O. G. 562, C. D. 1889.

37. Abandonment is never presumed, but must always be strictly proved. Clark v. Broad, 57 O. G. 1426, C. D. 1891.

38. Where the first form of a machine was never put into use by reason of being defective, and there was a delay of ten years, largely due to pecuniary reasons, before a working machine was completed, these facts do not show abandonment. *Shaw Stocking Co. v. Pearson, 58 O. G. 948, C. D. 1892.

39. The establishment of abandonment or of two years' public use requires proof so clear as to put the matter beyond all reasonable doubt. Bury v. Thompson, 58 O. G. 1255, C. D. 1892.

40. Where an inventor had forgotten an invention or laid it aside as worthless—abandoned it—he had the right to take it up again and proceed as if he had then first made the discovery, so long as its abandonment was unknown to the public. *Western Electric Co. v. Sperry Electric Co., 65 O. G. 597, C. D. 1893.

41. Before applying for the patent, Hall had experimented with a carbon anode; but in his application as first filed, he recited that there were certain disadvantages in its use, and it was not claimed by him until after priority of invention of the process had been awarded him in an interference with an application in which the carbon anode had been included. *Held*, that this was not an abandonment of the carbon anode to the public. *Pittsburgh Reduction Co. v. Cowles Electric Smelting & Aluminum Co., 69 O. G. 789, C. D. 1894.

42. Where T. reduced the invention to practice in 1886, successfully tested it, then laid it aside, filed an application therefor in the same year, which application his attorney permitted to become abandoned without his consent, and in 1893, after learning that another party had an application pending for the same subject-matter, filed another application therefor, *held* not to constitute abandonment of the invention. Thomson v. Priest, v. Wetmore, 71 O. G. 1769, C. D. 1895.

43. Where it appeared that the device had never been manufactured for sale and use, but had been abandoned, *held*, that the device was not patentable, and a patent granted after previous rejection of the appplication, and only granted to give applicant the benefit of a doubt, was invalid. *Carter Machine Co. v. P. H. Hanes & Co., 74 O. G. 1277, C. D. 1896.

44. Delay in applying for a patent after an invention is made will not constitute abandonment where the inventor has used reasonable diligence to perfect the invention and avail himself of its benefits, and there is no general standard by which such diligence is to be established; but it must be reasonable under all the circumstances of the particular case. The character of the invention; the health, the means, the liberty of the inventor; his occupation upon kindred or subordinate inventions,—are proper subjects for consideration. Such reasonable diligence does not involve uninterrupted effort nor the concentration of his entire energies upon the single enterprise. *Von Schmidt v. Bowers, 80 O. G. 347, C. D. 1897.

III. Of Invention, by Failure to Claim it.

45. Campbell's acquiescence for nine or ten years in Hartshorn's original claim is regarded as an abandonment by him of any right to such claim, and he cannot resume the same. It is no answer to this view that the invention was not dedicated to the public by Campbell because it was covered in the interim by Hartshorn's claim, since Hartshorn never had a right to the claim. As Campbell had the right to an interference with Hartshorn when the original applications were pending and did not avail himself of that right, but acquiesced in the claim of Hartshorn, he cannot afterward claim that which he voluntarily abandoned. *Hartshorn v. Saginaw Barrel Co., 38 O. G. 540, C. D. 1887.

46. A part of an invention described, but not claimed, in a patent is virtually abandoned and dedicated to public use. *Eames v. Andrews, 39 O. G. 1319, C. D. 1887.

47. The presumption of dedication to the public may be rebutted by a reservation of the right to apply for the unclaimed features in a second application or by filing a subsequent application. Ex parte Roberts, 40 O. G. 573, C. D. 1887.

48. The law conclusively infers from the issuance of a patent that the inventor dedicated to the public the unclaimed features of the invention. Id.

49. Description of a process in an application for a machine patent does not constitute an abandonment or dedication to the public of such process so as to estop the inventor from subsequently obtaining a patent for the process if applied for in two years. *Eastern Paper Bag Co. v. Standard Paper Bag Co., 41 O. G. 231, C. D. 1887.

50. In the absence of evidence of any attempt to secure by the original patent the inventions covered by the first eight claims of the re-issue, these inventions must be regarded as abandoned or waived, so far as the re-issue in question is concerned, subject, however, to the right to have made a new application for a patent to cover them. *Parker & Whipple Co. v. Yale Clock Co., 41 O. G. 811, C. D. 1887.

51. Although the patent may show features which were patentable, and which, if properly patented, would render the defendants liable as infringers, such matters are abandoned to the public by the act of the patentee in accepting a claim which fails to comprehend the same. *Toepfer v. Goetz, 41 O. G. 933, C. D. 1887.

52. The respondent contended that a certain contrivance, for which letters patent No. 269,480 were granted, was shown in a prior patent to the same patentee. *Held*, it was not clear that this contrivance was shown in the prior patent. *Held*, following McMillan v. Rees, 17 O. G. 1222, 1 Fed. Rep. 722, even if this contrivance were shown in the prior patent, that this did not constitute a dedication to the public. *Vulcanite Paving Co. v. American Artificial Stone Pavement Co., 42 O. G. 828, C. D. 1888.

53. Description of a process in an application for a machine patent does not constitute an abandonment or dedication to the public of such process so as to estop the inventor from subsequently obtaining a patent for the process if applied for within two years from the date of the machine patent. *Eastern Paper Bag Co. v. Nixon, 45 O. G. 1571, C. D. 1888.

54. If an applicant should take out his patent for the machine without defining or claiming his process, he probably would unconsciously dedicate the process to the public. Ex parte Young, 46 O. G. 1635, C. D. 1889.

55. A patentee who shows but does not claim a certain invention which is distinct and separate from that claimed in his prior patent, and which could not have been prosecuted in that application and ought not to have been shown in such patent, does not necessarily dedicate such unclaimed invention to the public. Ex parte Johnston, 46 O. G. 1641, C. D. 1889.

56. Where the invention described and not claimed in a prior patent to the same inventors is absolutely independent of the invention actually claimed in the first patent, there can be no presumption of dedication from the failure to make reservation or to file a concurrent application. Ex parte Mullen and Mullen, 50 O. G. 837, C. D. 1890.

57. A prior patent granted to applicants for certain details in the construction of old and well-known grain-drills, the claims of which were based upon a feed-regulating device which was special to the structure shown and described, *held* to be no bar to a subsequent application for an improvement in grain-drill teeth, which subject-matter was disclosed but not claimed in said prior patent, for the reason that the two inventions were independent, and hence there was no dedication from failure to claim such improvement. Id.

58. Where the invention described and not claimed in a prior patent to the same inventor might have been lawfully claimed in the first patent, there is a presumption of dedication from the failure to make reservation or to file a concurrent application. Ex parte Beggs, 50 O. G. 1130, C. D. 1890.

59. Where applicant sought in his present application to cover matter shown and described in a patent previously granted to himself and which might have been lawfully claimed therein, and attempted to justify his present application on the ground that it was a continuation of an abandoned application filed earlier, but pending concurrently with the application upon which the patent issued, and it appeared that in said patent he alluded to the earlier application and stated that it was his intention not to abandon any rights therein asserted, and it further appeared that the subject-matter of the present application could not have been claimed in the said abandoned application, *held*, that the prior patent was a bar to the present application, but otherwise if the matter shown and described but not claimed in the patent had been claimed in the earlier application. Id.

60. *Held*, the delay of a month and a half between the issue of applicant's patent and the filing of a new application by him for matter shown but not claimed in the patent did not amount to abandonment of the invention. Ex

parte Scott, 50 MS. D., May, 1892 (Simonds, Com'r).

61. It is the duty of the office to lean toward the side of liberality when strict construction works a forfeiture. Id.

62. The mere disclosure of a thing in an application raises no presumption that the applicant is the inventor of the thing disclosed but not claimed. Van Depoele v. Daft, 58 O. G. 520, C. D. 1892.

63. Where an applicant for a patent already has a prior patent three and a half years old which fully describes the invention claimed in the subsequent application, but does not claim it or make any reservation thereof, *held* to constitute abandonment. Zipernowsky v. Edison, 58 O. G. 803, C. D. 1892.

64. When 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. Rennyson v. Merritt, 58 O. G. 1415, C. D. 1892.

65. Where the patent in suit described a composition of matter and claimed only a sheet of material or fabric coated with such composition, *held*, that the composition must be regarded as disclaimed and as being public property and that there was no invention in applying it to paper, as claimed. *Underwood v. Gerber, 63 O. G. 1063, C. D. 1893.

66. An applicant is estopped now reviving a claim after having canceled the same claim ten years before in an application that was patented. Ex parte Flomerfeldt, 59 MS. D. 57, March, 1896 (Seymour, Com'r).

67. Failure to claim or suggest an alleged invention is sufficient to place evidence as to its prior use either in the rule of abandoned experiments or within the requirement of proof beyond a reasonable doubt. *A. B. Dick Co. v. Henry, 75 O. G. 1204, C. D. 1896.

68. If at the date of the issue of a patent the patentee has another application pending which describes and claims what he describes, but does not claim in the patent issued, the presumption of dedication to the public does not arise. *Independent Electric Co. v. Jeffrey Mfg. Co., 78 O. G. 797, C. D. 1897.

ABANDONED EXPERIMENTS.

1. It appearing that Dr. Cushman did, with the aid of others, in 1851, construct a device containing magnetic coils substantially identical in principle, construction and working with the Bell telephone, through which he transmitted articulate sounds short distances, but that the transmission was faint, the words difficult to hear, and the attempts to talk through it often failures; that the proof of its operation at a distance greater than the ordinary acoustic telephone would carry depended on the uncorroborated testimony of Dr. C.; that the device was set up in Racine, Wis., in a public place, where any one could use it, but that it attracted no attention, nor did it suggest to any one its practical value; that in 1854 and 1855 attempts were made to improve it without substantial success; that it was exhibited in 1867 to several wealthy and intelligent men with a view to patent and render it available, but the experiments were unsatisfactory; that the device was given to an electrician to experiment with and patent, but he died, and the device cannot now be found; that no contemporaneous newspaper accounts appear of these experiments, and that it was not until after Dr. C. had seen the Bell telephone operate and become familiar with it did he give it out that he was the first inventor,—*held*, that what was done by Dr. C. must be treated as an abandoned experiment. *American Bell Telephone Co. v. American Cushman Telephone Co., 45 O. G. 1101, C. D. 1888.

2. A machine which had operated at least once to accomplish its desired result, and subsequently was worked satisfactorily several times without change, is not an abandoned experiment, although several changes not relating to the main operating parts of the machine were suggested, and the use of the machine was discontinued after it had once accomplished its desired result, because the persons using it had turned their attention to other matters. *Bromley Bros. Carpet Factory v. Stewart, 61 O. G. 1481, C. D. 1892.

3. Where from the date of the first application until the date of the application for the invention in its final form the machine on which both applications were based was preserved and in use, either partly or wholly dismantled or entirely assembled for the purpose of obtaining a patent, and with a view to its mechanical perfection for actual commercial use. *held*, that such machine does not present the case of a dismantled and abandoned experiment recalled to memory by the successful effort of a later inventor. *Coffee v. Guerrant, 63 O. G. 279, C. D. 1894.

4. The witnesses' efforts must be relegated to

that class of unsuccessful and abandoned experiments which, as we have repeatedly held, do not affect the validity of a subsequent patent. (Corn Planter Patent, 6 O. G. 392, 23 Wall. 181, 211; Coffin v. Ogden, 5 O. G. 270, 18 Wall. 120, 124.) *Deering v. Winona Harvester Works, 69 O. G. 1641, C. D. 1894.

5. Where B. in 1883 set up in his boiler-room a fire-extinguisher substantially embodying the invention in issue and successfully used the same, *held*, that the invention was complete at the close of that test and that his subsequent search for still better expansible compounds for his tubes did not convert his successful test into an abandoned experiment. Buell v. Shaffer, 71 O. G. 1453, C. D. 1895.

6. Inoperative devices are frequently set up as anticipations; but they are usually such as have proven to be so far failures that the inventor has not taken out patents for them, and are resuscitated for the purpose of showing that other machines similar to the one patented have been invented before. *Dashiell v. Grosvenor, 75 O. G. 507, C. D. 1896.

7. The fact that only one device was made and operated for only a short time and that it was then laid aside and not used again until other parties were making and advertising the device raises the presumption that such use was merely experimental and that what was done amounted to no more than an abandoned experiment. *Wurts v. Harrington, 79 O. G. 337, C. D. 1897.

8. The fact that in a room ordinarily used to contain complete devices ready for the market there was exhibited a certain device is not conclusive proof that such device was complete and on sale. *Id.

(See Seymour v. Osborn, 20 Wall. 353; Corn Planter Patent, 6 O. G. 392, 23 Wall. 181.)

AFFIDAVITS.

(See DEPOSITIONS; OATH.)

I. IN GENERAL.
II. TO OVERCOME REFERENCES.
III. TO OBTAIN INTERFERENCE.
IV. BEFORE NOTARIES AND CONSULAR OFFICERS.

I. IN GENERAL.

1. Where it appeared that certain affidavits which had been filed in a case had been lost or mislaid, *held*, that copies might be received and placed on record. Ex parte Palmer, 44 MS. D. (2 G. W. D.), Sept., 1890 (Fisher, Acting Com'r).

2. Affidavits alleging public use or sale of an invention should, by machine, model, or drawing, clearly show what the thing alleged to be in public use or on sale was, and the allegations should be as to specific acts, leaving the office to determine the question whether they establish a public use or sale under the statute. Ex parte Shettler, 60 O. G. 158, C. D. 1892.

II. TO OVERCOME REFERENCES.

3. Where applicant requested that he be put into interference with a certain unexpired domestic patent upon which he had not been rejected, and it appeared that he had been rejected upon a prior foreign patent granted to the same person for the same invention covered by the domestic patent, and had filed an affidavit stating that the invention was made before the foreign patent, without reciting the facts upon which he relied to prove that he antedated the foreign patent, *held*, that the affidavit was not such as was required by rule 75 to overcome the foreign reference, and the request must be denied. *Held* further, that rule 94 (2) was not applicable to such a case. Ex parte Boyer, 49 O. G. 1985, C. D. 1889.

4. An applicant cannot be held to have complied with the requirements of 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. The mere statement that he disclosed the invention is of no avail, either to constitute evidence of disclosure or to impart sufficiency to a statement of facts in themselves inadequate. Ex parte Donovan, 52 O. G. 309, C. D. 1890.

5. When claims are rejected upon references and facts are submitted tending to show completed invention by the applicant at an earlier date than the references, the question of novelty is presented. The office says that a patent should not be granted for want of novelty, and this applicant denies and presents the proof upon which he relies. Upon such a question applicant is entitled to the judgment in turn of the examiners-in-chief, the commissioner, and the supreme court of the District of Columbia. No sound principle can justify the practice of deflecting that particular inquiry from the main current of discussion and decision relat-

ing to the merits of the application, which lawfully terminates only with the decree of the supreme court of the District. Id.

6. If the examiner be of opinion that the affidavit is insufficient, he should reject for such reason. No appeal, however, should be taken until final rejection has been had upon all the grounds relied upon by the examiner for refusing patent. Id.

7. If sketches or models of the invention were made, applicant should so state, and produce and describe them; if made and lost and their contents remembered, they should be reproduced and furnished in place of the originals. If neither sketches nor models are relied upon, but it is claimed that verbal disclosures were made, the witness should state as nearly as possible the language used in imparting knowledge of the invention to others. Id.

(See Pullman's Palace Car Co. v. Boston & Albany R. R. Co., 53 O. G. 1255, C. D. 1890. Also Deering v. Winona Harvester Works, 69 O. G. 1641, C. D. 1894.)

8. A patent granted subsequently to applicant's filing date, but on an application filed prior thereto, which patent shows and describes but does not claim the invention, is a proper reference, and the applicant should be required, under rule 75, to overcome by affidavit the presumption of prior invention which the office always recognizes in favor of the earlier application and of the patent granted thereon, even though the same be issued subsequently to the filing date of the second application. Ex parte Eddleblute, 52 O. G. 751, C. D. 1890.

9. When an application has been rejected on reference to a patent showing and describing but not claiming the invention under consideration, the applicant should not be required to file an affidavit under rule 75 when his application was in the office prior to the filing of the application upon which such patent was granted. Ex parte Bonna, 52 O. G. 751, C. D. 1890.

10. Where certain claims stood rejected on a prior English patent, and the applicant, without admitting or denying the pertinency of the reference, filed an affidavit in supposed compliance with rule 75, and the affidavit stated, among other things, that the applicant, prior to a certain date, had made drawings which would enable a skilled mechanic to make an operative machine, and that, prior to the same date, he disclosed the drawings to others, and the examiner held that the affidavit was not sufficient in itself to overcome the reference, and that the drawings should be filed, as should affidavits of the people to whom the drawings were disclosed, properly identifying them, *held*, that the action of the examiner should be sustained so far as it related to the drawings. Ex parte Hurlbut, 52 O. G. 1062, C. D. 1890.

11. *Held* further, that the requirement that the affidavits of the persons to whom the drawings were disclosed should be furnished must be complied. Id.

12. In all such cases the examiner's discretion must be exercised, care being taken on the one hand not to be too exacting toward the applicant, nor, on the other hand, to excuse the applicant from presenting the *facts* upon which he relies to show completed invention in this country before the date of reference. Id.

13. Rule 75 provides that on filing the proper antedating oath the unexpired patent shall cease to be a bar. Reed v. Landman, 55 O. G. 275, C. D. 1891.

14. Where it was necessary to introduce an affidavit in an *ex parte* case under rule 75, the attorney set up great difficulty and hardship in obtaining applicant's signature to the necessary papers, and offered the deposition of the applicant taken in prior interference proceedings and alleged to cover the matter in controversy; *held* admissible as an affidavit under the rule. Ex parte Keller, 61 O. G. 1790, C. D. 1892.

15. A deposition taken in an interference proceeding is an affidavit within the meaning of rule 75, and the examiner should receive it as such. The question of its sufficiency is another matter. Id.

16. An oath made during pendency of application that the invention was made prior to date of a British patent, *held* sufficient to sustain patent on said invention, Deering v. Winona Harvester Works, 69 O. G. 1641, C. D. 1894.

17. An affidavit which seeks to overcome a foreign patent cited as a reference must make a showing of facts, as required by rule 75, that the invention was completed in this country before the date of the foreign patent. Ex parte Grosselin, 76 O. G. 1573, C. D. 1896.

18. The affidavit required by rule 75 does not necessarily mean the same affidavit as that required by rule 76. The latter rule is a general one, and the affidavits therein referred to include not only the special affidavit provided for by rule 75, but all other affidavits "supporting or traversing references or objections." Id.

19. In an affidavit under rule 75, total omission of a statement of facts as to the time and circumstances of the conception of the invention and its development to completion prior to the filing date of the reference is fatal. *Drawbaugh v. Seymour, Com'r of Patents, 77 O. G. 313, C. D. 1896.

20. An affidavit under rule 75 may be aided and supplemented by a preliminary statement made in an interference in which the application is involved. Schmertz v. Appert, 77 O. G. 1784, C. D. 1896.

21. An affidavit under rule 75 should contain not merely the deponent's conclusion that he had invented prior to the time of the reference sought to be overcome, but should state the facts supporting such conclusion. Id.

22. An affiant under rule 75, when his application becomes involved in interference, is entitled to invoke the doctrine of priority of mere conception. Even though he can show evidence of nothing but mental acts prior to the date of the reference sought to be overcome, it is the duty of the office to consider whether his conception was sufficiently clear and distinct and whether under all the circumstances of the case his progress was marked by due diligence. This can only be done upon the full record of the case. Id.

III. To Obtain Interference.

23. The affidavit required by paragraph 2 of rule 94 does not 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, 57 O. G. 1598, C. D. 1891.

24. The affidavit required by paragraph 2 of rule 94 must identify the invention in controversy and state that affiant made it before the patentee's application was filed; but it does not call for a statement of facts showing date of invention. The right to call for such a showing is discretionary with the office. (Citing Ries v. Thomson, 57 O. G. 1598.) Ex parte Davis, 62 O. G. 1516, C. D. 1893.

25. Rule 94 applies to a case in which the rejection is based upon the very patent with which the interference is to be had in case a satisfactory affidavit is filed to overcome it as a reference. Ex parte Boyer, 49 O. G. 1985, C. D. 1889.

IV. Before Notaries and Consular Officers.

26. A notary who is not authorized by the laws of his country to administer oaths or take affidavits lacks the requisite authority to administer the oath required by Revised Statutes, section 4892. §Opinion of Attorney-General, 60 O. G. 1481, C. D. 1892.

27. A preliminary statement affirmed before a United States consul will not be stricken out merely because no venue or indication of the place where such affirmation was made appears save in the seal of the consulate impressed upon the paper. Prym v. Heilbrunner, 81 O. G. 2245, C. D. 1897.

28. The purpose of the venue is to show that the officer administering the affidavit acted within his jurisdiction. It will be presumed that he so acted in the absence of any showing to the contrary. This presumption is strengthened by his use of a consular seal. Id.

29. The usual test of the sufficiency of an affidavit as to the possibility of assigning perjury cannot be applied to a paper executed before a United States consul abroad when the latter cannot be brought within the jurisdiction of the federal court. Id.

AMENDMENT.

I. In General.
II. Delay in Filing.
III. Of Drawing.
IV. Election and Division.
V. After Final Rejection.
VI. New Matter.
VII. Upon Recommendation of Examiners-in-Chief or Commissioner.

I. In General.

(See Examination of Application; Genus and Species.)

1. Amendments which do not remove objections nor relieve the application from its condition as subject to appeal call for no action on the part of the office and do not change the status of the application. Ex parte Edison, 45 O. G. 461, C. D. 1888.

2. Rule 133 applies to the whole original application and does not preclude an applicant from amending so as to cover every part or feature of the invention originally shown which might have been claimed when the application was filed. Ex parte Regan, 45 O. G. 589, C. D. 1888.

3. An amendment presented in good faith which does not respond to *every* requirement of the office may be entered to save an application from becoming abandoned, conditioned upon applicant's complying within a reasonable

time with *all* the requirements or taking his appeal therefrom. Ex parte Sullivan, 45 O. G. 709, C. D. 1888.

4. An amendment which was only in part responsive to the official action, but was apparently made in good faith, *held* sufficient to save application from abandonment. Ex parte Todd, 41 MS. D., Oct., 1889 (Mitchell, Com'r).

5. 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 the applicant from obtaining a full investigation of his rights on appeal. Ex parte Rogers, 49 O. G. 1361, C. D. 1889.

6. The substitution of the descriptive term "absorptive substance," after the original application was filed, for the original language "mechanically applied, porous, granular, spongy or equivalent lead," *held* not to invalidate the patent, since it did not change the invention. *Brush Electric Co. v. Julien Electric Co., 41 Fed. Rep. 679 (1890).

7. If, as matter of language, the amended claim does not present the same idea or invention presented by the previous claim, an amendment has been made in matter of substance, and the applicant is entitled to a second rejection upon the amended claim. Ex parte Griswold, 50 O. G. 838, C. D. 1890.

8. Where the admission of an amendment would necessitate division the examiner should refuse to incorporate it; but where the departure from the claim originally presented is not such as to require division, the amendment should be incorporated and rejected. Ex parte Bailey, 52 O. G. 608, C. D. 1890.

9. Although the present practice permits the joinder in proper cases of apparatus and process, it places limitations upon amendments to applications for inventions of one class which seek to incorporate inventions of the other. Ex parte Carpenter, 47 MS. D. (3 G. W. D.), June, 1891 (Mitchell, Com'r).

10. Amendments, without new oaths, in correction or amplification by attorneys in the specification and claims upon which the patents were granted are allowable. Whether proposed amendments come within the scope of what is proper in that behalf rests largely in the discretion of the commissioner. *Wirt v. Hicks, 55 O. G. 867, C. D. 1891.

11. Where an inventor when filing his application entertains an idea as to the importance of a particular feature of operation of a device, but before the patent issues, without changing the drawing or modifying the structure in the least, repudiates by amendment that idea, *held*, that he had a right to change the specification, even though he did so in view of a patent applied for and issued while his application was on file, so long as he did not change the invention. *Western Electric Co. v. Sperry Electric Co., 65 O. G. 597, C. D. 1893.

12. Where claims are amended, the amendment may not be held as not involving a matter of substance merely because such amendment does not avoid the references. Ex parte Pfeffer, 66 O. G. 845, C. D. 1894.

13. When an application is amended by the assignees of the invention so as to change the word "cement" to "hydraulic cement," in a claim for a conduit for electric conductors, by such amendment, when the application was stated both originally and as amended to be for "an improvement in underground conduits for electric wires," the assignees did what they would have had a right to do in re-issue, and their act does not amount to a perversion of the application to a different invention. *National Conduit Mfg. Co. v. Connecticut Pipe Mfg. Co., 75 O. G. 1361, C. D. 1896.

14. Where an amendment was presented canceling claims and amending others and the examiner admitted the amendment so far as it related to the cancellation of claims, but refused to admit that part relating to the amendment of claims, *held*, that such practice is incorrect and the examiner instructed to reinstate the claims canceled, so as to give applicant a chance to appeal on such claims if he chooses. An amendment should be either entered as an entirety or refused admission as an entirety. Ex parte Stern, 76 O. G. 1417, C. D. 1896.

II. Delay in Filing.

15. Delay, especially if the amendment would operate to the prejudice of intermediate inventors, raises a presumption that the original application correctly set forth the scope of the invention then made, and that the additions or variations disclosed by the amendment are of late discovery. Ex parte Lillie, 53 O. G. 2041, C. D. 1890.

16. 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. Ex parte Perkins, 55 O. G. 189, C. D. 1891.

17. What is unreasonable delay in filing an application after making oath to it must be decided by the circumstances of each particular case. A delay of six months held unreasonable in the case of a party residing in Massachusetts. Ex parte Lovejoy, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

III. Of Drawings.

(See Drawings.)

18. The drawing filed with an application is one of its most important and essential parts. It becomes a permanent record in the office, and no one has authority to change any of its features by erasure or otherwise mutilating the same. Such practice is violative of every principle applicable to public records. Ex parte Wharton, 40 O. G. 917, C. D. 1887.

19. When a figure is added to an original drawing on file in the office, without direction or permission of the office, it must be erased or canceled, even though it has been added in good faith. Ex parte Cordrey, 48 O. G. 397, C. D. 1889.

20. The unauthorized addition of new figures to the drawings is a violation of the rules. Ex parte Burt, 49 O. G. 1986, C. D. 1889.

21. An attorney whose power has been revoked cannot have his name erased from the drawing of the application. Ex parte McNulty, 53 MS. D., Nov., 1893 (Fisher, Ass't Com'r).

22. If in the opinion of the examiner the proposed amendment to the drawing involves new matter, the changes in the drawing should not be allowed until the question has been finally determined. Ex parte Ernest, 76 O. G. 1417, C. D. 1896.

23. The drawings of two applications by the same applicants having become interchanged, *ordered* that the correction be made and a canceled sheet restored. Ex parte McPherson & Laing, 62 MS. D., Sept., 1897 (Greeley, Ass't Com'r).

(Regarding correction of drawing, see Ex parte Snyder, 22 O. G. 1985, C. D. 1882.)

IV. Election and Division.

(See Division of Application; Divisional Application.)

24. If claims for a genus and several species are presented, and a claim for one of the species is imperfect, it should be amended preliminary to requiring applicant to elect which of the species he will retain. Ex parte Johnson, 40 O. G. 574, C. D. 1887.

25. To allow an applicant, after prosecuting to final action claims covering a certain species, or genus and species, to present an entirely new species and construction and ask consideration thereof in the same application, would be to reverse the well-settled rules and decisions of the office. (Ex parte Eagle, C. D. 1870, 137.) Ex parte Wharton, 40 O. G. 917, C. D. 1887.

26. When an applicant has made an election of the species he will prosecute and has presented his claim therefor, he is bound by that election, and can no more change his purpose, when he shall find the selected species anticipated or unpatentable, by selecting for prosecution another species than he can claim two or more species in one and the same application. Id.

27. When division of an application has been required and an amendment is presented which does not relieve the application from the objection raised, but simply reduces the number of the inventions, the examiner should refuse to admit it. Ex parte Maxim, 43 O. G. 506, C. D. 1888.

28. The only effect of such amendment, when admitted, is to narrow or limit the right of applicant in making election of the invention he desires to prosecute in his pending application. Id.

29. The objection that applicant has elected and cannot be permitted to further amend his case raises the question of what constitutes an election under these circumstances. *Held*, that such action does not put the applicant in the status of having made a final election from which he may not be allowed to recede, and applicant cannot be considered to have made a final election until he shall have complied with the requirement as to division and the office approves and accepts his action. Id.

30. An applicant who in his application has elected, through mistake or ignorance, to prosecute claims for one invention must exercise diligence in presenting his amendment correcting such error, and this before the application has been examined and rejected. Ex parte Zabel, 43 O. G. 627, C. D. 1888.

31. The examiner was right in refusing to admit an amendment covering a distinct and separate invention from that originally retained and prosecuted to rejection. To enter and consider such an amendment would be to permit

the applicant to secure examination of two distinct inventions for one fee. Id.

32. When an applicant is required to divide his application and eliminate from his specification so much thereof as relates to the invention which he elects to withdraw, the drawings of such invention should also be canceled, unless they are actually necessary to enable those skilled in the art to construct or operate the invention retained. It is not necessary that those skilled in the art should have made the exact subject of the invention, provided the general state of the art is such as to enable them to make it. Ex parte Simonds, 44 O. G. 449, C. D. 1888.

33. In such case it is enough for the applicant to state in a general way the manner and means in which his invention can be constructed. The requirement in this particular is necessary to prevent duplication of printing drawings and specifications, to save expense in the examination and preparation for issue, and in the various forms of publication and reproduction of the same; also to relieve the public of uncertainty as to the scope of the patent and its possible scope as a re-issued patent, and to protect the public in other directions. Id.

34. Under rule 42, when an application is divided the applicant will be required, so far as practicable, to cancel all matter in the original specification, descriptive or otherwise, which has been eliminated therefrom by division, and when the drawings in the case admit of canceling such eliminated subject-matter such cancellation of the drawings will be required. Ex parte Hunter, 59 O. G. 1922, C. D. 1892.

35. An applicant having originally presented only claims for a method and having prosecuted them to a final rejection and taken an appeal to the examiners-in-chief has made his election, and he cannot be permitted to thereafter substitute claims covering mechanism alleged to be capable of carrying out the method originally claimed, merely because they are believed to be patentable and do not include new matter. Ex parte Eschner, 63 O. G. 760, C. D. 1893.

V. After Final Rejection.

(See Rehearing in Patent Office; Reopening Cases in Patent Office; Amendment, Delay in Filing.)

36. If an applicant cancels a claim, even though the requirement of the examiner which led to such action was irregular and improper, he cannot re-assert it by amendment after its final rejection. Ex parte Johnson, 40 O. G. 574, C. D. 1887.

37. The decisions are numerous to the effect that an applicant cannot re-assert a claim after a final rejection which he had previously voluntarily erased. In such case he must file a new application. Id.

38. An applicant whose claims have been twice rejected and his case is in condition for appeal has no longer the right to amend as a matter of course. If he has elected to prosecute his claims to a final rejection by the tribunals below, before being permitted to have his case reopened for further amendment he must present a satisfactory showing to the office why the proposed claim was not originally or earlier introduced. Ex parte Donovan, 44 O. G. 698, C. D. 1888.

39. An applicant whose claim for a combination has been rejected has the right to appeal to the examiner-in-chief. If he should not avail himself of this right, but eliminate his claim for the combination, his drawings and specification should also be amended by canceling all reference thereto. The admission of a subsequent amendment restoring such a claim for the combination was erroneous and irregular. Ex parte Gillette, 44 O. G. 819, C. D. 1888.

40. When 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 reopened and that applicant be heard upon the amendment must be denied. Ex parte Cordrey, 48 O. G. 397, C. D. 1889.

41. When, after material amendment, the examiner rejects, without giving new references or reasons, announcing such 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 was entitled to further amend, and, having elected the latter course, the examiner should have incorporated the amendment and considered the same. Ex parte Griswold, 50 O. G. 838, C. D. 1890.

42. Amendments canceling claims or presenting those rejected in better form for consideration on appeal may be admitted either before or after the appeal has been taken, without a showing why they were not earlier presented. Ex parte Collis, 50 O. G. 992, C. D. 1890.

43. An amended claim which does not differ materially from that finally rejected may be admitted for the purpose of appeal, but not otherwise, without further showing. The applicant's opinion may properly be consulted as to whether the proposed amended claim is couched in better form than the corresponding claim which has been rejected. Id.

44. 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. Ex parte Peloubet, 56 O. G. 928, C. D. 1891.

45. The decision of the commissioner of patents in McDonough v. Gray, v. Bell, v. Edison (C. D. 1889, 9) was a final rejection of the McDonough application, and the examiner upheld in refusing to consider an amendment thereon subsequently offered by the applicant. Ex parte McDonough, 61 O. G. 1479, C. D. 1892.

46. Where a claim was finally rejected and at the same time the statement of invention was criticised as being too broad, the final rejection was premature and an amendment touching the merits may properly be admitted thereafter. Ex parte Klaus, 64 O. G. 299, C. D. 1893.

47. A final rejection, under rule 65 (six-months rule), is a date from which to reckon the two years the statute allows for action by the applicant. Ex parte Van Norman, 60 MS. D., Dec., 1896 (Fisher, Ass't Com'r).

48. An amendment presented seventeen months after a final rejection will not be admitted, even for the purpose of appeal, in the absence of a showing of unavoidable delay. Ex parte Zimmerman, 61 MS. D., June, 1897 (Greeley, Ass't Com'r).

49. Rule 28, established April 22, 1897, having been abolished, no showing is required why an amendment is not presented sooner. The applicant has two years from the last official action within which to amend. Ex parte Fuller and McKinney, 62 MS. D., July, 1897 (Greeley, Ass't Com'r).

50. The "six-months rules" having been abolished, the examiner is directed to receive an amendment filed more than six months after the last official action in the case. Ex parte Adams, 62 MS. D., Oct., 1897 (Butterworth, Com'r).

51. Where the claims of an application were rejected under old rule 65 and no action was taken until several months after the six months' limit of appeal under rule 134, *held*, that as the rules had been amended to permit applicants two years within which to prosecute their cases, no showing is required as to why amendment was not earlier presented. Ex parte MacMaster, 80 O. G. 1475, C. D. 1897.

52. It is a well-settled principle of law that alterations of procedure or practice are always retrospective unless there be some good reason against it. In this case it seems that justice and equity demand that the applicant should have two years from the last official action in which to prosecute his case. Id.

53. Where a case was rejected on August 15, 1895, under rule 68, then in force, not on references, but on the ground that there had been intentional and unreasonable delays in prosecution, and such rejection made final under rule 65, *held*, that as these rules have been revoked and there has been no final rejection on references, the action under said rule 65 is set aside and the case opened for reconsideration. Ex parte Higgins, 80 O. G. 2037, C. D. 1897.

54. If an amendment, after rejection, inserting additional claims and requesting suspension of action upon other matters for stated reasons be admitted without question, it cannot be objected to at a subsequent period as insufficient to obviate abandonment. Ex parte Burson, 81 O. G. 2246, C. D. 1897.

VI. New Matter.

(The term "new matter" was first technically used in re-issue cases.)

55. In applications for inventions capable of illustration, rule 69 contemplates the existence of two things: *first*, a model or drawing; *second*, a specification. Amendments cannot be allowed which introduce new matter not found in either at the time of filing the application. Amendments proposing such new matter are a departure from the original invention and should be excluded. Ex parte Wharton, 40 O. G. 917, C. D. 1887.

56. Applicant has been required to amend his claim by erasing the words "or equivalents." Acquiescing in such requirement, applicant seeks to amend by inserting a description of a device asserted to be the equivalent of that originally described and shown. The examiner refused to enter the amendment, and applicant appeals to the commissioner. *Held*, that the action of the examiner was correct for the following reasons: The proposed amendment did not cure any defect in the original specification, for the invention therein described was complete and operative. It

added nothing which had been omitted, nor omitted anything which ought not to have been originally inserted. Ex parte Johnson, 43 O. G. 507, C. D. 1888.

57. The proposed amendment did not explain any matters set forth originally. It simply described in detail devices not originally disclosed, and broadened the scope of the claims which contained the parts of the newly-described devices which are said to be the equivalents of those originally set forth, but from which they differ in construction. Id.

58. The proposed amendment involved *new matter*, and would compel the office to pass upon the merits of each newly-introduced device in order to determine the question of equivalency. Id.

59. The proposed amendment would have the effect of permitting applicant to add new and different species — would be analogous to permitting an applicant who originally claimed a genus and one species to amend by adding other species which he did not claim or show, although they might to some extent illustrate the nature and character of the invention. Id.

60. The admission of such amendments would permit an applicant to make a picture gallery of his application by introducing all the known forms of what might be equivalents, and thus secure an examination of each device. Id.

61. Amendments which propose claims involving a departure from the invention originally presented, or a want of identity with the invention originally disclosed, should be admitted for consideration and *rejected for such reasons*, whereupon appeal would lie to the examiners-in-chief. Ex parte Regan, 45 O. G. 589, C. D. 1888.

62. If the new matter presented in an amendment contains claims for another and distinct invention, which, if admitted, would immediately require a division of the application to be made or applicant to elect which invention he will prosecute in the pending application, it should not be admitted. Id.

63. The original application of Sawyer and Man, filed January 9, 1880, for a patent for improvements in incandescing electric lamps, was evidently intended to secure only the arched form of the carbon burner; but in 1885, after Edison's inventions had been published to the world, the purpose of the application was changed to secure the use of all carbons made of fibrous material. *Held*, that such a change was not justifiable and the claim based thereon is void. *Consolidated Electric Light Co. v. McKeesport Light Co., 49 O. G. 1536, C. D. 1889.

64. The courts look with disfavor upon "attempts to enlarge the scope of an application once filed." Ex parte Lillie, 53 O. G. 2041, C. D. 1890.

65. A drawing cannot be altered to show a construction neither disclosed in such drawing nor described in the specification as originally presented, upon the filing of an affidavit that the drawing made from and with the proposed amendment would correctly represent a model which was never filed in the patent office. Ex parte Kissner, 53 O. G. 919, C. D. 1890.

66. Officials of the patent office 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. Winssinger, 56 O. G. 804, C. D. 1891.

67. 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. Ex parte Austin, 56 O. G. 1059, C. D. 1891.

68. Where a proposed amendment embodied a substitute claim and descriptive matter relating to the subject-matter of such claim, *held*, that the amendment should be entered, and if, in the opinion of the examiner, it included matter not disclosed by the application as originally filed, the claim should be rejected. Ex parte Harvey, 58 O. G. 1257, C. D. 1892.

69. The question raised upon an amendment sought to be introduced into a pending application is not whether the applicant's invention of its subject-matter dates back to the filing of his original application, but whether such subject-matter is itself new so far as it relates to said pending application. Ex parte Burson, 58 O. G. 1414, C. D. 1892.

70. 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. Ex parte Smith, 58 O. G. 1840, C. D. 1892.

71. An applicant of his own motion filed a substitute sheet of drawings, which was entered as a part of the application. The examiner subsequently held it to be unwarranted by the specification, and required cancellation.

On appeal, *held*, that while the better course would have been to refuse to enter the new drawing until after the final determination of the question as to its admissibility, yet, it being clear that the drawing was uncalled for and superfluous, the requirement of cancellation must be sustained. Ex parte Shepard, 60 O. G. 575, C. D. 1892.

72. An amendment comprising a substitute specification and drawings and containing new matter should be refused entry. Ex parte Nelson, Jr., 52 MS. D., Feb., 1893 (Simonds, Com'r).

73. When an amendment is filed which in the judgment of the examiner substantially varies the scope of the application as originally filed and necessitates a change in the drawings, *held*, that the amendment should be entered and rejected on the ground of new matter and for all other reasons which bar its patentability. Ex parte Zuber, 67 O. G. 529, C. D. 1894.

74. In such a case the drawings should not be changed unless and until the question of the new matter in the amendment has been determined in favor of the applicant. Id.

75. It is competent to amend the specifications while the application is pending, so long as it is done within the scope of the original application; but it is not competent, under color of this privilege, to introduce new matter. (Railway Co. v. Sayles, 15 O. G. 243, 97 U. S. 554, and Eagleton Mfg. Co. v. West, etc. Mfg. Co., 27 O. G. 1237, 111 U. S. 490.) *Michigan Central R. Co. v. Consolidated Car-heating Co., 71 O. G. 1028, C. D. 1895.

76. Where the specification as originally filed said nothing about inclining the steam-pipes downward from the center to the ends of the car and from the ends to the center of the car, and the drawings failed to show any such inclination, and thereafter the specification was amended to incorporate this feature, *held*, that the amendment was for new matter. *Michigan Central R. Co. v. Consolidated Car-heating Co., 73 O. G. 615, C. D. 1895.

77. It is competent to amend the specification so long as it is done within the scope of the original application; but it is not competent, under color of this privilege, to introduce new matter. If the amended application embodies any material addition to or variance from the original — anything not comprised in that — such addition or variance cannot be sustained. (Railway Co. v. Sayles, 15 O. G. 243, 97 U. S. 554.) So long as the inventor does not change the structure of his device he can change the specification. (Western Electric Co. v. Sperry Electric Co., 65 O. G. 597, 58 Fed. Rep. 186.) *Id.

78. Claims based on new matter should be cousidered and rejected on the ground of departure and for all other reasons that are applicable, so that all questions may be settled at once if appeal is taken to the examiners-in-chief. (Ex parte Zuber, C. D. 1894, 47, 67 O. G. 529.) Ex parte Ernest, 76 O. G. 1417, C. D. 1896.

VII. Upon Recommendation of Examiners-in-Chief or Commissioner.

79. The primary examiners possess the whole jurisdiction of determining whether questions presented by offered amendments involve matters which were *res adjudicata*, and have the power to refuse to cousider or act upon them, whether the question is referred to them by recommendation from the examiners-in-chief or the commissioner; but from this refusal there is a right of appeal. Ex parte Pearson, 40 O. G. 244, C. D. 1887.

80. Where the examiners-in-chief annex to their decisions a statement and a recommendation of an amendment, the applicant in presenting the same to the primary examiner is not required to make any showing, under rule 67, why the amendment was not sooner presented. Id.

81. Where the examiners-in-chief do not make such statement and recommendation, a doubtful or uncertain suggestion by them will not relieve the amendment from the requirements of rule 67. Id.

82. When an amendment is presented in compliance with a supposed recommendation of the examiners-in-chief which the examiner refuses to accept, the commissioner should be advised by the examiner in his answer to petition whether the proposed claim differs in scope or subject-matter from the claim already adjudicated. Ex parte Donovan, 44 O. G. 698, C. D. 1888.

83. An examiner is not bound by a recommendation contained in decision of examiners-in-chief. (Ex parte Dysart, 34 O. G. 1390; Ex parte Pearson, 40 O. G. 244.) Rule 139 (*b*) clearly implies that the examiner may reach a judgment adverse to 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. Ex parte Heyer, 44 MS. D. (2 G. W. D.), Nov., 1890 (Mitchell, Com'r).

84. The rules of practice of the patent office

provide that the examiners-in-chief may annex to their decision a statement of apparent grounds for granting letters patent in the form claimed or any other form and may make such recommendation as they deem proper. Such statement and recommendation cannot be ignored or pleaded as of no effect. It is binding upon the examiner and cannot be disregarded. Ex parte Letellier, 81 O. G. 1611, C. D. 1897.

85. It is to be presumed that the examiners-in-chief consider fully all matters bearing upon the question of patentability of claims as to which they make favorable recommendations, the question of new matter as well as other questions. Unless a state of the art not before the examiners-in-chief when their recommendation is made is found to exist by the examiner, such as precludes the allowance of claims recommended by them, the examiner should accept the recommendation. Id.

86. The examiner's action holding that an applicant cannot appeal from the decision of the examiners-in-chief and at the same time take advantage of so much of their decision as is favorable to him — cannot "split up their decision and accept a part of their suggestion and appeal from the rest of their decision"— overruled, as this is precisely what an applicant is entitled to do. It is the purpose of the patent law to grant to an applicant all that he is entitled to claim as new. Id.

87. The examiners-in-chief intimated in their decision on appeal that a certain feature might be allowed if it could be shown an advantage resulted therefrom as alleged by the applicant; and upon appeal to the commissioner, an affidavit that the invention has been made and put into practical operation having been filed, the application was allowed. Ex parte Wm. A. D. Graham, 62 MS. D., July, 1897 (Greeley, Ass't Com'r).

88. In a case appealed to the commissioner, he having suggested a certain feature might have novelty, and the examiner having subsequently refused entry of a claim therefor, *held*, the entry should be made, since it appears said claim was not substantially the same as one before registered. Ex parte Arthur M. Wiatt, 62 MS. D., July, 1897 (Greeley, Ass't Com'r).

ANALOGOUS USE.

(See PATENTABILITY; DOUBLE USE; NEW USE.)

ANNULMENT OF PATENTS.

(See CANCELLATION OF PATENTS.)

ANTICIPATION.

(See PATENTS; PATENTABILITY.)

I. PATENTS AND PRINTED PUBLICATIONS.
II. PRIOR ART.
III. PRIOR USE.

I. PATENTS AND PRINTED PUBLICATIONS.

1. The date of an application for a patent is conclusive evidence that the invention was made prior to such date, and a patent, though dated a month later than another for the same thing, is not anticipated by it when it appears that the application for such later patent was filed in the patent office two months before the date of the earlier patent. *Kearney v. Lehigh Valley R. Co., 32 Fed. Rep. 320 (1887).

2. Green's patent is not anticipated by earlier patented processes for obtaining water by bored wells, or artesian wells, or by any earlier published description which was not as full, clear and exact as would be required in a specification of a patent, or was a description which would enable a properly qualified person to put the invention in practical operation from the description alone. *Eames v. Andrews, 39 O. G. 1319, C. D. 1887.

3. A prior patent anticipates a later patent patent where the later patent varies from the prior patent in particulars which do not require patentable invention. *Sax v. Taylor Iron Works, 40 O. G. 118, C. D. 1887.

4. A prior patent had all the features of the patent in suit, except that it had two corrugated zinc rubbing-plates instead of one, and in this respect the earlier patent described an equivalent of the single zinc plate of the patent in suit, and such patent, being also prior to the other in date of invention, was an anticipation of it. *Starling v. St. Paul Plow Works, 41 O. G. 818, C. D. 1887.

5. A prior patent will not deprive a later patent of patentable novelty if by discarding some of its mechanism so as to make it a failure in the way intended it will resemble the later patent. *The Enterprise Mfg. Co. of Pennsylvania v. Sargent & Co., 42 O. G. 1403, C. D. 1888.

6. An English patent does not anticipate back of date of sealing, at which time it was made patent to the public. (Cases cited.) *Elec-

trical Accumulator Co. v. Julien Electric Co., 38 Fed. Rep. 117 (1889).

7. The fact that the specification of the foreign applicant was made accessible to the public in an unpublished form prior to the filing date of the American application is immaterial, because it was not then a printed publication, nor was it a patent. De Ferranti v. Westinghouse, 52 O. G. 457, C. D. 1890.

8. A domestic applicant is entitled to receive a patent for an invention as against all foreign knowledge or use of said invention, unless it has been patented or described in a printed publication. Id.

9. Novelty is not negatived by any prior patent or printed publication, unless the information contained 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. Deprez and Carpentier v. Bernstein, 54 O. G. 1711, C. D. 1891.

10. Prior publications must give "an account of a complete and operative invention, capable of being put into practical operation," in order to anticipate a patented invention. This general rule, however, is subject to the qualification that if the prior publication contains an omission which would ordinarily be supplied by one skilled in the art, the omission will not avail the subsequent patentee. (Cases cited.) *Chase v. Fillebrown, 58 Fed. Rep. 374 (1893).

(A patent for an invention which was experimental and unsuccessful will not invalidate a subsequent patent for the perfected invention. Whiteley v. Swayne, 7 Wall. 685.)

11. The so-called publications made in the British Official Journal and the German Imperial Gazette concerning applications for patents and the laying open of such applications to public inspection do not constitute either publications of or patents for the inventions involved. Parkin and Wright v. Jenness, 63 O. G. 759, C. D. 1893.

12. A drawing contained in a pamphlet which appears to be a mere trade circular and not accompanied by any printed description, and there being no evidence that the pamphlet was ever actually published or intended for public use, or accessible to the public, is not such a printed publication as would anticipate the patent. *Britton v. White Mfg. Co., 61 Fed. Rep. 93 (1894).

13. Claims 20 and 21 of patent No. 272,598, dated February 20, 1883, not anticipated by British patent of Howard and Bousfield of 1881, Steward having made oath during pendency of application that he had completed the invention and made a working model before the date of the British patent. *Deering v. Winona Harvester Works, 69 O. G. 1641, C. D. 1894.

14. It is well settled that mere paper patents may negative otherwise patentable novelty, provided that they sufficiently disclose the principles of the alleged invention, or provided the alleged objections can be obviated by mere mechanical skill. *Edward Miller & Co. v. Meriden Bronze Co., 79 O. G. 1520, C. D. 1897.

15. A mere trade circular never actually published or intended for general use, or accessible to the public, is not such a printed publication as would anticipate a patent, although it may have been for a number of years in the possession of a witness. *Britton v. White Mfg. Co., 79 O. G. 2195, C. D. 1897.

16. A mere paper patent may anticipate, provided it sufficiently discloses the principle of the alleged invention. Such prior patent may be relevant also to show that another device is not an infringement of such alleged invention, but is merely an improvement upon the prior patent or an application thereof to a new purpose. (Pickering v. McCullough, 104 U. S. 310; Dashiell v. Grosvenor, 162 U. S. 432.) *Universal Winding Co. v. Willimantic Linen Co., 80 O. G. 1273, C. D. 1897.

II. Prior Art.

17. Where the defendant attempts to defeat a patent by showing that the patentee was not the original discoverer of the thing claimed, the patent will, for the purpose of meeting such proof, be considered as relating back to the date of the original discovery. (Dixon v. Moyer, 4 Wash. 68, and other cases.) *Consolidated Bunging Apparatus Co. v. Woerle, 38 O. G. 1015, C. D. 1887.

18. It is doubted if a simple construction of a machine more than two years before application for a patent upon it would invalidate the patent. *Campbell v. Mayor, etc. of New York, 45 O. G. 345, C. D. 1888.

19. Although each separate step of a process may have been taken before, the process is not anticipated so long as it is not shown to have been used. *Celluloid Mfg. Co. v. Russell, 37 Fed. Rep. 676, C. D. 1889.

20. Prior to December, 1875, abandoned and rejected applications were cited as references;

but after Brown v. Guild (6 O. G. 392) that practice ceased. Although such was the practice, yet a reference of that character was illegal, for the reason that by statute a patent can be barred only by public use, a publication, or prior knowledge or use by others of the completed invention. Webster v. Sanford, 44 O. G. 567, C. D. 1888.

21. Knowledge of foreign invention, although of an earlier date than an original invention in this country, is not necessarily a bar to a domestic patent. Green v. Hall, v. Siemens, v. Field, 47 O. G. 813, C. D. 1889.

22. The mere taking of a coloring substance already known and applying it to paper does not involve invention, and in view of the state of the art the patent is void. *Underwood v. Gerber, 48 O. G. 116, C. D. 1889.

23. An abandoned application cannot of itself constitute a bar to a subsequently granted patent. Black v. Fowler, 48 O. G. 821, C. D. 1889.

24. *Held*, that a sketch made from memory of a machine seen fifteen years before is not sufficient evidence to anticipate a patent. *Tatum v. Gregory, 41 Fed. Rep. 142 (1890).

25. A combination of parts in an automatic ventilating fan is anticipated by a similar combination of the same elements in various prior patents relating to windmill fans. The uses are analogous. *Smith v. Partridge, 42 Fed. Rep. 57 (1890).

26. It is not sufficient to constitute anticipation that the device relied upon might by modification be made to accomplish the function performed by the patent in question, if it were not designed by its maker nor adapted nor actually used for the performance of such functions. *Topliff v. Topliff, 57 O. G. 1257, C. D. 1892.

27. Evidence of the prior existence of the patented invention, to deprive an inventor of the fruit of his genius, must be so definite as to produce strong belief that the machine existed; and where such machine would naturally be known to more than a few observers, the fact that the evidence tends to disclose that it had been known only to a few at a particular time throws doubt upon its existence at that time. *Knickerbocker Co. v. Rogers, 67 O. G. 1448, C. D. 1894.

28. It is well settled that an abandoned application, even though accompanied by experiments which fall short of practical use, cannot defeat a subsequent patent. (Corn Planter Cases, 6 O. G. 392, 23 Wall. 181.) Hien v. Pungs, 68 O. G. 657, C. D. 1894.

29. When a caveat did not describe the same invention patented by the caveator, its date of filing could not be availed of to defeat a subsequent publication by another of the invention embraced in the patent. *Electric Ry. Co. of the United States v. Jamaica & Brooklyn R. Co., 68 O. G. 769, C. D. 1894.

30. Prior invention must be established by "full, unequivocal and convincing evidence." *American Sulphite Pulp Co. v. Howland Falls Pulp Co., 70 Fed. Rep. 986 (1895).

31. A feature of construction in a prior invention which was immaterial and was not in the contemplation of the inventor thereof or pointed out by him as an improvement, or in any way suggested as a function of the arrangement of the parts, does not show anticipation of the patent. *Edison Electric Light Co. v. Electric Engineering & Supply Co., 73 O. G. 1287, C. D. 1895.

(However suggestive the experiments of others may have been, . . . they "will not suffice to defeat a patent." United States Nickel Co. v. Anthes, 1 O. G. 581, C. D. 1872—Judge Shipley.)

32. The fact that all the elements of a combination may be found partly in one structure and partly in another is unsafe ground for overturning a patent. *American Soda Fountain Co. v. Green, 76 O. G. 964, C. D. 1896.

33. The fact that in a room ordinarily used to contain complete devices ready for the market there was exhibited a certain device is not conclusive proof that such device was complete and on sale. *Wurts v. Harrington, 79 O. G. 335, C. D. 1897 (decided April 29, 1896).

34. The mere fact that a patented device is limited in operation or application is not alone sufficient to destroy its relevancy in a consideration of the prior art. *Edward Miller & Co. v. Meriden Bronze Co., 79 O. G. 1520, C. D. 1897.

35. As against the defense of anticipation the patentee may show the fact of invention by drawings, sketches, models or any other competent proof. The defense of anticipation to be successful must be established as of a date anterior to the patented invention, not merely prior to the application for or date of the patent. *Von Schmidt v. Bowers, 80 O. G. 347, C. D. 1897.

36. Letters patent No. 259,416, *held* to be invalid, as the changes over the prior art were of that order of mechanical detail which is far removed from inventive skill. *National Fold-

ing Box and Paper Co. v. Stecher Lithographic Co., 80 O. G. 813, C. D. 1897.

37. Letters patent No. 270,522, granted to the American Bell Telephone Company as assignee of Thomas A. Watson, for an improvement in telephone switches, is void in view of the prior state of the art, as it involves only several expedients in arranging a subscriber's outfit. *Western Electric Co. v. Western Telephone Construction Co., 80 O. G. 2038, C. D. 1897.

38. A model of an alleged anticipating machine made merely from recollection years after the machine that it purports to represent, and which is introduced without disclosing the fact that it was not an original model until the same was developed on cross-examination, cannot be accepted as sufficient evidence to invalidate a patent. *Kansas City Hay-press Co. v. Devol, 81 O. G. 1277, C. D. 1897.

III. Prior Use.

39. An old device will not be considered sufficient to defeat a patent when its construction is such that radical changes and additions would be required before it could be made to perform the work of the patented device satisfactorily. *Consolidated Bunging Apparatus Co. v. Woerle, 38 O. G. 1015, C. D. 1887.

40. To antedate a patent by evidence of an earlier machine, such evidence must be very clear and precise to overcome the presumptions arising from the grant of the patent. *Osborn v. Glazier, 40 O. G. 1137, C. D. 1887.

41. A fraudulent surreptitious purchase or construction or use of an invention prior to the application for a patent probably would not affect the rights of the patentee under this section of the act of 1839. *Andrews v. Hovey, 42 O. G. 1285, C. D. 1888.

42. Where an element of a claim does not depend for its novelty in the material of which it is made, it will be anticipated by a like element in a like instrument of different material. *Brinkerhoff v. Aloe, 46 O. G. 338, C. D. 1889.

43. The slide employed in the Brinkerhoff instrument and covered, broadly, by the first claim of the patent is made of metal. The patent makes no mention of any novelty existing in the material of which the slide is composed. *Held*, that the claim is anticipated by a glass slide in a similar instrument. *Id.

44. A claim for an incandescing conductor for an electric lamp of carbonized, fibrous or textile material is void for want of novelty in view of the fact that wood charcoal had previously been used for electric lighting in incandescent lamps. *The Consolidated Electric Light Co. v. McKeesport Light Co., 49 O. G. 1536, C. D. 1889.

45. It is a well-established rule that whatever, if subsequent, would infringe will, if prior, anticipate. *Olds v. Brown, 41 Fed. Rep. 698 (1890).

46. Evidence that a particular device, forming an element of a combination claim, was used prior to the date of a patent upon which suit was brought is immaterial. The evidence should tend to prove that the device was so combined that the combination operated in the same way for the same purposes as in the claim in question. *St. Paul Plow Works v. Starling, 55 O. G. 1821, C. D. 1891.

47. 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 than was previously produced, *held*, that the patented method involves no novelty within the meaning of the patent law. (Citing Smith v. Nichols, 21 Wall. 112.) *Ansonia Brass and Copper Co. v. Electrical Supply Co., 58 O. G. 1692, C. D. 1892.

48. Where evidence adduced by defendant of 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. *Washburn & Moen Mfg. Co. v. Beat 'Em All Barbed Wire Co., 58 O. G. 1555, C. D. 1892.

49. There is no anticipation by any prior device if it was of an accidental character of which the parties using it never derived the least hint. (Tilghman v. Proctor, 102 U. S. 707; Pittsburgh Reduction Co. v. Cowles Electric Smelting and Aluminum Co., 55 Fed. Rep. 301; Topliff v. Topliff, 145 U. S. 156.) *Chase v. Fillebrown, 58 Fed. Rep. 374 (1893).

50. He who alleges prior use must establish it by the same high class of testimony which a prosecuting attorney is required to produce in a criminal case. He holds the affirmative of that issue and must prove it beyond a reasonable doubt. If the evidence is susceptible of two interpretations, the one sustaining and the other destroying the patent, the court must accept the former. *Lalance & Grosjean Mfg. Co. v. Habermann Mfg. Co., 62 O. G. 452, C. D. 1893.

51. It is well settled that evidence of prior use, when the thing used is not produced, is of little weight, after a long interval, as to its identity with the patent in evidence. *Pratt v. Sencenbaugh, 64 Fed. Rep. 779 (1893).

52. The indefinite, unsubstantiated evidence of prior use is insufficient to affect the validity of a patent. (Cases cited.) *Britton v. White Mfg. Co., 61 Fed. Rep. 93 (1894).

53. Where the novelty of an invention resides in the particular form adopted, it is not negatived by prior structures in another art which were not capable of doing its work, though afterward, in the light of that invention, they can be modified to perform its function. *Knickerbocker Co. v. Rogers, 67 O. G. 1448, C. D. 1894.

54. As against an original inventor, anticipation is not shown by prior use of the invention under conditions which failed to disclose its composition or operation. Such knowledge of the invention should be accessible to the public. (Citing Boyd v. Cherry, 50 Fed. Rep. 279.) *Matheson v. Campbell, 69 Fed. Rep. 597 (1895).

55. Where the devices alleged to anticipate the patented device were not designed to meet nor subjected to conditions analogous to those of the patented thing, *held*, that such prior structures did not anticipate the patented device. *National Meter Co. v. Thomson Meter Co., 70 O. G. 925, C. D. 1895.

56. Where it is proved that the article set up as anticipating the patent was made a sample and known only to its maker, his daughter, and the person for whom it was made, *held*, that the proof was sufficient to establish prior public use. *Dalby v. Lynes, 71 O. G. 1317, C. D. 1895.

57. The number of anticipations is not material. If one perfected and used has preceded, it is sufficient to defeat the validity of the patent relied upon. *The Front Rank Steel Furnace Co. v. Wrought Iron Range Co., 72 O. G. 288, C. D. 1895.

58. The fact that a slight compression of the contacts had existed in a prior lamp does not show anticipation of the Bergmann patent, it appearing that such compression was immaterial to the form of construction employed in the prior lamp and was not in the contemplation of the inventor thereof or pointed out by him as an improvement or in any way suggested as a function of the arrangement of the parts. *Edison Electric Light Co. v. Electric Engineering and Supply Co., 73 O. G. 1287, C. D. 1895.

59. The prior use of a paper with a fiber too close to allow the ink from an ink-roller to pass through it, such paper being impregnated with wax of a character so hard as to rupture or abrade the fibers of the paper when it is removed by a perforating instrument, is not an anticipation of a paper with a fiber so open as to permit the ready passage of ink and impregnated with wax of a character sufficiently soft to permit its removal from the paper without tearing or breaking the fiber of the paper. *A. B. Dick Co. v. Henry, 75 O. G. 1204, C. D. 1895.

60. A mere accidental use of some of the features of an invention, without recognition of its benefit, does not anticipate a patent. *Taylor Burner Co., Limited, v. Diamond, 76 O. G. 477, C. D. 1896.

61. To constitute anticipation of a device it is enough that such a device has been in well-established use, whether it originated in design or by accident. *National Harrow Co. v. Quick, 76 O. G. 1574, C. D. 1896.

62. A new combination and arrangement of old parts, whereby spinning-spindles, instead of running in rigid bearings, are flexibly mounted on the rails so as to allow of greatly increased speed of revolution, *held* to involve invention and not to be anticipated by the use of similar devices in centrifugal machines for drying sugar or creaming milk. The two devices are so different in size, structure, and uses to which they are adapted that it is not a case of double use. (Potts & Co. v. Creager, 70 O. G. 494.) *Taylor v. Sawyer Spindle Co., 77 O. G. 452, C. D. 1896.

63. Under the decision in Potts v. Creager (70 O. G. 494, 155 U. S. 597), power picks and plows are not anticipations for a mining machine, since they do not belong to related arts. *Independent Electric Co. v. Jeffrey Mfg. Co., 78 O. G. 797, C. D. 1897.

64. Decree for complainant in Hanifen v. Godshalk, *supra*, vacated upon rehearing, since it appears that defendants have established, at least *prima facie*, the identity of the fabric sued on with a prior British one. *Hanifen v. Godshalk, 79 O. G. 513, C. D. 1897.

65. Novelty is not negatived nor overcome by showing prior construction of a similar thing for a wholly different and foreign use not suggestive of the particular use to which the patented invention is applied. (Cases cited.) *Kinnear & Gager Co. v. Capital Sheet-metal Co., 81 Fed. Rep. 491 (1897).

APPEAL.

(See INTERFERENCE — APPEAL.)

I. PETITION OR APPEAL (INTERLOCUTORY) TO COMMISSIONER.
II. APPEAL FROM PRIMARY EXAMINER TO EXAMINERS-IN-CHIEF.
III. APPEAL FROM EXAMINERS-IN-CHIEF TO COMMISSIONER.
IV. APPEAL FROM COMMISSIONER TO COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.
V. APPEAL FROM COMMISSIONER TO SECRETARY OF THE INTERIOR.
VI. APPEAL TO UNITED STATES CIRCUIT COURT OF APPEALS.
VII. APPEAL TO UNITED STATES SUPREME COURT.

I. PETITION OR APPEAL (INTERLOCUTORY) TO COMMISSIONER.

1. There is no rule or requirement that an appeal which, though made because relating to form, involves the absolute merits of a claim shall be taken to the commissioner merely to save applicant the appeal fee. If applicant be put to the trouble and expense of a second appeal after the requirement of division has been complied with and the application has reached the stage for full consideration upon its entire merits, the fault is with applicant who has presented his application under such conditions rather than due to the office or its practice. Ex parte Carter, 46 O. G. 1391, C. D. 1889.

2. Where 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 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, a petition on behalf of applicant praying that the examiner be directed to make the examination required by the statute, allowing or rejecting said claims, was granted. Ex parte Rogers, 49 O. G. 1861, C. D. 1889.

3. Questions involving "the rejection of a claim" are not reviewable by the commissioner upon petition. Ex parte Tobie, 50 O. G. 992, C. D. 1890.

4. Upon petition to the commissioner from decision of the assistant commissioner, *held*, that the law makes no provision for such an appeal and the petition was treated as a motion for rehearing. Ex parte Clauton, 42 MS. D. (2 G. W. D.), Mar., 1890 (Fisher, Ass't Com'r).

5. Objections to the specification, accompanied by refusal to act further on the merits until they have been removed, are reviewable by a petition to the commissioner and not by an appeal to the examiners-in-chief. Ex parte Gäbel, 55 O. G. 863, C. D. 1891.

6. Where the complaint was that the examiner had declined to consider claims 2 and 3, which were alleged to be modifications of the design shown in the drawing and claimed in the first claim, which stood allowed, *held*, that the examiner's action should be sustained. Ex parte Petzold, 55 O. G. 1528, C. D. 1891.

7. Objections that a claim is indefinite or that certain claims are substantially identical pertain to form, and a petition lies to the commissioner. Ex parte Eastman, 56 O. G. 410, C. D. 1891. 5709

8. Petition to expunge argumentative matter and new reasons of rejection from an examiner's statement refused. Ex parte Mevey, 56 O. G. 805, C. D. 1891.

9. An action of an examiner that amounts in effect to a holding that an alleged divisional application covers matter that could not be legitimately divided out of the earlier application of which it purports to be a division, is reviewable by the commissioner on petition, and does not involve a question that can be taken to the examiners-in-chief by way of appeal. Ex parte Fuller, 57 O. G. 1883, C. D. 1891.

10. Where the effect of action by the commissioner on an appeal from an examiner would be to review a decision of such examiner favorable to the merits of an application in question, such appeal will not lie. Hochhausen v. Eickemeyer, 58 O. G. 521, C. D. 1892.

11. An appeal from the adverse action of an examiner which involves the question whether the application under consideration is a division of a prior application is properly taken to the commissioner rather than to the examiners-in-chief. Ex parte Freeman, 58 O. G. 522, C. D. 1892.

12. No appeal lies to the commissioner from a decision of the examiner of interferences affecting the evidence before his own tribunal; but a motion to take additional testimony is not within this rule, and an appeal from the examiner's adverse decision thereon is properly taken to the commissioner. Guerrant v. Cable, v. Coffee, 59 O. G. 629, C. D. 1892.

13. When the objection to new matter is

that it is merely in the descriptive part of the specification or drawing and does not affect the scope of the claims, an interlocutory appeal lies from the examiner to the commissioner; but when new matter appears in or affects a claim or claims, the appeal lies to the examiners-in-chief. Ex parte Suter, 59 O. G. 1431, C. D. 1892.

14. A decision by the examiners-in-chief affirming a rejection by an examiner, subject to certain recommendations made by them, is such an affirmance of the examiner's decision that a petition to the commissioner asking "that a record decision affirming the patentability of the invention in issue may be entered" will not lie. Ex parte McGowan, 60 O. G. 735, C. D. 1892.

15. If a patent be granted on one of two concurrent applications by the same applicant and the other application is rejected on such patent for lack of divisibility of invention, a petition to the commissioner asking that the examiner be instructed that the application is a division of the application for which a patent was granted will not be passed upon, since it presents a question relating to the merits of the case. Ex parte Feister, 61 O. G. 152, C. D. 1892.

16. Where the examiner of interferences refused to consider a motion to strike out a wife's testimony and reserved the question until final hearing, *held*, on appeal to the commissioner, that this was a proper subject for interlocutory action. Crawford v. Lichtenstein, 61 O. G. 1480, C. D. 1892.

17. No petition can be properly taken from the action of the examiner when there has been no repetition of such action. Ex parte Bishop, 63 O. G. 153, C. D. 1893.

18. The question whether or not an examiner should cite as a reference an applicant's former patent, the application for which was copending with the present application, is one pertaining to the merits of the invention and therefore not reviewable by the commissioner on petition. Ex parte McDonald, 64 O. G. 857, C. D. 1893.

19. Ex parte Mullen and Mullen (50 O. G. 837) and Ex parte Rogers (49 MS. D. 418) discussed and held not to indicate a different practice. Id.

20. "There is no petition from the rejection of a claim by the primary examiner upon anything which he may hold is a substantial disclosure and anticipation of a claim." The remedy is by appeal to the examiners-in-chief. Ex parte Hulbert, 66 O. G. 315, C. D. 1894.

21. A petition asking that an examiner be advised that a certain figure and description are sufficiently described and indicated in the original specification and drawing presents an appeal from the sufficiency rather than the propriety of a rejection. This is a question for the examiners-in-chief. Ex parte Coe, 81 O. G. 2086, C. D. 1897.

22. A request that an examiner be instructed in his duty as to his general practice toward applicants and in relation to application should be presented in a complaint against the examiner and not in a petition. Id.

(The term "petition" was substituted for "interlocutory appeal" by Commissioner Montgomery.)

II. Appeal from Primary Examiner to Examiners-in-Chief.

24. Since April 27, 1880, all *ex parte* cases appealed to the examiners-in-chief are within the jurisdiction of the primary examiner immediately after a decision by the examiners-in-chief. Ex parte Pearson, 40 O. G. 244, C. D. 1887.

25. No appeal lies to examiners-in-chief from adverse decision of primary examiner in public use proceedings. Ex parte Finch, 40 O. G. 1037, C. D. 1887.

26. Objections by the examiner that the alleged invention shown in an application for a mechanical patent should be made the subject of a design application, *held* to be a *rejection* of the application, the appeal from which must go to the examiners-in-chief. Ex parte Schulze-Berge, 42 O. G. 293, C. D. 1888.

27. An applicant whose claim for a combination has been rejected on the ground of illegitimacy and that it covers a mere aggregation of devices or elements has the right to appeal to the examiners-in-chief. Although such rejection is a vital formal objection, it also relates to the merits, and applicant has the right by appeal to all the tribunals provided by law to test the validity of such claim. Ex parte Gillette, 44 O. G. 819, C. D. 1888.

28. An objection holding that claims are functional is not a *rejection*, and therefore not appealable to the examiners-in-chief. Ex parte Barrett, 45 O. G. 125, C. D. 1888.

(Practice now modified. See *inter alia*, Ex parte Halfpenny, 78 O. G. 1135; Williams, 61 O. G. 423; McClellan, 59 O. G. 1763.)

29. The action of the examiner refusing to answer an appeal on the ground that it is not regular in form, in that it did not set forth the points on which it was taken, but simply stated that the appeal was from the rejection of the claims on references of record, overruled, and *held* that the present rules do not require that the reasons of appeal shall constitute a brief of the argument upon which applicant will rely before the board, but merely that the point or points of decision from which appeal is taken shall be specified. Ex parte Callahan, 50 O. G. 990, C. D. 1890.

30. The rules (133 and 135) require that the appellant should identify the part or portion of the decision from which appeal is taken, 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. Id.

31. From an examiner's rejection on account of "new matter," appeal lies to the examiners-in-chief. Ex parte Regan, 45 O. G. 589, C. D. 1888.

(See, also, Ex parte Burt, 49 O. G., C. D. 1889; and Niolin Ochsenreiter, 56 O. G., C. D. 1891.)

32. The refusal of the examiner to answer an appeal to the examiners-in-chief on the ground that it was premature was irregular, the examiner having twice objected to a certain claim because it did *not* cover a *combination*. Ex parte Bullard, 45 O. G. 1569, C. D. 1888.

33. The objection of the examiner that under such circumstances a petition to the commissioner is premature because he has not twice declined to answer the appeal to the board is not well taken. If the application is in condition for appeal, the statement required by rule 135 is required as a matter of course, and if the examiner refuses to furnish such statement the commissioner can at once direct that he shall do so. Id.

34. Where a petition prayed that examiner be instructed to accept an affidavit as sufficient to remove the effect of a reference cited, *held*, that under Ex parte Payne, 41 MS. D., and Ex parte Boyer, id., it was a matter appealable to the examiners-in-chief, and the petition dismissed. Ex parte Rosenstock, 41 MS. D. (1 G. W. D.), Dec., 1889 (Fisher, Ass't Com'r).

35. One of the claims in an application had been rejected because it covered an illegitimate combination or an aggregation of elements. Applicant appealed from such rejection to the examiners-in-chief. The board refused to take jurisdiction of the appeal and remanded the case to the primary examiner for reconsideration and such action as would dispose of the merits of all the claims. The examiner referred the case to the commissioner for instructions. Whenever a claim for an illegitimate combination is presented in an application which also contains claims for different elements constituting distinct and separate inventions which ought not to be claimed in the same application, a vital objection as to form is presented, and the claim may be rejected for the purpose of enabling the office to require division. Such a rejection, though relating to form, involves merits, and an appeal therefrom should lie to the examiners-in-chief. Ex parte Carter, 46 O. G. 1391, C. D. 1889.

36. When applicant claims the combination of a "stitch-forming and cloth-feeding mechanism" in a sewing-machine and "an automatic expansible or yielding hemmer and feller," and the examiner objects to the claim for the reason that the "means for securing an automatic action of the hemmer and feller" and "the means for securing an expansible or yielding action thereof" are not stated, and the applicant insists that his invention resides in a combination of which the peculiar hemmer and feller is an element, irrespective of the mere means by which its automatic action or its expansible or yielding action is secured, *held*, that the objection of the examiner presents a question of fact which relates to the merits, upon which applicant has a right of appeal to the examiners-in-chief. Ex parte Laskey, 48 O. G. 539, C. D. 1889.

37. An appeal from an action of the examiner objecting to a claim for an article of manufacture because of supposed aggregation goes to the examiners in-chief. Ex parte Baker, 49 O. G. 1363, C. D. 1889.

38. The appeal from a rejection by the examiner because of insufficiency of the oath required by rule 75 lies to the examiners-in-chief. Ex parte Boyer, 49 O. G. 1985, C. D. 1889.

39. No appeal should be taken from an examiner's action until a final rejection has been had on all his grounds for refusing a patent. Ex parte Donovan, 52 O. G. 309, C. D. 1890.

40. Whether a process is a proper or legitimate one is a question relating to the merits and the subject for an appeal to the examiners-in-chief, and not a petition to the commissioner. Ex parte Read, 47 MS. D. (3 G. W. D.), June, 1891 (Frothingham, Ass't Com'r).

41. Questions involving "the merits of an invention" are questions concerning the meritorious or unmeritorious attitude of an alleged invention to the antecedent rights of the public; or, in other words, questions other than questions of "form" arising between the applicant and the office. The presence in rule 124 of the words quoted means no more than that the questions which go to the examiners-in-chief, when they arise *directly* under rule 133, go to the same tribunal when they arise *collaterally* under rule 124. Zeidler v. Leech, 54 O. G. 503, C. D. 1891.

42. All appeals in which, under the rule, the party only "whose claim is affected" has a right to be heard lie 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 from the examiners' decision upon motions to dissolve upon which both parties have the right to be heard go directly to the commissioner, and from his decision there is no further appeal. Id.

43. 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 unless they alter or enlarge the meaning of the old claims already in the case. Ex parte Gäbel, 55 O. G. 863, C. D. 1891.

44. 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. Ex parte Eastman, 56 O. G. 410, C. D. 1891. 04 57

45. The recommendations of the examiners-in-chief are not binding upon the primary examiner, but there is no good reason why an applicant should be put to the delay involved in going through a second appeal simply to have the examiners-in-chief formally affirm what they have already decided in substance. Ex parte Williamson, 56 O. G. 1060, C. D. 1891.

46. 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. Ex parte Thomson, 56 O. G. 1203, C. D. 1891.

47. Only those parties are entitled to be heard by the examiners-in-chief who have specifically entered an appeal and paid the fee thereon. Shinn v. Baker, v. Gold, 56 O. G. 1204, C. D. 1891.

48. 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. Ex parte Ferguson, 56 O. G. 1334, C. D. 1891.

49. 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. Ex parte Murphy and Atkinson, 56 O. G. 1449, C. D. 1891.

50. A petition does not lie directly to the commissioner under rule 145 simply on the point whether or not a proposed amendment involves a departure from the invention disclosed in the application as originally presented. This question is one which involves the merits, and appeal lies to the examiners-in-chief under rule 133. Ex parte Turner, Van Beek and Brown, 56 O. G. 1708, C. D. 1891.

51. The refusal of the examiner to forward to the examiners-in-chief an appeal taken from his action holding that an application was not a legitimate divisional application, *held* to have been properly made. Ex parte Fuller, 57 O. G. 1883, C. D. 1891.

52. The question of "incomplete combination of elements" and an objection that a claim covers only the function of a machine involve the merits, and are appealable to the examiners-in-chief in the first instance. Ex parte McClellan, 59 O. G. 1763, C. D. 1892.

53. Where an applicant who has been in interference seeks, after a decision of priority in his favor, to amend his claims, and the examiner rejects his amendment as covering matter which applicant has claimed too late, *held*, that the question thus raised is one which should be decided by the examiners-in-chief on appeal before it comes to the commissioner. Ex parte Woodward, 60 O. G. 1052, C. D. 1892.

54. The question whether a claim for a so-called "process" is a claim for the function of a particular machine is one relating to its merits. Appeal lies to the examiners-in-chief. Ex parte Williams, 61 O. G. 423, C. D. 1892.

55. The question whether an applicant may claim operative parts of a device which as a whole is inoperative is one on which applicant has a right of appeal to the examiners-in-chief. Ex parte Smith, 52 MS. D., Jan., 1893 (Frothingham, Ass't Com'r).

56. Where an application was rejected on a previously allowed application taken cumulatively with a patent and the applicant petitioned the commissioner for relief from such

action, *held*, that the question involved was appealable to the board of examiners-in-chief. Ex parte Seymour, 65 O. G. 751, C. D. 1893.

57. The use in claims of the terms "means" and "mechanism," limited only by the function which such means or mechanism performs, has heretofore been held to render the claims objectionable in form only when the novelty resides in the specific kind of means or mechanism; but whether the novelty resides in the specific means or mechanism can only be determined by reference to the state of the art. *Held*, therefore, that the question raised when this objection is made against such claims is one going to the merits of the invention and properly appealable to the board of examiners-in-chief. Ex parte Halfpenny, 73 O. G. 1135, C. D. 1895.

58. Rule 133 does not enumerate mutually exclusive points of appeal in such sense that one must be wholly different from another. Ex parte Briggs, 75 O. G. 1854, C. D. 1896.

59. The subject-matter of each appeal under rule 133 is the rejection of a claim and not the reasons upon which such rejection was based. Id.

60. Appeal is not merely from the examiner rejecting the claim, but from his decision holding it to be not allowable. Id.

61. The question as to whether a claim for a device different from that originally claimed may be introduced into a case more than two years after the device covered by the later claim has been in public use is a question of new matter which goes to the merits, and is appealable in the first instance to the examiners-in-chief. Casler v. Edison, 80 O. G. 966, C. D. 1897.

62. The rule (134) requiring an appeal to be taken in six months after final rejection has been abolished, and under present rules (June 18, 1897) an appeal may be filed at any time before the case becomes abandoned under the statute. Ex parte Hodgins, 62 MS. D., Aug., 1897 (Greeley, Acting Com'r).

(This time is limited to one year under the law which went in force January 1, 1898. Appeal to the court of appeals is differently regulated.)

III. Appeal from Examiners-in-Chief to Commissioner.

63. Acquiescence in the decision of the examiners-in-chief and abandonment of the right of appeal are not obviated, nor is applicant restored to his right of appeal, by again amending and restoring the canceled claim. The applicant cannot thus experiment with the office, go back to the primary examiner to ascertain what he may secure, and, failing there, retrace his steps and appeal from the examiners-in-chief and try his chance with the commissioner. If by such proceeding the applicant has deprived himself of the right of appeal to the commissioner, it is because he has elected to abide by the decision of the examiners-in-chief, and if he has thus deprived himself of any substantial right he must resort to some new procedure to extricate himself or file a new application. Ex parte Williams and Raidabaugh, 40 O. G. 1337, C. D. 1887.

64. It is not hereby held that a mere amendment before the primary examiner, by authority of the commissioner, and which does not change the subject-matter or scope of the claim, but only renders it more intelligible or less ambiguous, would thus operate as an abandonment of the appeal. Id.

65. Where an applicant has appealed from a rejection by the primary examiner to the examiners-in-chief and the latter have affirmed the rejection, the applicant has two courses which he may pursue. He may appeal to the commissioner, or he may return to the primary examiner and take such action before him as the rules and practice of the office permit. If he pursues the latter course and obtains such action by the examiner as to eliminate the claim involved in the appeal or amend it substantially in scope or subject-matter, this is an election to abide by the decision of the examiners-in-chief and constitutes an abandonment of the right of appeal. This proposition is not affected by the fact that the cancellation or amendment of the claim was irregularly allowed by the examiner without authority of the commissioner. Id.

66. Motion to dismiss an appeal taken to the commissioner from the decision of the examiners-in-chief, upon the ground that it was not accompanied by the brief statement of reasons required by rule 147, denied, and *held* 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 and Holmes v. Coler, 51 O. G. 1622, C. D. 1890.

67. 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 al-

leged by one of the contestants to constitute a statutory bar. Schmiedl v. Walden, 56 O. G. 1563, C. D. 1891.

IV. Appeal from Commissioner to Court of Appeals of the District of Columbia.

68. The action of the commissioner of patents in rejecting a claim for the striker plate in another application by the same inventor, but which rejection was acquiesced in by the applicant, *held* not to be reviewable on appeal from a decision of the commissioner rejecting a claim in this application for the combination of the striker plate and door or casing. *In re Forg, 66 O. G. 515, C. D. 1894.

69. There is no appeal to the court of appeals from any order or ruling of the commissioner of patents in any preliminary or interlocutory matter in an interference. *Westinghouse, Jr., v. Duncan, 66 O. G. 1009, C. D. 1894.

70. There is no appeal to the court of appeals from the *opinion* of the commissioner of patents holding that there is or is not an interference, nor from his refusal to investigate an alleged interference, such matters being left by law to his sound discretion. *Id.

71. A decision of the commissioner of patents that may be appealed from to the court can only be made after the primary examiner, the board of examiners-in-chief and the commissioner have all considered the case and made a finding therein. *Id.

72. The record of the proceedings in a case in the patent office, upon being filed with the clerk of the court of appeals, becomes a public judicial record of the court and must be so treated. There is no warrant found either in the patent law or the common law of the land to keep such papers secret and not to allow copies to be made except upon the special order of the court or consent of the appellant. *Ex parte Drawbaugh, 66 O. G. 1451, C. D. 1894.

73. In appeals from the commissioner of patents the court of appeals has no power or jurisdiction to award cost or to execute any judgment therefor that it might enter therein. *Wells, Jr., v. Reynolds, 69 O. G. 1507, C. D. 1894.

74. On an appeal from the decision of the commissioner awarding priority of invention, *held*, that the court will confine its decision to the matter passed upon in his decision and not consider the questions of abandonment, prior public use and anticipation of the invention, which have not been acted on in the patent office. *Colhoun v. Hodgson, 70 O. G. 276, C. D. 1895.

75. Upon an appeal to the court of appeals of the District of Columbia from the decision of the commissioner of patents as to priority of invention, in an interference between parties, *held*, that the question as to the patentability of the issue is not properly presented; the appeal presents a question of priority simply. *Hisey v. Peters, 71 O. G. 892, C. D. 1895.

76. *Held* further, that the right of appeal in case of refusal of a patent upon the ground of non-patentability of the claim, and refusal of a patent because of interference with a prior right of invention, are distinct rights, and the latter does not involve the former. (Sec. 4911, R. S., and sec. 9 of act establishing Court of Appeals, D. C.) *Id.

77. Where the question of fact as to priority of invention had been fully considered by the officials of the patent office, *held*, that the decision of the patent office must stand, unless the evidence shows beyond any reasonable doubt that the appellant was the first inventor. (Coffin v. Ogden, 5 O. G. 270, 18 Wall. 120; Morgan v. Daniels, 67 O. G. 811, 153 U. S. 120; Crawford v. Neal, 144 U. S. 585, and Furrer v. Ferris, 145 U. S. 132.) *Id.

78. There is no justification for the theory that, since Revised Statutes, section 4894, give an applicant a possible two years in which to prosecute his application, he has two years in which to take an appeal to the court of appeals of the District of Columbia. *Hien v. Pungs, 73 O. G. 1600, C. D. 1897.

79. The right of appeal is not a vested right, but may be altered by statute or by rule of court made in pursuance of statutory authority to enact such rule. *Id.

80. Even if there were no rule at the time the right of appeal accrued, after the promulgation of a rule regulating the time for taking appeals the appellant became bound by it. *Id.

81. The parties failing to print the transcript of record, the appeal was dismissed. *Pelton v. Evered, 77 O. G. 1600, C. D. 1896.

(See, also, *Munson v. Casper, 79 O. G. 160, C. D. 1897.)

82. Appeal from the decision of the commissioner of patents, nearly a year after such decision, is brought in violation of rule 20 of the rules of this court, and should not be entertained, especially when no excuse for the delay is urged. *Bryant v. Seymour, Com'r of Patents, 77 O. G. 1599, C. D. 1896.

83. While some rules of court may be modified in special cases, they are in general as binding upon the court as upon parties and counsel, and rigid adherence is required to time-rules which are intended to have the effect of statutes. *Id.

84. The rule that all appeals taken from the commissioner of patents shall be taken within forty days from the date of the ruling appealed from, and not afterward, is a positive law to the court and to the suitors therein. *Ross v. Loewer, 77 O. G. 2141, C. D. 1896.

85. The contention that a motion for rehearing in the patent office should operate as a stay of the running of the time for the prosecution of appeal to this court till after the motion for rehearing has been determined, cannot be admitted. *Id.

86. When it appears that an appellant has failed to have his cause filed and docketed, his appeal may, on motion, be docketed and dismissed, with costs. *Rosebrugh v. Holman, 78 O. G. 1258, C. D. 1897.

(See, also, *McCreery v. Seymour, Com'r, 79 O. G. 1684.)

87. The fact that the court of appeals of the District of Columbia has refused to consider questions of patentability of issues in priority cases does not establish the conclusion that the decision of the commissioner upon questions of patentability in such cases is final and conclusive. Such questions should come before the court by regular course of appeal. Breul v. Smith, 79 O. G. 153, C. D. 1897.

88. In a case of interference appealed to a court, the decision of the patent office must stand unless the evidence shows beyond any reasonable doubt that the appellant was the original inventor. *Arnold v. Tyler, 79 O. G. 156, C. D. 1897.

89. The appellant having failed to have his cause filed and docketed, on motion of the appellee the cause was docketed and the appeal dismissed. *Cleaveland v. Wright, 79 O. G. 866, C. D. 1897.

(See, also, *Morrissey v. Seymour, Com'r of Patents, and *Southall v. Seymour, Com'r of Patents, 79 O. G. 1634, C. D. 1897.)

90. Where all the tribunals of the patent office have decided adversely to an appellant, the concurrent decision will not be reversed except in a very clear case. *Barratt v. Seymour, Com'r of Patents, 79 O. G. 2020, C. D. 1897.

91. Apart from the general rule that courts have power to make reasonable rules not conflicting with express statutes, the court of appeals was duly authorized by statute to make rules limiting the time of appeals from the decisions of the commissioner of patents. *In re Hien, 79 O. G. 507, C. D. 1897.

92. The fact that a rule of the court of appeals relating to the time in which an appeal must be taken was promulgated after the decision appealed from, is not controlling as to the appeal, since the right of appeal is not a vested right, but one which may be altered by statute or by rule of court. *Id.

93. The court of appeals for the District of Columbia has authority to limit the time for taking appeals, and there is no restriction by reason of section 4894, Revised Statutes, which has reference solely to the abandonment of an application by failure to prosecute. *Id.

94. The decision of the supreme court in Gandy v. Marble, in which it was held that a bill in equity under section 4915, Revised Statutes, was *sub modo* a branch of the application and governed as to laches by section 4894, Revised Statutes, had nothing to do with the time in which an appeal from the decision of the commissioner of patents must be taken. *Id.

95. The supreme court in Butterworth v. Hoe, in considering the difference between an appeal under section 4911, Revised Statutes, and a bill in equity under section 4915, Revised Statutes, held that the latter is a proceeding according to the ordinary course of equity. This being so, section 4894, Revised Statutes, is inapplicable to the case of an appeal from the decision of the commissioner of patents. *Id.

96. The act of congress approved February 9, 1893, by which the determination of appeals from the commissioner of patents was vested in the court of appeals of the District of Columbia, does not overstep the boundaries erected by the constitution between the three great departments of the government, but it is within the power of congress to enact such law. *Bernardin v. Seymour, Com'r of Patents, 79 O. G. 1190, C. D. 1897.

97. As congress had the power to create a distinct special tribunal, proceeding after the manner of a court of law or equity, for the adjudication of claims to patents for inventions, there seems to be no convincing reason why it could not, without violating the constitution, make it a branch or bureau of an executive department, subject to supervision in matters administrative only by the head of that depart-

ment, and subject to review in matters judicial in their nature by a court of competent jurisdiction. *Id.

98. Where on appeal from the decision of the commissioner of patents a record was allowed to be filed in the case by appellee upon assurance that it would have some material bearing upon the question of the issue presented by the appellee, but on consideration it was found that the record had no such bearing, *held*, that the record so introduced must be at the cost of the appellee. *Stevens v. Scher, 81 O. G. 1932, C. D. 1897.

V. Appeal from Commissioner to Secretary of the Interior.

99. The secretary of the interior has no appellate jurisdiction over the commissioner of patents in cases involving the performance of judicial or *quasi*-judicial duties imposed by law upon the commissioner of patents. †Houston v. Barker, v. Bannister, v. Eastman, 44 O. G. 697, C. D. 1888.

100. The secretary of the interior has authority to direct the commissioner of patents to perform the duties, either judicial or ministerial, which the law enjoins upon him; but when these legally-enjoined duties are judicial or *quasi*-judicial he cannot control the commissioner's discretion in the manner of their performance. †Id.

101. The appellate jurisdiction of the secretary of the interior over the actions of the commissioner of patents is limited to cases not involving duties directly imposed by congress, but such only as are imposed by the rules and regulations prescribed by the secretary for the government of the commissioner and his subordinates. †Id.

102. No appeal lies to the secretary of the interior in interference cases. †Petithomme v. Bedbury, 52 O. G. 605, C. D. 1890.

(See, also, Ex parte †Noakes, 66 O. G. 575, C. D. 1892; also †Jenkins v. Jenkins & Armat, 78 O. G. 1002, C. D. 1897.)

103. The secretary of the interior will not advise the commissioner of patents how to decide a case pending before him on appeal when he conceives that the parties appealing have the right to expect the individual judgment of the commissioner. †Ex parte H. Manske & Co., 63 O. G. 1687, C. D. 1893.

104. Upon an appeal to the secretary from the decision of the commissioner refusing to make an order of default against K. and declining to entertain and dismiss from consideration motions on behalf of M. for an order upon B. and upon C. to show cause why judgment should not be entered against them as junior parties for failing to take testimony within the time assigned them for that purpose, *held*, that the question involved is one which has been already judicially determined by the commissioner, and, as in such cases the secretary has no appellate jurisdiction, the appeal is dismissed. †Knight v. Bagnall, v. Curtis, v. Morgan, 76 O. G. 1115, C. D. 1896.

105. To construe and apply a rule of the patent office is at least a *quasi*-judicial act, and hence an appeal from the decision of the commissioner based upon an alleged disregard of a certain rule must be dismissed. †Warner v. Stimson, 78 O. G. 1901, C. D. 1897.

106. Another ground for dismissing the appeal is founded upon the grounds of policy, since to allow appeals to the department from interlocutory orders of the commissioner would unnecessarily delay the progress of the case. †Id.

(No appeal lies to the secretary from the commissioner as to judicial or *quasi*-judicial actions of the latter. Butterworth, Com'r, v. United States ex rel. Hoe, 29 O. G. 615, C. D. 1884.)

VI. Appeal to United States Circuit Court of Appeals.

107. On a suit for infringement the court passed a decree for a perpetual injunction and accounting, and after an interval of more than two months defendants asked for a rehearing and a dissolution of the injunction. Pending this petition, and before its denial by the court, the circuit court of appeals was created. *Held*, that the order denying the petition for a dissolution of the injunction was not an interlocutory order or decree of continuance from which an appeal lies to this court within the meaning of section 7 of the act of March 3, 1891, establishing the circuit court of appeals. *Boston & Albany R. Co. v. Pullman's Palace Car Co., 61 O. G. 428, C. D. 1892.

108. In the prosecution of an appeal to the circuit court of appeals under section 7 of the act of March 3, 1891, from an order granting an injunction, there is no discretion in the court or judge allowing the same to deny or refuse the appellant a *supersedeas*, and the appellant is entitled to it as a matter of right. *Société Anonyme du Filtre Chamberland Systeme Pasteur and The Pasteur Chamberland Filter Co. v. Blount, 61 O. G. 1484, C. D. 1892.

109. A decree which is rendered after full hearing on the merits and which sustains the validity of a patent, declares infringement, and awards a perpetual injunction and an accounting, is an "interlocutory decree" granting an injunction, from which an appeal will lie to the circuit court of appeals under section 7 of the act of March 3, 1891. (Jones Co. v. Munger, etc. Co., 50 Fed. Rep. 785, 1 C. C. A. 688, approved.) *Richmond v. Atwood, 61 O. G. 1655, C. D. 1892.

110. The term "interlocutory order or decree" was used in its broadest sense in this section and should be given full scope, to the end that any party aggrieved by any order or decree granting an injunction at any stage of the proceedings may have a speedy remedy by appeal. *Id.

111. On such an appeal, where the whole record is before the circuit court of appeals, and, in order to determine the rightfulness of the injunction, the court necessarily examines the whole case on the merits and reaches the conclusion that there is no infringement, it may not only reverse the decree and dissolve the injunction, but may also vacate the order for an accounting and order the bill dismissed, thus rendering such a decree as the lower court should have rendered on the whole case. (Jones Co. v. Munger, etc. Co., 50 Fed. Rep. 785, 1 C. C. A. 668, disapproved.) *Id.

112. A decree sustaining the validity of a patent, declaring infringement, directing an injunction perpetual in form and referring the cause to a master to take an account of damages and profits is not appealable in its entirety, so as to give the circuit court of appeals jurisdiction to finally determine the questions of validity and infringement, for the decree is not final in its nature and appealable as such under prior laws, but is interlocutory, and on an appeal therefrom under section 7 of the act creating the circuit court of appeals, the court is limited to the question whether the injunction was providently granted in the exercise of a legal discretion, and it can have no jurisdiction to render a decision on the other questions, even at the request of both parties. (Jones Co. v. Munger Mfg. Co., 50 Fed. Rep. 785, 1 C. C. A. 158, disapproved.) *Columbus Watch Co. v. Robbins, 62 O. G. 1963, C. D. 1893.

113. In an action at law for damages for an infringement, the question whether a certain patent set up as a defense is an anticipation of the patent sued on is a question of fact to be submitted to and decided by a jury, and where there was no request for an instruction to the jury to return a verdict for the defendant the appeal court cannot, under such circumstances, consider the question. *Harper & Reynolds Co. v. Wilgus, 64 O. G. 302, C. D. 1893.

114. On a writ of error to the circuit court of appeals its review is confined to the consideration of questions of law, the rulings of trial courts upon questions of evidence, and the instructions given and refused to the jury. *Id.

115. Where there is nothing in the bill of exceptions to show that the jury disregarded the instructions of the court, the presumption is that they strictly followed them, and, in the light of the evidence, obeyed the charge of the court. *Id.

116. Where the appeal has been taken under the seventh section of the court of appeals act from an interlocutory order granting an injunction, the appellate court will not ordinarily hear and finally determine the merits of the controversy as to the validity of the patent sued on and its infringement; yet, in looking into the record to determine whether the order was properly granted, the court may be obliged to consider the validity and infringement of the patent and reach a conclusion on both of those points. *Columbus Watch Co. v. Robbins, 70 O. G. 132, C. D. 1895.

117. As the decree of the circuit court was not final, *held*, that the only appeal which could be considered is from so much of such decree as grants an injunction. *Kilmer Mfg. Co. v. Griswold, 72 O. G. 1780, C. D. 1895.

118. A suit by the United States to annul a patent is not within the limitations of the act creating the circuit court of appeals. *United States of America v. American Bell Telephone Co. and Berliner, 73 O. G. 1285, C. D. 1895.

119. The "interlocutory order or decree" made appealable by section 7 of act of March 3, 1891, for the organization of the courts of appeal, as amended February 18, 1895, must be one which leaves the cause pending on the issues in the court of original jurisdiction. The state of the record or progress of the cause must be such when said appealable "interlocutory order or decree" is entered that a "final decree" upon the matter with which said "interlocutory order or decree" has to do may yet be made. *Standard Elevator Co. v. Crane Elevator Co., 77 O. G. 811, C. D. 1896.

120. By providing an appeal from a prelim-

inary or *pendente lite* injunction and in an adjoining section of the same act giving an appeal from any "final decision," the law-makers indicated that a perpetual injunction decreed as the outcome of a final hearing on the merits in a patent case was appealable as a "final decision." *Id.

121. The words "the proceedings in other respects in the court below shall not be stayed unless otherwise ordered by that court during the pendency of such appeal," in section 7, seem to imply that the mere perfecting the appeal shall not in legal effect stay the suit. *Id.

122. Where the lower court held that defendant had infringed and referred the cause to a master in chancery to take, state and report to the court an account with respect to the infringement and the gains, profits and advantages which the defendant had received or which had arisen or accrued by reason of such infringement, and while the matter was so pending before the master and before any report by him the appellant (here) perfected an appeal from that decree to the court of appeals, *held*, that the appeal should be dismissed, as the decree appealed from was interlocutory, and that the appeal was taken after the expiration of thirty days from the entry of the interlocutory decree. *Raymond v. Royal Baking Powder Co., 77 O. G. 1124, C. D. 1896.

VII. Appeal to United States Supreme Court.

123. 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, 55 O. G. 715, C. D. 1891.

124. Where it appeared that the decree in the circuit court was against only one of several defendants, *held*, that the suit was still pending and undetermined against the other defendants, that the decree was not final, and that the supreme court had, therefore, no jurisdiction of the appeal. *Hohorst v. Hamburg-American Packet Co., 63 O. G. 155, C. D. 1893.

125. In order to bring a case by appeal or writ of error from the court of appeals of the District of Columbia within the jurisdiction of the supreme court of the United States under this alternative, the matter in dispute must be money or some right the value of which can be estimated and ascertained in money and which appears by the record to be of the requisite pecuniary value. *United States ex rel. State of South Carolina v. Commissioner of Patents, 67 O. G. 1191, C. D. 1894.

126. In order that a case may come within this clause the validity and not the construction only of an authority exercised under the United States must be directly drawn in question. *Id.

127. The United States supreme court alone has appellate jurisdiction of a suit to annul a patent. *United States of America v. American Bell Telephone Co. and Berliner, 73 O. G. 1285, C. D. 1895.

128. The supreme court of the United States will not take jurisdiction on appeal of applications for patents in view of the provisions in relation to appeals from the circuit courts of appeals under the act of March 3, 1891, as the right to apply for a patent and the invention cannot be regarded for jurisdictional purposes as in itself property or a right of property having an actual value susceptible of estimation in money. *Durham v. Seymour, Com'r of Patents, 74 O. G. 1731, C. D. 1896.

APPLICATION FOR PATENT.

I. Date of.
II. Delay in Filing.
III. Joint and Sole.
IV. By Employees of Patent Office.
V. In a Foreign Language.
VI. Improper Alteration and Substitution of Papers.
VII. Name of Applicant.
VIII. Return of Papers to Applicant.
IX. Inks Required for Papers.
X. Title of Invention.

I. Date of.

1. The date of completed application is the date the fee is paid, and not the date that the application is filed. Ex parte Columbia Sewing Machine Co., 41 MS. D. (1 G. W. D.), Nov., 1889 (Mitchell, Com'r).

2. An application dates from the day when the papers were filed complete and formal. The omission of applicant's residence from the oath is an informality, and the application takes date from the day when the omission is supplied. Ex parte Brand, 63 MS. D., Dec., 1897 (Greeley, Acting Com'r).

II. Delay in Filing and Prosecuting.

3. An applicant having deceased shortly after official action on his application, and his widow having been appointed administratrix of decedent's estate more than two years after, and having then promptly applied for reinstatement of the application, *held*, the delay was sufficiently accounted for. Ex parte Guerrant, 34 MS. D., April, 1887 (Montgomery, Com'r).

4. Applicants present broad and generic claims and claims for specific constructions. The former have been rejected for lack of novelty, and the latter found to conflict with claims in other pending applications. They insist that they have two years in which to appeal from the rejection, and by refusing to act successfully tie up other applications and prevent the issue of patents, or place the office in the position of issuing patents which may hereafter be adjudged to interfere with an application pending at the time the patents were granted. *Held*, that if applicants refuse to avail themselves for an unreasonable time of their right of appeal, or are unreasonably dilatory in seeking the protection which the rules offer them, for the purpose of delaying the issue of patents to other parties for their inventions which have been found patentable, the commissioner would not be justified in permitting such dilatory and unjust action of applicants to work hardship to other applicants who are entitled to the specific constructions, but will issue the patents. Ex parte Lombard, 43 O. G. 1847, C. D. 1888.

5. In such cases the applicants should be notified that in order to secure an interference they must act with reasonable promptness; but the office and not the applicants must be the judge of what constitutes reasonable promptness. Id.

6. Applicant has failed in this case to make a sufficient showing to enable the commissioner to arrive at the conclusion that his delay in completing the application was unavoidable during the entire period of non-prosecution on account of his financial condition. Ex parte Fenno, 52 O. G. 1665, C. D. 1890.

7. An inventor is not responsible for delay in patent office occasioned by interminable interference proceedings between him and other inventors. *Brush Electric Co. v. Julien Electric Co., 41 Fed. Rep. 679 (1890).

8. The delaying of applications which are in condition to go to patent in order that an applicant whose claims have been rejected may appeal to the examiners-in-chief is wholly in the interest of the public. Abel and Dewar v. Maxim, v. Nobel, 56 O. G. 139, C. D. 1891.

9. To what extent the suspension of issue of an allowable application should be carried to await an appeal upon a rejected application, which, if allowed, would interfere therewith, is a question depending upon the exercise of a wise discretion; but it would be an abuse of that discretion to permit an applicant whose claims are rejected to tie up and delay the issue of other applications by negligently or wilfully refraining from taking an appeal. Even though an applicant may have a strict legal right as between himself and the public to avail himself of the two years allowed by statute within which to take his appeal, he has no such right as against other applicants who are seeking in good faith to obtain patents for their inventions. Id.

10. An application will not be reinstated under section 4894 of the Revised Statutes, although the applicant had been sick fourteen months, when it appeared he had experienced attorneys who might have proceeded with the prosecution of the case. Ex parte Tuoti, 45 MS. D. (3 G. W. D.), Jan., 1891 (Fisher, Acting Com'r).

11. The application was filed June 4, 1877; the patent granted November 17, 1891. "The device covered by the patent in suit had been in public use by the respondent corporation since the year 1878. The respondent corporation was of ample means to prosecute the application. The result of any delay which might take place in the issue of the Berliner patent would evidently be to continue so much longer the practical monopoly of the art of electrical transmission of articulate speech." Under these circumstances the duty of the respondent corporation was to use the greatest degree of diligence in prosecuting the application to an early issue. "There should have been at least as great diligence as their own interests would have called for had their business been unprotected by patent-rights." The delays subsequent to June 9, 1882, were unwarrantable, were acquiesced in, and therefore intended by the respondent corporation, and were such as to invalidate the patent. *United States of America v. American Bell Telephone Co., 69 O. G. 1778, C. D. 1894.

12. There can be but one law touching alleged delays in the progress of an application through the patent office and touching the duty

of applicants with reference thereto, whether the invention was from the outset seen to be valuable, or only afterward proves to be so, or always remains of little account. To deny this is to deny that the laws are equal, and would furnish a standard for the determination of the rights of patentees too fickle and imaginative to form a proper basis for the use of a court of law. *American Bell Telephone Co. v. United States of America, 71 O. G. 1903, C. D. 1895.

13. Where an inventor delays four or five years in applying for a patent, "he assumes the chances of the field being occupied by other and more diligent designers more prompt to supplement their creative efforts by a reduction to practice." *Front Rank Steel Furnace Co. v. Wrought Iron Range Co., 72 O. G. 288, C. D. 1895.

14. It is insufficient excuse for seven months' delay in filing an application that the attorney was too busy with other engagements to write the claims, there being no proof of sickness or poverty, etc. The rule of *stare decisis* must prevail. (Cases cited.) McCormick v. Cleal, 61 MS. D. 461, June, 1897 (Butterworth, Com'r).

15. Under the statute, former rule 68, relating to an inquiry as to delay in prosecuting a case if pending more than five years, held of doubtful validity, in view of decision of supreme court in American Bell Co. v. United States, 71 O. G. 1903; and the rule having been abrogated, the rejection is set aside. Ex parte Jenne, 62 MS. D., July, 1897 (Butterworth, Com'r).

III. Joint and Sole.

16. One of two joint caveators filed an application, and both caveators stated they had abandoned their interest in the caveat; *held*, the applicant need not furnish evidence he was sole inventor. Ex parte Drury, 46 MS. D. (3 G. W. D.), March, 1891 (Frothingham, Ass't Com'r).

17. Rule 32 (Rules of February 9, 1897) has been abolished. A joint application cannot be changed and continued as sole under present rules. The applications are separate and distinct, and the papers and fee filed in the joint application cannot be transferred to the other. Ex parte Prescott, 62 MS. D., Aug., 1897 (Greeley, Ass't Com'r).

18. When through ignorance a party who is not an inventor joins with the inventor in making application, the ignorant cannot legally succeed as sole applicant the joint applicants. The fact that for a time the rules permitted the substitution now asked for does not make it possible or equitable to grant relief not in accordance with the law. Ex parte Erne and Bridges, 81 O. G. 2247, C. D. 1897.

IV. By Employees of Patent Office.

19. The obvious purpose and intent of congress, as expressed by section 480, Revised Statutes, was and is to prevent persons employed in the patent office from improperly utilizing their knowledge of the inventions of others, acquired as a result of their official connection with the patent office, and from utilizing the opportunities they have, as a result of their employment, to become rivals or competitors of inventors whose applications they have before them for examination, or in any wise to take undue advantage of the knowledge they have acquired of pending applications in their capacity of examiners or officials. Ex parte McElroy, 80 O. G. 1123, C. D. 1897.

(Order No. 1,144.)

Department of the Interior,
United States Patent Office,
Washington, D. C., August 6, 1897.

All applications for patents now pending before the office filed by employees of the patent office during the period of their service, either complete or incomplete, or completed after they had separated themselves from the service, are ordered to be stricken from the files and the fees returned.

The views of the commissioner upon section 480 of the Revised Statutes are expressed in his decision of even date herewith in the case of Ex parte John H. McElroy (80 O. G. 1123).

Benj. Butterworth,
Commissioner.

See decision of Commissioner Butterworth, 26 O. G. 637, C. D. 1884, 12.

20. The reason of the statute which prohibits an officer or an employee of the patent office from acquiring either directly or indirectly *any interest* in a patent issued would seem by fair intendment to prohibit him from filing an application for the interest he is not permitted to acquire. The application is the evidence of an inchoate right to a patent, and the ownership becomes complete when the patent is issued. Id.

21. To construe the statute to allow an employee of the patent office to file an application would obviously permit, if in fact it did not encourage, the very mischief the statute was clearly intended to prevent, as examiners might

make some slight improvement or modification in inventions covered by applications pending before them for examination and file an application, change or modify it from time to time, negotiate the sale of the whole or a part interest in the invention or application or the patent to be predicated thereon, and resign and prosecute the case and take a patent whenever such course seemed to offer greater pecuniary advantages than to remain in the office, and thus the office might become freighted with applications filed by examiners or other employees in contravention of the spirit if not the strict letter of the statute, and thus become a prolific source of scandal. Id.

22. An application filed by an employee of the patent office ordered to be stricken from the files and the fee returned, as under section 480, Revised Statutes, it is not competent for an inventor to file an application for a patent while he is such an employee. He may file his application, however, after he has severed his connection with the office. Id.

(An employee of the patent office may have a patent after his employment ceases, for an invention made before such employment began (*Page v. Holmes Burglar Alarm Telegraph Co., 17 O. G. 737, C. D. 1880), or for an invention made during his term of employment. Foote v. Frost, 14 O. G. 860, C. D. 1878. See, also, Com'rs Dec., 26 O. G. 637, C. D. 1884.)

V. In a Foreign Language.

24. An application in the German language, accompanied by a translation, *ordered* stricken from the files and a new file prepared as of date of receipt of the duly-executed specification in the English language. Ex parte Gentzsch, 62 MS. D., Oct., 1897 (Greeley, Acting Com'r).

VI. Improper Alteration and Substitution of Papers.

25. In Ex parte Schuetz & Schuetz, 41 MS. D., it was held that interlineations and erasures are unauthorized if made subsequently to the execution of the application. In cases where it is established to the satisfaction of the examiner that the application has been "altered or partly filled up after being signed or sworn to," such application should be stricken from the files. Ex parte Kirkpatrick, 41 MS. D. (1 G. W. D.), Dec., 1889 (Mitchell, Com'r).

26. An application signed and sworn to in blank will be stricken from the files. Ex parte Ayres, 42 MS. D. (2 G. W. D.), Jan., 1890 (Fisher, Ass't Com'r).

27. A surreptitious alteration having been made in the drawings after filing, *ordered* the application be stricken from the files. Ex parte Merrill, 53 MS. D., Nov., 1893 (Seymour, Com'r).

28. An omitted page of a specification cannot be substituted by an attorney before filing an application. The application in this case ordered stricken from the files. (Ex parte Altmann, 80 O. G. 1475.) Ex parte Raetzell, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

29. Where it appeared that the sheets of the specification were removed from the cords or ribbons connecting the same to the other papers of the application, and over the ends of which the seal of an officer before whom the oath was taken was affixed, and another specification was substituted, *held*, that there was a violation of rule 31 and an offense against the notice published in the Official Gazette, volume 79, page 1309, and the application was ordered stricken from the files of the office. Ex parte Altmann, 80 O. G. 1475, C. D. 1897.

VII. Name of Applicant.

30. The law knows but one christian name. The middle names are mere matters of ornament or of social distinction; hence the omission of the middle name, or of the initial of the middle name, is wholly immaterial. But an omission to write the christian name in full is fatal. Ex parte Gentry, 44 O. G. 822, C. D. 1888.

VIII. Return of Papers to Applicants.

31. It is the settled practice of the patent office to refuse to return any of the papers of a complete application — that is, an application which comprises all necessary papers properly executed and on which the filing fee has been paid. Applications which do not comprise all papers necessary to a complete application properly executed may be returned where their return is necessary in order to enable the applicant to complete the papers, and this may be done whether the filing fee has been paid or not. Ex parte Van Etten, 80 O. G. 1760, C. D. 1897.

32. There are good reasons why papers should not be returned. It must be presumed that in filing the papers the applicant contemplated and intended the completion of the application and its preparation for examination

within the period fixed by statute. They must be taken to have been filed in good faith for the purpose of obtaining a patent on the invention set forth in them, as this is the only purpose for which applications can be filed or received by the patent office. Id.

33. It is a matter of grave doubt whether any paper or drawing relating to an application for patent, whether such application be complete or not, which has been filed in the patent office and has been stamped or otherwise marked by the office with the date of its receipt, should be returned. Certainly a paper or drawing so marked should not be returned except on satisfactory showing therefor being made, and in no case should it be returned without erasure or cancellation of the marking put upon it by the office. Id.

34. The receipt of the papers and drawing is acknowledged by the office. To permit the papers so dated to pass out of the custody of the office would offer opportunity for material changes in the drawing and specification and would give rise to endless controversy as to the date at which the invention set forth was actually shown by the records of the patent office. Id.

IX. Inks Required for Papers.

35. The preservation of the files of this office requires the use of permanent ink in the preparation of papers by applicants, and to this end an examiner may require an applicant to furnish copies of papers filed by him when the ink used in the originals is not of a lasting character. Ex parte Ritter, 55 O. G. 1883, C. D. 1891.

X. Title of Invention.

36. 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. Ex parte Nickola, 57 O. G. 1425, C. D. 1891.

37. If the title of an application is short and correctly indicates the nature and design of the invention, the applicant should be allowed, within reasonable limits, to say what it shall be. Ex parte Becker, 64 O. G. 559, C. D. 1893.

38. If the title given by the applicant is not satisfactory to the examiner, objection should be made; but the examiner himself should not arbitrarily select such title. Id.

ART.

(See Patentability — Process or Method.)

1. 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, 43 MS. D. (2 G. W. D.), May, 1890 (Mitchell, Com'r).

2. An art, within the meaning of the patent laws, must accomplish some change in the character or condition of material objects. Ex parte Turner, 66 O. G. 1593, C. D. 1894.

3. When the practice of the alleged art will not produce any physical effect, but will merely carry out a plan or theory of action without the production of any physical results proceeding directly from the operation of the theory or plan itself, it is not an art in the sense of the patent law. Id.

4. Where the separate steps in the process are found separately in different patents, but taken with a different effect and in necessary relations with another set of operations, and in none of them as a complete process, these steps, when brought together, bear the same relation to one another and to the prior art that the few and simple elements of an improved machine bear to the many and complicated elements of its precursor. Ex parte Rudd, 68 O. G. 535, C. D. 1894.

5. The terms "art" and "process" in a patent have substantially the same meaning, and the expression "In the art of," as an introduction to a claim to an application, is misleading and confusing. Ex parte Davis & Mustard, 63 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

(Art embraces all those inventions which cannot be embraced under one or more of the four groups of instruments enumerated in the statute. Rob. on Pats., vol. 1, 164.)

ASSIGNEES — RIGHTS OF, IN APPLICATIONS.

(See Attorneys.)

1. The rights of assignees under the joint patent are protected; for if the sole applicant has assigned and transferred all the right and title which he had in the invention, then such assignees become the owners of the sole invention, and the office, if satisfied on this point, would permit them to take charge of and control all proceedings had in and under the sole application. Kohler v. Kohler and Chambers, 43 O. G. 247, C. D. 1888.

2. It would not be policy to allow any one but an assignee who is the owner of an undivided part of the entire invention to prosecute an application, owing to great confusion that would necessarily result. Ex parte Funston, 49 O. G. 1044, C. D. 1889.

3. An assignee of the entire invention may assert his right to hold correspondence with the patent office to the exclusion of the inventor. Ex parte Baker, 49 O. G. 1363, C. D. 1889.

4. In cases in which there is a dispute or a conflict of interest between the inventor applicant and his assignees, neither party will be permitted to take any action in the prosecution of the application without the concurrence of the other. Petition of John S. Campbell, 44 MS. D. (2 G. W. D.), Aug., 1890 (Fisher, Acting Com'r).

5. It is common practice to allow an 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 does not eutitle the holder to such representation. Ex parte Hunter, 46 MS. D. (3 G. W. D.), April, 1891 (Frothingham, Acting Com'r).

6. When an applicant makes a full assignment of one of two applications, together with the invention disclosed therein and the right to a patent therefor, and such applications contain the same subject-matter, together with claims not drawn upon proper lines of division, he thereby conclusively elects to give the preference to the assigned application and to assert in the unassigned application only such portion, if any, of the invention as is special thereto. It follows that the assignee is entitled to prosecute the assigned application precisely as if the other application had never been filed. Ex parte MacLaughlin, 55 O. G. 863, C. D. 1891.

7. *Quære*, whether public policy will permit the office to allow an assignee to prosecute an application wholly from the sight of the inventor if the latter wishes to keep himself informed as to the proceedings. Ex parte MacLaughlin, 55 O. G. 864, C. D. 1891.

8. The assignee of an inventor who died before making his application has no standing as an applicant before the patent office, and this is true where the application sought to be made by the assignee is a division of one properly filed by the inventor. Ex parte Stevens, 59 O. G. 299, C. D. 1892.

9. The assignee of the entire interest may control the appointment and dismissal of an attorney to the exclusion of the applicant. Ex parte Anderson, 62 O. G. 449, C. D. 1893.

10. The assignee of a part interest has the right to have access to the files at any time. Protest of the New Era Iron Works Co., 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

ASSIGNMENT.

I. In General.
II. Defined.
III. Construed.
IV. Of Future Improvement.
V. By Attorney.
VI. By Corporation.
VII. By Order of Court.
VIII. In Bankruptcy.
IX. Disputed Title.
X. Recording and Identification.

I. In General.

1. An assignment before application for letters patent "of the full and exclusive right to the invention as fully set forth in the specifications" carries with it whatever patents may issue upon divisions of the application required by the rules of the patent office. *Puetz v. Bransford, 39 O. G. 1083, C. D. 1887.

2. A new application based upon features withdrawn from the original application, and differing in construction and arrangement, but not to a patentable degree, from the corresponding features in the original application does not relieve such new application from the assignments before stated of the original application. *Id.

3. Letters patent No. 330,850, issued to Tillman Puetz, Jr., November 17, 1885, shows features of novelty not embraced in the drawings and description of the application for patent No. 330,849, and an assignment conveying an interest in the latter does not confer any right to the former. *Puetz v. Bransford, 39 O. G. 1427, C. D. 1887.

4. A clause appointing the assignees attorneys of the patentee, with authority to use his name whenever they deem proper in the management of the business connected with the ownership of the patent, does not restrict in any way the interest or power of the assignees. Such a clause is simply unnecessary. *Rude v. Westcote, 48 O. G. 399, C. D. 1889.

5. An assignment by a patentee of a certain patent does not, in the absence of misrepresentation as to the scope of the patent assigned, estop the assignor from taking out patents for other and different improvements in the same class of articles as that with which the earlier patent was concerned. *Essex Button Co. v. Paul, 58 O. G. 1095, C. D. 1892.

6. A complete agreement of sale in an instrument purporting to be an assignment of a patent is all that is necessary to pass the legal title of personal property as between the parties. *Jonathan Mills Mfg. Co. v. Whitehurst, 56 Fed. Rep. 589 (1893).

7. An exclusive right to make and sell is not assignable. *Waterman v. Shipman, 64 O. G. 713, C. D. 1893.

8. An assignment executed before the consul-general of the United States at Frankfort-on-the-Main, Germany, is sufficiently proved by the signature of the said consul-general and the United States general seal. (Cases cited.) *Matheson v. Campbell, 69 Fed. Rep. 597 (1895).

9. He who takes an equitable title by assignment takes subject to all existing equities whether he has notice or not. ‡Harrison v. Morton, 76 O. G. 1275, C. D. 1896.

10. When in a written instrument intended to effect the transfer of patents one such patent is inadvertently, as shown by competent evidence, omitted, the assignee has equitable title. Newton v. Buck, 79 O. G. 2200, C. D. 1897.

(Assignments of patents are not required to be under seal. *Gottfried v. Miller, 21 O. G. 711, C. D. 1882.

An assignment of all an assignor's property except such as is exempt by law does not carry a patent-right. *Campbell v. James, 18 O. G. 1111, C. D. 1880, 18 Blatch. 92.)

II. Defined.

11. An assignee of an undivided part of an invention within and throughout a specified part of the United States is not such an assignee of an "undivided part of an invention" as rule 6 requires to enable him to join in the prosecution of an application which the inventor had, without consent of said assignee, abandoned in a written declaration. Ex parte Funston, 49 O. G. 1044, C. D. 1889.

12. Such assignee does not come within the definition of an assignee as laid down in rule 211, paragraph 1. Id.

13. A grant of the exclusive right to make, use and sell a patented article throughout the United States for the full term of the patent is to be treated as an assignment, enabling the assignee to bring suit in his own name against the patentee for an infringement. *Rapp v. Kelling, 52 O. G. 1666, C. D. 1890.

14. An assignment is an instrument in writing, conveying either (1) the whole patent, comprising the exclusive right to make, use and vend the invention throughout the United States; or (2) an undivided part or share of that exclusive right; or (3) the exclusive right under the patent within and throughout a specified part of the United States. *Waterman v. Mackenzie, 54 O. G. 1562, C. D. 1891.

15. 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 jointly with the assignor in the second. *Id.

16. Any other transfer is a mere license, giving the licensee no title in the patent and no right to sue at law in his own name for an infringement. *Id.

17. A transfer of the exclusive right to a patent within and throughout a specified part of the United States is, properly speaking, an assignment. Ex parte Buchanan, 56 O. G. 140, C. D. 1891.

18. An instrument granting all right, title and interest in the invention, except as to a certain combination, is not an assignment. (*Waterman v. Mackenzie, 54 O. G. 1562.) Ex parte Hunter, 56 O. G. 929, C. D. 1891.

19. An alleged assignment purporting to convey an invention yet to be made is a mere executory contract and not an assignment proper. *Regan Vapor-Engine Co. v. Pacific Gas-Engine Co., 58 O. G. 1695, C. D. 1892.

20. An instrument recorded in the patent office before application for patent was made and not specifically identifying the invention is not an assignment but a mere executory agreement. Ex parte Lorentz, 59 O. G. 158, C. D. 1892.

(When an exclusive right is given for manufacture and sale of an invention throughout the United States, excluding the patentee as well as others, there remains nothing in the patentee. Nellis v. Pennock Mfg. Co., 13 Fed. Rep. 451.)

III. Construed.

21. A provision in an assignment of a patent, that the net profits arising from sales, royalties, settlements or other sources are to be divided between the parties to the assignment, so as to give the patentee one-fourth thereof,

does not in any respect modify or limit the absolute transfer of title. *Rude v. Westcott, 48 O. G. 399, C. D. 1889.

22. Schwintzer, by an absolute assignment, transferred, for a certain consideration, title to a patent, and on the following day he and the assignee entered into a contract reciting that, instead of the consideration mentioned in the assignment, the assignee should pay certain sums on future dates, and if he should fail to do so the title to the patent should return to Schwintzer. *Held* that, by this transaction, the legal title to the patent vested in the assignee, but was liable to be defeated *in futuro* on failure of the condition subsequent. *Boesch v. Graff, 51 O. G. 477, C. D. 1890.

23. Complainant's president, being the owner of letters patent under which it manufactured split pulleys, assigned an interest therein, with the right in the assignee to manufacture, and any improvements were to be joint property. An employee of complainant instructed the assignee in the manufacture, and, it appeared, used substantially the forms claimed in a patent for which he applied, but assigned to the president, who assigned immediately after its issue to complainant. *Held*, that complainant could not dispute the right of the assignee to manufacture under the last patent. *Dodge Mfg. Co. v. Puster, 52 O. G. 159, C. D. 1890.

24. When a written agreement is uncertain and shows a patent ambiguity, it is proper to admit parol testimony to explain it, and to construe it according to such testimony adduced. Ligowsky v. Peters, v. Hisey, 56 O. G. 1595, C. D. 1891.

25. When an assignment of patent-rights conveys rights for certain specified territory, a subsequent assignment of "all his right, title and interest" must be construed to convey only the interest for territory not included in the first assignment. *Regan Vapor-Engine Co. v. Pacific Gas Co., 56 O. G. 1886, C. D. 1891.

26. The mere fact that an agreement which recites certain previous assignments of patents as the consideration for its execution was not executed until the day after such assignments were made does not of itself establish the fact that it was a separate and independent transaction. If it is apparent that the parties at the time had the entire transaction under consideration, the documents should be construed together. *Id.

27. An agreement purporting to convey all discoveries and inventions of a certain character owned by C. and B., and applications for patents pending therefor, may be construed to include inventions of the same character owned by and applications for patents pending in the name of B. alone, where C. and B. jointly own but one of such inventions, but C. is B.'s solicitor for procuring patents for the others. *Lowry v. Cowles Electric Smelting and Aluminum Co., 65 O. G. 295, C. D. 1893.

28. B. and K., being owners of a patent for dress-stays, entered into an agreement that any inventions in dress-stays made by either of them should be owned jointly. Thereafter B. secured a patent for an improvement in dress-stays. After this the two entered into partnership with an existing firm for the purpose of making and dealing in dress-stays, the contract reciting that the right under the original patent owned by B. and K. should be in the partnership exclusively, and that any improvements made by either B. or K. should belong to the partnership. Several months later this partnership was dissolved by a written agreement reciting that "K. for a money consideration assigned all his right, title and interest in and to all and singular the property, assets and business of said copartnership" to the other partners. *Held*, that this assignment divested all of K.'s right and title to the patent secured by B. after the making of the original agreement between them. *Bray v. Denning, 65 O. G. 754, C. D. 1893.

29. A clause in an assignment of a patent that, if the assignee fail to make certain statements and payments within a certain time after the same become due, the assignors shall have the right by giving notice to cancel the exclusive privilege and grant conferred does not authorize a cancellation by notice given at a time when no money is due. *E. C. Atkins & Co. v. Parke, 68 O. G. 1519, C. D. 1894.

30. Where a written instrument transferred the exclusive right to make, use and sell machines in accordance with certain designated patents of the defendant, and it appeared that the object of the transfer unquestionably was to vest in the transferee the exclusive right to manufacture under all the patents of the defendant during their entire existence, *held*, that the omission to designate one of the patents from the transfer was a mistake. *Newton v. Buck, 75 O. G. 673, C. D. 1896.

IV. Of Future Improvement.

31. Where the same inventor had assigned an earlier patent on potato-planters, together

with all improvements which he might thereafter make, certain interests in which patent became the property of defendants, they thereby acquired equitable interests in subsequent patented improvements of the same inventor in potato-planters and a right to a legal title to the same. *Aspinwall Mfg. Co. v. Gill, 40 O. G. 1133, C. D. 1887.

32. An assignment of a patent, with future improvements of the same by the same inventor, is valid as to the improvements, as collateral or incidental stipulations connected with the conveyance of the principal subject. *Id.

33. An instrument purporting to assign an invention yet to be made does not operate as an assignment of such invention when made, but is a mere executory contract. *Regan Vapor-Engine Co. v. Pacific Gas-Engine Co., 58 O. G. 1695, C. D. 1892.

34. An indorsement of such an instrument assigning and transferring "all right, title and interest in and to the above agreement" passes only the written instrument itself, with such right of action thereon as had not at the time of the indorsement become vested in the indorser. (Reversing Regan Vapor-Engine Co. v. Pacific Gas-Engine Co., 57 O. G. 1886.) *Id.

35. An assignment of part of right, title and interest in a patented invention and in and to any further improvements that the inventor might make or acquire does not give assignee title to an invention which is radically different in several respects, though belonging to the same art. To do so would be in effect to hold that the assignment in question constitutes a mortgage on the inventor's brain. Only improvements on the particular machine patented would pass by the assignment referred to. *Independent Electric Co. v. Jeffrey Mfg. Co., 78 O. G. 797, C. D. 1897.

V. By Attorney.

36. The assignment of a patent for an invention when executed by one acting as attorney by an instrument under seal must be executed in the name of the principal and purport to be sealed with his seal in order to bind the principal. *Machesney v. Brown, 38 O. G. 1130, C. D. 1887.

37. A conveyance executed by an attorney under a power of attorney to sell for the patentees, for them and in their names, all their right, title and interest in a patent, is in law their conveyance and not his. *H. Tibbe & Son Mfg. Co. v. Heineken, 47 O. G. 1221, C. D. 1889.

38. An instrument 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 under such an instrument will not be recognized in the prosecution of the application. Ex parte Hunter, 56 O. G. 920, C. D. 1891.

39. A patentee appointed an attorney with full authority to grant licenses and also with authority to assign the patent, but on terms and conditions to be "agreed on and approved by the grantor, or every bargain closed will be void." The attorney thereafter, without referring the matter to his principal, transferred in his own name, as grantor, to the plaintiff, his executors, etc., "the exclusive liberty, license, power and authority to make, use and sell" the machines in all the states and territories of the Union for the remainder of the term of the patent. *Held*, that this was an assignment of the patent, and was void as such both because made in excess of the attorney's authority and because it was his own act and deed and not that of his principal. *Chauche v. Pare, 77 O. G. 1123, C. D. 1896.

40. After this transfer the principal wrote several letters to the plaintiff recognizing his interest in the invention, but all of which indicated that the patentee understood the plaintiff to have merely a license. *Held*, that they did not amount to a ratification of the assignment which the attorney had attempted to make. *Id.

VI. By Corporation.

41. Officers of a corporation are special, not general, agents, and have no power to bind the corporation, except within the limits prescribed by the charter and the by-laws. The president of a corporation has no authority to assign a patent owned by the corporation without authority of the directors or managers. *Kansas City Hay-Press Co. v. Devol, 72 Fed. Rep. 717 (1896).

42. While an assignment of a patent by a corporation executed by its president and secretary without previous authorization by the trustees is not within the scope of the ordinary powers of such officers, the act was clearly subject to ratification by the corporation, and inasmuch as four years have elapsed without any question being raised by the corporation,

no third party can challenge the validity of the assignment in a collateral proceeding. *Id.

VII. By Order of the Court.

43. As a void patent confers no title or right upon the patentee, a court of equity will not order him to assign it. *Kennedy v. Hazelton, 46 O. G. 973, C. D. 1889.

44. Under the Public Statutes of Massachusetts, chapter 151, section 2, clause 11, authorizing "bills by creditors to reach and apply . . . any property, right, title or interest, legal or equitable, of a debtor within this state, which cannot be come at, to be attached or taken on execution in a suit at law;" and act of 1884, chapter 285, authorizing a bill to reach and apply in payment of a debt any property of the debtor, as provided by the above act, notwithstanding certain facts specified, "or that it is of uncertain value, provided the value can be ascertained by a sale or appraisal, or by any means within the ordinary procedure of the court," the court may decree that the master make and deliver an assignment of letters patent if the defendant refuse to assign them. ‡Wilson v. Martin-Wilson Automatic Fire Alarm Co., 52 O. G. 901, C. D. 1890.

45. Letters patent containing, under the Revised Statutes of the United States, section 4884, "a grant to the patentee, his heirs or assigns," and being by section 4898 "assignable in law by an instrument in writing," an assignment by a master under decree of court, without the patentee joining therein, is sufficient in form. ‡Id.

46. The *situs* of a patent-right is not such that it cannot be sold under a decree of a state court having jurisdiction over its owner. ‡Id.

47. The rule seems to be well settled that an assignment can only be made by the actual owner of a patent; that rights under the patent cannot be sold by a sheriff on execution and do not, like other incorporeal rights, vest in a receiver. *Newton v. Buck, 75 O. G. 673, C. D. 1896.

48. It might be proper under some circumstances to have the patent issue to an inventor of an improvement, and then by process in equity compel an immediate assignment to an original inventor; but the jurisdiction of this court is equitable as well as legal in character, and that circuitous course is unnecessary. *Milton v. Kingsley, 75 O. G. 2193, C. D. 1896.

49. A receiver under the laws of New York becomes, in proceedings supplementary to execution, invested with the title to all the debtor's property, equitable as well as legal, and a court may compel such debtor to appropriate his property and transfer it to a receiver. *Newton v. Buck, 79 O. G. 2200, C. D. 1897.

(If an insolvent refuses to convey when ordered by the court, the latter may appoint a trustee to make the assignment. Murray v. Ager, 20 O. G. 1311.

The patent-right may be subjected by bill in equity to the payment of a judgment debt of the patentee. *Id.

Note.—The decision of the supreme court of the District of Columbia in this case quotes decisions of the same and other courts and practically establishes the law upon the subject.

The patent privilege does not rest in a receiver merely by virtue of his appointment. See *Dick v. Struthers, 34 O. G. 131.

A receiver, as such, has no power to convey the legal title to a patent. See *Adams v. Howard (1884), 23 Blatch. 27; *Gordon v. Anthony (1879), 16 O. G. 1135, 16 Blatch. 234.

A receiver, as such, may convey the equitable title. *Adams v. Howard, *supra*.)

VIII. In Bankruptcy.

50. Where an assignee in bankruptcy elects to abandon property to the bankrupt before the expiration of the period of limitation within which he may bring suit under section 5057, the effect is as if the property abandoned had never been included in the assignment, and the statute of limitations is not pleadable in bar of a subsequent action for infringement by the owner of the patent. *Sessions v. Romadka, 59 O. G. 939, C. D. 1892.

51. Where a bankrupt purposely leaves out of his schedule of assets certain property which he regards as unproductive and valueless, and his assignee in bankruptcy is a whole year winding up the estate and gives no sign of his wish to assume the property, *held*, in view of all the facts, a plain election within the discretion of the assignee not to accept the property, and that a transfer by the party himself some time subsequent to the winding up of his affairs vests a good and valid title in the purchaser. *Id.

(*Held*, under section 5046, Revised Statutes, a right to the patents of the bankrupt vested in the trustee by virtue of his appointment. *Carver v. Peck (1881), 131 Mass. 291; *Prime v. Brandon Mfg. Co. (1879), 16 Blatch. 453, 4 Bann. & Ar. 379.

Held, the trustee's right was superior to that of an assignee of record whose assignment was made by the bankrupt after the bankruptcy. *Id.)

IX. Disputed Title.

(See Patents—Issue to Assignees.)

52. While the commissioner is authorized to recognize formal legal assignments, and when they have been filed in the patent office before patent issues may give the assignee control of the management and prosecution of an application and direct the patent to issue in the name of the assignee, yet he cannot recognize equitable rights under executory or other equitable contracts; but where the relief asked, as in a petition for rehearing, is founded upon an alleged state of the title to the invention, the commissioner possesses the power to determine the allegation as to title in order to exercise his discretion in granting or refusing the relief. McDonough v. Gray, 46 O. G. 1295, C. D. 1889.

53. When an instrument is presented for record, the only thing to pass upon is whether it, upon its face, does in fact affect the title. If it does, and is accompanied by a proper fee, the commissioner's plain duty is to record it, and the parties affected unfavorably are to seek their remedies in the courts. Ex parte Thompson, 40 MS. D. (1 G. W. D.), Aug., 1889 (Fisher, Acting Com'r).

54. The commissioner of patents has no judicial authority to take action in disputed questions of title under an assignment. Ex parte Gallatin, 59 O. G. 1104, C. D. 1892.

55. The patent office cannot determine private rights under assignments. An assignment, regular on its face and regularly recorded, must be considered an absolute assignment until canceled by the written consent of both parties, or by the decree of a competent court. Ex parte McFarlane, 76 O. G. 1418, C. D. 1896, and Ex parte Nichols, 80 O. G. 1891, C. D. 1897.

X. Recording and Identification.

56. An assignment should be identified by date of execution. Ex parte S. J. Murray, 47 MS. D., May, 1891 (Mitchell, Com'r).

57. 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. *Waterman v. Mackenzie, 54 O. G. 1562, C. D. 1891.

58. The statutes give no authority for recording or otherwise noting on the records of this office a protest against the validity of a previously-recorded assignment. Ex parte Backus Portable Steam Heater Co., 58 O. G. 385, C. D. 1892.

59. The office acts in a ministerial capacity in recording assignments and has no authority to enter upon a judicial inquiry as to their validity. Id.

60. Assignments of patents ought always to distinctly describe the patent, and, if the language of the assignment leaves in doubt the question whether the patent was intended to be included, the doubt ought to be resolved against the assignee in suits between him and third parties. *Levy v. Dattlebaum, 63 Fed. Rep. 992 (1894).

61. The court refused to agree that an assignment which does not identify the patent by name, number and date cannot convey a title to the patent. *Id.

62. The statute makes it the duty of the commissioner of patents to record assignments, meaning assignments that are genuine. He has no authority to record a spurious instrument. A spurious assignment recorded in the patent office would not be in law a record of that office. The record of an assignment is in law tantamount to a finding or certificate by the commissioner that the original is genuine. It matters not that the commissioner may act on the mere assumption that whatever paper of this kind is presented for record is genuine. He is a public officer charged by law with the duty of recording only such as are genuine. The law attaches to his act in making the record the *prima facie* presumption that the instrument copied upon his record book is entitled to record—that is to say, is genuine. (The view announced in Mayor of New York v. American Cable R. Co., not acceded to.) *Standard Elevator Co. v. Crane Elevator Co., 77 O. G. 811, C. D. 1896.

63. Section 4898 does not require that any instrument in the chain of title to a patent shall be recorded, but all such assignments may be recorded. The sense, the essential significance and intent, of this section is that the record or official copy of any assignment shall give to any person interested the *prima facie* assurance that an original assignment was made in terms as shown in the record; that such instrument was subscribed as shown; that it was delivered; that the signature thereto is the genuine signature of the assignor, and that such assignor had an assignable interest according to the purport of the instrument. *Id.

64. The record of assignments in the patent

office is a record "belonging to the patent office" within the literal terms of section 892; but in the absence of that section and on the general principles of evidence, a paper purporting to be a copy of a record in the patent office could be proven to be such copy by the sworn testimony of the person who made it or of a person who had compared it with the original record in the patent office. *Id.

(Recording is only necessary as notice to strangers. Case v. Redfield, 4 McLean, 526. As to requirement for identification, see Wright v. Randel, 19 Blatch. 945.

Two classes of record books are used in the patent office for assignments, namely: "Transfers of patents" *and* "Irregular transfers of patents." "The former contain all writings affecting the title of an invention or patent, whether an assignment, grant, license, injunction, power of attorney to sell, etc., where the inventor's name is given. The latter contain similar writings, but where the inventor's name is not known." Assignments which do not unmistakably identify the applications they are intended for are held unrecorded, and the parties filing the same so notified. (See Offi. Gaz. of *May 1, 1883.*) *Identification can be made by date of execution or date of filing of the application or its serial number.*

No deed can be recorded *nunc pro tunc.*)

ASSISTANT COMMISSIONER OF PATENTS.

(See JURISDICTION OF.)

ATTORNEYS.

I. ATTORNEYS AND POWERS.
II. DISBARMENT.

I. ATTORNEYS AND POWERS.

1. An applicant has an undoubted right to revoke a power of attorney and nominate another attorney. (Ex parte Morley, 37 O. G. 337.) Ex parte Brewster, 33 MS. D., Feb., 1887 (Montgomery, Com'r).

2. The protest of an attorney against revocation of his power by the applicant, based on an oral agreement by which he was to receive an interest in the patent, held unavailing, there being no written assignment and no legal interest. Ex parte Nicholson, 34 MS. D., April, 1887 (Hall, Com'r).

3. An "associate attorney" cannot be nominated by an applicant without the consent of the *regular* attorney. Ex parte Ranks, 38 O. G. 329, C. D. 1887.

4. The regular course would be for such principal attorney to nominate his associate upon the written authorization of his client. Id.

5. The nomination of an "associate attorney" made by applicant without the consent of the principal attorney cannot be recognized or acted upon. Id.

6. When two or more attorneys are empowered to act in a case, the applicant should designate with which correspondence should be held. Ex parte Jewett, 38 O. G. 781, C. D. 1887.

7. Failing to do this, the office will, if either reside in this city, recognize the resident attorney. Id.

8. Practitioners before the patent office are not required to be learned and experienced lawyers, or to possess any special qualifications. Consequently greater indulgence should be shown applicants in matters touching the management and presentation of their cases. While the rules and practice of courts of equity govern here as far as applicable, cases may arise in which they should not be rigidly enforced. Osgood v. Badger, v. Bennett, 44 O. G. 1065, C. D. 1888.

9. The attorney appointed by an inventor who has assigned his interest is recognized in conduct of the case until the assignee asserts his right to appoint another. Ex parte Baker, 49 O. G. 1363, C. D. 1889.

10. Until an assignee of the entire invention asserts his right to hold correspondence with the office to the exclusion of the inventor, it is the practice of the office, to be deviated from only in exceptional cases, to recognize a correspondingly exclusive right on the part of the attorney of the inventor. Id.

11. Where it appeared that an appeal, taken under rule 147 by counsel who had repeatedly appeared in the case, was taken in season and with authority of appellant, and the appeal fee had been paid and accepted by the office, such appeal was not dismissed simply because the power of attorney of said counsel had not been filed, as called for by rule 18, and the attorney of record was permitted to sign the appeal *nunc pro tunc.* Pituey v. Smith & Egge, 49 O. G. 129, C. D. 1889.

12. An attorney appointed by a person holding under an assignment granting all right, title and interest save as to a certain combination set forth in the instrument, will not be recognized in the prosecution of the application. Ex parte Hunter, 56 O. G. 929, C. D. 1891.

13. Where one of two joint applicants subsequently files a sole application for the same improvement, a power of attorney, executed by the other of the joint applicants and their assignee, will be accepted by this office as sufficient in the joint case. Ex parte Benjamin and Bailey, 59 O. G. 298, C. D. 1892.

(NOTE.—This decision has not affected the practice of the office in refusing to recognize in a joint application a power of attorney given by one of the joint applicants.)

14. It is not ordinarily within the discretion of the commissioner of patents to prevent revocation of a power of attorney by an applicant. Ex parte Gallatin, 59 O. G. 1104, C. D. 1892.

15. Where objection was made to the validity of a patent because of an amendment made by the attorneys after the applicant's death, no new power of attorney having been filed at the patent office and no administrator having intervened and filed a new oath, *held*, (1) the amendment was within the scope of the original specification and required no new oath; (2) it appearing that the attorneys had power in fact to act, and that their acts were subsequently ratified by both administratrix and assignee, the amendment did not invalidate the patent. (Distinguishing Eagleton Mfg. Co. v. West, 27 O. G. 1237, 111 U. S. 490.) *De La Vergne Refrigerating Machine Co. v. Featherstone, 62 O. G. 741, C. D. 1893.

(NOTE.—In an opinion delivered by the assistant secretary of the interior department, John M. Reynolds, under date of September 4, 1894, addressed to William Lochren, Commissioner of Pensions, it was held that "where a firm of attorneys has been prosecuting a claim for pension, and before the completion of the claim one of said attorneys dies, the surviving partner will not be required to obtain a new power of attorney in his own behalf to entitle him to recognition in such claim, but he will be allowed to complete the same in the name of the firm." (*Vol. 8, Pension Decisions, p. 280.*) The above doctrine had been practically applied (by Ass't Com'r S. J. Fisher) in at least one case in the patent office.)

In a previous case it was held that where an attorney dies, leaving pension claims pending which he was entitled to, his personal representative will not be recognized to complete such claims. In re J. Ambler Smith, Attorney, deceased—Sam. H. Lewis, Administrator, vol. 7, p. 69.)

16. The assignee of an entire interest may control the appointment and dismissal of an attorney to the exclusion of the applicant; but when an applicant joins with an assignee of less than the whole interest, or with the grantee or a licensee, in making a power, it will require the co-operation of both to revoke it. Ex parte Anderson, 62 O. G. 449, C. D. 1893.

17. When an applicant alone makes a power of attorney he may revoke and appoint anew, to the exclusion of every one except the assignee of the whole interest. Id.

18. It is the uniform practice of the office in a case of dispute between an attorney and an assignee,—unless he is an assignee of entire interest, unless the power is coupled with an interest, or unless the assignee has joined in appointing the attorney,—to recognize the attorney of the applicant only. Protest of the New Era Iron Works Co., 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

19. A power of attorney given by an alleged assignee will not be entered in a case where the assignment fails to properly identify the application. Ex parte Rudolph Chillingsworth, 62 MS. D. 1, July, 1897 (Greeley, Ass't Com'r).

20. A power of attorney, coupled with a promise to pay to the attorney ten per cent. of all money received for the invention, does not give him such an interest in the invention as to render the said power of attorney irrevocable, since, although such power was given for valuable consideration, the interest which the attorney has in the invention exists *in futuro*, and is an equitable, not a legal, interest. Ex parte Firsching, 80 O. G. 1272, C. D. 1897.

II. DISBARMENT OF.

21. The relation which a patent solicitor sustains to the commissioner of patents is not the same as that which a member of a bar sustains to a court. The commissioner is not a member of the judiciary, practitioners are not members of a court of which the commissioner is judge, nor does the commissioner have the authority or jurisdiction of a judge in a similar proceeding. In re John Wedderburn and John Wedderburn & Co., 81 O. G. 159, C. D. 1897.

22. The respondent corporation having by advertisements, by their pamphlets and letterheads, and by the whole tenor of their correspondence with clients, put themselves before the public as patent attorneys, cannot be heard to deny that they are in fact subject to the jurisdiction of the commissioner simply because they are in fact a corporation not legally competent to practice law. Id.

23. In proceedings under a rule to show cause why an attorney should not be disbarred, it is not necessary that the rules of evidence applicable in criminal proceedings be strictly observed, such proceeding being in its nature civil. (Ex parte Wall, 107 U. S. 265.) Nor is it

necessary in proceedings of this nature that offenses be proved beyond a reasonable doubt. It is sufficient if the investigation be conducted with fairness and the respondents be afforded ample opportunity to explain the transactions on which the charges were based and to vindicate their conduct in reference thereto. (Randall v. Bingham, 7 Wall. 523.) Id.

24. Since disbarment proceedings in this office are not *quasi*-criminal in character, the failure of a respondent in such proceedings to appear and testify in his own behalf, as well as his failure to exhibit to the inspection of the office the organization and details of his business, may properly be made subjects for consideration in arriving at a conclusion. Id.

25. When an attorney is charged with dishonest practices before this office, since the character of such practices is peculiarly within his own knowledge, it is not only competent for him to testify concerning them, but it is his duty to himself, to the patent office and to the public to show, if he can, that such practices are legitimate and proper. Id.

26. It appearing that while applications for patent were filed in the name of J. W. as attorney all correspondence with clients was carried on in the name of the corporation, J. W. & Co., J. W. being the president thereof, J. W. is to be considered as merely the agent of the corporation, and the corporation must and should be held responsible for his acts. Id.

27. The name of J. W. having appeared continuously since 1893 on papers filed in this office, he cannot be presumed to be ignorant of the requirements of attorneys or agents practicing before this office. As president of the corporation he must be held to have been cognizant of and responsible for whatever has been done by the corporation or its employees. Id.

28. If it were true that a solicitor might falsely and deceitfully obtain business from clients, might utilize the offer of the government to grant patents to defraud citizens, might advise the public falsely that advice would be given free, and might fraudulently induce clients to intrust the prosecution of claims to him without notice of such things being taken by the head of the proper department, the result would be the organization of combines of confidence men to plunder the public. It is the duty of the head of each department to protect the public in its relations to such department. Id.

29. A prize competition open only to those who have paid money to the respondents clearly has nothing philanthropic or generous about it, is not intended for broadly stimulating invention, but is intended solely to boom respondents' business. It is necessary to a fair competition that the jury or board of awards should be impartial, disinterested men, competent to decide on the merits, and it is also necessary that such jury or board should see and examine the invention submitted. To permit the merit of inventions to be finally passed upon by inexperienced and incompetent searchers is to make the competition a mere farce and a fraud. Id.

31. An offer to advise free as to patentability and salability of any device a supposed inventor who had failed to respond to J. W. & Co.'s first letter with its accompanying papers, in view of the fact that the advice given was a mere statement that the device was of a patentable nature, but to determine its patentability a search at a cost of five dollars would have to be made, and a statement that a successful device of this nature, if patented immediately and properly handled, would net its owner not less than so many thousand dollars, is deceptive and a mere trick to reopen correspondence with the inventor to lead him on to send fees to J. W. & Co. Id.

32. It is the duty of an attorney to report the result of a search fully and correctly to the inventor. A false and misleading report upon a search is as grossly deceptive as such a report would be if no search had been made. When references exist which approach the invention so closely as to throw doubt on the advisability of taking out a patent, they should be called to the inventor's attention, even though they do not completely anticipate. Id.

33. The failure to revise the favorable reports of unskilled searchers indicates reckless disregard of the rights of clients, indifference to the agreement as to the character of the search, and intended fraud. It was the duty of respondents to have had reports made under such circumstances revised. Id.

34. The respondents were bound by their agreement with their clients to have searches made properly. Their failure to do so is gross and inexcusable negligence. They must be held responsible for the acts of their employees in making these searches, particularly as the system under which the searchers worked was of respondents' creation. Id.

35. The sending of favorable reports by personal direction of J. W. in cases in which ref-

erences had been found by searchers, without waiting to obtain copies of these references, was nothing less than a deliberate fraud upon the clients and amounts to gross misconduct. Id.

36. A report of search which, while citing an anticipating reference, included a request to send on money for fees, and a promise, on receipt of fees, to prepare the necessary application papers and an offer to find a purchaser, is not an unfavorable report and was not intended to be understood by the client as an unfavorable report. It is upon its face a deceptive and fraudulent report. It was intended to deceive and mislead the client. Its use, followed up by the acceptance of fees for the preparation of application papers, is clearly gross misconduct. Id.

37. The propriety of an attorney or solicitor of patents combining the business of soliciting with that of selling pateuts is questionable. Doubtless it may be done honestly; but propositions for undertaking the sale of inventions which require the payment of a fee in cash in advance are justly condemned. Id.

38. Advice to take out foreign patents should be given to clients only in those cases in which it is clear that such patents will be of advantage to the clients. In cases in which the invention is not patentable, the advice to take out foreign patents presents a plain case of attempt to defraud the client for the benefit of the attorney. That this is gross misconduct is not open to question. Id.

39. Studious concealment from the client of the true condition of his case, or positive misrepresentation of the condition of the case, in each case representing the coudition of the case more favorably than the facts justified, while at the same time the attorney is urging the taking out of foreign patents or the payment of fees to the attorney for advertising the invention for sale, is gross misconduct. Id.

40. An attorney is bound to inform his client of such steps in the progress of the case as he should know, and he should at least tell the truth and treat his client with candor when he does inform or advise him in regard to his case. If he does not do so, and is at the same time urging further expenditure of money for purposes which he knows cannot result in advantage to the client, his misrepresentation of the condition of the case is conclusive evidence of fraud. Id.

41. A letter merely stating to a client that his application is finally rejected and the only course open is to appeal, without explanation of the references, information as to the grounds of the rejection, or advice as to the wisdom of appealing, such as a capable and honest attorney is bound to give his client, is not such a letter as in fairness and justice to clients should be written. Id.

42. An attorney is employed because he is of greater skill and experience in prosecuting applications than his client. He is bound to give his client the advantage of his skill and experience. When he not only fails to do so, but omits that duty for an unworthy purpose, he is guilty of gross misconduct. At so critical a period in the case as that at which the question of appeal has to be considered, the client is entitled to the best information and the best judgment of the attorney. Id.

43. For persons who represent themselves to be attorneys of experience in practice and skilled in patent matters to accept appeal fees in cases in which they know there was nothing patentable and appeal would be useless, without hesitation or explanation, purposely keeping the client in ignorance of the true significance of the examiner's rejection and thus misleading them as to the possibility of favorable action on appeal, is gross misconduct. Id.

44. An attorney who, after repeated assurances to his client that he would do his best on the appeal, fails to appear to argue the case orally and fails to even file a written brief, is guilty of gross negligence. Id.

45. To award an inventor a silver medal and to state to him that his invention is of special merit and promises to be exceedingly profitable, when the invention is known to be unpatentable and therefore worthless, and to subsequently accept fees for the preparation of an application therefor, shows that the medal was sent intentionally and for a definite purpose, and such award is deceptive and fraudulent and amounts to gross misconduct. Id.

46. Even if the silver medals had been sent only in those cases on which favorable reports had been made by the searchers, the fact that such medals, together with the accompanying award-letter, were sent in eleven thousand cases shows that many inventors whose inventions were in no sense remarkable, in no sense valuable, and in no sense such as would be selected by any competent or honest board of awards, received these medals, and that the

respondents in sending medals in these cases were guilty of grossly deceiving a large number of their clients. Id.

47. It appearing that in each of twenty cases $5 more than the fees agreed on was asked for and paid to the respondents and not returned by them, *held*, that this excess could not have been called for by mistake, and it is not seen that the retention of this excess is anything less than petty cheating. Id.

48. An attorney who files several successive applications for the same unpatentable invention, in behalf of different clients to whom he has successively reported such invention patentable, is either grossly negligent or has committed a grave offense against law and morals. Id.

49. Persons in the employ of an attorney who has been engaged in fraudulent practices, when, being in responsible positions, they have co-operated and assisted in carrying forward such practices, and when, in view of prior experience, such persons must be presumed to have been aware of the nefarious nature of such practices, must be held to be sharers in his guilt and with him be held unfit to practice before this office. Id.

50. Section 4 of the act of July 4, 1884, applies to agents or attorneys before the patent office as well as before the other bureaus of the interior department. *United States ex rel. Wedderburn v. Bliss, Secretary of the Interior, 81 O. G. 1783, C. D. 1897.

51. The proper construction of section 487 of the Revised Statutes is that a person to be disbarred is entitled to notice of the charges against him and an opportunity in some form to be heard in relation thereto prior to any decision of the commissioner or approval by the secretary. Any other construction would render the section void, as being in conflict with that part of the fifth amendment to the constitution which provides that no person shall "be deprived of life, liberty or property without due process of law," and this is the construction very properly given that section by the commissioner of patents and the secretary, as shown by the practice under it. *Id.

52. The only difference between section 487 of the Revised Statutes and section 5 of the act of July 4, 1884, is that the act of July 4, 1884, directs that the order disbarring an agent or attorney from practicing before the patent office shall be made by the secretary of the interior, while section 487 provides that it shall be made by the commissioner of patents with the approval of the secretary. The only substantial difference between the two sections is that section 5 applies to all the bureaus of the interior department, while the section of the Revised Statutes applies only to the patent office. *Id.

53. Where an agent was furnished with a copy of charges made against him before the commissioner of patents as to why he should not be disbarred from practicing as a patent agent, and he had a hearing before the commissioner of patents on these charges and the commissioner recommended that he be disbarred from further practicing as an agent or attorney, and the secretary approved the reasons given by the commissioner of patents without affording the agent a hearing before him in person, *held*, that the refusal of the secretary to hear oral argument was not arbitrary, oppressive or unjust and the proceeding before him was conducted under "due process of law." *Id.

54. The proceeding before executive and ministerial officers and special tribunals exercising *quasi*-judicial powers in order to constitute due process of law need not be as formal as in courts of justice or conducted after the manner of proceedings in such courts. What would be due process of law before such officers and tribunals might not be considered such in a court of justice. What is due process of law in a particular case depends largely upon the nature and object of the proceeding, the duties and the jurisdiction of the officer or tribunal, and the nature of the right or immunity to be affected by the proceeding. If the mode of procedure be such that the party to be affected has an opportunity of presenting to the officer or tribunal in any reasonable way his contention as to the facts and merits of the question to be determined, the proceeding is due process of law; but if the determination be made in an arbitrary, oppressive or unjust manner so that the party to be affected has no reasonable opportunity for hearing, then the proceeding and determination are void because not due process of law. *Id.

55. Upon a demurrer to the petition for writ of *mandamus* to compel the secretary to grant a hearing in person to a patent agent whom the commissioner had recommended to the secretary for disbarment, the reasons for which recommendation the secretary had approved without a hearing before him in person, *held*, that the demurrer should be sustained, the rule to show cause discharged. and the petition for writ of *mandamus* dismissed. *Id.

CANCELLATION OF PATENT.

1. The court, adopting the conclusions of Judge Shepley, of the same circuit (Attorney-General v. Rumford Chemical Works, 2 Bann. & Ard. 298, 9 O. G. 1062, C. D. 1876, 391), are of the opinion that the government, in the absence of any express enactment, has no power to bring a bill to cancel a patent. *United States v. American Bell Telephone Co., 41 O. G. 123, C. D. 1887.

(Decision of U. S. Cir. Ct.—Dist. of Mass.)

2. The constitution and acts of congress cover all the rights and remedies of patentees, and under the constitution congress could have provided for suits to cancel patents; but congress has not made such provision. *Id.

3. The history of patent legislation under the constitution tends to show that congress never intended to include suits to annul patents under the present patent laws. *Id.

4. The power to bring *scire facias* under the acts of 1790, 1793, to cancel patents was limited to patents obtained surreptitiously or upon false suggestion, and by the act of 1836 and the terms of the patent law as it now stands and has been construed by the supreme court the same defenses may now be made in a suit for infringement as were grounds for the cancellation of a patent under the acts of 1790, 1793. *Id.

5. The power of the government to bring suit for the cancellation of a patent does not exist by implication springing from the general principles of equity jurisprudence arising out of the procedure in England, because the foundation of the patent system in England differs from that in the United States, the one being a matter of royal favor, the other of constitutional statutory provisions. *Id.

6. The decisions of the courts upon canceling patents for lands do not apply to patents for inventions, because the government is the owner of the public lands, while patents for inventions are based on statutes, and the inventions described in them never belonged to the United States. *Id.

7. In the various suits for the cancellation of patents for lands in the circuit courts such patents have been repealed for fraud, error or mistake, and the same is not limited to cases in which the United States has a direct pecuniary interest. *United States v. American Bell Telephone Co., 45 O. G. 1311, C. D. 1888.

(Decision of U. S. Sup. Ct.)

8. In both instances the essence of the right of the government to interfere is the obligation to protect the public from a grant procured by fraud. *Id.

9. In this case, although the court was called upon only to decide that an individual could not bring a suit to repeal a patent, the reason given for so doing must be held to establish the principle that the individual could not bring such suit, because the government alone could do so. *Id.

10. The United States in granting patents to Bell, if the same were granted improperly, took away enormously valuable rights from the people and conferred them upon the patentee. The government that did this wrong to the people certainly had the right to correct the error of its own officers, and the way for doing so seems clearly to be by suit in equity. *Id.

11. The broad and conclusive effect of a decree to repeal a patent is so widely different, so much more beneficial, and so much more likely to secure complete justice than any defense made by an individual infringer that it is impossible that congress in granting certain rights to the individual intended to supersede or take away the more enlarged remedy of the government. *Id.

12. Letters patent No. 463,569, granted November 17, 1891, to Emile Berliner, for a combined telegraph and telephone, cannot be declared invalid on the ground that the delay of the application in the patent office for thirteen years was unlawful and fraudulent. United States v. American Bell Telephone Co. and Emile Berliner, 79 O. G. 1362, C. D. 1897.

13. Congress has established a department with officials selected by the government to whom all applications for patents must be made, has prescribed the terms and conditions of such applications, and intrusted the entire management of affairs of the department to those officials. When an applicant for a patent complies with the terms and conditions prescribed and files his application with the officers of the department, he must abide their action, and cannot be held to suffer or lose rights by reason of any delay on the part of those officials, whether reasonable or unreasonable, unless such delay has been brought about through his corruption of the officials, or through his inducement, or at his instance. Proof that they were in fault, that they acted unwisely, unreasonably, and even that they were culpably dilatory, casts no blame on him and abridges none of his rights. *Id.

14. Before the government is entitled to a

decree canceling a patent for an invention on the ground that it had been fraudulently and wrongfully obtained it must establish the fraud and the wrong by testimony which is clear, convincing and satisfactory. *Id.

15. When the evidence does not tend to show any corruption by the applicant of any of the officials of the department or any undue influence exerted by it upon them, and, on the other hand, does affirmatively show that it urged promptness on the part of such officials and that the delay was the result of the actions of those officials, no presumption of fraud arises. *Id.

16. If circumstances show that there were reasons for official delay in the prosecution of an application, even though they do not make it clear that such delay was wholly justified, such reasons deserve consideration. *Id.

17. Suits may be maintained by the government in its own courts to set aside one of its patents, not only when it has a proprietary and pecuniary interest in the result, but also when it is necessary in order to enable it to discharge its obligations to the public, and sometimes when the purpose and effect are simply to enforce the rights of an individual. In the former cases it has all the privileges and rights of a sovereign. The statutes of limitation do not run against it. The laches of its own officials does not debar its right. But when it has no proprietary or pecuniary result in the setting aside of the patent, is not seeking to discharge its obligation to the public, when it has brought the suit simply to help an individual, making itself, as it were, the instrument by which the right of that individual against the patentee can be established, then it becomes subject to the rules governing like suits between private litigants. *Id.

18. The objection to the validity of a patent on the ground that it was already covered by another patent is a defense which, under the statutes (sec. 4920, R. S.), is open to every individual charged by the patentee with infringement, whether the proceeding against him be an action at law or a suit in equity. The government, therefore, if seeking simply to protect the right of an individual, ought not to be permitted to maintain a suit to cancel that against which the individual has a perfect legal defense available in any action brought by or against him. *Id.

19. It is unnecessary to determine whether there are two separate inventions in the transmitter and the receiver, or whether the patent of 1891 is for an invention which was covered by the patent of 1880. The judgment of the patent office, the tribunal established by congress to determine such questions, was adverse to the contention of the government, and such judgment cannot be reviewed in this suit. *Id.

CAVEAT.

1. The examiner refused to receive a caveat for a design, knowing that there was no law authorizing the filing of caveats for designs. Applicant petitions the commissioner to direct that the filing-fee be returned to him. Section 4902 of the Revised Statutes, providing for the filing of caveats for any new invention or discovery, does not apply to the subject of designs, nor is there any statute authorizing the filing of caveats for this class of inventions. Ex parte Carty, 44 O. G. 570, C. D. 1888.

2. A design invention covers the form, contour or ornamentation, and such design cannot exist in an incomplete condition. A patent when issued covers all the dominant and controlling features, all the distinct and segregable parts. Petition granted and fee ordered to be returned to applicant. Id.

3. Decision in Ex parte Kenney (C. D. 1869, 97) considered and modified and the following practice directed: Whenever an application is filed showing subject-matter interfering with any pending caveat, the notice which the statute provides shall be sent to the caveator should be sent at once and not delayed until the invention shall have been favorably passed upon and the application found to be ready for allowance. Ex parte Ward, 46 O. G. 1513, C. D. 1889.

4. The statute confers no rights upon the caveator, nor does it give him any status in the office as an applicant. It extends, as matter of grace, to him the right to be notified of the pendency of an application relating to the subject-matter of his caveat. It is not intended that he shall have the benefit of an examination of his caveat before he has filed an application, which substantially results when the notice is withheld until the patentability of the invention of another applicant is determined. Id.

5. A caveator should not be allowed to delay issuance of a patent to an applicant who has diligently prosecuted his application. Id.

6. The statute authorizing the filing of a caveat does not intend to confer upon the caveator any right as an inventor, nor to save him

from the effect of negligence or give him any advantage over any other inventor who has conceived the invention and prosecuted his application with diligence. The statute authorizing a caveat does not compel a caveator to file any application. It is not intended as a stimulus to prod and drive him to perfect his invention, nor is it intended to extend the time in any manner within which he may complete the invention; but it simply provides as matter of grace that the caveator shall be notified of the filing of any application which comes into the office within a year, covering the subject-matter of his caveat. Elges v. Miller, 46 O. G. 1514, C. D. 1889.

7. *Held*, that the law does not require that a caveat shall give a complete and accurate description of the construction and details of an invention. Green v. Hall, v. Siemens, v. Field, 47 O. G. 813, C. D. 1889.

8. After a caveat has been filed by joint caveators and afterward an application for the same invention is filed by one of the caveators, and a written abandonment of the caveat has been filed, it is improper to require him to furnish evidence showing that he is the sole inventor. Ex parte Drury, 56 O. G. 1447, C. D. 1891.

9. Section 4902 of the Revised Statutes provides for the filing of caveats and limits their operative term to one year; but it does not limit the condition of secrecy on the part of the office to that term. Ex parte Pollok, 59 O. G. 939, C. D. 1892.

10. Under the provisions of section 4902 of the Revised Statutes the commissioner has no power to extend the time within which a caveator may avail himself of his caveat, by filing an application for patent, beyond three months from the time of placing the notice in the post-office at Washington, with the usual time required for transmitting it to the caveator added thereto. Ex parte Moore, 63 O. G. 463, C. D. 1893.

11. A caveator is not entitled to notice of the renewal of an application originally filed before the caveat, although such renewal was made during the life of the caveat. Ex parte Graves, 65 O. G. 2059, C. D. 1893.

12. Change of the filing date of a caveat refused, where, in payment of the fee, petitioner's attorney had returned unindorsed a draft received from the office and which had stood to his credit. Ex parte Sullivan, 58 MS. D., Feb., 1896 (Fisher, Ass't Com'r).

(A caveator is entitled to notice after expiration of the caveat in the case of an application filed during the term of the caveat but whose patentability was decided subsequently. In re Kenney, C. D. 1869, p. 97.

A caveator should be notified in the case of an application filed the same day as his caveat. In re Essex, 9 O. G. 497, C. D. 1876.

It is sufficient if a caveat is signed by but one of two or more joint inventors. In re Gray, 12 O. G. 396, C. D. 1877.)

CLAIMS.

(See PATENTABILITY; PATENTS.)

I. ALTERNATIVE.
II. ARTICLE DEFINED BY PROCESS.
III. DUPLICATE OR REDUNDANT.
IV. FOR EQUIVALENTS.
V. FUNCTIONAL AND INDEFINITE.
VI. GENUS AND SPECIES.
VII. "MEANS," "MECHANISM," ETC.
VIII. REINSTATEMENT OF.
IX. "SUBSTANTIALLY AS DESCRIBED;" "AS SHOWN AND DESCRIBED."

I. ALTERNATIVE.

1. A claim having the phrase "one or more" is alternative in form, if the elements covered by such phrase are not duplicates. Ex parte Hulbert, 63 O. G. 1687, C. D. 1893.

2. When the alternative devices specified in the claim are duplicates, an objection of alternativeness to the form of the claim is apparent rather than real, and therefore should not be made. Ex parte Thorsen, 63 O. G. 1688, C. D. 1893.

3. Ex parte Hulbert (63 O. G. 1687) referred to and the distinction between it and the present case pointed out and defined. Id.

4. A claim in which several elements are recited, and containing the clause "whereby a dynamo or telegraph sounder may be made as desired," is not alternative. The result only is alternative. Ex parte Crowell, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

II. ARTICLE DEFINED BY PROCESS.

5. A claim for an article of manufacture should not, as a rule, be defined by the process of producing it; but when an article of manufacture is a new and useful thing and embodies invention and cannot be properly defined except by reference to the process of producing it, a case is presented which constitutes a proper exception to the rule. Ex parte Painter, 57 O. G. 999, C. D. 1891.

III. Duplicate or Redundant.

6. Where a simple invention is made the subject of numerous claims, differing in mere methods of expressions, 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 defense of a needless multiplication of claims. Ex parte Johnson, 54 O. G. 505, C. D. 1891.

7. The question of redundancy or multiplicity of claims is one of form and not one involving the merits; hence the proper remedy is by petition to the commissioner. Ex parte Sawn, 54 O. G. 1561, C. D. 1891.

8. The matter to be determined is not whether the several claims standing alone would be patentable as against the public. It is conceivable that each one of the claims standing alone would be an entirely valid claim, and yet that sound principle would require that not all of them should be allowed. Id.

9. The danger and impropriety of covering the same structure by a number of claims, which can be differentiated only by abstruse and metaphysical distinctions, are apparent. *Brush Electric Co. v. Electrical Accumulator Co., 56 O. G. 1334, C. D. 1891.

10. 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. *Illinois Watch Co. v. Robbins & Avery, 61 O. G. 721, C. D. 1892.

11. Two claims are not, as a matter of form, substantially alike when corresponding elements are set forth broadly in one and specifically in the other and when one includes an element neither actually nor impliedly included in the other. Ex parte Baackes, 63 O. G. 909, C. D. 1893.

(It is admissible to put claims in different forms when one set or form of words would be inadequate to clearly cover the invention and prevent misconception. Ex parte Woodruff, 17 O. G. 433, C. D. 1880.)

IV. For Equivalents.

(See Equivalents.)

12. The words "or equivalent devices" should not be employed in a claim unless such equivalent devices are clearly described in the specification. Ex parte Dolph, 39 O. G. 239, C. D. 1887.

13. When so clearly described, and when the employment of one in the combination and a grant of patent thereon would be a complete bar to the granting of patent for the same combination with the employment of the other, such words are permissible. Id.

(Note.—It is settled practice to allow the term "or equivalent" in a claim only when an alleged equivalent is described, and it must be also illustrated in the drawing save in the exceptional case when it is so common and well known as to be unmistakable.)

V. Functional and Indefinite.

(See Claims—"Means," "Mechanism.")

14. A claim in the following form—The combination of the following elements: mechanism, substantially as described, for . . .; mechanism, substantially as described, for . . ., etc.—covering four groups of mechanism, condemned as indefinite. Claims covering *all* mechanism which will perform the same functions or accomplish the same result are not sufficiently limited or restricted by the words "substantially as described." Such claims would suppress all further improvements in mechanism that could accomplish the same results. The same principles relative to vague and broad claims prevail in original as in reissue applications. Ex parte Paige, 40 O. G. 807, C. D. 1887.

15. Comprehensive terms and phrases to denote mechanical equivalents are regarded as proper, provided when so used they clearly and distinctly express the invention. The words "means" and "mechanism" may be proper where they refer to mere adjunctive devices readily understood; but in claims for combinations of mechanism composed of several elements the words "means" and "mechanism" alone used as defining the element of invention are vague and definite. Id.

16. Applicant claims, broadly, "automatically-operating mechanism to impart alternate fast and slow movements to the driving-shaft" in his needle-grooving machine, but concedes that the principle involved is old, and that this varying movement or motion has been accomplished by an infinite variety of means to an infinite variety of kinds and classes of machinery; but he insists that he is the first in this particular kind of machinery to apply *means* for varying the movement. *Held*, that applicant has only invented improvements upon

mechanism already used to accomplish the same result, and that he must limit his claims to the specific construction by which he obtains this variableness of movement. The courts would undoubtedly construe his patent to cover his specific construction, and to permit such vague and indefinite language in claims would result in misleading the public or in deterring others from entering this particular field of invention, and thus by a species of intimidation applicant would secure a protection to which he is not entitled. Ex parte Miller, 43 O. G. 1346, C. D. 1888.

17. When several old elements are brought into close propinquity, and joint operation is effected by means but for which there would be only aggregation and not a combination, such means are the essential invention, and on a claim for a combination with the old elements and such means the terms "power-actuated transfer mechanism" and "power-actuating mechanism" are indefinite and vague. Such means are not mere adjunctive devices, but become new elements in the alleged combination, and must be properly and clearly described. Ex parte Treat, 44 O. G. 342, C. D. 1888.

18. A functional claim is vague, uncertain and indefinite, and may be incapable of being understood. When the office objects to such a claim it simply says to the applicant, put your claim in intelligible form and it will receive examination on its merits. Ex parte Barrett, 45 O. G. 125, C. D. 1888.

19. The objection that a claim is functional is one of indefiniteness. 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 court would adjudge it so. In their desire, however, to save a patent the courts might construe and hold it to be a claim for the members or elements set out, if set out with sufficient certainty, which does not seem to be the case in the present claim. Hence, the office in insisting upon its rights to require claims to be framed with sufficient certainty and definiteness acts not only in protection of the public, but as a friend and adviser of the applicant. Id.

20. No general rule can be laid down for governing the employment in the claims of patents of such words as "means," "mechanism" and "appliances." It is the object of the law, as it is the solicitude of this 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 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. Ex parte Pacholder, 51 O. G. 295, C. D. 1890.

21. While the statute as interpreted by the courts is not inconsistent with the allowance of the controverted claims, yet the tendency to employ in claims such words as have been under consideration should not be encouraged. Id.

22. Where in a claim the language qualifying the word "means" was employed to set forth function and contained no limitation whatever in respect to the 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 claim was vague and indefinite and should not be allowed. Id.

23. 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 claim was not vague and indefinite. Id.

24. Words and phrases in combination claims which ascribe functions to enumerated elements do not ordinarily make the claims functional. Houchens and Marr, 41 MS. D. (1 G. W. D.), Sept., 1889 (Mitchell, Com'r).

25. The specification of function in claims frequently promotes definiteness, but when the claim is so drawn as to ignore construction and cover any and every device which will accomplish the same result, it is functional. Ex parte Raymond, 41 MS. D. (1 G. W. D.), Oct., 1889 (Mitchell, Com'r).

26. Functional claims are, first, those covering a function, result or effect not a product or composition of matter; second, those covering the function of a machine or apparatus; third, those reciting the functions of elements and not their structure; and fourth, those defining sets of mechanism by statements of the results produced. Ex parte Knudsen, 72 O. G. 589, C. D. 1895.

27. Claims of the first class are usually participial in form. *Held* not to be patentable and

should be rejected. (Ex parte Simonds, C. D. 1870, 23; Ex parte Hahn, C. D. 1875, 107; Rob. on Pat., vol. 2, sec. 518, notes.) Id.

28. Claims of the second class are in the form of methods or processes or equivalent expressions. *Held*, should be rejected. (Corning v. Burden, 15 How. 252; Rob. on Pat., vol. 2, sec. 529, notes.) Id.

29. Claims of the third class define the construction as "means," "mechanism" or "devices" for effecting certain results, or define certain named elements or the device by statements of function instead of structure. *Held*, should be objected to if vague or indefinite, or rejected on references disclosing the combination and the functional qualifications, or both. (Ex parte Pacholder, 51 O. G. 295; Morley Sewing Machine Co. v. Lancaster, 47 O. G. 267; Ex parte Halfpenny, 53 MS. D. 489.) Id.

30. Claims of the fourth class define sets of mechanism by the results produced. *Held*, should be objected to and receive action on their merits. (Smith & Egge Mfg. Co. v. Bridgeport Chain Co., 56 O. G. 1449.) Id.

(A functional claim is properly one that has for its subject the performance of an act merely, and not the means by which that act is executed. In re Hahn, 8 O. G. 597, C. D. 1875.)

VI. Genus and Species.

(See Examination of Application—Rejection; Amendment of Application—Election and Division; Division of Application.)

31. Generic and specific claims distinguished from claims for mere improvements upon or additions to an invention which may be generically claimed. Ex parte Smith, 44 O. G. 1183, C. D. 1888.

32. 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 the invention. But more than this he is not entitled to do. If applicant can comprehend in some one form of expression the patentable novelty which is common to all of the forms shown and described, he is entitled to employ that expression to cover the generic invention. Ex parte Cook, 51 O. G. 1620, C. D. 1890.

33. An invention embodied in a given structure and restrictedly claimed does not become a different invention when claimed more broadly or generically. Ex parte Edison, 54 O. G. 263, C. D. 1891.

34. Claims which are specific are not severable from so-called fundamental or generic claims, since they are distinguishable only in respect to scope, and are not for different parts of the machine. *Fassett v. Ewart Mfg. Co., 58 Fed. Rep. 360 (1893).

35. A claim covering a combination of elements is not objectionable in form because the terms employed to designate one of such elements are broad enough to cover either of two devices that differ in structure and mode of operation, but are shown and described as capable of performing the same function. Ex parte Bancker, 63 O. G. 909, C. D. 1893.

36. Where there are combination claims for the structures, one of the structures being specifically set out, such claims should be regarded as combinations of all the enumerated elements, and not as claims for a part only of the elements contained in them. Ex parte Korff, 64 O. G. 1397, C. D. 1893.

37. An inventor may not regard his invention, at the time it is produced, as any broader than his one specific form, but he has, notwithstanding, a right to a broad claim. Hill v. Hodge, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

38. A pioneer inventor is entitled in his patent to a generic claim, under which will be included every species of the genus, and in addition thereto he is entitled in the same patent to make specific claims for one or more species of the genus. *Von Schmidt v. Bowers, 80 O. G. 347, C. D. 1897.

VII. "Means," "Mechanism," etc.

(See Claims, Functional.)

39. The terms "means" and "mechanism" are not outlawed, but they may be too vague and indefinite to be permissible. Ex parte Paige, 40 O. G. 807, C. D. 1887.

40. When the terms "means" or "mechanism" indicate the essential novel element in a combination, they are too vague and indefinite to be allowed. Such means are not mere adjunctive devices, and must be clearly described. Ex parte Treat, 44 O. G. 342, C. D. 1888.

41. In a claim, "mechanism" to effect a certain result is an element of means. *Brush Electric Co. v. Western Electric Co., 77 O. G. 1273, C. D. 1896.

42. An applicant should be allowed to claim his invention as broadly as possible in view of the state of the art. The use of the term

"means," with the proper qualifying words, is not prohibited by any decision of the office or courts. Ex parte Weaver, 81 O. G. 967, C. D. 1897.

43. Where the idea is clearly stated and the combination or relation of parts to produce a desired end is plainly expressed, the breadth of the statement of the claim is no reason for objecting to it. (Ex parte Knudsen, 72 O. G. 589.) Id.

(Claims are too broad when distinguished from a reference only by the terms "means for" and "mechanism by which." Ex parte Denming, 26 O. G. 1207, C. D. 1884.)

VIII. Reinstatement of.

(See Withdrawal from Issue; Amendment after Final Rejection.)

44. A claim canceled upon a requirement for division cannot be reinstated save by due showing of inadvertence, accident or mistake. (Maxim, 43 O. G. 506; Gillette, 44 O. G. 700.) Ex parte Carlton, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

IX. "Substantially as Described;" "As Shown and Described."

45. Claims covering *all* mechanism which will perform the same functions or accomplish the same result are not sufficiently limited or restricted by the words "substantially as described." Ex parte Paige, 40 O. G. 807, C. D. 1887.

46. Where the specification described joining the end caps to the outer shell without flanges or projections by tin joints made by soldering with pure tin, and the patentee testified that he adopted a solder of pure tin and dispensed with rivets, the claim to the fountain as a new article of manufacture "in the manner substantially as described" limited the patent to a fountain in which the caps were connected with the outer cylinder by pure tin solder without rivets or flanges. *Matthews v. Iron Clad Mfg. Co., 42 O. G. 827, C. D. 1888.

47. It is well understood that, while the courts, when construing the validity, scope and extent of the claims in patents, will regard the words "as shown and described" as ever present, and when absent will not construe patents to embrace more than is shown and described, it is the policy of the office while it has control over applications to insist that the form and phraseology adopted and employed by applicants should not be misleading nor unintelligible to the common people who seek to deal with patent property. Ex parte Gerard, 42 O. G. 1235, C. D. 1888.

48. A claim for "The construction of a conically shaped crushing-mill with an eccentric motion as herein described for the purposes and in the manner substantially set forth" is limited to a mill constructed in the manner substantially as set forth, and is not broadly for a conically shaped crushing-mill with an eccentric motion. *Gates Iron Works v. Frazer, 42 Fed. Rep. 49 (1890).

49. Under the closing words of a claim, in this case "substantially as and for the purposes set forth," an element necessary to operation, and on which stress is laid in the description, may be read into the claim or treated as an element thereof by implication. *Alaska Refrigerator Co. v. Wisconsin Refrigerator Co., 57 O. G. 125, C. D. 1891.

50. The words "substantially as specified" in the claim of a patent are to be given effect, and where the claim read literally would be inoperative their effect is to include in the claim elements or devices contained in the specification that are wanting in the claim. *Lee v. Pillsbury, 60 O. G. 1752, C. D. 1892.

51. The words "substantially as described" concern only the specific elements or things stated in the claim, or the combination which is the subject of the claim. (Cases cited.) *McKay & Copeland Lasting Machine Co. v. Claflin, 58 Fed. Rep. 353 (1893).

52. Where the claim is unambiguous and exact, matter in the description cannot be read into it to change its scope, nor do the words "substantially as described" in the claim open the way to the admission therein of matter only incidentally described or mentioned in the description. *Westinghouse v. Edison Electric Light Co., 69 O. G. 1774, C. D. 1894.

53. Where a claim is so broad as to appear to seek to appropriate results or functions rather than the means or devices whereby the results are accomplished, but contains the words "substantially as described," etc., *held*, that the claim ought to be sustained, if possible, by regarding it as restricted to the devices disclosed, and the words "substantially as described," etc., therein as necessarily limiting it to the structure disclosed in the specification. *Columbus Watch Co. v. Robbins, 70 O. G. 132, C. D. 1895.

54. When a patented invention shows but a slight advance upon a previous art, the words in the claims "as herein described" and "as described" must be construed closely. (Cases

cited.) *Davis v. Parkman, 71 Fed. Rep. 961 (1895).

55. When a communication between two parts is desired in a specification, and claimed "substantially as described," it is an essential element of the claim. *Scarborough v. Neff, 76 O. G. 475, C. D. 1896.

56. The phrase "substantially as described" may indicate a particular construction. *Id.

57. The words "substantially as described" may be part of a claim and control its construction. They may not be omitted from the claim in order to give it a broader construction. *Campbell v. Richardson, 78 O. G. 1103, C. D. 1897.

(NOTE.—The phrase "substantially as set forth" is ignored when the admissibility of a claim is made to depend upon it. In re Moule, C. D. 1871, 87; In re Rubens & C., C. D. 1869, 107; In re Collins Co., Assignees, 2 O. G. 617, C. D. 1872; In re Rice, 5 O. G. 522, C. D. 1874.)

COMITY.

(See PRIOR ADJUDICATION; INJUNCTION; PRIOR JUDGMENT.)

1. The courts of one circuit follow the decisions of another covering the same questions upon the same pleadings and evidence. *Worswick Mfg. Co. v. City of Philadelphia, 30 Fed. Rep. 625 (1887).

2. It would be very unseemly for one judge of a circuit court to overrule another judge of the same circuit in the same cause, particularly when the first decision had been adopted in other circuits and had not been reversed by the appellate court. *Bate Refrigerating Co. v. Gillett, 40 O. G. 1029, C. D. 1887.

3. Hammerschlag's patent having been sustained by the courts in a number of contested cases, a proper regard for uniformity of decisions should incline other courts to hold the patent valid against the same, or substantially the same, decisions until all controversy over its validity is put at rest by a decree of the supreme court of the United States. *Hammerschlag Mfg. Co. v. Bancroft, 40 O. G. 1339, C. D. 1887.

4. Where a court, having general jurisdiction of the estates of decedents, has confirmed a sale by an administrator of a right of action for infringement of a patent owned by the decedent, the order thus made is conclusive upon another court, in which an action is brought by such assignee upon such right of action, of the assignee's right to sue, and the latter court will not inquire whether the former court could, under the statutes of the state, legally sell such assets, or whether the original order of sale was broad enough to include the chose in action. *May v. Mercer County, 41 O. G. 815, C. D. 1887.

5. Where a patent has been found to be valid by a circuit court at an earlier date upon the same evidence as now exhibited, and since that date the supreme court has defined more strictly the line between mere mechanical skill and the exercise of invention, it is no longer the duty of the last circuit court to follow and adopt the adjudication of the former court. *Rubber and Celluloid Harness Trimming Co. v. India Rubber Comb Co., 44 O. G. 343, C. D. 1888.

6. The circuit court of the United States for the northern district of Illinois will, under the rule of comity, be governed, as to the infringement of a patent, by prior decisions of other circuits as to the same patent where the proof is the same. *Thompson v. E. P. Donnell Mfg. Co., 50 O. G. 1208, C. D. 1890.

7. The court not able to arrive at the conclusion reached in the case of Consolidated Roller Mill Co. v. Coombs (48 O. G. 255), from the eastern district of Michigan, sustaining the patent to Gray, No. 222,895, notwithstanding the rule of comity which should prevail between the federal courts in cases involving the same patents. *Consolidated Roller Mill Co. v. Barnard & Leas Mfg. Co., 53 O. G. 431, C. D. 1890.

8 Where there was a prior decision in the same circuit as that in which the present case was pending against the complainant, pressing with equal binding force as the decision relied upon from another circuit, *held*, that the rule of comity ought not to be invoked to the same extent as in most cases where it has been applied. *Id.

9. The doctrine of comity does not require a circuit court to enjoin an infringement of a patent on the strength of a decision rendered by another circuit court inconsistent with one of its own decisions in which the same patents were considered. *Pullman Palace Car Co. v. Wagner Palace Car Co., 55 O. G. 715, C. D. 1891.

10. Where a patent has already been construed by the court in an action, that construction must be accepted in another action by the patentee against a third party where no new defenses are interposed. *National Folding Box and Paper Co. v. American Paper Pail and Box Co., 58 O. G. 1844, C. D. 1892.

11. The circuit court for the southern district of New York having adjudicated the validity of the second claim of letters patent No. 171,866, for an improvement in paper boxes (41 Fed. Rep. 139), thereafter granted a preliminary injunction, based upon such prior adjudication, against a third party (48 Fed. Rep. 913), no new defenses having been interposed. *Held*, on appeal to the circuit court of appeals for the second circuit, that the prior adjudication would have the same weight with the circuit court of appeals which it had with the circuit court. *American Paper Pail & Box Co. v. National Folding Box and Paper Co., 61 O. G. 287, C. D. 1892.

12. The rule of comity as between the circuit courts approved; but it does not apply as between the circuit courts and the circuit courts of appeals. The latter courts, while regarding the decisions of the circuit courts with sincere respect, are not bound to follow them, but must base their decisions upon their own independent judgment. *National Cash Register Co. v. American Cash Register Co., 62 O. G. 449, C. D. 1893.

13. A circuit court should follow the decision of another circuit court upholding a patent, except when new evidence of invalidity is introduced, and in the latter event should confine its investigation to the additional evidence. (National Cash Register Co. v. American Cash Register Co., 62 O. G. 449, 53 Fed. Rep. 367, followed.) *Wanamaker v. Enterprise Mfg. Co., 63 O. G. 156. C. D. 1893.

14. The rule of comity between circuit courts in respect to decisions in patent cases does not apply to the circuit court of appeals, and the latter court will examine independently all the questions presented by the record. *Id.

15. The rule of comity is limited to a case involving the same state of facts. (Starling v. Plow Co., 53 Fed. Rep. 119.) *Pratt v. Sencenbaugh, 64 Fed. Rep. 779 (1893).

16. A decision of the circuit court of appeals sustaining the validity of a patent is not conclusive in a second suit in a circuit court of another circuit involving the same patent, where a different defense is made. *Edison Electric Light Co. v. Columbia Incandescent Lamp Co., 65 O. G. 133, C. D. 1893.

17. In a suit for infringement of a patent, where it appears that the courts of other circuits have already sustained the validity of the patent as against all the defenses now made, save that of anticipation by reason of certain patents not before in evidence, and have also found that defendants infringed, the court will accept those decisions and examine only the anticipation alleged. *National Folding Box and Paper Co. v. Phœnix Paper Co., Limited, 65 O. G. 752, C. D. 1893.

18. Upon general questions of law the views of courts of co-ordinate jurisdiction are always regarded with respectful consideration, but never as controlling. In patent causes, however, conclusive effect is accorded by each of the circuit courts of the United States to a prior judgment of any other of them wherever the patent, the question and the evidence are the same in both suits, not on the ground of comity alone, but with the practical and salutary object of avoiding repeated litigation and conflicting decrees in the courts of the several districts upon matters which, having been once passed upon by a court of first instance, ought to be referred to a court of appeal for authoritative determination. (National Cash Register Co. v. American Cash Register Co., 62 O. G. 449, 53 Fed. Rep. 370.) *Office Specialty Mfg. Co. v. Winternight & Cornyn Mfg. Co., 71 O. G. 1918, C. D. 1895.

19. "*Prima facie* a decision founded upon one patent not in suit here and another decision founded upon three patents collectively, one only of which is in suit here, the two decisions declaring that an invention used by a defendant who is not the defendant here against the machine of that defendant differing widely in its structure from the one complained of here, cannot be treated as binding in the decision which this court may feel bound to render in the suit at bar." *Boyden Power Brake Co. v. Westinghouse Air Brake Co., 73 O. G. 1857, C. D. 1895.

20. A federal court follows the rulings of another, especially in patent cases. *National Harrow Co. v. Quick, 76 O. G. 1574, C. D. 1896.

21. The question whether or not a claim is invalid for want of novelty or utility depends on the evidence in the particular case, and the fact that in a suit in one circuit, upon probably different evidence, a patent was not sustained is no ground for holding it invalid in a suit in another circuit. *Gates Iron Works v. Fraser and Chalmers, 79 O. G. 2015, C. D. 1897.

22. On an appeal from an order granting a preliminary injunction the case is ordinarily to be treated in the appellate court from the standpoint from which it was viewed by the circuit court, and the decision on the merits by a circuit court of another circuit sustaining the patent is therefore usually of controlling weight

in the appellate court, as it should be in the court below. *Thompson-Houston Electric Co. v. Ohio Brass Co., 80 O. G. 654, C. D. 1897.

COMMISSIONER OF PATENTS.

(See JURISDICTION OF.)

CONTEMPT OF COURT.

1. When the defendant below had been fined for contempt in the violation of a preliminary injunction and had given bond, and the proceeding was based on a right which depended on the validity of a patent, the proceeding is reviewable on appeal and in the particular case is not upheld. *Worden v. Searls, 39 O. G. 359, C. D. 1887.

2. This case remanded to the court below, with directions to dismiss the bill, without prejudice to the power and right of the circuit court to punish the contempt by a proper proceeding. *Id.

3. An attachment for contempt is a summary proceeding, and the writ is granted only in cases which are free from any reasonable doubt on the law or the facts. *Bate Refrigerating Co. v. Gillett, 39 O. G. 833, C. D. 1887.

4. Where a preliminary injunction to restrain the infringement of patent-rights is granted on condition that a bond be filed by the plaintiff, and the defendant was present in court at the time the order was read and approved, and the complainant then exhibited the form of bond which he was required to give, and stated that the bond would be filed as soon as the surety's signature could be obtained, and it was, in fact, filed on the same day, the defendant cannot, in proceedings to punish him for contempt in committing a breach of the injunction, plead in justification that he was ignorant of the filing of the bond, it being his duty, without notification, to ascertain whether the bond had been filed or not. *Burr v. Kimbark, 40 O. G. 246, C. D. 1887.

5. Where the principle involved in a patent is the point in issue in a suit to restrain its infringement, the defendant will commit a breach of preliminary injunction and be punishable for contempt where, for the purpose of evading the injunction, he continues to manufacture articles involving the same principle with but slight modifications of structure. *Id.

6. While upon an examination of the contract under which defendants claimed to be licensees it is found insufficient to support such claim, still, as it is apparent that defendants acted in good faith, under the belief that they were authorized by said contract, and ceased manufacture upon the commencement of these proceedings, they should not be punished as guilty of wilful contempt. *Iowa Barb Steel Wire Co. v. Southern Barbed Wire Co., 40 O. G. 578, C. D. 1887.

(See Pennsylvania Diamond Drill Co. v. Simpson, 48 O. G. 676, C. D. 1889.)

CONTINUING APPLICATIONS.

(See DIVISIONAL APPLICATION; SUBSEQUENT APPLICATION; INTERFERING PATENTS.)

1. Where patentee filed an application for a patent January 6, 1879, amended the same frequently, and upon the suggestion of the examiner filed an application December 30, 1879, containing the essential features of the original application, *held*, to be a continuous proceeding dating from January 6, 1879. *International Tooth-Crown Co. v. Richmond, 39 O. G. 1550, C. D. 1887.

2. Should the executor elect to pay a new fee and file a new application for the invention of the decedent instead of continuing the prosecution of the original application, the application so filed by the executor should be entitled to the same status and precedence in order of examination as the application of the decedent. Such application is merely a revival and continuation of the original application, and should receive the same action and consideration which belonged to the original application had death not intervened and arrested the progress of decedent's case. Ex parte Smith, 43 O. G. 505, C. D. 1888.

3. A second application cannot legally be considered a continuation of a first or earlier application by the same inventor unless it contains *the same invention*. Green v. Hall, 46 O. G. 1515, C. D. 1889.

4. Where an applicant files a second application as a division of his original application, then incorporates the claims of the original application into the divisional application and formally abandons the original application, *held*, that the whole proceeding is a continuous one, and that public use to bar the patent granted on the second or divisional application must be a public use two years prior to the filing of the original application. *Dederick v. Fox, 63 O. G. 1963, C. D. 1893.

5. Where an applicant abandoned his rejected application he cannot, in an interference based upon his subsequent application, treat the two applications as continuous. Hien v. Pungs, 68 O. G. 657, C. D. 1894.

6. Carty filed an application April 20, 1885. October 21, 1887, the application became abandoned. The present application cannot be held a continuation of the first nor as evidencing constructive reduction to practice of the invention in issue. Carty v. Kellogg, 73 O. G. 285, C. D. 1895.

CONTRACTS.

I. CONTRACTS.
II. CONTRACTS ILLEGAL.

I. CONTRACTS.

1. Where there is any doubt or ambiguity arising out of the language of an executory contract, the construction given by all the parties to the same is entitled to great, if not controlling, influence. *Topliff v. Topliff, 40 O. G. 115, C. D. 1887.

2. The manufacture by complainants under Patent No. 114,885, and the payment of royalties up to 1879, constituted an acceptance of such patent as a substitute for the patent named in the agreement, and the subsequent discovery by the complainants of the insufficiency of Patent No. 110,513 gave them no right to rescind the agreement. *Id.

3. The language in the agreement as to "any improvement made in these articles" is not restricted to articles like those described in the patent referred to in the agreement, but embraces articles such as are described in Patent No. 114,885. *Id.

4. Complainant was bound by a contract, although he did not sign the written memorandum, and was not mentioned as a party to it, by which suits then pending between himself and defendants over the infringement of patents were to be dismissed, and defendants were to be licensed to use the patented inventions, it appearing that, though complainant did not himself sign the instrument, he participated in the negotiation which led to its being signed, was present at the signing, knew its terms, and intended to allow the parties who did sign to adjust the whole matter, as they were principally interested in effecting a settlement. *Bean v. Clark, 40 O. G. 1454, C. D. 1887.

5. A written contract, although inartificially drawn, obscure, and capable of different interpretations in several particulars, yet its provisions embracing, although in very inadequate terms, every matter which the parties had definitely agreed to, and the circumstances surrounding its execution being consistent with no other conclusion, must be regarded as a completed agreement or contract, and not merely an agreement to agree. *Id.

6. An agreement or contract to create an estoppel must be of certain intent and effect, and leave nothing open to conjecture. Ligowsky v. Peters, v. Hisey, 57 O. G. 1595, C. D. 1891.

7. The supreme court of the United States has often enforced the rule that, in the absence of fraud, accident or mistake, it must be conclusively presumed that the written contract contains the whole engagement of the parties. (Cases cited.) (In Pennsylvania there has been some relaxation of this rule.) *Consumers' Gas Co. of Danville v. American Electric Construction Co., Limited, 50 Fed. Rep. 778 (1892).

8. A contract provided that a corporation should employ a certain patentee as its general manager for ten years, subject to termination by either party on one year's notice, or by the patentee's death or inability to act, and that, in the event of a termination of the agreement, the corporation should have a license to use his patents on payment of a certain royalty. *Held*, that a wrongful discharge of the patentee by the corporation was a mere breach of contract, and did not terminate the agreement so as to render the corporation liable to pay the royalty. (Johnson v. Signal Co. (N. Y. App.), 29 N. E. Rep. 964, followed.) ‡Miller v. Union Switch and Signal Co., 59 O. G. 633, C. D. 1892.

9. In an action to recover a balance alleged to be due on written contract whereby plaintiff agreed to furnish and set up certain machinery for defendant, the latter set up, among other defenses, that he had been served with notice by a certain patentee of a claim for damages for infringing letters patent by the use of the machinery furnished by the plaintiff. *Held*, that a purchaser of machinery who has had the full use and enjoyment and undisturbed possession of it cannot, in the absence of fraud, withhold the purchase price because of an alleged liability on his part to a patentee for infringement in the use of the property. *Consumers' Gas Co. of Danville v. American Electric Construction Co., Limited, 60 O. G. 737, C. D. 1892.

10. It is only a latent ambiguity which may be explained by evidence *aliunde*. [illegible]

parent upon the face of an instrument must be resolved by the court, resorting, if necessary, to the rule that a grant expressed in doubtful words shall be construed most strongly against the grantor. *Adriance, Platt & Co. v. McCormick Harvesting Machine Co., 63 O. G. 1688, C. D. 1893.

11. A contract of complainant to furnish defendants "such a number of machines as they desire for their own use at present or hereafter" is of doubtful legal validity for want of mutuality. No duty or obligation is upon defendants to take any number of machines, or do anything except to pay for such as they might desire. *Columbia Wire Co. v. Freeman Wire Co., 71 Fed. Rep. 302 (1895).

12. The release and settlement of July 27, 1891, examined and held not to be void either for gross inadequacy of consideration or by reason of any false statement or fraudulent concealment on the part of the defendant. The long period during which the settlement was allowed to stand is almost enough to estop the complainant. *Thorn Wire Hedge Co. v. Washburn & Moen Mfg. Co., 73 O. G. 1411, C. D. 1895.

13. The contracts between the parties *held* not to import that the defendant should guaranty the payment by the licensees of the royalties, but should exercise reasonable diligence in their collection. *Id.

14. It appeared that, in an action by L. for royalties, B. & Sons had set up fraud as a defense, and, upon such defense being overruled, had obtained a re-assignment of the contract and tendered the same back to L., without offering to return any of the profits made under the contract. *Held*, that by continuing to treat the contract as existing, after discovering the supposed fraud, and by retaining its fruits, B. & Sons ratified such coutract. *E. Bement & Sons v. La Dow, 74 O. G. 271, C. D. 1896.

15. A contract to pay for articles of manufacture containing a patented improvement is an agreement to pay for articles which by reason of the omission of such unnecessary details of construction as the patented article dispensed with are of a simple and less expensive construction, such as the patent sought to secure, even though such manufactured articles are in other respects unlike the patented article. *Andrews v. Landers, Frary & Clark, 75 O. G. 510, C. D. 1896.

16. Evidence to show the prior state of the art is admissible to explain the latent ambiguity in the language "containing the patented improvement," occurring in a contract between manufacturers and a patentee, and as bearing upon the situation of the parties and their object in making said contract. *Id.

17. Where the parties entered into a contract that a royalty of forty per cent. should be paid on all sales of the machines, and the contract also contained the provision "If the parties of the second part shall sell or lease, or [shall] cause to be sold or leased, for use, or shall cause to be used, in any foreign country [the machines in question], . . . then the royalty to be paid shall be forty-five per cent. in lieu of forty per cent. as hereinbefore provided," *held*, that this provision is not retroactive, and that therefore a royalty of forty-five per cent. should be paid only on sales made after the commencement of foreign sales. *National Sewing Machine Co. v. Willcox & Gibbs Sewing Machine Co., 76 O. G. 961, C. D. 1896.

18. A court is always bound in construing a coutract to look at the entire instrument, even though a conclusion derived therefrom may seem to antagonize the meaning of a particular paragraph of the instrument. *Fox Solid Pressed Steel Co. v. Schoen, 78 O. G., C. D. 1897.

19. A clause in an agreement regulating the manufacture of center plates in general which prohibits the manufacture of sheet-metal frames during the life of the agreement is secondary and incidental to the main agreement. *Id.

20. The fact that complainants are engaged in making frames of one species and defendants in making frames of another, and that those of the species made by the defendants are those sought to be restrained, as well as the fact that complainants knew of such manufacture long before they objected, should be taken into consideration in iuterpreting the contract. *Id.

21. A clause which finally interdicts the manufacture of a portion of a patented article which may be needed in the repair of such article is in undue restraint of trade and will not be enforced. *Id.

II. Illegal.

22. A contract wherein one party, in consideration of receiving a license from the other party to use certain patents during the life of said patents, agrees never to dispute or contest the validity of certain other patents or the licensor's title thereto, is a contract against public policy. *Pope Mfg. Co. v. Gormully, 59 O. G. 464, C. D. 1892.

23. A corporation or combination organized to regulate and control the price at which a device manufactured under patents may be sold by the members of the combination and to prosecute and defend all suits involving alleged infringement of such patents, *held* to be an illegal combination, and its purposes are violative of sound public policy. *National Harrow Co. v. Quick, 71 O. G. 608, C. D. 1895.

24. Doubtful whether the present bill for infringement, etc., can be sustained without giving aid to the unlawful combination or trust represented by the complainant; but doubt resolved in such way as will not lend the countenance of the court to the creation of combinations, trusts or monopolies. *Id.

25. The entire theory and purpose of our patent laws is to create a limited monopoly. The rights so acquired by the patentee are entirely inconsistent with the patentee's being made subject to the provisions of the anti-trust laws of the several states. He has been given, and is entitled to maintain, a monopoly of the patented article or device. (Cases cited.) *Columbia Wire Co. v. Freeman Wire Co., 71 Fed. Rep. 302 (1895).

26. An exclusive license for a consideration by a corporation to a person assigning to it his patent to manufacture and sell, as agent, upon his own account, subject to uniform terms and conditions, the corporation itself agreeing not to manufacture, is part of an illegal combination and in unwarrantable restraint of trade. *National Harrow Co. v. Hench & Dromgold, 76 O. G. 2011, C. D. 1896.

27. Combinations between a number of persons engaged in the same general business to prevent competition and maintain prices, being against public policy and illegal, the same principle, notwithstanding the patentee's exclusive control of his invention, is applicable in questions concerning patents. *Id.

28. While it is true that all contracts in restraint of trade are not prohibited, and it is sometimes difficult to determine whether a particular one is, there is no room for doubt that a contract between patentees and manufacturers of patented articles to prevent competition in business and enhance prices is unlawful. *National Harrow Co. v. Hench, 81 O. G. 1612, C. D. 1897.

29. The fact that property involved is covered by letters patent cannot be urged as a justification of a contract which enhances prices and restrains trade. Patents confer a monopoly as respects property covered by them, but they confer no right upon the owners of several distinct patents to combine for the purpose of restraining competition and trade. Patent property does not differ in this respect from any other. *Id.

30. The fact that one patentee may possess himself of several patents and thus increase his monopoly affords no support for an argument in favor of a combination by several distinct owners of such property to restrain manufacture, control sales, and enhance prices. Such combinations are conspiracies against the public interest and abuses of patent privileges. The object of these privileges is to promote the public benefit as well as to reward inventors. *Id.

31. A contract based on patent-rights which restrains trade is not justified by the situation of the parties. Their exposure to litigation is entitled to no greater weight. Patentees may compose their differences, as the owners of other property may, but they cannot make the occasion an excuse or cloak for the creation of monopolies to the public disadvantage. *Id.

COPIES AND INSPECTION OF PATENT OFFICE RECORDS.

1. Whenever a reasonable suggestion of its necessity for the purposes of evidence is made by the person requesting it, the commissioner of patents cannot lawfully refuse to furnish a certified copy of an abandoned or rejected application for a patent. The right to be furnished such a copy is given to the public by statute, and the refusal thereof entitles the applicant to the writ of *mandamus* against the commissioner to compel a compliance with such request. *United States ex rel. Pollok v. Hall, Com'r of Patents, 48 O. G. 1263, C. D. 1889.

2. An attorney at law who has requested such a copy in 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 relator for the writ of *mandamus*. *Id.

3. Where petitioners requested that an order be issued permitting them to inspect the abandoned cases in the patent office in order to protect their client from unnecessary expense and suit for alleged infringement of certain letters patent, etc., *held*, that the petition must be denied, although, if the petitioners shall make request for certified copies of one or more abandoned applications, accompanied by a reasonable suggestion of their necessity for pur-

poses of evidence, the request will be granted under authority conferred upon the commissioner by rule 179. Ex parte Fowler and Fowler, 49 O. G. 562, C. D. 1889.

4. The case of United States ex rel. Anthony Pollok v. Hall, Commissioner of Patents (48 O. G. 1263), distinguished from the case at bar. The question before the court in the case cited was whether a copy of a certain specified abandoned application which had been asked for should be furnished by the commissioner, and it is believed that the court did not intend to decide or to lay down a doctrine which would involve the logical necessity of deciding that a petition like the present should be granted. Id.

5. It is not to be conceded that the inventions represented in the abandoned applications of the patent office are the property of the public. Id.

6. Where the complaint averred that, on the surrender of the original patent, a new patent was issued to the patentee for the same invention, for the residue of the term then unexpired for which the original patent was granted, and the defendant in his answer denied each and every, all and singular, the allegations contained in the complaint. *held*, that a duly-certified copy of the original patent was relevant evidence upon the question whether the re-issue was for the same invention as the original, and that the issue was sufficiently raised by such averment and denial. *Oregon Improvement Co. v. Excelsior Coal Co., 49 O. G. 1694, C. D. 1889.

7. It is the practice of the office to refuse copies of caveats unless the party filing the caveat shall first consent. (Cases cited.) Ex parte Spear, 44 MS. D. (2 G. W. D.), Nov., 1890 (Fisher, Acting Com'r).

8. Section 892, Revised Statutes of the United States, providing for the obtaining of certified copies of any records, books, papers or drawings belonging to the patent office, does not require or authorize the commissioner of patents to furnish copies of pending applications for patents, or of papers connected with such applications. *United States ex rel. United States Electric Lighting Co. v. Commissioner of Patents, 54 O. G. 267, C. D. 1891.

9. When an inventor has two applications pending, both covering the same generic invention, and has made a full assignment of one of them, thereby conclusively electing to give the preference to the assigned case and to claim nothing in the unassigned application that is not special thereto, *held*, that he should be allowed to inspect the assigned application in order that he may properly restrict the unassigned application. Ex parte MacLaughlin, 55 O. G. 864, C. D. 1891.

10. Because an applicant has been forced to use an application in an interference proceeding to establish a record date, it does not follow that the office should allow any and every one to obtain certified copies of said application. Ex parte Dyer, 56 O. G. 1564, C. D. 1891.

11. A party who bases his rights as an assignee upon an instrument recorded in the patent office before application was made and not specifically identifying the invention will not be permitted to examine the files because such an instrument is not an assignment, but a mere executory agreement. Ex parte Lorentz, 59 O. G. 158, C. D. 1892.

12. A single uncertified copy of a decision or action by any tribunal of this office will be furnished to an interested party without charge. Ex parte Failor, 59 O. G. 630, C. D. 1892.

13. In a petition for *mandamus* against the commissioner of patents where the prayer was for permission "to inspect the abandoned cases in the United States patent office," and was not confined to a specific case, *held*, that no such broad right exists to the public, and writ refused. (Citing United States ex rel. United States Electric Lighting Co. v. Commissioner of Patents, C. D. 1891, 271, 54 O. G. 267.) *United States ex rel. Fowler v. Commissioner of Patents, 62 O. G. 1968, C. D. 1893.

14. The office is not warranted in furnishing copies of the papers in a pending application except to parties in interest, unless advised by a court of competent jurisdiction, having a case before it, that evidence of this sort within the possession of the office is essential to the proper decision of the case. Ex parte American Bell Telephone Co., 63 O. G. 152, C. D. 1893.

15. The refusal of the commissioner of patents to furnish copies of records, books, papers, etc., to any person making application therefor and paying the fee required by law would subject the commissioner to an action for damages (citing supreme court in Boyden v. Burke, 14 How. 576). It is not, therefore, every sort of record or paper the commissioner can protect from inspection and copy. *Ex parte Drawbaugh, 66 O. G. 1451, C. D. 1894.

16. Files, papers, etc., in a case appealed to the court of appeals of the District of Columbia are open to the public for inspection and copy. *Id.

17. Where, in an interference to prove the

granting of foreign letters patent and the date and contents thereof, certified copies of the records in this office of such letters patent were introduced, *held*, that the commissioner had power to grant such certified copies and that they are proper evidence under sections 892 and 893, Revised Statutes. Lossier v. Cowles and Cowles v. Boguski, 71 O. G. 1616, C. D. 1895.

18. After the preliminary statements have been received and approved each party may have free access to the files and papers of the other; but if an application contains a description and claims of one or more inventions not related to the one in issue in such a manner as to affect its scope or meaning, the opposing party should not be allowed to inspect this part of the application. Zwietusch v. Wittemann, 74 O. G. 183, C. D. 1896.

19. It is the practice of the office to refuse to give to strangers to the record copies of pending applications without the consent of the applicants or assignees. Ex parte Stockton, 79 O. G. 683, C. D. 1897.

20. Some of the records and papers of the patent office are public records, and of these any person is entitled to copies upon paying the usual fee therefor; but there are others not public records, and of these no one is entitled to copies without showing that they are material evidence for him, and the commissioner of patents cannot be required to furnish copies until such showing is made. Abandoned applications are evidently of the latter character. (Section 892, Revised Statutes, construed.) *United States ex rel. Bulkley v. Butterworth, Com'r of Patents, 81 O. G. 505, C. D. 1897.

21. No person is required to submit his private papers to others or produce them in court on the demand of a party to a suit on his allegation or claim that they are material evidence for such party, but only in obedience to the mandate of the court in which such suit is pending; and it is only reasonable that when a public officer has under his control a paper or document in its nature private or such as the public generally is not entitled to have access to as a public record, he should not be compellable to produce it or deliver copies of it until he has some information from the court in which the case is pending that it is required as evidence. *Id.

22. The court in which a suit is pending and not the commissioner of patents is the appropriate tribunal to determine whether a given paper should be produced as evidence; and where there is no satisfactory showing, as by a certificate of the court, that a paper is proper evidence, the commissioner of patents may refuse copies of such paper, and a writ of *mandamus* will not issue to him to furnish such copies. *Id.

23. In allowing inspection or in furnishing copies of pending cases, the claims will henceforward be withheld from all save parties directly interested or their attorneys. Ex parte Metzler, 60 MS. D., Feb., 1897 (Fisher, Acting Com'r).

24. Affirmed upon rehearing, that certified copies of the papers composing an abandoned application may be furnished to interested and proper parties, to determine a question of title; but the papers showing the steps taken in prosecution of the case, having no bearing on the question of title, should not be furnished. Bates Machine Co., 63 MS. D., Dec., 1897 (Greeley, Acting Com'r).

COPYRIGHT.

I. In General.
II. Assignment and License.
III. Copyrightable Subjects.
IV. Non-Copyrightable Subjects.
V. Depositing Copies with Librarian of Congress.
VI. Dramatic Composition.
VII. False Marking.
VIII. Infringement.
IX. International.
X. Musical Compositions and Lithographs.
XI. Notice.
XII. Publication and Sale.
XIII. Title of Copyrighted Subject.

I. In General.

1. As to whether the forfeiture to the United States, in section 4965, applies to anything but "painting, statue or statuary," *quære*. *Thornton v. Schreiber, 42 O. G. 1165, C. D. 1888.

2. When a man takes out a copyright for any of his writings or works he impliedly agrees that at the expiration of that copyright such writings or works shall go to the public and become public property. *Merriam v. Holloway Publishing Co., 53 O. G. 1409, C. D. 1890.

3. The complainants have no special property in "Webster's Dictionary" since the copyright has expired. *Id.

4. The amount of labor or skill in the production does not seem to be material if the proper subject of a copyright is produced and the producer copyrights it. *Falk v. Brett Lithographing Co., 48 Fed. Rep. 678 (1891).

5. Following Baker v. Selden, 101 U. S. 99, the copyright for a book entitled "Eclectic Short Hand" does not protect the system when considered as such apart from the language which expresses it. *Griggs v. Perrin, 49 Fed. Rep. 15 (1892).

(Literary merit is not a necessary element of a legal copyright. *Drury v. Ewing, 1 Bond, 540.

To be worthy a copyright, the thing must have some value as a composition, sufficiently material to lift it above utter insignificance and worthlessness. Drone on Copyright.

The national copyright system dates from 1790. The law now in force is substantially the law of 1870, although amended several times, notably by the act of March 3, 1891, providing for international registration, and the act of January 6, 1897, relating to performance of dramatic and musical compositions. The transfer of the copyright department to the librarian of congress was in 1870.)

II. Assignment and License.

6. A copyright may be assigned as to the whole or undivided part thereof, and may become "the undivided property of joint owners." (Citing Drone on Copyright, 334.) *Black v. Henry G. Allen Co., Scribner v. Same, 42 Fed. Rep. 618 (1890).

7. A non-resident foreigner is not within our copyright law, but he may take and hold by assignment a copyright granted to one of our own citizens. (Carte v. Evans, 27 Fed. Rep. 861.) *Id.

8. A license in writing may be given by the proprietor of a copyright to any person, and there is no restriction upon the power of such proprietor to assign or transfer, in equity, an exclusive right to use the copyrighted article in a particular manner or for particular purposes upon such terms and conditions as may be agreed upon. In such case the legal title remains with the proprietor, and the equitable title vests in the other party. (Cases cited.) *Id.

9. An inchoate right to a copyright may be transferred by parol prior to taking of copyright. (Cases cited.) *Id.

10. The first edition of the work was copyrighted in the name of Charles Scribner & Co., Proprietors; and the second edition — the one now in controversy — was copyrighted in the name of Charles Scribner's Sons, Proprietors; and, since Mrs. Terhune, whose *nom de plume* is Marion Harland, settled from time to time with the owners of the copyright for her royalties, the court will presume that her legal title as author was duly conveyed to and vested in the persons who secured the copyright, despite the fact that she was a married woman at the time the copyright was taken. *Scribner v. Clark, 50 Fed. Rep. 473 (1892).

III. Copyrightable Subjects.

11. The term "book" embraces every character of publication, whether a volume, pamphlet, newspaper article, calendar, or catalogue, following the interpretation in England of a similar English statute. A book of forms may be entitled to copyright protection. Original forms adapted to the requirements of a state statute relating to the sale of liquors are copyrightable. Some learning and some literary labor were required to produce them. (Citing Drone on Copyright, 208-210.) *Brightley v. Littleton, 37 Fed. Rep. 103 (1888).

12. Since the decision of the United States supreme court in Burrow-Giles Co. v. Sarony, 111 U. S. 53, a photograph which has artistic merits is a subject of copyright. Falk v. T. P. Howells & Co., 37 Fed. Rep. 202 (1888).

13. 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 there is no ground of public policy on which a reporter who prepares a volume of law reports, of the character of those in this case, can, in the absence of a prohibitory statute, be debarred from obtaining a copyright for the volume, which will cover the matter which is the result of his intellectual labor. *Callaghan v. Myers, 46 O. G. 565, C. D. 1889.

14. Even though a reporter may be a sworn public officer, appointed by the authority of the government which creates the court of which he is made the reporter, and even though he may be paid a fixed salary for his labors, yet, in the absence of any inhibition forbidding him to take a copyright for that which is the lawful subject of copyright in him, or reserving a copyright to the government as the assignee of his work, he is not deprived of the privilege of taking out a copyright, which would otherwise exist. *Id.

15. A statistical atlas is a book of maps, tables, and printed texts, and is not simply a bundle of maps. It is properly copyrighted as a whole, and there is no necessity for copyrighting each map separately. *Black v. Henry

G. Allen Co., Scribner v. Same, 42 Fed. Rep. 678 (1890).

16. A photograph may be the valid subject of a valid copyright for the photographer as the author of it. (Lithographic Co. v. Sarony, 111 U. S. 53.) *Falk v. Britt Lithographing Co., 48 Fed. Rep. 678 (1891).

17. When a person submits himself or herself as a public character to a photographer for the taking a negative and the making of photographs for the photographer, the negative and the right to make photographs from it belong to him. He is the author and proprietor of the photograph, and by copyright obtains the exclusive right to make copies. (Cases cited.) *Press Publishing Co. v. Falk, 59 Fed. Rep. 324 (1894).

18. A mere compilation of facts is protected by the copyright law, as well as original matter showing invention. The same facts could be gathered by other than the registrant, but it must be at his own expense and as the result of his own efforts. *American Trotting Register Association v. Gocher, 70 Fed. Rep. 237 (1895).

19. A book containing credit ratings and the financial standing of stove-dealers and manufacturers, held clearly entitled to copyright. (Lamb v. Evans, 1 Ch. 218, 1893; Leslie v. Young, App. Cas. 335, 1894.) *Ladd v. Oxnard, 75 Fed. Rep. 703 (1896).

20. Compilations, though involving only industry, and no such degree of originality as is expected from authors of repute, may be protected by the copyright statutes. *Id.

(A compilation of information that is useful in a counting-room is a proper subject of a copyright. Bullinger v. Mackay, 15 Blatch. 550 (1879).

21. Photographs have been held copyrightable by the supreme court. *Falk v. City Item Printing Co., 79 Fed. Rep. 321 (1897).

(Copyright protection was extended to photographs and magazines in 1865.

Copyright for playing cards sustained. Richardson v. Miller, 12 O. G. 3, C. D. 1877. A separate registration is required for each card if the designs differ.)

IV. Non-Copyrightable Subjects.

22. The judicial decisions of the courts are not the subject of copyright, but may be freely published by any one who chooses. It has never been authoritatively decided, however, by the courts of this country whether such decisions can be copyrighted by the state. The opinion in Gould v. Banks, 53 Conn. 415, undoubtedly asserts the right of the state to copyright judicial decisions. *State of Connecticut v. Gould, 34 Fed. Rep. 319 (1888).

23. Plaintiffs made and sold prints and labels to dealers in cigars. They registered as a copyright a picture described by the title "Nosegay." On the prints sold to dealers they substituted "Opera Bouquet" for "Nosegay." *Held*, section 3 of the act of congress of June 18, 1874, does not authorize such registration of prints and labels. (Schumacher v. Schwenke, 25 Fed. Rep. 466, distinguished.) *Schumacher v. Wogram, 35 Fed. Rep. 210 (1888).

(A label intended for no other use than to be pasted on vials or bottles containing a medicinal preparation is not the proper subject of a copyright. *Scoville v. Toland, 6 West L. J. 84; Colleen v. Brunton, 4 McLean, 516.)

24. A picture designed for an article of manufacture cannot be copyrighted in view of section 3, act of congress of June 18, 1874, which provides for registration of prints or labels for articles of manufacture. *Schumacher v. Wogram, 35 Fed. Rep. 210 (1888).

25. Speeches, letters and conversations by themselves alone are understood not to be the subjects of a copyright. (Cases cited.) *Gilmore v. Anderson, 38 Fed. Rep. 846 (1889).

26. Complainants and defendant manufacture furniture which is not patented. Both publish books containing illustrations of their goods, several of which are strikingly similar. Both books are published and used solely as means of advertisement. The complainants cannot have a monopoly in such a case. If the illustrations could be established as intrinsically valuable as works of art independent of their use as advertisements, a very different question would be presented. In view of the doubt, preliminary injunction denied. *Lamb v. Grand Rapids School Furniture Co., 39 Fed. Rep. 474 (1889).

27. A copyright for a form of a blank statement which the political code of California required in respect to property, held invalid. *Carlisle v. Colusa County, 57 Fed. Rep. 979 (1893).

28. The statutes, as amended by the act of 1874, limit copyright to such cuts and prints as are connected with the fine arts. Cuts and prints of bath tubs contained in advertising sheets were not contemplated or intended as works of fine art. They are adjuncts simply to a publication connected with a useful art.

*J. L. Mott Iron Works v. Clow, 72 Fed. Rep. 168 (1896).

29. An advertisement alone is not the subject of copyright. (Citing Drone on Copyright, p. 164.) *Mutual Advertising Co. v. Rego, 79 O. G. 159, C. D. 1897.

30. A mechanism or device for the storage and indexing of letters is not proper subject-matter for copyright inasmuch as it is not a medium for information or intelligence. The creator of this is not an author within the meaning of the word in the constitution, nor is what he has produced a book. *Amberg File and Index Co. v. Shea, Smith & Co., 70 O. G. 514, C. D. 1897.

31. Holmes' "The Autocrat of the Breakfast Table," was printed serially in the Atlantic Monthly, and the last part or fragment of it appeared before the title was filed by the author. *Held*, that the copyright is invalid. If the author had published part of the book only and then deposited the title, he might have had copyright protection for the remainder. *Holmes v. Hurst, 80 Fed. Rep. 514 (1897).

V. Depositing Copies with Librarian of Congress.

32. Francis A. Walker obtained a copyright for an article which was assigned for use as part of the Encyclopedia Britannica. The two copies of Walker's separate work, deposited in the office of the librarian of congress to complete the copyright, were obtained by taking to pieces a bound volume of the work, and taking the sheets which contained the articles and depositing them in the librarian's office; *held* to be sufficient compliance with the statute. *Black v. Henry G. Allen Co., Same v. Funk, 56 Fed. Rep. 764 (1893).

33. If the copies required to be sent to librarian of congress are mailed *before* publication, they are mailed within ten days of publication. (Cases cited.) *Falk v. Donaldson, 57 Fed. Rep. 32 (1893).

34. Under the provisions of section 4956, to make out a *prima facie* case of copyright it is only necessary for a complainant owner of a copyright to allege and show that he deposited with the librarian of congress, on or before the date of publication, a printed copy of the title-page of his book, also two copies of the book, and that he has given the lawful copyright notice. *Osgood v. A. S. Aloe Instrument Co., 72 O. G. 418, C. D. 1895.

VI. Dramatic Composition.

(This subject was first admitted to copyright in 1856.)

35. The decisions which extend the definition of "dramatic composition" so as to include situations and "scenic" effects do not cover the mere mechanical instrumentalities by which such effects are produced. (Daly v. Palmer, 6 Blatch. 264—a leading case—cited and discussed.) *Serrana v. Jefferson, 33 Fed. Rep. 347 (1888).

36. Marie Louise Fuller obtained copyright protection for a composition or description of a stage dance and the arrangement and setting of the stage, manipulation of the lights, etc., during the dance. *Held*, that complainant's performance is not a dramatic composition within the meaning of the copyright act, since the merely mechanical movements by which effects are produced on the stage are not subjects of copyright. *Fuller v. Bemis, 50 Fed. Rep. 926 (1892).

37. Complainants have title to copyright of the novel "Trilby," and they may restrain the production or public performance of any play or drama presenting the scenes, incidents, plot or dialogue of the said novel "Trilby," but they cannot restrain the mere use of the name 'Trilby" as the title of any dramatic composition which does not present such scenes, incidents, etc. The copyright law protects the name in connection with the novel, not the name alone. *Harper v. Ranous, 67 Fed. Rep. 904 (1895).

VII. False Marking.

38. The language of section 4963, Revised Statutes, providing a penalty for falsely marking articles "copyrighted," is not "for each copy," and while it may be true that if upon different days, under different circumstances, separate copies are printed, each transaction thus separate would constitute a separate offense, yet when the printing of many copies is a single continuous act only one offense is committed thereby. *Taft v. Stephens Lithographing and Engraving Co., 47 O. G. 1355, C. D. 1889.

39. The law is clear that no offense is committed when the word "copyrighted" is placed upon an article that is not the subject-matter of copyright—that cannot be copyrighted. *Id.

VIII. Infringement.

40. Defendant's copied lithographic copies of a painting for which copyright had been ob-

tained, *held*, an indirect copying of the painting itself and an infringement. *Schumacher v. Schwencke, Jr., 30 Fed. Rep. 690 (1887).

41. A compiler of a general directory is not at liberty to copy any part, however small, of a previous directory, to save himself the trouble of collecting materials from original sources. He must do that which the first compiler has done; that is, collect the materials for himself. He may, however, use the first compiler's work for purposes of verification of correctness of his own. *List Publishing Co. v. Keller, 30 Fed. Rep. 772 (1887).

42. Merely taking extracts from a copyrighted book, merely using it, in no manner infringes upon a copyright. *Stover v. Lathrop, 33 Fed. Rep. 348 (1888).

43. Perforated strips of paper for use in organettes can hardly be considered as sheet-music, there being no clef, no bars, no lines, no spaces nor other marks which are found in common printed music. *Held*, that such strips do not infringe the copyright for a song and musical composition entitled "Cradle's Empty, Baby's Gone," although the tune is the same in both cases. *Kennedy v. McTammany, 33 Fed. Rep. 584 (1888).

44. The copyright protects the registrant only against transcribing and embellishing his blank forms for application for a liquor license, and does not confer a monopoly of the forms themselves. Any one else may prepare and publish forms of this nature, provided they are not copies. *Brightley v. Littleton, 37 Fed. Rep. 103 (1888).

45. A copyright for a photograph is infringed by a design copied directly from it and stamped on leather intended for the bottom or back of a chair. *Falk v. T. P. Howell & Co., 37 Fed. Rep. 202 (1888).

46. The defendant is not liable unless he has copied—"pirated"—the plaintiff's charts, or some part of them. If he devised the same plan in ignorance of what plaintiff had done, he has not infringed any privilege secured by the plaintiff. *S. S. White Dental Co. v. Sibley, 38 Fed. Rep. 751 (1889).

47. A copyrighted chart showing illustrated sections of teeth so arranged as to convey information respecting their character, size, etc., is not infringed by a chart conveying to purchasers the same character of information, since neither the teeth nor the numbers accompanying them are the same as the plaintiff's, neither in fact nor appearance. Defendant has not copied and published plaintiff's chart, but has employed simply the same plan of advertising. *Id.

48. Plaintiff's book contained about thirty thousand Swedish words with short English definitions. Defendant's book contained about ten thousand of the same Swedish words with similar English definitions, with considerable changes in roots, terminations, etc. Each Swedish word was a topic for the composition of an English definition, and the plaintiff's copyright would protect his literary work in composing them, however short they might be upon each topic. (Citing 2 Kent, Com. 381; Callaghan v. Myers, 128 U. S. 617.) *Chils v. Gronlund, 41 Fed. Rep. 145 (1890).

49. The consent of a copyright owner to publish the subject of copyrighted article in an encyclopedia does not authorize the publication of such article as a part of a reprint of such encyclopedia. *Black v. Henry G. Allen Co., Scribner v. Same, 42 Fed. Rep. 618 (1890).

50. The unauthorized reprinting of eight maps from a volume of maps is an infringement. *Id.

51. The just and proper rule of damages in this case is to ascertain the profits the defendants made by their piracy of the complainant's work and fix that as the measure of complainant's damages. *Scribner v. Clark, 50 Fed. Rep. 473 (1892).

52. Defendants procured the manufacture of copies of complainant's pictures, and had the title and plate-mark applied in London, England. The appropriation of a part of a work is an infringement if it "contains any substantial repetitions of any material parts which are original and distinctive." The defendants omitted the mere work of the artisan and appropriated the genius of the artist. The question is not whether the article is marketable, but whether it is piratical. (Cases cited.) Copyright held infringed. *Fishel v. Lueckel, 53 Fed. Rep. 499 (1892).

53. The defendants procured the infringing act to be done; they are therefore liable as joint tort-feasors. (Cases cited.) *Id.

54. The allegation of defendants that they had no intention to infringe the copyright is no defense. Where infringement is otherwise established, the intention is immaterial. (Reed v. Holliday, 19 Fed. Rep. 325.) *Id.

55. The total number of cases digested in defendant's book was nineteen thousand. The disputed paragraphs, assuming that all are pirated, were less than one per cent. *Held*, an injunction would compel the mutilation of a completed

edition, or perhaps a printing of a new edition; the damage to defendant, should an injunction issue, would be entirely out of proportion to the damage to plaintiff should the preliminary writ be refused. The effect of an injunction would be an irremediable injury. (Cases cited.) *West Publishing Co. v. Lawyers' Co-operative Publishing Co., 53 Fed. Rep. 265 (1893).

56. An action for infringement of a copyrighted painting cannot be maintained unless the notice required by section 4962, Revised Statutes, has been applied to the original. Merely applying it to the published reproduction will not suffice. *Pierce & Bushnell Mfg. Co. v. Werckmeister, 72 Fed. Rep. 54 (1896).

(Decision of circuit court of appeals, reversing decision of circuit court.)

57. *Held*, the plaintiff should be protected in the name "Investor," for a trade-journal, as against the same name applied to another trade-journal. *Investor Publishing Co. of Massachusetts v. Dobinson, 72 Fed. Rep. 603 (1896).

58. The defendant published a crude illustration or wood-cut of certain poses of the dancer Mme. Loie Fuller; but the illustration was not a copy of, nor in any wise connected with, the petitioner's photographs. *Held*, there was no infringement. *Falk v. City Item Printing Co., 79 Fed. Rep. 321 (1897).

59. The mere circumstance that two syllabi of the same opinion are found to be expressed in identical language is not always sufficient proof that the one was borrowed from the other.* West Publishing Co. v. Lawyers' Co-operative Publishing Co., 79 Fed. Rep. 756(1897).

(This important case was heard by Circuit Judges Lacombe, Wallace and Shipman—circuit court of appeals, second circuit.)

60. If, however, instance after instance is found where the production is continuous, and in which identity of language is found, in technical phraseology as well as common speech, such continuous identity is suggestive. *Id.

61. When in a suit for infringement of an advertising pamphlet the defendant's pamphlet resembles the complainant's in its advertising features merely, there is no infringement, since such features are not the subject of copyright. *Mutual Advertising Co. v. Refo, 79 O. G. 159, C. D. 1897.

62. A demurrer on the ground of multifariousness brought against a bill in which thirty different copyrights are sued upon, each copyright covering a letter or portion of a letter in a system of indexing, is not well taken, since the subject-matter of litigation is in a sense single. *Amberg File & Index Co. v. Shea, Smith & Co., 79 O. G. 514, C. D. 1897.

IX. International.

63. Complainant's copyrighted photograph represents a German painting, the right of publication or reproduction of which was duly assigned in Germany. There is no proof that the painting itself was ever copyrighted. By the proclamation of the president of April 15, 1892, the benefit of the international copyright act of March 3, 1891, was extended to German subjects. The two copies of the photographs required to be delivered at the office of the librarian of congress were not printed from negatives made within the limits of the United States, consequently complainant's imported photographs cannot be directly protected by statute; but complainant has all the rights the artist ever had. *Werckmeister v. Pierce & Bushnell Mfg. Co., 63 Fed. Rep. 445 (1894).

(The privilege of copyright in the United States now extends to eleven foreign governments, namely, Great Britain and her dependencies, France, Germany, Italy, Spain, Portugal, Belgium, Switzerland, Denmark, Chile and Mexico.)

X. Musical Compositions and Lithographs.

(Music was brought within copyright protection by the act of 1831.)

64. Section 3 of the (international) copyright act of March 3, 1891, construed and held to distinguish musical compositions from books, so that it is not required that the copies of musical compositions to be delivered to the librarian of congress shall be manufactured in this country. *Littleton v. Oliver Ditson Co., 62 Fed. Rep. 597 (1894).

(Circuit court.)

65. It seems clear that the term "book" in section 3 was not intended to include "musical composition." *Id.

66. Musical compositions differ in the view of the copyright law from books as such, since the penalty for infringement was made expressly different in the act of February 3, 1831, and so stands in the present statute, act of March 3, 1891. *Id.

67. The word "lithograph" found in the proviso in section 3 of the statute under consideration represents only a subdivision of the

matter embraced in the word "print" in the same section. *Oliver Ditson Co. v. Littleton, 67 Fed. Rep. 905 (1895).

(Circuit court of appeals.)

XI. Notice.

68. The wrong year of entry of a copyright having been inscribed on a copyrighted article, suit for injunction cannot be maiutained. (Following Baker v. Taylor, 2 Blatchf. 82; Myers v. Callaghan, 5 Fed. Rep. 726, *contra*.) *Schumacher v. Wogram, 35 Fed. Rep. 210 (1888).

69. The notice given on a photograph was "1889, copyrighted by B. J. Falk, New York." Following Callaghan v. Myers, 128 U. S. 617, the notice is sufficient. *Falk v. Schumacher, 48 Fed. Rep. 222 (1891).

70. The plaintiff did not adopt the formula for the notice prescribed in section 4962, Revised Statutes of the United States, 1878, second edition, since he omitted the words "In the office of the librarian of congress at Washington." This omission, in view of the fact that the statute is highly penal in character and must be strictly construed, would be fatal but for section 5601, Revised Statutes of the United States, 1878. Consequently the act of June 18, 1874, is the one that must determine the sufficiency of the notice. *Hefel v. Whitely Land Co., 54 Fed. Rep. 179 (1893).

71. Section 1 of the act of June 18, 1874, prescribes that "Copyright, 18—, by A. B." may be a sufficient notice. The notice given by plaintiff embodies these exact words with additional words that simply amplify the formula without affecting its meaning. They are hence to be regarded as surplusage. *Id.

72. The exhibition of a card of miniature samples of photographs for obtaining orders, *held* not a publication; hence it was not necessary that the card should give notice of copyright in the language the statute prescribes. *Falk v. Gast Lithograph and Engraving Co., Limited, 54 Fed. Rep. 890 (1893).

73. Complainant being a resident of Germany and engaged in business under the name of "Photographische Gesellschaft," the copyright notice, "Copyright, 1882, by 'Photographische Gesellschaft,'" is proper. (Scribner v. Henry G. Allen Co., 49 Fed. Rep. 854, and Lithograph Co. v. Sarony, 112 U. S. 53.) *Werckmeister v. Springer Lithographing Co., 63 Fed. Rep. 808 (1894).

74. A notice of copyright in the following language, "Copyright, 1891. All rights reserved," is insufficient under the law, which requires the copyright notice to state the name of the person by whom the publication is copyrighted. *Osgood v. A. S. Aloe Instrument Co., 72 O. G. 418, C. D. 1895.

(See Jackson v. Walkie, 20 Fed. Rep. 15 — 1884.)

75. While an artist's copyrighted original painting remains unpublished, it is unnecessary to put any notice of copyright upon it. The notice is only required from the published *replica*. It is the same in the case of any design or model. *Pierce & Bushnell Mfg. Co. v. Werckmeister, 72 Fed. Rep. 54 (1896).

76. Whoever duly obtains a copyright cannot force any right against infringers except upon giving the notice required by section 4962 as amended by the act of June 18, 1874. The necessity of this notice is to inform the public. *Id.

77. The notice given by the plaintiff was "Copyright 95, by Bolles, Brooklyn." *Held* sufficient in view of the circumstances and the decisions of the supreme court in Lithographic Co. v. Sarony, 111 U. S. 53, 4 Sup. Ct. 279. *Bolles v. Outing Co., Limited, 77 Fed. Rep. 966 (1897).

78. The general rule is that in legal proceedings, and in statutory notices, the full name of the party must be given for purposes of identification, and designation by the initial letter or letters of the christian name will not suffice. In the Sarony case the initials were held superfluous and the surname as sufficient, because the public were not likely to be misled by omission of the full name. *Id.

XII. Publication and Sale.

(See Title, *infra*.)

79. A sale of a printed work prior to perfecting registration of the copyright constitutes a publication and the copyright must fail. *Gottsberger v. Aldine Book Publishing Co., 33 Fed. Rep. 881 (1887).

80. The exhibition of a card of miniature samples of photographs for the inspection of dealers alone, for the purpose of enabling them to give orders, is not a published edition within the meaning of the statute. *Falk v. Gast Lithograph and Engraving Co., Limited, 54 Fed. Rep. 890 (1893).

81. At the common law the artist or owner of the painting can prohibit reproductions of it until he in some way publishes it, but after publishing (without copyright) the public becomes entitled to it. (Parton v. Prang, 3 Cliff.

537.) *Werckmeister v. Pierce & Bushnell Mfg. Co., 63 Fed. Rep. 445 (1894).

82. The sale of a painting, reserving the right of reproduction, does not bar copyright. *Werckmeister v. Springer Lithographing Co., 63 Fed. Rep. 808 (1894).

83. The sale of the *replica* of a painting did not destroy the right to copyright. It was not a copy of the painting, but was made before the painting, for assistauce to the artist in producing the painting. *Id.

84. An illustration not taken from the painting but from a very superficial crayon sketch printed in the catalogue of the salon where the painting was exhibited, and not intended to be a copy of the painting, was not such a printing as would work a forfeiture of the right of copyright. *Id.

85. A copyrighted painting exhibited in Berlin and Munich, *held* to have been "published" within the meaning of section 4962, Revised Statutes. *Pierce & Bushnell Mfg. Co. v. Werckmeister, 72 Fed. Rep. 54 (1896).

(Circuit court of appeals, Judges Colt and Nelson; Judge Webb dissenting.)

86. Whatever right the author may have possessed before publication must have been at common law. The first publication is the foundation of the right under the copyright and a condition precedent to the existence of the right. *Id.

87. If the circulation of a copyright book be "limited to friends and acquaintances, it would not be a publication; but if general, and not so limited, it would be." (Coppinger on Copyright, 3d ed.) "To constitute a publication it is necessary that the work shall be exposed for sale or offered gratuitously to the general public, so that any person may have an opportunity of enjoying that for which the copyright was intended to be secured." *Ladd v. Oxnard, 75 Fed. Rep. 703 (1896).

XIII. Title of Copyrighted Subject.

88. If a publication be made under a title different in substance from that by which it was copyrighted, the departure would probably leave the publication to the public. (Drone, Copyrights, 140, 142.) *Blume v. Spear, 30 Fed. Rep. 629 (1887).

89. A copyright is invalid if there be sufficient variance between the title as registered and the title as published. *Daly v. Bradley, 39 Fed. Rep. 265 (1889).

90. A copyright protects the name in connection with a book, not the name alone. *Harper v. Ranous, 67 Fed. Rep. 904 (1895).

91. Protection has never been afforded by injunction under copyright laws for the title separate from the body of the work which it is used to designate. *Corbett v. Purdy, 80 Fed. Rep. 901 (1897).

CORPORATIONS.

1. A corporation cannot be a resident, under the act of 1887, of a state other than that in which it was incorporated. *Miller v. Wheeler & Wilson Mfg. Co., 57 O. G. 276, C. D. 1891.

2. It would be contrary to the well settled rules of equity to hold the defendant, who was president and general manager of the corporation, alone personally responsible for the alleged infringing acts committed by said corporation, contrary to the express instructions of the defendant and without his knowledge. (Cases collected in Linotype v. Ridder, 65 Fed. Rep. 853). *Stuart v. Smith, 68 Fed. Rep. 189 (1895).

3. The rule that a corporation has a distinct personality of its own and is not responsible for the personal acts of its stockholders will not apply in a case where the vender of a patent holds almost the entire stock of a defendant corporation and the facts show that he either uses such corporation as a mere cover for the transaction of his business or that there is knowledge and privity of interests between him and another stockholder, and the defendant corporation in such case will be estopped by the acts of said vender. *National Conduit Mfg. Co. v. Connecticut Pipe Mfg. Co., 75 O. G. 1361, C. D. 1896.

(A corporation may be bound by a contract which is not under its corporate seal in a case where the law does not require it. *Gottfried v. Miller, 21 O. G. 711, C. D. 1882—U. S. Sup. Ct.)

CORRECTION OF PATENTS.

1. The drawings having been interchanged in two patents, *ordered*, that the grant be canceled and new letters in proper form issued. Notice also given that the new letters patent would bear a later date than those canceled, and, if foreign patents had been obtained, the term of the United States patents would be limited thereby. Ex parte Crawford, 34 MS. D., June, 1887 (Hall, Com'r).

2. A court in equity has power to require

delivery of instruments obtained by fraud, for the purpose of correction or cancellation. *United States v. American Bell Telephone Co., 45 O. G. 1311, C. D. 1888.

3. The patent had not at the date of the suit been signed by the acting secretary of the interior, but was subsequently signed by him. The circuit court dismissed the bill. Complainant took an appeal in 1885 to this court. In 1887 congress passed an act for relief of patentees, making the patent legal, valid, complete, and operative from its original date, December 28, 1880. *Held*, while a patent of the United States can be attacked for defects upon its face only by regular proceedings instituted for that purpose, and is not open to collateral attack, except where specially provided by statute, this rule applies only to such patents as have been in fact executed under proper authority, and does not apply to any others. *Marsh v. Nichols, Shepherd & Co., 46 O. G. 239, C. D. 1880.

4. Thus, it may be shown that the patent was never executed by the person whose name appears on it, or that it was wrongly dated, or was never signed by the person who appeared to have signed it, or was signed after the official was out of office. A patent unsigned is void. *Id.

5. Such grants, if defective from insufficient execution, may be corrected subsequently, upon application to the proper department; but the correction must be made by the existing officers of the department. *Id.

6. The correction by the same acting secretary of the interior is sufficient, the commissioner of patents remaining the same at the date of the correction, which is the true date of the patent. *Id.

7. In this instance the actual date of correction, being more than six months after the date written in the patent, may be shown by proof. *Id.

8. Where the assignments referred to applications as of even date, but they bore date a day earlier, and patents issued in the name of the inventor, a certificate of correction refused, Ex parte Wirth, 46 MS. D. (3 G. W. D.), April 1891 (Mitchell, Com'r).

9. The commissioner of patents has no jurisdiction to alter the patent by a certificate of correction, and such certificate is wholly void. *Edison Electric Light Co. v. United States Electric Lighting Co., 61 O. G. 564, C. D. 1892, 52 Fed. Rep. 300.

(United States circuit court of appeals, second circuit.)

10. While the application for Edison's United States patent 223,898 was pending, a British patent was obtained dated November 10, 1879. The United States patent was granted January 27, 1880, unlimited, for the full term of seventeen years. December 18, 1883, upon the request of the party in interest, the commissioner of patents issued a certificate of correction, naming the date of the British patent aforesaid. On March 6, 1893, by petition of the parties in interest, the said certificate was canceled, this action being taken in view of a decision by the circuit court of appeals of the second circuit, declaring the former action of the commissioner to be without authority of law and therefore void. *Edison Electric Light Co. v. Buckeye Electric Co., 59 Fed. Rep. 691 (1894).

11. After issue of the patent, the commissioner issued a "certificate of correction," stating that the said patent is limited to expire with foreign patent for the same invention. The attempted "correction" was without jurisdiction and wholly void; citing Edison Electric Light Co. v. U. S. Electric Lighting Co., 52 Fed. Rep. 300. *Edison Electric Light Co. v. Bloomingdale, 65 Fed. Rep. 212 (1894).

CROSS-REFERENCES.

(See RESERVATION IN APPLICATION.)

1. When two or more applications are pending at the same time and each contains a disclaimer of matter in the other, and all showing, but only one claiming, the same subject-matter of invention, the issue of the patent on one application is not a bar to a patent on the other. Ex parte Roberts, 40 O. G. 573, C. D. 1887.

2. If the inventions are so nearly related to each other — as in case of an apparatus and process — that an application covering one invention discloses the other, applicant may fully protect his rights by incorporating in the applications cross-references, the effect of which would be the announcement that the invention claimed in the one was not the same as that claimed in the other. Ex parte Blair, 43 O. G. 113, C. D. 1888.

3. The examiner has the right to waive his requirement that applicant file cross-references and to take such other steps as in his judgment and discretion are necessary to remove any conflict between subject-matter of two pending applications of the same applicant. Ex parte Donovan, 44 O. G. 698, C. D. 1888.

4. A reference in an application for a patent to a contemporaneously-pending application for another patent for a fuller description is not permissible. Ex parte Borgfeldt, 49 O. G. 132, C. D. 1889.

5. A cross-reference which refers by serial numbers only to applications which may never mature into patents is not sufficient and not in compliance with rule 43. Cross-references must be of such nature that they will impart a more or less definite conception of their scope. It cannot be assumed that all applications will mature into patents, nor can it be permissible that they shall refer for purposes of construction or interpretation to instruments to which the public has no access. Ex parte Everitt, 49 O. G. 564, C. D. 1889.

6. 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. Ex parte Chadwick, 57 O. G. 124, C. D. 1891.

7. Where an applicant has two applications in the office disclosing different species of the same invention, each containing specific claims and one containing a claim broad enough to cover both species, and the one containing only specific claims has been allowed, a cross-reference disclaiming the subject-matter of the broad claim may be inserted into the allowed case under rule 78 without withdrawing it from the issue. Ex parte Anderson, 63 O. G. 463, C. D. 1893.

8. A cross-reference in an application to another pending application, both filed by the same party, is proper even in a case where the other application has been rejected and the rejection affirmed by the examiners-in-chief, since such rejection is not final and the application may be finally allowed on further appeal. Ex parte Simon W. Wardwell, 62 MS. D. 9, July, 1897.

COURTS.

(See JURISDICTION OF.)

DAMAGES AND PROFITS.

I. IN GENERAL.
II. ACCOUNTING.
III. ACTUAL.
IV. BURDEN OF PROOF.
V. DESIGN PATENT.
VI. ESTIMATION AND MEASURE OF.
VII. ESTIMATION AND MEASURE OF; LICENSE FEES AND ROYALTIES.
VIII. EXPENSES.
IX. INTEREST ON.
X. MASTER'S REPORT.
XI. NOMINAL.

I. IN GENERAL.

1. The assignment of a patent does not ordinarily transfer the right to damages for infringements prior to the assignment; and *held*, that a sale and assignment by an administrator, under order of court, of a number of patents belonging to the deceased, some of which had expired, the sale being for a nominal sum, contained no circumstances to vary the general rule. *May v. Juneau County, 41 O. G. 578, C. D. 1887.

2. Under section 4921 of the Revised Statutes, where a decree is given in a suit in equity restraining the infringement of a right secured by patent, the court may also decree a recovery of the profits arising from such infringement and the damages the plaintiff has sustained thereby. *Asbestine Tiling and Mfg. Co. v. Hepp, 49 O. G. 413, C. D. 1889.

3. The patentee is entitled to recover the profits made by an infringer where the article is complete in itself and is sold separately from the machine the operation of which it is intended to improve. *Keep v. Fuller, 42 Fed. Rep. 896 (1890).

4. On suit for infringement of patents of different dates damages need not be apportioned for infringement of each. *Timken v. Olin, 51 O. G. 1469, C. D. 1890.

5. Section 4921 of the Revised Statutes of the United States confers no authority upon a court of equity to increase a recovery of profits decreed against an infringer of a patent. This statute distinctly discriminates between the profits which are recoverable in a court of equity and the damages which were formerly recoverable in actions at law only, and confines the power of increasing the recovery to the latter. *Covert v. Sargent, 52 O. G. 1372, C. D. 1890.

6. Where an assignment of a patent was made two months after such patent had expired, nothing remained capable of assignment except the mere right of action for the recovery of damages for past infringement. Equity

has no jurisdiction. An action at law was the only adequate redress. *Ross v. City of Fort Wayne, 58 Fed. Rep. 405 (1893).

7. A final decree making an injunction perpetual and awarding only nominal damages was rendered upon a stipulation that such decree should not be a bar to the recovery of substantial damages in a subsequent case. *David Bradley Mfg. Co. v. Eagle Mfg. Co., 66 O. G. 315, C. D. 1894.

8. Damages can be collected from the manufacturer of a machine, and further damages from a subsequent purchaser and user of the same machine. The payment of damages for making an infringing machine does not give any right to the future use of the machine; but this may be restrained by injunction; and when the whole machine is an infringement it may be ordered to be delivered up and destroyed. (Birdsell v. Shaliol, 30 O. G. 261, 112 U. S. 485.) *United States Printing Co. v. American Playing Card Co., 72 O. G. 1499, C. D. 1895.

9. Where a patentee takes a decree for profits against a manufacturing infringer, he sets the manufactured machine free. The profits of the infringer are full compensation to the complainant for the wrong done him; but a judgment for damages covers only damages in the past and has no relation to the future. *Id.

II. Accounting.

10. The rights of the parties are to be determined as they stood at the commencement of the suit, and when determined the accounting should cover everything within it to the time of taking the account. *Rogers v. Riessner, 39 O. G. 832, C. D. 1887.

11. A court in equity will require an infringer to account for the gains and profits which he has made from the use of a patented invention instead of limiting the recovery to the amount of royalties paid to the patentee by third persons. *Tilgham v. Proctor, 43 O. G. 628, C. D. 1888.

12. Where the patent in suit had been adjudged invalid by this court in a suit against another defendant, and subsequently in this suit the court had adjudged the patent valid, the defendants must account for infringements committed after the date of the first adjudication that such patent was invalid. *Id.

13. In this instance there can be no accounting for profits earned subsequently to the suit, which was not tenable at the date of its commencement. *March v. Nichols, Shepherd & Co., 46 O. G. 239, C. D. 1889.

14. An interlocutory decree, after finding an infringement of plaintiff's patents by defendant corporation, directed the master to take an account of the profits which had arisen or accrued to the corporation thereby; and on suggestion that the individual defendants were all the stockholders and officers of such corporation, and might, under the guise of a new name and form of a new corporation, continue to infringe, the decree further directed the master to also take an account of profits that had accrued to such individual defendants over and above the profits of the corporation. *Held*, that the decree did not direct an accounting of profits arising from infringements by other previously existing corporations, in which defendants were stockholders, or by corporations which had previously been formed in good faith and not for the purpose of evading the decree, though defendants were controlling stockholders therein. *New York Grape Sugar Co. v. American Grape Sugar Co., 53 O. G. 277, C. D. 1890.

15. Where infringement is admitted damage is presumed, and the owner of a patent is entitled to a reference for accounting without giving specific evidence of damage. *Campbell Printing Press & Mfg. Co. v. Manhattan Ry. Co., 60 O. G. 894, C. D. 1892.

16. A court will hesitate to compel a large additional expenditure of time by ordering an accounting in a suit which has been pending for a long time, especially when the manufacture which forms the basis of the suit has ceased and it is likely that further testimony would result in mere estimates. The court will itself determine the profits. *Tuttle, Trustee, etc., v. Claflin, 77 O. G. 973, C. D. 1896.

III. Actual.

17. Where defendants infringe on complainant's rights, it is immaterial whether they were acting in good faith or under the supposed protection of letters patent where actual damages only are allowed. *Timken v. Olin, 51 O. G. 1469, C. D. 1890.

18. Where the evidence shows that the article manufactured by the defendant by the use of the infringing device differs from the plaintiff's product in a material respect, and is produced by an essentially different process, and where, as a matter of fact, defendant's product is superior in quality and finish to the plaint-

iff's product, *held*, that there is no presumption, either of law or fact, that the actual damage done to the patentee is commensurate with the gains of the infringer. *Royer v. Schultz Belting Co., 55 O. G. 1141, C. D. 1891.

19. The exclusive use granted by a patent is a property right, and a plaintiff in an action at law for infringement may recover actual damages therefor. *Lee v. Pillsbury, 60 O. G. 1752, C. D. 1892.

20. The actual damages suffered by plaintiff may be arrived at by evidence showing the value of that which defendants have used, the utility and advantage of the invention of the plaintiff over the old modes or devices that have been used for working out similar results, and the saving effected thereby. *Id.

21. Plaintiff must prove the actual damages directly or show such facts as will enable the jury to ascertain the amount, and mere opinion as to the amount of that damage cannot be considered. *Id.

IV. Burden of Proof.

22. The plaintiff has the burden of proving the amount of profits the defendants have made by the use of his invention. *Tilgham v. Proctor, 43 O. G. 628, C. D. 1888.

23. If an invention contributes only a subsidiary value to an article, it is incumbent upon the patentee as against an infringer to show affirmatively what this advantage is worth. *Webster Loom Co. v. Higgins, 54 O. G. 888, C. D. 1891.

24. The burden is on the licensor to show that the licensee has operated under his license, and in the absence of such proof the licensor cannot recover. *Marsh v. Quick-Meal Stove Co., 60 O. G. 1056, C. D. 1892.

25. To entitle a patentee to recover as damages for infringement the profits he would have realized if he had made the sales which were made by the infringer, he must show that he had the ability to make and that he would have made said sales but for the infringement. *Tatum v. Gregory, 60 O. G. 1753, C. D. 1892.

26. Certain deductions from accountable profits *held* to be for defendant to clearly establish. *Seabury v. Am Ende, 67 O. G. 401, C. D. 1894.

27. If defendants took complainant's device in its original form, the latter are entitled to the pecuniary advantage which the infringers derived from the unauthorized use of the patent. If the infringers added an improvement they have a right to an apportionment, the burden of proof being upon them to show that a portion of the profits was the result of the improvement. *Tuttle, Trustee, etc., v. Claflin, 77 O. G. 973, C. D. 1897.

V. Design Patent.

28. The act of congress (February 4, 1887) fixing a liability of $250 against every infringer of a design patent is within the authority conferred by article 8, section 1, of the constitution, and therefore valid. *Untermeyer v. Freund, 59 O. G. 1923, C. D. 1892.

29. The language of the act being "that hereafter, during the term of letters patent for a design, it shall be unlawful," etc., makes no exception as to cases commenced before the approval of the act. *Id.

30. The act provides that an infringer shall be further liable for all profits in excess of two hundred and fifty dollars made from the sale "of the article or articles" to which the design is applied. *Held*, that the court cannot limit damages to the profits due merely to the design, but must take into account all profits made on the sale of the article made thereunder. *Id.

VI. Estimation and Measure of.

(See Master's Report, *infra*.)

31. The value of an invention to the party using it is competent evidence on the question of damages for the infringement of a patent. *Royer v. Coupe, 39 O. G. 239, C. D. 1887.

32. Defendant infringed the patent as a participant in the unauthorized sales and became liable for the whole infringement. *Hatch v. Hall, 40 O. G. 1342, C. D. 1887.

33. As to the comparative expense of the old process, the cost at which the defendants used it, if at all, is not conclusive evidence that the old process could not have been used at a less cost. *Tilgham v. Proctor, 43 O. G. 363, C. D. 1888.

34. The infringer is liable for actual, not for possible, gains; for the fruits of the advantage which he derived from the use of the invention over that which he would have had in using other means then open to the public, and adequate to enable him to obtain an equally beneficial result. *Id.

35. If there was no advantage in the use of the plaintiff's invention, there can be no decree

for profits, and the plaintiff's only remedy is by action at law for damages. *Id.

36. If the defendants gained an advantage by using the plaintiff's invention, that advantage is the measure of the profits to be accounted for, even if from other causes the business in which that invention was employed by the defendants did not result in profit. *Id.

37. A court of equity will itself administer full relief by awarding as an equivalent or a substitute for legal damages a compensation computed and measured by the same rule that courts of equity apply in the case of a trustee who has wrongfully used the trust property to his own advantage. *Id.

38. When the invention relates to a new composition of matter and the infringing article is made of the patented material, and this alone, the measure of the patentee's damages may be the entire profit which he would have made. *Welling v. La Bau, 43 O. G. 117, C. D. 1888.

39. This rule is not changed where the infringing articles are of a poorer quality than the complainant's, if they are so nearly alike in appearance as to deceive not only buyers but experts in the trade. *Id.

40. A., one of the plaintiffs, was sub-licensee of three patents under B., another plaintiff, licensee under the inventor of the same patents at a lower royalty. One patent alone was infringed, and no evidence was produced to apportion its separate value. *Held*, no basis shown on which to compute damages, and plaintiff restricted to defendant's profit made by use of the infringing device. *Vulcanite Pavement Co. v. American Artificial Stone Co., 45 O. G. 948, C. D. 1888.

41. The basis for estimating damages for infringement should be the amount of profit or savings made by the use of the infringing device over what could have been made by the use of devices free and open to the public. *McMurray v. Emerson, 47 O. G. 815, C. D. 1889.

42. The rule that, "when the entire profit of a business or undertaking results from the use of the invention, the patentee will be entitled to recover the entire profits, if he elects that remedy," applied. *Hurlbut v. Schillinger, 47 O. G. 1067, C. D. 1889.

43. The payment of a sum in settlement of a claim for an alleged infringement of a patent cannot be taken as a standard to measure the value of the improvements patented in determining the damages sustained by the owner of the patent in other cases of infringement. *Cornely v. Marckwald, 47 O. G. 1353, C. D. 1889.

44. The defendant used a patented solvent which was cheaper than others; the defendant thereby saved a sum which complainant is entitled to recover as a profit. *Celluloid Mfg. Co. v. Cellonite Mfg. Co., 50 O. G. 841, C. D. 1890.

45. In a suit for infringement of a patent on lamp-burners, the evidence showed that complainants, during the time of the infringement, sold six thousand of the burners, after reducing the price, and that defendants sold only one hundred and fourteen of them. In competition with complainants, defendants sold various other kinds of burners, not protected by complainants' patent. *Held*, that the evidence was not sufficient to show that the reduction of price by complainants was caused by defendants' infringement, and they should recover only for the profits made by defendants in the infringing sales. *Boesch v. Graff, 51 O. G. 477, C. D. 1890.

46. The statute gives $250 as a measure of profits in cases where a less amount only can be proven, and not as a penalty above the actual profits. It seems to insist upon the idea that the amount of liability for infringement is merely a fixed measure of profits which may be decreed in equity as an incident to the jurisdiction for relief by injunction. *Pirkl v. Smith, 52 O. G. 1372, C. D. 1890.

47. The exceptions to the master's report as to the liability of the defendants for profits upon re-argument overruled; and *held*, that upon the facts presented the defendants were not accountable for any part of their profit upon the material when it was ready for the loom included in its market value at that time, or for any part of the seller's profit in the increased production. (Case of Webster v. Carpet Co., 9 O. G. 203; 2 Ban. & A. 67, not followed.) *The Webster Loom Co. v. Higgins, 54 O. G. 388, C. D. 1891.

48. The advantage gained by the infringer who makes and vends a patented article is measured by the value which the invention contributes to the market value of the article, and he is held accountable to that extent, unless his net profit in making and selling the article is less than the value of the invention. *Id.

49. If the invention invests the article with its whole value as a marketable commodity, his entire gains are attributed to the invention. If it contributes only a subsidiary value, this value segregated from the independent market

value of the article is the advantage for which he is accountable. *Id.

50. In settling an account between a patentee and an infringer, the liability of the latter for profits is measured by the advantage which he has gained by the use of the patented invention. *Id.

51. The infringing corporation held liable for whatever profit is derived from the manufacture and sale of the chemical preparation of plaintiff's patent, notwithstanding it might have made and sold the ingredients of said preparation if it had chosen to do so, and at the same or even larger profit. *Am Ende v. Seabury & Johnson, 54 O. G. 1268, C. D. 1891.

52. The loss entailed upon plaintiff by reason of his being compelled to reduce his price in consequence of the reduction of price made by the defendant, who was the only competitor of the plaintiff in the market, was a proper item of damages. *Id.

53. Defendants who infringed a patented valve by the manufacture of valves commercially worthless but for the infringed invention, are liable for the profits realized by them, though the form of their valves is different from those manufactured by complainants. *Consolidated Safety Valve Co. v. Crosby Steam Gage & Valve Co., 54 O. G. 663, C. D. 1891.

54. Where the valves manufactured by defendants also infringed another later patent, likewise owned by complainants, no injustice is done defendants in acceding to complainants' claim that all profits realized by defendants during the life of the earlier patent were solely due to the invention covered by that patent, especially in view of the fact that defendants contended that the invention embodied in the later patent is worthless; and hence, in an action for the infringement of the earlier patent, it is unnecessary for the master to find how much of defendants' profits are due to the later invention. *Id.

55. In an action at law for infringement the measure of recovery is the actual loss or damage that the plaintiff has sustained as the proximate result of the infringement. *Royer v. Shultz Belting Co., 55 O. G. 1141, C. D. 1891.

56. In estimating damages evidence may be given of profits, but such proof is of no avail unless further evidence is produced from which it may be legitimately inferred that, but for the infringement, the profits realized by the infringer or some definite portion thereof would have been realized by the patentee. The fact that a defendant has made large profits furnishes in itself no basis for a correct estimate of the injury sustained by the patentee. *Id.

57. Where defendants have infringed plaintiff's patent by the manufacture and sale of valves the entire commercial value of which lies in a feature covered by plaintiff's patent, they are liable in damages for all profits realized by them from such manufacture and sale. *Crosby Steam Gage and Valve Co. v. Consolidated Safety Valve Co., 57 O. G. 1000, C. D. 1891.

58. The only subject of inquiry in estimating the amount of damages is the profit made by defendant on the articles which it sold at a profit and for which it received payment; and losses incurred by the defendant through its wrongful invasion of the patent are not chargeable to the plaintiff, nor can their amount be deducted from the compensation which the plaintiff is entitled to receive. *Id.

59. In estimating profits defendant has made by use of plaintiff's device, where such device is a mere improvement upon what was known before and was open to defendant's use, plaintiff is limited to such profits as have arisen from the use of the improvement over what defendant might have made by the use of that or other devices without such improvement. *McCreary v. Pennsylvania Canal Co., 57 O. G. 1131, C. D. 1891.

60. Where an infringer has not sold the infringed device as a separate article, but has manufactured and used it upon certain articles sold by him, the proper measure of damages is not the profits on the entire article sold, but the defendant's savings from the use of the infringed device over what was known and open to the public before, and in such a case the question of defendant's profit or loss in the sale of the entire article is immaterial. *Sessions v. Romadka, 59 O. G. 939, C. D. 1892.

61. Where there is no license fee and nothing to show that the patentee puts his machine upon the market, he must furnish other evidence to enable the jury to come to a proximate amount of the damage which he has sustained by the infringement, and for this purpose general evidence may be resorted to. *Lee v. Pillsbury, 60 O. G. 1752, C. D. 1892.

62. The proper measure of damages for infringement of a patent is an indemnity to the plaintiff for the loss sustained by the infringement. *Id.

63. When a patent covers only certain features of a machine and not the entire machine,

if the patented features constitute the essential features of the machine and give it its merit, without which the machine would be valueless and unsalable, the damages and profits for infringement must be calculated on the basis of the entire machine and not merely on the patented features alone. *Id.

64. In a suit for infringement of a patent for a lifting-jack the court decreed that complainant recover the profits made "from said infringement by the manufacture, use or sale of the improvements described" in the patent, and referred the cause to a master to take proof and report the profits made from the manufacture, use or sale "of said improvements or from said infringement." No proof was given before the order of reference was made showing that the patented feature gave the infringing machine its entire commercial value. *Held*, that the order did not and could not properly direct the finding of profits on the entire machine; and defendants having claimed at the commencement of the hearing before the master that they were liable only for the profits realized from the infringing feature, the burden was on complainant to show either that such feature gave the machine its entire commercial value or else to segregate the profits made on that feature from the profits on the machine as a whole. (45 Fed. Rep. 205, affirmed.) *Mosher v. Joyce, 61 O. G. 153, C. D. 1892.

65. Complainant, claiming that the entire commercial value of the infringing machine was due to the patented improvement, offered no evidence to segregate the profits on that feature alone, and the master reported the profits on the whole machine. The court, on exceptions to the report, held that the entire commercial value was not due to the patented feature, and thereupon complainant moved to recommit the report for evidence of separate profits. *Held*, that it was a proper exercise of discretion for the court to refuse the motion, as complainant, with full notice of defendant's claim, had chosen to rely entirely on his own theory of the case. *Id.

66. A sum paid by the defendant for patents under which he claims to operate and the cost of his patterns should be disallowed, as such purchases remain his property. *Sayre v. Scott, 63 O. G. 1818, C. D. 1893.

67. Where the entire value of the infringing machine made and sold by the defendant is due to the invention covered by the patent in suit, the plaintiff is entitled to the whole profits realized by the defendant. *Id.

68. Although the bill for infringement was filed in 1886, the infringement continued after the filing of the bill and passage of the act of February 4, 1887. *Held*, that the complainant is entitled to the total profits resulting to the infringer to the date of the accounting (Marsh v. Nichols, 46 O. G. 239, 128 U. S. 605), even in the absence of proof that the entire profits were attributable to the use of the design. (Act of February 4, 1887.) *Untermeyer v. Freund, 65 O. G. 1767, C. D. 1893.

69. While it is the law that complainants in patent cases may give evidence to show the profits realized by the defendants from use of the patented device, and thus enable the courts to measure the amount of damages, and where the whole device is infringed, it is easy to apply the rule that the profits of the defendants afford a standard measurement of damages; but when the invention is but one feature among other devices that contribute to the profits made by defendants, serious difficulties arise in applying the rule. *Keystone Mfg. Co. v. Adams, 66 O. G. 654, C. D. 1894.

70. The conclusions reached upon this question upon consideration of the various decisions, briefly stated, are as follows: It is competent for a complainant to demand, in equity, an account of the profits actually realized by the defendant from his use of the patented device; that the burden of proof is upon the complainant; and that where the infringed device was a portion only of the defendant's machine, which embraced inventions covered by patents other than that for the infringement of which the suit was brought, in the absence of proof to show how much of that profit was due to such other patents and how much was a manufacturer's profit, the complainant is entitled to nominal damages only. (Seymour v. McCormick, 16 How. 480; Rubber Co. v. Goodyear, 9 Wall. 788; Mowry v. Whitney, 14 Wall. 620; Elizabeth v. Pavement Co., 97 U. S. 126.) *Id.

71. The complainant must establish the actual gains made by an infringer by the use of the patented device upon which the suit is brought (Garretson v. Clark, C. D. 1884, 206, 27 O. G. 524, 111 U. S. 120; Tilgham v. Proctor, C. D. 1888, 363, 43 O. G. 628, 125 U. S. 136), and in view of this rule it is error to permit a complainant to prove, not the defendant's profits, but those realized by other companies in the use of the patented device. This would be to allow the complainant to show what the defendant might have made, and not those profits which he actually did make. *Id.

72. It is no doubt well settled that where a patent is for a particular part of an existing machine it is not sufficient to ascertain the profits on the whole machine, but it must be shown what portion of the profits is due to the particular invention secured by the patent in suit (Blake v. Robertson, 11 O. G. 877, 94 U. S. 728; Dobson v. Hartford Carpet Co., 31 O. G. 787, 114 U. S. 120); but it is equally true that where the patented invention is for a new article of manufacture, which is sold separately, the patentee is entitled to damages arising from the manufacture and sale of the entire article. (Goulds Mfg. Co. v. Cowing, 21 O. G. 1277, 105 U. S. 258; Hurlbut v. Schillinger, 47 O. G. 1007, 130 U. S. 456; Crosby Valve Co. v. Safety Valve Co., 57 O. G. 1000, 141 U. S. 441.) The fact that another grate of the same kind was sold at the same time does not present any argument for lessening damages. *Warren v. Keep, 69 O. G. 1647, C. D. 1894.

73. In actions at law for damages for the infringement of a patent the plaintiff is entitled to recover, as damages, compensation for the pecuniary loss he has suffered from the infringement without regard to the question whether the defendant has gained or lost by his unlawful acts, the measure of recovery being, in such cases, not what the defendant has gained, but what the plaintiff has lost. *Coupe v. Royer, 70 O. G. 778, C. D. 1895.

74. Where a patent for an improvement in carts was limited merely to a device for sustaining the foot-board, but the invention practically introduced a new cart, for which a demand at once arose, *held*, that in the absence of any proof that any carts of this form were ever constructed without the patented feature, the measure of damages for infringement was complainants' entire loss, it being impossible to separate the value of the patented cart from a cart which did not contain the invention. *Holmes v. Truman, 73 O. G. 448, C. D. 1895.

75. "In a suit in equity for the infringement of a patent, the ground upon which profits are recovered is that they are the benefits which have accrued to the defendants from their wrongful use of the plaintiff's invention, and for which they are liable, *ex aequo et bono*, to the like extent as a trustee would be who had used the trust property for his own advantage. The defendants, in any such suit, are therefore liable to account for such profits only as have accrued to themselves from the use of the invention, and not for those which have accrued to another, and in which they have no participation." *Belknap v. Schild, 74 O. G. 1121, C. D. 1896.

76. Estimates only and estimates based upon experiments by the complainants, made only in a small way, which include estimates for the expense of an unnecessary feature of a process and which make no allowance for the economies which result from a subdivision of work, such as would be employed in manufacturing for wholesale trade, are unsatisfactory. *Tuttle, Trustee, etc., v. Claflin, 77 O. G. 973, C. D. 1896.

VII. Estimation and Measure of, License Fees and Royalties.

77. An established license fee may be resorted to as a measure of damages. *Jennings v. Dolan, 38 O. G. 1018, C. D. 1887.

78. The general rule is that, where less than the whole number of claims has been infringed, evidence must be adduced to show the value of the part taken. *Asmus v. Freeman, Same v. Alden, 34 Fed. Rep. 902 (1888).

79. A license fee need not be uniform throughout the life of the patent, since the value of the monopoly diminishes as it approaches its close. It is sufficient that the price is uniform when the circumstances are similar. *Id.

80. It is a general rule in patent causes that established license fees are the best measure of damages that can be used. In this case the master excluded certain license fees as the basis of computing damages on the ground that they were practically settlements of pending litigations between the complainants and the parties taking said licenses, made with one exception after the commencement and during the pendency of this suit. *Held*, that those licenses were in full operation when the defendants elected to resume their infringing manufacture; that they are competent evidence as bearing upon the fair market value of the privilege which the infringers have wrongfully undertaken to exercise, and that the defendants took the risk of being compelled to pay damages on the basis of the rate of license thus established. *Carey v. The Lovell Mfg. Co., Limited, 47 O. G. 525, C. D. 1889.

81. In order that a royalty may be accepted as a measure of damages against an infringer who is a stranger to the license establishing it, it must be paid or secured before the infringement complained of; it must be paid by such a number of persons as to indicate a general acquiescence in its reasonableness by those who have occasion to use the invention, and

it must be uniform at the places where the licenses are issued. *Rude v. Westcott, 48 O. G. 399, C. D. 1889.

82. An established license fee for the use of a patented article is sufficient to sustain a finding of damages to the amount of such fee. *Timken v. Olin, 51 O. G. 1469, C. D. 1890.

83. The license fee is the proper measure of damages, and it is immaterial whether or not the patent is a foundation patent. *Id.

84. In a suit at law a patentee cannot recover as damages the market value of the use of his invention, except in those cases where, by the mode of enjoyment of the monopoly, the patentee has himself established such market value by granting the use of the invention to the public for prescribed royalties or license fees. *Royer v. Schultz Belting Co., 55 O. G. 1141, C. D. 1891.

VIII. Expenses.

85. The master held to have properly refused to allow the defendant corporation, as an element of the "factory cost" of the article infringed, interest on its capital invested in the business. *Am Ende v. Seabury & Johnson, 54 O. G. 1268, C. D. 1891.

86. The master held to have properly disallowed a certain sum for salary of the president of the defendant as an element of cost, it not being shown that the president was a salaried officer. *Id.

87. The master properly found that the percentage for selling expenses, which should be added to the factory cost of all the goods sold by the defendant exclusive of certain goods named, was twenty-nine per cent. *Id.

88. A lump sum claimed by defendant for "clerk hire, selling expenses, rent and insurance," resting altogether upon an arbitrary apportionment of the expenses connected with his general business, where no separate account was kept connected with the particular branch of the business employing the invention and affording no way of testing its accuracy, should not be allowed. *Sayre v. Scott, 63 O. G. 1818, C. D. 1893.

89. Where the infringer fails to show that the salary of the president of the infringing company was actually paid, *held*, that the salary was properly disallowed on the ground that to have allowed salaries which had never been paid would have been to permit a dividend of profits under the guise of salaries. *Seabury v. Am Ende, 67 O. G. 401, C. D. 1894.

IX. Interest on.

90. Interest should be allowed upon the amount found due the plaintiff by this court from the date when the master's report was submitted to the court below. *Tilgham v. Proctor, 43 O. G. 628, C. D. 1888.

91. Delay caused by the court or not attributable to the plaintiff in coming to a conclusion on a master's report where the amount of damages found by that report is confirmed ought not to deprive the plaintiff of interest on the amount found by the master. Under such circumstances the account ought to be considered as liquidated on the day when the master's report is filed. *Crosby Steam Gage and Valve Co. v. Consolidated Safety Valve Co., 57 O. G. 1000, C. D. 1891.

92. Where the infringer's plant and real estate were used for other kinds of manufacture than the infringing article, and the evidence offered by the infringer to distinguish between the profits derived from the use of the plant and real estate for making the infringing thing and those attributable to the other sources of profit was not sufficient to enable the master to apportion the interest between the several kinds of business, *held*, that the infringer could not be allowed, as part of the cost of the infringing thing, interest on his plant and capital invested. *Seabury v. Am Ende, 67 O. G. 401, C. D. 1894.

X. Master's Report.

93. The proceedings before a master have almost the same solemnity as a trial before a referee or a jury, and the familiar rule which precludes the court from setting aside a verdict which is not against the weight of evidence is to a great extent applicable. *Welling v. La Bau, 43 O. G. 117, C. D. 1888.

94. In dealing with the exceptions to the master's report, his conclusions, depending upon the weighing of conflicting testimony, have every reasonable presumption in their favor, and are not to be modified or set aside unless there clearly appears to have been error or mistake on his part. *Tilgham v. Proctor, 43 O. G. 628, C. D. 1888.

95. The master, having found that the complainant had failed to establish by trustworthy legal proof any basis for the computation of profits, stopped his investigations upon the ground that as the defendants had destroyed the complainant's standard there could be no

standard until the complainant voluntarily created one. *Webster Loom Co. v. E. S. & N. D. Higgins, 48 O. G. 1119, C. D. 1889.

96. Report recommitted to master, with instructions to estimate the amount of profits in accordance with the rule stated in the opinion of Judge Wallace in a previous case. *Id.

97. The master is the representative of the court and his findings are *prima facie* correct, and the burden of showing error on the party who excepts. "His findings are not to be set aside or modified unless there clearly appears to be error or mistake on his part." (Cases cited.) *Keep v. Fuller, 42 Fed. Rep. 896 (1890).

98. Where, in an action to recover profits arising from the use of a patented solvent, the master in chancery found that defendant used the solvent for treating pyroxyline and during the same period treated it with other solvents, but, owing to a defect in the pyroxyline, its treatment with the various solvents resulted in a product which could not be sold at a profit, and that if defendant had not used the solvent in question it would have used others, and that, by reason of the patented solvent being cheaper, defendant saved a sum which complainant was entitled to recover as a profit. *Held*, that the conclusion of the master was correct. *Celluloid Mfg. Co. v. Cellonite Mfg. Co., 50 O. G. 841, C. D. 1890.

99. The reason for the rule requiring objections to the findings of a master in chancery to be first made to him on the draft of his report does not fully obtain where the objection is to the principal finding of fact, as he probably would not have changed his conclusion; but it is no hardship to require of the dissatisfied party that he so state his objections, or be deemed to have waived them. *Id.

100. Where the master is correct in his findings of fact, but errs as to conclusions of law, the rule requiring exceptions to his report is not applicable. *Id.

101. A master's report that there was an established license fee for the use of a patented article is sufficient to sustain a finding of damages to the amount of such fee, though the evidence was oral and no license was introduced. *Timken v. Olin, 51 O. G. 1469, C. D. 1890.

102. An exception that the master's report returned profits made by defendants, though profits were waived, is groundless where the master makes his finding on the measure of the license fee alone. *Id.

103. Where in action for infringement the master in his report on the question of damages sustained by plaintiff did not specifically find as to the alleged superiority of a non-infringing loom over the one infringed, and it appeared that he did not intend to state his conclusions in regard to said non-infringing loom, although he might have thought that its superiority was proved, *held*, that the case should be recommitted to him in order for him to state his own conclusions from his patient study and accurate knowledge of the evidence, rather than that they should be spelled out from the answers to the defendant's requests. *Webster Loom Co. v. Higgins, 54 O. G. 390, C. D. 1891.

104. The supreme court will not review a master's report upon objections first taken before it, the proper place for exceptions being in the court below. *Topliff v. Topliff, 59 O. G. 1257, C. D. 1892.

105. When a master's report was based upon facts relating to an industry which has long ceased to be active, and when the time in which facts based upon the experience of actual manufacture can be ascertained has passed, it does not appear that anything will be gained by new testimony before a master upon the question of profits. *Tuttle v. Claflin, 78 O. G. 1739, C. D. 1897.

XI. Nominal.

106. However it may be as to articles wholly covered by a patent for which there is no, or no convenient, substitute, the sale of an article having a patented invention as an incidental part thereof only will not entitle the patentee to recover more than nominal damages, unless he shows what they are and furnishes a reliable basis for estimating them. *Roemer v. Simon, 40 O. G. 1456, C. D. 1887.

107. Where complainants have failed to establish a royalty as measure of damages, and no evidence of the value of the invention to defendants is adduced, except the conjectural estimates of witnesses who had no practical knowledge of the subject, a decree for anything more than nominal damages cannot be sustained. *Rude v. Westcott, 48 O. G. 399, C. D. 1889.

108. Complainants, after contending for and accepting a finding in an action for the infringement of the earlier patent that defendants' profits arising from the manufacture and sale of valves infringing both patents were due solely to the earlier invention, cannot be permitted to recover more than nominal damages in an action for the infringement of the later

patent alone, brought after the expiration of the earlier one. *Consolidated Safety Valve Co. v. Crosby Steam Gage and Valve Co., 54 O. G. 633, C. D. 1891.

109. In the absence of evidence showing the amount of the damage, only nominal damages will be awarded. *Royer v. Schultz Belting Co., 55 O. G. 1141, C. D. 1891.

110. Plaintiff can recover only nominal damages for the infringement of an impracticable machine, or if he fails to show actual advantage to defendants by the use of his machine. *Lee v. Pillsbury, 60 O. G. 1752, C. D. 1892.

111. Plaintiff, owning a patent for two improvements in fruit-driers, sued for the infringement of but one. *Held*, that nominal damages only were recoverable where the evidence showed only the amount of a license fee for both devices and the profits to be made in manufacturing fruit-driers containing both improvements. *Hunt Bros. Fruit Packing Co. v. Cassidy, 62 O. G. 1965, C. D. 1893.

DEATH OF APPLICANT.

(See ABANDONMENT OF APPLICATION.)

DECREES OF COURT.

1. A party complained of as violating a decree who has never been a defendant of record in the suit cannot be bound by the decree except as privy to one or more of the defendants, or as a purchaser *pendente lite*. *Bate Refrigerating Co. v. Gillett, 39 O. G. 833, C. D. 1887.

2. To bind such a party not defendant of record as privy, the judgment must bind in relation to some specific right of property directly affected by the judgment and acquired after the judgment. *Id.

3. Where transfers are colorable, as for the purpose of avoiding an injunction, or if there has been a mere change of names, or if the transferring parties retain the management and principal ownership, and the violation is wilful, then privies not defendants of record are bound by decree. *Id.

4. There is no privity to a party not a defendant in the suit because of a purchase by such party *pendente lite* of property not involved in the suit. *Id.

5. A party not a defendant to the suit does not become privy thereto, and is not bound by the decree, by reason of a purchase of the property after suit and before the decree with an agreement to meet all liabilities and obligations of the party selling existing at the date of the sale. *Id.

6. A decree absolute in its terms is an adjudication of the merits of the controversy, and constitutes a bar to any further litigation of the same subject between the parties. *Lyon v. Perin and Gaff Mfg. Co., 43 O. G. 983, C. D. 1888.

7. Where a suit for infringement of a patent is brought against a firm that is a branch of the company that manufactures the infringing device and such company conducts the defense, raising the question of validity of the patent, a decree for complainant is conclusive as to the validity of the patent as against the company conducting the defense, even in regard to alleged anticipations not referred to in the suit, since under the issues all anticipatory inventions might have been shown in defense. (50 Fed. Rep. 193, affirmed.) *David Bradley Mfg. Co. v. Eagle Mfg. Co., 66 O. G. 315, C. D. 1894.

8. Such decree is none the less conclusive because it was merely interlocutory at the bringing of the suit in which it is set up as a bar and subsequently ripened into a final decree. *Id.

9. In a suit to restrain infringement of a patent and to obtain an accounting, an interlocutory decree was rendered, granting a temporary injunction, and afterward a final decree, making the injunction perpetual, and awarding only nominal damages, was rendered upon a stipulation which provided that such decree should not be a bar to the recovery of substantial damages in a subsequent suit. *Held*, that the decree was conclusive as to the validity of the patent, the stipulation only affecting its force as an adjudication on the subject of damages. *Id.

10. The contrast suggested by the words "interlocutory order or decree" and "final decree," as used in the first paragraph of amended section 7, is between a decree which is preliminary to a hearing on the merits, and hence discretionary in the court, and one which follows a hearing on the merits and is hence final, conclusive, and as of right in the prevailing party—between a decree which is meant to preserve the subject-matter of the litigation or prevent irreparable injury till a hearing on the merits can be had and a decree which follows the hearing on the merits and ultimately determines the rights of the litigants. *Standard Elevator Co. v. Crane Elevator Co., 77 O. G. 811, C. D. 1896.

11. There is no power in the court of appeals whereby its affirmance or approval on review of a decree of the circuit court can give a finality to that decree which it did not have when entered of record in the circuit court. *Id.

12. The power *incidental to appellate* jurisdiction is the power to direct the circuit court to enter such a decree as on the showing of the record ought to have been entered by that court. What is done by a court of original jurisdiction pursuant to a mandate from a court of review on reversal is precisely what ought to have been done by the court of original jurisdiction in the first instance. *Id.

13. The general rule is that when a case has been once decided by the supreme court of the United States, whatever was before that court and disposed of by its decree is finally settled. The circuit court is bound by the decree, and must carry it into execution without variation or intermeddling, except as to matters left open by the decree. *Rosebrugh v. Holman, 78 O. G. 1258, C. D. 1897.

DEFENSES.[1]

(See ANTICIPATION, PRIOR ART AND USE; PLEADING; PRIORITY OF INVENTION.)

I. IN GENERAL.
II. BURDEN OF PROOF.

I. IN GENERAL.

1. The defense that two persons to whom a patent has been issued were not in fact joint inventors is so purely formal that it cannot be regarded with favor unless it be shown that the action of the patentees in that regard was disingenuous or calculated to mislead the defendants. (Butler v. Bainbridge, 29 Fed. Rep. 142.) *Consolidated Bunging Apparatus Co. v. Woerle, 38 O. G. 1015, C. D. 1887.

2. It is no justification for sales of infringing articles to allege that the patentees have violated their license contract with the vendor. *Willis v. McCollin, 38 O. G. 1017, C. D. 1887.

3. In a suit for infringement of a patent, the defense being that defendant was the first inventor, the fact that soon after the time of his alleged invention he applied for a patent relating to the same subject, which he based on an entirely different principle, overcomes his and his witness' testimony that he was the first inventor. *Lamson Cash Ry. Co. v. Osgood Cash Car Co., 38 O. G. 1490, C. D. 1887.

4. It is no defense in a suit for infringement that the defendant's machine was used for forming staple-seams in paper, and not in leather, both machines operating in the same way. *Thompson v. Gildersleeve, 43 O. G. 886, C. D. 1888.

5. It is not a valid defense to a suit for the infringement of letters patent granted under the Revised Statutes that the patentee in his application therefor made oath that he was a citizen of the United States when he was not, such misstatement as to his citizenship having been made innocently through mistake, without any improper design whatever. *Toudeur v. Chambers, 46 O. G. 1110, C. D. 1889.

6. A change in the position of a part of a machine will not avoid infringement where the part transposed continues to perform the same function as before. (Citing Adams v. Manufacturing Co., 3 Ban. & A. 1.) *Schlicht & Field Co. v. Chicago Sewing Machine Co., 46 O. G. 1394, C. D. 1889.

7. *Held*, that it was no defense that the patents had been infringed by other manufacturers, as the license contained no express covenant by plaintiff to protect the defendant against such infringement. *National Rubber Co. v. Boston Rubber Shoe Co., 50 O. G. 559, C. D. 1890.

8. It is no defense that the infringing article made under defendants' patent was manufactured by complainant's licensees where the latter did not account for them to complainant nor consider them within their license. *Timken v. Olin, 51 O. G. 1469, C. D. 1890.

9. Want of patentability is a defense, though not set up in an answer or plea. *May v. County of Juneau. 53 O. G. 1888, C. D. 1890.

10. In the ordinary case of a bill for infringement filed by the holder of a senior patent against the holder of a junior patent the claims whereof conflict, it is no defense that the defendant is acting under a patent. *American Roll Paper Co. v. Knopp, 54 O. G. 391, C. D. 1891.

11. Any person sued for infringement of an American patent may show in defense that the invention claimed was patented or described in some printed publication before the patentee's supposed invention or discovery thereof. *Clark Thread Co. v. Willimantic Linen Co., 56 O. G. 395, C. D. 1891.

12. In an action for infringing a patent demonstrable facts are the decisive factor in determining the actual bearing upon each other of the patents under consideration, and a de-

fense which rests upon a mere theory as to the philosophy of operation of the complainant's device will not be considered by the court when this theory is negatived by the history of the art and by the practical working of the device in question. *Stilwell & Bierce Mfg. Co. v. S. N. Brown & Co., 60 O. G. 1191, C. D. 1892.

13. The existence of letters patent issued in due form constitutes *prima facie* evidence of the validity of the patent; and where, in an action at law for infringement, such letters are introduced, an alleged want of invention is matter of defense, the burden of showing which is on defendant; and the court cannot direct a judgment for defendant, even though the patentee on cross-examination has given evidence that may tend to show a prior state of the art excluding invention on his part. *Hunt Brothers Fruit Packing Co. v. Cassidy, 62 O. G. 1965, C. D. 1893.

14. The allegation by defendants that they have invested large amounts in their enterprise based upon the patent for the improvement is not a valid defense to a suit for infringement in the face of repeated adjudication sustaining the complainant's patent. *American Bell Telephone Co. v. Brown Telephone and Telegraph Co., 65 O. G. 894, C. D. 1893.

15. The defense of want of patentable novelty operates not merely to exonerate the defendant, but to relieve the public of an asserted monopoly. *Haughey v. Lee, 66 O. G. 1450, C. D. 1894.

16. Where in a defense to a suit it is shown that more than two years before the suit was brought the complainant acquiesced in a decision adverse to him in an interference in the patent office in favor of a patent issued to the defendant, *held*, that his acquiescence in the decision for such length of time worked an abandonment of any claim he might have made to the invention. *Fassett v. Ewart Mfg. Co., 69 O. G. 953, C. D. 1894.

17. When defendant at the hearing had ample opportunity and every inducement to produce a result equal to that of the complainant with devices known in the art prior to the production of the device of the patent sued on, and failed, the presumption, notwithstanding his explanation to the contrary, is that the prior art was not sufficient for the production of results as good as the patentee's. *A. B. Dick Co. v. Henry, 75 O. G. 1204, C. D. 1896.

18. A defense that machines were bought by the defendant without notice of a clog upon the title to them will not avail when it appears that the contract by which the machines were conveyed contains a reference to the license which contains the limitations constituting the clog referred to, and knowledge is justly imputable to the defendant in such case. *International Pavement Co. v. Richardson, 70 O. G. 166, C. D. 1896.

19. A contention that a patent built on the lines of the patent in suit was a failure will not avail defendants where it appears that there was no defect of principle. *Independent Electric Co. v. Jeffrey Mfg. Co., 78 O. G. 797, C. D. 1897.

20. Where an assignment of a patent by a corporation is executed by its president and secretary, who own all the stock, without any previous authorization by the board of trustees, *held*, that it is no defense to an infringement suit brought by the assignees against a third party where the corporation itself has never questioned the validity of an assignment. *Kansas City Hay-press Co. v. Devol, 81 O. G. 1277, C. D. 1897.

II. Burden of Proof.

21. Where an alleged infringer's defense relies upon unpatented devices claimed to be anticipations of the patent, and the use and existence of which are proven only by oral testimony, 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 they will subject such evidence to the closest scrutiny. *Washburn & Moen Mfg. Co. v. Beat 'Em All Barbed Wire Co., 58 O. G. 1555, C. D. 1892.

22. The mere fact that in rejecting one of the claims of Roberts' original application the patent examiner said "that cones are common things in coiling-machines" is no proof that "rotary" coiling-cones were before used, and if any such cones were, in fact, used the burden was upon defendant to show it. *Roberts v. H. P. Nail Co., 63 O. G. 613, C. D. 1893.

23. In the manufacture of infringing devices, if any advantage results from the use therein of an improvement by the defendant, the burden is upon the defendant to show it. *Sayre v. Scott, 63 O. G. 1818, C. D. 1893.

24. Where the defense to an infringement suit is prior use the burden is on defendant, and it is not sustained where the evidence shows that the alleged prior use was only for experimental purposes and had with a view to perfecting the device. *Pacific Cable R. Co. v. Butte City Street R. Co., 64 O. G. 1397, C. D. 1893.

25. In order that a defense of prior public use may prevail against the patent sued on it is necessary to prove the use beyond a reasonable doubt. *Oval Wood Dish Co. v. Sandy Creek (New York) Wood Mfg. Co., 66 O. G. 1895, C. D. 1894.

26. To invalidate a patent by prior invention or use the proof must establish the fact beyond a reasonable doubt. This means that the defense must be established by proof as explicit and convincing as that required to convict a person charged with crime. *Dodge v. Post & Co., 78 O. G. 339, C. D. 1897.

DEPOSITIONS.

(See AFFIDAVITS; TESTIMONY; WITNESSES, CROSS-EXAMINATION OF.)

1. When a deposition is taken irregularly and without authority, or shows on its face reasons why it cannot and should not be considered, or where an entire deposition is irrelevant, unless there has been a waiver, an objection at the hearing would be entertained. *Milligan v. Niedringham, 38 O. G. 103, C. D. 1887.

2. Depositions may be taken *de bene esse* in equity causes before any notary public or any other officer authorized to take depositions in civil causes under United States Revised Statutes, section 863. *Stegner v. Blake, 45 O. G. 126, C. D. 1888.

3. All objections to mere informalities in depositions not called up before final hearing should be considered as waived. *Id.

4. Until depositions are filed in the patent office the commissioner has no control over them. There is no positive rule requiring the parties to file all depositions taken, and it necessarily follows that the commissioner is without authority to compel the filing of such depositions. †Petithomme v. Bedbury, 52 O. G. 605, C. D. 1890.

DESIGNS.

I. APPEAL AND PETITION.
II. CONSTRUCTION OF STATUTES.
III. INFRINGEMENT.
IV. LIMITED TO A SINGLE INVENTION.
V. MECHANICAL PATENT.
VI. PATENTABLE SUBJECT-MATTER.
VII. PUBLIC USE AND SALE.
VIII. PRACTICE IN PATENT OFFICE.
IX. TEST OF IDENTITY.

I. APPEAL AND PETITION.

1. An application for patent upon "a design for ornamenting the surface of the walls of railway cars," etc., which, in the opinion of the examiner, contains nothing which can "constitute proper subject-matter for a design patent," should be by such examiner rejected. From such rejection an *appeal* will lie to the board of examiners-in-chief, as in ordinary cases of the rejection of claims. Ex parte Harris, 38 O. G. 104, C. D. 1887.

2. Objections to claims for non-segregable parts relate to the merits rather than to form, and upon rejection the appeal should go to the examiners-in-chief. Ex parte Gérard, 43 O. G. 1235, C. D. 1888.

3. 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. Ex parte Herrick, 43 MS. D. (2 G. W. D.), May, 1890 (Fisher, Ass't Com'r).

4. Where a single entire design is claimed, and the question arises whether portions of the design claimed separately are segregable, a question of merits is presented, upon which the appeal lies to the examiners-in-chief, in case of rejection by the examiner. Ex parte Petzold, 55 O. G. 1651, C. D. 1891.

5. Where a petition was taken from the action of the examiner objecting to the claims as not setting forth proper subjects-matter for a design, no repetition of such action having been made, *held*, that the petition was prematurely taken and that the examiner should have made his reasons for *objecting* to the claims the basis for a *rejection*. Ex parte Bishop, 63 O. G. 153, C. D. 1893.

6. An objection that a claim for a design is not single goes to the merits and appeal lies to examiners-in-chief. Ex parte Myers, 64 O. G. 359, C. D. 1893.

II. CONSTRUCTION OF STATUTES.

7. The word "useful," employed by congress in legislation upon the subject of mechanical and design applications, defined and distinguished, and *held*, when applied to designs, to relate to matters of decoration and æsthetic art which reach the senses through the eye, and so used in an entirely different sense from that in which it is applied to the subject of

mechanical invention, where the *usefulness* contemplated by the statute relates to the employment of dynamic force, its modification or operation. Ex parte Schulze-Berge, 42 O. G. 293, C. D. 1888.

8. The word "manufacture," as used in section 4929 of the statute relating to designs, is to be construed so as to have the same meaning as the word "manufacture" in the prior statutes relating to mechanical patents. Ex parte Lewis, 54 O. G. 1890, C. D. 1891.

9. The word "manufacture" in the patent statutes has never been construed to include real estate, and it must be limited to manufactured articles — that is, those made by hand, machinery or art, from raw or prepared materials. Id.

10. The design covered by the patent in suit *held* to come within the first clause of this section, as a "manufacture," rather than within the third clause, as an "original impression, ornament," etc. *Eclipse Mfg. Co. v. Adkins, 56 O. G. 1407, C. D. 1890.

11. The second clause of the section requires that there should be a description of the design, which is to be "printed, painted, cast or otherwise placed on or worked into any article of manufacture." *Id.

12. The word "manufacture," as used in section 4929, Revised Statutes, *held* not to include such a generic term as the word "table-ware." Ex parte Proeger, 57 O. G. 546, C. D. 1891.

13. The act of February 4, 1887, entitled "An act to amend the law relating to patents, trademarks and copyrights," which *inter alia* imposes a penalty upon an infringer of a design patent to be recovered by the owner of the patent upon a bill in equity for an injunction to sustain such infringement, examined and *held* to be constitutional. (Root v. Railway Co., 21 O. G. 1112, 105 U. S. 189, 206; Stevens v. Gladding, 17 How. 454, and Stevens v. Cady, 2 Curt. 20.) *Untermeyer v. Freund, 65 O. G. 1767, C. D. 1893.

14. The act of February 4, 1887, was passed for the manifest purpose to enlarge the remedy against infringers of design patents and to declare that the measure of profits recoverable on account of the infringement should be considered to be the net profits upon the whole article. The rule which the act declares for the computation of profits is the total profit from the manufacture or sale of the article to which the design was applied, as distinguished from the pre-existing rule of the profit which could be proved to be attributable to the design. *Id.

15. The word "expense" in the statute relating to design patents means a "disbursement of money" and also "the employment and consumption of time and labor." To confine its meaning to the mere expenditure of money would be contrary to the purpose of the statute, which purpose is to secure to those who shall invent and produce a new and original design a monopoly in the design. *Matthews & Willard Mfg. Co. v. Trenton Lamp Co., 75 O. G. 674, C. D. 1896.

16. The word "useful" in the statute relating to designs has reference to mechanical rather than purely esthetic features in designs relating to machinery. The excellence of such a design depends upon its nice adaptation. The word "useful" may be applied to the shape or configuration of a patentable form with a signification much wider than "not harmful." Ex parte Lunken, 76 O. G. 785, C. D. 1896.

III. Infringement.

(See Test of Identity.)

17. The test of infringement is the "identity of appearance, determined by the eye of the ordinary observer — the public." (Gorham Co. v. White, 14 Wall. 511.) Ex parte Gérard, 43 O. G. 1235, C. D. 1888.

18. Where the alleged infringing manufactures of the defendants produced a different effect upon the eye of the ordinary observer from what was produced by the complainant's manufacture, *held*, that there was no infringement. *Dukes v. Bauerle, 51 O. G. 805, C. D. 1890.

(See, also, page 803, same volume.)

19. The statute relating to designs only insists — in order to sustain an action for infringement — that the design shall have been applied without license, coupled with a sale, the party selling knowing that the design has been so applied. *Pirkl v. Smith, 52 O. G. 1372, C. D. 1890.

20. The drawing of the patent represents, and the specification describes, a square mat, but the specification adds "it might be oblong or other desirable shape." Defendant's mat shows the design as applied to an oblong mat, which involves changes in the central panel. An ordinary purchaser would take one for the other. *New York Belting and Packing Co. v. New Jersey Car Spring & Rubber Co., 48 Fed. Rep. 556 (1891).

21. Although the suit does not involve the method of producing the result, yet in consid-

ering the question of anticipation the court may properly take into consideration the fact that the patentee invented the method of making articles of glassware having a "blown" body and a "pressed" neck, thereby rendering possible the raised ornamentation of the neck in the patent. *Ripley v. Elson Glass Co., 60 O. G. 298, C. D. 1892.

22. In determining whether a design patent is infringed, the test is whether there is a substantial similarity in appearance not to the eye of the expert, but to that of the ordinary observer giving such attention as would ordinarily be given by a purchaser of the article bearing the design. *Id.

23. Where the infringement of a design patent is deliberate and intentional, the court will impose upon the defendant the penalty of $250 provided for by act of February 4, 1887. *Id.

24. The only new feature of the patented design being the sharp drop of the pommel at the rear, while the saddles of the defendants have only a slight curved drop at the rear of the pommel, *held*, that the difference was so marked that the defendants' saddle could not be mistaken for the saddle of the complainant, and that there was therefore no infringement. *Smith v. Whitman Saddle Co., 63 O. G. 912, C. D. 1893.

25. A design which imitates the figures of a patented design in their characteristic and important features and produces the same general appearance infringes, though the imitative figures are much smaller than those of the patent. *Whittall v. Lowell Mfg. Co., 80 O. G. 809, C. D. 1897.

26. Design Patent No. 18,100 not infringed by defendant's stove, which in its appearance, either generally or in detail, does not so far resemble the complainant's design as to deceive purchasers or dealers, but, on the contrary, seems to be well distinguished in form and ornamentation. *Michigan Stove Co. v. Fuller-Warren Co., 80 O. G. 1892, C. D. 1897.

IV. Limited to a Single Invention.

27. A design application will not be permitted to embrace more than one subject of invention. The same principles in this particular which control in mechanical applications must obtain in design applications. A distinct and separate invention relating to the form or configuration cannot be lawfully included in a patent embracing a distinct and separate invention as to surface ornamentation—as, for instance, an *alto-rilievo* cannot be joined with an ornamentation or picture to be worked into a woolen fabric; but when the shape and the ornamentation are parts of the same article of manufacture, so that both unite in producing the same result, then they are not distinct and separate within the purview of the rule. Ex parte Gérard, 43 O. G. 1235, C. D. 1888.

28. Under the statute the design must be a *finished* and *completed* thing—must be one entire and integral thing. It cannot consist of several integral different designs aggregated, so as to protect the several individual parts, nor so that these parts may be separately applied to other and different articles or parts of articles of manufacture. Id.

29. The doctrines of combinations and elements of combinations and of genus and species obtaining in mechanical inventions cannot be applied to designs. In a mechanical combination, when one element is withdrawn that combination ceases; but in a design, a subordinate and unimportant feature may be withdrawn and yet the design as a whole remain, and to simulate the predominant features would infringe the whole. Id.

30. As the subject of identity of the design is addressed to the eye of the ordinary observer—the public—so the questions of the extent and character of claims in patents for distinctive and segregable parts must be determined largely by the skill and judgment of the experts of the office. Id.

31. The relation of genus and species does not exist in designs. The question involved in designs is one of identity. Ex parte Gérard, 43 O. G. 1240, C. D. 1888.

32. A patent for a design must be limited to a single invention; but such patent may cover any variation or modification, provided the distinct and predominant features so far remain as to preserve the identity of the original completed design. Id.

33. While it is probable that a design patent may have different claims for different ornaments to be placed on the same manufactured article, yet a single claim cannot cover several ornaments in no way depending upon each other. *Dukes v. Bauerle, 51 O. G. 805, C. D. 1890.

34. Where two or more designs are not only claimed, but are represented in the drawings, neither one being a part of either of the others, applicant must elect which one he will retain in the pending application, and any appeal

from the examiner's action in requiring the election should be taken to the commissioner. Ex parte Petzold, 55 O. G. 1651, C. D. 1891.

35. Where one design is illustrated and two or more designs are claimed, neither one being a part of either of the others, the examiner should decline to consider any claim excepting the one for the design illustrated, requiring the remaining claims to be severed from the application. Id.

36. The question of similarity or dissimilarity arising upon the comparisons of designs is determined by the eye of the ordinary observer and not by the judgment of experts. Ex parte Petzold, 55 O. G. 1652, C. D. 1891.

37. The patent office should not seek to forestall the judgment of the courts by holding, upon the judgment of its experts, that certain designs differing from the design illustrated in the drawing are mere modifications thereof. Id.

38. A claim for the design as illustrated, if new and patentable, should be allowed, leaving the question whether or not other designs which are claimed by the applicant to be mere modifications are or are not independent designs, to be determined by the lawful tests applied in the courts. Id.

39. Any number of designs require for their protection the same number of patents unless one or more of them are component parts of another design from which they are segregable. Id.

40. Cases arise in which separable subordinate designs form when united one principal and complete design, and if such separable subordinate designs are new and patentable there would seem to be no reason why they should not be claimed in the same application with such principal and complete design, whether or not the experts of the office are of opinion that the separable subordinate designs are in and of themselves suggestive of the design in its entirety. Ex parte Bennett, 55 O. G. 1821, C. D. 1891.

41. If the design as a whole is patentable as constituting one complex whole of beauty or attractiveness, and a border, or center-piece, or other design element which is segregable therefrom, would be in itself new and patentable, if it constituted the entire ornament, *held*, that claims may properly be allowed in the same application for the complex whole and the segregable element. Id.

42. If the designs are independent they should be the subject of separate applications. (Ex parte Beattie, C. D. 1879, 142.) Id.

43. The question whether or not three different forms cover the same design is for the courts and not for the office. Ex parte Hess and Hess, 56 O. G. 1834, C. D. 1891.

44. 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. Id.

45. Only one design can be the subject of a design patent, and where applicant's specification attempts to cover more than this it is properly held defective. Ex parte Petzold, 57 O. G. 1277, C. D. 1891.

46. The range or scope of a design patent is to be determined by the courts and not by the patent office. It is therefore not proper for the office to issue a design patent which on its face purports to cover an indefinite variety of modifications which may or may not be within the proper scope of the claim, as that matter shall be determined by the courts. Ex parte Finck, 60 O. G. 157, C. D. 1892.

47. 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. Ex parte Requa, 60 O. G. 295, C. D. 1892.

48. While the law may permit claims in one design patent for the entire design and for constituent parts complete in themselves, the patent office will not permit independent ornamental inventions to be joined in one patent. Ex parte Petzold, 61 O. G. 1789, C. D. 1892.

49. The practice of the office in refusing to permit independent and alternative mechanical inventions to be joined in one patent is warrant for a like refusal as to two independent and alternative designs. Id.

50. An *objection* to a claim for a design that it is not single; that it fails to set up any article of manufacture, but, on the contrary, calls for three separate articles aggregated, is one pertaining to the merits and should therefore have been a *rejection*. Ex parte Myers, 64 O. G. 859, C. D. 1893.

51. An applicant may describe and claim variations in his patentable form within such limits as are consistent with unity of design and to the extent claimed. Ex parte Lunken, 76 O. G. 785, C. D. 1896.

52. Separate claims for the entire design and for its separate parts may properly be allowed in one patent. (Dobson v. Carpet Co., 114 U. S.

439.) *Britton v. White Mfg. Co., 79 O. G. 2195, C. D. 1897.

53. The patent office having allowed the separate claims in one patent, a mere statement by counsel during the prosecution of the case, of a reason why it was desirable to include them in a single patent does not estop the patentee to claim what was clearly granted him under said patent. *Id.

54. Where applicant presents two distinct articles of manufacture—a cradle-supporting frame and a cradle-body—and claims them as such, *held*, that the application should be restricted to one or the other of these two designs. (Ex parte Patitz, C. D. 1883; 101, and Ex parte Brower, C. D. 1873, 151, followed.) Ex parte Haggard, 80 O. G. 1126, C. D. 1897.

55. Claims of a design patent are related as generic and specific when one has more elements recited therein than the others. Ex parte Coe, 81 O. G. 2086, C. D. 1897.

56. When an inventor has produced a design, he has produced a single shape or configuration and not a plurality of them. He may make additions to that design, but may not make modifications. Two different manifestations constitute two distinct species, of which one is a modification of the other. Id.

57. Two separate designs are never permissible in one application. (Ex parte Patis, 25 O. G. 980, and Ex parte Brower, C. D. 1873, 151.) Claims for a cradle-body and a cradle-supporting frame *held* inharmonious. Ex parte Ries W. Haggard, 62 MS. D., June, 1897. (Rehearing, Greeley, Ass't Com'r.)

58. An application disclosing two castings for use in adjoining parts of a bedstead, and adapted to interlock and form a joint, *held* to cover distinct inventions not constituting a unitary design, but merely an aggregation. Ex parte Brand, 63 MS. D., Dec., 1897 (Greeley, Acting Com'r).

(A patent for a design held not bad because it embraced more than one letter of the alphabet. *Miller v. Smith, 18 O. G. 1047, C. D. 1880.)

V. Mechanical Patent.

59. The inventor and patentee of a mechanical device may also receive a design patent for the configuration, ornamentation or decoration which the mechanical invention is capable of receiving. Ex parte Schulze-Berge, 42 O. G. 293, C. D. 1888.

60. A new and original design under the statutes may also be the subject of a mechanical patent. (Ex parte Schulze-Berge, 42 O. G. 293.) Ex parte Gérard, 43 O. G. 1235, C. D. 1888.

61. Since the subject-matter of an application for a design patent and of a mechanical patent is different, since the matter claimed in the design application could not have been claimed in the other, and since the grant of the design patent cannot extend the term of the other, *held*, that the mechanical patent is no bar to the grant of a design patent upon the same article. Ex parte Lunken, 76 O. G. 785, C. D. 1896.

(The question whether a mechanical patent showing a design is a bar to the grant of a patent for such design subsequently applied for by the patentee was first decided adversely, under the law of 1870 (in Ex parte Kohler, C. D. 1873, 84), by the supreme court of the District of Columbia, the chief justice (Carter) dissenting. Subsequently the circuit court (Blatchford, J.) rendered an opposite opinion, which, taken with Commissioner Marble's decision in Ex parte Palmer, 21 O. G. 1111, C. D. 1881, settled the practice which still prevails.)

VI. Patentable Subject-matter.

62. It is not novelty which will sustain a design patent to transfer to rubber, or to a rubber mat, an effect or impression to the eye which has been produced upon other materials or articles by contrast or variation of light and shade. *New York Belting & Packing Co. v. New Jersey Car Spring and Rubber Co., 30 Fed. Rep. 785 (1887).

63. 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, 42 O. G. 1292, C. D. 1888.

64. It is no answer to the validity of a design patent that special features of it are found separately in prior things. *Id.

65. 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. *Untermeyer v. Freund, 47 O. G. 527, C. D. 1889.

66. The policy which protects a design is akin to that which protects the works of an artist by copyright. If the design produce a different impression upon the eye, even though it be simple, and does not show wide departure from other designs, its use will be protected. *Id.

67. When two design patents were applied for by the same person and issued to the same person on the same day, and were each for a

design for a sewing-machine case, and each design exhibited one or more features found in the other, *held*, that each qualified and limited the other. *Dukes v. Bauerle, 51 O. G. 805, C. D. 1890.

68. A design patent must exhibit exercise of the inventive or original faculty as clear and of as high degree as is called for in patents for inventions or discoveries. In the latter class there must be novelty and utility; in the former, beauty and originality. *Cahoone Barnet Mfg. Co. v. Rubber & Celluloid Harness Co., 45 Fed. Rep. 582 (1891).

69. Appropriation of the invention of another, though the design may disclose alteration, does not justify issue of a patent. *Id.

70. Whether the peculiar effect — "a sort of kaleidoscope effect" — produced by the particular design in question impressed upon the substance of India rubber would constitute a quality of excellence which would give to the design a specific character and value and distinguish it from other similar designs that have not such an effect, *quære*. *The New York Belting and Packing Co. v. The New Jersey Car Spring and Rubber Co., 54 O. G. 135, C. D. 1891.

71. 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 design patent. *Foster v. Crossin, 54 O. G. 1115, C. D. 1891.

72. In order to support a patent for a design, as for any other subject, under the acts passed by congress in the exercise of its constitutional power to secure to inventors the exclusive right to their discoveries, there must be some invention and not a mere application to a new material of something already known. *Id.

73. A dwelling-house is not a "manufacture" in the statutory sense, and a design for the exterior of a dwelling-house is not patentable. Ex parte Lewis, 54 O. G. 1890, C. D. 1891.

74. Articles which are manufactured and sold with reference to becoming a part of a house ultimately, such as mantels, are "manufactures" within the meaning of the statute relating to designs. Id.

75. A patent for an improvement in a design is valid if it be clear from the specification and drawings that the design is of itself new and distinctive and improved as compared with others and not merely an improvement upon another design. *Anderson v. Saint, 57 O. G. 546, C. D. 1891.

76. A design patent is not invalid because it covers scolls and ornamentations, similar in effect to scrolls and ornamentations that have been before used, if a new idea is embodied in the method of their arrangement. *Id.

77. The plaintiff did not design an album case proper, nor an ornament proper for an album case, but he appears to have conceived the idea of placing such ornament upon an album case. The statute provides for patent upon designs for articles of manufacture and for patents for ornaments to be placed upon or worked into such articles, but does not appear to provide for a patent for the mere placing of an ornament on such articles. Patent held invalid. *Bergner v. Kaufmann, 52 Fed. Rep. 818 (1892).

78. Three design patents for pen cases and tips — Nos. 20,156, 20,157, 20,158 — present changes in assemblage and construction of parts which produce things not exactly known before, and in that sense new, but they seem to have been due more to good taste than to inventive skill, and are really too slight to sustain any one of the three patents. (Atlantic Works v. Brady, 107 U. S. 192, 2 Sup. Ct. 225.) *Eagle Pencil Co. v. American Lead Pencil Co., 53 Fed. Rep. 368 (1892).

79. As high a standard of originality is required for design patents as for any other class, and such originality goes to appearance or ornamentation rather than to utility. Ex parte Williams, Jr., 58 O. G. 803, C. D. 1892.

80. The object sought in the design is a new effect upon the eye alone — a new appearance, which alone the law regards. *Held*, that a Masonic design for decorating rugs, composed of certain Masonic symbols grouped in an orderly and tasteful manner so as to form a panel large enough to cover the face of the rugs, was sufficient to sustain the patent. *Smith v. Stewart, 55 Fed. Rep. 481 (1893).

81. In determining the patentability of a design for a new and original shape or configuration of an article of manufacture its utility is an element for consideration. (Lehnbeuter v. Holthaus, 21 O. G. 1783, 105 U. S. 94.) *Smith v. Whitman Saddle Co., 63 O. G. 912, C. D. 1893.

82. The exercise of the inventive or originative faculty is required in the production of a patentable design, and a person cannot be permitted to select an existing form and simply put it to a new use any more than he can be

permitted to take a patent for the mere double use of a machine. If, however, the selection and adaptation of an existing form amount to more than the exercise of the imitative faculty and the result is in effect a new creation, the design may be patentable. *Id.

83. The patent being for a design for a riding-saddle, and the evidence showing that the form of tree was that of one known type, the form of cantle that of another known type, and that the central open slot was old, *held*, that the presence or absence of the slot was not material, and that the addition of a well-known cantle to a known saddle, in view of the fact that such use of the cantle was common, did not in itself involve genius or invention or result in a patentable design. *Id.

84. If the design in the patent consists merely in a transfer of an old form for a design or its mere adaptation by imitation from one kind of manufacture to another kind, it is not an invention, and the patent, therefore, is void; but if the adaptation is more than the exercise of the imitative faculty, and the result is in effect a new creation, the design is an invention and is patentable. (Smith v. Whitman Saddle Co., 63 O. G. 912, 148 U. S. 674.) *Untermeyer v. Freund, 65 O. G. 1767, C. D. 1893.

85. It cannot be said to require exercise of the inventive faculty to emboss a pattern on a radiator which had before been painted thereon. *Eclipse Mfg. Co. v. Holland, 69 O. G. 372, C. D. 1894, 62 Fed. Rep. 465.

86. Under the statute and decisions of the supreme court a design must exhibit originality and the exercise of the inventive faculty. *Hammond v. Stockton Combined Harvester and Agricultural Works, 70 Fed. Rep. 716 (1895).

(See Gaskill v. Myers, 81 O. G. 1111, C. D. 1897.)

87. Where two designs are in their prominent features identical, and their sole difference lies in the fact that the protuberance of one has a small nut on the end and the other has none, the difference is not of such material character as to afford ground for the grant of a design patent. *Welker v. Weller, 75 O. G. 185, C. D. 1896.

88. Originality was not displayed, invention was not exercised, and novelty was not introduced by placing different shades of color in divided stripes upon an old form of flag. *Caldwell & Co. v. Powell, 75 O. G. 1206, C. D. 1896.

89. A design patent for the case of a "nickel-in-the-slot machine," *held* invalid, because used on a gambling device (which was asserted to be adapted for other purposes). (Quoting Device Co. v. Lloyd, 40 Fed. Rep. ——, 1889, which concerned a patent for a "toy automatic race course.") *Reliance Novelty Co. v. Dworzek, 80 Fed. Rep. 902 (1897).

90. A design as a whole should be of unchanging character and should not include movable parts, since the shape or configuration of a device is varied by varied positions of its elements. Ex parte Smith, 81 O. G. 969, C. D. 1897.

(On the question whether utility as well as ornamentation may form the basis of a design patent, see the following cases: Ex parte Crane, C. D. 1869, 7 (Foote, Com'r); Ex parte Solomon, C. D. 1869, 49 (Hodges, Acting Com'r); Ex parte Bartholomew, C. D. 1869, 103 (Fisher, Com'r); Ex parte Fenno, C. D. 1871, 52 (Duncan, Acting Com'r); Ex parte Parkinson, C. D. 1871, 251 (Leggett, Com'r); Ex parte Doolittle, C. D. 1872, 176 (Thacher, Acting Com'r); Ex parte Oglesby, 3 O. G. 211, C. D. 1873, 5 (Leggett, Com'r); Ex parte Fairchild, 3 O. G. 323, C. D. 1873 (Thacher, Acting Com'r); Ex parte Collender, 2 O. G. 360, 1873 (Thacher, Acting Com'r); Ex parte Norton, 22 O. G. 1205, C. D. 1882 (Marble); *Theberath v. Rubber & Celluloid Harness Trimming Co., 23 O. G. 1121, C. D. 1883; Ex parte Stetson, 36 O. G. 691, C. D. 1874 (Leggett, Com'r); *Smith v. Whitman Saddle Co., 63 O. G. 912, C. D. 1893.)

VII. Public Use and Sale.

91. 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. *Anderson v. Eiler, 57 O. G. 410, C. D. 1891.

92. Sale before application for patent of an article bearing a design by the designer to a manufacturer with knowledge that the manufacturer buys to obtain the design for use on his goods does not constitute abandonment, but operates as a license to the manufacturer. *Id.

VIII. Practice in Patent Office.

93. It has been customary to require that the words "as shown and described" shall be employed in the claims of design patents, in order that the patents may be limited to the subject-matter shown and described. The introduction of such words operates as a guide-post to inform all persons that the patent is limited to the precise invention shown and described, and that there is no hidden mystery or secret trap by which those who attempt to enter the same field of invention or to use other articles may be arrested in their efforts or mulcted in damages. Ex parte Gérard, 43 O. G. 1235, C. D. 1888.

94. An applicant who has filed an application for a design patent for the term of three and a half years, which has received examination on the merits, will not be permitted to have the government fee paid on filing such application applied as part payment on a second application filed for the full term of fourteen years for the same subject-matter. Ex parte Haley, 44 O. G. 1399, C. D. 1888.

95. It is doubtful whether a claim, in a design patent, which is not restricted to the particular pattern shown in the drawing, is valid, because not a claim for a particular design in the sense of the statute. The claim must be to a particular impression or ornament, of a particular configuration, or color, or pattern, and it must be so shown or described as to be identified. *Condé v. Valkenburgh, 39 Fed. Rep. 788 (1889).

96. An application for a design patent, which the applicant has elected to prosecute for the shortest period prescribed by law, cannot be amended to run for a longer period after favorable action on the merits. Ex parte Kinnear, 51 O. G. 156, C. D. 1890.

97. The rules of the patent office require that the specification shall distinctly point out the characteristic features of the design for which a patent is sought. Ex parte Pegel, 55 O. G. 1528, C. D. 1891.

98. The examiner should exercise his judgment in each case as to the extent to which the characteristic features shown in the drawings should be pointed out in the specification in order to comply with the requirement of distinctness. Id.

99. Where a floral border for a rug was designated by the letter A, and the characteristic features of the design were pointed out as consisting of a floral border A surrounding an oval field center, *held* sufficient. Id.

100. An application for a design patent may properly be rejected upon a drawing in a former patent, although such drawing is not accompanied by any detailed description. Ex parte Crouch, 57 O. G. 845, C. D. 1891.

101. Where certain words and figures (numerals) appeared on the illustration of a design, *held*, that they should be erased if they form no part of the design. *Held* further, that the examiner should reject if such words, etc., are a part of the design, provided he is of the opinion that words and figures (numerals) may not form part of the subject-matter of a design patent. Ex parte Van Slyke, 60 O. G. 893, C. D. 1892.

102. The discretion of the commissioner of patents is not limited by the statute to dispensing with the model of a design. Ex parte Aumonier, 63 O. G. 1815, C. D. 1893.

103. Rule 83 (relating to drawings, etc.) is not "inconsistent with law" (Rev. Stats., sec. 483), and it has all the force of a statute. Id.

104. The chief draftsman is the proper person to decide whether a line-drawing can be made of a design. Id.

105. Granting the fact that *fac-similes* may be received as models or specimens, the question as to whether a line-drawing or photograph should be furnished is not affected thereby. Id.

106. In a design application showing more than one modification, applicant is permitted to show, describe and claim modifications generically. (Ex parte Hess and Hess (56 O. G. 1334) and Ex parte Finck (60 O. G. 157) overruled.) Ex parte Bark, 69 O. G. 369, C. D. 1894.

107. The use of mechanical terms in setting forth the relation of the parts of a design and their uses is not objectionable. Ex parte Lunken, 76 O. G. 785, C. D. 1896.

108. The three claims in a design patent covered (1) the body part, A, (2) the upper part or cover, D, and (3) the body part A and the upper part or cover D together. *Britton v. White Mfg. Co., 61 Fed. Rep. 93 (1894).

109. In a design, claims for the segregable features may be allowed, whether accompanied by a claim for the whole design or not. Ex parte Ringold, 58 MS. D., Nov., 1895 (Seymour, Com'r).

110. The drawing of a design application may include an illustration of the practical use of the device. Ex parte Bensinger, 59 MS. D., May, 1896 (Fisher, Acting Com'r).

111. A claim reading "In a design for a carpet, the body, A, substantially as shown" refers to the description as well as the drawing. *Whittall v. Lowell Mfg. Co., 80 O. G. 809, C. D. 1897.

112. Black and white drawings illustrating the designs in a design patent are to be considered as forms, into which may be filled a great variety of arrangements or effects of color or shades without affecting the patented design. *Id.

113. The essentials of a design are what cannot be changed without destroying its characteristic appearance; and where shading shown in the drawings may be reversed or removed without such effect, it must be considered as but one of many permissible ways of treating

the design, and therefore as an unnecessary addition to the conventional black and white outline drawing, which neither restricts nor enlarges the scope of the design. *Id.

114. A drawing of a design case should disclose the entire design, not merely a part thereof. Ex parte Parker, 80 O. G. 1892, C. D. 1897.

IX. Test of Identity.

(See Infringement, *supra.*)

115. The question is whether to the eye of the ordinary purchaser — and this is the recognized test in such cases — the designs of the plaintiff and defendant present the same appearance. *Macbeth v. Gillinder, 54 Fed. Rep. 171 (1891).

116. The true test of identity of designs is sameness of appearance — that is, sameness of effect upon the eye of an ordinary observer bringing to the examination of the article upon which the design has been placed that degree of observation which men of ordinary intelligence give. *Smith v. Whitman Saddle Co., 63 O. G. 912, C. D. 1893.

117. The novelty of a design is to be tested, not by investigation of the means employed for its creation, but by ocular comparison of the design itself with the prior designs in the art. *Braddock Glass Co., Limited, v. Macbeth, 70 O. G. 1799, C. D. 1895.

DISCLAIMER.

I. In Application.
II. In Patent (Under the Statute).

I. In Application.

1. The primary examiner should not and has no right to require applicant to "acknowledge the subject-matter shown to be old by the references," nor, indeed, to *acknowledge* anything else. Ex parte Massicks and Crooke, 88 O. G. 1487, C. D. 1887.

2. In such cases, if applicant "should claim things as new which the examiner clearly thought to be old, this would constitute no reason why the examiner should require an acknowledgment or recognition on the part of applicant that such things in dispute were really old. He should rather reject for that reason." Id.

3. Rule 36 contains nothing indicating that in presenting an application for a patent, the invention being a mere improvement, the applicant is required to disclaim anything that may be old. That rule only requires that the particular and specific claim of the applicant shall be put in such clear and unambiguous form that the public and any person called upon to construct the machine or device may be able to distinguish between the thing claimed as new and that which is old. Ex parte Firm, 39 O. G. 1199, C. D. 1887.

4. Neither rule 42 nor rule 104 has any application in the present case. The disclaimers contemplated by the former are between several applications of the same individual, covering, either by claiming or showing, the same device or invention, and the rule was adopted to prevent the party from procuring a prolongation of the monopoly of his patent by securing two patents for the same thing, and also to prevent an abuse which occasionally might occur of a re-issue upon a patent which showed but did not claim the whole invention. Id.

5. In Letters Patent No. 172,608, issued January 25, 1876, to John W. Cassidy, for an improvement in fruit-driers, the patentee first claimed "spring or other catches," but, on an objection that his application was not in proper form, amended by striking out "or other." *Held*, that this was not a disclaimer of gravity-catches, which were known mechanical equivalents for spring-catches. *Hunt Bros. Fruit Packing Co. v. Cassidy, 62 O. G. 1965, C. D. 1893.

II. In Patent (Under the Statute).

6. Where in the original there was a disclaimer of an earlier patent, and it appeared that in a subsequent interference proceeding it was determined that such subsequent patent was for a different invention, the omission of the disclaimer in a re-issue was proper. *Eames v. Andrews, 39 O. G. 1319, C. D. 1887.

7. After a decision by the supreme court that the first claim of the re-issue was invalid as being for an invention different from that of the original patent, the owner of the re-issue filed a paper setting out that the specification and claim of the re-issue are too broad, including that of which the patentee was not the first inventor, and disclaiming the first claim. *Held*, that this disclaimer was broad enough to carry with it all of the specification which was applicable only to such claim. *Tarrant v. Duluth Lumber Co., 39 O. G. 1425, C. D. 1887.

8. A disclaimer is properly employed for the surrender of a separate claim, or some other

distinct and separate matter, which can be rescinded without mutilating or changing what is left standing. Perhaps it may be used to limit a claim to a particular class of objects, or to change the form of a claim which is too broad; but certainly it cannot be used to change the character of the invention. *Hailes v. The Albany Stove Co., 42 O. G. 95, C. D. 1888.

9. Sections 4917 and 4922, Revised Statutes, have reference to the same sets of circumstances as grounds for disclaimer, the former authorizing the filing of a disclaimer and the other legalizing suits brought on such patents as have been amended under the first-mentioned section. *Id.

10. The patent might be held to be invalid on account of its covering the product, of which the patentee is not the inventor, and which is a material and substantial part of the thing patented (R. S. 4920); but regarding this as claimed through inadvertence, accident or mistake, without any wilful default or intent to defraud or mislead the public, the patentee may file a disclaimer to the second claim now, and thereupon have a decree for the infringement of the first claim, without costs. *Hake v. Brown, 47 O. G. 1071, C. D. 1889.

11. To disclaim the skein except for use in the process of dyeing would not change the patent into one for the process. The patent for the skein would still be void and the process of using it be still free from the patent. *Grant v. Walter, 47 O. G. 1220, C. D. 1889.

12. Where a case had been heard and decided upon its merits, *held*, the plaintiff could not file a disclaimer in court or introduce new evidence upon that or any other subject, except at a rehearing granted by the court, upon such terms as it thought fit to impose. *Roemer v. Neumann, 49 O. G. 1535, C. D. 1889.

13. Where a formal petition for rehearing had been filed to enable plaintiff to avail himself of a disclaimer filed after decision on the merits and the petition had been granted conditionally, *held*, that the terms imposed as a condition precedent to the rehearing not having been complied with the disclaimer was not in the case. *Id.

14. A patentee is not required to disclaim anything in the specification not covered by the claim, and it is only when the claim following the specification is too broad, in the sense of embracing something as new which is not new, that he is required by section 4922 to disclaim. *The Brush Electric Co. v. The Fort Wayne Electric Light Co., 50 O. G. 434, C. D. 1890.

15. Section 4917 of the Revised Statutes, relating to disclaimers, is broad enough to cover disclaimers made to avoid the effect of having included in the patent more devices than could properly be made the subject of a single patent. *Sessions v. Romadka, 59 O. G. 939, C. D. 1892.

16. Section 4917 of the Revised Statutes must be construed with reference to section 4922, and when so read the only effect of delaying a disclaimer until after the commencement of a suit upon the patent containing the disclaimed subject-matter is to prevent the recovery of costs. *Id.

17. A disclaimer to so much of the claim as does or might make such claim apply to a skein which by reason of being coated with gum or by reason of the manner of its lacing, or for any other reason, is not in condition for dyeing for ordinary manufacturing purposes, *held* to be insufficient to give any increased validity to the patent for a skein or to change it into one for a process. *Grant v. Walton, 63 O. G. 910, C. D. 1893.

18. Where a disclaimer has been filed by a patentee as a result of litigation, the validity of the patent as regards the question of novelty is to be tested not by its original terms and scope, but by what remains after the disclaimer, in the same manner as if the matter disclaimed had never been a part of the patent. (Dunbar v. Myers, 11 O. G. 35, 94 U. S. 194.) *Schwarzwalder v. New York Filter Co., 72 O. G. 1043, C. D. 1895.

19. The disclaimer of matter which is not a part of the description, but is merely a recital designed to enlarge the scope of the patent, operates merely to expunge from the claim what otherwise would, by force of the recital, be incorporated into it constructively. *Id.

20. It is not the office of a disclaimer to broaden a patent. In this case the elimination of one element of the claim clearly broadened it. If one element may be disclaimed out of a combination patent, there would be no limit to the changes which might be effected. *Cerealine Mfg. Co. v. Bates, 77 Fed. Rep. 883 (1897).

DIVISION OF APPLICATION.

(See DIVISIONAL APPLICATIONS; AMENDMENT—ELECTION AND DIVISION; INTERFERENCE.)

I. IN GENERAL.
II. APPARATUS AND PROCESS.
III. CLASSIFICATION IN PATENT OFFICE.

IV. PRACTICE.
V. PROCESS AND PRODUCT.
VI. STATUS OF INVENTION IN THE ARTS.

I. IN GENERAL.

1. When the applicant has a claim for a combination between several elements or parts, and the claim for combination cannot be sustained for want of co-operation, then division between the distinct elements or parts should be required in accordance with the principle hereinbefore announced. Ex parte Herr, 41 O. G. 463, C. D. 1887.

2. When inventions are so near the dividing line as to render impossible the determination with certainty whether in a proper sense coordination 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. Id.

3. While a patent would not be declared void, but would be supported in the courts, even though it might cover two independent inventions, the commissioner in the proper administration of the office is vested with the discretionary power to require division in certain cases. Ex parte Sartell, 42 O. G. 295, C. D. 1888.

4. The question of division as decided in Ex parte Herr (41 O. G. 463), re-examined and that decision adhered to. The case of Mosler Safe and Lock Co. v. Mosler, Bahmann & Co. (43 O. G. 1115) considered. Ex parte Simonds, 44 O. G. 445, C. D. 1888.

5. The practice of selecting one of the elements of a combination claim, as if it were claimed separately, and some other element which is claimed specifically outside the combination and requiring division, *disapproved*. Such practice denies an applicant the legal right to an appeal on his combination claim. (Ex parte Hyams, MS., v. 36, p. 200; Ex parte Gessner, id. 277.) By taking such appeal applicant forfeits no right, nor is his status changed with reference to the remaining claims in his application. Ex parte Gillette, 44 O. G. 819, C. D. 1888.

6. The determination of the present case must depend upon whether the invention consists of a new sewing-machine originally new in all its parts and elements, or only new in its combination of old or new elements or parts of each, or whether the invention consists simply of "improvements" upon parts of an old organism, but which do not disturb its original organism or identity as such. Ex parte Willcox and Borton, 45 O. G. 455, C. D. 1888.

7. Mere improvements upon an old element in a combination, which improvements do not change the identity of that element, will not render the element patentable in the same application with the combination. As corollary to this, several improvements upon parts of a distinct organism, which tend to improve the proximate result of the whole but do not disturb its identity, may be claimed in the same application. The "improvements" here contemplated do not embrace or relate to mere additions. adaptations of new parts, or attachments which are not incorporated in the old organism and do not assist in improving the specific function of the whole organism. Id.

8. Division must be required for two reasons: *first*, because the distinct subjects of invention ought not to be embraced in one application; *second*, because the applicant has not the right, by aggregating claims to any number of distinct inventions under a false claim to a combination, to force the office to examine and act upon his several inventions. Ex parte Carter, 46 O. G. 1391, C. D. 89.

9. Division of an application should not be demanded unless there is in the given case such a total want of interdependence between the two matters claimed as would render them absolutely independent and distinct inventions. Ex parte McMahan, 48 O. G. 255, C. D. 1889.

10. 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. Ex parte Lord, 50 O. G. 987, C. D. 1890.

11. The question of division has always been held to pertain to the administrative side of the functions of the commissioner; jurisdiction over this question is not changed by reason of its being presented in the present form. Ex parte Chambers, 51 O. G. 1943, C. D. 1890.

12. 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 the same application that they all relate to the same machine or apparatus and in various disconnected ways tend to improve

it. Ex parte Stearnes, 57 O. G. 1768, C. D. 1890.

13. Two sets of claims involving separate and distinct inventions may be joined in the same application if the inventions are dependent upon each other and mutually contribute to produce a single result. Ex parte Wahlquist, 42 MS. D. (2 G. W. D.), Jan., 1890 (Mitchell, Com'r).

14. The general rule is that when a new combination has been invented the several elements, if new, may be patented in the same application. Ex parte Blume, 45 MS. D. (3 G. W. D.), Jan., 1891 (Mitchell, Com'r).

15. Where, in an application for a patent describing a series of mechanisms in one machine performing certain functions in succession, the applicant made certain claims for combinations which were not limited in their scope to either one of the mechanisms of the series, and also other claims for elements and sub-combinations which were limited to one of the mechanisms of the series, but were also contained in the broader combinations not so limited, *held*, that division could not be required until it had been determined whether the broader combinations were true combinations within the meaning of the law. Ex parte Speckbauch, 54 O. G. 1265, C. D. 1891.

16. Where the machine improved upon is as a whole an old and well-known machine performing in succession a series of separate and distinct functions, and some of the improvements are limited in their scope to the mechanism performing one function, the remaining improvements being limited to other mechanism performing different functions, division should be required aud the claims should be grouped with reference to the mechanism to which they pertain. Id.

17. Athough it appears that certain claims in an application are for a mechanism capable of use in other relatious than that which forms the specific subject-matter of the application, division will not be required if these claims have elements in common with the more specific claims of the application. Ex parte Kerr, 58 O. G. 1553, C. D. 1892.

18. Where applicant's machine was in its entirety a mangle or ironing machine, *held*, that the examiner properly required division as to certain claims in the application which related purely to a belt-shifting device. Ex parte Wendell, 59 O. G. 630, C. D. 1892.

19. Within the limits of validity of the grant, claims for distinct but dependent inventions may be joined in the same application or be made in separate applications, at the option of the applicant. This general rule leaves to the discretion of the office the requirement of division in those exceptional cases in which the inconvenience resulting from a single application amounts to the necessity to divide, and leaves room, also, for the exercise of that inherent discretion necessarily left on this subject to the office. (Bennet v. Fowler, 8 Wall. 445.) Ex parte Demeny, 64 O. G. 1649, C. D. 1893.

20. Division required of an application having claims for (1) frame of a bicycle, (2) the bearings, (3) the brace, (4) the toe-clips. (Ex parte Burgess, 80 O. G. 1758, construed.) Ex parte Rose, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

21. Division is not required when certain claims relate to a machine, and other claims relate to mechanical elements which are also elements of the claims to said machine. It is not a question of difference of species, but of scope of claims. The invention is unitary. (Case distinguished from Ex parte Burgess, 80 O. G. 1759.) Ex parte Harris, 63 MS. D., Dec., 1897 (Greeley, Acting Com'r).

22. In an application for the manufacture of incandescent lamps, division was required between the part relating to the lamp and that relating to the exhausting apparatus, since there is not such an interdependence between the two as would warrant their being joined in one application. Ex parte Olan, 79 O. G. 861, C. D. 1897.

23. It does not follow because the courts would not hold a patent invalid that it is the duty of the patent office to allow more than one invention to be claimed in the same application. Whether a given invention or improvement shall be embraced in one, two or more patents is a matter about which some discretion must be left with the head of the patent office. Ex parte Burgess, 80 O. G. 1759, C. D. 1897.

24. Claims for distinct and independent improvements on a gun, one set of the claims being for a gun-barrel or false muzzle, which falls within a different classification from the other claims, cannot remain in the same application. Id.

25. "Although the classes in one division may relate to somewhat analogous arts, it does not follow that two inventions which belong in that division are so closely related as to be properly claimed in one application, since the

inventions may be as separate, distinct and independent of each other as if they belonged in different divisions." Ex parte Southgate, 62 MS. D., Aug., 1897 (Greeley, Ass't Com'r).

26. An applicant is entitled to claims embodying essentially different statements of the same invention, if the art permits. Division is not properly required when the parts of a unitary invention are claimed separately or in different combinations. Ex parte Shipley, 63 MS. D., Dec., 1897 (Greeley, Acting Com'r).

II. Apparatus and Process.

27. It must be regarded as settled by the very highest authority that an apparatus and a process are separate and distinct inventions. There is no requirement of law that they must or ought to be comprehended in a single patent, while there are many reasons why they should not be. A claim for a machine or apparatus and a claim for a process should be prosecuted in separate applications, and each, when allowed, comprehended in separate patents. Ex parte Herr, 41 O. G. 463, C. D. 1887.

28. The relation between process and apparatus is not that of genus and species, but of independent inventions. If the inventor of an apparatus is subject or tributary to a patent for a process, it is due to the patent law, which forbids all persons to use the invention of another for which a valid patent has been issued. Ex parte Atwood, 44 O. G. 341, C. D. 1888.

29. When a process and product, or a process and machine, are so intimately connected that neither can exist without the other, the process is only the function of the machine, or the structure of the product or method of its construction, and when this relation does not exist the process and product and the process and machine are independent and distinct inventions, to be solicited in different applications. A process which is merely the function of a machine does not constitute patentable matter. Such a process may be an industrial fact or entity inherent in a machine, or such a process may be inherent in its product; but then it possesses no patentable novelty as a separate invention. (Ex parte Blythe, 30 O. G. 1324.) Ex parte Simonds, 44 O. G. 445, C. D. 1888.

30. Where there is no express provision of the statute limiting or controlling the discretion of the commissioner in embracing more than one invention in the same letters patent, and the courts would not for that reason declare such a patent void, the statute does prohibit the introduction into re-issue patents of new matter or other invention than that covered by the original patent. The supreme court has held that under this prohibition no new matter could be introduced; that process and apparatus are separate and distinct inventions, and that when a patent for one has issued, although the other was distinctly shown, a reissue for both could not be maintained. (Burr v. Duryee, 1 Wall. 531; James v. Campbell, 104 U. S. 356; Powder Co. v. Powder Works, 98 U. S. 126; Heald v. Rice, 104 U. S. 737.) Ex parte Tainter, 47 O. G. 135, C. D. 1889.

31. When the apparatus cannot operate for any other purpose than to carry out the process, and the process can be carried out only by a machine operated substantially upon the principle of that shown by the applicant, division should not be required. Ex parte McMahan, 48 O. G. 255, C. D. 1889.

32. In such case there is no reason for requiring a division upon the ground that the examination of the office would be facilitated, because the field of search is precisely the same whether the application is divided or not. Id.

33. But one substantive apparatus for carrying out a process — other, of course, than mere sub-apparatuses — can be joined in the application with the process claims. Ex parte Bayne, 42 MS. D. (2 G. W. D.), Feb., 1890 (Mitchell, Com'r).

34. 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. Ex parte Lord, 50 O. G. 997, C. D. 1890.

35. Perhaps a good working rule would be that process and apparatus are presumptively connected in design and operation where the examination of both belongs to the same division of the office. Id.

36. 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. Ex parte Norwood, 50 O. G. 1129, C. D. 1890.

37. It is sufficient to justify joinder of process and apparatus if, as matter of fact, the single result had in view by the inventor as the

proximate purpose of his invention is contributed to by both process and apparatus. In such case there is mutual contribution and interdependence within the meaning of the rule. Id.

38. Where it appeared 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. Ex parte Hyde, 50 O. G. 1293, C. D. 1890.

39. 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 or 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. Id.

40. 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. Ex parte Chambers, 51 O. G. 1943, C. D. 1890.

41. When an application containing claims for a process and a described apparatus for practicing the process has been divided in compliance with the requirement of the office, and 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 covered 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. Id.

42. 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 claims as originally presented," there is no reason why claims for the process may not be incorporated, if seasonably presented and supported by supplemental oath. Ex parte Lillie, 53 O. G. 181, C. D. 1890.

43. There is no rule which excludes a case where apparatus and process are appropriately described and but one of them claimed from being brought within the scope and remedial agency of a supplemental oath. Id.

44. The amendment and supplemental oath should be seasonably presented. The applicant has as good a right to confine his application to either apparatus or process as he has to embrace both in his claims, and where division is optional it is accompanied by the responsibility of electing whether to divide or not and also by the obligation to stand by the election, when decisively made. Id.

45. 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 later application declared itself to be a division of the application first filed, which was identified also by serial number and date, *held*, that the later application was technically a division of the earlier. Forbes v. Thomson, 53 O. G. 2042, C. D. 1890.

46. The practice of the office recognizes the right of an inventor to secure protection in one patent for an apparatus and a process under certain conditions, but applicant has the right, if he so elects, to file separate applications for such inventions. Ex parte Hopkinson, 54 O. G. 264, C. D. 1891.

47. Division of an application as between claims for apparatus and claims for process is unnecessary where no wider range of search is required for the two than for the one. Ex parte Curtis, 57 O. G. 1128, C. D. 1891.

48. As a general rule claims for a process and claims covering means for carrying out such process may be joined in one application; but when the process belongs to one division of the office and the apparatus to another, joinder should not be permitted. Ex parte Everson, 63 O. G. 1381, C. D. 1893.

49. Claims to a method, if no such method is warranted by the original disclosure, rest upon an uncertain basis; but such claims, if so bound up with the apparatus of another application of the same inventor as not to warrant different ownership of the two, may accompany the real invention, which is the apparatus, proper oath being filed. Dewey v. Colby, 75 O. G. 1360, C. D. 1896.

III. Classification in Patent Office.

50. The decision in Ex parte Blythe (C. D. 1885, 82) re-affirmed in so far as it is held that congress has recognized the natural classification of arts as existing in four great divisions, and that a single and distinct invention clearly

belonging in one ought not to be joined in the same invention with an invention belonging in another division. This conclusion arises from the fact that congress has required a careful examination to be made of each application, has recognized classification as a necessary part of the system, has invested the commissioner with large discretion in the matter, and that without such arrangement and classification it is impossible to carry out the express requirement as to examination; but it is not based upon any statutory declaration or any ascertained intention of congress except as results from the system itself. Ex parte Herr, 41 O. G. 463, C. D. 1887.

51. There has been a general practice in the office to permit an applicant to claim in the same application and secure in one letters patent his combination and any *new* element which constitutes part of the combination, even though they are separate inventions. This has been allowed under a general proposition that the applicant may claim his invention as an entirety and also everything that goes to make up his invention — much as a grant for land in fee covers all the improvements, hereditaments and appurtenances to the soil itself. But this general proposition has been and must be modified by the important necessity and usefulness of classification in the arts. The examination required by statute renders it necessary that some regulation and classification shall be adopted by which such examination shall be complete and satisfactory in order to prevent the duplication of patents for the same thing. It follows that there should not be a commingling of different subjects in different classes of art in the same patent; for if this be allowed not only will examination by those expert in a specific art be rendered practically impossible, but the patent when issued can find no appropriate place in classification for reference when future applications are to be examined. Ex parte Willcox and Borton, 45 O. G. 455, C. D. 1888.

52. The classification in the patent office is not founded upon names and titles but upon the actual subjects of art. It determines what is or is not a machine, a tool or implement; whether it is generically new and original or is composite, made of two recognized old machines, tools or implements, or whether it presents mere additions to or improvements upon what already exists and is known. Id.

53. When one particular element of a machine is dependent upon and acts with the other elements thereof to produce a single result, it may be claimed in the same application with them without regard to the office classification. Ex parte Coe, 48 O. G. 1119, C. D. 1889.

54. An apparatus attached to a photographer's lamp for feeding a magnesium spray to the flame may be claimed in the same application with other parts of the lamp. Ex parte Jljinsky, 48 O. G. 1399, C. D. 1889.

55. Where all the elements which go to make up a complete device are so connected in design and operation as to form parts of one complete whole, they may stand in the same application regardless of the office classification. Ex parte Harris, 42 MS. D. (2 G. W. D.), Jan., 1890 (Fisher, Ass't Com'r).

56. Classification 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? And where all these questions could not be answered affirmatively as to the devices in question, *held*, that they were properly included in one application. Ex parte Bennett, 43 MS. D. (2 G. W. D.), July, 1890 (Fisher, Ass't Com'r).

57. Independent inventions 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. Ex parte Steinhilber, 57 O. G. 1720, C. D. 1891.

58. Where the inventions are classified in different divisions, such mere difference of the location of the inventions in the office classification is not the sole test in determining the question of division. Ex parte Demeny, 64 O. G. 1049, C. D. 1893.

59. The confusion and litigation likely to follow the grant of two patents which might come into the hands of two separate owners, neither having the full enjoyment of the right to work his own, if both be valid, and the doubt cast upon the validity of both, are more important considerations than the suggestion that the inventions are classified in different divisions. Id.

60. Where the requirement for division between dependent inventions was made because the sub-classes in the office classification have acquired a distinct place in the arts to which the several parts of this application would go,

held, that this in itself presents no ground for a requirement to divide. Ex parte Carr, 66 O. G. 653, C. D. 1894.

61. The time arrived long since when a proper classification in the patent office, so as to facilitate examination and prevent mistakes in the granting of patents, requires that improvements on an old machine having a distinct status in the arts and classified separately in this office should be preseuted in separate applications. Ex parte Burgess, 80 O. G. 1759, C. D. 1897.

IV. Practice.

62. 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. Ex parte Stearns, 46 MS. D. (3 G. W. D.), March, 1891 (Mitchell, Com'r).

63. Under rule 64 questions of form are always subordinate to those of merit. The question of division, being one of form, should, if the applicant declines to accede to the examiner's requirement, be postponed until after a final determination of the merits. Exception to this practice applies to cases in which the examiner is of the opinion that the patent, if granted, would be held invalid by the courts as covering two or more independent inventions. In such cases the examiner should reject for that reason. Ex parte Ofeldt, 54 MS. D., Feb., 1894 (Fisher, Ass't Com'r).

64. "Since the present inventions would be classified in oue division of the office, the state of the art on both of them should be cited before the requirement for division is insisted upon." Ex parte Southgate, 62 MS. D., Aug., 1897 (Greeley, Ass't Com'r).

V. Process and Product.

65. The examiner required division, and advised applicant that the product could be produced by other processes, but refused to state to applicant what those processes were. *Held*, that the examiner should furnish applicant with all the information upon which he bases his opinion that the product is not new, in order that applicant may act intelligently as to the requirement of division; that the examiner ought not, when he has information which would bar the issue of patent, require an applicant to go to the trouble and expense of filiug an application which must necessarily fail of success. Ex parte Pastor Perez de la Sala, 42 O. G. 95, C. D. 1888.

66. The opposite conclusion has been reached in regard to process and product when both were new and the process could produce no other product and the product could be made by no other process. This conclusion is based upon the premise that such process and product constitute one single invention. It must be deemed settled by the highest authority that such processes and products are not separate and distinct but uuitary inventions, and that the process and product may be regarded and claimed as parts of such invention, much as different elements in a combination may be separately claimed. This conclusion finds satisfactory support in the nature of the invention itself, as well as in the character of legal property residing in it. Ex parte Tainter, 47 O. G. 135, C. D. 1889.

67. This conclusion excludes all other cases of process and product, such as when either process or product is not new, or when the product can be made by some other process or the process will produce some other product. Id.

68. The novelty of the tablet in the present case doubted, but not determined; but the novelty and patentability of the process denied. The question of division in such case, being a preliminary one, must be settled first, and consequently the action of the examiner in requiring division is affirmed for this reason, and not upon the general proposition. Id.

69. Where the article of manufacture claimed could be made by other methods than that claimed, and the method, if practiced, would not necessarily eventuate in that particular article of manufacture, *held*, that division was properly required. Ex parte Greenfield, 58 O. G. 274, C. D. 1892.

70. It is the proximate result of the process and not its ultimate result which is to be considered in disposing of questions of division. Id.

71. 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 and examined in different divisions of the office, *held*, that Ex parte Fefel (57 O. G. 409) and Ex parte Curtis (57 O. G. 1128) presented no grounds for overruling the requirement of division. Id.

72. On appeal from examiner's decision requiring division between claims for a printing block or plate and the process of making it, *held*, that no wider range of search being re-

quired under the present practice of the office for both groups of claims than for one of them, division should not be required. Ex parte Hines, 60 O. G. 576, C. D. 1892.

73. 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. Id.

74. Where it appears that the process can produce no other product and the product can be produced by no other process, the process and product are parts of one invention, and division should not be required. Ex parte Demeny, 64 O. G. 1649, C. D. 1893.

75. Where, if the application were a patent containing claims for a process and product, it would not be invalid because of independent inventions, division ordinarily ought not to be required, and not unless some exceptional burden would be placed upon the office in conducting the examination. Id.

76. Where the examiner stated the issue to be whether articles made by numerous processes other than the applicant's process can be claimed in the same application, *held*, that if the issue is correctly stated it is in effect equivalent to a decision that the product is old, and, this being the case, the claims for the product could never pass to issue at all, either in this or in a separate application. Ex parte Kny, 65 O. G. 1403, C. D. 1893.

77. It is in the direction of good practice to forbear to order division between process and product claims unless in the exceptional cases alluded to in Ex parte Demeny, 64 O. G. 1649. Id.

78. The words "mutually contribute to produce a single result" are not confined to the result of the process, but to the ultimate result with a view to which the whole invention was made. Id.

79. Where a process and its product are claimed in one application the office will not concern itself with the inquiry whether the article might be made by any other process or whether the process will necessarily result in the particular product, for the purpose of determining whether division should be ordered between process and product. Ex parte Thomson, 66 O. G. 653, C. D. 1894.

80. The above inquiry would be no guide in the case where the process was new, as to which the office could not say with certainty whether it must always result in the product. Id.

81. Similarly, in the case of a new article such rule would require the office to solve the insoluble question whether the article might not be made by some other method not yet invented or discovered, or else when a known process had produced the article the order to divide would be followed by the rejection of the claim for the article as old. Id.

82. It has been the practice to require division upon an inspection of the prior art which is only cursory. Should the applicant follow the intimation of the office thus made and cancel one aspect of his claimed invention, and further, acting upon the intimation, should forbear to file a new application for the elements canceled, he might lose, upon the suggestion of the office, protection for a valuable invention. If, on the other hand, he should file a new and divisional application, and the cursory examination should turn out to be a correct disclosure of the prior art, and the process or its product, as the case might be, turn out to be old, that being the ground upon which division was ordered, the applicant would have been required to file a fruitless application. Id.

83. Process and its product concern inventions which are so related that they may, at the option of the applicant, be placed in the same application, he taking all the risks of future difficulties in the courts, and it is generally thought to be the better practice to include them both in one application, since division between process and product may produce confusion in the arts and conflicting interests, as intimated by the court in McKay v. Dibert (19 O. G. 1351, 5 Fed. Rep. 587), since no patent has been declared void by reason of the joinder of such claims, while many have been held to be valid, since manifest advantages would follow from one uniform rule as to division, and, more important than all else, since division or joinder approaches, if it does not present, a question of right in the applicant to choose between two courses, both of which are open to him, it is broadly announced that division in such cases will not be required. Id.

84. Requirement for division between claims for process and product overruled. Ex parte Kny, 58 MS. D., Jan., 1896 (Seymour, Com'r).

85. When, upon a requirement of division, claims for a process were canceled and an application was limited to the claims for an article, and a second application for the process was filed while the first application was pending, but not within two years from the can-

cellation of the process claims from the first application, *held*, that the process claims were not abandoned and that the second application was a division of the first. Edison v. Ball, 71 O. G. 1313, C. D. 1896.

86. Where a patent first describes a new and patentable process producing an article chemically or technically identical with an article formerly known, but superior thereto, and the invention is a meritorious one, a valid claim may be made for the product as well as for the process. *Matheson v. Campbell, 79 O. G. 684, C. D. 1897.

VI. Status of Invention in the Arts.

87. Among the rules and principles announced in Ex parte Herr for determining when division should be required was one applicable to combinations, and the proposition is there stated that in the case of a combination applicant may claim such combination and also any element therein which in itself is new and possesses individual utility separate from the combination; provided, that element has not already obtained a distinct location in the arts as an independent subject of invention and possesses utility in various other relations than that in which it is used in the particular combination claimed. Ex parte Sartell, 42 O. G. 295, C. D. 1888.

88. The classification referred to in Ex parte Herr was not a mere classification to be found in the different examining divisions of the office, and it was not intended that division of an application should be required because one examining division had one subject and another division another subject, both of which might be sometimes found in a combination; but the principle therein announced was based upon the determination of the fact as to whether the particular device sought to be made a part of a combination had become a separate and distinct subject of invention and classification, made so by the inventors and manufacturers themselves. Id.

89. In the case under consideration the inventors and manufacturing interests of the public have made the coupler a distinct subject of invention and manufacture, and applicant, therefore, ought not to be allowed to claim this particular invention in the present application, because as an individual coupler it is a distinct and separate invention from the combination, which it is claimed has for its object the heating of cars. Id.

90. An element forming part of a combination which has become the subject of general invention and manufacture, and which can be used in other relations, cannot be joined in the same application with claims covering the general combination. Ex parte La Borde, 44 O. G. 700, C. D. 1888.

91. Sub-mechanisms and parts of a machine which have not acquired a distinct place in the arts and the industries and are not capable of use in other relations, but are manufactured and sold to take the place of corresponding parts in the general organism which have been broken or worn out, are not required to be separately applied for and patented. Ex parte Willcox and Borton, 45 O. G. 435, C. D. 1888.

92. Where a combination of elements is held to be legitimate, the elements and sub-combinations may be claimed in the same application, unless they have acquired a definite status in the arts, industries and trades — that is to say, pertain to and are improvements upon parts or devices which have acquired such status. Ex parte Specbauch, 54 O. G. 1265, C. D. 1891.

93. In order to necessitate the dividing out of elements, when the combination as a whole is held to be patentable, it must appear, *first*, that the elements or parts of the invention which are to be divided out have obtained a definite place in art and manufacture, and *second*, that they can be used in other relations. Id.

94. A device which has obtained a distinct status in the industries and trade should be the subject-matter of a separate application. Ex parte Sawn, 54 O. G. 1561, C. D. 1891.

95. 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. Ex parte Hine, 58 O. G. 385, C. D. 1892.

96. Where a certain claim was considered as a *combination* claim and not a claim for *some of the elements* of the combination, *held*, that the subject-matter of the claim had not acquired a definite status in art and manufacture. Ex parte Connelly, 59 O. G. 787, C. D. 1892.

97. Where certain devices were claimed separately and also in combination, *held*, that division should not be required unless one or each of such devices could be used in other

relations and belonged to a class that had acquired a distinct status in manufacture and trade. Ex parte Learned, 63 O. G. 1062, C. D. 1893.

98. Where the respective structures have reached definite places in the arts and in the office classification, they cannot be claimed in the same application. Ex parte Korff, 64 O. G. 1397, C. D. 1893.

99. Where there are claims for specific structures and combinations of the structures, and the structures have acquired distinct status in the arts, division should be required between the claims for one of the structures and combinations of the structures on the one hand and the claims for the other structure on the other hand. Id.

DIVISIONAL APPLICATIONS.

(See SUBSEQUENT APPLICATIONS; DIVISION OF APPLICATIONS; RESERVATION IN APPLICATIONS; INTERFERING PATENTS.)

I. DIVISIONAL APPLICATIONS, IN GENERAL.
II. ISSUE OF.

I. DIVISIONAL APPLICATIONS, IN GENERAL.

1. By filing a second divisional application before a patent issued on the first, the applicant avoided and prevented the legal inference of dedication to the public. Ex parte Roberts, 40 O. G. 573, C. D. 1887.

2. Applicant has two or more separate and distinct applications pending, which show and describe, substantially, the same invention, in each of which respectively he has broad and limited claims, which are not, in the opinion of the examiner, drawn upon legitimate lines of division. An applicant should not be allowed to prosecute at the same time several applications for the same indivisible subject-matter. Ex parte Smith, 44 O. G. 1183, C. D. 1888.

3. Such practice would enable an applicant to defer the exercise of option as to which invention or sub-combination he will elect to be the subject of his patent in any one of the applications, and would result in enabling him to prolong the period of his monopoly. Id.

4. Applicants must make clear distinctions between the inventions in their respective applications; otherwise the task is thrust upon the office, which properly belongs to themselves, of defining and maintaining the lines between divisional applications, the perplexities and difficulties of examinations are increased, and repeated and careful comparisons of all cases made necessary at every stage of the proceedings. Id.

5. If the invention be of such a character that it is incapable of division upon proper lines, then the office should refuse to recognize or proceed with the consideration of the divisional application. Independent applications of this or any other kind must receive examination of a preliminary character, under rule 64, until some question arises beyond which the examination cannot proceed; but unquestionably the examiner ought not to be required to proceed with the consideration of such cases, examine them, and allow or reject them as if they were wholly independent, separate applications. Id.

6. When an application is filed describing and illustrating more than one invention, and during its pendency in the office another application is filed by the same inventor, stating that it is a division of the original application and claiming an invention so described and illustrated, the later application is to be considered a divisional application for the purpose of interference proceedings, whether or not the divisional invention was claimed in the first application. Forbes v. Thomson, 51 O. G. 207, C. D. 1890.

7. Where applicant filed an application containing a claim for a process declaring it to be a division of a former application, and it appeared that said process was not embraced or indicated in the claims or statement of invention as originally sworn to, and that no oath had been filed which included said process as any part of the thing for which a patent had been solicited, *held*, that the examiner was correct in ruling that the process claim as tendered could not be entered in the alleged divisional application. Ex parte Lillie, 53 O. G. 2041, C. D. 1890.

8. The application under discussion *held* not 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. Ex parte Freeman, 58 O. G. 522, C. D. 1892.

9. 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. Ex parte Fuller, 58 O. G. 804, C. D. 1892.

10. An application containing claims for new

matter in addition to claims for the matter shown and described in an earlier application of which it does not on its face purport to be a division is not a proper division of such earlier application. Searle v. Frumveller, v. Sessions, 58 O. G. 804, C. D. 1892.

11. Where an alleged divisional application describes and claims something different from what was disclosed in the original application, it is not properly a division of such original application. Ex parte Hunter, 60 O. G. 295, C. D. 1892.

12. The only questions for the examiner are whether or not the new application is a legitimate division of the earlier application, and whether or not the original application is in proper condition for the substitution of the divisional application. Ex parte Perkins, 61 O. G. 1015, C. D. 1892.

13. The action of the patent office allowing a separation of the claims is not conclusive upon the court but may be reviewed. In the patent office applications for patents are not severable except upon structural, *i. e.* physical, lines, which actually divide the machine into separable parts. *Fassett v. Ewart Mfg. Co., 58 Fed. Rep. 360 (1893).

14. A divisional application should only contain matter carved out of the parent case; but if the matter has been fully disclosed in the earlier application, although not reached by any claim or statement of invention, such disclosure should be sufficient to secure to the applicant the benefit of the date of the parent case. Ex parte Henry, 64 O. G. 299, C. D. 1893.

15. The matter claimed additional to what was claimed in the parent case should always be supported by a proper supplemental oath, or if claimed in the divisional application as first filed the oath prescribed by rule 46 should be correspondingly changed. Id.

16. In a divisional application the addition of mere details, such as braces for a frame, does not affect the status of such application as properly divisional, especially when such details were shown in other figures of the original not included in the divisional application. Phelps v. Hardy, v. Gattman & Stern, 77 O. G. 631, C. D. 1896.

II. Issue of.

17. When two applications by the same inventor are pending at the same time and it is stated in one that it is a division of the other, even if the divisional case should issue before the principal one and the inventor were responsible for the delay, the fact of such prior issue would in no way mislead the public. They never for a moment acquired the right to use the broad invention. *Brush Electric Co. v. Electrical Accumulator Co., 56 O. G. 1334, C. D. 1891.

18. Where an applicant has several alleged divisional applications pending at the same time and the examiner holds that there is no proper line of division between the respective applications, but one of the applications is ready for issue, while the others stand rejected on references, *held*, that the proper practice would be to pass to issue the application ready for issue, and if the other applications be further prosecuted, and the examiner still be of the opinion that there is want of divisibility between the claims of the respective applications, he reject them for that reason. Ex parte Cahill, 63 O. G. 1815, C. D. 1893.

19. When only one of several divisional applications is in condition for allowance, it is contrary to the recent decisions and practice of the office and inconsistent with rule 106 to withhold such application from issue until all the other divisional applications are ready for allowance. Ex parte Drawbaugh, 64 O. G. 155, C. D. 1893.

20. The doctrine announced in Ex parte Holt, 29 O. G. 171, that all the divisions of an application should be passed to issue simultaneously, overruled. Id.

21. There is no proper line of division between one application covering a specific rail and implying certain adjuncts and another application by the same inventor for the combination of the rail and the adjuncts, and one application should not go to patent while the other is in interference. *Porter v. Louden, 73 O. G. 1551, C. D. 1895.

DRAWINGS.

(See Amendment; Patents — Construction of, by Drawings.)

1. In describing a process, but few of many reference letters on the drawings, which show a complicated machine, were used. *Held*, that the lettering of the drawings should correspond to the references contained in the descriptive portion of the specification. Ex parte Borgfeldt, 49 O. G. 132, C. D. 1889.

2. An applicant may illustrate in his drawings the generic apparatus claim by more than one figure, provided his specific claims are all

confined to one preferred form of his invention. Ex parte Payne, 44 MS. D., July, 1890 (Mitchell, Com'r).

3. Present rule 51 prohibits the use of the same reference letter 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^2 A^3, thereby conforming to the rule and at the same time suggesting the presence of similarity and the absence of sameness. Ex parte Cook, 51 O. G. 1620, C. D. 1890.

4. A drawing filed as a part of an application cannot be transferred to a new application filed in place thereof. Ex parte Ayres, 51 O. G. 1944, C. D. 1890.

5. The number of sheets of an application drawing should not be more than is absolutely necessary. Ex parte Krause, 56 O. G. 1708, C. D. 1891.

6. The statute requires that drawings should be *signed*. Stamped signatures are not sufficient. Id.

7. The office rule requiring line-drawings in design cases *held* to apply to cases pending at the time of its adoption; but where, in such a case, the acceptance of a photograph had already been specially approved by the commissioner, ordered that the line-drawing be furnished by the office. Ex parte Poole, 61 O. G. 1655, C. D. 1892.

8. The discretion implied in section 4930, Revised Statutes, as to the requirements of drawing or photograph in design cases is vested in the office and not in the applicant. Id.

9. The discretion under rule 83 as to permitting the use of photographs in place of line-drawings vests in the office and not in the applicant. Ex parte Petzold, 61 O. G. 1780, C. D. 1892.

(The drawings should show the parts or elements of a machine combined as claimed, and separate views of each particular feature will not suffice. Ex parte Kemp, 15 O. G. 775, C. D. 1879.)

EMPLOYER AND EMPLOYEE.

I. Employer and Employee, in General.
II. Government Employee.

I. Employer and Employee, in General.

1. The relation of employer and employee cannot be established where it appears that one party received no pay whatever for his services, and that it was not pretended there was any promise of payment on the part of the other or expectation of payment on the part of the former, although it appears that there were frequent interchanges of courtesies between the parties and "in this interchange of courtesies that honors were easy." Wherry v. Heck, 49 O. G. 559, C. D. 1889.

2. Although a mechanic may be employed to devise and perfect a machine, and although the employer may clearly communicate the result to be attained by the machine proposed, yet if the idea of means, including the general plan and the specific details, is conceived and reduced to practice by the employee, the latter, and not the former, is the inventor, and to him the patent should be granted. Greenlee and Ström v. Roberts, 55 O. G. 1399, C. D. 1891.

3. To employ a mechanic to make one machine do what three machines have done is not to disclose the general plan of the 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. Id.

4. Although the relation of the employer to the employee may entitle the former to an equitable interest in the invention and patent therefor, it does not entitle him on that account to take the place of the inventor as the lawful grantee. Id.

5. Where the conclusion reached in the former opinion that the employer did not explain the invention in such a way that the machine could be built from the instructions given was professedly founded upon the testimony as to what took place prior to the building of the machine, and it appeared that all the testimony as to what transpired after as well as before the machine was built was considered so far as it had any bearing upon what instructions were given to the employee, *held* no error. Id.

6. Where a skilled workman is employed to embody an inventor's idea in practical form, the results are the property of the inventor unless they show that the workman has discarded the original idea and proceeded upon a wholly distinct and separate plan. Hisey v. Peters, 58 O. G. 1691, C. D. 1892.

7. Where an employer discloses the general idea and plan of his invention to an employee, 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 Wall. 583.) Hayes v. Hopkins, 59 O. G. 157, C. D. 1892.

8. Where one has conceived of an invention and discloses the essence of it to another whom he employs to develop and perfect it, suggestions from the employee in the course of experiments and dependent upon the main idea will not ordinarily give the employee any rights as an inventor. (Citing O'Reilly v. Morse, 15 How. 62, and Agawam Co. v. Jordan, 7 Wall. 583.) Webster v. Parkhurst and Ham, 60 O. G. 1325. C. D. 1892.

9. A manufacturing corporation which has employed a skilled workman for a stated compensation to take charge of its works and to devote his time and services to devising and making improvements in articles there manufactured is not entitled to a conveyance of patents obtained for inventions made by him while so employed in the absence of express agreement to that effect. *Dalzell v. Dueber Watch Case Mfg. Co., 63 O. G. 1381, C. D. 1893.

10. Where the testimony of the superior employee that he made the invention is corroborated by the mechanical engineer of the establishment; where the subordinate employee makes the pattern for the invention of his superior, but announces no claim at the time that he was the originator of it, and where the invention was openly manufactured there without a circumstance or fact occurring at the time showing the subordinate to be the inventor, and, still more, where the acts of both of them are more conformable to the probability that the former made the invention, and there is no indisputable fact that is not conformable to this theory, *held*, that the testimony leads to the conclusion that the superior employee was the originator of the invention. Leeman v. Smith, 66 O. G. 1307, C. D. 1894.

11. *Held*, that an employer may assume that he may allot the brain-work of his employees as he pleases and take out in the name of one a patent for an invention which he knows to have been made by another, because it may in some way suit his convenience, is an assumption that may be repudiated by the common sense of mankind. *Soley v. Hebbard, 70 O. G. 921, C. D. 1895.

12. A contract between an employer and employee, wherein the employee obtains service with the employer on condition that any improvement he may make on the machines of the employer shall be for the exclusive use of his employer, *held* valid. *Hulse and Wright v. Bonsack Machine Co., 70 O. G. 1498, C. D. 1895.

13. Where an employee made a device under the direction of his employer, who applied for a patent, and received an allowance, with the knowledge of the employee, who made no suggestion that the device embodied his invention, *held*, that the employer was the original inventor. Northall v. Painter, v. Bernardin, 71 O. G. [illegible] C. D. 1895.

II. Government Employee.

14. The chief of the government bureau of printing and engraving, being requested by his superior officer to devise an internal revenue stamp, conceived the idea of a self-canceling stamp, and under his direction the employees of the bureau, using government property and machinery, prepared a die for printing. Recommending the adoption of this stamp, he stated to the commissioner of internal revenue that he would make no charge for its use because he was in the government employ and used government machinery in producing it. He however applied for a patent, which was issued December 21, 1869, to his assignee, who brought suit for the use of said stamp. *Held*, that the government had a right to use the stamp without making any compensation therefor. (Affirming 21 Ct. Cl. 479, and 22 Ct. Cl. 335.) *Solomons v. United States, 54 O. G. 265, C. D. 1891.

15. Where one in the employment of the government experiments and finally perfects an invention, he is entitled to a patent therefor in the absence of an explicit assent and agreement on his part that his invention shall be the property of the government. (Discussing and distinguishing Solomons v. United States, 137 U. S. 342, 54 O. G. 265, C. D. 1891.) Riley v. Barnard, 59 O. G. 1919, C. D. 1892.

16. "Wherever inventions are the outcome of the assignment of the officers making them to the special duty of experimenting with a view to suggesting improvements upon existing methods, special facilities having been afforded them by the department to that end, it has been held that the product of their experiments is the property of the United States. If, however, an invention is the result of the personal enterprise and effort of the officer making it, no expense being incurred or facilities furnished by the government, the inventor is entitled to the fruits of his labor, and letters

patent issued to him for such invention are his property and cannot be acquired by the government without his consent and the payment to him of such royalty as he may demand." Annual Report of the Judge-Advocate-General (Lemley) of the Navy to the Secretary of the Navy, November, 1897.

17. A workman, in the employ of another, manufactured for him in his shop and with his materials and upon weekly wages, machines which the employer used as a part of his tools without objection, and for which the inventor obtained a patent during the term of his employment. *Held*, that the workman as patentee could not enjoin the use by the employer of the particular machines thus made. *Blauvelt v. Interior Conduit & Insulation Co., 80 Fed. Rep. 906 (1897).

EQUITY.

(See EVIDENCE; INJUNCTION; SUIT; INFRINGEMENT; TESTIMONY.)

I. BILLS — ORIGINAL, CROSS, AND SUPPLEMENTAL.
II. JURISDICTION.
III. PROCEDURE.
IV. TESTIMONY BEFORE AN EXAMINER.

I. BILLS — ORIGINAL, CROSS, AND SUPPLEMENTAL.

1. Where the assignment under which the complainant holds title employs, so far as the bill shows, such words as "all the right, title and interest," *held*, that the complainant had no right to a discovery prior to the date of transfer. *Kaolatype Engraving Co. v. Hoke, 39 O. G. 589, C. D. 1887.

2. Mere intention, not signified in an assignment of letters patent, to include therein claims for infringements previously committed, will not suffice to invest the assignee with any equitable title to those claims, and such assignee, after bill filed, in a suit for infringement brought by him, having procured an assignment of said claims, will not be permitted in that suit to set up by a supplemental bill this post assignment. *Emerson, Smith & Co. (Limited) v. Hubbard, 46 O. G. 976, C. D. 1889.

3. The court held that the whole basis and foundation of the present suit had disappeared by reason of its decree in a former case, and that the cause should be remanded to the circuit court with instructions to allow the appellant, defendant below, to file such supplemental bill as he may be advised, in the nature of a bill of review, or for the purpose of suspending or avoiding the decree, upon the new matter arising from the reversal of the decree in the former case. *Ballard v. Searles, 47 O. G. 655, C. D. 1889.

4. Leave to file cross-bill in proceeding under section 4915, Revised Statutes, denied, the object of the cross-bill being to enjoin the complainant from infringing a patent for the same invention already issued to defendant. *McCormick Harvesting Machine Co. v. Deering, 47 O. G. 1222, C. D. 1889.

5. The original bill not necessarily involving the question of infringement of the defendant's patent, such a cross-bill is not germane thereto. *Id.

6. The purpose of a cross-bill is to obtain discovery of facts in aid of the defense to the original bill, or to obtain full relief to all parties touching the matter of the original bill. *International Tooth Crown Co. v. Carmichael, 54 O. G. 1116, C. D. 1891.

7. The defendant in an equity suit for infringement of patent cannot file a cross-bill to enjoin the complainant from publishing the fact of infringement and thus interfering with his trade or business. In such case the fact sought to be presented by cross-bill, being at most merely an independent unlawful act by the complainant, would neither throw light upon the subject, nor avail to defeat the patent or justify an infringement of it, if valid. *Id.

8. A supplemental bill by the plaintiff, alleging that since the beginning of the suit plaintiff's patent had been adjudged valid by another court in a case to which defendant was not a party, on plaintiff's filing a disclaimer limiting the scope of the patent, and that in view of such disclaimer the two patents no longer interfere, will not be stricken out on general demurrer, as the facts alleged can be made to appear by supplemental bill only. *Electrical Accumulator Co. v. Brush Electric Co., 55 O. G. 573, C. D. 1891.

9. Under Revised Statutes, section 4915, the only question the court can consider is whether the complainant is the first inventor of a patentable device. Whether respondent or a third party was the inventor of the device for which respondent has received a patent should not be inquired into either by the court or by the commissioner in interference proceedings between

the same parties. *Christie v. Seybold, 64 O. G. 1650, C. D. 1893.

10. On a bill by the assignee of a patent against the assignors for infringement, praying for an accounting, defaults of the assignee in not complying with conditions of the assignment and other wrongs on his part, which do not authorize a forfeiture by the terms of the contract, are not grounds for a cross-bill by the assignors to cancel the assignment or to remove the cloud on their title to the patent arising therefrom or for other affirmative relief where all the matters complained of may be pleaded as defenses to the original bill and damages therefor may be considered on the accounting. *E. C. Atkins & Co. v. Parke, 68 O. G. 1519, C. D. 1894.

11. Where a defeated party to an interference in the patent office files a bill in equity, under section 4915, against his successful contestant and patentee as defendant, the propositions submitted by the defendant that under section 4915 something more than the ordinary *quantum* of evidence is required of the complainant and that the suit must proceed upon the same lines as though it were a bill filed to set aside a judgment at law, certainly have force. *Held*, however, that it was unnecessary to discuss them in this case, as the weight of evidence sustains the defense. *Rudolph v. Williams, 69 O. G. 642, C. D. 1894.

12. Claims canceled in the patent office cannot be reinstated or reviewed in bill in equity under section 4915, Revised Statutes. *Durham v. Seymour, Com'r of Patents, 71 O. G. 601, C. D. 1895.

13. Where in a suit under section 4918, Revised Statutes, after the filing of a cross-bill by defendant, and the right to affirmative relief thereunder having been decided adversely to defendant, and an appeal to the court of appeals, plaintiff assigned its patent, *held*, that the assignment did not abate the suit, but directed that when the case is remanded to the circuit court that court be instructed that if the assignee of complainant files an original bill, in the nature of a supplemental bill, within a designated time, and proof of interest is made, and the validity of title sustained, a decree in favor of the assignee be entered. *Appleton v. Ecaubert, 71 O. G. 1617, C. D. 1895.

14. When the suit was under section 4915, and not under section 4918, of the Revised Statutes, it is a continuation of the interference contest in the patent office, and the only question that can be considered is whether the complainant is entitled to receive a patent for the invention described in the bill and as specified in his claim filed in the patent office. *Standard Cartridge Co. v. Peters Cartridge Co., 72 O. G. 742, C. D. 1895.

15. Where on a suit under section 4915, Revised Statutes, much additional testimony was introduced, but it was mostly either in corroboration or in contradiction of the testimony in the interference case in the patent office, *held*, that the decision of the commissioner ought not be set aside upon merely cumulative or impeaching evidence, which is no ground for the granting of a new trial at law. *Id.

16. A party asking relief by bill of review must satisfy the court that the evidence upon which he relies could not, with the exercise of due diligence, have been secured prior to the hearing. *Bennett & Shepherd v. Schooley, 77 O. G. 1432, C. D. 1896.

17. Proof that respondent wrote to a firm of attorneys instructing them to send him copies of all patents relating to a certain subject does not amount to proof that such attorneys made a search to discover all such patents, though they sent a number, and presumption in favor of such search having been made is negatived by the discovery of the patents now urged in the place where prudence would have suggested a search. *Id.

II. JURISDICTION.

18. A bill in equity which sets forth a license to defendants to use certain patents embodied in machines leased to them by plaintiff, the license providing for payment of license fees, or purchase and use of license stamps, and for rendering accounts, and which alleges failure of defendants in their obligations under the license, and prays for discovery and account, and decree for payment of fees, and an injunction until such payment, shows a cause for equitable relief. *McKay v. Smith, 39 O. G. 959, C. D. 1887.

19. This court had jurisdiction because the complainant had equitable rights for which he had no remedy at law; the suit did not depend upon an injunction and the amount in dispute exceeded five hundred dollars. *Rogers v. Reissner, 41 O. G. 351, C. D. 1887.

20. A patentee is not compelled to sue at law and establish the validity of his patent. Questions affecting validity are usually heard and determined for themselves by courts of

equity. *Wise v. Grand Avenue Ry. Co., 33 Fed. Rep. 277 (1888).

21. A bill for a discovery and account, and for a decree for the payment of the royalties and damages sustained, and for an injunction against the use by the defendants in the meantime of any of the inventions recited in the license, exhibits a case for equity cognizance. *Hat Sweat Mfg. Co. v. Porter, Crofut & Hodgkinson, 44 O. G. 1070, C. D. 1888.

22. If the sole object of the bill was to enforce the payment of the royalties, the complainant would have an adequate remedy at law; but as discovery is sought as well, and an order to compel the defendants to perform their covenants or abstain from the use of the patents, and as the denial of equitable relief might result in a multiplicity of suits, equity jurisdiction is attained even in the absence of irreparable damage. *Id.

23. The general powers of a court in equity include the right to annul and set aside contracts or instruments obtained by fraud, to correct mistakes in them, and to require their delivery for cancellation or correction. *The United States v. The American Bell Telephone Co., 45 O. G. 1311, C. D. 1888.

24. A patentee who grants a license to manufacture and sell the patented article under a contract by which the licensee is to make monthly reports and pay a stipulated royalty, and for failure to comply with which the licensor may declare a forfeiture, cannot sue in equity to compel the licensee to make reports and account for royalties due, or on his failure to do so to enjoin him from further manufacture or sale. By such prayer he waives the forfeiture clause, and is left to his action at law for the royalties. *Washburn & Moen Mfg. Co. v. Cincinnati Barbed Wire Fence Co., 52 O. G. 2110, C. D. 1890.

25. It is more than doubtful if an original bill will lie to enjoin publications injurious to one's trade or business; and this upon the ground that the injured party has a complete remedy at law. *International Tooth Crown Co. v. Carmichael, 54 O. G. 1116, C. D. 1891.

26. Objection that equity has no jurisdiction comes too late when raised for first time at final hearing and after answer has tendered a number of issues upon which much testimony has been taken. *Vaile v. Buckeye Iron and Brass Works, 63 O. G. 1965, C. D. 1893.

27. The failure of a party in an interference proceeding in the patent office to raise the question whether his opponent's invention includes the issue declared in the interference does not estop such party to raise that question in an equity suit, under Revised Statutes, section 4915, to determine his right to a patent. *Christie v. Seybold, 64 O. G. 1650, C. D. 1893.

28. The preliminary objection of defendants that the complainants had created a close corporation, trust or syndicate to crush rivals and had resorted to vexatious and frivolous suits, compromises and other devices to control the market and fix prices of tobacco, and therefore that a court of equity should not and cannot aid the complainants in the prosecution of their unlawful designs, overuled, the court stating that, in the absence of fraudulent or improper conduct toward the defendants, the motives of the complainants in procuring and exercising their exclusive rights under the patents may not be the subject of judicial inquiry; that patent-rights are essentially monopolistic and patent contracts or contracts relating to patents are not subject to the general rules governing contracts in restraint of trade; and that it follows that a patentee may secure and protect his monopoly in any lawful way by suit, purchase, sale or combination; that a case requiring the most elaborate investigation and careful consideration cannot be considered vexatious and frivolous, and it is not in point to urge that other pending suits are without merit; that there can be no reason for the interference of the courts, notwithstanding the existence of patent-rights, to secure the uninterrupted manufacture of cigarettes, which are neither necessary nor beneficial to the public, and that there should be no interference by any department of the government with open competition in the markets. *Bonsack Machine Co. v. Smith, 73 O. G. 963, C. D. 1895.

29. Where in a patent case no equitable right is presented which cannot be made available at law, the parties should proceed in the usual manner in the action at law. The possible cost and expenses to which an applicant would be put by defending an action at law is no reason for enjoining such a pending action. *Germain v. Wilgus, 73 O. G. 1555, C. D. 1895.

30. The action of a patent owner in harassing purchasers with threats of litigation when no possible ground of action exists against them, even if the patent is valid, in attempting to dismiss his bill, whereby defendant, in order to prevent it, is compelled to file a cross-bill, and in delaying the taking of evidence until after defendant begins the taking of testimony, is not such as commends the cause to a court of

equity. *American Fibre Chamois Co. v. Port Huron Fibre-Garment Mfg. Co., 75 O. G. 836, C. D. 1896.

31. When a bill in equity discloses that more than forty-nine thousand machines are in use and charges a long-continued infringement and a purpose to continue therein, both upon the ground of avoiding a multiplicity of law-suits and upon the general and apparent inadequacy of a suit at law for damages, a court of equity has jurisdiction. *Heaton-Peninsular Button Fastener Co. v. Eureka Specialty Co., 78 O. G. 171, C. D. 1897.

III. Procedure.

(See Practice in the Courts; Pleading.)

32. In a proceeding under a bill in equity alleging the assignment of an invention to the complainant and the identity of said invention with an invention alleged by the defendant to have been subsequently made by him and not assigned, and also alleging the consequent ownership by the complainant of both inventions, and apparatus embodying both of said inventions being in possession of the defendant and inaccessible to the complainant, *held*, 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 inventions 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, 43 O. G. 511, C. D. 1888.

33. On a bill to set aside an alleged assignment of a patent by defendant as being a cloud on complainant's title, he claiming under an assignment of the inventor, the issue raised by the plea was that the patent belonged to defendant because it was included in an instrument executed while the application was pending, by which the inventor assigned to defendant all inventions and applications that did or might interfere with pending applications of defendant. Patents were afterward granted upon said applications of both parties. *Held*, that the presumption from this result is that the applications did not interfere, and the burden is on defendant, in order to sustain his plea, to show from the patents or their file or papers that there might have been such an interference. *Lowry v. Cowles Electric Smelting and Aluminum Co., 65 O. G. 295, C. D. 1893.

34. To a suit in equity to have an assignment of patent-rights, alleged to be fraudulent and to constitute a cloud on plaintiff's title, declared to be fraudulent and void, for the cancellation of such assignment and that the record thereof be expunged from the records of the patent office, the parties by whom the alleged assignment was made are indispensable parties, and no decree declaring the assignment fraudulent and void and directing its cancellation can be made in their absence. *Backus Portable Steam Heating Co. v. Commissioner of Patents, 66 O. G. 1893, C. D. 1894.

35. The rights involved in such a suit are strictly *in personam*, and no decree can be made affecting them unless it be founded upon control of the parties by the court after due process served or their voluntary appearance. *Id.

36. Where the title to a patent passed to the assignee upon a contract which was champertous, the assignee's bill in equity will be dismissed. *Keiper v. Miller, 71 O. G. 1916, C. D. 1894.

37. The assignee's title, founded upon an agreement that the assignee should bring suits at his own expense and divide with the assignor the amount recovered, is tainted with champerty. *Id.

38. Evidence was developed upon cross-examination of the patentee to require of complainant to set forth with fullness the actual contract upon which title to the patent was founded and to require of him to clear the contract of its champertous features. *Id.

39. The distinction between complainant's agreement upon which he sues and a champertous agreement for the compensation of an attorney discussed. *Id.

40. A court of equity will not grant a decree on another ground where the bill charges actual fraud as the ground for relief and the fraud is not proven. (62 Fed. Rep. 584, reversed.) *Dashiell v. Grosvenor, 74 O. G. 500, C. D. 1896.

41. A court of equity will not be overzealous in behalf of a defendant who persists in producing an old article which concededly contains all the elements save one of a combination uniformly forbidden him in previous suits. *Beach v. Inman, 77 O. G. 1275, C. D. 1896.

42. When it is urged by the defendant, a corporation, in justification of failure to answer certain interrogatories propounded that the complainants' waiver of an answer under oath is a waiver of all right to exceptions for insufficiency, *held* that, the cause being against a corporation only, an answer under oath, even if not waived by the bill, could not have been

required. Corporations answer under the sanction and solemnity of their seals only. But whether defendant answers under oath or under corporate seal, when oaths are waived they are required to answer fully on every material issue. *National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co. (No. 4,047), Chicago Railway Equipment Co. v. Interchangeable Brake-Beam Co. (No. 4,048), 81 O. G. 1423, C. D. 1897.

43. The waiver of an oath in any case is made by the complainant for the purpose of depriving the defendant of the advantage of his answer as evidence in his favor. If no such waiver is made, a sworn answer is taken as evidence in favor of the defendant so forceful as to require two witnesses or one witness and corroborating circumstances to overcome it. *Id.

44. The sole purpose of a waiver of an oath to an answer is to affect the evidential character and value of the answer. It has nothing to do with the answer as a pleading, and the rule prevails that the defendant must answer fairly and fully to each and every material fact alleged in the bill. This fair and full answer should serve the purpose of eliminating many undisputed facts from the case. *Id.

45. Equity rule 89 discussed and construed. *Id.

IV. Testimony Before an Examiner.

(See Testimony.)

46. On a motion for the appointment of an examiner to take testimony in an equity cause the court will not limit or restrict the taking of testimony or determine what is proper testimony. Objections taken to evidence on the ground of incompetency or irrelevancy properly come before the court at the final hearing. *United States v. American Bell Telephone Co. and Alexander Graham Bell, 48 O. G. 824, C. D. 1889.

47. Under the sixty-seventh rule in equity of the United States courts an examiner is required to note the exceptions, but cannot decide their validity, and must take down all the examination in writing and send it to the court with the objections noted. *Appleton v. Ecaubert, 55 O. G. 717, C. D. 1891.

48. The materiality of the questions propounded on the direct examination will not be passed upon in advance. *Id.

49. Testimony taken under a stipulation by the parties before an officer qualified, but without special appointment by the court, as an examiner, is beyond the control of the party in whose behalf it was taken, and cannot be withheld if the opposing party insists upon its introduction. *J. L. Mott Iron Works v. Standard Mfg. Co., 58 O. G. 277, C. D. 1892.

EQUIVALENTS.

(See Claims for.)

1. "Where change of form or combination only is involved, each inventor must be content with the structure described and claimed by him." "The doctrine of equivalents cannot be invoked to suppress improvements on a well-known machine." *Hill v. Sawyer, 31 Fed. Rep. 282 (1887).

2. Where there were a number of devices similar to that covered by the patent in existence when the patent was applied for, the doctrine of mechanical equivalents should have a restricted operation. *Archer v. Arnd, 40 O. G. 1032, C. D. 1887.

3. A stationary plate with radial slots and a perforated disk rotating in close proximity to the same in a prior patent is not the equivalent of complainant's stationary perforated plate and knives rotating in close proximity thereto. *Enterprise Mfg. Co. of Pennsylvania v. Sargent & Co., 42 O. G. 1403, C. D. 1888.

4. The mechanical devices used by the defendant are known substitutes or equivalents for those employed in the Morley machine to effect the same results, and this is the proper meaning of the term "known equivalents," in reference to a pioneer machine, such as that of Morley. *Morley Sewing Machine Co. v. Lancaster, 47 O. G. 267, C. D. 1889.

5. The doctrine of equivalents is as applicable to improvements and combinations of old elements as to original inventions and new devices. (Citing Gould v. Rees, 15 Wall. 192; Seymour v. Osborne, 11 Wall. 555, and Gill v. Wells, 22 Wall. 28.) *Tatum v. Gregory, 41 Fed. Rep. 142 (1890).

6. If two devices do the same work in substantially the same way, and accomplish exactly the same results, in the sense of the patent law they are the same devices, notwithstanding the differences in name, form or shape. (Cases cited.) *Harmon v. Struthers, 43 Fed. Rep. 437 (1890).

7. The invention being of a primary character, the patentee and his assignees are en-

titled in full measure to the benefit of equivalents. (Cases cited.) *Id.

8. 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, Ex parte, 39 O. G. 239; Cook, Ex parte, 43 MS. D. 1.) Ex parte Lockwood, 43 MS. D. (2 G. W. D.), June, 1890 (Fisher, Ass't Com'r).

9. 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 in a combination. If he desires some advantage beyond that which the law of equivalents gives him, he is seeking more than can properly be accorded to him. Ex parte Cook, 51 O. G. 1620, C. D. 1890.

10. 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 a positive and exact equivalent which performs the same functions in the same manner, the burden being upon the complainant to show this. *Dudley E. Jones Co. v. Munger Improved Cotton Machine Mfg. Co., 58 O. G. 274, C. D. 1892.

11. 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. *Id.

12. Where change of form or combination only is involved, the doctrine of equivalents cannot be invoked to suppress improvements, and each inventor must be content with the mechanism claimed by him. *Dederick v. Gardiner, 59 O. G. 790, C. D. 1892.

13. When patents deal with inconsequential details, each patentee must be confined to the precise structure which he has contributed to the art. (Cases cited.) There is no room in such a case for the doctrine of equivalents. *Dietz v. C. T. Ham Mfg. Co., 58 Fed. Rep. 367 (1893).

14. When an invention is of a primary character, a larger latitude is to be given to the doctrine of equivalents than if the art had been well explored. *Dederick v. Seigmund, 60 O. G. 1193, C. D. 1892.

(See numerous cases cited in this decision.)

15. When a combination patent covers a new arrangement of old elements, producing a new and useful result, the same may be protected by invoking the doctrine of equivalents, as against the substitution for any particular element of a different device known at the date of the patent as a means of performing similar work; and the fact that the substitute performs some additional functions does not prevent it from being an infringement. *Norton v. Jensen, 60 O. G. 1326, C. D. 1892.

16. In comparing the patented combination with the defendant's machine, "though some of the corresponding parts of the machinery are not the same, and, separately considered, could not be regarded as identical or conflicting, yet, having the same purpose in the combination and effecting that purpose in substantially the same manner, they are the equivalents of each other in that regard. *National Cash Register Co. v. American Cash Register Co., 62 O. G. 449, C. D. 1893.

17. Two things are the same in the sense of the patent law when they perform the same function in substantially the same way and accomplish the same result. *Sayre v. Scott, 63 O. G. 1818, C. D. 1893.

18. Complainants are not entitled to claim, broadly, the benefit of the doctrine of equivalents, which is rightly applicable to inventions of a primary character, Poyton being a mere improver, structurally, of an old and commonly-used device and having applied no new principle and produced no distinctively new result. *Vincent v. Rigby, 64 O. G. 861, C. D. 1893.

19. The substitution of spring-rockers for a pivot or hinge to produce a tipping movement in one of the plates of a lasting-machine is an infringement, for the two are equivalents. *McKay & Copeland Lasting Co. v. Dizer, 68 O. G. 281, C. D. 1894.

20. Where the patented machine never before existed, it will not be carrying the doctrine of equivalents too far to hold a device an infringement which does the same work as the patented machine, if not by the same, certainly by equivalent means. *Beach v. American Box Machine Co., 69 O. G. 1067, C. D. 1894.

21. The patentee is not "a pioneer in the art," and therefore the doctrine of equivalents does not apply to this case, so as to include all forms of devices which operate to perform the same functions or accomplish the same results. (Citing Miller v. Manufacturing Co., 151 U. S. 186.) *Wells v. Curtis, 66 Fed. Rep. 318 (1895).

22. Such an addition to the mechanical details of the combination embraced in the claims is within the doctrine of equivalents when the patented invention is a broad one, as this is, and cannot be evaded by the fact that the addition itself is an improvement. *Westing-

house Air Brake Co. v. New York State Air Brake Co., 70 O. G. 388, C. D. 1895.

23. *Held*, that powdered asbestos is the equivalent of powdered soapstone within the meaning of the issue. Pratt and Johns v. Thomson, 72 O. G. 1347, C. D. 1895.

24. As a general definition, a mechanical equivalent that may be properly substituted for an omitted mechanical element, device or agency in a patented machine is one that performs the same function by applying the same force to the same object through the same mode and means of application. As applied to a combination of old elements, it is special in its significance and materially narrower in its range than when applied to an invention consisting of a new device or an entirely new machine. *Carter Machine Co. v. P. H. Hanes & Co., 74 O. G. 1277, C. D. 1896.

25. In applying the doctrine of equivalents a distinction is made between inventions of specific devices and those of combinations. In a simple invention the range of equivalents is much wider than in a combination. In the former a change which would be held to be a substitution of equivalents may in the latter be considered to be an introduction of a new idea of means. *Erie Rubber Co. v. American Dunlop Tire Co., 74 O. G. 1443, C. D. 1896.

26. In applying the doctrine of equivalents it is essential there be an identity of function, and the function must be performed in substantially the same way by the alleged equivalents. *Engle Sanitary and Cremation Co. v. City of Elwood, 73 Fed. Rep. 484 (1896).

27. It is an essential rule governing the application of the doctrine of equivalents that not only must there be an identity of function between the two things claimed to be equivalents, but also that function must be performed in substantially the same way. *Engle Sanitary and Cremation Co. v. City of Elwood, 75 O. G. 1713, C. D. 1896.

28. Where an invention is fundamental the patentee should have the benefit of the doctrine of equivalents. *Société Anonyme Usine J. Cleret v. Rehfuss, Same v. Selig, 75 Fed. Rep. 657 (1896).

29. When two forms are known interchangeable substitutes for each other at the time of the patentee's invention, a claim for one must be held to include the other as its manifest equivalent. *Id.

30. For the purpose for which the thimbles or bushings are employed, metal is not the mechanical equivalent of wood. *Dodge v. Post & Co., 78 O. G. 339, C. D. 1897.

31. When at the date of the invention of an improvement the state of the art is such that an inventor can only claim the exact construction which he has selected as the embodiment of his improvement or its ordinary equivalent, the broad range of equivalents permissible in the case of a primary invention cannot be allowed. *Edward Miller & Co. v. Meriden Bronze Co., 79 O. G. 1520, C. D. 1897.

32. A patentee cannot speculate on the equivalents of his invention, and thereby oblige the public to resort to experiments in order to determine the scope of his patent. He has no right, when he has made a discovery relative to one or more specific substances of a certain class, to base upon this a contention that his patent relates to and covers the use of all substances of that class, especially when it appears that his discovery does not in fact relate to most of such substances. *Matheson v. Campbell, 79 O. G. 686, C. D. 1897.

33. Claims 2 and 5 of Letters Patent No. 472,004, and claim 2 of Letters Patent No. 472,005, granted to Charles H. Willcox, for a sewing machine, cannot be construed to cover defendants' device without unduly straining the doctrine of equivalents. *Willcox & Gibbs Sewing Machine Co. v. Merrow Machine Co., 81 O. G. 1613, C. D. 1897.

34. An equivalent is an element or device which was well known as a proper substitute for the one described in the specification at the date of the patent. Hence he is an infringer who employs a substitute which "performs the same function as the ingredient for which it is so substituted, and it appears that it was well known at the date of the patent that it was adaptable to that use." (Gill v. Wells, 22 Wall. 1.) *Norton v. Jensen, 81 Fed. Rep. 494 (1897).

35. The term "equivalent" is special in its signification when applied to an invention consisting merely of combinations of old ingredients, and somewhat different from what is meant when the term is applied to an invention consisting of a new device or an entirely new machine. *Id.

ESTOPPEL.

(See PRIOR ADJUDICATION; INJUNCTION, PRIOR JUDGMENT.)

1. The defendant in this suit having been a defendant in a former suit upon the same patent, where the assignor of the complainant corporation was the party complainant, and wherein the defendant had filed an answer

setting up substantial defenses and then permitted a decree by consent for nominal damages, with no costs, and with an injunction, *held*, that upon this state of facts it is not open to the defendant on this motion to deny the validity of complainant's patent in suit. *United States Metallic Packing Co. v. Tripp, 39 O. G. 1554, C. D. 1887.

2. The defendants, having had and enjoyed the exclusive rights under the patents, cannot question their validity. *Rogers v. Reissner, 41 O. G. 351, C. D. 1887.

3. Where a patentee has assigned his patent he is estopped, in an action brought against him for infringement by his assignee, from denying the validity of re-issues of his patent, though such re-issues were obtained since the assignee acquired an interest in the patent, and the latter might have known that they were void when he accepted them. *Burdsall v. Curran, 42 O. G. 1167, C. D. 1888.

4. A party applying for a patent as a joint invention of himself and another should be estopped as against a *bona fide* owner of the patent from defeating it by proof tending to show that he took a false oath or otherwise imposed upon the patent office. Having given life to the patent by one oath, he cannot be heard to destroy it by another. *Schlicht & Field Co. v. Chicago Sewing Machine Co., 46 O. G. 1394, C. D. 1889.

5. A former licensee is not estopped from questioning the validity of a patent after his license has expired in vindication of acts done subsequent to its termination. *H. Tibbe & Son Mfg. Co. v. Heineken, 47 O. G. 1221, C. D. 1889.

6. *Held*, that defendant was estopped from setting up the invalidity of the patents that were still in force, as it appeared that from the date of the license until after the period for which recovery was brought in this action the defendant acted under the license and enjoyed its benefits. *National Rubber Co. v. Boston Rubber Shoe Co., 50 O. G. 559, C. D. 1890.

7. Though a patent is void by reason of its anticipation by an earlier foreign patent, the patentee is estopped from urging that as a defense to a suit by his assignee for an infringement of the patent. *Adee v. Thomas, 51 O. G. 1132, C. D. 1890.

8. A patentee who has assigned his patent cannot deny its validity, as against his assignee, on the ground that it infringes another patent previously acquired by him, where the application for the assigned patent is sufficiently broad to include the previous one. *Adee v. Thomas, 51 O. G. 1134, C. D. 1890.

9. Where defendants admit that they have manufactured and sold under a license, and that they have assigned whatever rights they had thereunder, they will not be permitted to plead that they were led to make the contract by complainant's false and fraudulent representations, nor that the patent was invalid, as complainant knew. *Hatfield v. Smith, 54 O. G. 1802, C. D. 1891.

10. After a stipulation by the defendant that a decree might be entered for a royalty, he is estopped from claiming that the invention is useless. *Western Electric Co. v. La Rue, 55 O. G. 571, C. D. 1891.

11. One who has adopted and used in the manufacture of an article some feature covered by a patent is estopped from afterward denying the utility of the invention. *Gandy v. Main Belting Co., 59 O. G. 1106, C. D. 1892.

12. Where a manufacturer of mantels purchased two mantels of a design not then patented, for the usual price and for the avowed purpose of using them as copies in his business, *held* equivalent to the consent on the part of the inventor that the manufacturer might use the design, and that, having subsequently obtained a patent therefor, he could not maintain a suit for infringement against the manufacturer. *Anderson v. Eiler, 60 O. G. 740, C. D. 1892.

13. The fact that the defendant sought through one of his employees to obtain a patent for the device, *held* to be no ground of estoppel to prevent him from asserting that there is no patentable novelty in the device. *Haughey v. Lee, 66 O. G. 1450, C. D. 1894.

14. The rule that a patentee is estopped from claiming a construction of the claims equivalent to those canceled applies when the canceled claim is narrower as well as when it is broader than those rejected. (Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co., 67 O. G. 272.) *Johnson v. Olsen, 68 O. G. 1146, C. D. 1894.

15. Where the patents of several parties are assigned to a corporation, which corporation subsequently re-assigns to each party his patents in order that he might resume what he had put into the corporation, *held*, that this was a mere transfer of stock in the corporation and did not estop the corporation from denying the validity of the patents. *Electric Ry. Co. of the U. S. v. Jamaica & Brooklyn R. Co., 68 O. G. 769, C. D. 1894.

16. Where a patentee was advised by the patent office that his application disclosed, but did not claim, an invention claimed in a pending application by another party, and upon this information added claims for the invention, and the resulting interference was decided in his favor, but subsequently canceled the additional claims because the patent office, on change of opinion, rejected them on reference to a patent and took his patent with his original claims, *held*, that he was not estopped from insisting on his narrower construction of the original claims in order to avoid anticipation of them as not including the invention in the canceled claims nor met by the patent that caused their rejection and cancellation. *Id.

17. Where a party to an interference practically withdrew by means of a stipulation by which he agreed that the preliminary statement of the other party should be accepted as evidence, that no additional evidence should be received, and that priority should be decided on this evidence and without argument, and where, a patent having been issued to his opponent, he accepted a license thereunder, *held*, that the stipulation amounted to an admission of priority sufficient, as evidence in a suit for infringement, to show, *prima facie*, that the successful party in the interference was the first inventor. *Shoemaker v. Merrow, 68 O. G. 1523, C. D. 1894.

18. Where an interferant in the patent office dissolved the interference by canceling his claim for the specific element forming the issue, *held*, that he is estopped from asserting such element as part of his claim in his patent. *Id.

19. Where an applicant in the patent office withdrew claims which were rejected and substituted others with the statement that they were the ones on which he would want a final decision, *held*, that such action was a waiver by the applicant of his right to assert title to the withdrawn claims in a bill in equity under section 4915. *Durham v. Commissioner of Patents, 69 O. G. 507, C. D. 1894.

20. The assignment of a patent by a patentee for a valuable consideration estops him, when sued for infringement thereof by an assignee deriving title under the assignment, from setting up the question of validity, except as affected by the state of the art and anticipatory matter as a part of the state of the art, and these only as bearing on the construction of the patent. *Babcock v. Clarkson, 69 O. G. 1773, C. D. 1894.

21. In a suit for infringement brought by the assignee against the assignor of a patent the latter is estopped from denying its validity; but the prior state of the art is admissible in evidence to aid the court in the construction of the patent. (Ball & Socket Fastener Co. v. Ball Glove Fastening Co., 58 Fed. Rep. 818; Babcock v. Clarkson, 69 O. G. 1773, 63 Fed. Rep. 607.) *Martin & Hill Cash-Carrier Co. v. Martin, 72 O. G. 744, C. D. 1895.

22. An interference judgment in the patent office in a proceeding between the complainant and the patentee whose device the defendant is using does not estop the defendant from denying novelty and priority of invention of complainant's patent when the issue in such proceeding included an additional element and the only evidence that the defendant was a party in privity or that the opposing application was made in its interest rested upon a single inconclusive reply to a question. *McCarty v. Lehigh Valley R. Co., 73 O. G. 1707, C. D. 1895.

23. Defendants set up, as anticipating the patent sued on, another patent owned by complainant. It appeared that this patent, together with numerous others relating to the same art, owned by complainant and other parties, had by agreement been conveyed to a trustee to issue licenses to others for the use of all the patents, and that in this way licenses had been granted under the alleged anticipating patent, but not to the defendant. *Held*, that complainant was not estopped by reason of such licenses from showing, as against the claim of anticipation, that the patent in question was inoperative, and that the fact of such licenses was only evidential in character, as an admission, and its force as evidence was rebutted by the character of the arrangement under which the licenses were granted. *McCormick Harvesting Machine Co. v. C. Aultman & Co., 73 O. G. 1999, C. D. 1895.

24. When a claim of an application assigned was void at the time of the assignment, in view of references cited thereto, and the vendees completed the payment of the consideration after they learned that such claim had been rejected, their act amounts to an election of the remedy by ratification and estoppel in preference to that by repudiation for fraud. *National Conduit Mfg. Co. v. Connecticut Pipe Mfg. Co., 75 O. G. 1361, C. D. 1896.

25. The foundation of the estoppel against a vendor patentee to deny the validity of his patent is the fact that he has received and retained a valuable thing in consideration of the statement contained in the application. *Id.

26. Such a sale is an agreement by the vendor that, whatever may be the status of the patent as to the public, he will not thereafter interfere with the vendee's rights in the invention covered by the patent during the life of the patent. *Id.

27. Manufacturers being defendants, having stamped articles made by them under a patent in the manner provided by the statutes, and having accounted to and paid royalty to the patentee, are estopped to deny that they contain the patented improvement. *Andrews v. Landers, Frary & Clark, 75 O. G. 510, C. D. 1896.

28. Said defendants are not estopped to deny that other articles do not contain the patented improvement when such articles do not contain the elements of the patented article, have not been represented by them as containing such improvement, and when there is nothing to show that by any act or omission of theirs was the position of the patentee, who is the plaintiff, affected to his prejudice. *Id.

29. It would be carrying the doctrine of estoppel to an extravagant length to hold that an unsound and unsuccessful argument made in the patent office by the applicant with respect to a rejected claim should have the effect of imposing a destructive limitation upon allowed claims. An estoppel is not to be implied from circumstances of doubtful import. *Société Anonyme Usine J. Cléret v. Rehfuss, 76 O. G. 336, C. D. 1896.

30. From defendants in privity with former interferants with a patentee a contention that there is no patentable novelty in the invention comes with ill grace. *Fenton Metallic Mfg. Co. v. Chase, 76 O. G. 478, C. D. 1896.

31. The fact that defendant was a licensee cannot estop him from disputing the validity of the patent under which he takes his license in a suit for infringements charged to have taken place after the license was drawn, though in a doubtful case it might have considerable evidential force as an admission of validity. *Dueber Watch Case Mfg. Co. v. Robbins, 77 O. G. 154, C. D. 1896.

32. Under the rule that if one was silent when it was his duty to speak he shall not be permitted to speak when he should be silent, since defendants, when threatened with a former suit upon the patent now sued upon failed to claim any interest in said patent, they should not be permitted to assert it now. *Independent Electric Co. v. Jeffrey Mfg. Co., 78 O. G. 797, C. D. 1897.

EVIDENCE.

(See TESTIMONY; DEFENSES; ESTOPPEL; PLEADING.)

I. IN GENERAL.
II. ADMISSIBILITY.
III. WEIGHING.

I. IN GENERAL.

1. Where in the patent in suit the only cutting claimed was by a revolving knife in close proximity to a stationary perforated plate, and the contention of the defendants was that in their machine there was a preliminary cutting before the material reached the perforated plate, the silence of defendants' patent in this respect is persuasive evidence to the contrary. *Enterprise Mfg. Co. of Pennsylvania v. Sargent & Co., 42 O. G. 1403, C. D. 1888.

2. Orders procured by fraud which affect the rights of person or property or are injurious to the persons affected should be vacated; but an order recognizing the right of a party to secure and present to the court all his evidence in support of his allegations, which in no sense invades or affects the rights of his adversary, should not be disturbed. Osgood v. Badger, v. Bennett, 44 O. G. 1065, C. D. 1888.

3. Pullman, in his affidavit of April 1, 1889, forwarded to the patent office, stated that he completed his invention prior to the filing of the Sessions application, and it was contended by the defendants that Pullman finally obtained his patent because the patent office believed that his invention was prior to Sessions', and not that it embraced anything patentable outside of Sessions'. *Held*, that in the *absence of record proof* the court had no right to assume that the patent was issued on that affidavit or for that particular reason, it appearing by the record in the present case that Sessions swore that what Pullman said in his affidavit as to his invention was true in point of fact. *Pullman's Palace Car Co. v. Boston & Albany R. Co., 53 O. G. 1255, C. D. 1890.

4. When a patent has been referred to and used in the examination, marked as an exhibit in the cause by the examiner, and returned and certified as part of the record, it will be received as offered in evidence, even though the depositions contain no express minute that the patent was so offered. *Clark Thread Co. v. Willimantic Linen Co., 56 O. G. 395, C. D. 1891.

5. The doctrine of privileged communications is confined to cases of counsel, solicitor

and attorney. *Brungger v. Smith, 58 O. G. 388, C. D. 1892.

6. Testimony must be construed with reference to "the ordinary laws that govern human conduct." (Quoting and discussing Atlantic Works v. Brady, 33 O. G. 1330, 107 U. S. 192, and The Telephone Cases, 43 O. G. 377, 126 U. S. 1.) *Brungger v. Smith, 62 O. G. 1513, C. D. 1893.

(Motion for rehearing.)

7. Anticipations must be proven by evidence so cogent as to leave no reasonable doubt in the mind of the court that the transaction occurred substantially as stated. *Deering v. Winona Harvester Works, 69 O. G. 1641, C. D. 1894.

8. Certified copies of assignments are sufficient to establish *prima facie* evidence of title to a patent. *American Cable Ry. Co. v. Mayor, etc. of the City of New York, 64 O. G. 1008, C. D. 1893.

(Circuit court, Coxe, J.)

9. A copy of an assignment of letters patent, certified by the commissioner of patents to be a true copy from the records of the patent office, if objected to at the time of offer, is not competent evidence of title. *American Cable Ry. Co. v. Mayor, etc. of the City of New York, 67 O. G. 1334, C. D. 1894.

(Circuit court of appeals.)

10. The inventor's application oath, especially when accompanied by an affidavit filed in the course of prosecution further supporting its statements, is not to be overcome by the testimony of a former employee of the inventor after nine years of silence and after the death of the inventor so that the testimony cannot be met. *Thomson-Houston Electric Co. v. Winchester Avenue R. Co., 73 O. G. 2155, C. D. 1895.

11. It is not for a moment supposable that if a device produced in an incomplete state by the defense in a court suit was or had been practically operative, it would not have been produced in evidence in an operative condition. In view of this and in view of a finding by the supreme court that the original instrument did not disclose the complete invention and that all claims to the contrary are wholly unfounded in truth, such finding will be accepted as final and conclusive. Drawbaugh v. Seymour, Com'r of Patents, 77 O. G. 313, C. D. 1896.

12. The fact that one contestant witnessed the signature of a second contestant, as inventor, to a drawing made by the latter and disclosing the invention in controversy may be overcome by testimony in behalf of the first contestant that said drawing was intended to disclose as the invention of the second contestant an improvement merely and by additional facts tending to show conception by the first contestant and then disclosure by him to the second. *Standard Cartridge Co. v. Peters Cartridge Co., 78 O. G. 621, C. D. 1897.

II. Admissibility.

13. Parol evidence as to the existence of an established license for a patent is not hearsay. *Timken v. Olin, 51 O. G. 1469, C. D. 1890.

14. The foreign publication held to be 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 structure therein disclosed to the patented structure. *French v. Carter, 53 O. G. 1572, C. D. 1890.

15. Where in the preparation for trial of several suits it was agreed by the parties thereto that testimony taken in either of the suits might be used in either of them, and where the complainant introduced a patent in rebuttal in explanation of the record in one of the cases, but it was not mentioned in the pleading of either party and no testimony was given in respect to it, such patent is not admissible under the general issue in the other of the suits as an anticipation of the patent sued upon, without an amendment of the pleadings setting it up. *Vermont Farm Machine Co. v. Gibson, 64 O. G. 300, C. D. 1893.

16. That a witness may be twice called is a circumstance touching his credibility alone, and not the competency of the evidence. A second deposition by a witness, therefore, cannot, as mere matter of law, be excluded from the consideration of the various tribunals. Jenkins v. Burke, 77 O. G. 973, C. D. 1897.

III. Weighing.

17. A court would not be warranted in rejecting the positive testimony of two respectable and unimpeached witnesses as to the fact of invention at a certain date upon the presumption that the same idea, alike even in mutual details, could not have occurred to two persons in different continents without one of the persons had known of the other device. *Bliss v. Merrill, 42 O. G. 97, C. D. 1888.

18. An *ex parte* test made by the defendant

and a defective test made by the complainant *held* to be entitled to no weight in evidence. *Fernoline Chemical Co. v. Carolina Oil and Creosote Co., 46 O. G. 974, C. D. 1889.

19. When a cross-examiner allows an ambiguous answer of the witness to go unexplained, the mere uncertainty in the witness' answer will not necessarily be construed against him. His testimony will be considered with reference to the probabilities and surrounding circumstances. Woodward v. Burton, 57 O. G. 1597, C. D. 1891.

20. 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. Ligowsky v. Peters, v. Hisey, 57 O. G. 1593, C. D. 1891.

21. When the court takes the responsibility of branding as unworthy of belief the uncontradicted testimony of reputable witnesses, it should have some reason to advance for a course so unprecedented. *American Tubing and Webbing Co. v. Nicholls, 75 O. G. 183, C. D. 1896.

22. The negative opinion of a witness, however skilled or expert, that a drawing is meaningless of which he was not informed what the subject-matter was does not weigh greatly against the positive testimony of another witness who finds meaning in the same drawing, when the drawing itself appears naturally to support such meaning. All the testimony must be construed together and in such manner that, like charters and statutes, it may have meaning, if it reasonably may, rather than that it fall away. Scudder v. Mergenthaler, 76 O. G. 1851, C. D. 1896.

23. Numerous witnesses of unquestioned credibility concurring in one matter may nevertheless be mistaken, particularly upon the question whether what is shown them as they testify is the identical thing which they saw more than two years before. In such a case, in weighing the testimony, the circumstances must be taken into account, considering that that which is conformable to experience is more probable than that which runs counter to it. Johnston v. Stone, 77 O. G. 2137, C. D. 1896.

24. The inherent improbability of the story is sufficient to negative the testimony of witnesses. *Dodge v. Post & Co., 78 O. G. 339, C. D. 1897.

25. Evidential weight of alleged declarations of one contestant in favor of his opponent, in a suit under Revised Statutes, section 4915, is much impaired by the fact that, though accessible, they were not introduced during the interference proceedings. *Standard Cartridge Co. v. Peters Cartridge Co., 78 O. G. 621, C. D. 1897.

26. *Held*, that the decided weight of the evidence supports the claim of the appellee, and that the decision of the commissioner of patents is correct and must be affirmed. *Roberts v. Brinkman, 79 O. G. 1100, C. D. 1897.

EXAMINATION OF APPLICATION.

(See AMENDMENT; CLAIMS; INTERFERENCE; PATENTABILITY; DIVISION OF APPLICATION.)

I. IN GENERAL.
II. INFORMATION AND ADVICE TO APPLICANTS.
III. LIBERALITY IN ALLOWANCE OF CLAIM.
IV. REJECTION.
V. ACTIONS OTHER THAN REJECTION.

I. IN GENERAL.

1. Any opinion which the examiner of trade-marks may express as to the propriety of covering matter by a mechanical application is purely *dictum* and cannot bind the examiner before whom the question of patentability comes in regular order. Ex parte Eiche, 41 MS. D. (1 G. W. D.), Oct., 1889 (Fisher, Ass't Com'r).

2. Where no references are found, no questions of form are to be antecedently insisted upon which are inconsistent with the allowance of the broadest claims to which the inventor of a new machine or art is entitled. Ex parte Ambler, 41 MS. D. (1 G. W. D.), Oct., 1889 (Mitchell, Com'r).

3. An application which is practically a division of another pending application will not be given precedence in order of examination because of applicant's intention to obtain foreign patents and because the time for payment of final fee on the parent application is about to expire. Ex parte Dickermann, 52 MS. D., Feb., 1893 (Frothingham, Ass't Com'r).

4. A requirement for new drawings waived until the result of action on the merits shall enable applicant to determine to what extent the application can be advantageously prosecuted. Ex parte Herzog, 60 MS. D., Sept., 1896 (Fisher, Acting Com'r).

5. Rule 63, section 3, giving preference in ex-

amination to applications for inventions patented abroad, applies to interference proceedings at every stage of their progress. Bolt v. Burton, v. Gatchell, 62 MS. D., Sept., 1897 (Greeley, Acting Com'r).

(It had been previously the custom not to apply the rule after formal declaration of an interference by the primary examiner.)

6. A petition taken from the action of the examiner rejecting claims on the ground of inoperativeness of the device and suggesting a model as a possible way in which the operativeness might be established, although the structure of the apparatus was understood, was dismissed, holding that, the claims being rejected, the applicant may either show to the examiner that the apparatus is operative or appeal to the examiners-in-chief. Ex parte Beach, 80 O. G. 1476, C. D. 1897.

7. The commissioner should not be called upon to instruct an examiner as to how he should act upon an application or pass upon questions arising during the prosecution of a case until the case is properly before the commissioner by petition or appeal. It is the examiner's duty to act on applications as they come before him, using his best judgment in deciding any question that may arise in the consideration of the case. If exception is taken to his ruling, there is relief by petition or appeal. Ex parte Sellers, 81 O. G. 803, C. D. 1897.

8. An application will not be transferred from one division to another on the ground that it is not receiving proper treatment by the examiner in charge of it. Other relief will be applied when it is clear that an examiner is not performing his duties as he should. Ex parte Weaver, 81 O. G. 967, C. D. 1897.

9. While a claim deemed allowable by one examiner is always subject to rejection by his successor upon references or reasons not before considered, and it may be, in exceptional cases, on the references previously considered, the spirit of rule 144 would seem to indicate that the favorable action of an examiner should be at least extremely persuasive upon his successor. Ex parte Nealon, 81 O. G. 1787, C. D. 1897.

II. Information and Advice to Applicants.

10. It is the duty of the examiner when he is satisfied that an application contains a patentable invention which is not claimed, but which he has reason to believe the applicant is seeking to cover, to advise the applicant briefly and specifically in the premises, precisely as the examiners-in-chief and commissioner are authorized to make suggestions and recommendations. Ex parte Donovan, 44 O. G. 698, C. D. 1888.

11. Rules 68 and 139 provide that at all times in the investigation of an application and in the progress of appeals it is the duty of each tribunal to see to it that the inventor shall secure a patent for whatever patentable subject-matter may be shown in his application. The office must put itself in the attitude of a friend and not of a litigant with the applicant. Id.

12. It should never be a work of supererogation on the part of an examiner to give to 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 or appeal. Ex parte Burt, 49 O. G. 1936, C. D. 1889.

13. When an applicant asks for advice, there is no reason why it should not ordinarily be given. Rule 14 makes an exception "as to questions arising within the office." Ex parte Bailey, 52 O. G. 608, C. D. 1890.

14. On petition that the references be explained and their pertinency pointed out as clearly and fully as would be done in the examiner's answer to appeal, should appeal be taken, *held*, that an applicant is entitled, before the case is closed before the examiner, to an explanation of the references and their bearing on the claims rejected, as full and clear as any explanation that would be considered necessary to be made at any subsequent stage in the progress of the case. Ex parte Barnes, 80 O. G. 2038, C. D. 1897.

(An attorney may properly ask information from an examiner, orally or in writing — say his opinions on points of interference — when it is done in good faith; but in the particular case, *held*, the counsel being experienced, it is unnecessary to instruct him in respect to the references (patents). Ex parte Deacon, Fleming and Neimau, 30 MS. D. 1888 — Montgomery, Com'r.)

III. Liberality in Allowance of Claim.

15. The patent office, in cases where the prior art admits of such a course, should grant to the applicant a claim or claims which will enable him to cover his invention, even when an infringer interchanges or reverses some of the elements, otherwise the invention made is inadequately protected. Ex parte Tobie, 50 O. G. 992, C. D. 1889.

16. 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 which is commensurate with the extent and importance of the invention which he desires and is entitled to protect. While the office will insist upon 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. Ex parte Pacholder, 51 O. G. 295, C. D. 1889.

17. 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. Id.

18. When 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. Ex parte Fanshawe, 57 O. G. 1127, C. D. 1891.

19. An applicant will generally be allowed all possible latitude in framing his claim. Ex parte Cahill, 63 O. G. 1815, C. D. 1893.

20. There being no doubt as to lack of invention in this case, there is no room for the application of the doctrine which the appellant enunciates — that in cases of doubt of invention that doubt should be solved in favor of the applicant. Ex parte Snider, 66 O. G. 1309, C. D. 1894.

IV. Rejection.

21. Claims rejected during the pendency of an application should be prosecuted under the regular course of appeal pending the issue of the patent, and not by a separate application on a so-called division after the issue of the patent. Ex parte Ransom, 40 O. G. 119, C. D. 1887.

22. An applicant has the right to present claims to combinations, and he cannot be deprived of those claims by the requirement for division. If there be no combination, but only aggregation, the claims must be rejected and the applicant allowed his right of appeal before division can be required. Ex parte Willcox & Borton, 45 O. G. 455, C. D. 1888.

23. Amendments which present claims involving a departure from the original invention should be admitted for consideration, and (under rule 133) rejected for such reason. Ex parte Regan, 45 O. G. 589, C. D. 1888.

24. The action of the examiner requiring a division before the question of combination was finally disposed of was irregular. The commissioner has repeatedly held that when a claim is presented which, in the opinion of the examiner, does not cover a patentable combination, the proper course for the examiner to pursue is to reject for such reason, in order that applicant may exercise his right of appeal to the examiners-in-chief. Ex parte Bullard, 45 O. G. 1569, C. D. 1888.

25. 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 is to enable persons skilled in the art to practice 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. Ex parte Laskey, 48 O. G. 539, C. D. 1889.

26. The examiner should act with reference to all questions which may be raised in rejection of any or all of the claims, so that the case may go forward to the examiners-in-chief as a whole, and all matters relating to patentability may be determined by that tribunal in one proceeding. Ex parte Burt, 49 O. G. 1986, C. D. 1889.

27. An action by an examiner, which, if incorrect, would entitle the applicant to an appeal upon the merits, should consist in a full rejection, and not merely in noting that the claims are objectionable. Ex parte Baker, 49 O. G. 1363, C. D. 1889.

28. Where the examiner had objected to a claim because of its undue breadth only, and declined to further 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 and not why an examination should be refused. Ex parte Opdyke, 50 O. G. 1293, C. D. 1890.

29. All grounds of rejection should be stated by the examiner, in order that the entire merits of the application may be determined upon a single appeal to the examiners-in-chief. Ex parte Wiard, 51 O. G. 155, C. D. 1890.

(See, also, Ex parte Roberts, same volume and page.)

30. An application having been rejected upon the ground that its claim described an

article of manufacture merely by the process of making it, which rejection was sustained by the examiners-in-chief and the commissioner, upon petition the application was remanded to the primary examiner for an examination upon the merits, so that if it should be desired to take an appeal to the supreme court of the District of Columbia the whole case might go up at one time, 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. Ex parte Rogers, 52 O. G. 460, C. D. 1890.

31. 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 each appeal, take a decisive step forward toward completion. Ex parte Bailey, 52 O. G. 608, C. D. 1890.

32. A patent granted subsequently to applicant's filing date, but on an application filed prior thereto, which patent shows and describes, but does not claim, the invention, is a proper reference. Ex parte Eddleblute, 52 O. G. 751, C. D. 1890.

33. 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. Ex parte Perkins, 53 O. G. 139, C. D. 1891.

34. Where the claims of an application are rejected in whole or in part, it is the duty of the commissioner to notify the applicant in order to enable him, if he desires, to make his description and specification of claims more specific and precise. *Pullman Palace Car Co. v. Boston and Albany R. Co., 53 O. G. 1255, C. D. 1890.

35. The proper course to be pursued by an examiner on discovering a new ground for rejection subsequently to an appeal to the examiners-in-chief is to direct the attention to it of both 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. Ex parte Mevey, 56 O. G. 805, C. D. 1891.

36. The action of the examiner requiring the elimination of claims because they presented illegitimate combinations overruled, and *held* that in such case the examiner is required by the rules to *reject* the claims. Applicant is entitled to have his claims allowed, or to have them rejected in such language as to make it unmistakable that action has been had under Revised Statutes, section 4909. Ex parte Wiard, 57 O. G. 155, C. D. 1891.

37. The following practice is prescribed in the treatment of *ex parte* cases: 1. The first action (unless there are vital objections 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 in condition for such action. Ex parte Eastman, 57 O. G. 410, C. D. 1891.

38. If the examiner is of the opinion that there is a want of divisibility of invention between the claims of an application and the claims of a patent to the same applicant, both applications having been pending concurrently, he should *reject* the claims of the application for that reason. Ex parte Feister, 61 O. G. 152, C. D. 1892.

39. Rule 65 provides that when a case is rejected by an examiner "the reasons for such rejection will be fully and precisely stated, and such information and references will be given as may be useful in aiding the applicant to judge of the propriety of prosecuting his application or of altering his specification," and when an applicant receives an office letter stating objections to his application, and he, without demanding action under said rule, proceeds to ask for a reconsideration, which ultimately results in a second rejection, he has waived any right he may have had under the rule. Ex parte Mahlecke, 61 O. G. 285, C. D. 1892.

40. The question whether or not a claim for a so-called "process" is a claim for the function of a particular machine is one relating to the merits. The examiner's action in such a case should take the form of a *rejection*. Ex parte Williams, 61 O. G. 423, C. D. 1892.

41. A rejection for "lack of invention," *held*, in effect, a rejection for "want of novelty," and that the examiner must cite references under rule 66. Ex parte Clifford, 62 O. G. 316, C. D. 1893.

42. An examiner should not merely object to claims, but should make his objection the basis for rejection. Ex parte Bishop, 63 O. G. 153, C. D. 1893.

43. A claim containing words of limitation which are dependent upon the location or operation of mechanism that forms no part of the invention claimed and is neither shown nor described is objectionable. Ex parte Baackes, 63 O. G. 909, C. D. 1893.

44. Parenthetical clauses which do not contribute to clearness or exactness in stating the applicant's invention, but which at least are only superfluous, will not be allowed. Ex parte Cahill, 63 O. G. 1815, C. D. 1893.

45. Final rejection should not be given until all matters of form are settled. Ex parte Klaus, 64 O. G. 299, C. D. 1893.

46. A rejection may be given upon a patent granted to the same inventor upon an application which was pending concurrently with the application containing the rejected claim, and such rejection is, like all others, appealable to the examiners-in chief. Ex parte Hulbert, 66 O. G. 315, C. D. 1894.

(See, also, Ex parte Feister, 61 O. G. 152, C. D. 1892.)

47. The examiner decided the claims were met by the references, but the examiners-in-chief held there was no invention in the device. Ex parte Fergusson, 66 O. G. 651, C. D. 1894.

48. Complete anticipation is rare, and to reject a claim on the ground that it is substantially met by a reference is practically the same as to reject it on the ground of lack of invention in view of the reference, such differences as remain not involving invention. The two grounds of rejection, as applied to this case, are the same subject-matter of thought viewed from different points. Id.

49. Whether an amended claim can properly be finally rejected on the first action does not depend upon avoidance of the references, but whether, as a matter of language, the amended claim presents the same idea of invention as the old one. (Ex parte Pfeffer, 66 O. G. 845; Ex parte Griswold, 50 O. G. 838.) Ex parte Holland, 62 MS. D., Aug., 1897 (Greeley, Ass't Com'r).

50. An examiner may always reject on new reasons or references a claim which his predecessor deemed allowable, or, in exceptional cases, upon a reference previously considered; but the favorable action of the former examiner should be at least extremely persuasive upon his successor. Ex parte Nealon, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

51. In this case the favorable view of the former examiner, and the fact that the application has been twice in interference, are evidence of full and careful consideration and the claim should be allowed to remain. Id.

52. It is not necessary that a duly certified transcript record of a case in a federal court be filed in the patent office in order to render it competent for its tribunals to take notice of and be guided thereby. The officials of the patent office are not obliged to find their conclusions and judgments upon such evidence produced in such manner and form as is required by the rules of common law. They are not confined to merely technical evidence, but may resort to any source of intelligence upon which they can reasonably and safely act. The findings and judgment of a court as published in an official report are therefore competent to them, and were in this case ample ground for the rejection of claims. *Drawbaugh v. Seymour, Com'r of Patents, 77 O. G. 313, C. D. 1897.

V. Actions Other than Rejections.

53. In an application for patent for "a mere improvement" the primary examiner may require applicant, in conformity to rule 36, to "broadly point out the parts to which it (the improvement) relates," and "by explicit language distinguish between what is old and what is claimed as new." Ex parte Massicks and Crooke, 38 O. G. 1489, C. D. 1887.

54. When an application contains claims both for genus and for several species, one of which latter claims imperfectly describes a feature clearly illustrated in the drawings, it is irregular on the part of the examiner to first require applicant to elect which of the species he will retain and prosecute. Ex parte Johnston, 40 O. G. 574, C. D. 1887.

55. The first proper action in such case is for the examiner to require applicant to amend such claim so as to disclose the subject-matter thereof more clearly. Id.

56. In examining an application there are two steps to be taken: *first*, to determine whether it is in proper form; *second*, the consideration of the merits. These steps are to be continuous and practically one, except where a *vital* objection as to form exists. In such a case the examiner will proceed no further, but clearly point out to applicant the objections, and inform him that no action on the merits can be taken until the informalities are removed. Ex parte Mill, 40 O. G. 918, C. D. 1887.

57. When the formal objections are not *vital*,

or when found to exist in certain claims only, while others may be free from objection, the examiner will proceed to consider the merits, and in his first letter clearly point out to applicant the formal objections, reject the one class of claims and allow the others, and further state that further action on the merits cannot be had until the formal objections are disposed of. By such course the applicant receives at the earliest moment full information as to the opinion of the office upon his application, and is enabled to act advisedly, and the examiners are saved multiplied examinations, the tendency to make examinations slightingly is avoided, and the results generally are more satisfactory. Id.

58. The question of division would be a vital objection, or a claim for a combination where one of the elements was so vague and indistinct as to be incapable of examination on its merits, or where an important element was wholly lacking; but as to the dividing line between objections which are vital and those which are not, much must be left to the judgment and discretion of the examiner. Id.

59. The examiner may refuse to enter an amendment describing an alleged equivalent which constitutes new matter. Ex parte Johnston, 43 O. G. 507, C. D. 1888.

60. The office has no right to say that an element of a combination claim is not a part of the combination in advance of an action on the merits thereof. Ex parte Connelly, 59 O. G. 787, C. D. 1892.

61. The examiner's action in holding that no testimony as to the operativeness of an invention would be sufficient to warrant the withdrawal of the objection to the granting of a patent unless confirmed by personal inspection of the examiner or his deputized assistant, *held* not warranted by the rules. (Rule 76.) Ex parte Munn & Co., 63 O. G. 153, C. D. 1893.

62. It is the settled practice of the office not to detail examiners to supervise and report upon tests of inventions outside of the city of Washington. Id.

63. While an exhaustive search cannot be made in advance of compliance with the requirement of division, the best reference 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. Information readily accessible should not be withheld which would enable the applicant to act wisely with reference to the requirement of division. Ex parte Stearnes, 50 O. G. 1768, C. D. 1890.

64. Objection to a drawing that an unnecessarily large variety of forms is shown should not be insisted upon when it appears that the several figures relate to and show modifications of the generic invention claimed. Ex parte Nolan, 79 O. G. 861, C. D. 1897.

65. The examiner's action in making formal requirements after the case had been decided by the examiners-in-chief and the commissioner on appeal was regular and in accordance with rule 25. Id. *64

FEES.

I. PAYMENT.
II. REFUNDMENT.

I. PAYMENT.

1. Where the original application had been stricken from the files because it appeared that the inventor had signed and sworn to it in blank, *held*, that the fee formerly paid upon said application could not be applied to a new application filed in place thereof. Ex parte Ayres, 51 O. G. 1944, C. D. 1890.

2. The fee on an application must be paid within two years from date of filing, to save an application from abandonment. Ex parte Fenno, 52 O. G. 1665, C. D. 1890.

3. The commissioner of patents has no authority to directly or indirectly extend the time for paying a final fee to a period later than six months from *that* allowance of the application which results from proceedings according to law in the office. Ex parte Simonson, 53 O. G. 1571, C. D. 1890.

4. *Held*, where one of two sub-treasury certificates had been held by the applicant nearly two years, and the other taken out on the last day of the six months, the certificate could not be received. In re Wiegand, 45 MS. D. (3 G. W. D.), Jan., 1891 (Mitchell, Com'r).

5. It is proper that a rule should be adopted requiring the prompt presentation of the evidences of payment of final fees, made in conformity with section 4935, Revised Statutes; but in view of the different practice that has been allowed to obtain, the public should have due notice of the adoption and enforcement of the new rule of practice. †Ex parte Wiegand, 56 O. G. 803, C. D. 1891.

6. If the final fee is not received by the office within the six-months period provided by statute, the application will be held to be forfeited, even though said fee was mailed before the six months had expired. Ex parte Riley, 56 O. G. 1203, C. D. 1891.

7. Handing twenty dollars to a watchman not employed by the patent office at 11:55 P. M. on the last day of the six-months limit is not a payment of a final fee to the office within the six months allowed by law. Ex parte Poulter, 57 O. G. 1128, C. D. 1891.

8. A final fee, which reached Washington on Thanksgiving day — the last day for paying it — when the patent office was closed, not accepted. Ex parte Robertson, 51 MS. D. (4 G. W. D.), Dec., 1892 (Frothingham, Ass't Com'r).

9. Section 4935, regulating the payment of patent fees, is specific in its terms, and limits the officers of the government authorized to receive such fees to those mentioned therein. †Ex parte Poulter, 58 O. G. 519, C. D. 1892.

10. That provision of section 4885 which requires the payment of a final fee within six months after its allowance is mandatory and leaves the commissioner no discretion to accept it after the expiration of such time. Ex parte Anderson, 61 O. G. 886, C. D. 1892.

11. No discretion is vested in the commissioner by virtue of the terms of section 4885 of the Revised Statutes to accept and apply a final fee received more than six months after notice of allowance sent to the applicant, even though the last day of the six months falls upon a national holiday. Ex parte Mills, 62 O. G. 317, C. D. 1893.

12. Under the practice of the patent office the time within which a final fee may be paid is six *calendar* months from the date of the notice of allowance. Ex parte Brown, 63 O. G. 759, C. D. 1893.

13. A patent regular on its face is not subject to collateral attack because the patent office fee was not paid within the time prescribed by the Revised Statutes of the United States, section 4897. *Lamprey Boiler Furnace Mouth Protector Co. v. Economy Feed Water Heater Co., 69 O. G. 509, C. D. 1894.

14. An appeal fee may be applied as final fee on an application when a reference has been found and cited which meets the claim appealed. Ex parte Kratzer, 59 MS. D., May, 1896 (Fisher, Ass't Com'r).

15. The six months in which to pay the final fee expired on a Sunday. The fee was mailed the day before, but not received in due time. Application held forfeited. (Ex parte Riley, C. D. 1891, 136.) Ex parte Barry, 60 MS. D., Dec., 1896 (Fisher, Ass't Com'r).

II. Refundment.

16. A fee paid on a caveat for a design will be returned, since there is no law authorizing the filing of such a caveat. Ex parte Carty, 44 O. G. 570, C. D. 1888.

17. In a case where indistinctness of date of circular of allowance has misled an applicant, *held*, that no relief can be afforded him; the commissioner has no power to remit the office fee. Ex parte Chumard, 41 MS. D. (1 G. W. D.), Dec., 1889 (Mitchell, Com'r).

18. Where an application was filed to take the place of an application 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 Ex parte Hogan. Ex parte Sereno N. Ayres, 43 MS. D. (2 G. W. D.), May, 1890 (Fisher, Acting Com'r).

19. An appeal fee cannot be refunded after reversal of the examiner's decision on appeal, and after the examiner has again rejected the claim upon a newly-discovered reference and the claim has been canceled. Ex parte Ellis & Spence, 46 MS. D. (3 G. W. D.), May, 1891 (Frothingham, Ass't Com'r).

20. Where an applicant paid a second renewal fee on the very day that a decision was published to the effect that there was no authority in the statute for more than one renewal of an application for patent, *held*, that the fee was paid by mistake and that it should be returned. †Ex parte Smith, 71 O. G. 297, C. D. 1895.

21. Request after examination for the return of fee paid upon an application for a design upon the same day that a patent issued to the same inventor for the same design refused. †Ex parte Flomerfelt, 73 O. G. 1411, C. D. 1895.

22. Section 4885 of the Revised Statutes applies only to mechanical cases, and not to applications for designs. †Id.

23. A request for the return of an appeal fee where the appeal was not prosecuted denied, as the law establishes certain payments to be made upon filing certain papers, and this irrespective of whether the case is further prosecuted or not. Ex parte Borton, 77 O. G. 2137, C. D. 1896.

24. Where an appeal is regularly taken and the fee therefor paid, but thereafter the appellant changes his purpose and concludes not to prosecute the appeal, *held*, that there was no such mistake in the payment as would warrant the return of the appeal fee. †In re Borton, 81 O. G. 800, C. D. 1897.

25. Where a draft presented in payment of the fee in an application for patent is dishonored because of the failure of the bank by which it was issued, *held*, that it did not constitute payment of the fee. †In re Nash, 81 O. G. 799. C. D. 1897.

26. Such draft was not a compliance with rule 223, specifying the manner in which money shall be paid, since the money was never received by any officer of the United States. †Id.

27. An appeal fee should be returned in a case where the commissioner held (on petition) that appeal lay to the examiners-in-chief, and they dismissed it. Ex parte Crowell, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

FOREIGN PATENT.

(See ANTICIPATION — PATENTS AND PRINTED PUBLICATIONS; INTERFERENCE—PRIORITY, FOREIGN PATENTS.)

1. Where an earlier English provisional specification did not precisely anticipate the patent in suit, it may be used to show that no invention was required to make the simple alteration or addition which distinguishes it from the patent in suit. *McNab & Harlem Mfg. Co. v. Nathan Mfg. Co., 40 O. G. 1240, C. D. 1887.

2. An English patent is only effective from the date of its sealing as an anticipatory publication. *Bliss v. Merrill, 42 O. G. 97, C. D. 1888.

3. The filing of a "provisional specification" in the English patent office secures to the applicant for the term of six months "provisional protection"—*i. e.*, during this period the invention may be used and published without prejudice to any letters patent to be granted for the same, but does not invest the applicant with any of the powers, rights or privileges of a patentee. *Emerson, Smith & Co. (Limited) v. Lippert, 42 O. G. 964, C. D. 1888.

4. The filing of a complete specification not only protects the invention for six months, but during that period the applicant is clothed with the like powers, rights and privileges as if letters patent had already issued. *Id.

5. Foreign patents containing limited claims will not bar an applicant from securing in this country claims for a broader invention, provided he can maintain and substantiate them in an interference contest. Faure v. Bradley and Crocker v. Cowles and Cowles, 44 O. G. 945, C. D. 1888.

6. When an English patent, though dated as of November 1, 1870, was not sealed until April 2, 1871, *held*, that said English patent was not in fact issued until said latter date. *The Holmes Burglar Alarm Telegraph Co. v. The Domestic Telegraph and Telephone Co., 51 O. G. 2083, C. D. 1890.

7. An invention patented abroad was not patented under the British law prior to the patent amendment act of 1852, so as to operate as a bar to the grant of a patent or as a defense to a patent already granted, until the enrollment of the complete specification, and under that act and acts amendatory thereof prior to the act of 1883 the invention did not become patented until the filing of the complete specification. De Ferranti v. Westinghouse, 52 O. G. 457, C. D. 1890.

8. The fact that the specification of a British patent was accessible to public inspection on a certain date is immaterial, for it was not then a printed publication, and it certainly was not a patent. Id.

9. It cannot be contended that an invention was either patented or described in a printed publication by reason of the filing of the provisional British specification or the later filing of the complete specification. Under the British act of 1883 the filing of the complete specification is not accompanied by publication as was the case under the prior acts. Id.

10. It cannot be said that under the present law an invention is patented before the seal is finally attached. Id.

11. The Spanish law permits a patent for twenty years, but if a patent has been obtained in one or more foreign countries the term is for ten years only. *Accumulator Co. v. Julien Electric Co., 57 Fed. Rep. 605 (1893).

FORFEITED APPLICATION.

(See RENEWAL OF.)

FORMER DECISIONS AFFIRMED.

1. Commissioners' decisions in Ex parte Demming, C. D. 1884, 18, 26 O. G. 1207; Ex parte Kerr, id. 27, 28 O. G. 95; Ex parte Holt, id. 43,

29 O. G. 171; and Ex parte Wilkin, id. 71, 29 O. G. 950, approved. Ex parte Paige, 40 O. G. 807, C. D. 1887.

2. The decision of the United States court in the case of Uhlmann v. Bartholomae & Leicht Brewing Co. followed in holding that the patent granted to the senior party was a valid patent. Zwietusch v. Stockheim, 53 O. G. 755, C. D. 1890.

3. Smith & Griggs Mfg. Co. v. Sprague and City of Elizabeth v. Pavement Co. applied and explained. *Root v. Third Avenue R. Co., 46 O. G. 1393, C. D. 1889.

4. Previous decisions discussed and principles deduced. *Reece Button-Hole Machine Co. v. Globe Button-Hole Machine Co., 67 O. G. 1720, C. D. 1894.

INDUSTRIAL UNION.

(See INTERNATIONAL CONVENTION.)

INFRINGEMENT.

(See DAMAGES AND PROFIT; INJUNCTION; MARKING ARTICLES "PATENTED;" NEW TRIAL; PRACTICE IN THE COURTS; SUITS FOR INFRINGEMENT; TRADE-MARKS.)

I. IN GENERAL.
II. BURDEN OF PROOF.
III. CLAIMS FOR COMBINATION.
IV. CONTRIBUTORY.
V. BY COUNTIES AND CORPORATIONS.
VI. BY MANUFACTURE WITHOUT USE.
VII. MAKING AND SELLING.
VIII. PROCESS.
IX. SECRET USE.
X. STATE OF THE ART.
XI. PARTICULAR CASES.

I. IN GENERAL.

1. The assignment by a patentee of his interest in a patent does not prevent him from recovering for an infringement during the time he was owner of it. *May v. Saginaw Co., 32 Fed. Rep. 629 (1887).

2. There may be several judgments in respect to the same act of infringement, but there can only be one satisfaction. *Jennings v. Dolan, 38 O. G. 1018, C. D. 1887.

3. Where an improvement is made and patented in a machine, the first patentee cannot use the improved machine without the consent of the second, and the second cannot use his machine without the consent of the first. *Royer v. Coupe, 39 O. G. 239, C. D. 1887.

4. If the first patentee's machine is not operative and the second patentee's is operative, the first patentee must be confined to his own particular application of his principle, and there is no infringement by the second patentee. *Id.

5. The patent *held* infringed by defendants' apparatus, although the latter differs somewhat in construction from that described in the patent. The fact that the main features in the patented apparatus—such as the circuit-breaker, single circuit, operating the gas-cock directly by the armature—are old should not limit the patentee to the exact form of mechanism found in the patent. *Boston Electric Co. v. Fuller, 39 O. G. 710, C. D. 1887.

6. An infringement results when defendant employs the equivalents of the elements of the combination claims of the patent in suit for substantially the same purposes and with substantially the same result. *Barnes v. Ruthenburg, 40 O. G. 603, C. D. 1887.

7. The use of a device doing the same work in substantially the same way and accomplishing substantially the same result as another patented device is an infringement of the patent. *Shaver v. Skinner Mfg. Co., 41 O. G. 232, C. D. 1887.

8. An improvement including a patented device or combination infringes the patent. *Id.

9. Where the supposed infringing machine was for the same purpose as complainant's patented machine and produced the same result in operation but by different means from those claimed in the patent in suit there was no infringement. *Dryfoos v. Wiese, 42 O. G. 490, C. D. 1888.

10. A claim is not avoided because the specification does not describe details of construction in elements of the claims well known in the particular art and employed only by the defendant. *Thompson v. Gildersleeve, 43 O. G. 886, C. D. 1888.

11. The infringement of a patent is in the nature of a trespass upon the exclusive rights of the owner of the patent secured by it, for which an action would lie at common law. The action would be an action on the case as for a tort, in which all who participate are principals, and for which they are jointly and severally liable for the whole. *Babcock & Wilcox Co. v. Pioneer Iron Works, 43 O. G. 756, C. D. 1888.

12. The mere change in form or an alteration in unessential parts, or the use of known

equivalent powers not varying essentially the machine or its mode of operation or organization, will not avail to avoid infringement. *The Butz Thermo-Electric Regulator Co. v Jacobs Electric Co., 45 O. G. 833, C. D. 1888.

13. Where an invention is one of a primary character and the mechanical functions performed by the machines are as a whole entirely new, all subsequent machines which employ 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, 47 O. G. 267, C. D. 1889.

14. To justify a decree for infringement actual proof must be presented of the defendant's illegal acts. It will not do to substitute therefor suspicion and conjecture. *Winne v. Bedell, 49 O. G. 2152, C. D. 1889.

15. Where defendants in their apparatus used an instrument which was recognized in the art as an equivalent of certain devices shown in the patent, the fact that said instrument is made to perform an additional function in the defendants' apparatus will not relieve them from the charge of infringement so long as all the elements of the complainants' patent are embraced in their system. *The Holmes Burglar Alarm Telegraph Co. v. The Domestic Telegraph and Telephone Co., 51 O. G. 2083, C. D. 1890.

16. Where in a suit for infringement it appeared that an interference had been declared between the claims of the patent in suit alleged to have been infringed and a prior and still pending application for patent, and that in said interference proceeding priority of invention was awarded in favor of the applicant as against plaintiff's assignor, and that under the proofs before the court such an award was indisputable, *held*, that said application was competent evidence upon the issue whether the plaintiff's assignor was the original and first inventor of the thing alleged to be within the claims of the patent in suit. *Westinghouse, Jr. v. The Chartiers Valley Gas Co., 53 O. G. 599, C. D. 1890.

17. Where in a suit for infringement it appeared that plaintiff was not manufacturing and had not manufactured or sold any machines under the patent in suit, but manufactured a machine made under an earlier patent and seemed to be using the latter patent merely to keep other manufacturers out of the market, *held* that, whatever its technical right to make use of the patent might be, its conduct evidently deprived the public of whatever advantage the patent in suit possessed, contrary to the true policy of the patent laws. *American Roll Paper Co. v. Knopp, 54 O. G. 139, C. D. 1891.

18. 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 there are differences in form and structure tending to simplicity and perhaps improvement. *National Typographic Co. v. New York Typograph Co., 56 O. G. 661, C. D. 1891.

19. The defendants were not bound to inquire whether their purchasers were licensed by the plaintiff to use the invention, and having done no wrong themselves they are not answerable for the unlawful acts of others. *Lane & Park, 59 O. G. 788, C. D. 1892.

20. An infringement takes place whenever a party avails himself of the invention of the patentee without such a variation as constitutes a new discovery. *Norton v. Jensen, 60 O. G. 1326, C. D. 1892.

21. Where there is a difference between the construction of a patent and the construction used by the defendant, it is evidence of non-infringement where the device of the defendant does not accomplish the results of the patent. *Simpkins v. Perry Pie Co., 64 O. G. 859, C. D. 1893.

22. The patent is upon the device and not upon the functions, real or supposed, and if the device is appropriated in its essential features it will be an infringement notwithstanding some change in the location or relation of parts whereby a doubtful function of little comparative worth is eliminated. *Western Electric Co. v. Sperry Electric Co., 65 O. G. 597, C. D. 1893.

23. Although the defendants' improvement be an invented addition to the device in the complainant's patent and patentable as an independent invention, yet a patent for the improvement does not carry with it the right to use the complainant's invention. *American Bell Telephone Co. v. Brown Telephone and Telegraph Co., 65 O. G. 894, C. D. 1893.

24. Where the essential operations of two devices are wholly different, *held*, that there is no equity in charging infringement upon a defendant who apparently accidentally adopts in the practice of his invention an immaterial

feature of the plaintiff's patent, which feature is of no value to the alleged infringing device and an alleged advantage to the patentee never contemplated by him nor alluded to in his specification. *Ball and Socket Fastener Co. v. Kraetzer, 65 O. G. 1591, C. D. 1893.

25. Where the specific device described in and covered by the patent sued on could not be used in the defendant's combination, nor his device be used in the machine in the patent, this interchangeability or non-interchangeability is an important test in the question of infringement. (Prouty v. Ruggles, 16 Pet. 336; Brooks v. Fiske, 15 How. 212; Eames v. Godfrey, 1 Wall. 570.) *Miller v. Eagle Mfg. Co., 66 O. G. 845, C. D. 1893.

26. Where the identity of the device sued on and the infringing device is admitted they cannot be patentably distinguished by a suggested distinction in the purposes to which they are respectively applied. (Knapp v. Morss, 65 O. G. 1593, 150 U. S. 221.) *Wollensak v. Sargent & Co., 66 O. G. 1007, C. D. 1893.

27. Claim 20 is not invalid because inoperative for want of additional elements. The appropriate means for rendering the combination operative will be understood in any such case. This claim is valid and infringed. *Deering v. Winona Harvester Works, 69 O. G. 1641, C. D. 1894.

28. The use of an infringing device is not justified by the fact that defendant had previously attempted to use one made under complainant's patent, which proved to be useless. *Masseth v. Johnston, 67 O. G. 143, C. D. 1894.

29. The refusal of a patentee to furnish his device, when requested, does not justify the use of an infringing article. *Masseth v. Reiber, 67 O. G. 143, C. D. 1894.

30. The fact that a person has made an improvement on a patented machine does not give him the right to use such machine with his improvement nor absolve such use from being an infringement of it. *Traver v. Brown, 69 O. G. 1071, C. D. 1894.

31. A process patent, when involving a combination of different elements, is similar to a patent for a combination of mechanical devices. No infringement can be sustained unless every one of the constituent elements is employed. (Cases cited.) *Kennedy v. Solar Refining Co., 69 Fed. Rep. 715 (1895).

32. The infringement of a patented art or process consists only in the performance of all the acts of which it is composed, or their equivalents, in the manner and in the order in which they are claimed in the patent. (3 Rob. Pat., sec. 925.) *Id.

33. One who purchases a patented machine from an infringer and operates it unlawfully for a term of years cannot acquire a right to its use because the vendor and owner of the patent subsequently enter into partnership, and the owner is not estopped from charging infringement when no act calculated to deceive or mislead the defendant can be shown. *Thomson-Houston Electric Co. v. Elmira and Horseheads Ry. Co., 74 O. G. 144, C. D. 1896.

34. A device is none the less an infringement because it contains an improvement upon the patented invention. *Robbins v. Dueber Watch Case Mfg. Co., 74 O. G. 965, C. D. 1896.

35. An inventor of a machine consisting of a new combination of old elements, which is shown by experiment to be valueless and impracticable for the purpose intended, cannot, after obtaining a patent therefor, abandon his specifically-described novel invention and substitute as a mechanical equivalent the methods of old machines which he claimed to have improved upon, and sue as infringers persons who employed the old device in the old way. *Carter Machine Co. v. P. H. Hanes & Co., 74 O. G. 1277, C. D. 1896.

36. Mere change of proportion is not sufficient to avoid a charge of infringement, and is not, therefore, sufficient to establish difference of invention. *Thomson-Houston Electric Co. v. Western Electric Co., 75 O. G. 347, C. D. 1896.

37. A contention that defendants' device being patented is *prima facie* proof that it does not infringe complainant's patent, and that therefore it is not competent for the court upon inspection of the patents alone to adjudge infringement, might be sustained in some cases; but it cannot be in this one, where the patent set up by defendants is manifestly for an alleged improvement upon complainant's invention, the use of which it necessarily involves. *Hardwick v. Masland, 75 O. G. 350, C. D. 1896.

38. A trespasser cannot acquire a legal right to the continuance in his wrongful acts without affirmative proof of some such act or omission to act on the part of him whose property rights are invaded as would make it inequitable to assert such rights. The inequity of permitting the enforcement of such claim is founded on knowledge of an opportunity to enforce rights on the one hand, and on changes in the conditions or relations of the adverse

party on the other. *Imperial Chemical Mfg. Co. v. Stein, 75 O. G. 1551, C. D. 1896.

39. A claim which includes "means . . . for automatically opening and retaining" is not infringed by a device which has means for performing but one of these functions. *Gould Coupler Co. v. Trogan Car Coupler Co., 75 O. G. 2009, C. D. 1896.

40. A construction which might perform the functions of a complainant's device to some extent, but which lacks a communication between two parts substantially as described in complainant's specification, does not infringe a claim in which such communication is claimed "substantially as described." *Scarborough v. Neff, 76 O. G. 475, C. D. 1896.

41. The court is not prepared, in view of authorities, to sanction the proposition that the infringer of a patent may escape liability by showing that the legal owner is engaged in a supposed unlawful combination or trust. *National Harrow Co. v. Quick, 76 O. G. 1574, C. D. 1896.

42. In determining the question of rights intervening after the grant of a patent and before an application for a re-issue, the office does not decide whether any of the claims of the original patent are infringed. The question of infringement is not involved. Loewer v. Ross, 76 O. G. 1711, C. D. 1896.

43. A mere transposition or reversal of parts is not a material departure from a patented invention and will not avoid a charge of infringement. *Société Anonyme Usine J. Cléret v. Rehfuss, 76 O. G. 336, C. D. 1896.

44. The fact that the infringing part is capable of a lawful as well as an unlawful use, by way of reparation or restoration of a patented device, does not raise the presumption that the lawful use is the one for which it is alone intended. *Thomson-Houston Electric Co. v. Kelsey Electric Railway Specialty Co., 76 O. G. 609, C. D. 1896.

45. Mere differences in form are not sufficient to avoid infringement. *Taylor v. Sawyer Spindle Co., 77 O. G. 452, C. D. 1896.

46. A series of guesses will not suffice to inculpate a defendant. Neither will the fact that he received a bid for alleged infringing devices in behalf of another party, in the absence of any threat on his part and in the absence of any showing of profit resulting to him, render him liable. *Edison Electric Light Co. v. Kaelber, 77 O. G. 1430, C. D. 1896.

47. Every patent for a composition must identify the composition by certain characteristics or tests, and it is sound law and reasonable common sense to hold that the tests of prime importance in a suit for infringement are those which the patent itself sets up. *Matheson v. Campbell, 79 O. G. 686, C. D. 1897.

48. Mere reversal or immaterial change of parts will not avoid a charge of infringement. (Cleret v. Rehfuss, 76 O. G. 336, 75 Fed. Rep. 657; Devlin v. Paynter, 69 O. G. 1365, 64 Fed. Rep. 390.) *Edward Miller & Co. v. Meriden Bronze Co., 79 O. G. 1520, C. D. 1897.

49. The fact that a defendant was using an article four or six months before a patent on the article issued and the further fact that the defendant did not respond to a notice advising him of the issue of the patent is not sufficient to prove infringement or an intent to infringe. *Brill v. St. Louis Car Co., 79 O. G. 2017, C. D. 1897.

50. The Bowers patent has broad, generic claims, and all subsequent machines which employ substantially the same means to accomplish the same result are infringements, notwithstanding the subsequent machine may contain improvements in separate mechanism which go to make up the machine. *Von Schmidt v. Bowers, 80 O. G. 347, C. D. 1897.

51. The fact that the first machine built by a patentee whose patent is sued on was not successful in operation is unimportant and no reason for denying him relief, especially where his subsequent machines have proved successful in practice. *Id.

52. A patent owner who is suing an importer for infringement by the importation of infringing goods which have been detained by the customs officials and libeled for forfeiture because of fraudulent undervaluation may, for the protection of his interests, be permitted to intervene in the forfeiture proceedings on giving proper security. *United States v. One Case Chemical Compound (two cases), In re Société Fabriques de Produits Chimiques de Thaun et de Mulhouse (two cases), 81 O. G. 804, C. D. 1897.

II. Burden of Proof.

53. The burden of proof upon the issue of infringement is not satisfied merely by showing a state of facts from which infringement may be conjectured. *Morgan Envelope Co. v. The Albany Perforated Wrapping Paper Co., 60 O. G. 303, C. D. 1890.

54. The burden of proving an infringement rests on complainant, and it is not enough to show that defendant's furnace ought theoret-

ically to perform the functions covered by the patent sued upon; but the facts must be shown. *Siemens v. Chambers & M'Kee Glass Co., 62 O. G. 1351, C. D. 1893.

55. It is not presumptive evidence of infringement when a defendant offers no proof in support of his answer of intention not to infringe. The burden of showing infringement rests on complainant, and the law and well-settled practice forbids this burden being shifted upon the defendant. *Brill v. St. Louis Car Co., 79 O. G. 2017, C. D. 1897.

56. In a suit for infringement of a process and product patent covering a composition or chemical product, the complainant has sustained the burden of proof resting ou him as to infringement when he shows that defendant's product corresponds to the tests of identity, and the burden is then upon defendant to show that it was not made by the patented process. *Matheson v. Campbell, 79 O. G. 684, C. D. 1897.

III. Claims for Combination.

57. A patent for a combination is not infringed by the use of less than the entire number of elements claimed. *Royer v. Schultz Belting Co., 38 O. G. 898, C. D. 1887.

58. The doctrine that a party may be held liable as an infringer solely because an article sold by him might be used by the purchaser as one element of a patented combination would be too dangerous to be upheld. *Snyder v. Bunnell, 38 O. G. 1130, C. D. 1887.

59. Where all the parts claimed, with one exception, were old and had been used in a similar combination in other things of the same general character, the defendant not using the excepted part escapes infringement. *Bragg v. Fitch, 39 O. G. 829, C. D. 1887.

60. When the patent in suit is the first in its particular field of invention, its claim is infringed by a combination which employs well-known mechanical equivalents to accomplish the results which follow from the combination claimed in the patent. *Tarrant v. Duluth Lumber Co., 39 O. G. 1425, C. D. 1887.

61. When defendants' machine did not have elements which could be successfully employed in the combination claimed in the patent, there was no infringement. *Gray v. Bangs, 40 O. G. 812, C. D. 1887.

62. The defendant using that part of the construction which produced the principal effect of the combination in the claim of complainants' patent, although dispensing with other parts of such combination, infringed such claim. *Thompson v. American Bank Note Co., 45 O. G. 347, C. D. 1888.

63. Applying the rule that, where none of the elements of a combination are new or are claimed separately and there are other similar kindred combinations in use, the patentee is limited to the particular form of the various elements composing the combination shown by his drawings to Letters Patent No. 304,195, granted August 26, 1884, to Herman Heine, for purifiers for the feed-water of steam-boilers, the patent is not infringed by a device differing essentially therefrom in construction. *Heine Safety Boiler Co. v. Smith Feed Water Heater and Purifier Co., 47 O. G. 1634, C. D. 1889.

64. When the same thing is used in a series this should be considered as one entire thing and not a mere combination, and therefore the appropriation of any one of these things is an infringement of the whole. *Morrison v. The Canton Surgical and Dental Chair Co., 49 O. G. 733, C. D. 1889.

65. Where the patentee had described a device of a certain shape and a use to which it might be put, but did not claim it in that shape, either singly or in combination, *held* he could not maintain infringement against one who sold the device in that particular form only and who had not adopted the combination of the claim. *Winne v. Bedell, 49 O. G. 2150, C. D. 1889.

66. A party who uses a patented combination cannot escape the consequences of infringement by showing that he uses something in addition to the combination. *Williames v. Barnard, 41 Fed. Rep. 358 (1890).

67. To defeat a patent for a combination it is not enough to show that all the elements of the combination, separately considered, were old at the date of the invention. *Alaska Refrigerator Co. v. Wisconsin Refrigerator Co., 51 O. G. 125. C. D. 1891.

68. There cannot be any infringement of a combination claim unless every element of the combination or a mechanical equivalent of an omitted element is used. *Norton v. Jensen, 69 O. G. 1326, C. D. 1892.

69. The principle that "a combination is an entirety, and if one of the elements is given up the thing claimed disappears," prevails (Vance v. Campbell, 1 Black, 427), even where the patentee has claimed more than is necessary to the successful working of his device (McClain v. Ortmayer, 141 U. S. 419). *Vincent v. Rigby, 58 Fed. Rep. 371 (1893).

71. Where a patent shows and describes a duplicate construction, but contains no description of the manner in which one of the members of the construction can be used, and the defendant is using one member only, the bill will be dismissed. *Pacific Cable Ry. Co. v. Butte City Street Ry. Co., 66 O. G. 1758, C. D. 1894.

72. To constitute infringement of a combination the alleged infringing device must include every element of the combination as claimed. The fact that the omitted element is not of the essence of the invention is immaterial. *Kiuzel v. Luttrell Brick Co., 72 O. G. 900, C. D. 1895.

73. A machine is a concrete thing, being an entirety of co-operating elements and agencies. When it consists of a combination of old elements and devices, the leaving out of one of the essential elements of the combination destroys the identity of the combination, and a person cannot be sued as an infringer who uses a machine in which a material part of the combination patent is omitted. *Id.

74. Where a patent is for a combination, to support a charge of infringement it must be shown that the infringer has used substantially the same combination, including every one of the elements thereof, or a mechanical equivalent for any one that has been omitted. *Erie Rubber Co. v. American Dunlop Tire Co., 74 O. G. 1443, C. D. 1896.

75. The omission of a part whose presence or absence does not affect, essentially, the mode of operation nor determine whether a particular apparatus exemplifies one patent or the other is of no significance. *Thomson-Houston Electric Co. v. Western Electric Co., 75 O. G. 347, C. D. 1896.

76. It is a rule of universal application in construing "combination" claims that the omission in an alleged infringing device of one element of the combination embodied in any claim will repel the charge of infringement based on that claim. *Engle Sanitary and Cremation Co. v. City of Elwood, 75 O. G. 1713, C. D. 1896.

77. Combination patent held infringed by a device using but one element of the combination. *American Graphophone Co. v. Amet, 74 Fed. Rep. 789 (1896).

(The claim in this case was substantially for the combination, with a sound record formed in wax, of a reproducer having a rubbing style for receiving sonorous vibrations from said record.)

78. Separate sale of such element by the patentee does not release it from the patent. *Id.

IV. Contributory.

79. Where one makes and others sell infringing articles they are liable jointly and severally. *Jennings v. Dolan, 38 O. G. 1018, C. D. 1887.

80. Where a person makes and puts on the market an article which of necessity and to the knowledge of such person is to be used for the purpose of infringing a patent, such person will be held liable under the doctrine of contributory infringement. *Snyder v. Bunnell, 38 O. G. 1130, C. D. 1887.

81. In order to hold a party liable under the doctrine of contributory infringement, there must be proof that what he did was for the purpose and with the intent of aiding infringement. (Saxe v. Hammond, 1 Holmes, 456.) *Id.

82. The claims cover a window-screen frame made up of side pieces or bars having several specified features of construction. While it may not be an infringement to make these bars, defendants will be liable as infringers if they manufacture them with the intent that they shall be put together in the form of window-screens. (Walker, Pat., sec. 407.) *Stearns v. Phillips, 43 Fed. Rep. 792 (1890).

83. The sale of an element of a combination segregated from the whole combination does not break the patentability of the combination. *American Graphophone Co. v. Amet, 76 O. G. 1273, C. D. 1896. Also 74 Fed. Rep. 789 (1896).

84. Claims 6, 7, 8, 12 and 16 of Letters Patent No. 495,443, granted April 11, 1893, to the administrators of Charles J. Van Depoele, for a traveling contact for electric railways, which cover the combination consisting generally of an electric railway having an overhead conductor and a car for said railway provided with a "trolley-stand" carrying a trailing arm which is pressed into engagement with the under side of the conductor, are not contributorily infringed by defendant who makes and sells only the "trolley-stand" of the combination. *Thomson-Houston Electric Co. v. Kelsey Electric Railway Specialty Co., 76 O. G. 2008, C. D. 1896.

85. Where a patent covers the combination of a draw-head, a knuckle, a pivot-pin and a locking-pin, it is not infringed by a defendant who furnishes the knuckles to replace broken ones. *Shickle, Harrison & Howard Iron Co. v. St. Louis Car Coupler Co., 77 O. G. 2142, C. D. 1896.

86. Defendants who aid and abet infringement by intentionally and maliciously persuad-

ing and inducing the licensees of machines to exceed their licenses, and who furnish them with the means for such infringement, are themselves infringers and liable as tort-feasors. The knowledge that the articles made and sold by defendants are to be used for infringing, coupled with an active intent that they shall be so used, constitutes contributory infringement. *Heaton Peninsular Button Fastener Co. v. Eureka Specialty Co., 78 O. G. 171, C. D. 1897.

87. The principle governing infringement of combination patents, by furnishing a necessary element in the combination with the intent that it be used to effect infringement, is applicable to a case where one sells an unpatented article with the knowledge and intent that it will be used to effect infringement by enabling a licensee to violate the conditions of his license. *Id.

88. When complainant insists in his patent that one of the essentials to his device is a certain connection with which the defendant may dispense, and which at best he uses not as essential to its construction, but as a mere convenience to its operation, *held*, that infringement is not shown. *Edward Miller & Co. v. Meriden Bronze Co., 79 O. G. 1520, C. D. 1897.

89. Where one makes and sells one element of a combination covered by a patent, with the intention and for the purpose of bringing about its use in such a combination, he is guilty of contributory infringement and is equally liable to the patentee with him who in fact organizes the complete combination. *Thomson-Houston Electric Co. v. Ohio Brass Co., 80 O. G. 654, C. D. 1897. Also 80 Fed. Rep. 712 (1897).

90. Where a party makes a device which is adapted to be used only in a patented combination and is offering said device for sale to the public, he is legally presumed to intend the natural consequences of his act, and it is therefore *held* that he intended that the device made should be used in the patented combination, and an injunction will be granted. *Id.

91. Many of the most valuable patents are combinations of non-patentable elements, and the only effective mode of preventing infringement is by suits against those who, by furnishing the parts which distinguish the combination, make it possible for others to assemble and use the combination, and who by advertisement of the sale of such parts and otherwise intentionally solicit and promote such invasions of the patentee's rights. *Id.

92. A party may furnish parts for repairing and renewing a patented combination; but when he does so he must ascertain, if he would escape liability for infringement, that the one buying and using them for this purpose has a license, express or implied, to do so. *Id.

(The leading case on this subject is Wallace v. Holmes, 9 Blatchf. 65, 29 Fed. Rep. 79.)

V. By Counties and Corporations.

93. A suit brought against a county for infringement of a patent, or for damages after the expiration of a patent, may be maintained. *May v. County of Ralls, 40 O. G. 575, C. D. 1887.

94. A contract for building a county jail provided for a patent lock device, which was put in by the contractor or a subcontractor, but without authority from the owner of the patent. In less than two years after the county took possession of the jail the patent expired, and in the meantime the lock device was not used. The county authorities knew nothing of the contractor having put in the lock without authority from the patentee. *Held*, that the county was not liable in tort for infringement of the patent. *May v. Juneau Co., 41 O. G. 578, C. D. 1887.

95. Counties are liable for infringements of patents. Jacobs v. Hamilton Co. (1 Bond, 500) disapproved. *May v. Logan Co., 41 O. G. 1387, C. D. 1887.

96. Where the council of Portland authorizes a contractor to lay a sewer in one of its streets in pursuance of a power contained in its act of incorporation, and in so doing the contractor infringes upon the patent of another for making sewer-pipe, the act being a corporate one for the benefit of the corporation, it is liable for such infringement the same as a private corporation or person. *Asbestine Tiling and Mfg. Co. v. Hepp, 49 O. G. 413, C. D. 1889.

VI. By Manufacture Without Use.

97. It constitutes an infringement to manufacture for the purpose of use, even if not actually used. *The Butz Thermo-Electric Regulator Co. v. Jacobs Electric Co., 45 O. G. 833, C. D. 1888.

VII. Making and Selling.

98. It is no justification for such sales to allege that the patentees have violated their license contract with the vendor. *Willis v. McCollin, 38 O. G. 1017, C. D. 1887.

99. The claim being for a composition of matter or dry mixture, *held* not infringed by the sale of one of the materials forming part of the mixture, the use of both materials forming the mixture being old in the art. *Geis v. Kimber, 44 O. G. 108, C. D. 1888.

100. The mere fact that a person sells an article to which a patented device may be attached does not make him an infringer, provided the article is not so constructed that the patented device and no other can be used with it. *Bliss v. Merrill, 42 O. G. 97, C. D. 1888.

101. Where the article produced is perishable in its nature, which it is the object of the apparatus to deliver, and which must be renewed periodically, whenever the apparatus is used, and where the article so produced is not patented, *held*, that there is no infringement of the combination by the making and sale of the article. *Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co., 67 O. G. 271, C. D. 1894.

102. The fact that a defendant made and sold a patented article before the patent issued does not prove or tend to prove infringement. *Brill v. St. Louis Car Co., 79 O. G. 2017, C. D. 1897.

VIII. Process.

103. It does not follow that processes are different because the various steps do not succeed each other in precisely the same order, and an infringement is not thereby avoided. *Hammerschlag Mfg. Co. v. Bancroft, 40 O. G. 1339, C. D. 1887.

104. When a patentee emphasizes in his specification and makes a part of the claim allowed by the patent office a particular step in a particular process, which step in the process the defendant does not use, it is not allowable for him to disregard that step or to contend that it is not essential. *Van Camp v. The Maryland Pavement Co., 43 O. G. 884, C. D. 1888.

105. Even in a good claim for a composition of matter which is not described otherwise than by the process of making it, nothing can be in infringement which is not made by the process described. *Id.

106. The omission of a step of a process claimed averts the charge of infringement. *Id.

107. A person who subsequently discovers a new mode of carrying out a patented process is not entitled to use the process without the consent of the patentee. *Morley Sewing Machine Co. v. Lancaster, 47 O. G. 267, C. D. 1889.

108. The discoverer of a process is only required to point out one practicable method of using his process and may claim tribute from all who thereafter use the process, whether with his apparatus or with a different or improved means. *McCormick Harvesting Machine Co. v. C. Aultman & Co., 73 O. G. 1999, C. D. 1895.

109. Process claims of a patent in which one specific step of the process is described as affected by means of a particular device and in which there is no suggestion that such means could be dispensed with, even when the step referred to is stated in broad terms, are not infringed by a process which employs some other means. *Philadelphia Creamery Supply Co. (Limited) v. Davis and Rankin Building and Mfg. Co., 79 O. G. 1194, C. D. 1897.

IX. Secret Use.

110. In a suit for an alleged infringement conducted secretly in a manufactory, reliable evidence tending to show such infringement must be produced. The plaintiff cannot depend upon the chance of obtaining evidence to support the charge from the defendant and his workmen or from an inspection of his machinery. *Dobson v. Graham, 48 O. G. 976, C. D. 1889.

111. Defendant's business is conducted in private. By contract and in equity his workmen are bound to secrecy. They have not been permitted to answer questions when it would tend to describe peculiarities of defendant's machinery, and the court cannot properly compel them to go further, nor compel defendant to submit his machinery to inspection, in absence of a showing of positive knowledge that he infringes. *Dobson v. Graham, 49 Fed. Rep. 17 (1889).

112. Order to inspect premises of respondent where a process infringing a patent was alleged to be in use, granted on terms. *Maryland Hominy and Ceralline Co. v. Dorr, 55 O. G. 1143, C. D. 1891.

113. The defendants concealed their machines so that the complainant could not make satisfactory proof of infringement. Complainant thereupon called one of the directors of the defendant corporation and proved by him

that the defendants' machines contained the elements mentioned in certain claims of complainant's patents, and then moved the court for an order requiring the defendants to produce drawings or a model of said machines or to permit complainant's experts to visit their shops and make such drawings from the machines. *Held*, first, that although such order should not be granted upon mere suspicion or allegation of infringement, yet here, as the complainant had shown probable cause for believing that infringement was going on, the order should be granted; second, that the fact that an application for a patent on one of the defendants' machines was pending was no ground for denying the order, the rule of secrecy in the patent office having no application to investigations of causes by the courts; third, rule entered for the defendants to produce drawings of the alleged infringing machines upon payment of the cost thereof by the complainant. *Diamond Match Co. v. Oshkosh Match Works, 69 O. G. 1508, C. D. 1894.

X. State of the Art.

114. Where an infringer has attempted to avoid the patent by the use of a well-recognized mechanical equivalent, the court is bound to look to the state of the art at the time the patent was applied for to determine the limitations of the claim. *Rodebaugh v. Jackson, 47 O. G. 58, C. D. 1889.

115. Where an invention is of a primary character and stands at the head of an art, it is entitled to a liberal construction of its claims, and all persons who make devices or machines operating on the same principle and performing the same function by analogous means or equivalent combinations, even though the machine may be an improvement of the original and patentable as such, are to be treated as infringers. *Norton v. Jensen, 60 O. G. 1326, C. D. 1892.

116. Where a device covered by a patent granted two and one-half years after the date of the patent in suit was invented before that of the earlier patentee, and such earlier patentee had full knowledge of it before he made his alleged invention, *held*, that the device covered by the later patent should be considered as part of the art as it existed at the date of the earlier patent. *Duer v. Corbin Cabinet Lock Co., 63 O. G. 1060, C. D. 1893.

117. "The distinction suggested by the circuit court between inventions employing cranks and levers visible to the senses and those employing compressed air, which operates by modes not visible to the senses, as to which latter devices the circuit court held that "in judging of an infringement we are to direct our attention rather to functional equivalents than to mechanical equivalents," we do not think well taken, even in favor of pioneer inventions." *Boyden Power Brake Co. v. Westinghouse Air Brake Co., 73 O. G. 857, C. D. 1895.

118. With respect to a primary or pioneer patent the well-settled rule is that the patentee who has by the success of his patent pointed out the combination of functions needed to reach the new result, and has claimed the combination of mechanical parts performing those functions, may enjoin the use of another machine producing the same result where the second machine differs from the first only in a substitution for parts or elements in the patented device of parts or elements which, though different in form and kind, perform the same functions in substantially the same way. It may be that the substituted parts are well-known equivalents of those shown in the patent for the performance of the functions to which they are respectively applied, in which case there is manifestly no inventive faculty shown in the change; or it may be that, being shown by the successful operation of the patent the exact nature of the functions to be performed by a part of the patented device, the infringer by the use of his inventive faculty hits upon something as a substitute which will perform the same functions more completely and satisfactorily. In the latter case he is a tributary inventor; but he is none the less an infringer if he uses the whole machine, with his substituted part, to accomplish the same new result. *McCormick Harvesting Machine Co. v. C. Aultman & Co., 73 O. G. 1999, C. D. 1895.

119. The rule as to infringement of patents for pioneer inventions, which point the way to new products or results, is analogous to that applied to cases involving process patents. *Id.

XI. Particular Cases.

120. Each of the claims of this patent being limited to a buckle having a spring-clamp composed of two elastic wings or arms approaching each other, but not connected, they are not infringed by a buckle having its wings or arms firmly joined, and possessing no more

resiliency than is due to the character of the material, although it performs all the functions of the patented buckle. *Bruff v. Waterbury Buckle Co., 38 O. G. 1250, C. D. 1887.

121. In action for infringement of Letters Patent No. 77,920, issued to Herman and Louis Royer, May 12, 1868, for a machine for treating hides, plaintiffs' machine softened the hide by fastening it to a vertical shaft revolving in a crib, in which the hide was revolved under the pressure of a weight in the upper part of the crib, through which the shaft passed. Defendant's machine softened hides in the same way, except that his shaft was horizontal and the pressure on the hides was applied through the head of the crib by screws. *Held* an infringement, the principle and method of the plaintiffs being used in the design of the defendant. *Royer v. Coupe, 39 O. G. 239, C. D. 1887.

122. Where the specification showed that one material part of the invention was the detachment of the piston from the piston-rod, *held*, that a steam bell-ringer not containing this contrivance did not infringe the patent, although the most important features of the bell-ringer were suggested by the invention of the patentee. Decree of court below affirmed. *Snow v. The Lake Shore and Michigan Southern Ry. Co., 39 O. G. 1081, C. D. 1887.

123. When the original patent described and claimed a "bridge-piece," it described and claimed a piece which crossed an open space. *Patent Clothing Co. (Limited) v. Glover, 40 O. G. 1135, C. D. 1887.

124. The defendants, not using a bridge-piece which crossed an open space, did not infringe. *Id.

125. Although defendant employed a higher heat than that described in the patent and cooled the springs by plunging them into cold water, the patent being silent as to the method of cooling the springs, the patented method was infringed. *Cary v. Lowell Mfg. Co. (Limited), 40 O. G. 1239, C. D. 1887.

126. Where a patent is limited by disclaimer to a flat or "tape-wire" knife for cutting dough, there is no infringement in the use of a round wire. *Dosh v. A. J. Medlar Co. (Limited), 40 O. G. 1242, C. D. 1887.

127. Buttons similar to those made by the patentee's process were old, and the defendant in manufacturing a like article is not liable for infringement of any patent. *Cottle v. Krementz, 40 O. G. 1243, C. D. 1887.

128. The claim in controversy called for "outer sheets or layers of celluloid and an interlining of textile or fibrous material." The infringing article was made by one of the defendants of two sheets of muslin or cloth with a paper interlining, and sent in this form to another of the defendants, who placed a thin coating of zylonite upon one side of the compressed fabric and returned the same to the first defendant, who shaved off the cloth edge of the fabric and turned the zylonite side over upon itself, so that there was a surface of zylonite upon both sides of the collar except at the neckband. These collars were then sold by the third defendant. *Held*, that the claim of the patent had been infringed by each of the defendants. *Celluloid Mfg. Co. v. American Zylonite Co., 40 O. G. 1453, C. D. 1887.

129. It being contended that the fabric as manufactured did not infringe the patent, and the conversion of it into a collar being by an old and well-known method, *held*, that the question was whether an unpatented fabric had been changed into a patented one, and not whether a change had been effected by a familiar method. *Id.

130. A patent upon a device for an improvement in wagon-gear, designed to render the wagon-gear elastic and to relieve the strain upon the side springs, reach and head-block, is infringed by using a device substantially the same, although the latter is utilized also to aid the wagon to track. *Shaver v. Skinner Mfg. Co., 41 O. G. 232, C. D. 1887.

131. Although the bustle manufactured and sold by defendant was made, for all practical purposes, in imitation of the bustle patented by complainant, except that it was of rattan instead of wire, yet, as complainant in his specification limited himself to a bustle made of wire, he authorized the public to make and use bustles of any other material, and cannot complain of such use as an infringement of his rights. *Western & Wells Mfg. Co. v. Rosenstock, 41 O. G. 354, C. D. 1887.

132. Round rock-shafts in tilting malt-kiln trays are old and now common property, and it is an old expedient to tilt frames by square rock-shafts; but where the patentee sees fit to limit his claim to a square rock-shaft, the defendants who use a round shaft cannot be held liable. Also, while a patent may cover a new hook, it cannot prevent the use of an old door-latch. *Toepfer v. Goetz, 41 O. G. 933, C. D. 1887.

133. A patent claiming as an element in a combination "double braces," which are described in the specification and shown in the

drawings as extended in opposite directions, is not infringed by a construction where the "braces" extend in the same direction with a manifest advantage. *Morss v. Manchester, 41 O. G. 1392, C. D. 1887.

134. Where complainant's patent claimed "conical feed-rolls," and the defendant's machine had short cylindrical feed-rolls feeding in a circular direction, these latter rolls were not the equivalent of complainant's conical feed-rolls, and there is no infringement. *Dryfoos v. Wiese, 42 O. G. 490, C. D. 1888.

135. The complainant's patent is held to claim a spring-impelled cash-carrier and to have been infringed by a cash-carrier impelled by the expansion of compressed air. *Rapid Service Store Ry. Co. v. Taylor, 42 O. G. 721, C. D. 1888.

136. Where the defendant's anvil was made in separate parts, while the complainant's was a single piece, if the operation and results of each were the same, one construction was the equivalent of the other. *Thompson v. Gildersleeve, 43 O. G. 886, C. D. 1888.

137. The claim of the patent embracing a longitudinal groove as a guide for honey combs, the employment of pieces of wax as a guide is not a mechanical equivalent and not an infringement. *Forncrook v. Root, 43 O. G. 984, C. D. 1888.

138. The cylinder of the claim being described as having chambers or depressions, and the defendants' cylinder being smooth throughout, there was no infringement in this particular. *Hendy v. The Golden State and Miners' Iron Works, 43 O. G. 1117, C. D. 1888.

139. The process consisting of subjecting the slab of celluloid to pressure, then heating the mass from below, then applying the heat above, *held* infringed by defendants' process, in which the heat is first applied from above and afterward from below. *Celluloid Mfg. Co. v. American Zylonite Co., 42 O. G. 961, C. D. 1888.

140. A hay-press adapted to bale two bales at the same time, having a partition-board attached to and moving with the follower, is not infringed by a press having a partition-board which is removed before the pressure is applied and does not perform the offices of the complainant's board except to a limited extent. *Kulp v. Souder, 45 O. G. 712, C. D. 1888.

141. The first claim of Letters Patent No. 252,230, granted January 10, 1882, to George Ligowsky, for a target-trap — being "the combination, in a target-trap, of a spring-lever, a rack, and an adjustable tension-arm carrying the trigger, with which latter is engaged said lever" — is not infringed by a target-trap not having such notched rack and in which the adjustable tension is not produced by means of the tension-arm, but by means of a screw which operates a rod attached to the lower end of a coiled spring. *Ligowsky Clay Pigeon Co. v. Peoria Target Co., 45 O. G. 1457, C. D. 1888.

142. The distinguishing feature of the Teipel patent being that it is adapted to the use of the longitudinally-strained spring, and not the coiled spring, and the first and second claims being for the combination of the spring strained between the end of the lever and the point at which it is fastened to the bed-piece, they are not infringed by the defendants' device, in which such strained spring does not appear. *Id.

143. Where the claim is limited to a lever locking in vertical position, and defendants' lever, like a prior patented lever locked in a horizontal position, *held*, that the claim is either anticipated or not infringed. *Rodebaugh v. Jackson, 47 O. G. 658, C. D. 1889.

144. Where after official rejection a patentee's claim was limited to the specific device described, in which the lever for operating the dog-bar locked when in vertical position, and the defendant's lever was so arranged as not to lock in that position, *held* to be no infringement. *Rodebaugh v. Jackson, 47 O. G. 660, C. D. 1889.

145. The combination covered by the third claim of plaintiffs' patent, which includes an inclined and retreating anvil to sustain the wire of the staple while being bent and to support the staple while being driven, is infringed by defendant's device having a two-part anvil, which, though different in form, accomplishes the same result in the same way. *Thompson v. American Bank Note Co., 48 O. G. 540, C. D. 1889.

146. The only difference between the two gripping devices is that the pulleys in the defendant's device are connected with the movable jaw, while in the device of the patent they are connected with the fixed jaw; and in the patented devices the movement of the lower jaw to release the cable is a vertical movement both as respects the fixed jaw and the pulleys, while in the defendant's apparatus the movement of the lower jaw is a vertical movement as respects the fixed jaw, but not as respects the pulleys. These are merely formal differences. They do not involve any inventive thought, and are immaterial as respects the function and mode of operation of the parts of

the combination. *Root v. Third Avenue R. Co., 48 O. G. 674, C. D. 1889.

147. The selling by the defendant of valves under the name of "Foley's," or "Foley's Patent Valves and Overflows," signifies that they are the kind of valves invented and patented by Foley, but not that they are the valves which he or his successor is manufacturing. *Adee v. Peck Brothers & Co., 48 O. G. 823, C. D. 1889.

148. Defendant's lock was substantially identical with the lock of the defendant in Yale Lock Co. v. Berkshire Nat. Bank, except that in the latter there was an additional dog controlled by the time mechanism, which dog added nothing to the efficiency or value of the lock. The defense of that case was assumed by a lock company, or its president, who afterward became president of defendant, and all the questions presented here were presented in that case. On the authority of that case, *held*, that defendant's lock was an infringement. *Yale & Towne Mfg. Co. v. Consolidated Time Lock Co., 48 O. G. 1399, C. D. 1889.

149. Letters Patent No. 170,012, granted November 16, 1875, to John B. Newbrough, for improvement in dental chairs, *held* not to be infringed by a device used by the defendant, which simply operates to regulate the tilt of the back of the chair and not to tilt the body of the chair, which was the object of patentee's invention, and where it appears that the tilting of the back of the chair in the complainant's case is made by a different apparatus entirely from that used by defendant. *Brush v. Condit, 49 O. G. 1211, C. D. 1889.

150. The construction claimed in Letters Patent No. 272,598, granted February 20, 1883, to John F. Steward, has for its object to provide means in an automatic grain-binder to automatically regulate the position of the band on the gavel without aid or attention from the operator, and in view of the prior state of the art the claims must be restricted to the exact combinations set forth in them, and such claims are not infringed by parties using a different construction. *Deering v. McCormick Harvesting Machine Co., 52 O. G. 1223, C. D. 1890.

151. A claim in Letters Patent No. 266,913, granted October 31, 1882, to John F. Steward, relating to a construction for compressing the grain before tying, in connection with a spring-link for relieving the strain and avoiding breakage, is not infringed, in view of the prior state of the art, by a device for the same purpose which is not identical with the construction set forth in such claim. *Id.

152. The Scribner lamp held to infringe the Brush patent, as it contemplates a dissimultaneous arc-forming separation by mechanism not radically different from that of Brush. *Brush Electric Co. v. Western Electric Light and Power Co., 52 O. G. 1950, C. D. 1890.

153. The patent is infringed by a device whose only difference from the patented machine is that its trip-rod receives the stroke of the hammer in its backward instead of its forward motion. *Walker v. City of Terre Haute, 54 O. G. 507, C. D. 1891.

154. Where in a suit for infringement it appeared that the patent in suit was granted August 13, 1889, on an application filed December 2, 1887, and renewed March 28, 1889, and that the defendants manufactured and sold the alleged infringing machine made in accordance with letters patent issued to defendants' assignor December 4, 1888, on an application filed September 8, 1888, *held*, assuming that defendants' machine embodied substantially the same invention claimed and described in the patent in suit, and that the device of said patent possessed patentable novelty, that, under the circumstances and in the absence of other evidence, the court would not presume that plaintiff's assignor was the first inventor, simply because his application for a patent was first filed. *Held*, further, that the burden was on the plaintiff to establish that he was the first inventor; that such fact had not been shown, and that it was just as reasonable to infer that defendants' assignor was the first inventor. *American Roll Paper Co. v. Knopp, 54 O. G. 139, C. D. 1891.

155. A patent for a lens-holder is infringed by a lens-holder having a number of pieces operating in substantially the same way as the patented article, even though the number of pieces is not the same in the two holders. *White v. Walbridge, 56 O. G. 1204, C. D. 1891.

156. The words of the claim and specification which refer to the body of the vessel as "globe-shaped" or "spherical" must be taken in their ordinary rather than their mathematical signification, and infringement cannot be avoided by merely elongating the body so as to render it an ovoid rather than a sphere or globe. *Ripley v. Elson Glass Co., 60 O. G. 298, C. D. 1892.

157. The claim for "A new article of manufacture, a smoking pipe made of corncob, in which the interstices are filled with a plastic self-hardening cement, substantially as and for the purposes set forth," *held* infringed when

any plastic mixture—such as ground corncob and starch or ground corncob and shellac—which will set or harden is applied as a filler to the exterior surface of the bowl of a corncob pipe, and that it makes no difference whether the plastic self-hardening mass is moistened and mixed before it is applied or in the act of applying. *H. Tibbe & Son Mfg. Co. v. Lamparter, 61 O. G. 427. C. D. 1892.

158. Where the claim is for "the treatment of the prepared rawhide in the manner and for the purposes set forth," and the process as described comprehends "the removal of the hair from the hide by means of sweating," and further avers that the patentee avoids "the use of lime, acid or alkali," a treatment which omits the "sweating" but uses the "liming" process is not an infringement. *Royer v. Coupe, 62 O. G. 318, C. D. 1893.

159. Where the complainants' instruments differed in mechanical structure from those of the defendant to such an extent as to result in a noticeable difference in the tones of the instruments, calling for a different kind of trade, *held*, that there was no infringement. *Dobson v. Cubley, 63 O. G. 1059, C. D. 1893.

160. The infringement is not avoided by so attaching the gripping device that it may be detached when required, for the terms "permanently attached" in the claim import, merely, that the gripping device is an essential part of the car, and not that it is incapable of removal. *Pacific Cable Ry. Co. v. Butte City Street Ry. Co., 64 O. G. 1397. C. D. 1893.

161. Claim 1 of Patent No. 223,812, dated January 27, 1880, describing a swinging elevator located upon the *grain* or ascending side of the main belt, pivoted at its *lower* end and movable at its *upper* end, cannot be construed to cover a similar device located upon the *stubble* side, pivoted at its *upper* end and swinging at its *lower* end, particularly in view of the facts that the patent is not a pioneer patent, that the specification confines the invention to the terms of the claim, that in no one of the six claims is there a suggestion that the elevator or belt could be located upon the stubble side, that the invention was of doubtful utility and never went into practical use, that the mechanism set forth in the patent to Bullock and Appleby of October 31, 1882, No. 266,949, under which the defendant manufactured its machines, was extensively sold throughout the country for about eight years before any assertion of adverse right under the Olin patent, the plaintiff himself becoming a licensee under the patent, and that though Olin, while in the patent office, was thrown into an interference with another application having broader claims, he made no attempt to insert such broader claims. The Olin patent was not infringed. *Deering v. Winona Harvester Works, 69 O. G. 1641, C. D. 1894.

162. The claim for "a toy bank consisting of a hollow toy provided with a coin-receiving and coin-discharging aperture, a movable cover for the discharging aperture, and a spring-latch to secure the same from within, said spring-latch being normally closed, but constructed to be opened by the weight of the coin within," *held* infringed by a device consisting of the same elements, but in which the cover to the discharging aperture is retained in place until a pressure applied through the contained coin greater than the weight of the coin releases said cover. *Colby v. Card, 69 O. G. 125, C. D. 1894.

163. A patent for an improvement in shirts, all the claims of which apply only to shirts which have a double or supplementary front, is not infringed by a shirt having a false front forming part of the shirt, giving the appearance, without the reality, of a double or supplementary front. *Knit Goods Patents Co. v. Shuman, 69 O. G. 511, C. D. 1894.

164. Claims 1, 2 and 4 in Patent No. 360,070, dated March 29, 1887, to George Westinghouse, Jr., for an improvement in brake mechanism, which broadly covers "an auxiliary valve device, actuated by the piston of the triple valve and independent of the main valve," *held* infringed by a structure in which the piston of the triple valve acts upon the auxiliary valve, not directly, but by opening a port which reduces pressure on one side of another piston in a supplemental chamber, the movement of such supplementary piston opening the auxiliary valve. *Westinghouse Air-Brake Co. v. New York Air-Brake Co., 70 O. G. 388, C. D. 1895.

165. Claim 1 in Patent No. 376,837, dated January 24, 1888, to George Westinghouse, Jr., for an improvement in fluid pressure automatic brake mechanisms, which broadly is for a piston actuated "by pressure from an auxiliary reservoir," *held* infringed by a structure in which the piston is moved by a charge from an additional reservoir charged in the same way as the auxiliary reservoir is charged. *Id.

166. Because the differences do not involve invention and the function is the same in both,

there is infringement. *Holmes v. Truman, 73 O. G. 448, C. D. 1895.

167. Claim 1 of letters patent to A. A. Whiteley, No. 418,257, for an elastic cord exercising apparatus, issued December 31, 1889, *held* infringed. "The function, utility or result of defendant's apparatus is contained in that of complainant. . . . An infringement is not avoided because the infringing device is better, more useful and more acceptable to the public than that of the patent infringed, nor, on the other hand, because the infringing device by some colorable variation or expedient merely impairs or narrows the function and usefulness of the device infringed." *Whiteley v. Fadner, 74 O. G. 968, C. D. 1896.

168. Browning's device does away with the presence of a trainman in coupling cars, since it is automatic in its character, and a claim for it is not infringed by a device which is without any automatic means for necessarily placing the device in position for coupling. *Gould Coupler Co. v. Trojan Car Coupler Co., 75 O. G. 2009, C. D. 1896.

169. The patentee placed between the dies used in making his articles short sections of a smooth straight-sided tube. One effect of the dies is to change the thickness of metal of these sections by swaging or upsetting. This is not infringed by a process for making similar articles in which sections of a corrugated tube are used, in operating upon which the effect of the dies is to fold or unfold the corrugations without upsetting the metal or changing its thickness. *Jackson v. Birmingham Brass Co., 75 O. G. 677, C. D. 1896.

170. The fact that defendant employs a paper impregnated with a wax having a melting-point different from that of the wax used by complainant is not sufficient to avoid infringement when the essential characteristic of the wax employed in each case is its hardness and the degree of hardness is the same in both. *A. B. Dick Co. v. Henry, 75 O. G. 1204, C. D. 1896.

171. A claim for a torpedo, a detachable clip, and means for attaching the clip to the torpedo is infringed by a device which has the same elements, although differing in details. *Bennett v. Schooley, 76 O. G. 335, C. D. 1896.

172. A claim which includes as a persistent, express and pronounced feature an air-chamber is not infringed by a device some particular part of which may be a "compartment" or "inclosure," but which part never contained a volume of air. *Scarborough v. Neff, 76 O. G. 475, C. D. 1896.

173. The contention that, since it is physically impossible for two sets of carbons to be separated at one and the same electrical instant, the defendant's devices must infringe is manifestly fallacious. *Brush Electric Co. v. Western Electric Co., 77 O. G. 1273, C. D. 1896.

174. Devices which effect a distinctly simultaneous separation of pairs of carbons of a lamp do not infringe a patent in which there is claimed a device for securing a dissimultaneous separation of such pairs of carbons. *Id.

175. The substitution of a horizontally-moving roller presser and cutter for a vertically-moving direct plunger and cutter will not suffice to avoid infringement in the case of a defendant who was also an unsuccessful defendant in a long course of prior litigations, even though the structure complained of evades the wording of the claims in suit. *Beach v. Inman, 77 O. G. 1275, C. D. 1896.

176. A centrifugal separator in which a pump is employed to remove the separated cream is not infringed by a device in which the pump is omitted, when its omission is attended with a corresponding omission of its function, the same result being attained by a nice adjustment of the remaining parts. *Philadelphia Creamery Supply Co., Limited, v. Davis & Rankin Building and Mfg. Co., 79 O. G. 1194, C. D. 1897.

177. A device which uses a single continuous admission of air does not infringe a claim of which a second admission has been made a material feature. *Westinghouse Air-Brake Co. v. New York Air-Brake Co., 79 O. G. 1679, C. D. 1897.

178. When any two parts or spaces abut directly upon each other, the idea of a connecting-passage is necessarily dispensed with, and such construction does not infringe a claim in which the connecting-passage is an essential element. *Id.

179. A construction which has air in a chamber in free communication with a train-pipe is still train-pipe air in effect and has train-pipe pressure, and is not infringed by a device which is worked by air in a chamber absolutely cut off by a slide from a train-pipe. *Id.

180. A claim, one element of which is a curved spring-plate upon the vibrating end of a pitman, is not infringed by a press which lacks this element. *Kansas City Hay-Press Co. v. Devol, 81 O. G. 1277, C. D. 1897.

INJUNCTION.

(See DAMAGES AND PROFITS; EQUITY.)

I. IN GENERAL.
II. DISSOLUTION.
III. PRELIMINARY, WHEN GRANTED.
IV. PRELIMINARY, WHEN DENIED.
V. PERMANENT.
VI. PRIOR JUDGMENT.
VII. STAY OF.

I. IN GENERAL.

1. Where a patent has been applied for on an invention, the court has jurisdiction to grant an injunction to restrain its infringement pending the hearing. *Butler v. Ball, 38 O. G. 420, C. D. 1887.

2. There is no jurisdiction in the United States courts of equity to enjoin a libel on the rights or title of an owner of letters patent. *Baltimore Car Wheel Co. v. Bemis, 38 O. G. 1132, C. D. 1887.

3. The sale of materials to be used in an infringing process — the parties using said process having no license therefor — will be enjoined. *Willis v. McCollen, 38 O. G. 1017, C. D. 1887.

4. An injunction granted in this cause February 5, 1886, is not violated by the defendant in the use of a device which is a stop on moving the trip-hand of a fare-register forward beyond zero, but is not capable of being fixed where registration is begun away from the proper place so as to indicate that fact. *Railway Register Mfg. Co. v. Broadway and Seventh Avenue R. Co., 40 O. G. 1243, C. D. 1887.

5. The fact that defendant used a combination of his own in his self-feeding pen was not sufficient to overcome the fact that his combination was merely additional to plaintiff's combination, which he was using, and to prevent which an injunction would be granted. *Wirt v. Brown, 41 O. G. 236, C. D. 1887.

6. The complainant having filed his bill for infringement in the usual form, one of the defendants—a manufacturing company—applied for an order restraining the complainant from suits for infringement against its customers during the pendency of the suit against it. The petition for the restraining order was sworn to, and set out the defenses which would be made in the answer, particularly its own patent, under which it manufactured governors, and was supported by affidavits. The complainant put in no evidence in answer to the petition, but rested upon the proposition that, as a matter of law, the grant of the patent gave him the right to sue all infringers of it. *Held*, that the petition was proper, and the order was granted. *Ide v. Ball Engine Co., 41 O. G. 1271, C. D. 1887.

7. The court has authority under the general chancery powers to issue such an order before the filing of an answer or of a cross-bill. The form of such restraining order stated. *Id.

8. The use of words which are technically descriptive will be enjoined where it appears that they are used as a means of effecting a fraud. *Moxie Nerve Food Co. v. Various Defendants, 43 O. G. 888, C. D. 1888.

9. Complainants' licensees established telephone exchanges in certain cities and towns in the state of Indiana, but withdrew them upon the passage by the legislature of that state of an act limiting the rates of charges. The defendants re-established them, using the "Cushman" telephones, which have been held by this court to infringe the complainants' patents. *Held*, that the fact that the complainants' licensees had withdrawn their telephonic service from these cities furnished no excuse or defense for the infringement of their patents by the defendants. Injunction granted. *American Bell Telephone Co. v. Cushman Telephone Service Co., 45 O. G. 1193, C. D. 1888.

10. Under the law the monopoly secured by a patent ceases with the expiration of the patent, and articles made during the life of the patent in infringement of it cannot be enjoined after its expiration, and an injunction already granted as to such articles will be dissolved. *Westinghouse v. Carpenter, 46 O. G. 244, C. D. 1889.

11. In a suit for infringement of a patent a court of equity has the power, upon petition of defendants, to restrain complainant from bringing further suits against the purchasers or users of the patented article, and will do so when the affidavits filed by defendants show that the suits brought are vexatious and oppressive. *National Cash Register Co. v. Boston Cash Indicator and Recorder Co., 51 O. G. 626, C. D. 1890.

12. Section 4921 of the Revised Statutes confers upon courts vested with jurisdiction of cases arising under the patent laws power to grant injunctions according to the course and principles of courts of equity; but the exercise of the power is limited to a specific purpose — namely, to prevent the violation of any rights secured by patent. *Illingworth v. Atha and

Commissioner of Patents, 51 O. G. 803, C. D. 1890.

13. A defendant in a patent suit who was the manufacturer of certain articles claimed to be an infringement of plaintiff's patent sought to obtain an order enjoining the prosecution of three suits begun in other districts against its customers, as well as the commencement of new suits, and the sending of letters and circulars to others engaged in the trade threatening prosecution for selling articles made by the defendant. *Held*, first, that the prosecution of suits in other districts should not be enjoined, because such suits were begun before this suit, and because comity demanded that application should be made to the court in which such suits were pending. *Kelley v. Ypsilanti Dress-Stay Mfg. Co., 54 O. G. 659, C. D. 1891.

14. *Held*, further, that as the plaintiff might recover substantial damages against the defendant's vendees, in addition to those which he would be entitled to recover against the defendant as manufacturer, the commencement of new suits should not be enjoined unless irreparable injury was threatened to defendant's business, or there was evidence of malice or bad faith on the part of the plaintiff in commencing such suits. *Id.

15. And *held*, further, that plaintiff had a right to notify persons using his device of his claim and to call attention to the fact that by selling or using it they were making themselves liable to prosecution, and that an injunction would not be ordered unless the language of his letters or circulars was false, malicious, offensive or opprobrious, or they were used for the wilful purpose of inflicting an injury. *Id.

16. It is not necessary to show in a suit for infringement of a patent that the plaintiff is or has been engaged in the manufacture, sale or use of the patented inventions, or that they have been a source of profit to him, or a prior adjudication upon the validity of the patent, or acquiescence by the public in the use and enjoyment thereof, if a preliminary injunction is not asked for. *Wirt v. Hicks, 56 O. G. 663, C. D. 1891.

17. It is proper to issue an injunction against one who has already infringed a patent, even though he denies that he intends to make any further infringement. *White v. Walbridge, 56 O. G. 1204, C. D. 1891.

18. On the question as to whether an injunction should issue it is immaterial that the owner of the patent has never made, used or sold any of the patented articles or licensed any one to do so, especially when it appears that he has not done so because defendant and other railroad companies, being unwilling to pay the price asked by him, adopted his invention without leave, expecting to pay a less sum by way of damages for infringement. *Campbell Printing Press & Mfg. Co. v. Manhattan Ry. Co., 60 O. G. 894, C. D. 1892.

19. Defendant cannot escape the injunction on the ground of hardship to itself or to the public, since the decree may provide for a gradual removal from its cars of the patented article so as not to cause the withdrawal from service of a large amount of rolling stock at any one time, and for that purpose the amount of rolling stock required and available for its business may be proved by affidavits or the oral examination of its superintendent or master-mechanic. *Id.

20. Where a defendant has been guilty of bad faith toward a complainant in an infringement suit, he is not equitably entitled to ask a bond from complainant as a condition to the granting of a preliminary injunction, and the court will waive the requirement of bond where the record discloses proof of such a state of facts. *Pasteur Chamberland Filter Co. v. Funk, 60 O. G. 1479, C. D. 1892.

21. The right to an injunction rests on anticipated and threatened infringements, and where a bill avers reasonable ground for fearing such future infringements a failure to show prior infringements is unimportant except on question of damages. *Canton Steel Roofing Co. v. Kanneberg, 61 O. G. 424, C. D. 1892.

22. On motion for a preliminary injunction, where a patent is set up as anticipation, which on its face antedates the patent in suit, complainant may show, if he can, that his patented invention was actually made prior to the date of the anticipating patent, and he will thereby avoid anticipation, and the alleged anticipating patent will not be considered. *Norton v. Eagle Automatic Can Co., 65 O. G. 442, C. D. 1893.

23. The rule is well established that a patent does not create a sufficiently strong presumption of its own validity to justify a court in a preliminary injunction. *Palmer Pneumatic Tire Co. v. Newton Rubber Works, 73 Fed. Rep. 218 (1896).

24. The monopoly under a patent does not commence until the patent issues. An inventor

has no right to injunctive relief while his application for a patent is pending in the patent office. *Brill v. St. Louis Car Co., 79 O. G. 2017, C. D. 1897.

25. Where devices covering several patents are capable of embodiment and conjoint use in a single machine and it was sought to recover in a single suit for infringement. the failure of the complainant either to establish title to one of the patents or to show infringement of one or more of them does not affect his right to an injunction and an accounting in respect of others if the proof is sufficient to show that they are infringed. *Kansas City Hay-Press Co. v. Devol, 81 O. G. 1277, C. D. 1897.

26. While the issuance of an injunction would be advantageous to the complainant in its efforts to protect its business and prevent an onslaught upon it, yet when there are serious doubts as to the validity of the contested claims of the patent, injunction against infringement should not issue. Such an interference with the business of one manufacturer to strengthen the position of another pending an attack upon the validity of his patent seems to be an undue stretch of the power of a court of equity. *Welsbach Light Co. v. Benedict and Burnham Mfg. Co., 82 O. G. 2247, C. D. 1897.

II. Dissolution.

27. Motion to dissolve an injunction on the ground that the invention covered by the patent was described in a prior patent to same inventor denied. *Holmes Electric Protective Co. v. Metropolitan Burglar Alarm Co., 40 O. G. 1242, C. D. 1887.

28. An injunction as to articles made during the life of the patent in infringement of it will be dissolved after expiration of the patent. *Westinghouse v. Carpenter, 46 O. G. 244, C. D. 1889.

29. After a patent, the infringement of which has been enjoined, expires the injunction will be dissolved without reference to such articles as were manufactured while the patent was alive. The patentee may recover damages for such acts of infringement. *Westinghouse v. Carpenter, 54 O. G. 140, C. D. 1891.

30. The burden of proof is on defendant to show cause for dissolving a temporary injunction; but nevertheless a dissolution will be granted upon new evidence sufficient to raise grave doubts as to the complainant's right to such injunction. *Edison Electric Light Co. v. Buckeye Electric Co., 67 O. G. 529, C. D. 1894.

III. Preliminary, When Granted.

31. Should plaintiff use the injunction to injure the defendants' business, without regard to their use of the invention, his standing in a court of equity will be destroyed and the injunction promptly dissolved. ‡Russell v. Lundeen, 72 O. G. 420, C. D. 1895.

32. A preliminary injunction to restrain infringement of a patent will not be granted unless there is a special presumption that the patent is valid. The presumption may arise by proof that the patent has been suitably adjudicated in the federal courts and there held valid, or that its validity has been suitably acquiesced in by the public, or that the patent has successfully undergone an interference in the patent office. *Edward Barr Co. (Limited) v. New York & New Haven Automatic Sprinkler Co., 32 Fed. Rep. 79 (1887).

33. It appearing that the packing made by defendant since the injunction in the former suit differed only in form from that enjoined, but operated in the same way, a preliminary injunction is proper. *United States Metallic Packing Co. v. Tripp, 39 O. G. 1554, C. D. 1887.

34. Where the injury to the defendants would be trifling should a preliminary injunction be granted, and where the injury to the complainants would be destructive if the preliminary injunction should not be granted, and the infringement is not seriously denied and acquiescence is proved, the court will not hesitate to grant the relief asked for. *Hat Sweat Mfg. Co. v. Davis Sewing Machine Co., 41 O. G. 1273. C. D. 1887.

35. The mere fact that a defendant has ceased to infringe a patent is not a sufficient reason to withold the issuance of preliminary injunction. *Celluloid Mfg. Co. v. Arlington Mfg. Co., 42 O. G. 828, C. D. 1888.

36. A complainant may have a preliminary injunction against an infringing defendant who is a mere selling agent, where, the patent having nearly expired, the court might refuse it against a manufacturer giving proper security. *Remington Standard Type-Writer Mfg. Co. v. Bailey, 60 O. G. 440, C. D. 1892.

37. Although the complainant has not shown the manufacture by the defendants of the infringing articles, preliminary injunction will be granted based upon proof that they have kept such articles in stock and offered them for sale. Although the defendants may have no present intention of continuing such sales, in view of the fact that there is a final decision sustaining the patent, the court will exercise

its discretion to secure the continuance of that intention by the granting of a preliminary injunction. *New York Belting and Packing Co. v. Gutta-Percha and Rubber Mfg. Co., 61 O. G. 892, C. D. 1892.

38. A patentee assigned all his interest in a patent, agreeing not to manufacture or sell the patented machine or make any improvement thereon which would adapt it to any other kind of work. Subsequently the assignee sued him for infringement in making an improvement on the machine. *Held*, on motion for preliminary injunction, that in the light of the above contract, although the suit was not based thereon, the patentee was not in so favorable a position before a court of equity as one who infringes ignorantly or inadvertently, and that the patent should be construed liberally as against him. Loring v. Booth, 61 O. G. 1483, C. D. 1892.

39. An injunction will not be refused on a suggestion that an improper use may be made thereof by advertising to embarrass defendants in the sale of non-infringing articles, since it must be presumed that the injunction was sought in good faith, and should the contrary appear the court could reconsider its action. *New York Belting and Packing Co. v. Gutta-Percha and Rubber Mfg. Co., 64 O. G. 1534, C. D. 1893.

40. The offering of additional *ex parte* testimony not a reason for the grant of a preliminary injunction against a patent which has been so severely attacked and uniformly sustained. *American Bell Telephone Co. v. Cushman, 65 O. G. 135, C. D. 1893.

41. There are cases where the courts have refused a preliminary injunction and allowed defendant to give bonds in lieu thereof on the ground of hardship that would be entailed upon the defendant by an injunction, notwithstanding the fact of prior adjudication of validity of the patent; but upon consideration of the facts here it is held that this is not such a case, and the injunction is granted, although it may entail a hardship on the respondent. *Norton v. Eagle Automatic Can Co., 65 O. G. 442, C. D. 1893.

42. Although the patentees in this case have elected to enjoy the monopoly of their patent by granting licenses, nevertheless, it appearing that to refuse them a preliminary injunction would absolutely destroy the value of that patent, a preliminary injunction will be granted. *Id.

43. Where, on motion for a preliminary injunction, it is shown that six months prior to commencement of the suit complainant's attorneys visited the factory of respondent and there saw in operation respondent's machine, and it further appears that complainant had then pending, but undecided, in the same circuit a suit against another party upon a machine involving some, if not all, of the questions involved in the case at bar, complainant had a right to wait until a decision was rendered in the suit against the other party before bringing suit against respondent; and where complainant commenced his suit against respondent two weeks after the decision against such other party in the other case, he is not guilty of laches such as will disentitle him to a preliminary injunction. *Id.

44. Letters Patent Nos. 308,981 and 308,982, issued December 9, 1884, to Frank L. Palmer, are for improvements for stitching comfortables by machinery. Owing to the commercial advantages given by these patents, complainants, who owned them, were enabled to practically command the entire business of this country in this kind of quilts. The validity of the patents had never been denied except by one other party, who, after suit brought for infringement, compromised the same, and has ever since paid a royalty. *Held*, that on an application for preliminary injunction where infringement was plain, the patents would be presumed to be valid and the injunction granted, unless defendants gave a sufficient bond to secure any damages decreed against them. *Palmer v. Mills, 65 O. G. 1069, C. D. 1893.

45. Where a new art and apparatus, such as that of electric welding, is widely accepted by the scientific world and the public generally as novel and important, and is speedily put in operation, and the machines and rights under the patent are eagerly sought for by manufacturers, thus supplanting to a large extent the older methods—all with no question as to the validity of the patent, except in the case of the defendant,—this is sufficient evidence of acquiescence to justify the issuance of a preliminary injunction, unless defendant can clearly show that the patent is invalid. *Thomson Electric Welding Co. v. Two Rivers Mfg. Co., 69 O. G. 1207, C. D. 1894.

46. The rule is well established that a patent does not create a sufficiently strong presumption of its own validity to justify a court in a

preliminary injunction. *Palmer Pneumatic Tire Co. v. Newton Rubber Works, 73 Fed. Rep. 218 (1896).

47. A preliminary injunction will only be granted where the patent has been previously sustained, or public acquiescence is shown, or where it has withstood a contest by interference in the patent office. *Id.

48. A motion for a preliminary injunction will be granted when it appears that the defendant's structure is the same as the complainant's in all respects save one, and that one, though differing in a narrow technical sense, is the same in principle, and when it further appears that the complainant's patent has been uniformly upheld during years of arduous litigation with the present defendant. *Beach v. Inman, 77 O. G. 1275, C. D. 1896.

49. Injunction will be granted against the attorneys-at-law of an absent defendant to prevent importation of an infringing article when such attorneys are acting as attorneys-in-fact for such absent defendant. *Société Fabriques de Produits Chimiques de Thann et de Mulhouse v. Sander, 78 O. G. 1432, C. D. 1897.

IV. Preliminary, when Denied.

50. In an action for an infringement of a patent, where there is doubt as to the priority of the invention, if the defendants are amply responsible and the plaintiff sells licenses for a royalty, so that there will be no difficulty in ascertaining the damage, a preliminary injunction will be denied. *National Hat Pouncing Machine Co. v. Hedden, 38 O. G. 1129, C. D. 1887.

51. A preliminary injunction will not be granted to restrain the infringement of a "design for a banner-rod, consisting of a conventional imitation of a straight twig with the bark and slantingly-cut ends," the section which relates to design patents demanding, it may be supposed, the exercise of more genius than is exhibited by it. *Osborn v. Judd, 38 O. G. 1132, C. D. 1887.

52. A motion for a preliminary injunction was denied where it appeared that the validity of the patent in suit was vigorously assailed and that the defendants did not manufacture the infringing articles, but bought the same from the manufacturer living in another district, against whom complainant had a suit pending in which a preliminary injunction had been applied for and denied with leave to renew. *Hicks v. Beardsley, 41 O. G. 235, C. D. 1887.

53. Leave to renew the motion was granted should an injunction preliminary or final be obtained in the suit against the manufacturer. *Id.

54. Preliminary injunction denied when there was no special presumption in favor of the patents, arising from an adjudication in a federal court, acquiescence by the public, or a successful interference in the patent office. *Edward Barr Co. (Limited) v. New York and New Haven Automatic Sprinkler Co., 43 O. G. 392, C. D. 1888.

55. A preliminary injunction against the infringement of a patent will be denied where plaintiff does not show a prior adjudication sustaining the validity of the patent, or public acquiescence on which a presumption of validity may be based, and where it does not clearly appear that there is an infringement. *Raymond v. Boston Woven Hose Co., 48 O. G. 1776, C. D. 1889.

56. Where, in a suit for the infringement of a patent, the validity of which was dependent upon the result of an appeal in a former suit for its infringement, it appeared that the defendant was a manufacturer and the complainant was not, and that the defendant had been carrying on its business in good faith and in ignorance of the alleged infringement, and that a sudden stoppage of its business might be ruinous to it, while if the decree in the former suit were affirmed the complainant would have an adequate remedy in damages, *held*, that a provisional injunction would not be granted. *Consolidated Roller-Mill Co. v. Richmond City Mill Works, 50 O. G. 1133, C. D. 1890.

57. Where, in a suit brought under section 4915 of the Revised Statutes by the defeated party in an interference proceeding, a motion was made to make absolute a temporary order restraining the commissioner of patents from issuing to the successful party a patent for the subject-matter in controversy in said interference, and restraining the successful party from receiving a patent for the same, and for a preliminary injunction against both defendants in terms pursuant to the prayer of the bill, and it appeared that the most that could be said in review of the testimony was that it might be that the commissioner had made a mistake in awarding priority of invention, *held*, that the motion should be refused and the restraining order discharged as to both defendants. *Illing-

worth v. Atha and Commissioner of Patents, 51 O. G. 803, C. D. 1890.

58. A preliminary injunction should not issue in a suit for infringement where upon the issue of priority of invention the evidence is merely oath against oath. *Mack v. Spencer, 54 O. G. 1418, C. D. 1891.

59. A preliminary injunction will be denied when in the patent upon which suit is brought there is a disclaimer of what is covered by another application of the same inventor and the application or a copy thereof is not furnished. *National Typographic Co. v. New York Typograph Co., 56 O. G. 661, C. D. 1891.

60. An unexplained delay of over seven years in bringing suit for infringement of a patent deprives the complainants of the right to a preliminary injunction and perhaps to an account for past infringement. Further infringement, however, will be prevented by an injunction, notwithstanding previous laches. *Price v. Joliet Steel Co., 56 O. G. 664, C. D. 1891.

61. On a motion for an interlocutory injunction against the resale in the United States of patented goods purchased from a foreign corporation operating under the same patent as complainant, it must appear that defendant had notice of restriction against such resale when he paid the purchase price or the injunction will not issue. *Dickerson v. Matheson, 57 O. G. 1724, C. D. 1891.

62. A preliminary injunction will not issue in a case to restrain the infringement of letters patent where it appears that (1) the plaintiff's title is involved in some obscurity; (2) the patents have never been adjudicated; (3) the proof of acquiescence is inadequate; (4) infringement is not conclusively established; (5) defendant's financial ability is unquestioned. *R. E. Dietz Co. v. C. T. Ham Mfg. Co., 57 O. G. 1884, C. D. 1891.

63. If the court can see that there is any likelihood of the defendant's success on final issue, it should not permit the writ to issue, even though "it is probably true that the complainants have reason to complain of the defendant's course." *Id.

64. A motion for preliminary injunction to restrain the use of certain machines claimed an infringement of complainant's patent will not prevail where it appears that defendant is solvent and able to respond in damages to any amount suffered by complainant on account of such alleged infringement. *Whitcomb v. Girard Coal Co., 58 O. G. 523, C. D. 1892.

65. In an action for infringement, where it appears that both complainant and defendant sold the articles prior to grant of patent, and that the only instance of infringement by defendant was a sale made shortly after the patent was granted and prior to notice thereof, preliminary injunction should be denied. *Anderson v. Germain, 58 O. G. 1092, C. D. 1892.

66. When the court has a real doubt whether there is any infringement, and assurances have been given that a prompt final hearing shall be had, temporary injunction will not issue. *Hammond Buckle Co. v. Goodyear Rubber Co., 59 O. G. 301, C. D. 1892.

67. A motion for a preliminary injunction in advance of any adjudication by the courts or an adjudication by the patent office as to priority will not be allowed unless the case is entirely clear and unless irrevocable injury is to result from withholding the injunction. *Iron-Clad Mfg. Co., Incorporated, v. Jacob J. Vollrath Mfg. Co., Limited, 60 O. G. 1480, C. D. 1892.

68. Where the evidence as to the construction of claims and their infringement was necessarily and largely *ex parte*, and where the damages which the complainants may suffer can be compensated in money by the respondents. *held*, that a preliminary injunction ought not to be granted. *Standard Elevator Co. v. Crane Elevator Co., 64 O. G. 438, C. D. 1893.

69. Although complainant's patent has been upheld in a suit against other parties in which defendants' patent was pleaded, a preliminary injunction against alleged infringement by manufacturing devices under the latter will not be granted when it appears that the former suit was so decided on the ground that there was an estoppel to question the novelty of complainant's patent, so that the validity of defendants' patent was not considered. *Ney Mfg. Co. v. Superior Drill Co., 64 O. G. 1133, C. D. 1893.

70. A preliminary injunction will not be granted in an infringement suit where complainant does not apply for it until two months after his bill was filed, during which time defendant has proceeded to fill up his stock of the alleged infringing articles for the coming season, which lasts but a short time. *Id.

71. A preliminary injunction will not be granted in an infringement suit where the affidavits of experts disclose a conflict that cannot be decided in complainants' favor without danger of unjustly interfering with the business of defendants, who are merely users of the device in question, and whose financial responsi-

bility is not questioned. *Williams v. McNeely, 64 O. G. 1268, C. D. 1893.

72. Where the defendant avers that the subject-matter of the infringement alleged differs substantially from that of the patent, the question ought not to be decided upon the *ex parte* affidavits, but, unless the defendant's contention be plainly frivolous and unsupported, left entirely open for decision upon the evidence as finally presented. *Id.

73. Where the patent in suit has not been litigated and sustained, evidence of its validity in the nature of licenses to manufacturers, sales and public acquiescence must be so clear and conclusive as to carry conviction; and where it appears that the licenses were taken merely to avoid the annoyance of litigation and at half the fee demanded, that the sales were mere placing on the market for sale, and the public acquiescence was merely that the patent had lain dormant for a period of years, *held*, that the evidence was insufficient to sustain the order granting an injunction *pendente lite*. *George Ertel Co. v. Stahl, 70 O. G. 1068, C. D. 1895.

74. Where the infringement of the patent is doubtful, *held*, that an injunction *pendente lite* ought not to be allowed. (Standard Elevator Co. v. Crane Elevator Co., 64 O. G. 438, 9 U. S. App. 556.) *Ertel v. Stahl, 70 O. G. 1069, C. D. 1895.

75. Application for preliminary injunction on Re-issue Patent No. 11,443, re-issued September 25, 1894, to William B. Page for an improvement in pneumatic testers for cans, refused on the ground that there had been no adjudication of the patent and nothing that amounted to public acquiescence. *Page v. Buckley, 70 O. G. 1642, C. D. 1895.

76. Where it appears that the invention had been used for more than seventeen years with the knowledge and assent of appellants and without any complaint on their part, except that appellee had not paid royalties after complainants quit its employment, *held*, that the laches of appellants were such as to disentitle them to a preliminary injunction. *Keyes v. Eureka Consolidated Mining Co., 71 O. G. 1027, C. D. 1895.

77. Whether the first claim of Letters Patent No. 376,837, dated January 24, 1888, to George Westinghouse, Jr., for an improvement in brake mechanism, is infringed is too doubtful to be resolved in favor of complainant upon a motion for a preliminary injunction, and should be reserved for disposition upon the final hearing of the cause. *Westinghouse Air-Brake Co. v. New York Air-Brake Co., 72 O. G. 1350, C. D. 1895.

78. When the claims relate to most minute improvements and are not asserted to be fundamental, and the defendant has introduced some minor departures which may or may not be important, and the patent has never been adjudicated nor the claims construed, injunction should be denied and defendant required to give bond pending final hearing. *Consolidated Fastener Co. v. Columbian Fastener Co., 73 Fed. Rep. 828 (1896).

79. Where the validity of a patent is attacked and there is not a clear preponderance in its favor, injunction *pendente lite* should not issue. *Fenton Metallic Mfg. Co. v. Clnse, 76 O. G. 478, C. D. 1896.

80. A decision of the supreme court of the District of Columbia in which no opinion was expressed may have been intended to express the conclusion that for some reason particular defendants should be enjoined, while at the same time it may have been intended to avoid giving the patentee a supporting adjudication. *Id.

81. The doubts of the infringement of claim 3 of Letters Patent No. 364,081, granted May 31, 1887, to Albert J. Bates for a pneumatic drilling-tool, which arise from the difference in the mode of operation of the valves as described in said claim and that of the infringing device are such as to require a denial of the motion for a preliminary injunction. *American Pneumatic Tool Co. v. Bigelow Co., 79 O. G. 2198, C. D. 1897.

V. Permanent.

82. An injunction may be granted against a defendant who was not included in terms by the writing of the settlement. *Babcock & Wilcox Co. v. Pioneer Iron Works, 43 O. G. 756, C. D. 1888.

83. Where in a suit against a railroad company for infringement the answer admits the validity of the patent, complainant's title thereto and the infringement, the company cannot avoid an absolute injunction by averring that the invention is of trifling value and offering to submit to a decree for nominal past damages and to an injunction against the adoption of any more of the patented articles on condition of the undisturbed use of those already upon its trains. *Campbell Printing-Press & Mfg.

Co. v. Manhattan Ry. Co., 60 O. G. 894, C. D. 1892.

84. The fact that patent is about to expire is no reason to the mind of the court for refusing an injunction to restrain its infringement. *American Bell Telephone Co. v. Brown Telephone & Telegraph Co., 65 O. G. 1894, C. D. 1893.

85. Where, though the defendants ceased manufacturing the infringing article within the jurisdiction of the court that issued the preliminary injunction restraining infringement of the patent, yet remain in a business related to the production of the article, *held* to be more the reason why there should be a decree and injunction which would avoid further litigation on the same subject-matter between the parties in another tribunal. *Braddock Glass Co., Limited, v. Macbeth, 70 O. G. 1799, C. D. 1895.

86. Where the defendants do not intend to use a secret invention an injunction cannot harm them; but if the injunction be refused and the secret be divulged all harm possible will be done and the law will be powerless to afford plaintiff any remedy. *Russell v. Lundeen, 72 O. G. 420, C. D. 1895.

87. The mere fact that the plaintiff may be injured by enforcing the injunction is not sufficient reason for refusing it. *Id.

VI. Prior Judgment.

(See Prior Adjudication; Comity.)

88. Where a preliminary injunction had been refused in another circuit in a suit for infringement against the manufacturer of the machines used by the defendant in this case, such refusal was not considered binding upon this court. *Thompson v. American Bank Note Co., 45 O. G. 347, C. D. 1888.

89. The utility of the invention is inferentially established by large sales of the patented article, and, interlocutory injunctions having been granted by several circuit courts, a restraining order pending suit, prohibiting the sale of an imported shade-holder adapted and intended to be used as a substantial part of the combination of the patented invention, granted. *Schneider v. Missouri Glass Co., 45 O. G. 1069, C. D. 1888.

90. Upon motion for a preliminary injunction, all the questions arising upon opposition to said motion having been settled favorably to complainant in a suit between said complainant and others in another court, but a later decision of the supreme court in another case being thought to conflict with the former, where the defendants are engaged in an extensive manufacturing business, which would be entirely broken up by a temporary injunction, so that it could not be restored in case of a final decision in their favor, thus working defendants an irreparable injury, they should be allowed to give bond conditioned to satisfy the decree of the court against them for damages by infringement pending the suit, in case any be rendered, and in default of such bond within a fixed time such injunction should be granted. *Eastern Paper Bag Co. v. Nixon, 45 O. G. 1571, C. D. 1888.

91. It appears that in a suit for infringement a decree for a perpetual injunction was granted; that a second patent for a similar invention was issued, and that the defendant began to manufacture under the second patent. *Held*, that the court would not on motion declare that the injunction had been violated, but that the proper remedy was a new suit. *Truax v. Detweiler, 56 O. G. 662, C. D. 1891.

92. A prior adjudication sustaining a patent on the ground that the testimony was not sufficient to overcome the *prima facie* effect of the patent, said testimony being merely the statement by the defendant that he did not think there was any invention in the patent, is not sufficient to warrant the issuance of a preliminary injunction when the existence of an anticipating device is shown by testimony which is undisputed save by the opinion of an expert. *Jacobson v. Alpi, 57 O. G. 276, C. D. 1891.

93. Where upon a motion for a preliminary injunction to restrain infringement of certain patents it appears that these patents are anticipated by certain foreign patents, unless it is proved that the inventions patented were made at a certain time earlier than the dates of the applications, the finding of the examiner of interferences that the inventions were made at the earlier date is not sufficient to warrant the issuance of an injunction when the evidence upon which the examiner of interferences based his finding is not presented. *Siemens-Lungren Co. v. Hatch, 57 O. G. 1723, C. D. 1891.

94. Where the validity of complainants' patent is assailed, the fact that it has been sustained by adjudications of another court in the same district is not enough of itself to warrant the granting of a preliminary injunction by this court. *Whitcomb v. Girard Coal Co., 58 O. G. 523, C. D. 1892.

95. On appeal from a preliminary injunction

the prior adjudication on which such injunction was based will, in the absence of some controlling reason, have the same weight with the circuit court of appeals which it should have had with the circuit court which granted the injunction. *American Paper Pail & Box Co. v. National Folding Box & Paper Co., 61 O. G. 287, C. D. 1892.

96. The review of the interlocutory order for an injunction cannot be converted into a review of the final adjudication upon which it is based; but while the circuit court, upon a motion for an injunction, might deem itself constrained, contrary to its own judgment, to adopt the rulings of another circuit court upon questions of law made at final hearing, the circuit court of appeals is at liberty to re-examine such ruling, dispose of the questions of law conformably to its own convictions, and accord to the former adjudication such weight as in its judgment such adjudication was entitled to upon the motion. *Id.

97. Where letters patent have been twice sustained in another circuit, a preliminary injunction against infringers will issue as a matter of course, and such injunction will not be denied because of *ex parte* affidavits of alleged new evidence in respect to anticipation, especially when it appears doubtful whether such evidence was not known to the defendants in such prior cases, and that the defendant corporation herein was closely allied with the corporations defendant in the prior litigation and contributed to the expenses thereof, either directly or through its individual stockholders. *Brush Electric Co. v. Accumulator Co., 61 O. G. 726, C. D. 1892.

98. Where, however, an injunction will seriously affect defendants' business, and it appears that an appeal has been taken from the decisions in the other cases, the court will require complainants to give bond to secure payment of damages in case the injunction is subsequently dissolved. *Id.

99. Where upon motion for a preliminary injunction it is shown that the claim alleged to be infringed has already been adjudged by a federal court to be valid on substantially the same evidence as is presented with the motion, *held*, the validity of the claim for the purpose of issuing the injunction is thereby conclusively established. *S. S. White Dental Mfg. Co. v. Johnson, 64 O. G. 303, C. D. 1893.

100. In patent cases the infringement upon which a preliminary injunction will be granted must be without reasonable doubt and the rights of the patentees clear, and, failing in prior adjudication in favor of the validity of a patent, there must be shown such continued public acquiescence in the exclusive right asserted as raises a presumption of validity of the patent. *Standard Elevator Co. v. Crane Elevator Co., 64 O. G. 438, C. D. 1893.

101. A decision of the supreme court of the United States sustaining a patent must be regarded as conclusive upon a motion for preliminary injunction. *American Bell Telephone Co. v. McKeesport Telephone Co., 64 O. G. 1134, C. D. 1893.

102. Complainant in a suit for the infringement of a patent is entitled to a preliminary injunction where it appears that the supreme court of the District of Columbia has in a prior suit sustained the validity of his patent. *S. S. White Dental Mfg. Co. v. Johnson, 64 O. G. 1268, C. D. 1893.

103. The granting of a preliminary injunction by a circuit court in a patent case does not require the issuance of such an injunction by another circuit court in a suit between different parties when the defense, though the same, is supported by additional evidence. *Edison Electric Light Co. v. Columbia Incandescent Lamp Co., 65 O. G. 133, C. D. 1893.

104. Where infringement is established and it is shown that the validity of complainant's patent has been sustained in a contested suit in another district, a preliminary injunction will be granted him when the only additional evidence is such that, had it been introduced in the prior suit, the decision of the court must, under the view expressed in its opinion, have been the same. *Sawyer Spindle Co. v. Taylor, 65 O. G. 300, C. D. 1893.

105. When a patent has been sustained by prior adjudications in the same circuit, on motion for a preliminary injunction in a subsequent suit against other parties, the only question open is that of infringement and consideration of all other questions will be postponed until the final hearing, except in cases where new evidence is presented which is in itself of such a conclusive character that if it had been presented in the former case it would have probably led to a different conclusion; but in such contingency the burden of showing this is upon the defendant. *Norton v. Eagle Automatic Can Co., 65 O. G. 442, C. D. 1893.

106. Where a patent has been fully adjudicated and held valid by the court of last resort and the respondent is aware of this fact, but nevertheless builds and puts in operation a

large number of infringing machines, relying upon the opinions of his experts, as opposed to the decision of the court, that said machines are not an infringement, the respondent must be considered as acting with his eyes open to the exact condition of affairs, and in such case cannot avert a preliminary injunction on the ground of hardship, it being clear to the court that under the prior adjudications his machines are an infringement. *Id.

107. Where, on motion for a preliminary injunction in a subsequent suit against other parties, certain prior patents are set up in anticipation, which were so set up in prior suits in the same circuit and therein held not to anticipate, such patents will not be considered on motion, and the prior adjudication in that regard will be held conclusive. *Id.

108. Where the circuit court of appeals has sustained the patent, its decision will be regarded as conclusive on a motion for a preliminary injunction. *Edison Electric Light Co. v. Philadelphia Trust, Safe Deposit and Insurance Co., Trustee, 66 O. G. 1597, C. D. 1894.

109. Although the validity of the patent sued on had been sustained in previous litigation and was beyond dispute, yet where on a motion for a preliminary injunction the proof of infringement is not clear and decisive, but is in doubt, and further, where the complainant is guilty of laches in standing idly by for several years during the time of the alleged infringement, *held*, that for these reasons the motion for preliminary injunction must be denied. *Brush Electric Co. v. Electric Storage Battery Co., 69 O. G. 1508, C. D. 1894.

110. The granting of an injunction by the supreme court of the District of Columbia without an opinion, where defendant had been a contestant in interference proceedings, *held* insufficient ground for a preliminary injunction in a suit against a different defendant. *Fenton Metallic Mfg. Co. v. Chase, 73 Fed. Rep. 831 (1896).

111. A decision granting a preliminary injunction, where no counsel appeared for defendant, though some affidavits were submitted in his behalf, does not preclude the court in a subsequent suit against a different defendant from considering anew the question of the validity of the patent. *Covert v. Travers Brothers Co., 75 O. G. 349, C. D. 1896.

112. An adjudication sustaining a patent is not conclusive in favor of granting a preliminary injunction in a suit in another circuit where a decisive question raised in the latter suit was not contested in the former and it appears that in the former a motion for reargument for the purpose of raising this point has been entertained but not yet decided. *American Graphaphone Co. v. Leeds, 78 O. G. 802, C. D. 1878.

113. When a patent has been sustained by a circuit court of appeals, the only question open on a motion for a preliminary injunction in another suit is that of infringement, unless there is new evidence of such a conclusive character that, if introduced in the former case, it would probably have led to a different conclusion, the burden of establishing which is on defendant, against whom every reasonable doubt is to be resolved. *Tannage Patent Co. v. Adams, 79 O. G. 158, C. D. 1897.

(Affirmed, *verbatim*, in *Bowers v. Pacific Coast Dredging & Reclamation Co., 80 O. G. 2041, C. D. 1897. See cases therein cited.)

114. The appellate court sustained the patents in this case after *bona fide* and protracted litigation upon the merits. The proofs were voluminous and the defense was conducted by experienced counsel. The pendency of that suit was well known to the trade most interested in defeating the patents. It is then a fair presumption that the defense was exhaustive. *Id.

115. Where the court of appeals has decided that a patent is valid, its decision should be regarded as final until sufficient reason for departing from it shall be made to plainly appear, and the patentee should not, upon a motion to dissolve a preliminary injunction, be deprived of the advantage he holds as the result of such a decision upon anything less than thoroughly-convincing additional proofs. *Adams v. The Tannage Patent Co., 79 O. G. 2015, C. D. 1897.

VII. Stay of.

116. It is well settled that while a patent may be adjudged valid and the defendant an infringer, the award of a preliminary injunction is purely a matter of discretion, and courts are in the habit of withholding it upon such terms as to the giving of a bond and the like as may seem just and equitable, having regard to the comparative injury that will result to the parties by granting or withholding it. *Consolidated [illegible]er Mill Co. v. Coombs, 48 O. G. 973, C. D. 1889.

117. The power of the court to stay an injunction, even after final decree, not denied. *Id.

118. A complainant is ordinarily entitled to

an injunction after final hearing and decree in his favor, and in the southern district of New York it will be suspended only in exceptional cases. (Pasteur v. Blount, 61 O. G. 1484, 51 Fed. Rep. 610, disapproved.) *Lalance & Grosjean Mfg. Co. v. Habermann Mfg. Co., 62 O. G. 746, C. D. 1893.

INTERFERENCES.

(See APPEAL TO COURT OF APPEALS OF THE DISTRICT OF COLUMBIA; INTERFERING PATENTS.)

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XXXII. VACATING JUDGMENT.

I. IN GENERAL.

(Interferences were first provided for in the act of 1708, and, under it, three persons acted as arbitrators, two being selected by the applicant and one by the secretary of state. The act of 1836 gave the commissioner of patents the same authority, subject to appeal to a board of examiners. By the act of 1839 this appeal was given to the chief justice of the district court of the United States for the District of Columbia. By the act of 1861 the primary examiner decided the issue, subject to appeal to examiners-in-chief and commissioner. The act of 1870 gave authority to appoint a special examiner of interferences, whose office still continues. Appeal now lies to the examiners-in-chief, the commissioner, and the court of appeals of the District of Columbia. This court was created by act of February 9, 1893. 27 Stat., 434, ch. 74.)

1. The primary examiner, having seen proper to grant a motion to dissolve the interference for the purpose of including another and earlier application filed by one of the contestants, occupies the same position he did when the interference was declared originally, and neither of the parties at this stage of the procedure has any right to demand or be furnished with a copy of such application. White v. Demarest, 41 O. G. 1161, C. D. 1887.

2. When the primary examiner declares an interference and prescribes the issue, he acts wholly without the cognizance of the respective parties to that issue, and they have no right then or at any time to be present before him to control his action in determining what applications shall be brought into the interference proceeding and what shall not. Id.

3. The ultimate authority under the statute upon the question whether an interference exists in fact is "the opinion of the commissioner" (Rev. Stats., sec. 4904), and it is more than doubtful whether a construction of rule 124 which would deprive the commissioner of jurisdiction could possibly be a valid one. Mead v. Brown, 48 O. G. 397, C. D. 1889.

4. Where it appeared that an earlier application disclosed the subject-matter claimed in a later application involved in interference, and the earlier application was filed in a name different from that under which the later application was filed, and the claim was made that both applications were by the same inventor, *held*, the only manner in which the applicant could have the benefit of the earlier application was by way of testimony in the case. Oliver v. Everitt, 49 O. G. 731, C. D. 1889.

5. There can be no doubt that an interference cannot be declared in the patent office between two patents. Haish v. Rosado, v. Aishton, 43 MS. D., 2 G. W. D., May, 1890 (Mitchell, Com'r).

6. When a completed application is filed accompanied by a proper oath, it is presumed by the office, for all purposes of the interference, that the party filing the application is an original inventor. This presumption extends throughout the entire course of the proceedings and stands unless overcome by the proofs duly taken in the case. Gessner v. Miller, 50 O. G. 433, C. D. 1890.

7. In an interference case the important point is to fix the earliest date of 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, 57 O. G. 1426, C. D. 1891.

8. The province of the patent office in interference cases is to determine the issue of priority, the construction of patents being for the courts to determine when the occasion arises upon infringement proceedings. *Iron-Clad Mfg. Co., Incorporated, v. Jacob J. Vollrath Mfg. Co., Limited, 60 O. G. 1480, C. D. 1892.

9. The assignee of an entire interest may prosecute an interference on behalf of the application of his principal, who died while the interference proceedings were pending. Chase v. Ryder, 61 O. G. 885, C. D. 1892.

10. The object of an interference is to determine priority of invention, and if that question is properly raised as to a pending application it ought to be tried to a final issue, leaving questions of abandonment or public use or proper parties to be decided at the proper time. Id.

11. A decision upon an interference is conclusive between the parties when no steps are taken to set it aside. *Fassett v. Ewart Mfg. Co., 58 Fed. Rep. 360 (1893).

12. Where A. agreed to furnish the labor and material if B. would build a machine, with the understanding that if it worked well A. should pay a royalty on the product, to which B. consented, provided he be paid mechanic's wages during the construction, and where A. then caused B. to be engaged under his direction to make the machine in question, *held*, that judgment of originality must be awarded to B. Greenfield v. Prentice, 67 O. G. 1189, C. D. 1894.

13. A commissioner's decision is entitled to respect and consideration in every controversy, and where the controversy was properly disposed of in the patent office the court will not set aside the judgment of the commissioner where nothing has been presented to it which will justify such action. *Appleton v. Ecaubert, 68 O. G. 1025, C. D. 1894.

14. The commissioner has no power to determine the question of priority between contestants except they be applicants for patents, or except one of them be an applicant to whom, if he should prevail, a patent might at the time of the decision be properly issued. (Bourne v. Goodyear, 9 Wall. 811; Mills v. Green, 16 S. C. R. 132; Cheong Ah Moy v. United States, 113 U. S. 216; Dakota Co. v. Glidden, 113 U. S. 222.) Hopkinson v Hunter, 74 O. G. 653, C. D. 1896.

15. An independent inventor ignorant of an-

other's prior conception and diligent efforts in reducing to actual practice has the right to file an application without testing the practicability of his invention and to prosecute the same to the issue of a patent, and it could not be said that he had obtained the same surreptitiously or by unfair practices; but it does not follow that he can retain an advantage so obtained when it is made to appear intrinsically unjust. *Yates v. Huson, 74 O. G. 1732, C. D. 1896.

16. If one party has appropriated the invention of another and claims it as his own, there can properly be no question of priority of invention or of prior inventor. There is but one invention and one inventor, and the other is simply a claimant without right. Yet it is not to be supposed that rival claims of such parties do not constitute a proper subject for interference proceedings in the patent office. *Milton v. Kingsley, 75 O. G. 2195, C. D. 1896.

17. C. obtained a patent which discloses all the improvements embraced in the issue before he filed his present application; but such patent contained no claim to the present interfering subject-matter. This is significant of the facts that C. did not consider himself the inventor of the invention in question. Couch v. Finnegan, 77 O. G. 1595, C. D. 1896.

18. When lower tribunals of the office conclude that the inventions of two applications are the same and the commissioner concludes that they are different, since in interference cases the question of priority only is before the court, the court will not decide which is the proper theory, but will accept the theory of the commissioner. Each contestant is accordingly entitled to a patent for his particular invention. *Cushman v. Lines, 78 O. G. 2051, C. D. 1897.

19. Where fraud has been attempted upon a true inventor, and where another not the inventor has attempted to surreptitiously obtain a patent, the office will go to the limit of its jurisdiction, upon clear and convincing proof, to right such wrongs. Roberts v. Brinkman, 79 O. G. 1189, C. D. 1897.

20. In interference cases the proceeding to obtain a patent is distinctly judicial. The controversy is waged between adverse claims of the same right of property, and the public has no interest therein. It contains all the elements of a civil case — a complainant, a defendant and a judge — actor, *reus et judex*. (Fong Yui Ting v. United States, 149 U. S. 698, 729.) *Bernadin v. Seymour, Com'r of Patents, 79 O. G. 1190, C. D. 1897.

II. Access to and Production of Papers in Patent Office.

21. Under rule 126, when an application is involved in an interference, the adverse party thereto will be "permitted to see or obtain copies of the interfering claims and of so much of the specifications as relate thereto." Ex parte Fischer, 38 O. G. 1237, C. D. 1887.

22. During the pendency of an interference proceeding, and at any time before patent issues, the interference files, while accessible to each of the parties to such proceeding, are not accessible to any other person. Id.

23. When parties to an interference have entered into a written agreement to produce certain paper exhibits on file in the patent office at any session duly held for the taking of testimony, the commissioner will enforce the agreement by proper order upon the refusal of a party so bound to produce such papers. Brungger v. Smith, 57 O. G. 1883, C. D. 1891.

III. Amending Applications.

24. Whether an applicant who has voluntarily eliminated his claims and apparently abandoned them should be permitted, after the invention has been publicly introduced and made commercially valuable, to return after eleven years and amend and claim an interference with a patent so long outstanding, is a serious question, and the right to relief should be most convincing. McDonough v. Gray, 46 O. G. 1245, C. D. 1889.

25. Where a motion was made by one of the parties to an interference to change the date of the filing of the completed application of one of the other parties to the date of the filing of an amendment by the latter, on the ground that before the filing of such amendment the latter had not clearly illustrated and described the invention in controversy, *held*, that the motion must be denied because rule 116 only takes cognizance of the filing dates of completed applications and ignores the dates of amendments altogether. Steward v. Ellis, v. Lee, v. Howe, 49 O. G. 1983, C. D. 1889.

26. It is within the discretion of the examiner of interferences to extend, upon a proper showing, the limitation of time within which a motion for leave to amend an application under rule 109 should be brought. House v. Butler, 62 O. G. 587, C. D. 1893.

IV. Appeal.

(a) *In General.*

27. The brief statement of the reasons which rule 147 requires should accompany appeals in interference cases is not to be considered of the substance of the appeal in any such sense as that either the omission of such statement or the filing of a defective statement would make the appeal void, and if such statement be defective the opposite party is entitled to a further statement if he desires. Pitney v. Smith and Egge, 49 O. G. 129, C. D. 1889.

28. The commissioner has no power to determine what appeals, seasonably taken, are intended for delay. Id.

29. A question involving the right of an applicant to make the claim in interference will not be passed upon by the commissioner on appeal from the decision of the primary examiner upon a motion to dissolve the interference. Sweeney v. Jaros, 60 O. G. 1883, C. D. 1892.

30. While it is within the discretion of the commissioner to extend the limit of appeal in an interference case, he will uot exercise it in a case where a party has deliberately allowed the limit for taking appeal to expire without action and the facts show that his subsequent petition is based upon a mere change of mind. Guerraut v. Cable, v. Coffee, 61 O. G. 285, C. D. 1892.

31. In all motions to dissolve an interference both parties have the right to appear and be heard before the primary examiner, and if the motion is appealable to the commissioner both parties are heard before him. No valid reason appears to exist for making an exception when the motion is appealable to the examiners-in-chief and in allowing only one party to the contested proceedings to appear and be heard. Duncan v. Westinghouse, Jr., 66 O. G. 1005, C. D. 1894.

32. During the pendeney of appeal in an interference between a patentee and an applicant it conclusively appeared that it is not possible in any contingency to issue a patent to the applicant. *Held*, that the appeal should be dismissed without deciding the question of priority. Hopkinson v. Hunter, 74 O. G. 653, C. D. 1896.

33. Rule 123 of the patent office, which provides that in order to obtain a stay of proceedings motion must be made specifically to that effect, applies in reason and analogy to this case. The running of the time for appeal was not arrested by filing the motion for rehearing. *Ross v. Loewer, 77 O. G. 2141, C. D. 1896.

34. The fact that the court of appeals of the District of Columbia has refused to consider questions of patentability of issues in priority cases does not establish the conclusion that the decision of the commissioner upon questions of patentability in such cases is final and conclusive. Such questions should come before the court by regular course of appeal. *Breul v. Smith, 79 O. G. 153, C. D. 1897.

35. An error of procedure on the part of the commissioner cannot be construed as amounting to a final adjudication of the question of patentability of an issue. *Id.

36. It is not competent for the court of appeals of the District of Columbia, in an interference proceeding, to abandon the question of priority and pass upon the patentability of the alleged invention. *Doyle v. McRoberts, 79 O. G. 1029, C. D. 1897.

37. An appeal to the court of appeals of the District of Columbia in an interference case is not a proceeding in equity, and the provisions of Revised Statutes, section 4915, do not apply. It is a proceeding at law, and hence a decision of the supreme court of the United States as to the statute referred to does not apply in this case. *Id.

38. A motion by the junior and defeated party to an interference to dismiss an appeal to the court of appeals of the District of Columbia upon the ground that there is no invention in the patent-right claimed is at variance with the oaths in the application and the preliminary statement. *Id.

(b) *Appeal Lies.*

39. For a decision of the primary examiner granting or denying a motion to dissolve an interference on the ground that no interference in fact exists, an appeal lies to the commissioner under the first paragraph of rule 124 without any reference whatever to the reasons which the examiner may give for deciding the motion either affirmatively or negatively. Von Welsbach v. Lungren, 48 O. G. 537, C. D. 1889.

40. A motion to dismiss such appeal on the ground that the decision of the primary examiner is affirmative of appellant's right to a patent, that the law makes no provision for appeal from such favorable decision, and that the commissioner of patents is without jurisdiction of said appeal, must be denied. Id.

(c) *No Appeal Lies.*

41. The decision of the primary examiner is an adverse decision if it denies the patentability of the invention or the right of an applicant to make the claim, from which there exists no right of appeal. To permit an appeal under such circumstances would be a clear departure from a marked and peculiar feature in the procedure of the office, distinctly recognized in the statutes and rules relating to the subject. An applicant who has been in interference has no greater right in defeating the grant of a patent to his adversary than any other member of the public. The presumption is that the office will guard against the improper issuance of patents. Faure v. Bradley, and Crocker v. Cowles and Cowles, 40 O. G. 243, C. D. 1887.

42. Section 482 does not provide for an appeal in such cases to the examiner-in-chief. Id.

43. The primary examiner having held that Faure had the right to make the claims and was not barred by the state of the art or publications, he could not do otherwise than overrule the motion to dissolve. From such decision no appeal lies. Faure v. Bradley, 44 O. G. 945, C. D. 1888.

44. No appeal lies to the commissioner from a decision upon a motion to dissolve except upon the ground that there is no interference in fact, or that there has been such irregularity in the declaration as to preclude a proper determination of the question of priority. Manny v. Easley, v. Greenwood, Jr., 48 O. G. 538, C. D. 1889.

45. Where it appears upon the face of the papers that the real ground of a motion to dissolve relates to the merits, the commissioner will not take jurisdiction either by appeal or petition. Id.

46. It is no ground for an appeal from a decision of the examiner of interferences remanding a motion to dissolve filed seasonably in view of the showing made, to the primary examiner, that the reasons given in support of the claim that the interference issue is unpatentable were fully canvassed by the primary examiner before he originally declared the interference. Such motion simply makes a controversy *inter partes* before the examiner as to matter which he had previously considered in an *ex parte* matter. Reynolds v. Haberman, 49 O. G. 130, C. D. 1889.

47. From a decision of the examiner upon a motion to dissolve, involving the right of one of the parties to make the claim in issue, there is no appeal to the commissioner. Steward v. Ellis, v. Lee, v. Howe, 49 O. G. 1983, C. D. 1889.

48. No appeal can be taken to any tribunal from a decision of a primary examiner affirming the patentability of a claim or the applicant's right to make the same. Edison v. Stanley, 56 O. G. 273, C. D. 1891.

49. When an interference is dissolved by the primary examiner on motion, appeal cannot properly be taken by the party bringing such motion, though granted on a part only of the grounds urged therein. Zeitinger v. Reynolds, v. McIntire, 57 O. G. 1279, C. D. 1891.

50. When in an interference case an appeal is taken to the examiners-in-chief on which appellant only has a right to be heard, his claims are the only ones to be considered; and any comment in their decision relative to the equivalence of the devices of the several parties to the interference, on which would depend the question of interference in fact, can properly have no binding effect upon the judgment of the primary examiner, which should be independent. Id.

51. An appeal from the action of the examiner of interferences in reinstating an interference will not lie. Young v. Case, 58 O. G. 945, C. D. 1892.

52. Objections to the operativeness or patentability of the subject-matter of the issue of an interference are not proper subjects for an interlocutory appeal to the commissioner from an examiner's refusal to dissolve the interference. Lossier v. Willson, v. Cowles, and Cowles v. Rogers, v. Darling, v. Boguski, v. Gratzel, 59 O. G. 1605, C. D. 1892.

53. A petition asking that the examiner of interferences be directed to reconsider his decision awarding priority, upon the ground that such decision is a travesty on equity practice, a gross injustice, that it is in direct contradiction to the evidence, and that the examiner has exceeded his powers, when the record of the case discloses that the examiner acted with deliberation and apparent fairness, is wholly unjustifiable and should not have been presented. Clarke v. Pettengill, v. Crancer, 77 O. G. 1271, C. D. 1896.

54. Appeal by Appert from refusal to grant motion to dissolve, brought upon the ground of no interference in fact and also upon the ground that Schmertz had not overcome French patent to Appert under rule 75, dismissed upon both grounds. Schmertz v. Appert, 77 O. G. 1784, C. D. 1896.

55. A holding that an applicant has not pre-

sented an affidavit sufficient to overcome a foreign patent under rule 75, since it relates to the merits, is not properly appealable to the commissioner. Id.

56. In an interference of two issues, one of which the commissioner decided was made by one contestant and the other by the other, when he also holds in the same decision that the two are structurally and patentably different, the party adjudged the prior inventor has no ground of appeal, since, if the commissioner was right in his holding, the first issue covers all that there is patentable, and if the commissioner is not right his mistake does not injure such prior inventor. *Shellaberger v. Schnabel, 77 O. G. 339, C. D. 1897.

57. When the commissioner decides that one of two issues of an interference was invented by one party and the other by the other party, but that the second issue has no patentable novelty to distinguish it from the one first invented, an appeal from his decision awarding priority of the second issue amounts to nothing more than a moot case and should not be adjudicated. *Id.

(d) *Burden of Proof.*

1. In General.

58. A formal abandonment of the earlier application does not shift the burden of proof, if there is a clear continuity of action between it and the second application, where the two applications are filed by the same applicant and cover substantially the same subject-matter. Parmly v. Hochhausen, 57 O. G. 545, C. D. 1891.

59. A. filed an application July 31, 1890. B. filed an application April 21, 1891. A. filed his second application for substantially the same subject-matter as his first on April 23, 1891, accompanying it with a request that it take the place on the patent office files of his first application. Two days later he filed a formal abandonment of the first application. *Held*, that in an interference between the parties it was correct to give A. the benefit of the date of the filing of his first application for the purpose of fixing the burden of proof upon B. Id.

60. Where a party to an interference in which his divisional application is involved relies on an alleged statement of invention in his original application for the purpose of determining where the burden of proof lies, such statement must clearly and definitely cover the invention claimed in the divisional application. Sprague v. Hunter, 59 O. G. 1605, C. D. 1892.

61. Where it is admitted by the parties that a machine had been built from patterns designed by H., one of the contestants, but where S., the other contestant, claims that H. derived the invention from him, consequently that the reduction to practice ought to inure to his benefit, *held*, that the burden of proof is upon S. to prove his claim, and, failing to do so, priority of invention must be awarded to H. *Soley v. Hebbard, 70 O. G. 921, C. D. 1895.

62. In such case the contestant, in order to prevail, must prove his claim by a clear and fair preponderance of evidence. *Id.

63. The only question to be determined is priority. The burden of proof is upon complainants, and they must establish their proof beyond a reasonable doubt. *Standard Cartridge Co. v. Peters Cartridge Co., 72 O. G. 742, C. D. 1895.

64. Testimony which should be rejected for insufficiency cannot be used in favor of a party on whom is the burden of proof to defeat another party, although the truthful intent of the witnesses may not be doubted. It is incumbent upon the party on whom is the burden of proof to produce such clear and direct evidence as will satisfactorily prove his case. *McCormick v. Cleal, 80 O. G. 1614, C. D. 1897.

2. Upon Later Applicant.

65. 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 very strong presumption in favor of the prior applicant, and that the burden was strongly and squarely upon the junior party to show the origination and disclosure which he claimed. Zerbe v. Ohl, 58 O. G. 1839, C. D. 1892.

66. Where an attorney and skilled expert of a company made application for certain patents with the full knowledge of the company, and the president of the company applied for patents for the same invention, sixteen and seven months, respectively, later than the senior party, *held*, that the presumption and probabilities are all with the senior party and

can only be rebutted by the strongest possible proof. Tompkins v. Selkirk, 59 O. G. 629, C. D. 1892.

67. K. filed his application before M., and the reduction to practice of the invention claimed by both was under the direction of K. exclusively. "He is now in the position of a defendant in possession. The burden of proof is upon his opponent to show, not only that he at some time had the idea, but that he had it first, and also that *this idea, once* exclusively his, was actually communicated to Kingsley; otherwise he can take no benefit from the reduction to practice." (Citing Solely v. Hebbard, 70 O. G. 921, C. of App. D. C., Jan. 7, 1895.) Milton v. Kingsley, 71 O. G. 897, C. D. 1895.

68. In such case, where the reduction to practice by one of two associated inventors has put him in the position of a defendant in possession and placed the burden of proof upon his opponent, "it will not do merely to raise a doubt upon this point. There must be a reasonable preponderance of evidence in order to overcome the presumption of right arising from the state of one in possession." (Ibid.) Id.

3. On Party Last to Claim (Rule 116).

Rule 116 of the Rules of Practice of the 13th Revised Edition, April 1, 1892, was as follows:

116. In original proceedings in cases of interference the several parties will be presumed to have made the invention in the chronological order in which they *claimed the same in* their completed applications for patents clearly illustrating and describing the invention; and the burden of proof will rest upon the party who shall seek to establish a different state of facts. (1887, 111.)

In the present edition of the rules, promulgated June 18, 1897, this rule was changed by omitting the italicized words "*claimed the same in*," and substituting the word "*filed*."

69. Where one party to an interference filed his application in March, 1887, and the other in February, 1887, and the former asserted that he communicated the invention to the latter, and that he (the latter) simply embodied as a constructor and mechanic the ideas conceived by the former and described by him to the latter, and that even if the latter were an original inventor he (the former) was the first to conceive of the subject-matter in interference, and was using due diligence in reducing the invention to practice, while the latter was making the complete machine, it was *held* that the burden of proof was upon the former to establish one of those propositions under rule 116, and that the burden is discharged by establishing a fair preponderance of legal evidence in behalf of him upon whom the burden rests. Wherry v. Heck, 49 O. G. 559, C. D. 1889.

70. The object of ascertaining which of two contesting applicants first disclosed in a completed application the invention in controversy is to determine not only upon whom should rest the burden of proof under rule 116, but also in whose favor a judgment may be rendered upon the record, in case the opposite party fail to file a preliminary statement or such statement fail to overcome the *prima facie* case made by the respective dates of application. (Rule 114.) Oliver v. Everitt, 49 O. G. 731, C. D. 1889.

71. Rule 116, placing the burden of proof upon the last applicant, means precisely what it says. It announces that the last applicant must prove his case or fail. Nor is the rule an arbitrary one. It has its foundation in the same legal principle which finds expression in the maxim *prior tempore potior jure*. The senior party litigant has a right to expect that the rule will be applied and that he may be absolutely silent until a *prima facie* case is made out against him. Ecaubert v. Hofmann, 52 O. G. 2107, C. D. 1890.

72. The relation of the parties, under rule 116, is to be determined by the date on which each applicant made his claim or equivalent statement of invention for the subject-matter involved in the interference issue. Rennyson v. Merritt, 58 O. G. 1415, C. D. 1896.

73. The burden of proof in an interference is upon the contestant who fails to make a claim to the improvement in controversy or a statement of invention equivalent thereto until after the same was claimed by the other party to the interference. Reichenbach v. Goodwin, 63 O. G. 311, C. D. 1893.

74. Rule 116, as recently amended and construed in the light of decisions bearing upon it, means that he who first made a claim or statement of invention covering the invention in interference should be considered the senior party. Huson v. Crowell, v. Yates, 64 O. G. 1006, C. D. 1893.

75. The word "claimed" in rule 116 does not include the description or any part thereof; and the first to make a claim covering the invention is the senior party. Edison v. Ball, 71 O. G. 1313, C. D. 1895.

76. The first to make a claim in substance and effect covering the invention is the senior party. (Edison v. Ball, 71 O. G. 1313.) Richardson v. Leidgen, 77 O. G. 153, C. D. 1896.

77. The sole purpose of rule 116 is to deter-

mine the position of parties as plaintiff and defendant, in order to determine who shall first take testimony. Failure of junior party to bring motion to shift the burden of proof raises no presumption that his application involved is not a division of an earlier one. In any case he may introduce his earlier one to show that he made the invention of the issue before the date of the application involved. Phelps v. Hardy, v. Gattman and Stern, 77 O. G. 631, C. D. 1896.

4. When Patent Has Issued to One Contestant.

(See INTERFERENCE; DECLARATION; APPLICATION AND PATENT, *infra*.)

78. When one of the parties to an interference is a patentee the burden of proof is heavily upon his opponents, 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 and Carpentier v. Bernstein, 54 O. G. 1711, C. D. 1891.

79. The burden of proof is heavily upon an applicant striving to overthrow a prior patent. This burden is only shifted, when the applicant has overcome the patentee's *prima facie* case, arising from the previous grant of a patent, by proof beyond a reasonable doubt. Hansen v. Davis, 55 O. G. 998, C. D. 1891.

80. 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. Id.

81. Since patents are now re-issued strictly for the same invention covered by the original patent, and since the surrender of the original patent does not take effect until the issue of the amended patent, a re-issue application ought to have the same standing as to burden of proof as the original patent has. Id.

82. When 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. Hunter v. Jenkin, 56 O. G. 1705, C. D. 1891.

83. In an interference 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, 57 O. G. 1425, C. D. 1891.

84. 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. (Following Hunter v. Jenkin, 56 O. G. 1705.) Hunter v. Van Depoele, 57 O. G. 1720, C. D. 1891.

85. In an interference an applicant to prevail *against a patent already granted* must prove his case beyond a reasonable doubt. (Following Hunter v. Jenkin, 56 O. G. 1705.) Dillon v. Kimball and Wirt, 58 O. G. 384, C. D. 1892.

86. Where it appears that an applicant for a patent in interference with a patent already granted contracted with the original patentees before making his application, 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. Id.

87. A patent is of weight as evidence in favor of the patentee upon his contention that he is the first inventor, and it is a sound and recognized administrative rule that a second patent should not issue for the same invention to a rival claimant except in a clear case. La Flare v. Chase, 72 O. G. 741, C. D. 1895.

88. The application which eventuated in the Mayhew patent was filed during the life of the Kelleher and Grimm caveat. Kelleher and Grimm made application after the expiration of the caveat and the grant of the Mayhew patent. The presumption is that the office did its duty in notifying Kelleher and Grimm of the filing of the interfering application, and the burden was upon them to establish their allegation of no notice by adequate proof. Kelleher and Grimm v. Mayhew, 72 O. G. 895, C. D. 1895.

89. The patent to Mayhew need not be treated as an application, because the presumption is against the lack of notice to the caveator and because there is no direct evidence that Kelleher and Grimm did not know of the Mayhew application. Id.

90. Pratt and Johns, in view of the issue of the patent to their opponent, have the burden of showing beyond a reasonable doubt that

they are prior inventors and entitled to a patent for the same subject-matter. Pratt and Johns v. Thompson, 72 O. G. 1347, C. D. 1895.

91. The record held not to show that Thomson's patent was inadvertently issued, or that Pratt and Johns' application was not before the examiner who passed Thomson's application to issue, or that it was not done upon full consideration. In whatsoever division either application may have been, it is to be presumed that the office in treating one knew of the other, and that when the Thomson patent issued it was considered that he was justly entitled to his patent. The burden of proof is therefore on his opponent. Id.

92. Where a patent has been regularly issued and a question of anticipation or priority is raised in a suit for infringement or in proceedings in interference, a strict rule as to the proof required to overcome the patent, especially where the testimony from its nature and circumstances is open to suspicion, should prevail. *Wurts v. Harrington, 79 O. G. 337, C. D. 1897.

93. The fact that a patent has been issued irregularly during the pendency of an interfering application does not give it an advantage in the interference proceeding, and such proceedings should be governed by the ordinary rules of the courts of law in respect to the burden of proof. *Id.

94. The burden of proof is upon the party who is the last to file his application in the office, and this status of the parties is not changed by the fact that the junior applicant may have obtained a patent. *Hunt v. McCaslin, 79 O. G. 861, C. D. 1897.

95. When one of the parties to an interference has received a patent, this on its face affords *prima facie* evidence that he is the inventor and that the thing patented is a novelty, and the patentee will not be defeated of his rights under the grant unless the applicant shall establish the priority of his invention beyond a reasonable doubt, and shall also show diligence in reduction to practice, especially where the question of priority has been passed upon in the same way by the various officials of the office. Doyle v. McRoberts, 79 O. G. 1029, C. D. 1897.

V. Caveat.

96. Congress, in the very statute which required inventors to file applications in the patent office, expressly provided that all applications interfering with *caveats* should be deposited in the confidential archives and be therefore privileged (Rev. St., sec. 4902), and inferentially they only. *Edison Electric Light Co. v. United States Electric Lighting Co., 45 Fed. Rep. 55 (1891).

97. In patent act of 1836, the three months in which a caveator's rights were regarded did not begin to run until after the caveator had received the notice of the filing of an interfering application. The act of 1861, however, changed the law in this respect and provided that the three months should begin to run from deposit in the patent office, plus the regular time for transmission to caveator. This is substantially what is required by the Revised Statutes. *Held*, that three months and two days were sufficient in this particular case, and that the commissioner has no power to extend the time. Ex parte Moore, 52 MS. D., Feb., 1893 (Frothingham, Ass't Com'r).

VI. Conception of Invention.

98. If the thing described in the abandoned application is the same invention that is subsequently patented, it certainly does establish conception of the invention as of its own date, and if proof *dehors* the patent establishes reduction to practice or introduction into public use, and the time of the reduction to practice or public use is in dispute, then the application shows that reduction to practice *might* have taken place at any time subsequent to its date; but when, as in the present case, there is no proof even of experiment, it can have no other effect than to establish the date of conception of the invention which it discloses. Beach v. Fowler, 48 O. G. 821, C. D. 1889.

99. An abandoned application establishes only a date of conception. (Beach v. Fowler, C. D. 1889, 187; Webster v. Sandford, C. D. 1888, 92.) Hien v. Pungs, 68 O. G. 657, C. D. 1894.

100. The fact that sketches relied upon to establish conception are rude and imperfect and do not show a working machine is not a vital defect if skilled operators could from such sketches construct a machine embodying the improvement in dispute. *Standard Cartridge Co. v. Peters Cartridge Co., 78 O. G. 621, C. D. 1897.

101. A complete conception as defined in an issue of priority of invention is matter of fact and must be clearly established by proof. The conception of the invention consists in the complete performance of the mental part of

the inventive act. All that remains to be accomplished in order to perfect the act or instrument belongs to the department of construction, not invention. It is therefore the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice that constitutes an available conception within the meaning of the patent law. *Mergenthaler v. Scudder, 81 O. G. 1417, C. D. 1897.

102. The date of the conception is the date when the idea of means, including all the essential attributes of the invention, becomes so clearly defined in the mind of the inventor as to be capable of exterior expression; and it is settled both by practice and express decision that such exterior expression of the mind of the inventor, when relating to machinery, may be by exhibits either in the form of drawings or by model, so as to lay the foundation of a claim to priority, if thereby the invention be made sufficiently plain to enable those skilled in the art to understand it. *Id.

103. The fact of conception by an inventor, for the purpose of establishing priority, cannot be proved by his mere allegation nor by his unsupported testimony where there has been no disclosure to others or embodiment of the invention in some clearly perceptible form such as drawings or model, with sufficient proof of identity in point of time. *Id.

104. Any full and accurate description of the invention, either in words or drawings or by model, if it be of a machine, or even an unsuccessful effort to embody the conception, when the effort discloses that the idea was complete, will suffice, although the attempt to represent it may have failed. In the absence of all other proof, the date of the application for a patent, if containing a complete description, is taken as the date of the conception. *Id.

105. If drawings be exhibited and relied on as evidence of the conception of the invention, they must show a complete conception, free from ambiguity or doubt, and such as would enable the inventor or others skilled in the art to reduce the conception to practice without any further exercise of inventive skill. *Id.

106. Where drawings are in many essential particulars defective and wanting in completeness as means of showing and illustrating an invention involved in interference, such defects and want of completeness in the drawings cannot be aided and the defective drawings made effective by construction or by reference to the prior state of the art. *Id.

107. Where an inventor has undertaken to invent and construct a machine essentially different from pre-existing machines and not simply a mere improvement upon previous inventions, it is necessary for him to furnish such full, clear and definite drawings of his invention to prove conception as will enable any person skilled in the art of construction of such machines to reduce the invention to practical form. *Id.

VII. Copying Claims of Opponent.

108. The practice of appropriating literally the claim of a later invention 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. Rogers v. Winssinger, 56 O. G. 804, C. D. 1891.

109. Where an applicant copied the claims of a patent and thus provoked an interference, *held*, that all tribunals that pass upon the question of priority of invention must decide whether the applicant is entitled to claim that invention in his application. Reichenbach v. Goodwin, 63 O. G. 311, C. D. 1893.

VIII. Declaration of.

(a) *Application and Patent.*

(See Interference; Burden of Proof; When One Contestant Has a Patent.)

110. An applicant for patent is not entitled to an interference with an unexpired domestic patent until he has been actually rejected on such patent. Ex parte Massicks and Crooke, 38 O. G. 1489, C. D. 1887.

111. An interference is declared between an applicant and a patentee for the sole purpose of determining whether a patent shall issue or be refused to the applicant, and when the question is settled the patentee has no further interest or concern in the case. *Beardslee v. Moeslein, 46 O. G. 1640, C. D. 1889.

112. The fact that in such case the office failed to declare an interference prior to the issue of the patent does not establish the fact that there is no conflict between the application and the patent. Bechman v. Johnson, 48 O. G. 673, C. D. 1889.

113. A patent issued inadvertently while another application for the same invention was

pending is as against such application to be treated, for purposes of interference, as an application still pending. Ex parte Boyer, 49 O. G. 1985, C. D. 1889.

114. An interference should not be declared between a pending application and a patent granted before such application was filed until the applicant overcomes the patent as a reference by the method provided in rule 94, 2, *i. e.* by filing affidavit. Tavener v. Thomson, 51 O. G. 1465, C. D. 1890.

115. Kellogg's original application, upon which patent issued to him July 31, 1888, which he seeks to correct by re-issue, was filed July 30, 1887. Carty's application was filed November 17, 1887, and was not put into condition for an interference for five years after the issue of the Kellogg patent. There is nothing in the record to show that in the opinion of the commissioner of that time an interference did exist or that such was the opinion of any examiner in the office, except the fact that an interference was afterward declared, and the patent cannot now be treated as an application. Carty v. Kellogg, 73 O. G. 285, C. D. 1895.

116. The status of a patentee in an interference maintained, although the interfering application was filed one day before the patent issued, because of the exigencies of the office work. It cannot be considered that the law contemplated the instantaneous examination of applications out of order, for the purpose of withdrawing from issue patents which have already been printed and signed, and are ready to be mailed, and the substance of which has been set forth in drawings published in the gazette accompanying the claims. Bolens v. Morgan, 60 MS. D., Dec., 1896 (Seymour, Com'r).

(b) *Claims; Genus and Species.*

117. 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 though the latter coutains a claim of sufficient scope to include the species claimed in the unexpired patent. Reed v. Landman, 55 O. G. 1275, C. D. 1891.

118. Where a patentee claiming specifically would be entitled to all of his claims, even if he were an applicant, in spite of a judgment of priority in favor of his opponent, the fact that his opponent's claim would "dominate" his own is no sufficient reason for declaring or continuing an interference. Id.

119. In case of an article of manufacture, when 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 the genus, there is an interference in fact. Edison v. Stanley, 57 O. G. 273, C. D. 1891.

120. An interference in fact exists between an application showing and describing several species and containing generic claims that cover all of such species and an unexpired patent containing claims based upon and limited to one of the species covered by the generic claims of the application. Zeitinger v. Reynolds, v. McIntire, 57 O. G. 1279, C. D. 1891.

121. When an unexpired patent contains claims limited to a single species and an application shows and describes several species, all different from that claimed in the patent, but contains generic claims broad enough to cover the species of both patent and application, there is no interference in fact. Id.

122. The rule of Reed v. Landman (55 O. G. 1275) does not apply where both parties are applicants. Kinyon v. Carter, 66 O. G. 513, C. D. 1893.

123. Where different specific forms are shown by two applicants, both capable of being covered by a broad claim, and one applicant makes such broad claim and the other makes a more limited claim to the same structure, there is an interference, which may be avoided by the disclaimer provided for by rule 107. Id.

124. Where two applications are pending concurrently and the claims of one dominate those of the other, an interference should be declared. Grimmett v. Willett, 66 O. G. 1006, C. D. 1894.

125. Where an unexpired patent shows and describes two species and contains a claim in an alternative form which includes both species, and an application shows and describes one of the species and contains a generic claim, an interference in fact exists. Duncan v. Westinghouse, Jr., 66 O. G. 1005, C. D. 1894.

(c) *Claims; Subjects-matter Must Conflict.*

126. The primary examiner, when declaring an interference, must look alone to the language of the applications. Faure v. Bradley, 44 O. G. 945, C. D. 1888.

127. The inquiry in every case, whether or not an interference in fact exists, is whether the claims conflict; but in determining whether such conflict exists the subject-matter claimed

in the respective applications is to be considered and is to govern the conclusion, whatever resemblances or differences may exist in mere methods of expression. Gray v. Robertson, 50 O. G. 165, C. D. 1890.

128. Where the controversy related to telautograph systems and the claims which were in interference consisted of combinations involving the use of a pen or stylus and a "pen supporter," in connection with the operation of receiving the message, but the instruments were different and differed in modes of operation, *held*, that there was no interference in fact. Id.

129. It is not sufficient that an applicant copy the claim of a patentee with the view of securing an interference, but the claims must conflict in subject-matter and not in language only. (Gray v. Robertson, 50 O. G. 165, followed.) Bissell v. Robert, 51 O. G. 1618, C. D. 1890.

130. When there is no interference by reason of conflicting subject-matter care should be taken on the part of the office to prevent an appearance of sameness because of similarity of language employed. Id.

131. There is nothing in Ex parte Upton that affords any warrant for the view that claims can conflict which are not for the same invention either generically or specifically stated. Crane v. Merriam, 51 O. G. 1783, C. D. 1890.

132. Interferences in the patent office, like interferences in the courts, exist only when the claimed inventions conflict. Reed v. Landman, 55 O. G. 1275, C. D. 1891.

133. The question whether an interference in fact exists depends not merely upon the language employed in the respective claims, but upon the question whether, in addition to similarity in phraseology, there is an interference between the subjects-matter of the respective claims. Rogers v. Winssinger, 56 O. G. 804, C. D. 1891.

134. A claim should not be included in an interference which is broader than the issue although there may be an interference in fact. Ex parte Thomson, 51 MS. D., Nov., 1892 (Frothingham, Ass't Com'r).

135. The test of an interference resides in the claims and not in mere disclosures in the application, and office rules must be construed in connection with this settled principle of law. Van Depoele v. Daft, 58 O. G. 520, C. D. 1892.

136. It is not enough for an application sought to be put in interference to merely show and describe matter properly within the interference issue; but it must also claim such matter. (Following Van Depoele v. Daft, 58 O. G. 520.) Searle v. Frumveller, v. Sessions, 58 O. G. 804, C. D. 1892.

137. An interference should not necessarily be declared between two applications simply because a claim of one of them would dominate a claim of the other unless it also appears that the two applications are based upon the same structure of invention. Id.

138. Applications interfere only when they claim in whole or in part the same invention. (Citing Gold and Silver Ore Separating Co. v. U. S. Disintegrating Co., 6 Blatchf. 307.) Dodd v. Reading, 58 O. G. 1413, C. D. 1892.

139. An interference is declared between the applications or inventions involved rather than between the applicants or patentees. Snyder v. Kanneberg, 58 O. G. 1840, C. D. 1892.

140. Where the devices covered by the claims of the two applications are substantially alike in structure and mode of operation, there is an interference in fact even though the claims are not the same in scope. Moore v. Holland, 63 O. G. 1962, C. D. 1893.

141. Where the claim in a patent contains an element not disclosed in an application involved in an interference with the patent, and where the applicant cannot make a claim that will be commensurate in terms with the claim of the patent, no interference in fact exists. Dixon v. Van Auken, 64 O. G. 1005, C. D. 1893.

142. The interference was declared on a claim for a "platen detachably connected with the power-driving mechanism and provided with a counterbalancing weight." In the Christie invention, however, the point of disconnection was between the ratchet-wheel and the lever-pawl. *Held*, that this construction was fairly within the language of the claim and interference, notwithstanding that the point of disconnection was not immediately at the platen proper, and that there was an interference between the two inventions. *Christie v. Seybold, 64 O. G. 1650, C. D. 1893.

143. Interference cannot properly be declared except when two applications or a patent and an application conflict with each other. If the alleged inventions are substantially different from each other, so as to be each of them patentable, there is no ground for interference. In this case no question of priority can arise. Cushman v. Lines, 78 O. G. 2051, C. D. 1897.

IX. Disclaimer.

(See Disclaimer in Application.)

144. Where, after an interference has been decided, the losing party thereto amends his application and cancels the claims which had been in such interference, he should not be required to formally *disclaim* the subject-matter described therein and which he has so canceled. Ex parte Firm, 39 O. G. 1199, C. D. 1887.

145. There is no law or rule which requires an applicant under such circumstances to enter a disclaimer. If the specification is too broad, if it covers any of the matter which has been in interference, or if it is so indistinct, informal or ambiguous that the public may be imposed upon by the issuance of a patent, it is the duty of the examiner to require correction and modification, so as to bring the case within the rules of the office, and if such modification be not made to refuse the patent. Id.

146. The effect of rule 104 is simply to allow one of the applicants to anticipate the award of priority in the interference, and to place himself in the condition he would be in had the proceedings continued regularly and the award been made; but it certainly cannot be extended by implication. Id.

147. Rule 107 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 the disclaimer may be made. Clark v. Lord, v. Grimes, 51 O. G. 1943, C. D. 1890.

148. In case of an interference between a specific claim and a generic claim, the applicant making the specific claim is supposed to know from the time of the declaration of the interference what the "matter in issue" is, and that it is the matter in issue which he is required to disclaim in order to have the benefit of the rule. Id.

149. Rule 107 does not require that the tender of a disclaimer before the date fixed for the filing of the preliminary statement of the party proffering the disclaimer should be by motion, or that notice thereof should be given to the opposite party. *Diescher v. Walker, v. Diescher and McGill, 52 O. G. 459, C. D. 1890.

150. While each party is in ignorance of the character of his opponent's invention the interference is declared, and before either party is entitled to have the veil of secrecy lifted the office determines when a disclaimer is tendered whether the interference should continue. *Id.

151. It is to be distinctly understood that this ruling extends only to cases where a disclaimer is tendered unaccompanied by any motion in the case. If, for instance, motion is made to suspend the interference pending the determination of the question whether the disclaimer ought to be permitted, the case is, as to such motion, a contested one, and notice should be given, as in other cases. *Id.

152. Where in an interference the claims of one applicant dominate those of the other, the interference may be dissolved by filing a proper disclaimer by the applicant having the narrow claims. Grimmet v. Willet, 66 O. G. 1006, C. D. 1894.

(See, also, Ex parte Greenwood, 17 O. G. 626, C. D. 1880.)

153. It is the usual practice to allow entry of a disclaimer of the issue in an interference, leaving the question whether the disclaimant's claim is patentable over the issue to be determined *ex parte*. (Cases cited.) Millar and Miller v. Calm, 63 MS. D., Dec., 1897 (Greeley, Acting Com'r).

154. Rule 107 should be considered as a whole. Applying the provisions of the first part of the rule to the second part, a copy of the disclaimer required by the second part must be made a part of the specification. Cook v. Stover, 76 O. G. 2007, C. D. 1896.

X. Disclosure.

155. The descriptive language used should be 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 desirability of doing the thing, but also a conception of a way of doing it, and a way of doing it so definitely thought out that the listener, if skilled in the art, could produce the invention from the description, at least in a rude form of embodiment. Wherry v. Heck, 49 O. G. 559, C. D. 1889.

156. To constitute a disclosure of an invention 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 is clearly and intelligently shown. Ligowsky v. Peters, v. Hisey, 57 O. G. 1595, C. D. 1891.

157. The disclosure by an inventor to his attorney entitles the inventor to the benefit of the rule laid down in Agawam Co. v. Jordan (7 Wall. 583) in a subsequent interference between the parties, the issue of which is the disclosed invention. Wheaton v. Kendall, 62 O. G. 1516, C. D. 1893.

XI. Dissolution.

(a) *In General.*

158. A motion to dissolve an interference may be granted for the purpose of including another and earlier application filed by one of the contestants. White v. Demarest, 41 O. G. 1161, C. D. 1887.

159. Motion for dissolution of interference refused between a joint patent and a sole application, which was filed by one of the joint patentees. Kohler v. Kohler and Chambers, 40 O. G. 247, C. D. 1888.

160. Motion to dissolve interferences for the following reasons: *First*, that the foreign patents set forth by Faure in his preliminary statement are not patents for the invention in issue; *second*, that the invention in issue is a broader invention than that patented to Faure in the foreign patents set forth in his preliminary statement, and that on the principle of re-issues he is barred from making claims broader than those contained in his foreign patents. The question whether the invention covered by foreign patents is the same as that involved in interference, and therefore that such patentee is not entitled to the dates of such foreign patents, must be determined by the evidence adduced on the trial. The examiner of interferences has the exclusive right to determine the competency, construction, scope and legal meaning of the foreign patents or of any other evidence introduced, and to decide whether they cover the same invention as that involved in the interference. Faure v. Bradley and Crocker v. Cowles and Cowles, 44 O. G. 945, C. D. 1888.

161. The application is the procedure to obtain a patent, and, strictly speaking, a motion to dissolve an interference cannot be predicated upon something found in a preliminary statement, or anything *dehors* the application. Id.

162. There is no rule which requires that the facts upon which a motion to dissolve is based should be stated in the motion. If facts are, however, relied upon other than those disclosed by the record, they should be stated in order to receive consideration. Law v. Woolf, 55 O. G. 1527, C. D. 1891.

163. 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 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. Id.

164. Whatever appears incidentally from the testimony in bar of the right of a party to a patent is, under the established practice of the office, not to be considered in a motion to dissolve; but in the interference the motions to dissolve contemplated by rule 122 are upon grounds which appear from the records to have existed before the testimony was taken. Cook v. Leach, 42 MS. D., March, 1890 (Fisher, Acting Com'r).

165. Upon a proper showing the jurisdiction of the examiner of interfereuces will be restored for the purpose of considering a motion to dissolve the interference. Short v. Sprague, 56 O. G. 1708, C. D. 1891.

166. When new claims are admitted, either under the original issue or under a new issue, in accordance with the provisions of rule 109, *held*, that any or all motions provided for in rule 122 may be brought in connection with the new claims and the issue including the same, even though such motions were brought and the questions raised thereby decided under the interference as originally declared. Jenne v. Brown, v. Booth, 59 O. G. 158, C. D. 1892.

167. Where a party to an interference moved its dissolution on the ground that the opposing party was estopped by a prior interference, and appealed from the action of the examiner of interferences transmitting the case to the primary examiner for his decision, the appellant alleging that the examiner of interferences should have himself decided the motion, since it did not go to the right of the opposing party to make the claim involved, *held* not to be a real distinctiou, and the examiner of interferences affirmed. Foglesong v. Hutt, 61 O. G. 151, C. D. 1892.

168. The granting of a motion to stay the proceedings pending the determination of a motion to dissolve does not release the interferants from a requirement to file other motions specially provided for within a stated period. Lamb v. Warren, 64 O. G. 437, C. D. 1893.

169. The primary examiner has authority to decide a question of dissolution of an interference which was instituted by the commissioner in person. Ball v. Edison, 53 MS. D., Nov., 1893 (Fisher, Ass't Com'r).

170. Motion to dissolve an interference between applications containing a broad and narrow claim respectively. A reason for not dissolving is that the features of novelty on which the claims were allowed are the same in each case, and that the differences of the specific claim over the broad one are held by the examiner immaterial in view of the prior state of the art. Kinyon v. Carter, 66 O. G. 513, C. D. 1894.

171. Where applicant's prior British patent became void by reason of failure to pay the renewal fee, which fact was published in the Illustrated Official Journal, and he was called on to show cause why an interference in which his application was involved should not be dissolved for the reason that he had no right to make the claim, and he made no reply, *held*, that his refusal to show cause was the full equivalent of testimony that the fee had not been paid. Ex parte Armstrong, 71 O. G. 1615, C. D. 1895.

172. Parts of Miller's application having been filed on February 3, 1894, and the application completed December 21, 1894, the interference dissolved to permit the primary examiner to require an oath applying to the later date. Miller v. Lambert, 72 O. G. 1903, C. D. 1895.

173. An interference dissolved when the claims of each case cannot be read upon the other in view of the prior art. (Reed v. Landman, C. D. 1891, 73.) Barr v. McLennan, 61 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

174. A motion to dissolve is a mere suggestion and not proof, and is not to be granted as a matter of course at any stage of the interference. Hageman v. Young, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

175. When it is doubtful, in view of the state of the art, whether either party could make the interfering claims, the interference will be dissolved. Newton v. Woodward, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

176. Where a party fails to make a full presentation of his case on a motion for dissolution, but relies on the case as presented, *held*, that he is bound by the decision rendered, and a rehearing will not be granted merely to permit of a further showing, but only on grounds which would warrant a new trial at law. Bechman v. Wood, 81 O. G. 2085, C. D. 1897.

177. The office may of its own motion, under the provisions of rule 126, take cognizance of matter which would properly constitute a basis for a motion to dissolve without regard to the fact that such motion has been previously made. Id.

178. All grounds for dissolution should be presented in one motion, since it is contrary to the established practice of the office to allow a party to make motions to dissolve by piecemeal. Id.

(For requirements of a motion to dissolve, see Green v. Hall, v. Siemens, v. Field, 37 O. G. 1475, C. D. 1886; Law v. Woolf, 55 O. G. 1527, C. D. 1891.)

(b) *Appeal.*

179. When an interference is remanded to the primary examiner on proper motion or other reference and said motion is granted, the interference is dissolved *pro hac vice*, the applications involved become *ex parte*, the original jurisdiction of the examiner again attaches, rule 95 applies, and the same right of appeal follows as in other *ex parte* cases. Faure v. Bradley, 40 O. G. 243, C. D. 1887.

180. 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, that day being a legal holiday, the limit of appeal expired the day before. Dean & Robie v. Troendle, 42 MS. D. (2 G. W. D.), March, 1890 (Fisher, Ass't Com'r).

181. Appeal to commissioner from decision of the primary examiner dissolving an interference between an applicant and a patentee on the ground that the British patent of the applicant, upon which he relied to antedate the patentee and establish the interference, did not disclose an operative device, should be dismissed, for the reason that such an appeal, when proper, lies to the examiners-in-chief. Tavener v. Thomson, 51 O. G. 1465, C. D. 1890.

182. When neither party appeared at the hearing of an appeal on a motion to dissolve, and neither filed a brief, *held* that, with the limited time at the disposal of the commissioner, he could not investigate the intricate questions involved, and hence he affirmed the primary examiner's decision. Jones v. Collerés, 45 MS. D. (3 G. W. D.), Jan., 1891 (Mitchell, Com'r).

183. The appeal from a decision of the primary examiner denying a motion to dissolve on the ground that no interference in fact exists lies directly to the commissioner and not

to the examiners-in-chief. (Rule 124.) Zeidler v. Leech, 54 O. G. 503, C. D. 1891.

184. The question presented by such motion cannot be transformed into any other question by *obiter dicta* contained in the decision of the primary examiner; neither can the appellate jurisdiction be deflected by reasons of appeal which are not warranted by the nature of the question presented by the motion. In other words, the examiner decides nothing but the question raised by the motion, and the appeal brings up nothing for review but the decision and the motion decided. Id.

(c) *Applications for Process and Apparatus.*

185. Motion to dissolve an interference declared between an application for a process and a patent covering specific apparatus for carrying out the process, granted, and *held*, that the process and apparatus being separate and distinct inventions the claims for the one cannot conflict with claims for the other. Crane v. Meriam, 51 O. G. 1783, C. D. 1890.

186. It was expressly decided in Ex parte Atwood 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." Id.

(A process and product are two different inventions. *Excelsior Needle Co. v. Union Needle Co., 1885, 3 Blatch. 147; Rob. on Patents, note, p. 251, vol. 1.)

(d) *Rule 122.*

(See TIME ALLOWABLE FOR FILING MOTIONS, *infra*; EX PARTE PROCEEDINGS, *infra*.)

187. Where there was a motion to dissolve an interference upon the ground of irregularity in declaring the same, and it was alleged therein that such irregularity consisted in the fact that the claims of one of the parties were based upon new matter introduced into his description and drawings more than two and a half years after his application was originally filed, and it appeared that such party, if the preliminary statements were correct, was unquestionably the original and first inventor, *held*, that it should first be determined who was the original and first inventor of the issue in controversy, leaving the *ex parte* rights of the prevailing party for subsequent adjudication. Steward v. Ellis, v. Lee, v. Howe, 49 O. G. 1983, C. D. 1889.

188. When a motion is made to dissolve for irregularity in declaring the interference, upon the consideration of such motion the question is not whether there has been irregularity merely, but whether there has been such irregularity as will defeat the purpose for which alone interference proceedings are authorized by the statute. Id.

189. The only question raised by a motion to dissolve for want of interference in fact is whether an interference in fact exists between allowable claims, and the only inquiry arising on such a motion is one which assumes that the claims are allowable. Zeidler v. Leech, 54 O. G. 503, C. D. 1891.

190. Patentability is not in question under a motion to dissolve an interference on the ground that no interference in fact exists. Forslund v. Matthews, 57 O. G. 1720, C. D. 1891.

191. Upon a motion to dissolve an interference upon the ground of irregularity in declaring the same, the primary examiner is not at liberty to decide the question of patentability. Hutt and Phillips v. Foglesong, 60 O. G. 1477, C. D. 1892.

192. Failure to make a motion under rule 122 to dissolve an interference upon the ground that an accepted amendment to one of the applications involved is for new matter amounts to an acquiescence in such acceptance and in the decision of the office that such amendment does not involve new matter. *Croskey v. Atterbury, 76 O. G. 163, C. D. 1896.

193. Rule 122 provides for motions to dissolve an interference on the ground of non-patentability, although this question had been favorably decided in an *ex parte* proceeding by the examiner or one of the appellate tribunals. On a motion to dissolve the question is considered and decided *de novo inter partes*. Painter v. Hall, 80 O. G. 1124, C. D. 1897.

194. In an *inter partes* case the examiner is not precluded by the decision of the examiners-in-chief in an *ex parte* case, although said decision should be very persuasive, though not conclusive. To hold otherwise would be to deprive a party of his rights and benefits under rule 122. Id.

195. The primary examiner may not, as a matter of course, ignore the decision of the higher tribunals simply because the question is before him in a proceeding *inter partes*, whereas it was before the appellate tribunal in a proceeding *ex parte*. It is not to be presumed, nor would it be tolerable, for a primary examiner to disregard the decision of the appellate tribunal where the decision of the higher tri-

bunal is binding under the settled rules of decision. Id.

196. The primary examiner in his decision in an *inter partes* proceeding should state the reasons why in his opinion the decision of the higher tribunal in the *ex parte* case should not be followed in the *inter partes* proceeding. Id.

197. The question of patentability decided *ex parte* cannot be said to be *res adjudicata* when raised *inter partes*. To make the matter *res adjudicata* there must be concurrence of four conditions — identity in the thing sued for, of a cause of action, of the parties to the action, and of the quality in the persons. In the matter under consideration the identity of parties is lacking. Id.

(e) *Time Allowable for Filing Motions.*

198. When a motion to dissolve an interference on the ground of non-patentability is made more than twenty days after approval of the preliminary statements it is not an abuse of discretion on the part of the examiner of interferences to grant such motion when 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, 49 O. G. 130, C. D. 1889.

199. The twenty days within which, under rule 122, a motion to dissolve an interference for certain specified causes should be made runs from the day when the original preliminary statements are received and approved, and a subsequent amendment of a preliminary statement does not of itself operate to extend this time. Scribner and Warner v. Childs, v. Balsley, 59 O. G. 1103, C. D. 1892.

200. The pendency of other motions in an interference case is no excuse for delaying a motion to dissolve the interference beyond the twenty days limited by the rule. Hall v. Latta, 59 O. G. 1431, C. D. 1892.

201. Where an interferant relied upon a proper tracing of the drawing of his opponent's application for an understanding of the latter's invention and was misled thereby, such misunderstanding will not excuse his delay to file a motion to dissolve after the period of twenty days. Lamb v. Warren, 64 O. G. 437, C. D. 1893.

202. The delay that may be excused within the discretion of the office provided for in rule 122 is not such as will be exercised to relieve an interferant from his own negligence. Id.

203. A motion to dissolve under rule 122 must be made after the declaration of an interference, at which time both parties have the right to be heard. Sievert v. Shuman, 76 O. G. 1714, C. D. 1896.

204. Under the present rules the only period during which a party may file a motion to dissolve 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 interfering 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-Cély v. Payen, 51 O. G. 621, C. D. 1890.

205. When a judgment upon the record has been entered under rule 114, and the examiner of interferences has lost jurisdiction by reason of the expiration of the limit of appeal, a motion made before the commissioner for permission to file a motion to dissolve the interference should be supported by affidavits setting forth the facts relied upon, both in excuse for the failure to file the same within the time specified in the rule and in justification for the granting of the motion. Garrison v. Hübner, 54 O. G. 1889, C. D. 1891.

206. A showing is not required under rule 114 when a motion to dissolve is brought within the period fixed as a limit of appeal from a judgment upon the record, although the time originally fixed has been extended by stipulation approved by the office, and although more than twenty days may have elapsed since the approval of the preliminary statements. Law v. Woolf, 55 O. G. 1527, C. D. 1891.

207. A motion to dissolve an interference will not be allowed unless made with due diligence, and this is a question of fact to be passed upon according to the circumstances surrounding the particular case. Hall v. Latta, 59 O. G. 463, C. D. 1892.

208. A motion to dissolve, filed after judgment, and more than a year after preliminary statements had been filed, refused, when the defeated party offers no explanation save that he had just discovered the machine of the opposing party was inoperative. Cox v. Wood, 61 MS. D., July 7, 1897 (Greeley, Ass't Com'r).

209. A motion to dissolve filed tardily, and alleging a newly-discovered reference, denied, where the circumstances attending the discov-

ery were not stated and there was no accompanying affidavit. Hageman v. Youug, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

210. A motion to dissolve, purposely postponed until the testimony had been taken, denied. Kelly & Pickles v. Park, v. Clark, v. Hayden, v. Corrington, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

211. A motion to dissolve, made tardily and without a showing explaining the delay, was denied; but the attention of the primary examiner was called to newly-discovered references, referred to in the motion, and suspension of the interference suggested. Borton v. Ammerman & Toof, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

(f) *Statutory Bars.*

(See STATUTORY BARS, IN GENERAL; APPLICATIONS, JOINT AND SOLE.)

212. A history of the practice in the office in this particular, as shown in commissioners' decisions since Pugh v. Hamilton, C. D. 1870, 153. Hicks v. Keating, v. Purvis, v. Bilgham, 40 O. G. 343, C. D. 1887.

213. The rule (120), in so far as it authorizes the suggestion of a statutory bar to the grant of a patent as a cause for suspending or dissolving an interference, relates to such facts as are purely a bar, as contradistinguished from questions of title or joint inventors—a bar which, under the old rule, would operate against all the applicants in interference; but such a statutory bar to the claims of *either* one of the parties to the interference is sufficient to call into exercise the action contemplated by the rule. Id.

214. The rule does not require the examiner of interferences to act immediately upon being advised of the existence of a state of facts which might justify action looking toward suspension or dissolution of the interference. Id.

215. When a motion to dissolve is made showing a *prima facie* case in which there seems to be a statutory bar to the claims of the adverse party, the examiner of interferences has no discretion, but must at once refer the motion to the primary examiner. Id.

(This was under a former rule (116). The practice has been reversed. See Thomson & Unbehend v. Hisley, *infra*.)

216. 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 question, unless for extraordinary and amply sufficient reasons. Campbell v. Brown, 56 O. G. 1565, C. D. 1891.

217. Whether or not a statutory bar exists against the grant of a patent to an applicant is immaterial upon a motion to dissolve an interference, since priority of invention is the primary question in an interference. Lossier v. Willson, 59 O. G. 1605, C. D. 1892.

218. Where a patentee moved to dissolve upon the ground that public use was shown by the preliminary statement of the applicant, *held*, that the examiner of interferences properly refused to transmit the motion to the primary examiner. Thomson and Unbehend v. Hisley, 66 O. G. 1596, C. D. 1894.

219. An interference should not be stopped to allow a party "to try to create a bar upon the basis of a disclosure of the interference proceedings. The rule provides only for the use of an already complete bar—a bar independent of the interference proceedings." Id.

(The decision in this case collects many decisions held to govern present practice, namely, that "citing of the bar of public use is not an adequate reason for dissolving an interference." It is not, however, held that a proper case for suspension and dissolution might not thus arise. The office rule provides only for use of a bar independent of the interference proceedings.)

220. The primary examiner should have considered whether or not the record of the former interference between Lambert and Henry F. Miller and George Miller established a *prima facie* case of public use against the subsequent application of George Miller. Miller v. Lambert, 72 O. G. 1903, C. D. 1895.

221. When the commissioner has determined that there is no patentable invention in issue, that determination is a virtual dissolution of any interference, for there cannot be interference unless there is at least *prima facie* patentable novelty. *Shellaberger v. Schnabel, 79 O. G. 339, C. D. 1897.

(g) *Transmittal of Motions to Primary Examiner.*

(See DISSOLUTION—STATUTORY BARS, *supra*.)

222. Motions to dissolve an interference upon either one of the grounds mentioned in rule 116, viz.: *First*, that no interference in fact exists; *second*, that there has been such irregularity in declaring the same as will preclude a proper determination of the question of priority between the parties; *third*, or which deny the patentability of applicant's claims; *fourth*, or which deny applicant's right to make the

claims,—will, when in proper form, be transmitted by the examiner of interferences to the primary examiner for his determination. Edison and Gilliland v. Phelps, 38 O. G. 539, C. D. 1887.

223. It is not intended by the rule that every motion to dissolve an interference, even although the interference may have been irregularly declared, shall be transmitted to the primary examiner. The rule refers only to those motions where the irregularity is of that character which will preclude the proper determination of the question of priority. Id.

224. Motions to dismiss an interference upon grounds other than those mentioned in rule 116 should not be transmitted to the primary examiner by the examiner of interferences. Id.

225. Under rule 122 motions to dissolve are transmitted to the primary examiner "for determination." 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." Lorent-Cély v. Payen, 51 O. G. 621, C. D. 1890.

(Transmittal discretionary with examiner of interferences. Scribner & Warner v. Childs, v. Balsley, 59 O. G. 1103, C. D. 1892.)

226. A motion to dissolve upon the ground of the bar of public use should not be transmitted to the primary examiner by the examiner of interferences. Thomson v. Unbehend, 66 O. G. 1596, C. D. 1894.

227. An application will not be stricken from the files and the examiner of interferences will not transmit a motion for dissolution of the interference on the ground that the testimony showed that the parties did not *jointly invent* the subject-matter of the interference. Southwick v. Walker, v. Carnduff, 58 MS. D., Dec., 1895 (Fisher, Ass't Com'r).

228. A motion to dissolve made after the twenty-day limit (rule 122) may be transmitted, when it appears the copies of opponent's papers were received late, and a motion by the opponent to amend had intervened. Fairbanks v. Braley, 62 MS. D., July, 1897 (Greeley, Ass't Com'r).

229. In a motion for dissolution there was no motion for transmittal, but this seems immaterial, since the examiner of interferences undoubtedly has the right of his own motion to transmit any proper motion to the primary examiner. Johnson & Fry v. Leatherman, 62 MS. D., Sept., 1897 (Greeley, Acting Com'r).

230. A motion to dissolve, filed before the preliminary statements are opened, should be transmitted when accompanied by an offer from the moving party to furnish copies of his application to his opponents, exclusive of all dates. Gilman & Yarnell v. Weaver, v. Hunter, v. McNeal, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

XII. Divisional Application.

231. Where a new or divisional application has been filed under rule 106 for the purpose of including claims involved in an interference, other claims involved in a related interference subsequently arising may be transferred from the original to the divisional application. Ex parte Neiswanger, 50 O. G. 1132, C. D. 1890.

232. An application containing specific claims based upon the same embodiment of an invention as generic claims in another application of the same party involved in an interference cannot be allowed to go to patent before the determination of the question of priority. Id.

233. Only such parts of an invention as are not involved in an interference, or cannot be affected by the judgment therein, may be included in a divisional application and allowed to go out of the office during the pendency of the interference. Id.

234. In an interference a divisional application cannot stand upon the prior application of which it purports to be a division as to an improvement which the earlier application does not claim and upon which it bases no statement of invention. Van Depoele v. Daft, 58 O. G. 520, C. D. 1892.

235. When an applicant seeks to take advantage of the provisions of rule 106, he should not be required to file a certified copy of the interfering subject-matter. Ex parte Perkins, 61 O. G. 1015, C. D. 1892.

236. When an application goes to patent upon a claim which is not a proper division of another application in interference, the patentee should derive no advantage in an interference by presumption from the fact of issue of the patent on the divisional application; but, coming in subsequently to the filing of his opponent's claim, by claim of prior invention, he should bear the burden that such claim naturally imposes as between contending applicants in the production of proof as applied to both interferences. *Porter v. Lauden, 73 O. G. 1551, C. D. 1895.

237. Hunter filed a motion to vacate judgment, stating his application was a division of another antedating Wightman's. The examiner decided Hunter had his remedy by motion to dissolve, or by motion to change the burden

of proof. *Held*, these facts did not justify the examiner. It was his duty to take such step as might have been necessary to correct the error in the most expeditious manner. Hunter v. Wightman, 81 O. G. 1788 (1897).

238. Whenever it is found that the rights of a party to an interference or the rights of any party before this office have been prejudiced by an error of any tribunal of the office, all tribunals of this office should co-operate to remedy the error with as little delay or formality as is consistent with a due regard to the proper keeping of the records. Id.

XIII. Effect of Patent Office Decisions in the Courts.

239. While a decision of the patent office awarding priority of invention in an interference proceeding not appealed from is not conclusive in a suit between the same parties on the same subject-matter, yet it is strongly persuasive that it was right. *Kirk v. Du Bois, 42 O. G. 297, C. D. 1888.

240. Where there had been an interference between the Stonemetz and Brown applications in the patent office, the fact that priority of invention had been awarded to Stonemetz by the examiner of interferences, the board of examiners-in-chief, and the commissioner of patents, while not conclusive, is not without weight, especially in view of a subsequent disclaimer by Brown of the invention of the matter covered by the issue in the interference. *Stonemetz Printer's Machinery Co. v. Brown Folding Machine Co., 64 O. G. 1185, C. D. 1894.

241. Where the question decided in the patent office is one between contesting parties as to priority of invention, the decision there made must be accepted as controlling upon that question of fact in any subsequent suit between the parties, unless the contrary is established by testimony which in character and amount carries thorough conviction. *Morgan v. Daniels, 67 O. G. 811, C. D. 1894.

242. The object of an interference proceeding in the patent office is to determine priority, not patentability; and while the decision in such proceedings may be *res adjudicata* as to this question it does not preclude a defendant in an equity proceeding from raising other questions not in issue in said proceedings. *National Machine Co. v. Wheeler & Wilson Mfg. Co., 74 O. G. 1588, C. D. 1896.

243. A decision of the patent office as to priority of invention must be accepted as controlling upon that question of fact in any subsequent suit between the parties, unless the contrary is established by testimony which carries thorough conviction. (Citing Morgan v. Daniels, 67 O. G. 811, C. D. 1894, 285; 153 U. S. 124, 125.) *Standard Cartridge Co. v. Peters Cartridge Co., 78 O. G. 621, C. D. 1897.

244. It is not enough to justify a court in saying that the patent office was in error in a decision upon a question of priority that the declarations and admissions of the successful contestant cast discredit upon him as a witness. The evidence in the nature of admissions must make it clear that the evidence supporting the action of the office cannot be true. *Id.

245. In a case of interference appealed to a court the decision of the patent office must stand unless the evidence shows beyond any reasonable doubt that the appellant was the original inventor. *Arnold v. Tyler, 79 O. G. 156, C. D. 1897.

246. Failure of a party to move for dissolution of an interference in the patent office is not an acquiescence in the ruling that the inventions, as limited by the prior art there shown, were identical and patentable. While the decision on interference may be *res judicata* as to priority, it does not preclude either party from raising other questions. *National Machine Co. v. Wheeler & Wilson Mfg. Co., 79 O. G. 1863, C. D. 1897.

XIV. Estoppel.

(See Estoppel, proper.)

247. An applicant in a pending interference who claims to have been the sole inventor is not estopped by reason of his oath in a preliminary statement in a previous interference, wherein he was one of two joint applicants, nor by the testimony of his witnesses in that interference, from correcting an error, if an error can be shown to exist, as to the date when his invention went into public use, when the former statement of applicant and testimony of his witnesses were made with reference to an interference proceeding in which the question of two years' prior public use was not directly in issue. Mead v. Brown, 48 O. G. 397, C. D. 1889.

248. In such a case there is no irregularity in declaring the pending interference, and a motion to dissolve such interference upon the ground that the party claimed to be estopped has no legal standing in the office will be denied. Id.

249. In a contest for priority of invention the presumption referred to is conclusive against all of 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. Jenkins, 56 O. G. 1705, C. D. 1891.

250. A practical concession of priority in an interference proceeding makes a *prima facie* case against the party in a subsequent suit and estops him again claiming priority. *Shoemaker v. Merrow, 61 Fed. Rep. 945 (1894).

251. *Held* further, appellant is not to be heard to urge non-patentability of his claim after it has been placed in interference. He is estopped on that question by reason of his own affirmative assertion that his claim is patentable. *Hisey v. Peters, 71 O. G. 892, C. D. 1895.

252. The fact that Huson in his preliminary statement placed his conception in 1883, while his proofs of diligence apply only to the period subsequent to the "second conception" in 1891, does not create an estoppel *in pais*, because Huson did nothing nor omitted anything upon which Yates relied in building up his own status or upon the faith of which he acted otherwise than he would. Huson v. Yates, 72 O. G. 1201, C. D. 1895.

XV. Evidence in Foreign Country.

253. It is well settled that what an inventor did in a foreign country while a citizen of such country cannot in any way be used to antedate an invention made in the United States, and evidence tending to establish such facts would be wholly incompetent. Boulton v. Illingworth, 43 O. G. 508, C. D. 1888.

254. A party to an interference may have the right to prove what he did as an inventor, although living in a foreign country, for the purpose of showing his *knowledge*, but *not* for the purpose of establishing facts of invention as such. Such evidence is competent and admissible without the facts being set up in the preliminary statement. Id.

255. Evidence of invention in a foreign country cannot be received in an interference proceeding unless such evidence is in the form of a publication or patent, or is for the purpose of showing that some one of the contestants is not an original inventor. Green v. Hall et al., 46 O. G. 1515, C. D. 1889.

256. In the case of a foreign invention the knowledge of it in this country must be proven to be of such a nature as to comply with the statute. *Quære*, whether such knowledge was proven in this case. Gessner v. Miller, 50 O. G. 433, C. D. 1890.

257. As regards the case of a foreign interference contestant and upon the question of priority of invention, evidence of his acts performed abroad is to be excluded from consideration. Brown and Taplin v. Bixby, 57 O. G. 123, C. D. 1891.

258. When an inventor, during the course of his experiments, goes abroad and pursues his work in a foreign country and successfully opposes a motion to take testimony abroad with reference to his transactions there, evidence as to what occurred there will not be considered on behalf of the applicant in deciding a subsequent question of priority of invention. Ligowsky v. Peters, 57 O. G. 1593, C. D. 1891.

259. What an applicant has done abroad is not pertinent to the question whether he exercised reasonable diligence arising in an interference in the patent office. Peters v. Hisey, 62 O. G. 315, C. D. 1893.

260. Evidence of invention in a foreign country cannot be received in an interference proceeding unless such evidence is in the form of a publication or patent or is for the purpose of showing that some one of the contestants is not an original inventor. (Green v. Hall, v. Siemens, v. Field, 46 O. G. 1515.) Parkin and Wright v. Jenness, 63 O. G. 759, C. D. 1893.

261. A disclosure on board a foreign ship in mid-ocean may be received on the question of conception of an invention. Peters v. Hisey, 67 O. G. 927, C. D. 1894.

XVI. Ex Parte Proceedings.

(See Dissolution; Rule 122, *supra*.)

262. Where it appears that after a declaration of an interference, including H. and L.'s application, P. filed certain claims some of which are identical with those of H. and L. and if allowed to P. would make him a party to a branch interference in which H. and L. are involved, and that said branch interference is suspended pending the determination of P.'s right to the claims, a petition by H. and L. that they be heard in opposition to P. in all proceedings relative to said claims denied, as it is contrary to the established practice to allow a party to be heard on this question prior to the declaration of the interference. Ex parte Hutin and Leblanc, 80 O. G. 1618, C. D. 1897.

XVII. Filing Briefs.

263. The filing of briefs, as prescribed by rule 163, is not a positive requirement, but desirable. Kelley v. Bassett, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

XVIII. Issue.

264. In the matter of issues in interferences there is no rule applicable except that which provides the motion to dissolve. Clearly, however, when an issue has received a construction as to its meaning by the court and has been tried under that construction and the parties have acquiesced in it, the case becomes one in which the issue must be held to be complete and to read according to the construction thus given it. Ex parte Gray, 46 O. G. 1277, C. D. 1889.

265. When it appears that one party to an interference cannot be allowed a method claim while the other party bars the way, the issue covering the method practiced is properly declared, in spite of minor differences in the conflicting claims. Beach v. Fowler, 48 O. G. 821, C. D. 1889.

266. It is improper, in declaring an interference, to include a broad claim in a narrow issue. The issue should be as broad as the broadest claim involved therein. Short v. Sprague, 56 O. G. 1706, C. D. 1891.

267. When an interference has been declared upon a certain issue, that issue is the only subject-matter properly in dispute between the parties, and the office will not take notice of any arbitration between the parties conceding to each other priority as to certain patentable features, but not touching the actual issue of the case. Clawson v. Williams and Roovers, 58 O. G. 946, C. D. 1892.

268. The objectionable practice of making the issues of interferences broader than any of the claims included thereunder, or broader than are patentable in view of the state of the art, commented upon. Mets v. Crane and Bloomfield, 58 O. G. 947, C. D. 1892.

269. An application will not be included in an interference unless it falls within the requirements of the issue. Henkle v. Hull, 58 O. G. 1413, C. D. 1892.

270. In an interference proceeding the contention by one of the parties that the issue is devoid of patentable novelty is not a proper one for consideration, since it is *ex parte* in character. Benjamin v. Searle, 59 O. G. 630, C. D. 1892.

271. In an interference where the senior party claimed "a curved-spring seat-support" and his application disclosed a spring support curved at both ends, *held*, that the junior party, showing a spring-support curved at one end only, was properly within the issue and satisfied its requirements. Garford v. Edwards, 60 O. G. 893, C. D. 1892.

272. Where an applicant appealed from the refusal of an examiner to inform him of the subject-matter of the issue in a proposed interference in order that he might amend so as to include the issue in his claims, *held*, that it is not the practice of the office to suggest claims to an applicant in order to create possible interferences. Ex parte Weeden, 66 O. G. 1191, C. D. 1894.

273. Where the device in the issue consists in certain particular means by which certain valves in the principal machine may be thrown, counts for the combination of the valves and a walking-beam connecting the valves together, but omitting a device for operating them, should not have been included in the issue, Tremain v. Curtis, 66 O. G. 1447, C. D. 1894.

274. In this respect the claims in these counts are to be distinguished from the claims in the patents discussed in Webster Loom Co. v. Higgins (21 O. G. 2031, 105 U. S. 580, 585 and 586), for the essence of the improvement in this interference is the mode of connection of the valves with the principal machine — that is to say, it is the means by which the valves may be thrown. Id.

275. Where no patentable difference exists between the issues, but one patent can be issued, notwithstanding one party originated one issue and the other party the other. Schnabel v. Shellaberger, 68 O. G. 658, C. D. 1894.

276. Where the appealing party urges at the final hearing the non-patentability of the issue, without having made a motion to dissolve on this ground within the time prescribed by rule 122, his contention will be left to the determination of the courts, except in a clear case. Id.

277. A battery with an interrupter in a telephone circuit *held* within an issue calling for a generator generating alternating electric currents for distribution of energy. Hunter v. Spencer, 71 O. G. 1767, C. D. 1895.

278. If no warrant be found in an application as originally filed for one of the counts of an interference issue, the applicant is not the inventor of such count. Dewey v. Colby, 75 O. G. 1360, C. D. 1896.

279. It is a cardinal principle that in declar-

ing an interference the issue must be as broad as the broadest claim included thereunder. Morgan v. Hanson, 77 O. G. 154, C. D. 1896.

280. In an issue in which the word "encircle" is used to define a construction which performs the functions of a hook, the extent to which the encircling is carried is a question of degree merely and immaterial to the scope of the issue. Breul v. Smith, 78 O. G. 1904, C. D. 1897.

281. The patent office should not give so liberal a construction to the terms of an issue as to enable it to include a structure which had previously been held to be patentably distinct therefrom. Breul v. Smith, 78 O. G. 1906, C. D. 1897.

282. When a view of the ground covered by the claims of an issue has been accepted by the parties and has prevailed in the patent office, it should not be departed from in the final decision if injustice might result from that departure. Id.

283. An error of procedure on the part of the commissioner cannot be construed as amounting to a final adjudication of the question of patentability of an issue. Breul v. Smith, 79 O. G. 153, C. D. 1897.

284. Before an interference is declared the subject-matter of the issue must be decided to be patentable. To declare an interference and put a party to the trouble of conducting it, and then when he succeeded reject his claims on the same reason urged prior to the declaration of the interference, is unwise and unjust. Ex parte Weaver, 81 O. G. 967, C. D. 1897.

XIX. Joint and Sole Applications.

(See Dissolution, in General; Joinder of Inventions; Joint Inventions.)

285. Practice under rules 116 and 120 in cases where, from preliminary statements, evidence or otherwise, it appears that one of the applicants is not an inventor, or joint applicants are not joint inventors, etc., statutory bar, etc. Hicks v. Keating et al., 40 O. G. 343, C. D. 1887.

286. Rule 219 is paramount, and when formal declaration of interference has been made the proceeding should not be determined without judgment of priority, except when clearly and certainly required by rules 116 and 120. Id.

287. An interference is declared between the applications or inventions involved rather than between the applicants or patentees. The question is, which invention as claimed was first invented, rather than who has the ownership or title. Such inquiry may disclose a reason why one of the parties personally is not entitled to a patent, and at the same time not raise the consideration of a statutory bar. Id.

288. If the preliminary statements show that the joint applicants were not joint inventors, or other similar state of facts, the examiner's discretion should have in view the saving of time, avoiding delays, and protecting the rights of the parties and the public. Such statements should not be approved without first giving the parties an opportunity to correct them by amendment. If not amended and no disclaimer or concession of priority is made, the statement should be approved and the interference formally declared. If on final hearing priority should be awarded to one party when there was reason to believe he was not the first inventor, or that there was a statutory bar to his application, the examiner of interferences should call attention to the fact in his decision, as required by the rule. Id.

289. Should the same or other similar state of facts be developed in the evidence, the discretion of the examiner of interferences should be exercised in the direction of reaching a determination of the interference and awarding priority under rule 119, unless a statutory bar, as herein defined, is most conclusively shown, and to proceed with the interference would impose unusual and unnecessary trouble and expense upon the parties. The rule (120) does not require the examiner of interferences to act before rendering his decision, nor that the commissioner shall suspend the interference before such decision. The interest of the public is generally conserved by permittiug the interference to take its course to final hearing. Id.

290. An applicant is not estopped by reason of his oath filed with a joint application from asserting his rights as sole inventor; nor should he be denied a patent on account of having made an error or mistake in the matter of joint inventorship. Kohler v. Kohler and Chambers, 43 O. G. 247, C. D. 1888.

291. One of two joint patentees files a sole application for the invention; an interference is declared between the patent of the joint patentees and the application of the sole applicant, and motion is made to dissolve, based on the ground that the office has no power to declare the interference and cannot issue a patent to the sole applicant under these circum-

stances. Motion overruled, and *held* that when patent issues to joint inventors as such neither is *the* inventor, but the invention is made by an entity composed of both parties, and that joint patentees are not the same as the sole applicant claiming the invention. Id.

292. The interference will develop the truth and the facts, and if it shall appear that the invention was joint, patent will be denied the sole applicant. If, on the other hand, it shall appear that the joint application was prepared and executed through misapprehension or mistake, then the interference should be determined in favor of the sole applicant. Id.

293. For all the 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. Snyder v. Kanneberg, 58 O. G. 1840, C. D. 1892.

294. The joint patent of Snyder and Belding was involved in an interference with the application of Kanneberg, in whose favor priority was decided. Pending the determination of this question, but too late to be included in the interference, Snyder filed a sole application for the identical invention already patented to Snyder and Belding. *Held*, that an interference was properly declared between the applications of Snyder and Kanneberg and that the fact that in the earlier interference Snyder and Belding contended that Snyder was the first inventor of the issue was no bar to his claim in the later interference. Id.

295. It being clear that as to the third issue George Miller, and not Henry F. Miller and George Miller jointly, contributed all that is not the invention of Lambert, and the question of priority between George Miller and Lambert not having been presented upon the record, the decision upon the third is confined to this, that Henry F. Miller and George Miller are not joint inventors of the third issue. Miller and Miller v. Lambert, 72 O. G. 1903, C. D. 1895.

296. Where S. alone filed an application for a patent for himself and another, as joint inventors, alleging in the oath, petition and preamble that he and another party are joint inventors of the invention for which a patent is solicited, *held*, that an application for a patent for a joint invention must be made by all joint inventors, and the present application should not be forwarded for examination. Ex parte Schaeffer, 76 O. G. 1118, C. D. 1896.

XX. Judgment on the Record.

297. An earlier application, in order to entitle a junior party to judgment on the record, must be upon its face an application in behalf of the same person who filed the application immediately in interference. Oliver v. Everitt, 49 O. G. 781, C. D. 1889.

298. The practice under the present rule, 114, is to render judgment upon the opening of the preliminary statements, without an order to show cause why such award should not be made, leaving the party failing to prevail to bring any of the motions permitted by the rules within the time limited for appeal. Kendall v. Frasch, 50 O. G. 1132, C. D. 1890.

299. The senior party to an interference is not entitled to an order entering judgment against the junior party who fails to take testimony, until the time for taking such testimony has expired. Baglin v. Doubleday, 53 O. G. 1883, C. D. 1890.

300. The parties to an interference having indefinitely extended the times for taking testimony by stipulation approved by the office before the expiration of the period fixed upon for the junior party, the stipulation providing that the proceedings should be suspended until after notice by one of the parties to the other that proceedings would be resumed, and further providing that all dates for taking testimony should commence running upon delivery of said notice, *held*, that a motion for judgment by the senior party, made before giving the notice required by the stipulation, was premature. Id.

301. A judgment upon the record under rule 114 is a judgment rendered before the office has had the benefit of the views of counsel for either party upon the questions involved therein, and if a mistake has been made the entire public, as well as the injured party, is interested to have the mistake corrected. Garrison v. Hübner, 54 O. G. 1889, C. D. 1891.

XXI. Motions Generally.

302. Motions after judgment should be noticed for hearing within the time set for appeal, as otherwise the tribunal rendering judgment would not have jurisdiction at the time of hearing. Meyrose v. Jahn, 56 O. G. 1447, C. D. 1891.

303. When a motion to effect a stay of proceedings has been granted, the correct practice is to file all special motions at the times and periods specified for them. Such motions will then be determined in their usual order; or in

case of agreement of the interferants therein and upon approval of the agreement by the office the determination thereof will be adjourned to a day proper. Lamb v. Warren, 64 O. G. 437, C. D. 1893.

304. A construction of the rules of the office by means of which motions for mere dilatory purposes could be resorted to should not be adopted unless by express terms such construction cannot be avoided. *Ross v. Loewer, 77 O. G. 2141, C. D. 1896.

XXII. Practice on Final Hearing and After Judgment.

305. After a final award of priority there is no more reason for permitting the defeated party to the interference to be heard upon the relation of the prevailing party to the prior art than there would have been for permitting the same privilege before the institution of the interference. Green v. Hall, v. Siemens, v. Field, 47 O. G. 1633, C. D. 1889.

306. Where, after a judgment of priority upon the record, applicant 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 such claim, *held*, that it was too late for the examiner to pass upon the question whether or not applicant should be allowed the claim. Ex parte Booth, 49 O. G. 1841, C. D. 1889.

307. The examiner, after rejecting all claims involved in the interference of the defeated party which are or could be made by the prevailing party, may properly allow to the former such other claims as are held to be patentable and could not be made by the party prevailing in the interference. Ex parte Booth, 56 O. G. 141, C. D. 1891.

308. No claim should be allowed to the defeated party which could, by any latitude of construction, be held to embrace matter common to the structure of both parties to the interference. Id.

309. Rule 132 was established for the purpose of imposing the duty of making a formal final rejection in the case of the defeated party to an interference proceeding, and not for the purpose of prescribing the extent and measure of that duty. Id.

310. The cases of Ex parte Booth (C. D. 1889, 49 O. G. 1841) and Ehrlich v. Van Horn (54 O. G. 506) are to be regarded as precedents establishing the practice for 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. Id.

311. 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, this 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. Ex parte Archer, 57 O. G. 696, C. D. 1891.

312. Where the question of priority has been decided without the suspension of an interference proceeding, the question of patentability of a claim involved in the interference will be considered not *inter partes* but *ex parte* by the primary examiner. Pell v. Pierpoint, 76 O. G. 1573, C. D. 1896.

XXIII. Preliminary Statements.

(a) *In General.*

313. 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 the 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. Du Bois, 56 O. G. 1061, C. D. 1891.

314. A preliminary statement, after filing, becomes the property of the government like any other record and will not be returned to the applicant even if it was not used in the case or opened after it had been sealed up by the examiner of interferences. Ex parte Baxter, Jr., 56 O. G. 1448, C. D. 1891.

315. The nature and theory of a preliminary statement discussed and commented on. Washburn v. Hadfield, 57 O. G. 1719, C. D. 1891.

316. "The utmost care and diligence," rather than mere "reasonable diligence," are required in the making of a preliminary statement. Henderson v. Noakes, 59 O. G. 1762, C. D. 1892.

317. Upon agreement of the parties the time for filing preliminary statements was advanced and the examiner of interferences directed to open the statements as soon as filed. Ex parte Nickerson, 57 MS. D., Oct., 1895 (Fisher, Acting Com'r).

318. The rule that one is bound by the statements in his preliminary statement applies only to the proceedings in which the parties are in-

volved. Sievert v. Shuman, 76 O. G. 1714, C. D. 1896.

319. Preliminary statements correspond to pleadings in a suit at law, and should be formal and exact. A statement which lacks certainty as to date when a model, if any, was produced should be amended. Ansley v. Hamar, 63 MS. D., Dec., 1897 (Greeley, Acting Com'r).

320. It is of the utmost importance that strictness be observed as to the dates furnished in preliminary statements required in cases of interferences, for if parties were allowed to vary their dates at pleasure as to the time of discovery, invention or disclosure it would inevitably lead to the imputation of deception and bad faith practiced on the part of the party so changing his dates. *Stevens v. Seher, 81 O. G. 1932, C. D. 1897.

(b) *Amendment of.*

321. A party who prepares his preliminary statement, knowing and advising his counsel that the dates alleged therein are not the earliest which he can establish, and who fails to ask for a postponement when he has not time to obtain fuller information and data, but files his statement in such imperfect condition, cannot prevail in a motion to amend when he waits until possessed of all the facts and dates relating to his adversary's case. Donnelan v. Berry, 41 O. G. 1499, C. D. 1887.

322. When such a party enters a protest against his opponent's preliminary statement, and amendment has been made thereof, but waits until after the testimony-in-chief has been taken and then moves to amend his own statement for no other purpose than to carry his dates back of those set up by his opponent, he must be held to be guilty of laches and not to have shown such diligence which the rule requires, nor compliance with the clear intent and purpose of the practice requiring preliminary statements. Id.

323. Motion to amend a preliminary statement to set back the dates of invention and to allege disclosure and reduction to practice in a foreign country should have been denied. Boulton v. Illingworth, 43 O. G. 508, C. D. 1888.

324. Explanations as to the reasons why a drawing and structure were forgotten which are satisfactory for the purpose of securing an amendment to a preliminary statement are not to be regarded as necessarily satisfactory as against the claim that the forgotten drawing and structure were abandoned. When a preliminary statement is amended for any reason, the original statement remains to confront the applicant and to be considered in determining what the real truth was. Zwietusch v. Stockheim, 53 O. G. 755, C. D. 1890.

325. The decisions have been practically uniform that where ordinary care and prudence in the fixing of dates have been wanting, amendment of preliminary statement would not thereafter be permitted. (Cleusen v. Fowler, C. D. 1886, 35; Heermans v. Eichbaum, 41 MS. D. 391, 1 G. W. D. 93; Lamb v. Spiro, 42 MS. D. 445, and Hunter v. Brill, 44 MS. D. 156.) Bell v. Overman, 45 MS. D. (3 G. W. D.), Jan., 1891 (Fisher, Ass't Com'r).

326. Motion to amend a preliminary statement after a delay of four months and a half denied. Gornall v. Lovejoy, 56 O. G. 927, C. D. 1891.

327. When an interference has so far advanced that the junior party has taken his testimony, the patent office will not permit the other party to amend his preliminary statement by the addition of facts presumably within his knowledge at the time when the statement was originally filed. Washburn v. Hadfield, 57 O. G. 1719, C. D. 1891.

328. Where one party to an interference has taken his testimony, the office will not permit the other party to amend his preliminary statement in the absence of positive proof that the proposed amendatory matter or some material part of it was not within his knowledge when the statement was originally filed. (Affirming Washburn v. Hadfield, 57 O. G. 1719.) Washburn v. Hadfield, 59 O. G. 463, C. D. 1892.

329. An amendment to a preliminary statement which takes the amending party's date back of the corresponding date of his opponent will not be allowed upon a state of facts consistent with the supposition that the party seeking to amend might have presented this earliest date in his original statement if he had used the utmost care and diligence. Henderson v. Noakes, 59 O. G. 1451, C. D. 1892.

330. The office acts judicially rather than ministerially in permitting or denying the amendment of a preliminary statement. Henderson v. Noakes, 59 O. G. 1762, C. D. 1892.

331. Upon motion of a junior party to amend his own and strike out the senior party's amended preliminary statement, certain facts *held* to warrant an equitable treatment of the matter, and both amendments received. Pratt and Johns v. Thomson, 62 O. G. 449, C. D. 1893.

332. It is difficult to conceive a case in which

an amendment of a preliminary statement can be permitted, after testimony has been taken and no previous notice of intention to amend has been given. Foster & Foster v. Bent, 60 MS. D., Nov., 1896 (Seymour, Com'r).

233. It is always a suspicious circumstance in a case of interference that after the claim of one of the parties has been fully disclosed and fixed as a specified date the other party should then seek, by amendment of his preliminary statement, to show a date of invention prior to that of his original statement and prior to that of his opponent. *Parker v. Appert, 75 O. G. 1201, C. D. 1896.

334. Appellant's statement that he made the sketches upon which he relies for proof of his earlier date at said date, but mislaid them and forgot where they were until after the disclosure of the dates of appellee, is not credible in view of the facts surrounding the case, and amendment to his preliminary statement should not have been allowed. *Id.

335. The practice of the office should conform to the modern practice in courts, which allows amendments to pleadings upon a proper showing at any stage in the case; but it is not proper to allow an amendment to a preliminary statement at any stage of the case, as a matter of course, whenever asked for, without a showing of facts to justify it. Foster and Foster v. Bent, 77 O. G. 1781, C. D. 1896.

336. Motions to amend preliminary statements should not be disposed of upon affidavits alone, but upon the entire record. Id.

337. Amendments to preliminary statements should be permitted where indisputable facts or clearly-proved circumstances support the necessary inference that a mistake has been made which would defeat the ends of justice, and where such facts or circumstances by the exercise of reasonable diligence could not have been found and in fact were not found earlier. Id.

338. The fact that an affiant who is one of the parties did not give the original preliminary statement adequate study, did not follow back the details in his mind, did not at the time it was made recollect anything important about it, and confused the article which he afterward manufactured with the one which he then invented, are not sufficient grounds to justify disposing of the original statement by substituting therefor an amended one. Id.

339. If any material error occurs in the preliminary statements, or other statements made to the office, through inadvertence or mistake, the statement may be corrected on motion upon showing to the satisfaction of the commissioner that the correction is essential to the ends of justice, and the motion to correct the statement must be made, if possible, before the taking of any testimony and as soon as practicable after the discovery of the error. It is only upon complying with this rule that the correction of any material error in preliminary statements can be made. *Stevens v. Seher, 81 O. G. 1932, C. D. 1897.

340. A preliminary statement, which lacks certainty as to a date, should be amended. Ansley v. Hamar, 63 MS. D., Dec., 1897 (Greeley, Com'r).

(c) *Inspection of.*

341. After judgment upon the record on the ground that the filing date of the earlier applicant antedates the date of conception set up in the preliminary statement of the later applicant, a petition by the later applicant to inspect the preliminary statement of his opponent for the purpose of ascertaining whether he had reduced the invention to practice before filing his application will be denied. Lindsay v. McDonough, 55 O. G. 1402, C. D. 1891.

XXIV. Priority.

(a) *In General.*

342. If the award of priority given to Bell can be vacated and set aside, it should only be done upon a showing of merits that would entitle Gray to a patent. Such patent would run for a period of seventeen years from its date, and would dominate and control all devices relating to the telephone for another period of seventeen years. The effect would be to subject the public to a renewed monopoly in all nearly, if not quite, thirty-four years. Such result would be in contravention of the spirit of the statute, and, in view of the liberal provisions of the patent system, cannot be tolerated except when the inflexible rules of law and justice compel it, especially in the present case, wherein it is clearly shown that the Bell Company is the "equitable if not the legal owner of Gray's telephone inventions." McDonough v. Gray, 46 O. G. 1245, C. D. 1889.

343. A model or drawing, although a sufficient foundation for a claim to priority, as was held in Loom Co. v. Higgins, must be followed up with reasonable diligence in order to establish full title to priority. Green v. Hall, v. Siemens, v. Field, 47 O. G. 1631, C. D. 1889.

344. Where it was alleged as error that the commissioner erroneously decided that one of the parties did not intend, at the time he constructed the apparatus upon which his claim to priority was based, to use it practically upon an electric railway, and it appeared that the commissioner did not decide what was the ultimate intention of such party with reference to his invention, but simply decided that certain models were designed and intended as models, *held* no error. Id.

345. Where it was alleged as error that the commissioner held that priority of invention was to be determined by the intent of the inventor as to the use to which his apparatus should be put, and it appeared that the actual finding of the commissioner upon that subject was limited to the intent with which certain models were made and used, *held* no error. Id.

346. Where the senior party to an interference directly and unqualifiedly contradicts the claim of the junior party that he communicated the invention to the senior party and that he employed the senior party to make a model to embody the ideas which he (the junior) communicated, the issue must be found against the junior party in spite of his own testimony to the opposite effect, unless there is other testimony in the case corroborative of his contention and sufficient to turn the scale. Wherry v. Heck, 49 O. G. 559, C. D. 1889.

347. Where in a suit for infringement it appeared that the application of the patent sued on was filed December 2, 1887, and the application of the defendants' patent was filed September 8, 1888, and that there was no evidence that the original application of the patent in suit was modified or amended in any respect after it was filed, *held*, that it must be conceded in the absence of other evidence that plaintiff's assignor was presumptively the first inventor. *American Roll Paper Co. v. Knopp, 54 O. G. 391, C. D. 1891.

348. 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, 57 O. G. 1278, C. D. 1891.

349. Although there was such obvious irregularity in declaring the interference as rendered a decision upon the question of priority extremely difficult, *held* desirable, if not absolutely necessary, that such a decision be rendered by the commissioner as would terminate the interference proceedings, in view of the fact that the question of priority had been decided by both the examiner of interferences and the examiners-in-chief. Mets v. Crane and Bloomfield, 58 O. G. 947, C. D. 1892.

350. Where actual reduction to practice is wanting and testimony adduced by the parties to show date of conception is of the same character and quality, the earlier date will prevail, though the evidence to sustain it is meager and unsatisfactory. Doane v. Johnson, Jr., 58 O. G. 1414, C. D. 1892.

351. Where one of the parties to an interference failed to file his preliminary statement within the time limited, and the examiner of interferences decided the interference in favor of his opponent "in accordance with the provisions of rules 114, 115 and 116," *held* on appeal that as the appellant disclosed, but did not claim, the invention in controversy in application antedating his opponent's earliest claimed date, the office must consider this in determining the question of priority. O'Shaughnessy v. Depoele, 62 O. G. 1063, C. D. 1893.

352. Where the applicant was the mechanical engineer and the patentee the general superintendent and manager for the same employer, and where at an interview between them the applicant made sketches of the invention, from which drawings were made and signed by him as inventor and by the patentee as a witness, and where it was thought at the time that the conception of the invention was complete, and where the latter had the custody of the sketches and failed upon request to produce them or account for their loss, and also failed to produce sketches alleged by him to have been made by him prior to those of the applicant, and where, in addition to these facts, the patentee's candor as a witness is considered, his defective recollection of the contents of the applicant's sketches, and the general terms in which he describes his own sketches, *held*, that these facts establish that the applicant was the originator of the invention in issue in the interference. Reynolds v. Wells, Jr., 66 O. G. 1594, C. D. 1894.

353. Where F. suggests the idea to B. that a lifting-jack could be altered so as to adapt it to wrench the drill-rods of oil-wells, but gives no explanation of how such adaptation might be brought about, and where B., without further communication, changes the jack to adapt it to the suggested new use, *held*, that whatever of invention may be involved in the

change of the jack belongs to B. and not to F. *Forgie v. Oil Well Supply Co., 67 O. G. 1573, C. D. 1894.

354. Lambert brought to the Millers a can having the essential features of the first and second issues. Though the license agreement is not in evidence, the record shows that the Millers manufactured cans based upon Lambert's invention and paid royalty to Lambert. *Held*, that Lambert was the inventor of the first and second issues. Miller and Miller v. Lambert, 75 O. G. 1903, C. D. 1895.

355. After C. learned of F.'s patent he continued to make the patented article and made no protest about F.'s marking the article "Patented" and did not claim the article so marked as his own invention until after his employers had got into trouble with the owners of the patent. This conduct is not that of a person who had made the invention. Couch v. Finnegan, 77 O. G. 1595, C. D. 1896.

356. The conduct of the appellant Hill and of his assignee, the Sheldon Axle Co., toward the appellee for four months after their alleged discovery of the issue of a patent to the latter is wholly irreconcilable with any other theory than that they recognized the appellee as the true inventor of the device in controversy. *Hill v. Parmelee, 78 O. G. 170, C. D. 1897.

357. The doctrine announced in Webster Loom Co. v. Higgins (21 O. G. 231, 105 U. S. 580, C. D. 1882, 285) to the effect that that which is common and well known in the art may be understood as if written out in the specification of a patent, applies with even greater force to the adequacy of sketch drawings when the question is one of carrying back the date of an invention to the time of a first conception. *Standard Cartridge Co. v. Peters Cartridge Co., 78 O. G. 621, C. D. 1897.

(Affirming commissioner's decision.)

(b) *Foreign Patent.*

(See FOREIGN PATENT, PROPER.)

358. Where in an interference proceeding an American applicant relied upon the filing date of his application — to wit, December 27, 1886 — for the date of his invention, and a foreign applicant relied upon a British provisional specification, dated December 9, 1885, and also a complete specification, dated September 9, 1886, said specifications being filed under the British act of 1883, for the same purpose, *held*, (1) that the adjudication of priority should be in favor of the American applicant, and (2) that it would make no difference if it were proved that the complete specification was accepted on December 9, 1886, and made accessible to public inspection on the same date. De Ferranti v. Westinghouse, 52 O. G. 457, C. D. 1890.

359. 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 consummate a title to receive an American patent based upon it. Deprez and Carpentier v. Bernstein, 54 O. G. 1711, C. D. 1891.

360. Where a foreign patent exclusively relied upon as evidence of priority on behalf of an applicant as against a patentee failed to fully, clearly and exactly disclose the invention of the issue, *held*, that it could not avail the applicant as proof of prior invention; and *held* further, that if the claim of the applicant, when limited to that which was set forth as his invention in the foreign patent, contained anything patentable over the prior art, his right to a patent thereon was in no way affected by the granting of the subsequent patent. Id.

361. In an interference between an application and a patent where the applicant relies on 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 Deprez and Carpentier v. Bernstein, 54 O. G. 1711.) Deprez and Carpentier v. Bernstein, v. Hunter, v. Gaulard and Gibbs, 58 O. G. 1553, C. D. 1892.

362. Where L. proves that a French patent of a certain date was granted to him for the invention in issue and neither C. nor B. has proved a conception of the invention earlier than that date, *held*, that L. is the first inventor. Lossier v. Cowles and Cowles v. Boguski, 71 O. G. 1616, C. D. 1895.

363. Appert having patented the invention in a foreign country not only before Parker's completed invention but before Parker's first conception, he is held to be the prior inventor within the meaning of our statutes, whatever effect may be given to his foreign patent. Appert v. Parker, 74 O. G. 1587, C. D. 1896.

364. Appert, having patented the invention in France before Parker's first proved conception, is held to be the prior inventor. *Parker v. Appert, 75 O. G. 1201, C. D. 1896.

365. Appert's application and patent were dated October 19, 1893, and the issue of the patent to him was on January 12, 1894. *Held*, that the latter was the earliest date which he could claim for the conception and publication of his invention. (Opinion of the Attorney-General of the United States, construing articles of the International Convention, cited, 47 O. G. 398, C. D. 1889.) *Id.

(c) *Prior Conception and Reduction.*

366. An inventor (Hunter) who is the earliest to conceive, disclose and reduce to practice, and who connects his conception and completion by such diligence as his circumstances and the character of the invention admit of, cannot be defeated in his right to a patent by any amount of diligence in coming to the patent office of an inventor whose conception is of later date. Hunter v. Miller, 50 O. G. 1765, C. D. 1890.

(M.'s patent issued while H.'s application was pending.)

367. An inventor who first conceives and gives expression to the idea of an invention in such clear and intelligible manner that a person skilled in the business could construct the thing is entitled to a patent, provided he uses reasonable diligence in perfecting it, as against an inventor whose conception was of later date, but who was earlier to apply for a patent. *McCormick Harvesting Machine Co. v. Minneapolis Harvester Works, 51 O. G. 1130, C. D. 1890.

368. An inventor is entitled to a reasonable time, to be judged of according to the circumstances of the case, in which to perfect his invention and reduce it to practice without impairing his claim to priority. *Id.

369. Where A. was the first to conceive an invention and to apply for a patent, and followed up his conception with reasonable diligence in adapting and perfecting the invention, and B. was first to reduce to practice, it appearing, however, that A. had made sketches, a model and working drawings prior to B.'s conception, *held*, that A. was the first inventor and entitled to the patent. Lorruine v. Thurmond, 51 O. G. 1781, C. D. 1890.

370. An exception to the general rule that the first person to reduce his invention to actual practice is the first inventor is recognized in cases where the first person to conceive is diligent in adapting and perfecting the invention, and in all controverted interferences it must first be ascertained whether the rule or the exception is applicable to the facts involved. Id.

371. Where A. conceived the invention in issue in September, 1885; tested it in an experimental apparatus and became satisfied that he had made an invention of value and importance in the same month; set up a plant embodying the invention in March, 1886, which was operated continuously until June of the same year; extensively introduced the invention thereafter, and applied for a patent in August, 1888, and B. conceived the same invention in June, 1886, reduced it to practice in December of the same year, and obtained a patent in July, 1888, *held*, that A. was the first inventor. Stanley v. Slattery, 54 O. G. 1709, C. D. 1891.

372. The junior party, who proves conception of the invention in 1884, disclosure to others in 1886, and reduction to practice in September or October, 1887, *held* entitled to a decision of priority as against the senior party, who proves conception in January, 1887, and no reduction to practice prior to January 19, 1888, the filing date of the application. Mets v. Crane and Bloomfield, 58 O. G. 947, C. D. 1892.

373. Where the testimony of one of the parties is that he conceived the invention and used it in his business at a date prior to the date of conception by the other party, which testimony is corroborated by his caveat filed before the date of conception of the other party, *held*, that he is the first inventor. *Colhoun v. Hodgson, 70 O. G. 276, C. D. 1890.

374. H. conceived August 2, 1881. In January, 1884, he constructed an apparatus applying the conceived idea in the operation of a telephone, and November 9, 1887, filed an application, from which the application in interference was divided August 1, 1890. In August, 1890, the invention of the issue was operated upon a large scale by H. S. filed his application November 4, 1886, and has taken no testimony, and no further facts appear concerning his testimony. Priority adjudicated in favor of H. Hunter v. Spencer, 71 O. G. 1767, C. D. 1895.

375. Priority awarded to Mayhew, because Kelleher and Grimm not original inventors, and further, because Mayhew was the first to conceive and it was not clearly shown that he was not diligent in reducing to practice. Kelleher and Grimm v. Mayhew, 72 O. G. 895, C. D. 1895.

376. "Public policy and the settled practice of the office alike forbid the issue of a second

patent for the same invention in any but a clear case — clear beyond a reasonable doubt;" but the fact that one party has unjustly obtained a patent is not final, for the rule as applied to this case is that "he is the first inventor who first forms a complete mental conception of the improvement in question, as proved not merely by himself but by full and certain disclosure to another, and who, under all the circumstances of the case, proceeds with reasonable diligence to the construction of a full-sized machine embodying the improvement in working form; and that this is so although another with a later conception first fully reduces the invention to practice." Huson v. Yates, 72 O. G. 1201, C. D. 1895.

377. Where it appears that S. produced a sketch and described the invention to others on September 9, 1887, made and tried a model in April, 1888, and applied for a patent on June 19, 1888, and that K. was not engaged upon the invention until December 1, 1887, but applied for a patent March 3, 1888, *held*, that S. was the first inventor. Scribner v. Kellogg, 72 O. G. 1495, C. D. 1895.

378. Chase having failed to prove conception and reduction to practice, although he has a patent granted prior to La Flare's filing date, cannot prevail over La Flare, who conceived and reduced to practice prior to the filing of Chase's application. *La Flare v. Chase, 74 O. G. 1735, C. D. 1896.

379. On the record it must be held that Buhoup was not only the first to conceive and the first to reduce to practice, but that he actually disclosed the invention to Hien prior to his alleged date of conception. Hien may have forgotten the circumstances of this disclosure; but this cannot overcome the proof submitted on behalf of Buhoup. Hien v. Buhoup, 81 O. G. 2088, C. D. 1897.

380. Where it appears that Buhoup was the first to conceive the invention of a round-shanked gravity-pin and button-head and reduced the invention to practice after he had seen the model of the conception of the device in issue by Hien, *held*, that the subsequent modification of the pin from a round shank to a square shank with an oblong head and the substitution of this modification or form for that previously put into use was not such a departure from the original invention as to disentitle him to the right of priority against Hien, who had conceived subsequently to Buhoup, but not put into practical operation, a device of similar principle, but of different form and operation from that of the original conception. *Hien v. Buhoup, 81 O. G. 2087, C. D. 1897.

381. The decision of the assistant commissioner, holding that Buhoup was the first and original inventor, affirmed. *Id.*

(d) *Prior Reduction.*

382. When one of the parties to an interference has made the invention independently of the other party and has reduced it to practice upon an extended commercial scale, and has obtained a patent which he has held unchallenged for nearly a year, he must be adjudged the prior inventor as against the other, who, though he may have been the first to conceive the invention, without any excuse for his non-action, never did anything toward reducing it to practice, but who bases his claim to priority on a previous application filed by him which contained claims for the invention in controversy, which claims were rejected and positively and deliberately abandoned nearly four years before the filing of the application involved in this interference. Beach v. Fowler, 48 O. G. 821, C. D. 1889.

383. Property in patents ought not to be created as against a rival applicant first to reduce to practice and first in the office, upon mere verbal testimony indefinite in its character, unaided by the production of memoranda, drawings or models, under circumstances which in themselves tend to indicate its intrinsic improbability. Wherry v. Heck, 49 O. G. 559, C. D. 1889.

384. Where it appeared that the junior party to an interference involving a process for filtering beer had not reduced the invention to practice before its reduction to practice by the senior party, and that the latter had filed an application for a patent upon an apparatus, disclosing and describing the process at a time when the former had neither reduced the invention to practice nor was using reasonable diligence, and further, that the senior party had applied for and obtained a patent for the process before the application of the junior party was filed, *held*, that the senior party must be regarded as the original and first inventor of the process. Zwietusch v. Stockheim, 53 O. G. 755, C. D. 1890.

385. When 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 deprived of the benefit of the invention or of the title of in-

ventor by any other person who subsequently carries out his idea more perfectly and to a greater degree of usefulness. Riley v. Barnard, 59 O. G. 1919, C. D. 1892.

(Case of protest against issue of patent. See 59 O. G. 1921, same parties.)

386. Where all the experiments of both parties were conducted in the same shop and were embodied in the same machines, and where the evidence on the part of the applicant is that he disclosed the invention on September 15, 1890. and embodied it in successful operation by October 2d following, and on the part of the patentee that he made sketches of the invention in June or July, 1890, which were not dated and not disclosed until and except by mailing them to his patent agent on October 4th, and his assertion that he made them in June or July is without corroboration of a single witness or circumstance and is contrary to his conduct in his efforts through August and early part of September to invent a device like that in the issue, *held*, that the patentee cannot be given an earlier date than October 4th, and consequently judgment of priority must be awarded to the applicant. Tremain v. Curtiss, 66 O. G. 1447, C. D. 1894.

387. Where the testimony is full, explicit and satisfactory that P. conceived the invention in September, 1888, reduced it to practice in November, 1888, and began to put it into extensive public use by March, 1889, and where the testimony of H., his opponent, to his own earlier conception is not corroborated save by the recollection of one witness as to a conversation four years and a half in the past, *held*, that P. is the prior inventor. Peters v. Hisey, 67 O. G. 927, C. D. 1894.

388. Where reduction to practice on the part of one of the contestants is established beyond doubt to have been at a certain date, and when his opponent fails to produce a single sketch or exhibit of the numerous sketches and specimens alleged by him to have been made earlier than the said certain date, without any serious attempt to recover them and with their loss insufficiently accounted for, and where certain of his claims of earlier production are found to be disproved and others improbable, *held*, that there is a failure of proof that the invention existed prior to the date established by the first-mentioned contestant. Shellaberger v. Sommer, Sommer and Sommer, 68 O. G. 533, C. D. 1894.

389. Where the invention has been reduced to practice in a positive form under the patent and the applicant has simply filed his application, without doing anything to adapt and render the invention practical, and where he knew of the issue of the patent within a few days after its issue, and made no suggestion that the invention was his, but recommended it to purchasers, both orally and in writing, as the invention of the patentee, and where he did not assert any title to it until six months after the issue of the patent and after he had left the employ of the company who owned the patent to do service for a rival company, *held*, that priority must be awarded to the patentee. *Wells v. Reynolds, 69 O. G. 121, C. D. 1894.

390. Where one of the parties has reduced the invention to practice, he will be regarded as the *prima facie* original and first inventor. *Soley v. Hebbard, 70 O. G. 921, C. D. 1895.

391. Where it is admitted by the parties that a machine had been built from patterns designed by H., one of the contestants, but where S., the other contestant, claims that H. derived the invention from him, consequently that the reduction to practice ought to inure to his benefit, *held*, that the burden of proof is upon S. to prove his claim, and, failing to do so, priority of invention must be awarded to H. *Id.

392. Where the machine relied on by one of the parties as establishing priority of invention is inoperative, and that relied on by his contestant is operative and successful, *held*, that priority should be awarded to him who produced the operative machine. *Glidden v. Noble, 71 O. G. 141, C. D. 1895.

393. Ecaubert (Letters Patent No. 434,539, dated August 19, 1890) having abandoned any attempt to make his idea practically available and to develop his theory in fact, while Hofmann (Letters Patent No. 435,835, dated September 2, 1890) conceived the idea, embodied it in means by which it could be carried out, and proceeded to make watch-case centers, and thereby first perfected it, is entitled to be recognized as the real inventor. (Agawam Co. v. Jordan, 7 Wall. 583; White v. Swayne, id. 687; Reed v. Cutter, 1 Story, 590; Howe v. Underwood, 1 Fish. 166. Appleton v. Ecaubert, 71 O. G. 1617, C. D. 1895.

394. C. and L. both had the intellectual conception of the invention independently of each other. L. left his thought in abeyance in the presence of the activities of C. in reducing it to tangible form and incorporating it into a car. L. did not proceed promptly after learning that C. had obtained a patent for the improvement. He stood by and saw C. reduce the invention

to practice without any claim to the invention or for remuneration. The reduction and invention were C.'s. La Flare v. Chase, 72 O. G. 741, C. D. 1895.

395. Doyle not only failed in his attempts to reduce the invention to practice, but also failed to exhibit any interest or faith in the trials of McRoberts which proved successful. The neglectful conduct of Doyle after his attempts and his failure to establish his contention that McRoberts had been carrying out the invention of Doyle and the clear proofs of McRoberts, the patentee, entitle him to an award of priority. Doyle v. McRoberts, 73 O. G. 139, C. D. 1895.

396. Carty in his preliminary statement says "that he reduced the same to practice in part in February, 1885." It is no hardship to limit Carty by this explicit language and to consider that what he did at the time fell short of a reduction to practice. Carty, lacking both diligence and reduction to practice, cannot prevail over the patentee. Carty v. Kellogg, 73 O. G. 285, C. D. 1895.

397. Parmelee and Hill prove conception and disclosure at the dates set up in the statements; but, though Parmelee disclosed his invention to Hill and practiced it under contract with the company employing Hill as master mechanic, Hill did not claim it as his own invention at the time and did not file his application until eight months after the issue patent and, as stated, four months after Hill and his assignees knew of the patent. The conduct of Hill is inconsistent with a claim to originality. Hill v. Parmelee, 73 O. G. 447, C. D. 1895.

398. Shellaberger having proved reduction to practice in the spring of 1888 is awarded priority of invention over Sommer, whose earliest conception is September, 1888, and reduction to practice 1890. *Shellaberger v. Sommer et al., 74 O. G. 1897, C. D. 1896.

399. If effectual efforts were made to give an idea form, but were abandoned before reaching such a stage of completion as to require only ordinary mechanical skill to carry the conception to success, the claim of priority of conception cannot be sustained against a later independent conception carried into practical form at an earlier date. *Standard Cartridge Co. v. Peters Cartridge Co., 78 O. G. 621, C. D. 1897.

400. Where the testimony in an interference proceeding between an applicant and a patentee shows that the former was present on one of the first occasions upon which the invention which is the subject of the issue was tested and that he ridiculed the attempt as impossible of execution and dangerous to attempt, where the testimony also shows that the applicant did not claim credit for the invention when he was first accustomed to hear it attributed to the patentee, where it appears that the application was filed after the issue of the patent and is a substantial copy thereof, and where there are other and corroborating circumstances, the presumption that the patentee is the prior inventor has not been disturbed. Doyle v. McRoberts, 79 O. G. 1029, C. D. 1897.

XXV. Reduction to Practice.

(a) *In General.*

401. The purpose of the law is to benefit the public as well as to protect the inventor, and the inventor who reduces his 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 and failed himself to act upon them. Green v. Hall, v. Siemens, v. Field, 46 O. G. 1515, C. D. 1889.

402. The allegation that the fact of an application being put in interference determines that the invention has been reduced to practice, overruled. The office possesses no machinery for ascertaining such fact, but assumes for the purposes of the interference that the invention of each applicant is within the issue, although the subsequent history of the rival inventions may develop the fact that while one of them is in a form capable of commercial use the other may be incapable of any practical use whatever. Green v. Hall, v. Siemens, v. Field, 47 O. G. 1631, C. D. 1889.

403. Where neither party made an actual reduction to practice before filing his application and neither makes out a satisfactory case, decision will follow the preponderance of evidence, however slight it may be. Buckingham v. Jones, 58 O. G. 1413, C. D. 1892.

404. Where a party to an interference claimed to have reduced to practice early in 1887 and then discontinued the use of his invention for two years, meantime applying for two other patents upon devices of the same general character, *held*, that such conduct was inconsistent with the supposition that he made a successful reduction to practice at the earlier date. Rennyson v. Merritt, 62 O. G. 151, C. D. 1893.

405. Where a caveat disclosed substantially

the invention in interference, *held*, that the expression in the caveat of a desire to mature the same does not show that the invention could not have been reduced to practice at its date. *Colhoun v. Hodgson, 70 O. G. 276, C. D. 1895.

406. At the time of the contract it was certainly not contemplated that the assignee should be let into the secrets of the invention and become entitled to the larger share of the profits and yet be free to experiment as he pleased and appropriate to his own use the result of his experiments. Such a course would be a fraud upon the partnership. *Milton v. Kingsley, 75 O. G. 2193, C. D. 1896.

407. Whether the appellee, who is the original assignee, made invention in question is not decided; but if he did, he made it for the benefit of the partnership, and therefore the appellant, who is the original inventor, should receive the patent. *Id.

408. The assignee, if he made the discovery in question, did so only in the elaboration and reduction to practice of the ideas of the original inventor, and his obligations to the latter he should not now be permitted to repudiate by procuring a patent in which the latter has no interest. To allow this would be to place a premium upon fraud. *Id.

409. Where a plaintiff claims to be an original inventor and the defense is that the defendant is a prior inventor, thus conceding the invention of the plaintiff, but challenging his claim to priority of invention, it is imperative that the invention or discovery relied upon as a defense must have been complete and capable of producing the result sought to be accomplished, and this fact must be shown by the defendant. Progress, as such, no matter how near it may have approximated the end in view, cannot avail to defeat a patent. (Citing Coffin v. Ogden, 5 O. G. 270, 18 Wall. 120–124.) *Drawbaugh v. Seymour, Com'r of Patents, 77 O. G. 313, C. D. 1896.

410. A device which differs from the terms of the issue in that particular feature which the office once held in the same case was sufficient to constitute a patentable distinction, is not a reduction to practice of the issue. Breul v. Smith, 78 O. G. 1906, C. D. 1897.

411. When complete reduction to practice amounts to two years' public use, the fact of such reduction must be established by evidence of the same degree as that required in evidence setting up the bar of public use. *Wurts v. Harrington, 79 O. G. 335, C. D. 1897.

412. In a controversy between two rival applicants the requirement that reduction to practice by the junior party before the senior should be established beyond a reasonable doubt, is unduly onerous. *Id.

413. On the proof, *held*, that the claim of Seher is not sufficiently and definitely established to maintain his patent, it having, as it can have, only *prima facie* effect; that he has failed to show that he has fully and completely established by experimental tests so as to enable persons reasonably skilled in the science of chemistry to determine whether or not the composition made and claimed by him as new and valuable in the arts really possesses those properties which he claims as the essential character as an operative means, for no invention or discovery in such case as the present can be regarded as complete until such tests have been applied and have been successfully maintained. *Stevens v. Seher, 81 O. G. 1932, C. D. 1897.

(b) *Actual.*

414. Reduction to practice of a mechanism consists in the construction of the mechanism of a size capable of practical use and a knowledge, preferably by actual trial, that it will work practically for the intended purpose. Juengst v. Boyer, 63 O. G. 152, C. D. 1893.

415. Where the mechanism embodying the issue in interference works practically, and another mechanism connected thereto fails to work practically, *held*, that each stands on its own basis and that the former is competent evidence of reduction to practice. Id.

416. Where the exhibit relied on to establish priority of invention has all the necessary parts to a full-sized working machine, and it fully accomplished at the date of its construction the purpose for which it was intended, and its mode of operation and utility were understood and appreciated by those who saw it operate, *held*, that such exhibit was a reduction to practice, regardless of the question whether the various other mechanisms entering into the machine all worked with practical success or not. *National Cash Register Co. v. Lamson Consolidated Store Service Co., 67 O. G. 680, C. D. 1894.

417. Where G. was the first to conceive and the first to reduce to operation, although the machine was far from perfect and never operated continuously for work in a commercial sense, *held*, that such machine was something more than an unsuccessful experiment—that it was a reasonably successful reduction to

practice. *Coffee v. Guerrant, 68 O. G. 279, C. D. 1894.

418. Where a large dynamo was provided with the brush-holders in issue and was run for a time successfully under conditions of use such as would represent actual practice, *held* to constitute a reduction to practice. Thomson v. Priest, v. Wetmore, 71 O. G. 1769, C. D. 1895.

419. Where the brush-holder was used successfully on a dynamo, then laid aside, and could not be found when the testimony was taken, *held*, that the failure to produce the device had no effect on the question of reduction to practice, except that it suggests that the device did not work successfully; but on this point the direct evidence outweighs the suggestion. Id.

420. As a rule, to reduce a method or process to practice the series of acts which constitute such method or process must be performed. Croskey v. Atterbury, 75 O. G. 1359, C. D. 1896.

421. Actual reduction to practice of a process consists in the actual performance of the process. Making a device by means of which the process can be carried out is not such a performance, and is not, therefore, a reduction to practice. *Croskey v. Atterbury, 76 O. G. 163, C. D. 1896.

422. Although a device was not commercially perfected and did not do as efficient work as later devices, yet, as it showed every feature of the inventiou in controversy and was adapted to perform the work for which it was intended and actually did such work, it is *held* that such a device was a reduction to practice. Loewer v. Ross, 76 O. G. 1711, C. D. 1896.

423. When a senior party has shown that he was in possession of a machine which would make the article — a chain — of the issue, tho actual production of such chain may be safely presumed. Breul v. Smith, 78 O. G. 1904, C. D. 1897.

424. The use of a shoe-last in trimming soles is not a reduction to practice of the same last for use in leveling soles, where the conditions are different and the strain upon the last much greater. Arnold v. Taylor, 79 O. G. 154, C. D. 1897.

425. An invention that is complete and that produced the result sought to be accomplished by the inventor to his satisfaction and that of competent witnesses, and which was tried in connection with a working system, is a satisfactory reduction to practice, even though the device was never in fact incorporated into and made a part of the system, if the conditions of the trial were complete and satisfactory. *Wurts v. Harrington, 79 O. G. 337, C. D. 1897.

426. When complete reduction to practice amounts to two years' public use, the fact of such reduction must be established by evidence of the same degree as that required in evidence setting up the bar of public use. *Id.*

427. A work-shop test of a wick-lift for a lamp, which consisted in determining whether the lift would operate the wick-holder of a lamp provided with neither oil nor wick, when it appears that such is the ordinary shop way of testing wick-lifts, is a sufficient reduction to practice. Nankervis v. Johnson, 79 O. G. 1519, C. D. 1897.

(c) *Constructive.*

429. Webster filed an application in 1867 showing but not claiming the invention. It was rejected and the rejection acquiesced in. In May, 1875, Sanford filed an application claiming the invention, and in July the patent issued. June, 1876, Webster filed a second application claiming the invention, and was put into interference with Sanford's patent. Sanford conceived the invention in December, 1873, and diligently reduced it to practice as early as July, 1874. Webster did nothing toward a reduction to practice except filing his application of 1867. *Held*, that the filing of the application in 1867 constituted conception but not reduction to practice, and that showing no diligence priority of invention must be awarded to Sanford. The filing of such an application in the patent office does not constitute "prior knowledge or use by others" within the meaning of the statute. It requires the invention to be reduced to practice in "a concrete and perfect form to make it capable of prior knowledge or use by others." Mere drawing and description not published will not bring the invention within the requirement. *Webster v. Sanford, 44 O. G. 567, C. D. 1888.

430. The filing of a caveat does not give to the caveator the standing of an applicant with respect to constructive reduction to practice. The statute does not contemplate that a caveator shall stand as an obstruction to the diligent efforts of other inventors in the same field of art. Elges v. Miller, 46 O. G. 1514, C. D. 1889.

431. Actual reduction to practice is not the only competent evidence of perfection and adaptation to use; but the inventor's act in filing 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, 51 O. G. 1781, C. D. 1890.

432. The filing of an application, which is pronounced by the experts of the office to be sufficient to authorize the granting of a patent, is for the purpose of a judgment upon the record conclusive evidence of perfected invention on the part of the applicant at or before its filing date. Lindsay v. McDonough, 55 O. G. 1402, C. D. 1891.

433. An application for a patent which eventuates in the grant of a patent is a constructive and presumptive reduction to practice. Hunter v. Jenkins, 56 O. G. 1705, C. D. 1891.

434. The filing of an allowable application constitutes a reduction to practice. (Citing Lorraine v. Thurmond, 51 O. G. 1781, C. D. 1890, 86; Telephone Cases, 60 O. G. 1753, 126 U. S. 535.) *Porter v. Louden, 73 O. G. 1551, C. D. 1895.

435. Carty filed an application April 20, 1885, which became abandoned October 21, 1887. He filed another original application November 17, 1887. Kellogg filed an original application July 30, 1887. *Held*, that Carty's abandoned application is only evidence of conception; that his excuse for want of diligence in prosecuting his claim being weak, Kellogg, who first constructively reduced to practice by filing an application, is entitled to award of priority. *Carty v. Kellogg, 74 O. G. 657, C. D. 1896.

436. The filing of a completed allowable application for a patent for the invention is a constructive reduction to practice and is as effectual in a contest of priority as actual reduction to practice. (Porter v. Louden, 23 Wash. L. R. 689; Yates v. Huson, 24 id. 214, and the cases and authorities referred to in the opinions in those cases.) *Croskey v. Atterbury, 76 O. G. 163, C. D. 1896.

437. The filing of a complete application is a constructive reduction to practice, even though such application be subsequently amended, provided such amendment is made to secure conformity between parts of the application. *Id.

438. Neither an executed specification nor an incomplete application nor anything except a complete allowable application can be regarded as a constructive reduction to practice. Phelps v. Hardy, v. Gattman and Stern, 77 O. G. 631, C. D. 1896.

439. On the question of the sufficiency of a party's application to enable him to avail himself of his specification and drawings as constructive reduction to practice on the date of their filing, it is necessary to distinguish between those which are sufficient to show an intellectual conception of an improvement and those which are sufficient in a patent to enable others skilled in the art to build the machine without extraneous aid. Fowler v. Dodge, 78 O. G. 2045, C. D. 1897.

440. Allowed applications operate as constructive reduction to practice of the inventions claimed, and it is therefore incumbent upon the other applicant to show by clear proof completed invention prior to the dates of such applications. (Porter v. Louden, 73 O. G. 1551, 7 App. D. C. 64, 72; Soley v. Hebbard, 70 O. G. 921, 5 App. D. C. 99, 103; Christie v. Seybold, 64 O. G. 1650, 1653.) Mergenthaler v. Scudder, 81 O. G. 1417, C. D. 1897.

(d) *Diligence.*

441. Mere working models, allowed to rest in oblivion for many years, will not prevail to establish priority when application for patent is delayed and not filed until after another and more diligent inventor has entered the same field of invention and established his claim as an independent inventor. Green v. Hall et al., 46 O. G. 1515, C. D. 1889.

442. A failure in an interference proceeding, for more than two years after conception, to do anything to reduce the invention to practice, cannot be excused by engagements in other matters. Lowe v. Springer, v. Morse, v. Granger, 41 MS. D. (1 G. W. D.), Nov., 1889 (Mitchell, Com'r).

443. B. had an application pending for an invention not involved in this interference. After forwarding the application for such invention to the patent office, he conceived the invention in controversy and offered to incorporate it by amendment, unaccompanied by any oath, in the application already filed. *Held*, that the only effect of such action was to establish diligence. Lorraine v. Thurmond, 51 O. G. 1781, C. D. 1890.

444. A. was under no obligation to effort until B. had conceived the invention. A party second to conceive does not prevail in virtue of his own diligence, but by reason of lack of diligence on the part of his competitor. Id.

445. A party who had been previously diligent, and at the date of conception on the part of his opponent was actually engaged in preparing to file his application for patent, having already finished working drawings of the invention, *held* to have exercised reasonable diligence. Lorraine v. Thurmond, 52 O. G. 1949, C. D. 1890.

446. The settled rule of law is that whoever first perfects the invention is entitled to the patent and is the real inventor, although others may have previously had the idea and made some experiments toward putting it in practice. To this rule a single exception is recognized, to wit: that if the one first to conceive the invention was at the time using reasonable diligence in adapting and perfecting the same, he is to be recognized as the first inventor, although the second to conceive may have been the first to reduce to practice. Ecaubert v. Hofmann, 53 O. G. 2107, C. D. 1890.

447. In the case under consideration, *held*, that the last applicant has failed to establish by credible evidence that he first perfected the machine or the process, so as to come within the rule, or that he used reasonable diligence in adapting and perfecting the invention so as to come within the exception. Id.

448. Where, in a suit for infringement, it appeared that the application on which the patent in suit was granted was filed January, 1887, and that some months previous thereto the defendant had devised and constructed the machine complained of as an infringement, and that in the winter of 1883–84 the plaintiff had described it to his solicitor, and that in 1886 he repeated the description more fully, and that he did not intend at either date to reduce the invention to practice, his only concern being to protect himself in the construction and sale of the machine made under an earlier patent, and did not ever intend to apply for a patent at all unless it should seem necessary as a means for preventing others from making these machines, and that at the time of applying for patent he had not embodied his invention in a machine for practical use, and it further appeared that at the time of his first conversation with the solicitor he was as well prepared to reduce his invention to practice and apply for a patent as he was at the date of the second, and that any competent mechanic accustomed to such work could have constructed the machine from the first description almost, if not quite, as readily as from the second, *held*, that the plaintiff had failed in diligence. *Wright v. Postel, 53 O. G. 603, C. D. 1890.

449. It is the duty of inventors to use reasonable diligence in reducing their conceptions to practice and applying for patents when desired, and they cannot neglect it without danger to their rights. *Id.

450. A delay of over two months, wholly unexplained, counted against an applicant when his opponent, though later in conception, showed earlier and prompt reduction to practice. Morgan v. Wheeler, 46 MS. D. (3 G. W. D.), April, 1891 (Mitchell, Com'r).

451. If the first person to conceive would prevail in a contest of priority over his rival, who has first reduced the invention to practice, he must show that he was using reasonable diligence in adapting and perfecting the invention at the time when his competitor entered the field. He must show that his diligence antedates the inceptive invention of his rival if he would prevail over him, and he must show that his diligence extends back to his own conception if he would carry his invention back to the date of that conception. Christie v. Seybold, 54 O. G. 957, C. D. 1891.

452. Where in an interference proceeding it appeared that the senior party was the first to conceive and disclose the invention, but did nothing whatever toward adapting and perfecting the invention until six months after the time when the junior party entered the field without adequate excuse for his inaction, the junior party having meanwhile reduced the invention to practice also, *held*, that the junior party was the first inventor. Id.

453. A delay of a year and a half between conception of the invention and filing of the application, there being no reduction to practice, during which time a rival inventor applied for and obtained a patent for the same invention, and during which time the inventor first mentioned obtained a patent containing the more substantial elements of the invention in dispute, but not containing claims broad enough to give substantial protection as regards a structure such as that now sought to be patented, *held* not to be excusable. McDougall v. Phinney, 56 O. G. 928, C. D. 1891.

454. 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. Hunter v. Jenkin, 56 O. G. 1705, C. D. 1891.

455. The reasonable diligence which is required in a contest over priority of invention applies alike to actual reduction to practice and to the constructive reduction to practice involved in an application. Id.

456. An applicant delayed making his application for five years after his conception

of the improvement, 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 his invention. Ligowsky v. Peters, v. Hisey, 57 O. G. 1593, C. D. 1891.

457. Where an applicant delays for more than two years after his conception of invention 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 was not reasonably diligent. Thomson v. Ries, 59 O. G. 298, C. D. 1892.

458. As between interference contestants, he who was last to conceive of an improvement is not entitled to take a patent therefor over him who was first to conceive, unless by reason of the latter's delay his opponent becomes the first to reduce to practice. Eckerson v. Cox, 60 O. G. 437, C. D. 1892.

459. Sibbald filed an application for a patent in September, 1887, which passed to issue in October, 1888, and became abandoned in October, 1890. Meanwhile Cassidy and Smith filed an application in February, 1890, and took a patent in June, 1890. Sibbald filed his second application in January, 1891. The proofs established priority of conception for Sibbald, and while satisfactorily accounting for his delay on the score of poverty showed that he took steps to file his second application before the two years' limit had expired. *Held*, the facts save Sibbald's case from abandonment and give (or justify) judgment of priority in his favor. Sibbald v. Cassidy, 61 O. G. 563, C. D. 1892.

460. What an applicant has done abroad by way of disclosure or reduction to practice is not pertinent to the question as to whether he exercised reasonable diligence arising in an interference in the office. Peters v. Hisey, 62 O. G. 315, C. D. 1893.

461. An interval of a year and a half after conception of an invention, during which the inventor practically gave up work on his improvement, *held* to negative reasonable diligence. Slattery v. Shallenberger, 62 O. G. 1515, C. D. 1893.

462. Where a party to an interference claimed to have had a conception of the invention in controversy on or about April 1, 1887, and to have made various sketches and disclosures of it between that date and March 7, 1889, when he filed an application for patent, and where it appears that he took no other step toward developing the invention during that interval, although he knew the great value of the invention, was an experienced inventor, and meanwhile filed at least two other applications for patents, *held* his delay to either actually or constructively reduce to practice in this interval was not the exercise of reasonable diligence. Brungger v. Smith, 62 O. G. 1511, C. D. 1893.

463. The person who first conceived a comparatively simple improvement in power-presses for bookbinding made a rough sketch of it within a few months. Three years after his first conception he had working drawings made, and six months thereafter a machine was manufactured. He excused the delay by asserting that he could neither afford to buy the necessary tools sooner nor use them in his small shop. His reason for not having the machine made at another shop was that he would have made no profit on machines made by others according to his invention. *Held*, that he did not use due diligence so as to entitle him to patent as against one who conceived the invention later, but reduced it to practice sooner, than himself. *Christie v. Seybold, 64 O. G. 1650, C. D. 1893.

464. The man who first reduces an invention to practice is *prima facie* the first inventor under act of July 4, 1836 (5 St., p. 117), but the man who first conceives the invention may date it back to such conception if he uses due diligence in reducing it to practice, and he must use such diligence before as well as after the second conception of the invention. (Reed v. Cutter, 1 Story, 590, followed.) *Id.

465. Where under the above facts, and considering that the patentee was the applicant's superior officer, was adverse to him in interest in this question, had already obtained his patents, and told him, upon the latter complaining of this, that "that was all right," and had persuaded him not to apply for a patent, the applicant did not file his application until nine months after the date of his conception and more than five months after he knew of the patentee's patents, *held*, it must be considered, under these somewhat adverse circumstances, that the applicant had not incurred the penalties of negligence. Reynolds v. Wells, Jr., 66 O. G. 1594, C. D. 1894.

466. Where the first to conceive is negligent in reducing to practice, and the second to conceive is so diligent as to put the invention into practice before the date of the reduction to

practice by the first to conceive, *held*, under such facts, that the second to conceive is the first inventor. Calhoun v. Hodgson, 67 O. G. 1329, C. D. 1894.

467. In the cases where delay in completing an invention is excused there is something of compelling power in the circumstances that produce it. Dailey v. Jones, 67 O. G. 1719, C. D. 1894.

468. While an inventor who is first to conceive and is reasonably diligent in completing his invention should ordinarily prevail over a competitor who subsequently conceives but is first to complete his invention, still if the first to conceive has means, credit, influence and friends, and is not brought to a standstill by anything in the nature of compulsion, but chooses delay on business grounds, he thus excludes himself from the advantage which flows from his prior conception. Id.

469. A second patent for the same invention upon an application filed nearly three months after the patent issued is refused where the applicant made the hoop-coupling and tried it upon a strap around a block of wood, but soon afterward put it under his bench, where it remained for more than two years and until after the senior party invented it, put it into practice, and obtained a patent therefor. Burr v. Ford and Ferguson, 68 O. G. 655, C. D. 1894.

470. "Although Yates was the first to apply for a patent, and did so prior to the completion of Huson's machine, and subsequently received a patent thereon a few days before Huson made application, Huson was the first inventor; he was proceeding with reasonable diligence from April, 1891, to the completion of his invention on December 3, 1891, and was diligently engaged therein when Yates formed his first conception of this invention in October, 1891." Huson v. Yates, 72 O. G. 1201, C. D. 1895.

471. Croskey conceived the invention in December, 1890, and reduced it to practice October 3, 1892. Atterbury conceived the invention in July, 1892, and filed an allowable application October 1, 1892. *Held*, that Atterbury is the prior inventor in the absence of a showing of reasonable diligence on Croskey's part. Croskey v. Atterbury, 73 O. G. 1359, C. D. 1895.

472. When at any time within two years Croskey could have completed his process and failed to do so, he has not established a case of reasonable diligence against Atterbury, who conceived later than Croskey, but filed an application before Croskey reduced to practice. Id.

473. A delay of six years, unexcused by sickness or poverty, fatal to a claim of priority depending upon connecting an earlier conception to a later reduction. *Porter v. Louden, 73 O. G. 1551, C. D. 1895.

474. Huson, being the first to conceive the invention and using reasonable diligence in adapting and perfecting the same at the time of Yates' conception, must prevail as against Yates, although Huson failed to reduce to practice until after Yates had filed his application for patent. *Yates v. Huson, 74 O. G. 1782, C. D. 1896.

475. The words of the law, "was using reasonable diligence," refer to the very time of the second conception. For the prior conceiver to show that his diligence only began with the time of the second conception would not be sufficient; all that is necessary is that the first conceiver shall have begun and prosecuted with diligence the work of adapting and perfecting his invention before the date of his rival's conception. *Id.

476. While it is required that the first conceiver shall prosecute his labors in reducing to practice with reasonable diligence, that diligence, however, is a matter to be determined by the special circumstances of the particular case. *Id.

477. While the general policy of the law (sec. 4920, R. S.) is to require diligence in adapting and perfecting inventions on the part of those who wait and work to that end, yet it is to at the same time encourage those efforts to such a degree as that their merits and value might be practically tested before application for patent. *Id.

478. If Chase had the germ of the idea in 1883 and did not reduce to practice until 1891 and did nothing during the intervening years. *held*, that the idea had been forgotten and abandoned. *Chase v. La Flare, 74 O. G. 1735, C. D. 1896.

479. There is no general rule of what constitutes due diligence. It is reasonable diligence, and that is to be determined by all the facts in the case. An inaction of eighteen months, in the absence of controlling adverse conditions, is not reasonable diligence in the case of an invention which required but one month for actual development. *Croskey v. Atterbury, 76 O. G. 163, C. D. 1896.

480. Scudder being the first to conceive of the invention and having used reasonable diligence, under the circumstances, in reducing to practice, is awarded priority. Scudder v. Mergenthaler, 76 O. G. 1851, C. D. 1896.

481. Scudder, after conceiving of the invention, being confronted with large expenditure as to the making of the machine, and with the question whether the machine when perfected was an improvement upon the existing Mergenthaler machine, and not capable of separate and independent manufacture, except by license under the Mergenthaler patents, is entitled to some indulgence while he is enlisting the capital of others, while maturing his own plans, and, in the case of so complicated a machine, while dwelling upon the details of construction. Id.

482. While an inventor might file an application in the patent office covering an invention before making a test, yet it is not required that he should do so; but, on the other hand, it is presumable, if it be not required, by plain implication from the language of section 4920, Revised Statutes, that he should occupy himself first in adapting and perfecting his invention. Id.

483. Lack of diligence is not excused by applicants relying upon the advice of an attorney that the invention was not patentable. Gray v. Alexander, 62 MS. D., July, 1897 (Butterworth, Com'r).

484. Attorney's advice to an interferant to the effect that the invention of the issue is covered by his prior patent is an excuse but not a justification for delay in reducing to practice or applying for a patent. Breul v. Smith, 78 O. G. 1904, C. D. 1897.

485. Long delay in filing an application for a patent after alleged conceptiou of the invention casts a doubt upon the allegation of conception, but it may be shown by the circumstances to be not inconsistent with inventorship. *Hunt v. McCaslin, 79 O. G. 861, C. D. 1897.

486. Delay of four years is too long for reduction to practice of a simple device by a manufacturer possessed of ample means. Arnold v. Tyler, 79 O. G. 154, C. D. 1897.

487. The fact that an applicant made inquiries as to the patentability of a device is immaterial to the question of reduction to practice and does not establish diligence. Id.

488. Mistaken advice on the part of a solicitor, from which followed long delay in putting an invention into practice, will not be allowed to militate against the just claims of others who have been diligent in the realization of their conceptions. *Arnold v. Tyler, 79 O. G. 156, C. D. 1897.

489. Whether reasonable diligence is exercised in reducing an invention to practice is a question to be determined in view of all the circumstances of the case. While the law is indulgent to the inventor and saves him from the consequences of delays which he could not avoid, it gives him no option as to the diligent pursuit of his reduction according to his actual abilities, but holds him strictly to the rule, as justice and the public interest require. No difficulties in reducing to practice will excuse delay, unless they relate to matters or circumstances beyond the control of the inventor, such as sickness, poverty, or other involuntary disability not having the consent of the claimant. *McCormick v. Cleal, 80 O. G. 1614, C. D. 1897.

490. M.'s application, except the claims, was prepared in February, 1894, but he delayed filing until October, 1894, and in the meantime, in July, 1894, C. filed his application. *Held*, that the sole excuse of the delay — that M.'s attorney was too busy with other engagements to take up his case — was insufficient to defeat C.'s right to a patent. *Id.

491. Where the practice of the office is settled, it should be followed, unless there are very good reasons for changing it. The rule *stare decisis* must prevail in the patent office as in the courts. *Id.

(e) *Drawings or Sketches.*

492. Mere drawings and description not published, *held* not sufficient to meet requirements and show reduction. *Webster v. Sanford, 44 O. G. 567, C. D. 1888.

493. A rough sketch of an invention is not such a reduction to practice as to make its author the original inventor within the meaning of the patent laws. *Christie v. Seybold, 64 O. G. 1650, C. D. 1893.

494. While the failure to produce the original sketches, specimens of the device made, or the machine upon which it was made is always the subject of adverse criticism, yet it may be so explained that priority may be awarded to the party who does not produce such evidence to show reduction to practice. Shellaberger v. Sommer, 74 O. G. 1897, C. D. 1896.

495. An illustration which amounts to no more than a suggestion is not sufficient warrant for a claim filed nearly two years after the application and nine days after an interfering patent. Dewey v. Colby, 75 O. G. 1860, C. D. 1896.

496. An illustration of a device of doubtful purpose is not a reduction to practice. Id.

(f) *Experiment, Abandoned or Unsuccessful.*

497. Where one of the parties to an interference had first made a machine upon which the issue can be read, but which was inoperative and was dismantled and not assembled until and except for the purpose of the interference, and, furthermore, after such dismantling the party continued to experiment in that line with other devices and finally was only successful by substituting in his machine a device of another inventor, *held*, that the first machine was an experiment and not a reduction to practice. Glidden v. Busell, 67 O. G. 675, C. D. 1894.

498. While reduction to practice may be made with an experimental device, it must be by practical and successful operation and must be in such use as the device would have to stand when manufactured and sold. Arnold v. Tyler, 79 O. G. 154, C. D. 1897.

499. When a manufacturer recognized the need of an article in his business to perform certain functions performed by the device of another, the fact that he laid aside for four years a device which he subsequently claimed was a reduction to practice of the invention in question raises a strong presumption that such device was merely an unsuccessful experiment. Id.

500. The contention that an interferant was for four years trying to devise means for making a certain device practicable is inconsistent with the contention that such device was a complete reduction to practice. Id.

(g) *Working Model.*

501. It is well settled that a working model designed and intended as such is not a reduction to practice. Green v. Hall, v. Siemens, v. Field, 46 O. G. 1515, C. D. 1889.

(Decision (by Hall, Com'r) affirmed in Green v. Hall et al., 47 O. G. 1031, C. D. 1889—Mitchell, Com'r.)

502. An exhibit which does not show the identical thing in issue, and which was manifestly designed and intended as a mere working model and nothing more, may be evidence to lay the foundation of a claim to priority, but is not of itself sufficient evidence of reduction to practice of the alleged invention. *Porter v. Louden, 73 O. G. 1551, C. D. 1895.

XXVI. Reinstatement or Re-opening of.

503. When the office has 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, declining to do so, enters into an interference contest upon the broad issue, in which he is 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 proposing the amendment suggested by the office and declined by him, and which, if admitted, would result in a new interference. Ex parte Gray, 46 O. G. 1277, C. D. 1889.

504. The tribunals adjudicating the interference discussed and considered the specific invention and intimated that a motion to dissolve and reform the issue would be entertained; but applicant declined to avail himself of the suggested remedy. *Held*, that the decisions, involving the very question presented in the amendment now insisted upon, are final and conclusive upon Gray's right to claim the subject-matter presented in the proposed amendment. Id.

505. Decisions upon motions to re-open an interference and for the introduction of additional testimony after expiration of the time set for taking testimony, but before the hearing, are "generally regarded as within the discretion of the examiner of interferences, and the commissioner will not disturb such decisions unless it appears there has been some abuse of discretion or disregard of some rule or law." Schnabel v. Shellaberger, 52 MS. D., March, 1893 (Frothingham, Ass't Com'r).

506. When in an interference proceeding the commissioner upon reconsideration vacates a former decision of abandonment, the reinstatement of the interference which had been dissolved by reason of the former decision follows as a necessary consequence. Young v. Case, 58 O. G. 945, C. D. 1892.

XXVII. Renewal Application.

507. A renewal application properly filed in place of a successful 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 and Schutz, 58 O. G. 1416, C. D. 1892.

XXVIII. Service of Notice.

508. When an interference is declared between an application and a patent issued inadvertently during the pendency of that application, and the applicant files a motion to dissolve

the interference and to stay proceedings without having made any proof of service of notice of said motion upon the opposite party, said motion will not be entertained. (Rule 153.) Bechman v. Johnson, 48 O. G. 673, C. D. 1889.

509. The case is the same as if the interference had been declared between two pending applications, and the interference is rightly declared when declared under rule 94, paragraph 1, without the affidavit called for by rule 94, paragraph 2. Id.

510. While a motion to dissolve the interference and suspend proceedings will not be refused if made without notice to the opposite party, *quære*, whether in a case like the present a petition, without notice to the opposite party, to *vacate* the order establishing the interference might not be sustained. Id.

511. Pending the interference in such case an amendment which does not come within the terms of rules 106, 107, 109 will not be received or considered. (Rule 130.) Id.

512. H., a party to an interference, served notice on P., the opposing party, that he would take the testimony of certain persons named therein upon a certain day. When the testimony was taken, the party P., who had not been named as a witness in the notice, was called upon by H. and testified under protest. Upon motion here made to suppress his deposition, *held*, that P. as a witness for H. stands in the same position as any other witness under the rule regulating the taking of depositions, that the same formalities of notice must be observed, and the deposition having been taken informally should be suppressed. Hill v. Parmelee, 59 O. G. 631, C. D. 1892.

513. The provision of rule 104 which gives the examiner of interferences discretion to dispense with service on an opposing party of notice of motion to extend time for filing preliminary statement does not contemplate a case where such service can be reasonably effected, and it should not be exercised in such a case. *Illinois Watch Co. v. Robbins and Avery, 61 O. G. 721, C. D. 1892.

514. Where the junior party having the earlier filing date filed in the office a notice that he would take no testimony, but would rely upon his application and the record of the interference as evidence of invention and reduction to practice, *held*, that service of the same should have been made upon the other party; but no substantial injury having resulted to the latter because of lack of such service, and the amendment of rule 16 being comparatively recent, want of service was waived. Lane v. Hunter, Jr., 63 O. G. 151, C. D. 1893.

515. The office, when it has reason to believe that an inventor is dead, should endeavor to ascertain the identity of his heirs before the declaration of an interference, and should send the interference notices to such heirs if no formal or authentic notice of the death of the inventor has been given. Decker v. Looseley, 77 O. G. 2140, C. D. 1896.

XXIX. Statutory Bars, in General.

(See Dissolution—Statutory Bars, *supra*; Joint and Sole Applications, *supra*.)

516. Two applications of La Dow are involved in this interference, in one of which he is the junior and in the other the senior applicant. In his preliminary statement he sets up public sale of the invention, which, if established, would bar all parties. Clark moves that La Dow be required to file drawings and descriptions of the invention alleged to have been sold and furnish other information. *Held*, that in view of the averment of public use it would be unjust and unnecessary to put Clark to the expense of taking his evidence first, so long as La Dow was attempting to destroy the necessity of an interference, and ordered that La Dow be required to proceed first and take such evidence as he desires which shall establish the facts set forth in his preliminary statement, and also in support of the question of priority. Clark may then follow with evidence rebutting that offered by La Dow. Clark v. La Dow, 43 O. G. 248. C. D. 1888.

517. There is no precedent or principle justifying the granting of applicant's demand that a patent be allowed to him, in order that an interference may be instituted with a patent previously granted to another, when it distinctly appears that the applicant is not entitled to letters patent as between himself and the public. Ex parte Meucci, 51 O. G. 249 C. D. 1890.

518. So long as an applicant's claims are held to be unpatentable, he has no right either to the institution or continuance of an interference. Abel and Dewar v. Maxim and Nobel, 56 O. G. 139, C. D. 1891.

519. Although the testimony in an interference suggests a statutory bar to the grant of a patent, it is the usual practice to let the case take its regular course to final hearing and award of priority. Bohls v. Bonsack, 63 O. G. 464, C. D. 1893.

520. Where the applicant has the fundamental patent upon which the invention in issue is based, and where the question of the patentability of the invention in issue over the fundamental patent was discussed at the request of the commissioner, although the invention was patented, *held*, that the question of the patentability of the invention in the issue would now be referred to the examiner for his reconsideration. Reynolds v. Wells, Jr., 66 O. G. 1594, C. D. 1894.

521. The consideration of alleged anticipations in the patents of third parties and one of the parties to the interference refused in this proceeding and referred to the primary examiner, under the usual practice of the office, approved by the court of appeals in Peters v. Hisey, 71 O. G. 892. Hunter v. Spencer, 71 O. G. 1767, C. D. 1895.

522. Where the record contains testimony that the invention was in public use for more than two years prior to the application of L., *held*, that since priority is the only question before the office upon the record, L. is entitled to a further hearing upon this point, and the application referred to the primary examiner for this purpose. Lossier v. Cowles et al., 71 O. G. 1616, C. D. 1895.

XXX. Suspension.

(a) *In General.*

523. Interference proceedings should not be suspended in view of the advanced stage (appeal to examiners-in-chief pending) to which the case has progressed. Motion denied for the present, but may be called up at final hearing. Adams v. Kinzer, 44 MS. D., Sept., 1890 (Mitchell, Com'r).

524. Practice approving stipulations for the suspension of interference proceedings during the pleasure of the parties disapproved. Interference proceedings, like all other proceedings in the patent office, should be dispatched under a sense of responsibility to the public at large, and the suspension of proceedings during the pleasure of the parties should never be permitted by the examiner of interferences, and all postponements should be to a fixed and reasonable future time. Baglin v. Doubleday, 53 O. G. 1833, C. D. 1890.

525. The senior party, who was a patentee, having raised the question whether the application of his opponent had not become abandoned by non-prosecution, ordered that the interference be suspended and the applicant required to show cause why his application should not be held to have become abandoned under section 4894, Revised Statutes of the United States. Id.

526. When an interference is suspended under rule 128, the claims 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 tribunals will sustain the examiner in rejecting the claims, or until the laches and delay of the applicant in taking an appeal are such as to authorize the office to dissolve the interference or to issue a patent to the opposing party. Westinghouse v. Thomson, 56 O. G. 142, C. D. 1891.

527. The consideration of references under rule 128 should be *ex parte*. Id.

528. Petition for suspension of an interference in order that a question of the patentability of a claim might be considered denied, it appearing that the same interference had been previously suspended for nearly two years for a similar purpose. Holt v. Mills, 56 O. G. 1059, C. D. 1891.

529. An interference may be suspended on final hearing before commissioner and the case remanded to primary examiner for consideration of operativeness. Ex parte Archer, 57 O. G. 696, C. D. 1891.

530. A motion to stay the proceedings in interference may be granted pending the determination of a motion to dissolve. Lamb v. Warren, 64 O. G. 437, C. D. 1893.

(b) *For Adding New Parties.*

531. When an application is received in this office which, in the opinion of the primary examiner in charge, should be included in a pending interference, the fact and date of the filing of such application should be reported by such examiner to the examiner of interferences, together with a request for the suspension of the interference proceeding for the purpose of adding such new party. Reed v. Jordan, 38 O. G. 661, C. D. 1887.

532. If the files in the interference disclose that testimony has actually been taken, the examiner of interferences should forward to the commissioner a report to that effect, accompanied by the report of the primary examiner to himself, together with his recommendation as to whether or not, in his opinion, the new party should be added. Id.

533. If the interference files do not disclose the fact that any testimony has been taken, the examiner of interferences will advise the parties to the proceeding that a new application has been filed, that it should probably be included in the interference, that it is necessary to know whether or not any testimony has been taken, and if so, when, where and how much, together with the names of the witnesses who have been sworn; and if not, when and where the first testimony is expected to be taken. Id.

534. The examiner of interferences may, if he think necessary, take additional steps to assure himself as to the fact of whether or not testimony has been taken. Id.

535. If, after proper inquiry, the examiner of interferences is satisfied that no testimony has been taken, he may grant the suspension, and the new party may be added to the interference without the direction of the commissioner. Id.

536. If, on the contrary, after such inquiry the examiner of interferences is satisfied that testimony has been taken, he should report the facts, together with his conclusions and recommendation, to the commissioner. Id.

537. When no testimony has been taken, the primary examiner may, after suspension of the interference, add such new party thereto without the order of the commissioner. Id.

538. If, however, testimony has been taken, no new party can be added to the interference without the order of the commissioner. Id.

539. Where one effect of suspending an interference to add a new party would be to practically reinstate a party thereto who has 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, 58 O. G. 1416, C. D. 1892.

XXXI. Testimony.

(See Evidence in a Foreign Country.)

(a) *In General.*

540. 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 his testimony. Ricker v. Merrill, 43 MS. D., 2 G. W. D., July, 1890 (Fisher, Ass't Com'r).

541. The testimony of a witness in interference proceedings to the effect that he is the inventor of the subject-matter of the issue in controversy is not an incomplete caveat or application for patent within the meaning of the patent laws. Bohls v. Bonsack, 63 O. G. 464, C. D. 1893.

542. When a party to an interference is surprised by evidence or a line of defense which he has had no reason to anticipate or opportunity to prepare against, he should have the privilege of answer or explanation whatever may be the stage of the proceedings, even though he has had the opportunity of cross-examination. Scribner and Warner v. Childs, v. Balsley, 63 O. G. 1961, C. D. 1893.

543. The fact that an applicant in his testimony states his conception at an earlier date than in his statement, the fact that he declined to submit for general examination by opponent's counsel the sketch-book from which he states the drawings offered in evidence were cut, and the fact that he declined to answer some of the questions put to him, do not constitute grounds for disregarding his testimony. *Croskey v. Atterbury, 76 O. G. 163, C. D. 1896.

544. It is contrary to established practice to receive *ex parte* affidavits as testimony in interference in absence of stipulation to that effect between the parties. McDonough v. Cleal, 61 MS. D., April, 1897 (Fisher, Ass't Com'r).

545. An extension of time to take testimony refused when repeated extensions had already been granted and specific warnings against delay been given. Birrell v. Regan, 61 MS. D., June, 1897 (Greeley, Ass't Com'r).

546. A request for a commission to take testimony abroad should be decided by the examiner of interferences on its merits, whether it contains a request for extension of time or not. Freeman v. Bernstein, v. Hunter, v. Thomson and Houston, v. The Westinghouse Electric Co. & Gibbs, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

547. The rule for extension of time for taking testimony is a salutary one, made in the interest of all parties. Where there is an obvious disregard of the rule, there is nothing left to do but to abolish the rule or compel its observance, and there is only one way to accomplish the latter, which is to refuse to permit testimony to be taken when it is not observed. Keller v. Wethey, v. Roberts, 81 O. G. 331, C. D. 1897.

548. It is better to insist upon a reasonable and just compliance with the rules of practice

of the office, though it may work a hardship in an individual case, than adopt a course which would result in a practical abrogation of them, with consequent confusion. (Citing Smith and Thomas v. Cowles, 30 O. G. 343.) Id.

(b) *Admissibility of Record in Former Case.*

549. Testimony taken in an interference may not be used in another interference between the same parties, unless the latter so agree. Goodell v. Ellrich, 34 MS. D., April, 1887 (Montgomery, Com'r).

550. 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 part of the record and the purpose for which its admission is sought. Wilson v. Haines, 57 O. G. 1278, C. D. 1891.

551. Testimony taken in one interference cannot be used in a subsequent interference when such use is opposed by a party to such later interference who was neither a party nor privy to the earlier interference at the time the testimony was taken and thereafter, when it does not appear that the witnesses who testified in the earlier interference cannot be procured to testify in the later one. Hunter v. Sprague, 63 O. G. 611, C. D. 1893.

552. Testimony taken in one interference should not be admitted into a subsequent interference between different parties against the protest of one of the parties to the later interference, even though the evidence sought to be introduced is pertinent to the later issue and the protesting party was also a party to the earlier interference. Secor and Secor v. Knapp, 63 O. G. 612, C. D. 1893.

(c) *Filing.*

553. There is no positive rule requiring parties to file all depositions taken in a contested case, and the commissioner is without authority to compel the filing of such depositions. †Petithomme v. Bedbury, 52 O. G. 605, C. D. 1890.

554. Assistant attorney-general suggests that the commissioner be directed to consider and report upon the advisability of adopting a rule to the effect that either party to an interference may have the right to file and use the testimony upon payment of the costs for taking the same with appropriate penalties for obstructing the filing thereof. †Id.

(d) *Interested Parties.*

555. Where the notary taking depositions in an interference case was an employee of a company holding the interest of one of the parties thereto by assignment, 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*, on motion to strike out the testimony so taken, that the notary was an interested party within the meaning of rule 156, and that the testimony must be stricken from the record. Vanness v. Shettler, 57 O. G. 843, C. D. 1891.

556. The rules and practice of this office regarding the taking of depositions look first of all to the strict impartiality of the magistrate and must be strictly applied, and the office will exercise a jealous supervision in this respect. Id.

557. Rule 156 is broad enough to cover any interest in or relation to the party or subject-matter sufficient to raise a presumption of bias. Id.

558. If the proceedings were originally repugnant to the rule, the depositions taken thereunder are void *ab initio*, regardless of any question of actual fraud or prejudice resulting therefrom. Id.

(e) *Irrelevant.*

559. Where the record abounds in improper remarks, long statements touching the conduct of counsel and witnesses, imputations of fraud, perjury and bribery, which are not proof and are not proper parts of the record, *held*, that such matter should have been expunged before printing, and would have been excluded upon motion. (Smith v. Elliott, 9 Blatchf. 400, 407.) Northall v. Painter, v. Bernardin, 71 O. G. 1159, C. D. 1895.

560. Where the record is unnecessarily voluminous from the method of examination adopted, *held*, that the office should be burdened with the reading of additional and wholly irrelevant discussion of other matter of the kind alluded to is intolerable, and the insertion of such things in the record cannot be too strongly condemned. Id.

XXXII. Vacating Judgment.

561. *Held*, that applicant might make a motion to vacate the judgment in interference so far as it related to subject-matter not common to both parties, and that if the facts were as alleged proper relief might be afforded. Ex parte Booth, 49 O. G. 1841, C. D. 1889.

562. Where, after a judgment of priority by the commissioner, and after the claims of the defeated party had been rejected under rule 132, it appeared that certain of said claims were clearly special to his structure and would not be infringed by anything contained in the device of the prevailing party, *held*, that said judgment should be vacated as to said claims. *Held*, further, that as to another of said claims, which was liable to be construed so as to embrace matter common to the organization of the structures of both parties, the judgment should not be vacated. Ehrlich v. Van Horn, 54 O. G. 506, C. D. 1891.

563. On the granting of a motion to dissolve the interference after judgment upon the record, the examiner of interferences will vacate the judgment of priority. Garrison v. Hübner, 54 O. G. 1889, C. D. 1891.

564. Vacation of judgment of priority ordered on the granting of a motion to dissolve an interference on the ground that there was no interference in fact. Rogers v. Wiussinger, 56 O. G. 804, C. D. 1891.

565. On a motion to vacate a judgment rendered in an interference, based upon a misunderstanding as to what applications were included, and where it appears that the office action was clear and unequivocal, *held*, the office will not interfere to cure mere remissness and inadvertence of an applicant, and the motion denied. Hunter v. Knight, 61 O. G. 423, C. D. 1892.

INTERFERING PATENTS.

(See SUBSEQUENT APPLICATIONS; RESERVATION IN APPLICATION; CROSS-REFERENCES; DIVISIONAL APPLICATIONS.)

I. SAME INVENTOR.
II. DIFFERENT INVENTORS.

I. SAME INVENTOR.

1. Decision in Ex parte Holt, April 26, 1884, reiterated. A patent should not issue upon an application covering subject-matter shown in a prior patent to the same party, but not constituting a proper division of said patent. Ex parte Ransom, 39 O. G. 119, C. D. 1887.

2. Where the subject-matter of invention is one, integral and indivisible, the issuance of the first patent bars all subsequent applications, whether concurrent with the first or filed subsequently. This results because the law conclusively infers from the issuance of the first patent that the inventor dedicated to the public the unclaimed features of his invention. It is against public policy to permit the inventor in such case to prolong the monopoly of his invention by a second or repeated patents. Ex parte Roberts, 40 O. G. 573, C. D. 1887.

3. After a patent has been granted for an article described or made in a certain way the inventor cannot afterward obtain a valid patent on an independent application for the method or process of making the article in the way described in the earlier patent. *The Mosler Safe and Lock Co. v. Mosler, Bahmann & Co., 43 O. G. 1115, C. D. 1888.

4. Where a patent fully describes an invention which could be claimed therein and makes no reservation and gives no warning to the public, a second patent granted upon an application filed after the first patent was issued, which claims simply the invention previously made public, is invalid. (Holmes Electric Protective Co. v. Metropolitan Burglar Alarm Co., 33 Fed. Rep. 254.) *Brush Electric Co. v. Julien Electric Co., 41 Fed. Rep. 679 (1890).

5. To grant a patent upon 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 and more restrictedly stated would be in effect to grant a re-issue of the previous patent and at the same time extend its term. Ex parte Edison, 54 O. G. 265, C. D. 1891.

6. The case to be clearly distinguished from that of Ex parte Edison (C. D. 1889, 234, 49 O. G. 1691), a case relating to specific improvements. Id.

7. 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. Ex parte Barrett, 56 O. G. 930, C. D. 1891.

8. 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. *Washburn & Moen Mfg. Co. v. Beat 'Em All Barbed Wire Co., 58 O. G. 1555, C. D. 1892.

9. Where pending a long interference as to a broad invention the applicant takes out a patent for a narrow or specific part of that broad invention, which patent states on its face that it is a division of the broad application and which patent describes but does not

claim the broad invention, *held*, that the earlier narrow patent should receive a limited construction in accordance with its apparent scope, and that the later broad patent is valid. *Electrical Accumulator Co. v. Brush Electric Co., 61 O. G. 886, C. D. 1892.

10. Where two patents exist for the same invention, the applications for which were filed on the same day by the same inventor, the patents were issued on the same day, and are owned by the same person, and the testimony shows that it can never be ascertained which patent actually first received the final signature which rendered it a complete and legal deed, *held*, that there are no known presumptions which can be resorted to upon which to base a finding as to which of the two is the earlier patent, and *held* that the owner of both patents has the right to elect the one upon which it will rest its title to a monopoly, even though that one be the one having the higher or later serial number. *Id.

11. *Held*, also, that in such case, in connection with the finding of validity of the one patent, the court should adjudge the other patent to be inoperative and should prohibit its assignment or sale. *Id.

12. *Held* that in such case, where the patentee was the actual and first inventor of the whole of the described and patentable thing which is specified in the patent, the sections of the statutes in regard to disclaimer were not intended to apply and do not apply. *Id.

13. Where the inventor of a machine for coupling the links of drive-chains simultaneously filed two applications for patents, one for a machine for an endwise and one for a machine for a sidewise thrust of the coupling-bar, and had a patent issued on the first machine, *held*, that it was not afterward entitled to a patent on the second machine, as it was only a matter of mechanical skill, and not invention, to adapt the endwise to the sidewise thrust. *Fassett v. Ewart Mfg. Co., 64 O. G. 439, C. D. 1893.

14. A patent having been granted for a machine and for a dish made by it, a subsequent patent for the process was held invalid. *Oval Wood Dish Co. v. Sandy Creek (N. Y.) Wood Mfg. Co., 60 Fed. Rep. 285 (1894).

(Miller v. Eagle Co., 66 O. G. 845, declared "the latest and most pronounced case on this subject.")

15. Of two patents for the same invention issued to the same inventor the later is void. (Suffolk Co. v. Hayden, 3 Wall. 315; James v. Campbell, 21 O. G. 337, 104 U. S. 382; Mosler Safe Co. v. Mosler, 43 O. G. 1115, 127 U. S. 355; McCreary v. Pennsylvania Canal Co., 57 O. G. 1131, 141 U. S. 467; Underwood v. Gerber, 149 U. S. 224, 63 O. G. 1063.) *Miller v. Eagle Mfg. Co., 66 O. G. 845, C. D. 1894.

(Decision of United States supreme court.)

16. The reason for the rule established by the above-cited cases is that the power to create a grant is exhausted by the first patent, and for the further reason that a new and later patent for the same invention would operate to extend or prolong the monopoly beyond the period allowed by law. (Odiorne v. Amesbury Nail Factory, 2 Mason, 28, 1 Robb, 300.) *Id.

17. The result of the authorities on this point of law is that no later patent can be issued for an invention actually covered by an earlier patent, especially to the same patentee, although the terms of the claims in the two patents may differ and the later patent may contain the broader claims, but that where the later patent covers matter described in the earlier patent, which, however, is essentially distinct and separable from the invention covered by the earlier patent and claims made thereunder, its validity may be sustained. *Id.

18. In the last class of cases just mentioned it must distinctly appear that the invention covered by the later patent was a separate invention distinctly different and independent from that covered by the first patent. It must consist in something more than a mere distinction of the breadth or scope of the claims of each patent. *Id.

19. Nor, in view of the aforecited authorities, can the proposition be sustained that whether the invention shall be protected in part of its *features* by one patent and as to the rest by another, or shall be completely protected by a single patent, is a matter which concerns solely the patent office and the inventor. *Id.

20. While it is settled law that a process and its product, an apparatus and its product and an improvement on a patented invention each may be patented in separate later patents, yet in each case the invention must be clearly distinct from and independent of the one previously patented. (Sewall v. Jones, C. D. 1876, 256, 9 O. G. 47, 91 U. S. 190; Merrill v. Yeomans, C. D. 1877, 279, 11 O. G. 970, 94 U. S. 94.) *Id.

21. The invention covered by the first patent (No. 222,767) consists in a spring which serves the double purpose of *lifting* or *holding* down the plows at will, the patent thus embrac-

ing both the lifting and depressing operations and the later patent (No. 242,497) consists in the identical spring used for the single purpose of the *lifting* operation. The subject-matter being the same, no patentable distinction can be drawn between the two patents, and the rule above announced can have no application to the case. *Id.

22. The invention in the earlier patent covered the means by which the results sought by the later patent were to be accomplished, and, as it is settled law that the patentee of a device is entitled to all its uses whether described or not (Roberts v. Ryer, C. D. 1876, 439, 10 O. G. 204, 91 U. S. 105; Stow v. Chicago, C. D. 1882, 131, 21 O. G. 790, 104 U. S. 547), the increased lifting effect of the spring sought to be covered in the later patent being clearly shown and described and claimed in the earlier patent, it follows that it was not the subject of a later patent. *Id.

23. The claims in both patents might have been made in either patent, as they covered one and the same invention, and to hold that the second patent, which was for one part of the invention or in its function, after such part or its action had been covered by a prior patent, presents distinct invention, or that both are valid for the same invention, would involve the drawing of distinctions too refined for the practical administration of the patent law. *Id.

24. The decision of the supreme court in the case of Miller v. Eagle Mfg. Co. (66 O. G. 845) interpreted and *held* that it did not change the law. It simply declared a second patent void on the plain ground that it was for the same invention as the first, and the effect of it, if sustained, would be to prolong the monopoly beyond the period intended by the patent law. *Fenton Metallic Mfg. Co. v. Office Specialty Mfg. Co., 68 O. G. 1390, C. D. 1894.

25. Patent to Emile Berliner, No. 463,569, dated November 17, 1891, is void because one of the functions of the device shown in the patent No. 233,969, dated November 2, 1880, to the same inventor — namely, the function of transmitting articulate speech — is identical with the sole object or function of the device covered by the patent of 1891, and the device for effecting the transmission is identical in both patents. (Miller v. Eagle Mfg. Co., 66 O. G. 845, 151 U. S. 186.) *United States of America v. American Bell Telephone Co., 69 O. G. 1778, C. D. 1894.

26. Patent No. 238,315 to Elihu Thomson and Edwin J. Houston, issued March 1, 1881, examined and *held* an unwarrantable prolongation of the just monopoly conferred by letters patent No. 223,659 to the same inventors, for substantially the same invention, issued January 20, 1880. Thomson-Houston Electric Co. v. Western Electric Co., 73 O. G. 1123, C. D. 1895.

27. The fact that a patent was granted for a specific means for operating quick-action air-brakes after the grant of a pioneer patent describing and illustrating a different means is, in effect, a ruling by the patent office that the subsequent patent does not infringe the pioneer patent, and such a decision, while not conclusive, is entitled to great respect. *Boyden Power Brake Co. v. Westinghouse Air Brake Co., 73 O. G. 1857, C. D. 1895.

28. The issuing of a subsidiary patent for specific improvement during the pendency of an application for a primary patent held in the patent office without any fault of the inventor does not invalidate the primary patent subsequently issued. *Thomson-Houston Electric Co. v. Winchester Avenue R. Co., 73 O. G. 2155, C. D. 1895.

29. Where a patent for improvements issued with a reference to a prior application and a disclosure of the broad original invention contained therein, it is not a bar to a subsequent patent for the broad invention issued pursuant to the said prior application. (Distinguishing the familiar rule repeated in Miller v. Eagle Mfg. Co., 66 O. G. 845, 151 U. S. 186.) *Thomson-Houston Electric Co. v. Elmira and Horseheads Ry. Co., 74 O. G. 144, C. D. 1896.

30. The grant of a later patent to defendants for a machine designed to accomplish the same result as that of the patents in suit raises the presumption that there is a substantial difference between them, and that the later is not an infringement of the earlier patents. *Illinois Steel Co. v. Kilmer Mfg. Co., 74 O. G. 1282, C. D. 1896.

31. When a prior application for a generic invention has been delayed in the patent office without the fault of the applicant the grant of a subsequent patent for a specific, distinct and separate improvement upon the principal invention will not invalidate a patent subsequently issued upon the original application. (Miller v. Eagle Mfg. Co., 66 O. G. 845, 151 U. S. 186; Thomson-Houston Electric Co. v. Winchester Ave. R. Co., 73 O. G. 2155.) *National Machine Co. v. Wheeler & Wilson Mfg. Co., 74 O. G. 1588, C. D. 1896.

32. Letters Patent No. 424,695, to Charles J.

Van Depoele, is not invalid because of the prior issuance of Patent No. 397,451, for certain improvements on the broad invention covered by the first-named patent, the application for which was filed more than a year before that of Patent No. 397,451. *Thomson-Houston Electric Co. v. Ohio Brass Co., 80 O. G. 654, C. D. 1897.

33. Where a patent for mere improvements was granted during the pendency of an earlier application for the broad invention, *held*, that a patent subsequently granted on the earlier application is not invalid, though the elements covered by its claims were shown and described but not claimed in the earlier patent. (Cases of Suffolk v. Hayden, 3 Wall. 315, and Barbed Wire Patent, 58 O. G. 1555, 143 U. S. 280, discussed.) *Id.

34. Where a patent for an improvement issues while the application for the broad invention is pending in the patent office, *held*, that the monopoly in the broad invention is not extended. The patent for the improvement expires in seventeen years. After that any one may use the improvement without infringing the patent issued upon it. If he uses the improvement without a license to use the main invention, he is liable for the infringement, not of the patent for the improvement, but of the patent for the main invention, and in estimating the damages for the same the value of the main invention, and not that of the improvement, would be the basis for estimating the damages. *Id.

35. It can make no difference in considering this question whether the patent for the improvement issues to the patentee of the main invention or to another. The right of the public to use the improvement when the patent on it expires is exactly the same whether the patentees of the two inventions are the same or not, because in each case the improvement can only be used with the license of the patentee of the main invention. *Id.

36. Claims 6, 7, 8, 12 and 16 of Patent No. 495,443, granted to the administrators of Charles J. Van Depoele, construed and *held* to be void because the invention covered thereby had been previously claimed by the same inventor in Letters Patent No. 424,695, dated April 1, 1890. *Thomson-Houston Electric Co. v. Hoosick Ry. Co., 80 O. G. 967, C. D. 1897.

37. Where two patents are intended to and do secure to the patentee the same general inventions, differing only in the scope of the claims, the second patent is inseparably involved in the matter embraced in the first patent and is void. (Citing Miller v. Manufacturing Co., 151 U. S. 198, 66 O. G. 845.) *Id.

II. Different Inventors.

38. Under rule 41, Rules of Practice of the patent office, as interpreted by Ex parte Blythe (30 O. G. 1321) and Ex parte Herr (41 O. G. 463), two patents in which the description was substantially the same, No. 348,072 for a composition for transfer surfaces for producing copies of type-writing, and No. 348,073 for a process of reproducing surfaces for type-writing and manifolding, were obtained with a single claim on each, instead of one patent with two different claims, each embodying one of the above inventions. Suit for infringement was instituted upon Patent No. 348,073 alone, which patent was held void in view of the state of the art. *Underwood v. Gerber, 48 O. G. 116, C. D. 1889.

39. Where, after priority had been adjudicated by the patent office to one of two parties in an interference proceeding, and a patent had been issued in accordance therewith, it appeared that the circuit court, upon a bill in equity filed by the other party under section 4915 of the Revised Statutes, had decreed that the plaintiff was the original, first and sole inventor of the invention in controversy and entitled to a patent therefor, and that a certified copy of said decree had been filed in the patent office in accordance with the provisions of the statute referred to, *held*, that the commissioner was authorized by such adjudication to issue a patent to the plaintiff, notwithstanding it appeared that defendant had duly appealed to the supreme court of the United States and had filed a bond for the payment of costs. Daniels v. Morgan, 54 O. G. 113, C. D. 1891.

40. Where a suit was instituted under Revised Statutes, section 4918, to procure an adjudication of invalidity of a patent on the ground of interference with plaintiff's prior patent, and where the defendant filed an answer denying the validity of the prior patent and affirming the validity of his own patent, and where proofs were taken by both parties, *held*, that the defendant may obtain affirmative relief under that provision of the statute that "the court, on notice to adverse parties, . . . may adjudge and declare either of the patents void;" and *held*, further, that the court will refuse a motion to dismiss by the plaintiff, if it appears that the granting of such motion will prejudice the rights of the defendant.

*Electrical Accumulator Co. v. Brush Electric Co., 55 O. G. 573, C. D. 1891.

41. In such a suit questions of anticipation, novelty and duration of the patent will not be considered, as they are matters for a suit for infringement and not an interference suit. *Id.

42. Where the bill prays that defendant's patent may be adjudged void by reason of an interference with a prior patent, and the answer prays that the plaintiff's patent may be declared void, the suit cannot be regarded as a suit for infringement. *Id.

43. Allegations that plaintiff's assignor obtained a patent; that defendant obtained patents of later date which interfere with plaintiff's rights; that defendant is making and selling machines under his patents, and that he has in other ways disturbed the plaintiff in the use and enjoyment of the privileges conferred by his patent, sufficiently charge interference. *Stonemetz Printers' Machinery Co. v. Brown Folding Machine Co., 56 O. G. 263, C. D. 1894.

44. The invention which a man patents is that which he claims, and patents interfere under section 4918, Revised Statutes, only when they claim in whole or in part the same invention. (Distinguishing Garratt v. Seibert, 15 O. G. 383, 98 U. S. 75.) *Nathan Mfg. Co. v. Craig, 58 O. G. 1093, C. D. 1892.

45. Patents interfere under section 4918, Revised Statutes, only when they claim in whole or in part the same invention. *Dederick v. Fox, 63 O. G. 1963, C. D. 1893.

46. The question of interference between patents is determined by the claims, not by the general appearance and function of machines shown but not claimed. *Id.

47. Patents interfere only when they claim the same invention in whole or in part, and in a proceeding under section 4918 the court cannot go beyond the claims and consider generally the two patents as a whole. An interference does not exist, within the meaning of the statute, between a patent having a dominant broad claim and a junior patent having a subordinate specific claim. *Stonemetz Printers' Machinery Co. v. Brown Folding Machine Co., 64 O. G. 1135, C. D. 1893.

48. The patent claimed by complainant Bradley was for a process of separating metals from their ores, in which fusion by external heat was dispensed with and an electric current made to perform the double function of first fusing the ore and then separating the metal by electrolysis. The patents issued to defendants Cowles and others were for a process of smelting ore by electricity and means for accomplishing the same, wherein heat was distributed through the mass of ore by the current flowing through a granular conductor of high resistance. These patents were all filed as exhibits with the plea. *Held*, that the facts as presented are not sufficient to show interference between the Bradley and Cowles patents, whatever might be developed by expert evidence under an answer, and the plea will be overruled. *Lowry v. Cowles Electric Smelting and Aluminum Co., 65 O. G. 295, C. D. 1893.

49. When the question decided in the patent office is one between contesting parties as to priority of invention, the decision there made must be accepted as controlling upon the question of fact in any subsequent suit between the same parties, unless the contrary is established by testimony which in character and amount carries thorough conviction. (Morgan v. Daniels, 67 O. G. 811, 153 U. S. 120.) *Appleton v. Ecaubert, 71 O. G. 1617, C. D. 1895.

50. The printed copy of the testimony in the interference proceedings before the patent office and the opinion of the commissioner of patents *held* to be irrelevant, as a suit under section 4918, Revised Statutes, is an independent one, although between the same parties as in the patent office proceeding. *Id.

51. *Held*, further, that the opinion of the commissioner was not a decree and was not the finding of facts which a court is frequently called upon to make. It was the argument and recital of the considerations which led the commissioner to his conclusions and a statement of the effect of the testimony upon his mind, and was not a part of the judgment record. (In re Buckingham's Appeal from Probate, 60 Conn. 148.) *Id.

52. When the decision of the office is in favor of a junior applicant and a patent issues to him, in a subsequent suit under Revised Statutes, section 4915, the burden of proof is shifted, and it then devolves upon the senior applicant to show either that his invention antedates that of the patentee or that the latter never made the invention. *Standard Cartridge Co. v. Peters Cartridge Co., 78 O. G. 621, C. D. 1897.

INTERLOCUTORY APPEAL.

(See APPEAL.)

INTERNATIONAL CONVENTION.

(See TREATY; TRADE-MARKS—TREATY.)

1. This treaty is a reciprocal one. Each party to it covenants to grant in the 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 infraterritorially. It is therefore not self-executing, but requires legislation to render it effective for the modification of existing laws. †Opinion of the Attorney-General of the United States, 47 O. G. 398, C. D. 1889.

(See *Appert v. Parker, 75 O. G. 120, C. D. 1896; also "Trade-marks—Treaty.")

2. The international convention of March 20, 1883, to which, among others, Spain and France and the United States were parties, has not the force of a statute in the United States. (Citing opinion of Attorney-General Miller, April 5, 1889, 47 O. G. 398.) *Electrical Accumulator Co. v. Julien Electric Co., 64 O. G. 559, C. D. 1893.

INVENTION.

(See PATENTABILITY.)

INVENTOR, DECEASED.

(See PATENT TO DECEASED INVENTORS.)

ISSUE IN INTERFERENCE.

(See INTERFERENCE.)

ISSUE OF PATENT.

(See WITHDRAWING FROM ISSUE; WITHHOLDING FROM ISSUE.)

JOINDER OF INVENTIONS IN AN APPLICATION.

(See APPLICATIONS, JOINT AND SOLE; DIVISION OF APPLICATION; INTERFERENCE—DIVISIONAL APPLICATION and JOINT AND SOLE APPLICATIONS; JOINT INVENTIONS.)

1. One piece of mechanism may perform its function upon the material or subject of its action which at once falls or is delivered into the operation of another mechanism without the existence of any relation or combination between the two, and without the possibility of the separate action of the two constituting a patentable method or process. Ex parte Herr, 41 O. G. 463, C. D. 1887.

2. The question whether two or more inventions may be joined in single letters patent is not the same when presented for consideration by the courts as when [illegible]es in the administration of the patent law in the patent office. In the courts the maxim *ut res magis valeat quam pereat* finds great favor, and it would require an express rule of law or an inexorable necessity to justify a court in declaring void a patent issued by the office to a patentee who is the inventor of new and useful inventions and who has taken out his patent in good faith. But in administering the patent laws the large discretion vested in the commissioner of patents should be exercised in the matter of directing what inventions should be comprehended in a single patent as in all other particulars, so as to subserve the great purposes of the patent system and to protect inventors. Id.

3. While, possibly, the courts have never declared a patent void because comprehending more than one distinct and separate invention, there are numerous *dicta* to that effect. But there are numberless decisions holding valid patents, and there have continuously existed for years office rules authorizing their issuance, where the two or more inventions bore clear and distinct relation to each other, as where they were "connected in design and operation," etc. *Held*, that "connection and operation," the "mutually contributing to produce a single result," must be the proximate, immediate, direct act of the several inventions, respectively, not a remote one existing in the mind of the person who uses them, and the contribution must be such as to produce a resultant operation proceeding from all the inventions comprehended, such as would be manifest to one skilled in the art who should be called upon to construct or operate them. Id.

4. Whenever the original invention is such that it could properly be the subject of a patent, and the organism has not changed in its structure or identity, it is believed that several improvements on its parts may be embraced in one patent, providing they co-operate in affecting the whole organism, improving it as a whole, and provided, also, invention and art have not subsequently so advanced as to select

the improved parts as distinct subjects of invention, art and manufacture. Id.

5. This does not exclude the idea that such improvements upon a distinct organism could not have been united in a single original patent, provided it retained its identity and was not affected by the advance in arts and invention. But since the repeal of section 5, act March 3, 1837, by section 53, act July 8, 1870, the separate re-issue patents allowed for different parts of the invention are necessarily for divisional parts, for which separate patents might have originally issued. In cases of new combinations, in which some of the elements are new, claims for the combination and for the new elements may be united in one patent, because they all properly constitute one invention, and in such a case the applicant might embrace the claims for the new elements without making claim to the combination, for he is not required to do the latter, and by omitting the combination he would dedicate it to the public. But this is only true of elements new generically, and not of claims for mere improvements upon old elements which can be used and applied in other relations in the arts. Id.

6. An inventor who proceeds to invent a machine designed solely to carry out a particular process, and the only function of which is to execute that process, is entitled to protection. A process which is distinct and separate from the machine does not lose its identity because of any course pursued by the inventor in prosecuting his claims for a patent, or from the fact that he may not at the time of completing his machine have been fully conscious that he had also invented the process. If, at any time before he comes to the office or takes out his patent, he discovers or becomes conscious of the fact that his invention is of a twofold character—viz., that it constitutes both the machine and the process which it executes—and prepares his application accordingly, there can be no reason for holding that he has merged the two inventions or that the two are in fact one. Ex parte Young, 46 O. G. 1635, C. D. 1889.

7. That two or more inventions capable of joint use, although not always used conjointly, may be joined in the same patent is beyond question. Ex parte Fefel, 57 O. G. 409, C. D. 1891.

8. It does not follow, however, that the patent office must or will permit such inventions always to be thus joined. Such permission will be given if no wider range of search is required for all than for one. Id.

JOINT INVENTIONS.

(See APPLICATIONS — JOINT AND SOLE; EMPLOYER AND EMPLOYEE; INTERFERENCE — JOINT AND SOLE APPLICATIONS; JOINDER OF INVENTIONS, *supra*.)

1. The mere fact that two or more persons unite in an application for a patent as the product of their joint inventive efforts creates a very strong presumption that the device sought to be patented is the result of their united ingenuity, and to overthrow this presumption the evidence should be clear and unequivocal. (Gottfried v. Philip Best Brewing Co., 17 O. G. 675.) *Consolidated Bunging Apparatus Co. v. Woerle, 38 O. G. 1015, C. D. 1887.

2. If one conceives the entire invention and another makes a suggestion of practical value which the first one failed to think of, but which is needed to make the conception a success, this will be sufficient to constitute them joint inventors. *Id.

3. Where two parties work together in the making of an invention, each making suggestions to the other, the invention covered by a joint patent will generally be considered as the result of their joint efforts or contributions. *Schlich & Field Co. v. Chicago Sewing Machine Co., 46 O. G. 1394, C. D. 1889.

4. Where the patentee applied to a certain person as a mechanic who knew how to make "reversers," and who understood how to adapt them to machines of any description, to make a reverser for his fulling-machine, giving him a plan of the latter, and the mechanic successfully applied a reverser which he had previously applied to a washing-machine, and it did did not appear that the patentee had given him any instructions or that the latter worked under his supervision, *held*, that the patentee was not solely entitled to the credit of the invention, but that the mechanic was at least a joint inventor, even if the combination were patentable. *Royer v. Schultz Belting Co., 50 O. G. 557, C. D. 1890.

5. It is settled that letters patent to parties as joint inventors are *prima facie* evidence that the invention therein described was joint. (Hotchkiss v. Greenwood, 4 McLean, 456.) *Page Woven Wire Fence Co. v. Land, 49 Fed. Rep. 936 (1891).

JUDICIAL NOTICE.

(See PATENTS — CONSTRUCTION OF.)

1. A court will not take notice, on demurrer, of the contents of printed publications, such

as mechanical dictionaries, encyclopedias, etc., as the same do not fall within the category of things of general knowledge of which courts take judicial notice, but can more properly be considered at the final hearing, with an opportunity on the part of the complainant to explain or rebut them. *Kaolatype Engraving Co. v. Hoke, 39 O. G. 589, C. D. 1887.

2. 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. *Aron v. The Manhattan Ry. Co., 49 O. G. 1365, C. D. 1889.

3. It appearing that in the former decisions of the office judicial notice was taken of the fact that the telephone had been in public use for more than two years prior to the filing of the application under consideration, *held* no error. Ex parte Meucci, 51 O. G. 299, C. D. 1890.

4. In the absence from the record of references showing exactly certain features which were old, *held*, that the rights of the public demand that judicial notice shall be taken of what is well known to be old. (Phillips v. Detroit, 111 U. S. 604.) Ex parte Jones, 49 MS. D. (3 G. W. D.) Dec., 1891 (Frothingham, Acting Com'r).

5. A patent may be held void on demurrer to a bill by the court's taking notice, from common knowledge, that the structure is old. *Wall v. Leck, 66 Fed. Rep. 552.

6. Where the device used is within common knowledge, judicial cognizance may be taken of it. *Black Diamond Coal Mining Co. v. Excelsior Coal Co., 70 O. G. 1797, C. D. 1895.

7. The court did not err in assuming judicial knowledge of the construction and operation of grain elevators and in holding that these elevators contained practically the same elements as the grain-transferring apparatus of the Richards patent. *Richards v. Chase Elevator Co., 73 O. G. 1710, C. D. 1895.

8. The court has legal right and it is its duty to take judicial notice of such matters of science, art and mechanism and things of common knowledge as are involved in cases brought before it for determination. *Carter Machine Co. v. P. H. Hanes & Co., 74 O. G. 1277, C. D. 1896.

9. In considering the question of the validity of a patent on its face the court may take judicial notice of facts of common and general knowledge tending to show that the device or process patented is old or lacking in invention, and the court may refresh its recollections of what facts were of common knowledge at the time of the application for the patent by reference to printed matter which is known to be reliable and to have been published prior to the application for the patent. *American Fibre Chamois Co. v. Buckskin Fibre Co., 75 O. G. 833, C. D. 1896.

JURISDICTION.

(See APPEALS; EQUITY; INJUNCTION; PATENT OFFICE PRACTICE; SUITS FOR INFRINGEMENT.)

I. PRIMARY EXAMINER.
II. EXAMINER OF INTERFERENCES.
III. EXAMINERS-IN-CHIEF.
IV. ASSISTANT COMMISSIONER.
V. COMMISSIONER.
VI. SECRETARY OF THE INTERIOR.
VII. FEDERAL COURTS.
VIII. COURTS, IN GENERAL.
IX. UNITED STATES SUPREME COURT.

I. PRIMARY EXAMINER.

1. The office of primary examiner in the patent office is continuing, and does not change with the person of the incumbent. An application is not assigned to the examiner as an individual, but to the division over which he presides, and notwithstanding the resignation of an incumbent who has taken action upon a case and the appointment of his successor, the jurisdiction continues unaffected by the change. Ex parte Fredericks and Burns, 40 O. G. 691, C. D. 1887.

2. An application continues in the patent office, and in acting upon it the primary examiner is the vice-representative of the commissioner, and until reversed or modified his action or decision is that of the commissioner. This jurisdiction of the primary examiner continues until the case is taken out of his division by the superior jurisdiction operating through the rules of the office or by special order. Id.

3. An examiner has jurisdiction until the case is allowed and passed to issue. It is not until the examiner signs the file-wrapper and forwards the application to the issue division that he can be said to have rendered a favorable decision. He may have formed an opin-

ion in its favor and expressed an oral or even a written suggestion in the same direction; but these do not constitute his formal favorable decision. (Citing Ex parte Starr, C. D. 1879, 91; Ex parte Buell, 26 O. G. 437.) Id.

4. When the examiner, after action upon a case, had advised the applicant that his application "was now in condition for allowance, but required a new drawing," but had not signed the file-wrapper and forwarded the case to the issue division, *held* this did not deprive the successor in office of the primary examiner of jurisdiction to reconsider and reject the application. Id.

II. Examiner of Interferences.

5. The examiner of interferences is a primary examiner; but under the organization of the patent office the examiner in charge of the interference possesses no jurisdiction over the question of the patentability of the inventions or the declaration of interferences, but he has exclusive jurisdiction of the trial of the issues when declared. Faure v. Bradley, 44 O. G. 945, C. D. 1888.

III. Examiners-in-Chief.

6. The examiners-in-chief have no jurisdiction in case of appeal from examiner of interferences in public use proceedings. Ex parte Finch, 40 O. G. 1027, C. D. 1887.

7. Examiners-in-chief have no jurisdiction of the question of division, which is a matter appealable to the commissioner. Ex parte Gillette, 44 O. G. 819, C. D. 1888.

8. Under the organization of the various tribunals of this office and the system in force, it follows as a necessity that the recommendation which the examiners-in-chief may make under rule 139 must relate exclusively to the particular matter brought before them on appeal, or over which they have jurisdiction. Id.

9. A recommendation or statement incorporated in the decision of the examiners-in-chief touching the question of division, which is a matter appealable to the commissioner and not to the examiners-in-chief, is unwarranted, and in effect would contravene the practice settled by the present commissioner. Such practice should not be challenged or repudiated by a subordinate tribunal. Id.

10. The examiners-in-chief have exclusive jurisdiction of the question of new matter on appeal from the examiner. Ex parte Rasor, 41 MS. D. (1 G. W. D.), Sept., 1889 (Mitchell, Com'r).

11. The board has no authority to decide the question of public use, but may call attention thereto, and no appeal lies from their refusal to act under rule 126. (Schmiedl v. Walden, 56 O. G. 1503.) Hill v. Hodge, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

IV. Assistant Commissioner of Patents.

12. The duties of the assistant commissioner are necessarily the same in kind as those of the commissioner and such duties are directly prescribed by statute. Ex parte Hughes, 56 O. G. 1448, C. D. 1891.

13. The assistant commissioner, under assignment by the commissioner, has authority to hear and determine any *quasi*-judicial question on appeal, and his determination is a legal determination thereof. Hisey v. Peters, 76 O. G. 333, C. D. 1896.

V. Commissioner of Patents.

(See Secretary of the Interior, *infra*.)

14. While the commissioner of patents is authorized to establish rules and regulations for taking depositions, he is necessarily compelled to proceed under and in accordance with the laws of congress. He has no power to legislate as to the competency of witnesses nor as to the admissibility of evidence. Such rules of evidence as congress establishes or recognizes for courts of general jurisdiction must be deemed to be prescribed for officers and tribunals of inferior and limited powers and jurisdictions, unless they are expressly excepted or special rules are made for them. While sections 876 and 877 (Rev. Stats. of the D. C.) do not specifically name the patent office, and may not be held to embrace it as a court or tribunal, still there has never been any law of evidence prescribed for it, except as it has been prescribed for the courts. In other words, the law of evidence recognized in the courts for their guidance, whether common law, statute law, or both, becomes, *proprio vigore*, the law for the patent office and other bureaus, except when otherwise provided. Marsh v. Rein, v. Ruppel, 43 O. G. 1453, C. D. 1888.

15. The commissioner of patents has no control over witnesses. Their production, attendance and conduct are under the control of the United States courts. Osgood v. Badger, v.

Bennett, 44 O. G. 1065, C. D. 1888. See, also, Kelly v. Park, 81 O. G. 1931, C. D. 1897.

16. The duties to be performed by the commissioner of patents are divisible into two classes, viz.: (1) duties imposed by congressional legislation, and (2) duties imposed only by departmental rules and regulations emanating from or authorized by the secretary of the interior. †Houston v. Barker, v. Bannister, v. Eastman, 44 O. G. 697, C. D. 1888.

17. The discretion of the commissioner of patents cannot be controlled by the secretary of the interior in the performance of judicial or *quasi*-judicial duties. †Id.

18. The determination of questions concerning the admissibility of evidence in interference proceedings involves the exercise of judicial functions. †Id.

19. Authority to suppress incompetent evidence is conferred upon the commissioner by the statutes and not by any departmental regulation. †Id.

20. The commissioner has no equitable jurisdiction over the rights of parties claiming under assignments and grants of inventions and patents. He cannot set aside or vacate such instruments, nor can he recognize equitable rights growing out of transactions between inventors and applicants and other parties. McDonough v. Gray, 46 O. G. 1295, C. D. 1889.

21. Rule 144 confers upon the commissioner of patents jurisdiction to rehear the decisions of his predecessor when grounds other than those of fraud, error in computation or newly-discovered evidence are alleged. Daniels v. Morgan, 47 O. G. 811, C. D. 1889.

22. Rule 144 had its origin in an executive order, was transformed into a judicial rule when the commissioner of patents was, by act of July 1, 1870, substituted for the supreme court of the District of Columbia as the tribunal having final jurisdiction, and at a later date the office of commissioner was recognized as a continuing one, placed upon the same footing as a court, and given the power of granting new trials. Id.

23. The commissioner of patents exercises the function of a court in determining the question of priority in interference. Id.

24. The question of division has always been held to pertain to the administrative side of the functions of the commissioner. Ex parte Chambers, 51 O. G. 1943, C. D. 1890.

25. Request that the commissioner pass upon the patentability of a claim, which question had been previously decided by the examiner, denied. Walker v. Diescher and McGill, 56 O. G. 927, C. D. 1891.

26. The commissioner of patents has no jurisdiction to alter the patent by a certificate of correction, and such certificate is wholly void. *Edison Electric Light Co. v. United States Electric Lighting Co., 61 O. G. 564, C. D. 1892.

27. The supervisory authority of the commissioner should be exercised under section 481 of the Revised Statutes only under extraordinary circumstances. Duncan v. Westinghouse, Jr., 66 O. G. 1005, C. D. 1894.

28. The duties of the commissioner of patents are in part administrative and in part of a judicial nature. In the discharge of the latter duties he acts as the direct representative and agent of the law, subject to no appeal excepting to the tribunals expressly designated by statute. The rule limiting the right of an administrative officer to review his predecessor's decision to the three cases specified may be applicable to the commissioner in his capacity as an administrative officer; but it is clear that it is not binding upon the commissioner in the discharge of his official duties. *Daniels v. Morgan, 67 O. G. 811, C. D. 1894.

29. Notwithstanding that the law has provided certain official agencies to advance the work of the patent office, the commissioner is the head of the bureau, and if there be any reasonable ground within his knowledge why a patent should not issue, whether specific objection be raised by the examiners or not, it is his duty to refuse the patent; and it is especially his duty to do so when the primary examiner and the examiners-in-chief have found such ground for refusal to exist. *Drawbaugh v. Seymour, Com'r of Patents, 77 O. G. 313, C. D. 1897.

VI. Secretary of the Interior.

30. 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 the judicial functions conferred upon him by law the secretary has no jurisdiction. †Petithomme v. Bedbury, 52 O. G. 605, C. D. 1890.

31. The action of the commissioner in an interference proceeding refusing to reject certain evidence filed in behalf of one of the parties

clearly involved the judicial function imposed upon him, and from such action no appeal lies to the secretary. †Id.

32. While it may be true that the action of the commissioner in refusing to make an order directing one of the parties to file a certain deposition taken in his behalf belonged to that class of actions which involved the exercise of ministerial functions only, yet, in the absence of a rule giving either party the right to file and use the testimony upon payment of costs for taking the same, with appropriate penalties for obstructing the filing thereof, there has been no such disregard in the present case of any rule regulating the conduct of the business of said office as requires the interference of the secretary in the exercise of his supervising authority. †Id.

33. 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.) †Ex parte Noakes, 66 O. G. 575, C. D. 1892.

34. The secretary of the interior has no jurisdiction over such acts of the head of the patent office as involve the exercise of judicial functions conferred upon him by law. †Warner v. Stimson, 78 O. G. 1901, C. D. 1887.

35. The decision of the question as to whether an interference shall be allowed to proceed or not involves a judicial or *quasi*-judicial determination, and the secretary has no appellate jurisdiction. †Jenkins v. Jenkins & Armat, 78 O. G. 1902, C. D. 1897.

36. The secretary has no authority to interterfere to determine whether or not any one may be a proper party to an interference. †Id.

VII. Federal Courts.

(See Courts, in General, *infra;* Practice in the Courts.)

37. Parties to the suit are citizens of the same state. To the extent of questions arising out of the patent and defendant's acts in alleged infringement thereof the United States courts have jurisdiction. *Willis v. McCollin, 38 O. G. 1017, C. D. 1887.

38. Over controversies arising out of license contracts they have not. *Id.

39. The $2,000 limitation placed upon the jurisdiction of the court under the act of March 3, 1887, does not apply to patent cases or to suits for the infringement of patents. *Miller Megee Co. v. Carpenter, 43 O. G. 1118, C. D. 1888.

40. Under the act of March 3, 1887, a defendant can no longer be sued outside of the district of which he is an inhabitant, unless he consents or waives his right to object, except where the jurisdiction of the circuit court is founded only on the fact that the action is between citizens of different states. *Halstead v. Manning, Bowman & Co., 44 O. G. 344, C. D. 1888.

41. Under the act of March 3, 1875, the circuit courts have cognizance of all suits at law or in equity where the amount in dispute is sufficient. *The United States v. The American Bell Telephone Co., 45 O. G. 1311, C. D. 1888.

42. The circuit courts have jurisdiction of suits brought to recover penalties imposed by the copyright laws of the United States. *Taft v. Stephens Lithographing and Engraving Co., 47 O. G. 142, C. D. 1889.

43. Where a suit was brought to restrain defendants from unlawful competition in business and the complaint alleged that the defendants were fraudulently selling an article in imitation of that of plaintiff by using labels, bottles, etc., in imitation of those previously used by the plaintiff, and it appeared that the patent for the design for such bottles, etc., had expired, *held* that, whether the defendants were using the same in good faith or under false colors, the suit did not involve a federal question. *Société Anonyme de la Distillerie de la Liqueur Benedictine de l'Abbaye de Fecamp v. Cook, 50 O. G. 1298, C. D. 1890.

44. The circuit court of the district of New Jersey has no jurisdiction over the commissioner of patents in a suit brought under section 4915 of the Revised Statutes when it appears that he has not been served with process or that no appearance has been entered for or by him. *Illingworth v. Atha and Commissioner of Patents, 51 O. G. 803, C. D. 1890.

45. Where the defendant corporation, created under the laws of the state of New Jersey, desiring to transact business in Massachusetts, agreed as a condition precedent that it would submit to all lawful process in the manner required by the law applicable to foreign corporations enjoying such a privilege, and that such service should have the same effect as if the corporation existed therein, *held*, that it bound itself to submit to be sued within the state, the same as if it were a corporation or-

ganized under the laws of the state, and that upon the facts presented the circuit court had jurisdiction. *Consolidated Store Service Co. v. Lamson Consolidated Store Service Co., 51 O. G. 969, C. D. 1890.

46. The circuit courts have jurisdiction of a suit, as arising under the laws of the United States, even though one issue which may be raised in the case is whether the grant is still in force. *Rapp v. Kelling, 52 O. G. 1666, C. D. 1890.

47. Where one lives and has his factory and place of business in one district and also sells by an agent living in another district, he does not thereby become an inhabitant of the latter district within chapter 866, acts of 1888, and a bill against him for infringement cannot be maintained in such district by service of subpœna upon the agent. *Anderson v. Germain, 58 O. G. 1092, C. D. 1892.

48. Where a plaintiff's bill in equity is purely a bill for the infringement of patent-rights, asking for the usual relief in the usual form, and containing no suggestion of contract relations between plaintiff and defendant, the mere fact that the defendant's answer sets up an alleged contract gives the court no warrant to dismiss the case for want of jurisdiction on the ground that the rights of the parties are governed by contract. *White v. Rankin, 59 O. G. 1606, C. D. 1892.

49. In such a case the question is upon the infringement of the patent, and the subject-matter of the action is disclosed in the bill, the defendant's answer being in effect a mere denial of infringement, and raising an issue clearly within the jurisdiction of the court. *Id.

50. The word "inhabitant," as used in the act of March 3, 1887, ch. 373, sec. 1 (24 Stat., 552), corrected by the act of August 13, 1888, ch. 866 (55 Stat. 434), in the light of previous legislation upon the subject of original jurisdiction of the federal courts and of the connection in which it is used, *held* to be synonymous with "resident." *Bicycle Step-Ladder Co. v. Gordon, 65 O. G. 601, C. D. 1893.

51. It comprehends locality of existence, the dwelling place where one maintains his fixed and legal settlement, not the casual and temporary abiding place required by the necessities of present surrounding circumstances. A mere "sojourner" is not an "inhabitant" in the sense of the act. *Id.

52. The interpretation in Shaw v. Quincy Mining Co. (144 U. S. 444) of the word "inhabitant," as used in the act, followed. *Id.

53. The decision in United States v. Southern Pacific Ry. Co. (49 Fed. Rep. 297), not applicable to natural persons. *Id.

54. A corporation cannot be sued in the federal courts of a district other than in the state of its incorporation. *National Typewriter Co. v. Pope Manufacturing Co., 65 O. G. 755, C. D. 1893.

55. Upon a motion to dismiss a bill in equity for infringement of a United States patent by a receiver appointed by a state court, upon the ground that the complainant had not obtained leave to sue from the court making the appointment, *held*, that the general rule that a court will not entertain jurisdiction of a suit against a receiver appointed by another court until the appointing court has given its consent does not apply when the jurisdiction of the court in which the receiver is sued is conferred by federal laws. *Hupfeld v. Automaton Piano Co., 72 O. G. 287, C. D. 1895.

56. In a suit to restrain the infringement of a patent by a receiver appointed by a state court, *held*, that the federal courts will entertain jurisdiction of such suit, without leave of the state court first obtained, to enjoin individuals, even though they be officers of a state court, from acts of infringement. *Id.

57. The authority of a district judge when holding a circuit court under Revised Statutes, section 609, is co-extensive with that of any judge sitting in the same court, and the restrictions of Revised Statutes, section 719, relative to the granting of injunctions by district judges do not apply. *McDowell v. Kurtz, 78 O. G. 1104, C. D. 1897.

58. A demurrer setting forth that there is no jurisdiction in a circuit court of an interference case decided by the court of appeals of the District of Columbia; that the matter is *res adjudicata;* that the circuit court has no jurisdiction to determine the jurisdiction of the circuit court of appeals to entertain an appeal from the commissioner of patents, and that plaintiff and defendant are citizens of the same state, overruled. *Bernardin v. Northall and Seymour, Com'r of Patents, 78 O. G. 1740, C. D. 1897.

59. The bill establishing the court of appeals of the District of Columbia and permitting appeals thereto from the decision of the commissioner of patents in interference cases did not by implication repeal the statute providing remedy by bill in equity in a circuit court. *Id.

60. The decision of the court of appeals of the District of Columbia is not conclusive upon

a circuit court in patent matters, since the question of jurisdiction in such matters is not settled by a comparison of their relative dignity and importance. The appellate court merely affirms or reverses the commissioner in accordance with the general office of an appellate tribunal. The trial in a circuit court is a judicial hearing by original bill. *Id.

61. Where there was an assignment of an interest in an invention for which an application was prepared, which application while pending was divided and two patents issued thereon, a controversy whether the assignment applied to a third patent presented a federal question and the court had jurisdiction. *Puetz v. Bransford, 41 O. G. 353, C. D. 1887.

VIII. Courts, in General.

(See Federal Courts, *supra;* Practice in the Courts.)

62. The civil circuit courts of Indiana are courts of general jurisdiction, and may authorize the sale of property of decedents' estates whenever it is deemed for the interest of the parties concerned or necessary to wind up the administration. *May v. Logan County, 41 O. G. 1387, C. D. 1887.

63. The fact that the original order of court merely authorized a sale of the patent-rights does not invalidate the transfer therewith of accrued claims and demands of the estate arising thereunder if such transfer and sale are duly approved, ratified and confirmed by the court. The ratification and confirmation of the sale is equivalent to, and has the same legal effect and operation in, transferring the claims and demands included therein as if the court had previously directed their sale. *Id.

64. The court having jurisdiction to authorize the sale, and having exercised such authority, the propriety or validity of the sale is not open to examination in a collateral proceeding, though the record fail to disclose a strict compliance with all the provisions of the statute in making such sale. *Id.

65. Where a non-resident defendant corporation had appeared in a suit for infringement of letters patent, filed an answer, gone to proof and submitted the case for final hearing, it was *held* the court had jurisdiction to entertain the suit. *Morrison v. The Canton Surgical and Dental Chair Co., 49 O. G. 733, C. D. 1889.

66. Where the records show that the proceedings in the patent office are regular, and after the issue of the patent a question arises as to who is the true owner of the patent, the place to settle such controversy is in the courts. Ex parte Fowler & Hutton, 64 O. G. 1131, C. D. 1893.

67. An assignment being alleged fraudulent and void, in the absence of the parties who made it the court cannot decree that the commissioner of patents (he having been made a party defendant) shall expunge from the records of the patent office the record of the assignment as being there without authority, and declare the same null and void. Even if the court had jurisdiction, so far as the commissioner of patents was concerned, that jurisdiction was not complete over the subject-matter in the absence of the non-resident defendants, and no consent of the commissioner could give the court jurisdiction of the subject-matter. *Backus Portable Steam Heater Co. v. Simonds, Com'r of Patents, 66 O. G. 1893, C. D. 1894.

68. The jurisdiction of the supreme court of the District of Columbia to proceed in a suit under section 4915 can arise only in case of refusal of an application by the commissioner of patents or the supreme court on appeal from him. *Durham v. Commissioner of Patents, 69 O. G. 597, C. D. 1894.

69. The court of claims has no jurisdiction to hear and determine claims against the United States for mere torts. Some element of contractual liability must lie at the foundation of every action. *Schillinger v. United States, 69 O. G. 1505, C. D. 1894.

IX. United States Supreme Court.

70. When a patent is in force at the time of filing the bill and there was then time for procuring a preliminary injunction, the jurisdiction of the court is not defeated by the expiration of the patent before final decree. *Beedle v. Bennett, 39 O. G. 1326, C. D. 1887.

71. No question arising in a patent suit reviewable in this court can be regarded as finally settled, so as to establish the law for like cases, until it has been determined in this court. *Andrews v. Hovey, 42 O. G. 1285, C. D. 1888.

72. Where in a suit at law in a state court for the recovery of license fees under a written contract the plaintiff recovered damages, and the defendant by writ of error brought the suit into this court as involving a federal question, and the defendant in error moved in this court to dismiss the writ of error for want of jurisdiction, and also moved to affirm the judgment of the state court, *held*, that the motion to dismiss must be denied because the validity of a second re-issue subsequent to that under which

the license was given had been set up in defense below and that presented a federal question. *Held*, that the motion to affirm the judgment of the state court must be granted because the same was clearly right. *Dale Tile Mfg. Co. (Limited) v. Hyatt, 43 O. G. 249, C. D. 1888.

73. In an action of *assumpsit* in a state court for the recovery of license fees under a written contract the plaintiff recovered damages and the defendant brought the suit into this court as involving a federal question, and the defendant in error moved in this court to dismiss the writ of error for want of jurisdiction. *Held*, that as the question at issue in the state court was not of priority of invention or of the validity or construction of any patent, but simply whether the reels made and sold were the same, or substantially the same, as mentioned in the contract, no federal question was presented. *Held*, in allowing a writ of error to this court, the certificate of the chief justice of a state court that a federal question arose is not conclusive upon this court and cannot supply the want of evidence of such fact in the record. *Felix v. Scharnweber, 43 O. G. 251, C. D. 1888.

74. In the suit at bar, which was for patent license fees under a contract, where both the validity of the patent and infringement were put in issue and decided by the circuit court, there is no doubt that this was "a case touching patent-rights" and came within the jurisdiction of this court under section 689, Revised Statutes, without regard to the sum or value in dispute. *St. Paul Plow Works v. Starling, 43 O. G. 1350, C. D. 1888.

75. When one of two joint owners of a patent, not partners, dies after decree in circuit court under certain other conditions stated, the cause of action did not survive to the remaining owner and the supreme court had no jurisdiction of suit. *Dolan v. Jennings, 55 O. G. 141, C. D. 1891.

76. In order to give the supreme court jurisdiction by writ of error to a state court, it must appear affirmatively, not only that a federal question was presented for decision to the highest court of the state having jurisdiction, but that its decision was necessary to the determination of the case, and that it was actually decided, or that the judgment as rendered could not have been given without deciding it. *The Walter A. Wood Mowing and Reaping Machine Co. v. Skinner, 54 O. G. 1891, C. D. 1891.

77. Where the action was upon an agreement by the defendant that, in consideration of the right to the exclusive use of complainant's patented device, it would use it upon all mowing and reaping machines and would pay a reasonable value for such use, and the value of such use was the only question of fact, and neither the construction nor the validity of the complainant's patent was regarded as material by the trial court, and it did not appear upon what ground the highest court of the state proceeded in affirming the judgment below, but it did appear that the case might properly have been determined upon a ground broad enough to support the judgment without resort to a federal question, *held*, that the supreme court had no jurisdiction. *Id.

78. It was not the intention of congress in the circuit courts of appeals act of March 3, 1891 (ch. 517, 26 Stats. 828), to narrow the appellate jurisdiction of the supreme court in case of a suit brought by the United States as a sovereign in respect of an alleged miscarriage in the exercise of one of its functions as such, deeply concerning the public interests and not falling within the reasons of the limitations of the act. *United States of America v. American Bell Telephone Co. and Berliner, 73 O. G. 1285, C. D. 1895.

79. A suit brought by the United States to annul a patent is a suit brought by the United States as a sovereign in respect of an alleged miscarriage of one of its functions, as such deeply concerns the public interests, does not fall within the limitations of the act creating the circuit courts of appeals, and is within the appellate jurisdiction of the supreme court of the United States. *Id.

LABELS.

(See PRINTS; TRADE-MARKS.)

1. To maintain an action for protection of a label by virtue of its registration in the patent office under the act of June, 1874, notice of such registration must have been given in the form prescribed by the copyright law. *Higgins v. Keuffel, 39 O. G. 832, C. D. 1887.

2. Publication of the label with a defective notice is the same as a publication without notice, and is practically an abandonment of the copyright. *Id.

3. If the orators have any rights to the contents of the label growing out of its use as a trade-mark, these rights are not involved in a suit for infringement of copyright of the registered label. *Id.

4. The word "Magic" for liniment, *held* ar-

bitrary matter in a label, and required to be registered as a trade-mark. Ex parte Barber, 36 MS. D., March, 1888 (Vance, Ass't Com'r).

5. A label for towels, embodying the words "The Athlete's Towel," *held* not registrable, since they did not convey to the mind "some conception either as to quality, ingredients or method of use as an article." Ex parte Leakes, 38 MS. D., Aug., 1888 (Hall, Com'r).

6. The words "California Vitalizer," refused registration as a label upon the ground that they constituted a trade-mark. Ex parte Logan, 38 MS. D., Oct., 1888 (Vance, Ass't Com'r).

7. *Held*, "A tropical scene" and the title "Aqua de Florida" in a label should be registered as a trade-mark before registering the label. Ex parte Nunez, 39 MS. D., Feb., 1889 (Vance, Ass't Com'r).

8. *Held*, the word "Ervilline" in a label should be registered as a trade-mark before registering the label. Ex parte Jellerson, 39 MS. D., June, 1889 (Vance, Ass't Com'r).

9. A label is not registrable until trade-mark matter therein shall have been registered. Ex parte Columbia Sewing Machine Co., 41 MS. D., Nov., 1889 (Mitchell, Com'r); Ex parte Field, 41 MS. D.

10. A bill to restrain defendants from making and selling counterfeits of labels that are not trade-marks may be maintained, even though it does not show that defendants have affixed any of the spurious labels to articles of their own manufacture, or that they have sold any articles bearing the counterfeit labels, where it appears that complainant has a right to use the label and the right to use it is a valuable one, and the adoption of the label is not unlawful or opposed to public policy, and that he has sustained such special pecuniary damage as gives him a right to complain of the fraud. From the fact that defendants have made and sold spurious labels and advertised them for sale, it will be presumed that they intended that they should be used by the persons who buy them on articles similar to those on which complainant uses them and that they manufacture and sell them for that purpose. *Carson v. Ury, 49 O. G. 411, C. D. 1889.

11. Such case is not a trade-mark case, and the court cannot interfere as in ordinary trade-mark cases. *Id.

12. Cases of Cigar Makers' Protective Union, No. 98, v. Conhaim (41 N. W. Rep. 943) and Schneider v. Williams (14 Atl. Rep. 812) distinguished from the case at bar. *Id.

13. The settled doctrine of the office 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. Ex parte Diamond Laboratory Co., 43 MS. D. (2 G. W. D.), July, 1890 (Mitchell, Com'r).

14. A trade-mark must be registered for the particular class of goods upon which the label is to be used before the label is entitled to registration. Id.

15. The use of a capsule of the same color as that used by complainants on bottles of champagne will not be enjoined where there has been no attempt at deception thereby and where the labels used by the defendant were so unlike those of complainants that a person of average intelligence, exercising ordinary care, could readily ascertain the difference. *Von Mumm v. Kirk, 50 O. G. 1134, C. D. 1890.

16. A label containing a trade-mark cannot be registered. (Cases cited.) Ex parte Whitman & Son, 49 MS. D. (3 G. W. D.), Dec., 1891 (Frothingham, Ass't Com'r).

17. On motion for rehearing of above case in view of decision in In re Palmer, 58 O. G. 384, registration was still denied. Id.

18. The clause of the constitution under which congress is authorized to legislate for the protection of authors and inventors has reference only to such writings and discoveries as are the result of intellectual labor. It does not have reference to labels which simply designate or describe the articles to which they are attached, and which have no value separated from the articles, and no possible influence upon science or the useful arts. *Higgins v. Keuffel, 55 O. G. 1139, C. D. 1891.

19. To be entitled to a copyright the article must have by itself some value as a composition, at least to the extent of serving some purpose other than as a mere advertisement or designation of the subject to which it is attached. *Id.

20. Scoville v. Toland (6 Western Law Journal, 84) quoted with approval in holding that the law of 1831 could not bear a construction admitting an ordinary label for merchandise within its protection. That law was as broad as the law now in force, and the rule applied in that case is applicable now. *Id.

21. A mere label designates or indicates the article contained in the bottle, package or box to which it is affixed, and does not, like a trade-mark, distinguish the article otherwise. *Id.

22. The Revised Statutes secure protection to

the author of any subject of copyright on his compliance with certain provisions which are specifically set forth. They provide that in order to maintain an action for infringement of his copyright he shall have given notice thereof by a certain formula of words inscribed upon a certain designated part of the book, print, or other article. The formula allowed by the act of 1874 includes the simple word "copyright," with the addition of the year it was entered and the name of the party by whom it was taken out. *Id.

23. Assuming that the constitution authorizes legislation for the protection of mere descriptive labels as properly the subject of copyright, and that the statute relating to subjects of copyright includes such labels, the proceedings taken to secure protection in this case were insufficient and ineffectual, and no action can be maintained for infringement, and no suit in equity to restrain future use of the label, because the form of words prescribed by the law has not been followed in giving notice of the copyright. *Id.

24. 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 exhibiting no attempt at art or literary merit, is not entitled to registration under the recent decision of the supreme court as announced in the recent case of Higgins v. Keuffel (55 O. G. 1139). Ex parte Eldredge & Co., 55 O. G. 1278, C. D. 1891.

25. It is the settled practice of the office to consider the words "not a trade-mark," in the statute referring to the registration of labels, as applying to anything appearing on a label susceptible of appropriation as a trade-mark and not already registered as such. Ex parte Ruckstuhl, 56 O. G. 927, C. D. 1891.

26. Although a label may be artistic, yet if it is merely fanciful and arbitrary, and is not descriptive of the contents of the package to which it is to be applied, it is not registrable. Ex parte J. & P. Baltz Brewing Co., 51 MS. D., Oct., 1892 (Frothingham, Ass't Com'r).

27. Applicant offered for registration as a label "a pictorial representation descriptive of the hammock to which the label applies." *Held* proper subject for registration as a label. Ex parte Palmer, 58 O. G. 383, C. D. 1892.

28. A label in order to be entitled to registration by the commissioner of patents under the copyright law must have the same degree of artistic excellence as would entitle it to copyright in the office of the librarian of congress. The Trade-mark Cases (100 U. S. 82) and Higgins v. Keuffel (55 O. G. 1139, 140 U. S. 428) quoted and discussed. Id.

29. A label which is purely descriptive of the article to which it is intended to be attached is not registrable within the meaning of the law. (Quoting Higgins v. Keuffel, 55 O. G. 1139, 140 U. S. 428.) Ex parte C. G. Hainline & Co., 58 O. G. 947, C. D. 1892.

30. In label and trade-mark cases, as in patent cases, matters of form should be settled before the application is finally disposed of upon its merits. Ex parte Vermont Maple Sugar Makers' Association, 52 MS. D., July, 1893 (Fisher, Ass't Com'r).

31. A label for bitters containing arbitrary or fanciful matter suitable for a trade-mark refused registration. Ex parte Mette & Kanne Distilling Co., 53 MS. D., July, 1893 (Fisher, Acting Com'r).

32. A label for alcoholic liquors denied registration because it was a fanciful device and did not describe the article. Ex parte Librowicz, 53 MS. D., Sept., 1893 (Fisher, Acting Com'r).

33. A label having no value as a composition *per se* held not registrable in view of Higgins v. Keuffel and Ex parte Eldredge & Co., 55 O. G. 1278. Ex parte King & Co., 53 MS. D., Nov., 1893 (Fisher, Acting Com'r).

34. The purpose of the so-called "Label act" was to relegate to the patent office all registry in the general nature of or akin to copyright of things which are mere adjuncts or appurtenances of articles of trade, and to leave to the librarian of congress the registry of things whose value in exchange resides in themselves. In any case some spark of intellectual creation must be present. (See Ex parte Palmer, 50 O. G. 383.) Ex parte H. J. Heinz Co., 62 O. G. 1064, C. D. 1893.

35. Until the supreme court distinctly says otherwise the label law is, for the patent office, constitutional. Id.

36. A label refused registration which failed to reach the standard set up by the supreme court in Higgins v. Keuffel, 55 O. G. 1139. Ex parte Bevan & Co., 55 MS. D., July, 1894 (Fisher, Ass't Com'r); also Ex parte Cohen, 55 MS. D., Dec., 1894 (Fisher, Ass't Com'r).

37. A label for canned goods having the title "Brownie Brand" (which had been already registered as a trade-mark) and representing Brownies engaged in fishing, etc., *held* to have

sufficient artistic merit to entitle it to registration. Ex parte Williams & Co., 57 MS. D., July, 1895 (Fisher, Ass't Com'r).

38. A label entitled "Scroll Back No. 2 in Capital Brand of U. S.," for playing-cards, ruled not registrable, because primarily a design to be placed upon an article of manufacture to become a part thereof. Ex parte United States Printing Co., 57 MS. D., Aug., 1895 (Fisher, Acting Com'r).

LICENSE.

(See ASSIGNMENT.)

I. DEFINED.
II. IMPLIED.
III. IN GENERAL.
IV. TO MAKE, SELL AND USE.

I. DEFINED.

1. The right of the patent owner to permit or license the use of the invention is not the creature of the federal franchise or statute, but of the common law. *United States v. American Bell Telephone Co., 38 O. G. 1237, C. D. 1887.

2. A conveyance by a patentee of the right "to use and manufacture and sell rights to use" the patented article in a certain county is a mere license, not entitling the grantee to sue for infringement in his own name, since it does not convey the right to sell the patented article. *Rice v. Boss, 46 Fed. Rep. 195 (1891).

3. A grant, by the owner of a patent, of the sole and exclusive right and license to manufacture and sell the patented article throughout the United States does not include the right to use such patented article, at least if manufactured by third persons, and is therefore a mere license. *Waterman v. Mackenzie, 54 O. G. 1562, C. D. 1891.

4. An instrument which is in terms a transfer by complainant to defendant of the exclusive right "to manufacture and sell and vend" certain patented articles, the purchasers to have the right to use the articles, which expresses that it is intended for the purpose of vesting in defendants all the rights of complainant in the manufacture and sale of such articles, but which expressly provides that complainant shall retain the ownership of the patent, and in which defendants stipulate for payment of royalties and to do all reasonable things for the successful manufacture and sale of the patented articles, is a mere license. *Hatfield v. Smith, 54 O. G. 1892, C. D. 1891.

5. A conveyance, under a patent, of the right "to use and manufacture and sell rights to use" the patented device in a specified locality is a mere license and does not entitle the grantee to maintain an action in his own name. *Rice v. Boss, 56 O. G. 528, C. D. 1891.

6. "In consideration of the premises . . . I do hereby license and convey . . . the full and exclusive right to manufacture, use and sell . . . all inventions, whether patented or not, which I may hereafter make," etc. *Held* not only a license but an assignment of the inventions or improvements thereof that might thereafter be made and patents obtained therefor. *Regan Vapor-Engine Co. v. Pacific Gas-Engine Co., 56 O. G. 1886, C. D. 1891.

7. It has been said that the sole matter conveyed by a license is the right not to be sued. *Heaton-Peninsular Button Fastener Co. v. Eureka Specialty Co., 78 O. G. 171, C. D. 1897.

8. A licensee is one who is not the owner of an interest in the patent, but who has by contract acquired a right to make or use or sell machines embodying the invention. *Id.

9. Purchaser of a machine, upon the condition that such machine is to be used only upon or in connection with articles from a particular source, is a mere licensee. All alienations of a mere right to use the machine operate only as licenses. *Id.

II. IMPLIED.

10. The extent of an implied license to make and sell patented articles is to be construed according to the presumed intent of the parties as inferred from the circumstances. *Montross v. Mabie, 41 O. G. 931, C. D. 1887.

11. A firm having been largely engaged during several years in manufacturing and selling stoves upon designs patented by one of the partners, and accounts between them having been repeatedly settled embracing such sales and the profits thereon, as firm business, *held*, without regard to the question whether the patent was equitably the exclusive property of the patentee, (1) that a license by the patentee to the firm to make the stoves and to sell those manufactured was implied; (2) that such license, by necessary implication, was co-extensive with the business of the firm and continued until the copartnership affairs were wound up by any lawful agencies for that purpose; (3) that consequently the copartner of the patentee had

the same authority after dissolution as before to sell for the benefit of the firm the stoves manufactured for sale before dissolution; and (4) that a receiver of the partnership effects, appointed by a state court in a suit brought for winding up the affairs of the partnership, had a similar authority to sell the stoves remaining on hand, both as the representative of the parties and as a lawful agency for closing up the partnership business, and was by necessary implication included in the implied license. An application for an injunction to restrain him from selling was therefore refused. *Id.

12. Where the defendant bought and paid for the right to use certain flush tanks, which, in combination with a system of sewers, were covered by plaintiff's patent, and the plaintiff, claiming a royalty upon the sewers in connection with which said tanks were used, brought suit for an injunction against the use by defendant of said tanks and for an account, *held*, that such suit could not be maintained, but that if plaintiff had a claim it lay in the direction of an action at law for royalties upon an implied license. *Drainage Construction Co. v. City of Chelsea, 50 O. G. 559, C. D. 1890.

13. The granting of a license may be proved by the acts and dealings of the parties who own and permit others to use the patent without the necessity of resorting to written instruments. *The Holmes Burglar Alarm Telegraph Co. v. The Domestic Telegraph and Telephone Co., 51 O. G. 2093, C. D. 1890.

14. Where an employee of a firm made an invention in the direct line of its business while in its pay, and there were circumstances which raised a presumption of an implied license to the firm to sell the invention in its line of business, and where the firm is developed into a corporation upon the same basis — liabilities, assets and business — as the firm was, and where both employee and succeeding corporation continued the same relation to each other as existed between him and the firm, *held*, that the implied license to the firm was transmitted to its successor, the corporation. (Hapgood v. Hewitt, 37 O. G. 1247, 119 U. S. 226; Troy Iron and Nail Factory v. Corning, 14 How. 193; Oliver v. Rumford Chemical Works, 25 O. G. 784, 109 U. S. 75; Hammond v. Mason & Hamlin Co., 92 U. S. 724; Lightner v. Boston and Albany R. Co., 1 Lowell, 338.) *Lane & Bodley Co. v. Locke, 65 O. G. 1406, C. D. 1893.

15. Where a party is employed to assist in developing the line of machinery manufactured by the employer, and while in such employment uses the tools and workshop of his employer to experiment with in making and perfecting an invention relating to the development of such machinery, and such invention was immediately put into use and sale in the employer's machinery, which use and sale were fully known to and acquiesced in by the employee, and where the employee did not apply for a patent until several years after such use and sale by his employer, *held*, that such facts raised a conclusive presumption of an irrevocable equitable right or license in the employer to use and sell the invention in connection with his machinery both before and after the grant of a patent to the employee. (McClurg v. Kingsland, 1 How. 202; Solomons v. United States, 54 O. G. 265, 137 U. S. 342.) *Id.

III. In General.

16. The contracts between the American Bell Telephone Company and the local telephone corporations create the relation of licensor and lessor on the one side and licensee and lessee on the other, and not a relation of agency. *United States v. American Bell Telephone Co., 38 O. G. 1237, C. D. 1887.

17. Transactions, such as the American Bell Telephone Company has had with the licensee corporations of Ohio at its place of business in Boston, and not elsewhere, is not the carrying on of business by it in Ohio, nor are such licensee corporations its "managing agents." *Id.

18. The right of the patent owner to permit or license the use of the invention is not the creature of the federal franchise or statute, but of the common law, and in exercising this common-law right of licensing others to use its patent the corporation owner is no more nationalized than a private owner would be under the same circumstances; nor does the fact that a patent-holding corporation licenses others to use its patent in a particular state have any more effect and operation in domesticating it within such state than the same act on the part of a private owner would have in rendering him a citizen and resident of every state in which his patent might be used. *Id.

19. A licensee failed to make returns of his manufactures and sales, and to pay royalty according to his contract; *held*, this was no ground for annulling the contract, since the complainant had an adequate remedy at law for the injuries complained of. *Densmore v. Tanite Co., 32 Fed. Rep. 544 (1887).

20. Complainant was entitled to his three-

eighths share of the royalties from defendant, although the license provided for payment to Norris. At law this was due to Norris as trustee for complainant; in equity it was due directly to the complainant. *Rogers v. Riessner, 41 O. G. 351, C. D. 1887.

21. Where a patentee induces a manufacturing company to accept a license under the patent, representing that rival manufacturers were paying the schedule rates, when they were really paying only one-half of those rates, the company so imposed upon is not liable for the royalties agreed upon and is entitled to a decree canceling the license. *Hat-Sweat Mfg. Co. v. Waring, 56 O. G. 806, C. D. 1891.

22. A licensee who covenants not to dispute the validity of a patent under which he is licensed will not be permitted to do so. *Marsh v. Quick Meal Stove Co., 60 O. G. 1056, C. D. 1892.

23. Where an inventor, in consideration of assistance given him, verbally agreed to give an interest in the manufacture of his invention, but did not make an assignment of such interest in legal form, and where he subsequently made an assignment of the patent to another party without notice of the previous verbal interest, *held*, that no effect, as against the assignee, could be given to such verbal license or interest. *Gates Iron Works v. Fraser, 67 O. G. 1065, C. D. 1894.

24. When a buyer enters into an implied agreement that he will not use the machine contrary to his license, and when the agreement contains a provision for a reverter of the structure itself in case of breach, the licensor may have a remedy at law either for liability upon the broken contract or for the tortious use of the invention. *Heaton-Peninsula Button Fastener Co. v. Eureka Specialty Co., 78 O. G. 171, C. D. 1897.

25. A license operates only as a waiver of the monopoly as to the licensee and estops the licensor from exercising its prohibitory powers in derogation of the privileges conferred by him upon the licensee. *Id.

26. A court will not sustain the objection that a patentee has no right to license upon condition that the licensees use the invention only in conjunction with a non-patentable article made by himself, when the ground of objection is that an illegal monopoly will thereby be created. Courts will not lightly interfere with the freedom to contract, and especially will not sit in judgment upon the limitations which a patentee may put upon the use of his invention. *Id.

27. Each machine sold has a metal label affixed thereon to the effect that with such machines fasteners made by a certain company only are to be used. This is equivalent to notice of a restricted license only, and the purchaser of the machine obtains title subject to a reverter in case of violation. *Id.

IV. To Make, Sell and Use.

28. By a contract in 1877 between plaintiff, who was the patentee of a printing-press and of a subordinate improvement thereon, and defendant, the defendant agreed to manufacture presses for the plaintiff at agreed prices, keeping enough on hand to meet the demands of the market, and the plaintiff agreed to buy of no one else than defendant. Defendant was to have a license to sell, paying a royalty, "the conditions of sale" by defendant to be the same as the conditions under which plaintiff should sell, "so long as he continues in the business" in New York. Afterward a modified agreement as to prices was made, to last two years, at the end of which time the defendant should "be obliged to continue to furnish the presses at the prices" fixed by the original contract. Further than shown, no time was specified in the contract. Upon a motion for a preliminary injunction, *held* (not as a final decision, but for the purposes of the motion), that after the expiration of the patents on the press in 1886, but not on the improvement, being after the expiration of the two years named in the modified agreement, defendant was not obliged longer to make presses under the contracts either with or without the improvement; that he could sell presses for plaintiff without the improvement without restriction and without paying a royalty, but that as to presses with the improvement he could not undersell plaintiff. *Gally v. Colt's Patent Fire Arms Mfg. Co., 41 O. G. 576, C. D. 1887.

29. A license granting the right "to use a patented device must be considered as granting the right to make it for use. (Citing Walker on Patents, sec. 298; Stonecutter Co. v. Shortsleeves, 16 Blatchf. 381, and Woodworth v. Curtis, 2 Woodb. & M. 524.) *Illingworth v. Spaulding, 43 Fed. Rep. 827 (1890).

30. A contract granting the right to make and sell an article under a patent within a specified territory, whether or not it amounts

to an exclusive license, and containing no limitation on its face, cannot be terminated by the grantee without the consent of the grantor, and the latter can recover the royalty fixed by the contract, even though the grantee has previously given notice of the termination thereof. *St. Paul Plow Works v. Starling, 55 O. G. 1821, C. D. 1891.

31. Under such a contract, grantee, at all times during the existence of the patent, can set up the contract as a defense against a claim for infringement and limit his liability to the royalty fixed by the terms of the contract. *Id.

32. In addition to the grant of an exclusive license to manufacture and sell in certain specified parts of the United States the license in this case contained the following clause: "And, so far as we can control the same, the exclusive right to build harvesters and binders under the rights herein granted, for sale in Europe, Australia and South America." *Held* that, fairly and reasonably construed, this language conferred upon the licensee an exclusive right to manufacture throughout the whole United States for sale in the foreign countries named, and hence that an injunction should issue against the parties manufacturing outside the territorial limits in the United States in which the licensee was authorized to sell to restrain them from manufacturing for such foreign trade. *Adriance, Platt & Co. v. McCormick Machine Co., 63 O. G. 1688, C. D. 1893.

33. In the absence of words showing that it was intended that the license might be assigned, a license conferring the exclusive right to manufacture and sell patented articles is not assignable, and does not vest in a receiver of the property of the licensee, appointed in proceedings supplementary to execution under the New York code of civil procedure. *Waterman v. Shipman, 64 O. G. 713, C. D. 1893.

34. A transfer of "plant and good-will, . . . including the contract of license," is a contract to the effect that machines which form a part of the plant are thereby transferred subject to any restrictions of the license, and such machines cannot be used or sold except in accordance with the terms of such license. *International Pavement Co. v. Richardson, 76 O. G. 166, C. D. 1896.

35. When machines are acquired under the provisions of a license which prohibits the disposal of such machines, except to other licensees, and which permits the purchasing licensee to use and enjoy such machines subject to all the conditions of his own license, the said conditions are equitably enforcible against such purchasing licensee. *Id.

LIMITATION BY FOREIGN PATENTS.

(See FOREIGN PATENTS; INTERFERENCE — PRIORITY, FOREIGN PATENTS; ANTICIPATION — PATENTS, ETC.)

1. The time of expiration of a United States patent falling within the provisions of section 4887, Revised Statutes, is to be ascertained by the "term" of the foreign patent. *Paillard v. Bruno. 38 O. G. 900, C. D. 1887.

2. Fourteen years is the "term" of an English patent, and although said patent ceases to be in force after three years from its date if the stamp duty is not paid, it only operates by limitation upon an after-granted United States patent for fourteen years. *Id.

(By the thirteenth section of the British act of 1883, every patent is dated and sealed as of the day of the application, and by the twelfth section every patent is limited in duration to fourteen years from its date. The time begins to run from the date of the patent, including that day. Thus, a patent dated February 26, 1825, was held to expire at twelve o'clock on the night of February 25, 1839.)

3. The Canadian amendatory act of May 25, 1883, did not affect the duration of the Bate United States patent at the time of its issue in 1877, and no subsequent legislation anywhere could change its duration. *Bate Refrigerating Co. v. Gillett, 40 O. G. 1029, C. D. 1887.

4. A patent of the United States does not terminate at the date when an earlier English patent of the same inventor for the same invention becomes void for the non-payment of taxes. *Id.

5. The United States patent was for the same invention as the patent in Great Britain, although the former contained improvements which were not exhibited in the latter. The principal inventions were the same in both patents. *Guarantee Insurance, Trust and Safe Deposit Co. v. Sellers, 41 O. G. 1165, C. D. 1887.

6. A patent cannot be exempted from the operation of the law by adding some new improvements to the invention, and cannot be construed as running partly from one date and partly from another, which would be productive of endless confusion. *Id.

7. The act of 1861, section 16, was only in-

tended to change the length of the term during which patents should be in force and not the point of the commencement. The latter continued, as before, "the date of issue," as defined by the previous laws, referring either to the issue of the United States patent itself when no foreign patent had been previously obtained, or to that of the latter when such a patent had been obtained. *Id.

8. Upon application made May 31, 1871, letters patent of the United States for an invention were granted on February 6, 1872. On October 12, 1871, the inventor caused application to be made in England for letters patent for the same invention, and a provisional specification was then filed. Pursuant to this application letters patent of Great Britain for said invention were sealed April 3, 1872, and dated October 12, 1871. The complete specification for the English patent was filed April 12, 1872, the same having been subscribed March 22, 1872. *Held*, that the invention was not "first patented, or caused to be patented," in England within the meaning of the twenty-fifth section of the act of July 8, 1870 (sec. 4887, R. S.), and that the life of the United States patent was not abridged by the antedating of the foreign patent. *Emerson, Smith & Co. (Limited) v. Lippert, 42 O. G. 904, C. D. 1888.

9. No opinion expressed as to the effect on the life of a United States patent of the filing in a foreign country of a complete specification. *Id.

10. The effect of section 4887 of the Revised Statutes is not to render invalid an American patent by an English patent of an earlier date for the same invention, but only to limit its term. *Dolbear v. American Bell Telephone Co., 43 O. G. 377, C. D. 1888.

11. Under section 4887, Revised Statutes, it is not material whether the foreign patent is granted to the inventor who made the application in this country or to some other person to whom he has caused the invention to be patented, nor that the inventor who makes the application here is one of our citizens. *Edison Electric Light Co. v. United States Electric Lighting Co., 43 O. G. 1456, C. D. 1888.

12. A patent of the United States taken out by the inventor, a citizen of the United States, expires at the date of expiration of a foreign patent for the same invention previously taken out by the same inventor, or by his request, although the patent of the United States had been first applied for and the invention had been put in use in the United States before the foreign patent had been applied for. *Id.

13. Where the Canadian statute under which the extensions of the Canadian patent were 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. *Bate Refrigerating Co. v. Hammond, 46 O. G. 689, C. D. 1889.

14. The provisions of the act of 1870 and the Revised Statutes mean that the United States patent shall not expire so long as the foreign patent continues to exist, not extending beyond seventeen years from the date of the United States patent, but shall continue in force, though not longer than seventeen years from its date, so long as the foreign patent continues to exist. Under section 4887, although the United States patent may on its face run for seventeen years from its date, it is to be so limited by the courts, as a matter to be adjudicated on evidence *in pais*, as to expire at the same time with the foreign patent, not running in any case more than seventeen years; but, subject to the latter limitation, it is to be in force as long as the foreign patent is in force. *Id.

15. While it may be proper, in a case where the date of a foreign patent issued prior to the granting of a United States patent to the same patentee for the same invention is made known to the patent office prior to the granting of the United States patent, to insert in that patent a statement of the limitation of its duration, in accordance with the duration of the foreign patent, it does not affect the validity of the United States patent if such limitation is not contained on its face. *Id.

16. Section 4887 of the Revised Statutes of the United States so limits the power of the commissioner of patents that where an invention has been patented in a foreign country he cannot lawfully issue an American patent for the same invention for a term to extend beyond the actual duration of the life of the foreign patent. *Huber v. N. O. Nelson Mfg. Co., 47 O. G. 1732, C. D. 1889.

17. Letters patent of the United States granted after a foreign patent for the same in-

vention had lapsed and become null and void by reason of the non-payment of a stamp duty, *held* granted without authority of law and void. *Id.

18. The termination of a foreign patent prior to the time specified on the face of the grant by the failure of the patentee to comply with some requirement of the foreign law has the effect of terminating a subsequently-issued American patent for the same invention. *Id.

19. The "term" of a foreign patent referred to in United States Revised Statutes, section 4887, which requires letters patent issued for an invention previously patented abroad to be limited "to expire at the same time with the foreign patent," or, if there be more than one, "with the one having the shortest term," is not the original term expressed in the controlling foreign patent, but its period of actual existence. *Pohl v. Anchor Brewing Co., 49 O. G. 1695, C. D. 1889.

20. A patent should never be declared invalid because of the expiration of a foreign patent, if there is a doubt about the inventions being the same. The doubt should be resolved in favor of the patent. *Brush Electric Co. v. Julien Electric Co., 41 Fed. Rep. 679 (1890).

21. There is nothing in the statute (Revised Statutes, section 4887) 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 it 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, according to the foreign statute. *Pohl v. The Anchor Brewing Co., 51 O. G. 156, C. D. 1890.

22. Section 4887, 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, or, if there be more than one, at the same time with the expiration of the term of the one having the shortest term. *Id.

23. The ground of the decision in Bate Refrigerating Co. v. Hammond (46 O. G. 689, 129 U. S. 151) was that the "term" of the Canadian patent granted in January, 1887, was by the Canadian statute at all times a term of fifteen years' duration, made continuous and uninterrupted by the action of the patentee, as a matter entirely of right, at his own option. *Id.

24. In a suit for infringement of re-issued Letters Patent No. 10,137, granted June 13, 1882, to the Commercial Manufacturing Company, Consolidated, as assignee of Hippolyte Mége, for an improvement in treating animal fats, *held*, that the invention covered by this patent was substantially the same as that described in a Bavarian patent which expired April 8, 1876, and in an Austrian patent which expired May 26, 1876, both granted to said Mége, and that the United States letters patent expired with said foreign patents prior to the beginning of this suit. *The Commercial Mfg. Co., Consolidated, v. The Fairbank Canning Co., 51 O. G. 965, C. D. 1890.

25. The leading features of the present British statute distinguishing it from the former statutes are that the complete specification must be filed before the patent is granted; that such specification is not open to the inspection of the public when filed, nor even when afterward accepted, but only when advertisement is made of the fact of acceptance, and that the seal of the patent is the last step preceding its publication as a patent. De Ferranti v. Westinghouse, Jr., 52 O. G. 457, C. D. 1890.

26. Under the present British statute a British invention cannot be said to be patented, within the meaning of sections 4886 and 4887 of the Revised Statutes, until the final act of affixing the seal. Id.

27. Where a foreign statute, under which an extension of a foreign patent was granted or attempted to be granted, was in force at the time of the application for or issuance of a United States patent, and where, under such statute, the extension, in the absence of unfulfilled conditions, was a matter entirely of right, at the option of the patentee, on his payment of the required fee, the fifteen-year term of such foreign patent being, by the affirmative action of the foreign government 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 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. Edison Electric Light Co. v. Perkins Electric Lamp Co., 52 O. G. 1370, C. D. 1890.

28. Under section 4887 of the Revised Statutes a United States patent runs for the term for which the foreign patent was granted, not-

withstanding the lapse or forfeiture of the foreign patent by the non-observance of a condition subsequent prescribed by the foreign patent law. *Consolidated Roller-Mill Co. v. Walker, 54 O. G. 136, C. D. 1891.

29. By the Austrian patent law the "longest duration of privileges is fixed at fifteen years," and every patentee whose privilege has been granted for a shorter period than the longest may claim its prolongation for one or more years within the fixed longest period, provided such prolongation be demanded before the privilege has become extinct. In the original grant of an Austrian patent the allowance of the franchise was for one year, but on request it was four times extended, from year to year, and at the end of the fifth year the franchise was suffered to expire. A United States patent to the same patentee, and for the same invention, was issued after the Austrian patent was granted and during the first year it was in force. *Held*, that by the original grant of the Austrian patent the patentee was invested with the right, at his mere option, to have the patent prolonged for the full term of fifteen years, and that, under section 4887 of the Revised Statutes, the United States patent ran for that term, notwithstanding the expiration of the Austrian patent at the end of its fifth year. *Id.

30. Under the Austrian patent law the ministry of commerce, in deciding the question of the length of the term which appertains to every Austrian patent, exercises a judicial function, and its opinion on that subject will be followed here, agreeably to the established rule that the courts of the United States adopt the construction of a statute of a foreign country made by the courts of that country. *Id.

31. The tests of identity, under section 4887 of the Revised Statutes, are as follows: Is the principal invention in each the same; is the thing patented abroad the same in all essential particulars as the thing patented here; would the home patent be infringed by a structure made in accordance with the provisions of the foreign patent? *Brush Electric Co. v. Electrical Accumulator Co., 56 O. G. 1334, C. D. 1891.

32. The Canadian patent act which provides that, "when a foreign patent exists, the Canadian patent shall expire at the earliest date at which any foreign patent for the same invention expires" refers only to foreign patents which exist before the issue of the relevant Canadian patent. *Edison Electric Light Co. v. United States Electric Lighting Co., 61 O. G. 564, C. D. 1892.

33. A prior Canadian patent issued for five years and extended for the further period of ten years should be regarded as having a continuous term for the entire period, and as not limiting the United States patent to any shorter term. *Id.

34. The failure to limit the patent on its face to a shorter term than seventeen years, so as to expire at the same time with the prior foreign patent having the shortest term, does not affect its validity. *Id.

35. Where a previously granted foreign patent to the same inventor is not the same in its essential particulars with any one of the inventions which are claimed in the domestic patent, the latter is not limited in its term by the former. *Electrical Accumulator Co. v. Brush Electric Co., 61 O. G. 886, C. D. 1892.

36. The United States patent was issued January 30, 1877. Application for an English patent was filed December 9, 1876. The latter was sealed on May 15, 1877, but antedated to December 9, 1876. *Held*, the invention was not patented abroad before the actual sealing and issuance of the patent there. *American Bell Telephone v. Cushman, 57 Fed. Rep. 842 (1893).

37. A United States patent applied for and granted after the expiration of a foreign patent for the same invention never had any force or validity. The delay in applying for the United States patent until after the foreign patent expired amounted to an abandonment of the right to a United States patent. *Huber v. N. O. Nelson Mfg. Co., 63 O. G. 311, C. D. 1893.

38. The tests of identity of invention for the purposes of section 4887, United States Revised Statutes, collated from the leading cases of Siemens v. Sellers (123 U. S. 276) and Commercial Mfg. Co. v. Fairbank Canning Co. (51 O. G. 965, 135 U. S. 176) and applied. The tests are: Is the principal invention of the domestic patent found in the foreign patent? Is the subject-matter of the one the same in all essential particulars as that of the other? Would a structure made pursuant to the foreign patent infringe the domestic patent? Could both patents have been granted in this country? *Electrical Accumulator Co. v. Julien Electric Co., 57 Fed. Rep. 605, 64 O. G. 559, C. D. 1893.

39. The two patents need not be in identical garb or employ identical forms of expression. *Id.

40. Evidence of an intention to patent the

same invention in the two patents is material and important. *Id.

41. Admissions, express or implied, that the two patents are respectively for the same invention as a third and earlier patent issued in a third country are material and important. *Id.

42. The same canons or methods of criticism applied to the ambiguities or perspicuities of the domestic patent should be also applied to those of the foreign patent. *Id.

43. The comparison should be instituted with the domestic patent as it was issued and not with the domestic patent as it may afterward exist after being cut down by a disclaimer and limited by the state of the art. If a patent when granted covers an invention which has been previously covered by a foreign patent, it expires with the foreign patent, notwithstanding the fact that it has subsequently been pared down to cover only one method of practicing the invention or restricted to a single claim. *Id.

44. Though the domestic patent claim the product and the foreign patent claim the process, still where the process makes the product and the product can be made only by the process, the product and the process constitute one discovery and the patents are for the same invention. (Citing Mosler v. Mosler, 43 O. G. 1115, 127 U. S. 354; Plummer v. Sargent, 120 U. S. 442.) *Id.

45. In the present state of the law the date of issue of the domestic patent is controlling under section 4887, United States Revised Statutes, not the date of application for the domestic patent. (Citing Gramme Co. v. Arnoux, 25 O. G. 145, 17 Fed. Rep. 838; Edison v. United States Co., 35 Fed. Rep. 134.) *Id.

46. The right to obtain an extended term of the foreign patent on application within a time limited, if not availed of by actual application within such time, does not constitute such a potential term in the foreign patent as to prolong the domestic patent through or into such extended term. (Distinguishing Consolidated Roller Co. v. Walker, 54 O. G. 136, 43 Fed. Rep. 575, 580, and citing Bate v. Gillett, 46 O. G. 1029, 31 Fed. Rep. 809; Bate v. Hammond, 46 O. G. 689, 129 U. S. 151; Huber v. Nelson, 63 O. G. 311.) *Id.

47. Under Revised Statutes, section 4887, a United States patent expires with a foreign patent granted for the same invention to the same inventor prior to the date of the United States patent but subsequent to the application therefor. (Refrigerating Co. v. Gillett, 13 Fed. Rep. 553, followed.) *Bate Refrigerating Co. v. Sulzberger, 65 O. G. 135, C. D. 1893.

48. The term "patented" in section 4887 of the Revised Statutes does not mean the preliminary proceedings, but the actual issuance of the patent under the seal of the government. (Citing Telegraph Co. v. Telegram Co., 31 O. G. 1559, 23 Fed. Rep. 340; Emerson Smith & Co. v. Lippert, 42 O. G. 964, 31 Fed. Rep. 911; Seibert Cylinder Oil Cup Co. v. William Powell Co., 47 O. G. 1072, 35 Fed. Rep. 591; Smith v. Goodyear Dental Vulcanite Co., 11 O. G. 246, 93 U. S. 486–498.) A United States patent granted January 30, 1877, not limited by British patent which was sealed May 15, 1877, but antedated to December 9, 1876, the date of filing the provisional specification, and conditioned that on or before June 9, 1877, a complete specification should be filed. *American Bell Telephone Co. v. Cushman, 65 O. G. 135, C. D. 1893.

49. Where a domestic patent was granted February 20, 1883, and a British patent for the same invention was sealed August 20, 1883, and a re-issue application was filed January 21, 1893, *held*, that since the term of the re-issue would not be affected by the foreign patent, it was unnecessary to require the re-issue applicant to recite the British patent in his oath. (Ex parte Beck, C. D. 1880, 54, 17 O. G. 329, discussed.) Ex parte Cowles, 65 O. G. 2060, C. D. 1893.

50. The voluntary act of a patentee in causing his patent to be amended after issuance so as to be limited to expire with a foreign patent secured by him, even though taken under the mistaken view that the law required such limitation to appear on the face of the patent, estops him, as against one who invested money in a manufacturing plant on the faith of his action, from claiming that the amendment was invalid and of no effect or from relying upon a subsequent annulment of the amendment secured by him only a short time before the amended patent would have expired. *Edison Electric Light Co. v. Buckeye Electric Co., 67 O. G. 529, C. D. 1894.

51. Where the petition for correction in such case states that, while the inventor's American application was pending, "he applied for and obtained" letters patent for the same invention in several countries — enumerating such patents, with their dates — and prays that the American patent may be amended so as to be limited to expire with the expiration of that one of them having the shortest time to run, the petition does not, by reason of the indefi-

niteness of this language, put the public upon investigation as to the laws of the various countries, so as to affect them with notice that the British patent, which was the one first expiring, did not begin to run on the day of its date, but upon the day of its sealing and issuance. *Id.

52. Where the application for the United States patent for the invention was filed in 1876, December 1; the foreign patents obtained in 1877, January 9 and July 26, respectively, and the United States patent in 1877, November 20, *held*, that the invention for which the United States patent was issued was "previously patented in a foreign country," within the meaning of those words in section 4887, and the United States patent expired under the terms of that section before the expiration of seventeen years from its date. *Bate Refrigerating Co. v. Sulzberger, 70 O. G. 1633, C. D. 1895.

(Controlling decision — supreme court.)

53. The words "previously patented in a foreign country" are plain and unambiguous. Therefore the court has no authority to add to them the words "prior to his application." To do so would be to legislate and not to interpret the section. *Id.

54. Where a British patent to applicant became void prior to the filing of his United States application, by reason of failure to pay a renewal fee, *held*, that he was properly rejected for such reason, since no valid patent could issue to him. (Huber v. Nelson Mfg. Co., 63 O. G. 311, 148 U. S. 270.) Ex parte Armstrong, 71 O. G. 1615, C. D. 1895.

55. The word "expire," in section 4887 of the statute, is construed by the United States supreme court to mean cease to exist because of the termination of the duration of the original grant, and not to mean cease or determine by reason of some penalty or forfeiture for the non-performance of some condition subsequent. (Citing Pohl v. Brewing Co., 134 U. S. 381, 10 Sup. Ct. 577.) "A United States patent, therefore, runs for the term for which the foreign patent was granted, without reference to whether the latter patent became lapsed or forfeited in consequence of the failure of the patentees to comply with the requirements of the foreign law." (Cases cited.) *Bonsack Machine Co. v. Smith, 70 Fed. Rep. 383 (1895), 73 O. G. 963, C. D. 1895.

56. Under the Canadian act of 1872 a patent granted for five years is granted for a term independent of any other. Extension of the term is a privilege, not a duty, and the term is not forfeited, but expires. The patentee did not choose to renew his patent, and his patent expired because its term had expired. By his own act he made his invention free abroad, and thereupon it became free in this country. *Id.

57. The identity of invention patented required by the statute is of material substance and does not extend to minor details. (Siemens v. Sellers, 123 U. S. 276.) *J. L. Mott Iron Works v. Henry McShane Mfg. Co., 79 O. G. 865, C. D. 1897.

58. Letters Patent No. 245,318, granted August 9, 1881, to John Robertson, for an improvement in supply-tanks, appears to be for the same invention in substance as Canadian patent to same inventor and expired with the latter patent. *Id.

MANDAMUS.

1. An order by a circuit court to entertain and grant a petition for a rehearing upon a case decided by the supreme court, without previous leave obtained therefrom, is irregular and unauthorized, and such action affords good ground for a *mandamus* setting aside such order. *In re C. & A. Potts & Co., 78 O. G. 2049, C. D. 1897.

2. *Mandamus* to compel the commissioner of patents to reinstate an interference which he dissolved upon the ground that the issue was not patentable when the question of priority came before him on appeal will not lie. *Seymour, Com'r of Patents, v. United States of America ex rel. Brodie, 79 O. G, 509. C. D. 1897.

3. A *mandamus* lies lies for the enforcement of the performance of some act or duty required by law to be performed, in the performance or non-performance of which the applicant for the writ is interested, where there is no other legal remedy. *Id.

4. The mere fact that the relator has been put to trouble or expense in legal proceedings or has suffered commercial injury is no basis for the writ of *mandamus* when the respondent has failed in no legal duty. *Id.

5. A petition for a writ of *mandamus* to a public officer of the United States abates by reason of his retirement from office as well after judgment and pending an appeal therefrom as before. Seymour, Com'r of Patents, v. Nelson, 79 O. G. 1522, C. D. 1897.

6. Where pending an appeal on a petition

for a writ of *mandamus* against a public officer the officer retires, *held*, that the appeal will not be dismissed; but the judgment of the court below will be reversed and the cause remanded to said court with directions to dismiss the suit for want of proper parties. The result is the same whether the judgment appealed from is in favor of or against the officer. *Id.

7. Where an appellant delayed in applying to the court of appeals for the District of Columbia beyond the time provided in the rules of said court, in consequence of which said appeal was dismissed, *held*, that a writ of *mandamus* to compel the court of appeals to entertain the appeal will not lie to the supreme court of the United States. Ex parte Hien, 79 O. G. 507, C. D. 1897.

MANUFACTURE OF PATENTED ARTICLE OR MACHINE.

(See RIGHT TO MAKE, USE AND SELL.)

MANUFACTURE AND USE OF THEIR INVENTIONS BY PATENTEES.

1. A patentee failed for some years to manufacture his device; *held*, this could not avail to defeat his or his assignees' rights vested in them by the grant of a patent. (Campbell Printing Press and Manufacturiug Co. v. Manhattan Ry. Co., 49 Fed. Rep. 930.) *Masseth v. Johnston, 59 Fed. Rep. 613 (1894).

2. Whether a patentee exercises his exclusive right to his discovery by manufacturing his device cannot affect his exclusive right under the patent. (Masseth v. Johnston, 59 Fed. Rep. 613.) *Masseth v. Reiber, 59 Fed. Rep. 614 (1894).

3. Grants of patents are made upon the reasonable expectation that patentees will use their inventions or permit them to be used; but the public has no security to enforce such expectation beyond the interest of the patentee. *Heaton-Peninsular Button Fastener Co. v. Eureka Specialty Co., 78 O. G. 171, C. D. 1897.

MARKING ARTICLES "PATENTED."

1. Where a manufactured article contains, in addition to what is described and claimed in patents owned by the manufacturer, something which is new, substantial and valuable in the market, he has no right to mark the article as a whole "patented" by reason of his patents, simply because the new article embodies the inventions covered by the patents. *Deverall v. Banker, 45 O. G. 591, C. D. 1888.

2. In an action brought under section 4901 of the Revised Statutes of the United States seeking to enforce a penalty of $100 for each offense for marking articles "Patent Applied for," *held*, that the mark was not an offense, for the reason that it did not import that the article was covered by a subsisting patent. *Schwebel v. Bothe, 49 O. G. 1696, C. D. 1889.

3. Marking of goods with the design claimed to have been infringed, or else notifying the infringer, is a prerequisite to a claim for damages by the party insisting upon such infringement. *Schofield v. Dunlop, 52 O. G. 1369, C. D. 1890.

4. Where marking of goods is omitted, and notice relied upon, the burden of proof is on the plaintiff. *Id.

5. 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, such marking being inferred. *Id.

6. Where a defendant has shown a failure on the part of the plaintiff to mark the articles vended, the burden is upon the plaintiff to show that the defendant was notified before suit was brought that he was infringing. *Id.

7. A defense based upon the failure to mark the date of the patent upon the articles bearing the patented design should be set up in the answer. If set up for the first time in the hearing it will not be considered. *Anderson v. Saint, 57 O. G. 546, C. D. 1891.

8. When a dealer sells articles bearing a patented design knowing that the manufacturer had no license to apply such design, he is liable to the penalty prescribed in the act of congress of February 4, 1887. *Id.

9. Where there is any question under section 4900 of sufficiency of notice to the public that the device sued upon was a patented article, the presumption against the public arising from the record of letters patent in the United States patent office requires the averment of want of knowledge on the part of the defendant in his answer to the bill. *Sessions v. Romadka, 59 O. G. 939, C. D. 1892.

10. The patentee of wooden dishes which might have been marked "Patented," etc., as required by section 4900, Revised Statutes, did not stamp the dishes, but only the crates in

which they were packed. Upon a suit for penalties under the second paragraph of section 4901 against the defendants for placing a similar stamp upon crates of similar dishes made by the defendants without license, *held*, on demurrer to the complaint, that sections 4900 and 4901 must be construed together, that the stamping of articles capable of stamping was necessary, and that the stamping of the crates containing them was insufficient and was not protected by sections 4900 and 4901, and that a similar stamping of their own crates by the defendants did not render them liable to any penalty. *Smith v. Walton, 61 O. G. 289, C. D. 1892.

11. In an action for the recovery of penalties under section 4901, Revised Statutes of the United States, it appeared the article was marked with the number and date of each of the seven patents named in the license under which the defendant claimed it was manufactured and sold, and although it did not contain the improvements set forth in a particular one of the seven patents, there is no evidence even tending to show that it was not covered by them, nor is there any showing that it was in fact in any part unpatented. Judgment for defendant. *Russell v. Newark Machine Co., 55 Fed. Rep. 297 (1893).

12. In an action under the Revised Statutes, section 4901, to recover penalties for marking unpatented articles as "Patented," the jury can only consider cases in which the marking was done within five years before the commencement of the suit and within the judicial district in which it is brought. *Hotchkiss v. Samuel Cupples Wooden-Ware Co., 63 O. G. 1690, C. D. 1893.

13. To render defendant liable for the penalty the marking must have been done for the purpose of deceiving the public, and in determining the existence of such purpose the jury may consider that, although the articles were in fact unpatented, they were claimed to have been manufactured under a certain patent, and that the question whether they were covered by such patent was one upon which persons skilled in the patent law might reasonably entertain different opinions. The fact that defendant may have become convinced sometime after the marking was done that the articles were not covered by the patent would not render it liable. *Id.

14. A corporation may be held liable under this section when the wrongful acts are proven to have been committed by some officer or agent thereof acting within the scope of his authority, knowing that the articles were unpatented and with intent to deceive the public. *Id.

15. The marking of a number of separate articles with intent to deceive the public does not constitute separate offenses when it is all done on the same day and at the same time, so that the marking is practically a continuous act, and in such case but one offense is committed and one penalty is recoverable. *Id.

16. Where the complaint showed that the word "Patented," etc., was not stamped on plaintiff's patented article, as required by Revised Statutes, section 4900, not because of the "character of the article," but because the cost of such stamping would destroy the patentee's profits, *held*, on demurrer to the complaint in an action to recover penalties under section 4901 for an unauthorized use by defendants of the word "Patented," etc., on their articles, that the complaint was demurrable. *Smith v. Walton, 64 O. G. 1789, C. D. 1893.

17. The meaning of section 4900 is that the owner of the patent cannot recover damages of infringers unless he establishes that he has given notice of his patent-right either by marking his article "Patented" or by particularly informing infringers of his patent and of their infringement of it. *Dunlap v. Schofield, 67 O. G. 139, C. D. 1894.

18. This statute requires that, in order to charge either a manufacturer or seller of a patented design, the patentee must prove that the infringer applied the design or some colorable imitation thereof "with a knowledge of the patent and of his infringement." *Id.

19. Where a thing is marked "Patented" as of a date not of its patent, but of the date of an earlier patent to the same patentee, upon which it is an improvement, *held* not to be a compliance with section 4900 of the United States Revised Statutes and to secure to him no right to damages on proof of infringement of the improvement. *Traver v. Brown, 69 O. G. 1071, C. D. 1894.

20. The evidence proved that the articles covered by design patent were marked "as a rule." *Held*, this was insufficient to prove compliance with the statute. *Matthews and Willard Mfg. Co. v. National Brass and Iron Works, 71 Fed. Rep. 518 (1895).

21. "Marking patented articles or notice to the infringers is made by the statute a prerequisite to the patentee's right to recover damages against him." (Cases cited.) *Id.

22. Where it was objected that defendant was not liable because the patented machine was not marked with notice of the patent, *held*, that such defense to be available must be set up in the answer and established by proof. (Rob. on Pat., sec. 1046; Goodyear v. Allyn, 6 Blatchf. 38.) *United States Printing Co. v. American Playing Card Co., 72 O. G. 1499, C. D. 1895.

23. A bill dismissed in view of the failure to mark the goods (design), and the voluntary desistance of the defendant from manufacture when duly notified. When there is failure to mark, notice must be proved. *Pairpoint Mfg. Co. v. Eldridge Co., 71 Fed. Rep. 307 (1896).

24. The contention that there is no proof of public notice by the complainant by marking his machines relates only to the question of damages and does not apply to an injunction proceeding. *Beach v. Inman Mfg. Co., 74 O. G. 379, C. D. 1896.

25. Where plaintiffs have manufactured and sold their device without opposition for upward of five years, there is sufficient proof of public acquiescence, and it is immaterial that a large number of their devices were not marked "Patented" when it appears that enough were so marked to give general notice of the patent. *McDowell v. Kurtz, 78 O. G. 1104, C. D. 1897.

MECHANICAL SKILL.

(See PATENTABILITY — INVENTION AND SKILL DISTINGUISHED.)

METHOD.

(See PATENTABILITY.)

MODELS.

1. A model should not be indorsed upon the file-wrapper and be considered a part of the application unless the applicant has been required by the office to furnish one. Ex parte Beaumel, 56 O. G. 1203, C. D. 1891.

2. The office required a model, which applicant furnished, clearly indicating, however, at that time and subsequently, that he wished the model returned. The office did not, in response to applicant, insist upon the permanent filing of a model, nor were the receipt and application of the model to the case under consideration entered on the file-wrapper, under rule 56. *Held*, on renewed request by the applicant for its return, that the model was not regularly filed, and should be returned. Ex parte Hunter, 59 O. G. 1477, C. D. 1892.

3. A model filed with the application for a patent is not a part of the patent and not available as a defense to prove prior invention. *Lalance & Grosjean Mfg. Co. v. Mosheim, 65 O. G. 300, C. D. 1893.

4. A requirement for a model should be regarded simply as an alternative for an intelligible disclosure of the invention. The requirement may often be waived if better drawings and a full and clear description be furnished. Ex parte Tuttle, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

MORTGAGE OF PATENT.

1. A mortgage by a patentee vests in the mortgagee the whole title to the patent-rights, subject only to be defeated by performance of the condition, or by redemption by bill in equity within a reasonable time after default; and the right of possession to the incorporeal property is, in legal effect, delivered to the mortgagee at the time of the recording of the mortgage at the patent office. *Waterman v. Shipman, 64 O. G. 713, C. D. 1893.

2. The recital in a mortgage of patent-rights of the existence of a license is notice to the mortgagee and purchasers of the patent-rights under the mortgage of all the terms and conditions of the license. *Id.

NEW TRIAL AND REHEARING IN THE COURTS.

1. It is not sufficient ground for reopening a decree on petition of co-defendants that they were only nominal defendants, were ignorant of the patent in suit, and were misnamed in the bill, it appearing that they had answered without objection and the law imputing knowledge of patents as public records. *Bate Refrigerating Co. v. Gillett, 40 O. G. 1029, C. D. 1887.

2. Due diligence in making the motion is required of a party who seeks to correct or amend a decree, and a lapse of more than four years is not reasonable diligence. *Id.

3. A new trial should not be granted if the newly-discovered evidence submitted would not change the result of the verdict and judgment. *Starling v. St. Paul Plow Works, 41 O. G. 818, C. D. 1887.

4. After hearing upon the merits defendant moved to open the case to allow additional testimony to be taken upon a point where testimony had already been put in evidence, and the motion was denied because such additional testimony would be merely accumulative. *Pfanschmidt, Dodge & Co. v. P. H. Kelly Mercantile Co., 41 O. G. 1501, C. D. 1887.

5. Upon an application for rehearing in a suit for infringement of a patent, the invalidity of the patent being re-argued in the light of some additional evidence as to the state of the art, but no reason being assigned for failure to produce this evidence at the hearing, *held*, that the evidence would not be considered. *Burdsall v. Curran, 42 O. G. 1167, C. D. 1888.

6. Courts are uniformly liberal in extending times for the taking of testimony, provided the parties act in good faith and are reasonably diligent; but the degree of diligence required in procuring evidence before trial is not so great as that required to secure a new trial. Especially is this true when the evidence has actually been procured and is in the presence of the court before the trial begins. Osgood v. Badger, v. Bennett, 44 O. G. 1066, C. D. 1888.

7. In a suit for infringement of a patent an application for rehearing after settlement of the case must be denied. *Zinsser v. Kremer, 49 O. G. 414, C. D. 1889.

8. The granting or refusal, absolute or conditional, of a rehearing 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. Neumann, 49 O. G. 1535, C. D. 1889.

9. The judgment of the circuit court awarding damages in an action at law for infringement of said claims reversed, and the case remanded with direction to grant a new trial for the reason that the said court upon the evidence presented ought to have directed a verdict for the defendant on the ground that the patent was void. *County of Fond du Lac v. May, 53 O. G. 1884, C. D. 1890.

10. Where in an action for infringement it appeared that the defendants had introduced evidence in respect to a certain device at the close of a long and expensive hearing before the master, and that while plaintiff's counsel had not brought themselves without question within the rules which ordinarily govern the reopening of a hearing to admit newly-discovered evidence, the plaintiff had not presented that part of its case and had not had a full opportunity to do so, and it appeared that it would be inequitable to say that it never should present it, *held*, that a motion to reopen by plaintiff for the purpose of introducing new testimony in respect to said device should be granted. *Webster Loom Co. v. Higgins, 54 O. G. 390, C. D. 1891.

11. A petition for a new trial, brought as a motion for a rehearing, dismissed, it appearing that the evidence was not newly discovered, much less that it might not have been discovered prior to the previous hearing by the exercise of reasonable diligence. (Spill v. Celluloid Co., 22 Blatchf. 441, 459; Giant Powder Co. v. California Powder Co., 18 O. G. 1339, 5 Fed. Rep. 197, 201.) Bostad and Krabol v. Johnson, 72 O. G. 898, C. D. 1895.

12. Where the claims of a patent had been adjudicated adversely to defendants and at another trial the sole defense relied upon by them was new evidence of anticipation, the burden is upon them to support the defense by such proof as would convince the court that had it been presented upon the former trial it would probably have led to a different conclusion. *Allington & Curtis Mfg. Co. v. Lynch, 74 O. G. 1126. C. D. 1896.

13. Upon a petition for rehearing on the ground that the court of appeals of the District of Columbia had no jurisdiction over an interference case appealed to it, except on the question of priority of invention, and yet that, instead of deciding that question, it decided that appellant was entitled to the patent on account of the relations existing between him and the appellee, *held*, that it was not necessary to adjudge in formal terms that the appellant is the prior inventor when he has been adjudged to be, in law, the only inventor. *Milton v. Kingsley, 75 O. G. 2195, C. D. 1896.

14. The ruling that the time for prosecuting appeals from decrees in equity or writs of error from a judgment at law is stayed by a motion for rehearing or for new trial and only begins to run from the refusal of such motion is founded upon the principle that the judgment is not complete until the rehearing is disposed of. *Ross v. Loewer, 77 O. G. 2141, C. D. 1896.

15. On a rehearing, new testimony for the losing party not in harmouy with previous silence of the same witness for the same party, when such testimony relates to an important feature of the case, is not adequate to satisfy a court that justice toward a losing party requires a rehearing. *Tuttle v. Claflin, 78 O. G. 1739, C. D. 1897.

16. An order by a circuit court to entertain

and grant a petition for a rehearing upon a case decided by the supreme court without previous leave obtained therefrom is irregular and unauthorized, and such action affords good ground for a *mandamus* setting aside such order. *In re C. & A. Potts & Co., 78 O. G. 2049, C. D. 1897.

17. When questions of novelty and infringement are before the supreme court and are disposed of by it, they must be deemed to have been finally settled and cannot afterward be reconsidered by a lower court either by granting a new trial, or a rehearing, or to permit new defenses on the merits by amendment or answer. *Id.

NOVELTY.

(See PATENTABILITY.)

OATH TO APPLICATION.

I. ORIGINAL.
II. SUPPLEMENTAL.
III. NEW OR RENEWED.

I. ORIGINAL.

1. The oath accompanying the application contained the statement that the invention had not been patented to the applicant, "nor with his knowledge or consent in any foreign country," the words "to others" being omitted and the word "foreign" inserted before *country*. Ex parte Mason, 43 O. G. 627, C. D. 1888.

2. *Held*, the oath is indefinite and may be construed to mean that the invention has not been patented to applicant in any country, or to himself in any foreign country, or with his knowledge or consent in any foreign country. Id.

3. If the rules are violated or departed from in one material particular, the practice would soon become lax in other particulars. The several requirements of the rule with regard to the oath must be enforced. Id.

4. The taking of the oath is but a prerequisite to the granting of the patent, and is in no degree essential to its validity. *The Holmes Burglar Alarm Telegraph Co. v. The Domestic Telegraph and Telephone Co., 51 O. G. 2083, C. D. 1890.

5. Only those officials specified in the law (section 4892, Revised Statutes of the United States) *held* to be empowered to administer the application oath. Ex parte Hakansson, 63 O. G. 1688, C. D. 1893.

6. An application oath administered by an official not named in rule 47 *held* to be defective and not to be received and accepted as in full compliance with the rule. Id.

7. Rule 46 has all the force of a statute, and it contemplates that the oath shall set forth that the invention has not been in public use or on sale in this country for more than two years prior to the filing of the complete application. Miller v. Lambert, 72 O. G. 1903, C. D. 1895.

8. A portion of the original application oath relating to foreign patents, and alleged to be erroneous, cannot be canceled, but applicant may file explanations. Ex parte Schmidt-Storjohann, 62 MS. D., Sept., 1897 (Greeley, Ass't Com'r).

9. The oath in an application is not subject to amendment. Ex parte Brand, 63 MS. D., Dec., 1897 (Greeley, Acting Com'r).

10. An oath which does not comply with the requirements of the law is legally no oath and can be given no force and effect. It must give the residence of an applicant as a means of identification. Id.

II. SUPPLEMENTAL.

11. The supplemental oath required under an office rule, that applicant shall make oath that the matter introduced by amendment was a part of the original invention, does not of itself establish the fact that such matter was actually a part of the original invention. Whether the matter covered by the proposed amendment is a departure from the original invention shown and described must be determined by an inspection of the application, the specification and drawing. This is manifest from rule 70. Ex parte Regan, 45 O. G. 589, C. D. 1888.

12. The office of a supplemental oath, as set forth in an office rule, is to justify the introduction by amendment of a claim not substantially embraced in the statement of invention or claim originally presented, and affords no justification for the introduction of matter by way of amendment which is not substantially described or disclosed in the application as filed. Steward v. Ellis, v. Lee, v. Howe, 49 O. G. 1983, C. D. 1889.

13. It is not the province of a supplemental oath to introduce new matter. The supplemental oath simply enables the applicant to

cover and include in his claim such portion of his original disclosure or description as was not embraced in "the statement of invention or claims originally presented." Ex parte Lillie. 53 O. G. 2041, C. D. 1890.

14. The various considerations bearing upon the question whether, in a given case, the right to amend where a supplemental oath is required has been exhausted should be passed upon by the primary examiner in the first instance, and cannot in the nature of the case ordinarily be decided by the commissioner until he obtains the special information, based upon special knowledge, which it is the province of the primary examiner to possess. Id.

15. A supplemental oath is required to justify the insertion of a claim through the medium of a divisional application where it would be requisite if the claim were to be inserted in the parent application. Forbes v. Thomson, 53 O. G. 2042, C. D. 1890.

16. 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. Ex parte Perkins, 55 O. G. 139, C. D. 1891.

17. 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, 58 O. G. 1415, C. D. 1892.

18. The absence of a supplemental oath, although it may be necessary before allowance, does not furnish a ground for rejecting the claims and is an *ex parte* question not open to argument by an opponent in interference proceedings. (Rennyson v. Merritt, 58 O. G. 1415.) Ex parte Weidemann, 81 O. G. 2245, C. D. 1897.

19. Where it appears that it is impossible at the present time for the assignee to obtain the signature of the inventor to a supplemental oath, *held*, that the necessity for such oath may properly be left for consideration until after the decision in the interference under rule 96. Id.

III. New or Renewed.

20. Where an application, executed in Liverpool, England, was filed forty-eight days later, *held*, that the delay was not unreasonable and that an additional oath should not be required. Previously decided cases reviewed. Ex parte Wilson, 63 O. G. 465, C. D. 1893.

21. An additional oath required to an application which, although filed the day after execution of the proper oath, was not completed until more than ten months afterwards. Ex parte Miller, 58 MS. D., March, 1896 (Fisher, Ass't Com'r).

22. An additional or new oath required in the case of several applications filed four to six months after execution of the oaths. The fact that the application papers were filed within a reasonable time after execution of the oaths, but without the fees, does not avail, since the applications were not complete until the fees were paid. Ex parte Enos B. Willix, 62 MS. D., July, 1897 (Greeley, Ass't Com'r).

23. A new oath is required in an application filed seventeen months after the original oath was made. An affirmation by the assignee cannot take the place of the oath the statute requires from the inventor so long as the latter is alive. (Citing Ex parte Stevens, 59 O. G. 209.) Ex parte Elijah McCoy 80 O. G. 2037, C. D. 1897.

PATENTABILITY.

(See Anticipation; Claims.)

I. In General.
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X. Novelty Without Invention.
(a) *Aggregation.*
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(c) *Composition of Matter.*
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(e) *Double or Analogous Use.*
(f) *Mechanical Process or Method.*
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(h) *Product of Nature.*
(i) *Process or Method.*
(j) *Substitution of Materials or Parts.*
(k) *Particular Cases.*

I. In General.

1. One patented machine is an improvement upon another when the general construction and arrangements of parts, the principles of operation, and the results are substantially similar in both instances, although the later machine may be much better than the earlier one. *Aspinwall Mfg. Co. v. Gill, 40 O. G. 1133, C. D. 1887.

2. An inventor of a mechanical invention is entitled to give to it such enhancement by way of ornamentation and decoration as it is capable of receiving, and this without in any way modifying or detracting from his right to a patent. Ex parte Schulz-Berge, 42 O. G 293, C. D. 1888.

3. Although the patentee may be entitled to the merit of being the first to conceive of the convenience and utility of mechanism 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. *Aron v. The Manhattan Ry. Co., 49 O. G. 1365, C. D. 1889.

4. The office should not overlook the fact that it must be shown that invention was exercised in producing the article or machine, and that it is not every person who has made a new or useful thing who is entitled to a patent. Ex parte Devin, 45 O. G. 709, C. D. 1888.

5. 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 known before, and that it shall be useful, but it must, under the constitution and the statute, amount to an invention or discovery. *Hill v. Wooster, 50 O. G. 560, C. D. 1890.

6. The practical inventor who may succeed in building and equipping an air-ship consisting of a metallic shell from which the air has been wholly or partially exhausted, and who may hereafter first teach the world how to practice his invention by disclosing the means invented and discovered by him for overcoming obstacles, should not find himself forestalled by a theorist, and compelled to occupy the position of an infringer, when he is the first person who has ever been in position to teach the world how to build an air-ship operating upon the principle embodied in his apparatus. Ex parte De Bausset, 50 O. G. 1766, C. D. 1890.

7. An inventor is not to be deprived of the fruit of his invention simply because the physical laws upon which it operates are not susceptible of satisfactory exposition. *Knickerbocker Co. v. Rogers, 67 O. G. 1448, C. D. 1894.

8. The object of an invention is not patentable; the means may be. Brush Electric Co. v. Western Electric Co., 77 O. G. 1273, C. D. 1896.

II. Combination.

9. The court finds that one element of the combination claimed in the patent in suit was new, and that the combination was useful, and determines that the invention was patentable. *Temple Pump Co. v. The Goss Pump and Rubber Bucket Mfg. Co., 39 O. G. 467, C. D. 1887.

10. Where the patent in suit remedied serious defects in a former machine by the employment of old devices, it would appear to present a new combination involving invention. *Osborn v. Glazier, 40 O. G. 1137, C. D. 1887.

11. The facts that a patent for a device consisting of a combination of appliances previously used separately was granted after the device had been subjected to rigid scrutiny and comparison with previous patents by the patent office examiners, and that the combination, although useful, did not appear to have been used or proposed before, *held* sufficient to sustain the patent as against a defense of want of novelty. *Shaver v. Skinner Mfg. Co., 41 O. G. 232, C. D. 1889.

12. 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 effecting the same result by a different mode of operation. *Railway Register Mfg. Co. v. Third Avenue Ry. Co., 42 O. G. 379, C. D. 1888.

13. Where the elements of a combination in a claim co-operate in a result, these parts constitute the combination claimed, and all the other parts of the machine which make these parts operate in this way to produce the result required are for that purpose equivalents of the parts of any other machine (however different they may be in themselves) which also make these parts operate in the same way to produce the same result. *Thompson v. Gildersleeve, 43 O. G. 886, C. D. 1888.

14. Claims for combinations distinguished from claims covering elements having a specific construction and arranged in such peculiar relation as to be adapted to use with each other. While it cannot be doubted that it is the better practice in all cases of novel combination to express the claim in combination

form, it sometimes occurs that an invention is of such peculiar character as to render such a claim unimportant. Ex parte Weeks, 43 O. G. 1585, C. D. 1888.

15. A combination claim includes whatever is made a part of the combination by the words of the claim, or by necessary inference is a material part in the construction of the patent. *Thompson v. Gildersleeve, 43 O. G. 886, C. D. 1888.

16. In a combination it makes no difference in principle whether the separate elements are similar to each other or dissimilar if they produce a novel effect. *Stearns v. Phillips, 43 Fed. Rep. 792 (1890).

17. 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, which result, when attained, is the product of the simultaneous or successive action of all the elementary parts viewed as one entire whole. The term "co-operation" does not mean acting together or simultaneously, but unitedly to a common end. *The Holmes Burglar Alarm Telegraph Co. v. The Domestic Telegraph and Telephone Co., 51 O. G. 2083, C. D. 1890.

18. 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 new article without producing any new mode of operation is not invention. *Florsheim v. Schilling, 53 O. G. 1737, C. D. 1890.

19. Pickering v. McCullough, 21 O. G. 73, 104 U. S. 310, examined and explained. It is not necessary in a new combination of old elements that each element should modify or change the characteristic mode of action or method of operation of the others, but only that the combination should produce a new and useful result as the product of the combination, and not a mere aggregate of several results each the complete result of one of the combined elements. Where a new result is produced as a product of the combination, it is enough that each element contributes to its production. *National Cash Register v. American Cash Register Co., 62 O. G. 449, C. D. 1893.

20. *Held*, that the combination is an entirety, and if one of the elements is given up the thing claimed disappears (Vance v. Campbell, 1 Blatchf. 427–429); and this principle prevails even where the patentee has claimed more than is necessary to the successful working of his device. (McLain v. Ortmayer, 57 O. G. 1139, 141 U. S. 419–425.) *Vincent v. Rigby, 64 O. G. 861, C. D. 1893.

21. 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 new article without producing any new mode of operation is not invention. *Deere & Co. v. J. I. Case Plow Works, 65 O. G. 441, C. D. 1893.

22. Where the first advance over an eccentric device for moving the valves in a machine consisted in connecting the valves by a walking-beam, but such beam was in itself an old device and any one might have incorporated it in the combination, *held*, that such combination would not, on account of no one having previously used a walking-beam therein, become patentable unless the elements of the combination interacted in the manner set forth in Bates v. Coe (15 O. G. 337, 98 U. S. 31). Tremain v. Curtiss, 66 O. G. 1447, C. D. 1894.

23. *Quære*, whether, when a machine is designed to manufacture, distribute or serve out to users a certain article, the article so dealt with can be said to be a part of the combination of which the machine itself is another part. *Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co., 67 O. G. 271, C. D. 1894.

24. When a desired object is attained as a result of the mutual relation and co-operation of the several parts of an application embraced in a claim, said claim is for a combination and not for an aggregation. *American Soda Fountain Co. v. Green, 76 O. G. 964, C. D. 1896.

25. The Bowers claims are not mere aggregations, because the result produced is the product of the combination in which each element affects the action of all the others, and all of the elements co-operate in the one result of severing by the forward and side action of the machine the material in place where it is not wanted and depositing it in another place where it is wanted. *Von Schmidt v. Bowers, 80 O. G. 347, C. D. 1897.

26. No combination of elements that so operate can be regarded as a mere aggregation, for each one has a direct influence upon the action of each of the others, the result necessarily being the product of the combination itself and not a mere aggregate of several results each the complete product of one of the combined elements. (Hailes v. Van Wormer, 5 O. G. 89, 20 Wall. 353; Royer v. Roth, 49 O. G. 1987, 132 U. S. 201, 10 Sup. Ct. 58; Reckendorfer v. Faber, 10 O. G. 71, 92 U. S. 347; Beecher Mfg. Co. v. Atwater Mfg. Co., 31 O. G. 306, 114 U. S. 524, 5 Sup. Ct. 1007.) *Id.

27. In a combination of old elements all the parts must so act that each qualities every other. It is not enough that these independent parts are conveniently associated in one machine if each performs the same function it did before they were united. They must be so connected that the new result is due to their co-operative action. (Bunching Machine Co. v. Williams, 44 Fed. Rep. 191, and cases there cited: Green v. American Soda Fountain Co., 78 Fed. Rep. 119.) *Paul Boyton Co. v. Morris Chute Co., 80 O. G. 1894, C. D. 1897.

III. Invention and Skill Distinguished.

28. If to adapt separate elements to each other, so that they can act in one organization, requires the use ot means not within the range of mere mechanical skill, then the means of effecting a mutual a[illegible]gement of the parts would be patentable. The Thatcher Heating Co. v. Burtis, 39 O. G. 587, C. D. 1887.

29. The difficulty of drawing the line between skill and invention considered. The standard of skill is being constantly raised, and the standard of invention is, as a necessary consequent, correspondingly raised. The standard of the date of the alleged invention is that by which the test is to be made. *Wilcox v. Bookwalter Bro. & Co., 39 O. G. 1200, C. D. 1887.

30. Invention may be a discovery or it may be the embodiment, novel and useful, of a mental conception. *Id.

31. The patent system was not designed to protect the chimerical schemes of visionaries or closet theorists. Invention consists in more than the work of the imagination. To conceive of a scheme of vast dimensions is the work of a dreamer; to make the mathematical computations requires the ordinary knowledge of the student; to face the difficulties of construction and devise means to overcome them, is the true work of the inventor. Ex parte De Bausset, 43 O. G. 1583, C. D. 1888.

32. It is not sufficient that an applicant shall have made a *new* and *useful* article or machine; but he must have made an *invention* or *discovery*. It must be the result of the exercise of the inventive faculty, not simply of the mechanical faculty. Ex parte Devin, 45 O. G. 709, C. D. 1888.

33. The courts have uniformly held that the thing said to be new and useful must be the result of *invention*. A mere change or modification, or a mere 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. Ex parte Gibford, 45 O. G. 1557, C. D. 1888.

34. At the time applicant becomes conscious of the fact that there exists in his mental operations and discoveries a distinct process as well as a concrete machine he completes not only the invention of the process, but perfects his knowledge of it, and comes into the status of an inventor who may obtain the security of the patent laws. Ex parte Young, 46 O. G. 1635, C. D. 1889.

35. It is not easy to draw the line that separates the ordinary skill of a mechanic, versed in his art, from the exercise of patentable invention; and the difficulty is specially great in the mechanic arts, where the successive steps in improvements are numerous, and where the changes and modifications are introduced by practical mechanics. *Krementz v. Cottle Co., 48 O. G. 1775, C. D. 1889.

36. To do that which any competent mechanic familar with devices well known in the state of 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. *Aron v. The Manhattan Ry. Co., 49 O. G. 1365, C. D. 1889.

37. It is the province of the inventor to devise, by the exercise of the creative faculty, means for overcoming difficulties which are developed along the lines of theoretical calculation and to demonstrate that that can be done which theorists, basing their computations upon the results of previous experience, have believed to be impossible. Ex parte De Bausset, 50 O. G. 1766, C. D. 1890.

38. Following Ex parte De Bausset (43 O. G. 1583), *held*, that the alleged invention is wholly

theoretical, everything being based upon calculation, and nothing upon trial or demonstration. Id.

39. A conception of the mind is not an invention until represented in some physical form, and unsuccessful experiments or projects, abandoned by the inventor, are equally destitute of that character. *Clark Thread Co. v. Willimantic Linen Co., 56 O. G. 395, C. D. 1891.

40. The word "invention" 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. *McClain v. Ortmayer, 57 O. G. 1129, C. D. 1891.

41. 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. Vollrath v. Comstock, 59 O. G. 1105, C. D. 1892.

42. Whenever in an art, machine, manufacture or composition of matter a change, however apparently minute, is made which is not obvious and results in marked advantages, a patentable invention has been produced. Ex parte Champney, 60 O. G. 1051, C. D. 1892.

43. Changes which turn failure into success and which were not obvious to ordinary mechanical skill constitute invention. *Sayer v. Scott, 63 O. G. 1818, C. D. 1893.

44. It may be safely affirmed that one who perfects a device of confessed utility, which satisfactorily supplies a long-existing and imperative need of any branch of industry, and which excels in operation and results other existing appliances, superseding them at home and abroad, and by its structure overcoming difficulties and objections which have for years baffled the ingenuity of his fellow-craftsmen the world over, has proved beyond cavil that average mechanical skill was not equal to what he has accomplished. *Consolidated Brake-Shoe Co. v. Detroit Steel & Spring Co., 59 Fed. Rep. 902 (1894).

45. It is not the result, effect or purpose to be accomplished which constitutes invention or entitles a party to a patent, but the mechanical means or instrumentalities by which the object sought is attained. (Rubber Tip Pencil Co. v. Howard, 20 Wall. 498, 7 O. G. 172; Fuller v. Yentzer, C. D. 1877, 218, 11 O. G. 551, 94 U. S. 288.) A patentee cannot so split up his invention for the purpose of securing additional results or of extending or of prolonging the life of any or all of its elemental parts. *Miller v. Eagle Mfg. Co., 66 O. G. 845, C. D. 1894.

46. Where the only differences in an applicant's structure over those in the references reside in the skill of its construction, *held*, that such differences embody no exercise of the inventive faculty nor any change not within the range of mechanical ingenuity. Ex parte Snider, 66 O. G. 1309, C. D. 1894.

47. The patentee cast solid certain parts which had before been made separate and soldered together, and thus produced a "very strong and durable" electrode which may be "handled without fear of separation." These are not new results, but the ordinary consequences of casting solid, which is well known in the arts. The new results are facts so ordinary, common and immemorial that courts as well as juries must take notice of them. (Potts v. Creager, 155 U. S. 597.) *Consolidated Electric Mfg. Co. v. Holtzer, 67 Fed. Rep. 907 (1895).

48. To make an apparatus portable is not a patentable improvement. *Black Diamond Coal Mining Co. v. Excelsior Coal Co., 70 O. G. 1797, C. D. 1895.

49. *Held*, that a device, though a simple one, was a creation of the inventive faculty and not a product of mere mechanical skill, since it provided for a want which had been perceived and felt, but which no one had been able to meet. *Diamond Match Co. v. Schenck, 71 Fed. Rep. 521 (1895).

50. The right to improve upon prior devices by making solid castings in lieu of construction of attached parts is so universal in the arts as to have become a common one. *Consolidated Electric Mfg. Co. v. Holtzer, 72 O. G. 415, C. D. 1895.

51. The lowest order of invention is something more than the highest mechanical skill, and the question is not whether a particular or every mechanic could make the improvement, but whether any mechanic might, without invention. *Johnson Co. v. Pennsylvania Steel Co., 72 O. G. 594, C. D. 1895.

52. When it requires more than the discernment of the skilled mechanic to ascertain the cause of the defect in an existing machine and the kind of motion and the proper means of applying it to obviate the defect, there is in-

vention. *Smith v. Macbeth, 73 O. G. 619, C. D. 1895.

53. If the idea of furnishing an element to a device was not present to the mind at the time the thing was made, but was an afterthought perceived from subsequent experiences or scientific inspection and analysis, *held*, that there is no invention in thus by accident supplying the means of a function not contemplated. *Wells v. Curtis, 74 O. G. 495, C. D. 1896.

54. Mere change of proportion is not sufficient to establish difference of invention. *Thomson-Houston Electric Co. v. Western Electric Co., 75 O. G. 347, C. D. 1896.

55. An invention does not cease to be meritorious because it is simple. The test should not be whether the mechanism is simple or complex, but whether the patentee has given the world something new, whether the public is richer for his contribution to the art, whether he has produced novel and beneficial results. Invention should be determined more by an ascertainment of what the inventor has actually accomplished than by a technical analysis of the means by which the result is attained. *Gould Coupler Co. v. Pratt, 75 O. G. 1547, C. D. 1896.

56. Not every change or improvement is patentable invention, and the merits of the exercise of the inventive faculty must be refused to such things as are plainly within the scope of mechanical ingenuity. *Draper v. Seymour, Com'r of Patents, 79 O. G. 864, C. D. 1897.

57. Notwithstanding that appellant's device may be superior in finish, neater in its appearance, and generally better accommodated for the uses for which it is intended than the devices which it is said to have displaced, yet it is not a patentable device. *Id.

58. The matter of elastic suspension by springs and of otherwise giving either entire or partial support is so common in the arts that the presumption is against the patentability of any such mere form of suspension. The selection of a form of support is in the common field of mechanical construction. *Thomson-Houston Electric Co. v. Athol and Orange Street R. Co., 81 O. G. 969, C. D. 1897.

59. It may be that for any established art or any subdivision of any special art there would be invention in so adapting or shaping guides, gouges, packing-boxes or any other common tools and means as to adapt them to the special art or to the special subdivision; but whoever does this cannot, where the field is so common, encroach on any other person's special art or subdivision. *Bates v. Keith, 81 O. G. 1115, C. D. 1897.

60. To change the form of a pin from a round shank with a button-head to a square-shanked pin with an oblong head to overcome a defect in operation was simply a matter of variation in construction and not affecting the substance of the invention claimed, and such change or variation in form could be made by mere mechanical skill, without the exercise of the faculty of invention, in order to render more perfect the operation of the original device. (Pickering v. McCullough, 21 O. G. 73, 104 U. S. 319.) *Hien v. Buhoup, 81 O. G. 2087, C. D. 1897.

61. Form and proportions may sometimes involve patentable invention. (Winans v. Denmead, 15 How. 330; Mabie v. Haskill, 2 Cliff. 507.) *Lovell v. Johnson, 82 Fed. Rep. 206 (1897).

("Now that it has succeeded, it may seem very plain to any one that he could have done it as well. This is often the case with inventions of the greatest merit." *Coon Co. v. Higgins, 21 O. G. 2031.

Whether invention is involved in a particular case must depend upon the facts and circumstances of the latter. *Buttes v. Bainbridge, 29 Fed. Rep. 142 (1886).

For decisions of the United States supreme court determining what degree of development of thought or experiment constitutes invention, see cases cited in American Sulphite Pulp Co. v. Howland Falls Pulp Co., 70 Fed. Rep. 998.

"Invention is evidenced from the long-existing evil which was thereby remedied, and which would have been cured long since in the art, had it depended simply on mechanical skill." *Eppinger v. Richey & Boniface, 12 O. G. 712, C. D. 1877.

When 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. Lidgerwood Mfg. Co., 27 O. G. 718, C. D. 1884. See, also, *Dederick v. Casseli, 20 O. G. 1233; In re Jackson, 1 MacAr.'s Pat. Cases, 485; *Crandall v. Watts, 21 O. G. 945.

A single change, which others failed to discover, and which remedied a grave defect, *held* to constitute a patentable difference. *Adams v. Howard, 26 O. G. 825, C. D. 1884.

The degree of inventive skill is immaterial. *Forbush v. Cook, 2 Fish, 608, 1857.)

IV. Invention and Suggestion Distinguished.

62. The mere suggestion of a use for an invention is not sufficient to make the suggester a joint inventor with the person who invented the device. Logan v. Ringlander, 42 MS. D. (2 G. W. D.), Jan., 1890 (Mitchell, Com'r).

63. Suggestion is not invention. Over twenty years before Bell's invention of the telephone, an eminent scientist had said, "reproduce pre-

cisely these vibrations," to wit, the vibrations made by the human voice in uttering syllables, "and you will produce precisely the syllables;" yet Boursuel neither claimed nor invented the telephone. Whether a suggestion may be styled a "principle" or an "idea," it is a mere abstraction and unpatentable. (Cases cited.) *Consolidated Brake-Shoe Co. v. Detroit Steel & Spring Co., 59 Fed. Rep. 902 (1894).

64. Neither invention nor novelty is negatived by proof of the pre-existence of suggestion, as distinguished from practically available description; and neither is disproved by showing, after the invention in question has been made known, that its object might be obtained by adapting and uniting some of the components of prior inventions in a manner and for a purpose which had not been contemplated. *Diamond Match Co. v. Schenck, 71 Fed. Rep. 521 (1895).

(If suggestion furnishes all the information necessary to enable the patentee to construct the improvement, the patent may be invalidated. *Pitts v. Hall (1851), 2 Blatch. 229 (Judge Nelson). The entire invention must be suggested. *Celluloid Mfg. Co. v. Chrolithion Collar & Cuff Co., 23 Fed. Rep. 397 (1885).

Mere *suggestions* are not sufficient to constitute an invention. They must leave nothing for the mechanic to do but to work out what has been suggested. Hall v. Johnson, 23 O. G. 2411, C. D. 1883 (Marble, Com'r). See decision of United States supreme court in O'Reilly v. Morse, 15 How. 62.)

V. Evidence of Extensive Use.

65. The general introduction and use of driven wells since the date of Green's patent strongly corroborate the supposition that their construction and mode of operation are based upon the application of some natural force not previously known or used. *Eames v. Andrews, 39 O. G. 1319, C. D. 1887.

66. Where the manufacture under the patent had been extensive for several years, where numerous licenses had been granted under it, where the hat manufacturer almost universally had recognized the validity of it, where prior suits had been settled by the defendants in such suits taking licenses, the acquiescence in the validity of the patent may be regarded as established. *Hat Sweat Mfg. Co. v. Davis Sewing Machine Co., 41 O. G. 1273, C. D. 1887.

67. The circumstance that Shipman's apparatus immediately commended itself to the public is persuasive that what he did by way of improvement was not such an obvious thing as to deprive it of the merit of invention. *Shipman Engine Co. v. Rochester Tool Works (Limited), 44 O. G. 1067, C. D. 1888.

68. The utility of the invention is inferentially established by large sales of the patented article. *Schneider v. Missouri Glass Co., 45 O. G. 1069, C. D. 1888.

69. Public acceptance of an invention is persuasive, and warrants a court in sustaining a patent if no anticipating structure is shown. *Chicopee Folding Box Co. v. Nugent, 41 Fed. Rep. 139 (1889).

70. The popularity of a patented device, attested by large and rapidly increasing sales, is an inducement to the court to lean towards a favorable construction of the patent. *Stearns v. Phillips, 43 Fed. Rep. 792 (1890).

71. Where a patented improvement possessed such marked utility and so speedily and universally came into public use as the Pullman vestibule system, *held*, that the court should hesitate to declare the patent invalid for want of utility, because these circumstances tended strongly to prove invention. *Pullman's Palace Car Co. v. Boston and Albany R. Co., 53 O. G. 1255, C. D. 1890.

72. Facts that the Gately packing went at once into such extensive use as almost to supersede all packings made under other methods, and that, although the cost of production was less, the market price was higher for the Gately than the old packings, commented upon as evidence of novelty, value and usefulness. *Magowan v. New York Belting and Packing Co., 57 O. G. 845, C. D. 1891.

73. While in a doubtful case the fact that a patented article has gone into general use is evidence of its utility, it is not conclusive even of that, much less of its patentable novelty. *McClain v. Ortmayer, 57 O. G. 1129, C. D. 1891.

74. Where the question is upon the patentable character of the invention, evidence that it had practically superseded all other devices of its kind and tending to establish novelty is not material. Where there is no invention, the extent of use is not a matter of moment. *Adams v. Ballaire Stamping Co., 57 O. G. 1280, C. D. 1891.

75. The facts that the Dunlop tire was the first one to be commercially adopted, and that the first year after it was put on the market over one hundred thousand were sold in Great Britain, even if the question of patentable novelty were a doubtful one, would go far towards resolving that doubt in favor of the patentee. (Cases cited.) *Featherstone v. George R. Bidwell Cycle Co., 53 Fed. Rep. 113 (1892).

76. The allegation that an improvement claimed to be patentable was simple and perfectly obvious is negatived by the fact that up to the time of its discovery a more expensive compound was in general use. Ex parte Sommer, 58 O. G. 1255, C. D. 1892.

77. Where several inventors are striving for the same end and all of them fall just 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 involves patentable invention. Ex parte Shannon, 59 O. G. 297, C. D. 1892.

78. The fact that a device has gone into extensive public use is entitled to great weight in determining the question of patentable novelty. *Dederick v. Gardiner, 59 O. G. 790, C. D. 1892.

79. Where there had been several unsuccessful attempts to produce a satisfactory article in the trade, and the 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* sufficient evidence of novelty and utility. *Gandy v. Main Belting Co., 59 O. G. 1106, C. D. 1892.

80. Where 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, 59 O. G. 1257, C. D. 1892.

81. 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 improved machine or process displaced wholly or in a great degree prior products; (3) that while the prior products had been unsuitable from lack of cheapness or adaptation the new product answered all reasonable requirements. *Watson v. Stevens, 60 O. G. 1884, C. D. 1892.

82. Where a complainant was an extensive manufacturer, engaged in the special trade to which the patent sued upon relates, yet testified that he had held the patent for seven years but had never put upon the market a chair constructed to conform to it, *held* of great weight in determining the question of "invention" from the standpoint of utility. *Waite v. Robinson, 60 O. G. 1888, C. D. 1892.

83. Large sales of a patented machine, while evidence more or less cogent of value and usefulness, are not conclusive evidence of patentable novelty and are of little weight when it appears that such sales are the result of active and energetic efforts by means of circulars and traveling agents. (McClain v. Ortmayer, 57 O. G. 1129, 12 Sup. Ct. Rep. 76, 141 U. S. 427–429, followed.) *Fox v. Perkins, 62 O. G. 160, C. D. 1893.

84. The fact that a machine is capable of doing more work and at less expense than prior devices, while persuasive, is by no means decisive, and is only available to turn the scale in cases of grave doubt respecting the validity of the invention. *National Hat Pouncing Machine Co. v. Hedden, 63 O. G. 466, C. D. 1893.

85. The fact that a patented article has gone into general use is evidence of its utility, but is not conclusive of that, and still less of its patentable novelty. (McClain v. Ortmayer, 57 O. G. 1129, 141 U. S. 419, 425, and authorities there cited.) *Grant v. Walter, 63 O. G. 910, C. D. 1893.

86. The fact that a patented device gains immediate popularity, meets with large sales, and stimulates the activity of business competitors to produce an equally useful and popular device is an unsafe criterion in determining the question of patentability, and can at most only suffice to turn the scale in favor of the patentee when the question is one of doubt. *Duer v. Corbin Cabinet Lock Co., 63 O. G. 1060, C. D. 1893.

87. The popularity of a patented device may be the result of a more attractive appearance, a more perfect finish, more extensive advertising, larger discounts in price, or greater energy in pushing sales, and even though due to greater usefulness or a particular demand for such a device at the time it is put upon the market, such device does not necessarily contain any patentable feature of construction. *Id.

88. Utility is established by sales which, since the adoption of the improvement claimed, have increased from three hundred to ten thousand or twelve thousand per annum. The patent seems to fall within the settled rule that where a number of persons have all been engaged in repeated, but unsuccessful, efforts to accomplish a certain result, and one of them finally succeeds and secures a patent therefor, the courts will not be inclined to adopt such a narrow con-

struction as would be fatal to the validity of such patent. (Cases cited.) *Stahl v. Williams, 64 Fed. Rep. 121 (1894).

89. When the question is whether the patented device exhibits patentable invention, the fact that it is has gone into general use and displaced other like devices is always of importance and entitled to weight. (Smith v. Goodyear Dental Vulcanite Co., 11 O. G. 246, 93 U. S. 495.) *Keystone Mfg. Co. v. Adams, 66 O. G. 654, C. D. 1894.

90. Where the change in the patented hook is beneficial and embodies a new and better mode of operation; where numerous other patents have issued for hooks between the dates of invention of the alleged anticipating hooks and the patented hook, without its having occurred to those skilled in the art to make the change; where the best of the prior inventions met with only moderate success, and where the patented hook has great utility, extensive public use, and marked commercial success, *held*, that these considerations are sufficient to resolve any doubt on the question of patentability in favor of the patentee. *Richardson v. Shepard, 67 O. G. 144, C. D. 1894.

91. A pipe-cutter was seemingly without patentable invention; but it was shown that sales thereof had increased from three thousand nine hundred and twenty-six in 1885 to ten thousand seven hundred and twenty-seven in 1891. There was nothing to show to what extent price, workmanship, liberal discounts to dealers and extensive advertising had contributed to the success in introducing the tool. It appeared, also, that an old form of cutter still remained in very general use, and that there was a strong competitor in another patented cutter. *Held*, that the increased use was not sufficient to show patentable invention. *Saunders v. Allen, 67 O. G. 1330, C. D. 1894.

92. In a suit on a patent, when the other facts leave the question of invention in doubt, the fact that the device has generally displaced other devices of its kind on its merits, *held* to be sufficient to turn the scale in favor of invention. *Krementz v. S. Cottle Co., 69 O. G. 241, C. D. 1894.

93. While the patented article may have been popular and met with large sales, *held* those facts are not important when the alleged invention is without patentable novelty. (Citing Duer v. Lock Co., 63 O. G. 1060, 149 U. S. 216.) *Olin v. Timken, 69 O. G. 1361, C. D. 1894.

94. Where the record shows that plaintiff's device was novel in construction, that it was useful, and that it went into immediate and general use, the appellate court cannot hold that the jury should have been instructed that there was no invention therein. *Holmes v. Truman, 73 O. G. 448, C. D. 1895.

95. Extensive recognition by the public, large sales, and the fact that manufacturers have generally taken license under the patent, are potential facts largely influencing the judgment of the court. *Robbins v. Dueber Watch Case Mfg. Co., 74 O. G. 965, C. D. 1896.

96. The facts that a patented device was the first successful device and is of the greatest utility, and the further facts of long-continued use and public acquiescence, confirm the presumption of invention in the patent and entitle it to favorable consideration. *A. B. Dick Co. v. Henry, 75 O. G. 1204, C. D. 1896.

97. Invention cannot be predicated upon popularity alone. *Ypsilanti Dress Stay Mfg. Co. v. Van Valkenburg, 76 O. G. 333, C. D. 1896.

98. Where the patentability of a device is not clear, extensive sales may resolve the doubt of patentability in favor of an applicant. This, however, is an unsafe criterion and must be cautiously applied. Ex parte Flomerfelt, 76 O. G. 2007, C. D. 1896.

99. The fact that a machine has met great favor and general acceptance in the trade can have no persuasive force in view of the prior art, which limits the claim simply to the exact combination specified. *Rowlett v. Anderson, 76 Fed. Rep. 827 (1896).

100. Extensive use is only to be considered evidence of invention in doubtful cases, and it loses its force when attributable to another device used in connection with the alleged invention and which was useful and popular. *Dueber Watch Case Mfg. Co. v. Robbins, 77 O. G. 154, C. D. 1896.

101. That an invention has readily overcome initial distrust and disfavor, has had a phenomenal growth, and has acquired widely-extended mechanical and commercial success, are facts which testify powerfully to the novelty of the invention. *Dodge v. Post & Co., 78 O. G. 339, C. D. 1897.

102. The fact that the patentees are the first in an art in which there are many inventors and the fact that their device is the only one now used are significant of invention. *Fairbanks Wood-Rim Co. v. Moore, 79 O. G. 514, C. D. 1897.

VI. Evidence of Result.

103. A patent for a device or process used for one purpose cannot be patented to use in the same way for another similar purpose; but where a new and useful result is produced thereby it is patentable. *Byerly v. Cleveland Linseed Oil Works, 31 Fed. Rep. 73 (1887).

104. Shipman combined in effectual relations an automatic regulator, which was not novel in itself, with the atomizers of earlier patents. This combination presents one test of patentable invention if it produced a new result due simply to the combination. *Shipman Engine Co. v. Rochester Tool Works (Limited), 44 O. G. 1067, C. D. 1888.

105. A change in the method of making an article of manufacture producing a different and beneficial result, although the difference consists only in improving or cheapening the article, and the change and its advantages not having been seen or made by others interested in seeing and making it, is sufficient evidence of invention to sustain a process patent. *Zinsser v. Kremer, 48 O. G. 114, C. D. 1889.

106. 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. Ex parte Scriven, 57 O. G. 1128, C. D. 1891.

107. When a change however minute is made which was not obvious and results in marked advantages, and when such a change has remained unmade for a considerable time, in spite of inducements to make it by reason of its value, that is evidence approaching the conclusion that change was not obvious. Ex parte Champney, 60 O. G. 1051, C. D. 1892.

108. 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. (Affirming 50 Fed. Rep. 542.) *Illinois Watch Co. v. Robbins & Avery, 61 O. G. 721, C. D. 1892.

109. The fact that a device has utility and will perform that which no prior device will do is evidence of patentable novelty, and in a doubtful case will turn the scale in favor of the patentee. *Sayre v. Scott, 63 O. G. 1818, C. D. 1893.

110. Simplicity in change of constructions does not negative patentability where the change produced a new and beneficial result never attained before. *American Cable Ry. Co. v. Mayor, etc. of City of New York, 64 O. G. 1008, C. D. 1893.

111. A change of form and proportions may be patentable where new result is produced. *Front Rank Steel Furnace Co. v. Wrought Iron Range Co., 72 O. G. 288, C. D. 1895.

112. Where it appears that all the elements of the combination claimed in the patent are old, but a new and valuable result has been obtained, the safety and efficiency of the machine greatly enhanced, and the profits resulting from its operation greatly increased, *held*, that the combination itself displays invention. *United States Printing Co. v. American Playing Card Co., 72 O. G. 1499, C. D. 1895.

113. A patent for the re-use of previously-cooled slag, which consists of remelting it with lime (or with silica, or with both) and then converting the mixture into mineral wool, is not anticipated by processes which consist in using slag before it has cooled, for the same purpose, when it appears that the patentee was the first to use successfully previously-cooled slag and when it appears that his product is superior to the former product. *Western Mineral Wool and Insulating Fibre Co. v. Globe Mineral Wool Co., 77 O. G. 1127, C. D. 1896.

114. Simplicity does not negative invention, when a new and useful result is accomplished, where the process has clearly assisted in the manufacture of the product, and where, if the process were to be eliminated from public knowledge, loss to the public would result. *Id.

("If a new and useful result is produced, neither the simplicity of the structure nor the greater or less amount of invention or intellect employed as an element are of importance in determining the validity of the patent." Teese v. Phelps, 1 McAll. 48.

"A change made in an old device, which though simple is effective, and produces a new and useful result, *held* to involve invention." Sewing Machine Co. v. Frame, 24 Fed. Rep. 506.)

VII. Utility.

115. The office is bound to raise the question of utility of an alleged invention in cases where natural laws and established principles are disregarded, for the reason that the law does not authorize the grant of letters patent except for novel and useful inventions. In such cases, even if novelty were admitted, a patent would be withheld until applicant should demonstrate the operativeness of his de-

vice. *Ex parte* statements or theoretical arguments are not sufficient; applicant must prove by practical demonstration his assertions. Ex parte De Bausset, 43 O. G. 1583, C. D. 1888.

116. The patent office is bound to take notice of the question of utility, and the grant of a patent is assurance to the public of the favorable conclusion of the office thereon. Id.

117. The patent for a "toy automatic racecourse," used only for gambling purposes in saloons, bar-rooms and other drinking places, is not "useful" in the sense of the statute. The term "useful" is applied to inventions which are of beneficial use in society in contradistinction to those which are injurious to the morals, health or good order of society. (Following Bedford v. Hunt, 1 Mason, 302.) *National Automatic Device Co. v. Lloyd, 40 Fed. Rep. 89 (1889).

118. In an application for an inflatable uterine supporter the examiner required cancellation of a figure; on petition the commissioner said, in substance, that the case appeared to be presented and prosecuted in such an unseemly manner that the applicant was entitled to nothing. Therefore the application was ordered stricken from the files. Ex parte Nelson, 58 MS. D., Jan., 1896 (Seymour, Com'r).

119. The degree of utility of a device is unimportant in determining whether a device be patentable. If the invention is not frivolous or prejudicial to the public and has any degree of usefulness, no matter how slight the practical utility, then within the meaning of the law it is useful and may be patented. Ex parte Sanche, 80 O. G. 185, C. D. 1897.

120. The degree of utility is not a question for the patent office to arbitrarily determine. The mere assertion of theorists that they do not believe that a device possesses utility cannot prevail against the evidence of reliable witnesses who have by tests demonstrated that it does possess such utility as is claimed for it. Id.

121. Letters patent for improvements in coin-controlled apparatus, *held* invalid for want of utility, as the only use to which the inventions have been put or applied is for gambling purposes. *Schultze v. Holtz, 81 O. G. 2249, C. D. 1897.

122. A statement in a verified answer that complainant's invention is used only for gambling purposes in saloons and bar-rooms and cannot be used for any other purpose is sufficient evidence of want of utility, in the absence of testimony supporting the patent, to overcome the *prima facie* case made by the patent itself. *Id.

(See Mitchell v. Tilgham, 19 Wall. 287, 5 O. G. 299, for definition of utility.)

VIII. Burden of Proof on Applicant.

123. Where an applicant for a patent upon a method of telephonic transmission, having described his apparatus, claimed in various forms of statement the method of reproducing articulate speech as well as other sounds by intermittent impulses of electricity, *held*, that the burden was upon the applicant to show, *first*, that his apparatus made and broke the circuit while operating to transmit speech; and *second*, that it was because of the make-and-break characteristic that articulate speech was reproduced; and *held*, that if the first proposition had been established the applicant had failed to establish the second; and *held*, that the opinion of the experts of the office that the effect of reproducing speech was due to varying pressure, the initial contacts having been established, and not to the "fine staccato punctuations or discontinuities," must prevail. Ex parte Barney, 53 O. G. 1569, C. D. 1890.

124. The burden is upon the applicant to establish, by proof that is clear and conclusive, the patentability of the invention as claimed. *Durham v. Seymour, Com'r of Patents, 71 O. G. 601, C. D. 1895.

125. In an application for a patent the onus of showing that all the conditions and provisions of the law have been fully complied with, making it appear that the inventor is justly entitled to a patent under the law, and showing that the invention is sufficiently useful and important to justify the issue of a patent, is upon the applicant. *Drawbaugh v. Seymour, Com'r of Patents, 77 O. G. 313, C. D. 1896.

IX. Novelty and Invention.

(a) *New Use or Adaptation.*

126. The purpose, object and result of the application of heat in the method described in the patent differing from that before employed in the manufacture of other kinds of springs made such method patentable. *Cary v. Lowell Mfg. Co. (Limited), 40 O. G. 1239, C. D. 1887.

127. 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 *sim-*

ilar sphere of action, where it performs substantially the same function, does not involve invention. *Western Electric Co. v. La Rue, 55 O. G. 571, C. D. 1891.

128. If an old device or process be put to a new use which is not analogous to the old one, and the adaptation of such process to the new use is of such a character as to require the exercise of inventive skill to produce it, such new use will not be denied the merit of patentability. *Ansonia Brass and Copper Co. v. Electrical Supply Co., 58 O. G. 1692, C. D. 1892.

129. It is not sufficient to constitute anticipation that the device relied upon might by modification be made to accomplish the function performed by the patent in question if it were not designed by its maker, nor adapted, nor actually used for the performance of such functions. *Topliff v. Topliff, 59 O. G. 1257, C. D. 1892.

(See. also, Westinghouse v. New York Air Brake Co., 59 Fed. Rep. 581; Telephone Co., 57 Fed. Rep. 842; New Departure Bell Co. v. Bevin Bros. Mfg. Co., 61 Fed. Rep. 651, 1895.)

130. An adaptation of an old machine to the new purpose which was proposed almost simultaneously by three distinct and independent parties by an alteration of mechanism slightly different structurally, but the same in principle in each case, is evidence that such change was obvious and did not involve invention. *Bromley Brothers Carpet Factory v. Stewart, 61 O. G. 1481, C. D. 1892.

131. Where the novelty of an invention resides in the particular form adopted, it is not negatived by prior structures in another art which are not capable of doing its work, though afterward, in the light of that invention, they can be modified to perform its function. *Knickerbocker Co. v. Rogers, 67 O. G. 1448, C. D. 1894.

132. When re-adaptation—a decided change of form—is essential to success of a machine in its changed use, invention is inferable. *Id.

133. The patentee sewed the edges of celluloid sheets between leather bindings so that they were held by the stitches. It was a discovery that they could be thus sewed and held. This does not appear to be a merely mechanical double use, but a new use brought about by contrivance, experiment and adaptation. Such use held patentable. (Citing Potts v. Creager, 155 U. S. 597, 15 Sup. Ct. 194.) *Collins v. Gleason, 68 Fed. Rep. 915 (1895).

134. The bringing together, adapting in size, proportion and relation, and so inclosing parts as to form a tool capable of guidance by the hand in drilling, involves invention over prior like parts operating by steam or air in engines of various sorts. (Citing Potts & Co. v. Creager, 155 U. S. 597.) *American Pneumatic Tool Co. v. Fisher, 69 Fed. Rep. 331 (1895).

135. Where the alleged novelty consists in transferring a device from one branch of industry to another, the answer depends upon a variety of considerations. In such cases we are bound to inquire into the remoteness of relationship of the two industries; what alterations were necessary to adapt the device to its new use, and what the value of such adaptation has been to the new industry. If the transfer be to a branch of industry but remotely allied to the other, and the effect of such transfer has been to supersede other methods of doing the same work; the court will look with a less critical eye upon the means employed in making the transfer. *Potts & Co. v. Creager, 70 O. G. 494, C. D. 1895.

(In this important case, upon newly-discovered evidence, a new trial was granted by the circuit court without leave obtained from the supreme court, and the patent declared invalid. (See 80 O. G. 186, C. D. 1897.) The case was again taken to the supreme court and the action of the circuit court criticised as unauthorized and irregular, and as good ground for *mandamus*. See "Mandamus;" In re C. & A. Potts & Co., 78 O. G. 2047, C. D. 1897.)

136. Combinations of parts in a clay-disintegrator are not anticipated by a cylinder with cutting-blades in its periphery for grinding apples, nor by a cylinder for preparing paper, nor for polishing wood, nor by such like devices in other arts which were not used for a purpose analogous to that in the patent nor operated in the subject-matters in a way like that of the patented apparatus. *Id.

137. Where the devices alleged to anticipate the patented device were not designed to meet nor subjected to conditions analogous to those of the patented thing, *held*, that such prior structures did not anticipate the patented device. *National Meter Co. v. Thompson Meter Co., 70 O. G. 925, C. D. 1895.

138. Where the divergence between the uses of two devices is so radically extreme, the conditions so radically different, and the difficulties so peculiar to the one that the adaptation of what was useful in one sphere to use in another would possibly require more inventive faculty than the creation of something novel in itself, the new adaptation is not double use. (Potts v. Creager, 70 O. G. 494, 155 U. S. 607,

cited.) *Taws & Hartman v. Laughlin & Co., Limited, 73 O. G. 287, C. D. 1895.

139. A new combination and arrangement of old parts, whereby spinning-spindles instead of running in rigid bearings are flexibly mounted on the rails, so as to allow of greatly-increased speed of revolution, *held* to involve invention and not to be anticipated by the use of similar devices in centrifugal machines for drying sugar or creaming milk. The two devices are so different in size, structure aud uses to which they are adapted that it is not a case of double use. (Potts & Co. v. Creager, 70 O. G. 494, 15 Sup. Ct. 194, 155 U. S. 607, applied.) *Taylor v. Sawyer Spindle Co., 77 O. G. 452, C. D. 1896.

140. Under the decision in Potts v. Creager (70 O. G. 494, 155 U. S. 597), power picks and plows are not anticipations for a mining machine, since they do not belong to related arts. *Independent Electric Co. v. Jeffrey Mfg. Co., 78 O. G. 797, C. D. 1897.

141. Novelty is not negatived nor overcome by showing prior construction of a similar thing for a wholly different and foreign use not suggestive of the particular use to which the patented invention is applied. (Cases cited.) *Kinnear & Gager Co. v. Capital Steel-Metal Co., 81 Fed. Rep. 491 (1897).

142. A patent for a panel or ceiling section stamped from sheet-metal plates caunot be defeated by showing a continuous sheet in a bird-cage bottom, or tea-tray, coal-vase cover, etc. The only resemblance is in the merest outline of form, and there is not the slightest resemblance suggested in the end accomplished, or in the uses to which the two things are applied. *Id.

143. An invention, whether original or an improvement, is not anticipated by a thing which was in its original form and use neither designed, adapted nor actually used to perform the same function; nor by showing a prior construction of a similar one for a wholly different and foreign use. (Cases cited.) *Id.

144. An old device or process put to a new or non-analogous use, and the adaptation to the new use requiring the exercise of inventive skill, patentability is involved. *Ansonia Brass & Copper Co. v. Electrical Supply Co., 144 U. S. 11, 12 Sup. Ct. 601.

(b) *Process and Method.*

145. Where a process is capable of being carried on by a variety of apparatus, the validity of the claim is not affected by the want of novelty in the apparatus if the process is new and produces a new result. *New Process Fermentation Co. v. Maus, 39 O. G. 1419, C. D. 1887.

146. A process may be patentable irrespective of the particular form of instrumentalities used. *Eastern Paper Bag Co. v. Standard Paper Bag Co., 41 O. G. 231, C. D. 1887.

147. The omission of one step of an old process with improved result constitutes a new process. *Lawther v. Hamilton, 42 O. G. 487, C. D. 1888.

148. Where the new process requires greater care, or even greater skill, on the part of the workmen than formerly, it does not change its character as a process or materially affect its utility. *Id.

149. Where it appeared that the process embraced in applicant's claim was such that it could be performed by certain machines other than that disclosed in his application, that it could be performed by hand, and that the said process was invented before the machine which which carried it out, *held*, that such process was patentable and was not the mere function of the machine, regardless of the fact that applicant has an application pending covering the machine. (Following Ex parte Young, 46 O. G. 1635.) Ex parte Kerr, 53 O. G. 919, C. D. 1890.

150. If one of the steps of a process is novel for the purposes in hand, it gives novelty to the process considered as a whole. Ex parte Kalteyer and Bartholomew, Jr., 57 O. G. 1127, C. D. 1891.

151. Where the essential feature of the improvement is the method of manufacturing structural material by working the material from the center toward the ends consists in operating upon all parts of the cross-section of the material at every pass, and the best mode of applying the improvement is explained in connection with the applicant's machine for rolling structural material, and the references only indirectly disclose methods for shaping round and convex forms in the art of rolling iron bars, *held*, that the method is not the mere function of applicant's machine nor a discretionary variation of the well-known practices indicated by the references. Ex parte Butz, 67 O. G. 677, C. D. 1894.

152. Passing upward through falling impurities and flour commingled a current of air purified by centrifugal action, then subjecting the dust-laden air to centrifugal action, and finally passing the air so purified back to be used again and again in the same series of

steps, all in closed chambers and conduits, constitute a true process. Ex parte Holt, 68 O. G. 536, C. D. 1894.

153. Such process is patentable over one consisting of the same steps except that the purification of the dust-laden air is effected by the agency of a setting-chamber in place of a vortex-chamber. Id.

154. It is patentable over a process consisting of the first and second steps followed by the discharge of the purified air in the mill instead of its use over and over again in a closed circuit. Id.

155. It is patentable and is not the mere function of a machine, although but one apparatus is known or suggested for carrying the process out, and that the one patented to this applicant, the process and the apparatus having been originally in one and the same application. Id.

156. The cooking of various grains and crushing or otherwise breaking or dividing while in a soft state were old and well-known processes. The patentee prepared peas by cooking them, and flattening them while moist, without breaking them, thus changing their normal shape and preserving their individuality. Patent held valid. *Everett v. Haulenbeck, 68 Fed. Rep. 911 (1895).

157. Processes of manufacture which involve chemical or other similar elemental action are patentable, though mechanism may be necessary in the application or carrying out of such processes. *Risdon Iron and Locomotive Works v. Medart, 71 O. G. 751, C. D. 1895, 158 U. S. 68.

158. Where mechanism to carry out a process is subsidiary to the chemical action, *held*, that the fact that the patentee may be entitled to a patent upon his mechanism does not impair his right to a patent for the process, since he would lose the benefit of his real discovery, which might be applied in a dozen different ways, if he were entitled to such patent. *Id.

159. A process of reducing fibrous sheets to a soft and pliable condition by first moistening and then pounding the sheets while in a moist condition is not a mere mechanical process or an aggregation of functions within the limitation announced by the supreme court in the case of Risdon Iron and Locomotive Works v. Medart (71 O. G. 751, 158 U. S. 68). The moistening of the sheets and the treatment in a moistened condition is more or less chemical in its character. *American Fibre Chamois Co. v. Buckskin Fibre Co., 75 O. G. 833, C. D. 1896.

160. A process of spotting tobacco leaves, whereby they resemble Sumatra tobacco leaves, *held* to be a useful invention or discovery and entitled to a patent. Ex parte Rickard & Long, 62 MS. D., July, 1887 (Butterworth, Com'r).

(c) *Particular Cases.*

161. Wooden troughs with a covered float and valve at one end were old, and iron troughs with a standing supply-pipe and an overflow were old. The trough of complainant having a supply-pipe and an incased valve and float so arranged that the inflow of water came from the bottom of the trough through openings in the case involved patentable invention. *North American Iron Works v. Fiske, 39 O. G. 1086, C. D. 1887.

162. The problem which confronted the patentee he solved by simple means, it may be, but successfully and with highly beneficial results. The problem was new, and its successful solution was not obvious. *Hussey Mfg. Co. v. Deering, 40 Fed. Rep. 87 (1889).

163. The substitution in an evaporating apparatus of comparatively short parallel tubes for the old coils of pipe, and the addition of a separating-chamber into which they discharge both the liquid and vapor, with provision for an equal supply to each of the tubes, together with other changes from the old devices of less consequence, declared to constitute patentable novelty. *Sugar Apparatus Mfg. Co. v. Yaryan Mfg. Co., 53 O. G. 920, C. D. 1890.

164. Steel springs made of flat sheet steel have been used in a manner to give a tortional spring action. *Held*, that they did not anticipate spiral springs which operate on a straight line, tilt or draw, and have a regular yield. The two springs belong to different classes, and the flat spring has not been successful. *Rocker Spring Co. v. Flinn (six cases), 46 Fed. Rep. 109 (1891).

165. The difference between plaintiff's wick carrier and all others produced is small, but it is an essential and useful difference, and therefore patentable. *Wilson v. Ansonia Brass & Copper Co., 48 Fed. Rep. 681 (1891).

166. The use of a coiled spring in an angler's fly-book for holding the flies is not anticipated by a leaf spring adapted to hold one fly each. It performs new and useful functions in its new relation. Bray's fly-book has displaced the old ones by reason of its superiority. *Bray v. United States Net and Twine Co., 70 Fed. Rep. 1006 (1895).

167. A foot-board in a row-boat curved upward at an angle of about forty-five degrees, *held* to be a patentable invention, despite the common practice of turning up or curving of foot-rests, in view of the facts that what the patentee accomplished by this simple expedient had not occurred to other experimenters, and that it came into general use after it had been suggested by him. *Davis v. Parkman, 71 Fed. Rep. 961 (1895).

168. The Brown and Stillman patent No. 488,494, dated December 20, 1892, for a pneumatic tire containing an inflatable tube and made inextensible circumferentially by means of circumferential reinforcements along two lines within the edges and above the bottom of the groove, whereby the tire is made to seat itself on inflation and the necessity for mechanical connection with the rim is obviated, construed as to the first claim, which is *held* to show patentable invention and to be infringed by the Moomy patent, No. 513,617, of January 30, 1894. *American Dunlop Tire Co. v. Erie Rubber Co., 74 O. G. 963, C. D. 1896.

169. A construction which consists in giving the holes in a gas-heater a downward inclination, when such construction is attended by greater efficiency, is patentable over the prior art, which consisted in the use of holes with a horizontal or with only an accidental inclination. *Taylor Burner Co. (Limited) v. Diamond, 76 O. G. 477, C. D. 1896.

170. Upon the evidence, the device is not worthless; and if it be said the results obtained are due to the imagination of the patient, it may be replied as in Ex parte Kram, 26 MS. D. 424, that "if some scientist will devise some way or means of working on the imagination so as to cure physical disease he will be a public benefactor and this office will be prompt to issue a patent, if his invention has the element of novelty." Ex parte Sauche, 61 MS. D., June, 1897 (Butterworth, Com'r).

171. Though the only difference in the methods of producing a knitted fabric consists in the use of a single different yarn, the two fabrics, being articles of manufacture, may be patentably distinct. *Hanifen v. E. H. Godshalk Co., 79 O. G. 510, C. D. 1897.

172. The substitution for a wheel-rim made of a single piece of metal of a laminated rim made of a series of sections so constructed as to form a compact, durable, symmetrical and highly efficient structure involved invention. *Fairbanks Wood Rim Co. v. Moore, 79 O. G. 514, C. D. 1897.

173. A cylindrical journal-bearing provided with a conical journal obliquely placed, so that the surfaces of the two have a line of contact, is patentable over a ball-and-socket bearing in which there is but a point of contact, and a claim therefor does not express merely the function of the machine. *Gates Iron Works v. Fraser & Chalmers, 79 O. G. 2015, C. D. 1897.

174. Though a chuck at first sight seems to present nothing beyond a simple duplication of an old chuck, the fact that the single chuck was used for many years, while a need was felt for something to do the work which the double chuck now performs, and the further fact that defendants as soon as they heard of the improvement adopted it, are sufficient to establish original conception on the part of the inventor and not mere skill. *Gindorff v. Deering & Co., 80 O. G. 653, C. D. 1897.

X. Novelty Without Invention.

(a) *Aggregation.*

(For authoritative definition of "aggregation" see decision of U. S. Sup. Ct. in Halles v. Van Wormer, 5 O. G. 89, 20 Wall. 358; also, Reckendorfer v. Faber, 10 O. G. 71, C. D. 1876; Pickering v. McCullough, 21 O. G. 73, 104 U. S. 310.)

175. Simply transferring the well-known fuel-magazine from an outstanding base-burning stove to a fire-place heater, when each of the parts performed the same functions and operated in the same way as in the old relation, produces an aggregation of old elements, and does not possess patentable novelty. *Thatcher Heating Co. v. Burtis, 39 O. G. 587, C. D. 1887.

176. Where two old and well-known devices are brought into juxtaposition, and each continues to perform its old function, without any new result issuing from their united action, no patentable combination is produced. *Dosh v. A. J. Medlar Co. (Limited), 40 O. G. 1242, C. D. 1887.

177. Where there was merely a good selection from among known joints and involved good workmanship and apparently nothing more, there was no patentable invention. *Babcock & Wilcox Co. v. Pioneer Iron Works, 43 O. G. 756, C. D. 1888.

178. A convenient arrangement of old operative parts, each part doing in the combination what it had done before, is but an aggregation, and not a patentable combination. *Jones v. Clow, 39 Fed. Rep. 785 (1889).

179. An old oil reservoir with an old coil-burner and an old fire-pot mounted upon it, by which arrangement of such old parts together a more portable and convenient heater is produced, does not form a patentable combination since no new result is produced. *Id.

180. The mere aggregation of processes, each accomplishing independent of the other its well-known result, is not patentable, any more than a mere aggregation of mechanical devices. Ex parte Gent, 41 MS. D. (1 G. W. D.), Nov., 1889 (Mitchell, Com'r).

181. A claim consisting of a number of elements which do not co-act to produce a new and useful result is a mere aggregation and not a patentable combination. *Brinkerhoff v. Aloe, 46 O. G. 333, C. D. 1889.

182. Where several old elements are so combined as to produce a better instrument than was formerly in use, but each of the old elements does only what it formerly did in the instrument from which it was borrowed and in the old way, *held*, that the combination is not a patentable one. *Id.

183. Where the joint operation of mechanical parts, old in themselves, when combined is the same as and only that of their separate operation in the 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 change is merely mechanical, and does not rise into the realm of invention. *Ide v. Ball Engine Co., 49 O. G. 283, C. D. 1889.

184. An alleged combination which consists in a mere aggregation of parts, each to perform its separate and independent function substantially in the same manner as before combination with the other and without contributing to a new and combined result, is not patentable. *Watson v. The Cincinnati, Indianapolis, St. Louis & Chicago Ry. Co., 49 O. G. 1843, C. D. 1889.

185. Claims which cover merely placing several apparatus side by side, and connecting them in substantially the same manner as had previously been done with analogous apparatus, a pump to cause a flow of liquid from one to another being the only new element, do not, even though the individual apparatus had a special fitness for such connection, cover patentable novelty. *Sugar Apparatus Mfg. Co. v. Yaryan Mfg. Co., 52 O. G. 920, C. D. 1890.

186. The patent was for a corset that involved nothing original in the construction of its parts, nor in their relation to one another, nor any change in the function of any one of them; the combination of them produced no original mechanism or device. *Florsheim v. Schilling, 53 O. G. 1737, C. D. 1890.

187. Inasmuch as the angle-door of the patent in suit was an old contrivance, and as locks and bolts upon doors were old, *held*, that the combination of it with the safe lock or bolt I, claimed in claim 1, was not new or patentable. *Held* further, that the combination of an angle-door with a lock of any kind was not a patentable invention, even though the particular lock had not before been put upon an angle-door. *County of Fond du Lac v. May, 53 O. G. 1884, C. D. 1890.

188. 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 the devices and the grating. The case was one of mere aggregation. *Id.

189. *Held*, that so far as the grating was sought to be made an element in the combinations of claims 3 and 4 it was not an element of the mechanism. It was no part of the machine and had no effect upon its operation. *Id.

190. Where in a suit for infringement it appeared that all the elements of the claims of the patent in suit were to be found in various prior patents—some in one patent and some in another, but all performing like functions in well-known inventions having the same object as the patent in suit—and that there was no substantial difference between a certain old and well-known metal-cutter and the patentee's cutter, except in the configuration of their molded surfaces, *held*, that such a combination of old elements did not constitute patentable invention. *Held* further, that said difference in configuration was not a patentable difference, even though the one cutter was used in the metal art and the other in the leather art. *Busell Trimmer Co. v. Stevens, 53 O. G. 2044, C. D. 1890.

191. There is no invention in aggregating in a single vendible commodity magnesium adapted to use for flash-light purposes and put up in a case or shell and a time-fuse attached to said case or shell for communicating fire to the magnesium. The improvement may possess commercial advantages, but it lacks the quality of invention. Ex parte White, 54 O. G. 387, C. D. 1891.

192. A combination of old elements, when

no new function is performed by the combination, is a mere aggregation, and hence not patentable. *Union Edge Setter Co. v. Keith, 55 O. G. 285, C. D. 1891.

193. An aggregation of old devices, each working out its own office without securing some new and useful result as the joint product of the combination, does not constituto a patentable invention. (Quoting Hailes v. Van Wormer, 5 O. G. 89, 20 Wall. 353, and Pickering v. McCullough, C. D. 1882, 28, 104 U. S. 310.) *Adams v. Bellaire Stamping Co., 57 O. G. 1280, C. D. 1891.

194. A claim for a combination of old elements producing no new and useful result, each element having no essential change of individual structure or function, is invalid. *American Cable Ry. Co. v. City of New York, 56 Fed. Rep. 149 (1893); *Deere & Co. v. J. I. Case Plough Works, 56 Fed. Rep. 841 (1893).

195. The claim for the combination of an oven and an air-pump for working the process examined and found to be for an aggregation. Ex parte Rudd, 68 O. G. 535, C. D. 1894.

196. The state of the art disclosed that a cylindrical guide, a trough-like connection, and a combination of flat guides and trough each was old. *Held*, that claim 2, which covers a combination of the cylindrical guide and trough-like connection, is void, as covering a mere aggregation, or, if the combination is superior to the old one, it is a difference in degree, not rising to the dignity of invention. *Wright v. Yuengling, 69 O. G. 630, C. D. 1894.

197. The patentee made a convertible dredger adapted to use either a scoop or a clam-shell bucket. The parts do not, however, co-operate by contributing to a common end. The function and operation of the machine, where either bucket is attached, is exactly the same as it would be if the means for attaching the other bucket were not present. It is simply an aggregation, although it is true that there may be a true combination in which different parts perform different and separate functions, but all require a new result or an old result in a new way. *Osgood Dredge Co. v. Metropolitan Dredging Co., 69 Fed. Rep. 620 (1895).

198. An assemblage of old elements concerting no new and useful result is not a combination. *Palmer v. Corning, 70 O. G. 1497, C. D. 1895.

199. So long as each element performs some old and well-known function the result is not a patentable combination but an aggregation of elements. The multiplicity of elements may go on indefinitely without creating a patentable combination unless by their collocation a new result be produced. *Richards v. Chase Elevator Co., 71 O. G. 1456, C. D. 1895.

200. The use in the same wire band of two features separately old in wire bands to effect the identical functions performed separately by each of them in the prior devices, *held* not to constitute patentable novelty. Griswold v. Seymour, Com'r of Patents, 78 O. G. 482, C. D. 1897.

201. A twin wire "dress stay" for stiffening women's gowns with water-proof materials is anticipated by steel stays covered with rubber and twin stays covered with textile material, and steel stays enveloped in celluloid or rubber and sewed to the garment. The form of the stay was old, the materials were old, and in bringing them together as described no new characteristics nor capacity were developed. *Janowitz v. Levison, 82 Fed. Rep. 63 (1897).

(b) *Arrangement.*

202. The reversal of a tongue and its recess in the same kind of a structure, even if productive of an improved, but not a new, result, does not require patentable invention. *Sax v. Taylor Iron Works, 40 O. G. 118, C. D. 1887.

203. The invention being a book spaced for each bond, and its coupons in proximity when paid, with appropriate descriptive matter, and an earlier invention being a book with no place for the bonds, and adapted for the arrangement of the coupons in the order of payment instead of in groups, there was no invention in the special arrangement of the bonds and coupons together. *Munson v. City of New York, 43 O. G. 1061, C. D. 1888.

204. The defendant's entire machine is simply a re-arrangement of the Gray combination for the obvious purpose of an attempt to avoid his patent. The result attained by both combinations is the same. The means adopted to attain such result differ only in the location of the several elements and such dependent differences as are made necessary by such change of location. *Consolidated Roller Mill Co. v. Coombs, 48 O. G. 255, C. D. 1889.

205. 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 v. Evory, 50 O. G. 1294, C. D. 1890.

206. In a water-heating apparatus the arrangement of vertical pipes over instead of at the side of the fire does not constitute patentable novelty, and varying the length of these pipes so as to avoid interfering with the fuel-space is an obvious change for an obvious purpose and does not amount to invention. Ex parte Garland, 58 O. G. 273, C. D. 1892.

207. The only real difference between the devices in the prior state of the art and the patent is that in the patent two cooking-tanks were so arranged that each should be partly over the storage-heater, whereas in the prior art there was only one cooking-tank placed immediately over the storage-tank, the advantage of the arrangement in the tanks in the patent being the use of one storage-heater for two cooking-tanks. *Held*, that such new arrangement was not invention, but only an economical re-arrangement, such as would have suggested itself to any one with a slight knowledge of the art. *Vaile v. Buckeye Iron and Brass Works, 63 O. G. 1965, C. D. 1893.

208. Wooden bearings in excelsior machines being old, there is no patentability in a wooden bearing in such machine placed therein so that the grain of the wood will run vertically with the line of motion of the journal instead of at right angles thereto. *Johnson v. Olsen, 68 O. G. 1146, C. D. 1894.

209. There is no invention in setting the knives of a cutter-head at the precise angle of forty-five degrees. *Caverly v. Deere, 73 O. G. 1711, C. D. 1895.

210. In the patent the tool-holder is stationary and the chuck movable; in the defendant's machine the chuck is stationary and the tool-holder movable. This reversal involving no change in the principle of operation nor in the result, *held*, that the two forms were substantially the same thing. *Société Anonyme Usine J. Cleret v. Rehfuss, Same v. Selig, 75 Fed. Rep. 657 (1896).

(c) *Composition of Matter.*

211. When a mechanically-combined material composed of particular ingredients is old, a person who has merely altered the proportions of ingredients or the process of combining them has not discovered a new composition of matter in the sense of the patent law. To be a new composition of matter the product must have some distinctly new property or be applicable to some new use. *Van Camp v. The Maryland Pavement Co., 43 O. G. 884, C. D. 1888.

212. It is difficult to find invention in mixing or putting together in a dry state two materials, it being old to mix the same materials during the process of manufacturing or brewing. *Geis v. Kimber, 44 O. G. 108, C. D. 1888.

213. 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. Ex parte Crippen, 43 MS. D. (9 G. W. D.), May, 1890 (Fisher, Ass't Com'r).

(d) *Degree.*

214. A mere carrying forward or more extended application of an original idea—a mere improvement in degree—is not invention. *Burt v. Evory, 50 O. G. 1294, C. D. 1890.

215. The improvement of the patent in suit over the features of the earlier patents declared to be only an improvement in degree and therefore not patentable. *Bussell Trimmer Co. v. Stevens, 53 O. G. 2044, C. D. 1890.

216. The mere carrying forward of an original conception, resulting in an improvement in degree simply, is not invention. *Consolidated Roller Mill Co. v. Walker, 54 O. G. 1415, C. D. 1891.

217. Where the patent covered an improvement which was simply a slight advance over the corresponding device which had been in public use for over two years, coveriug a mere superiority in workmanship or finish over the same, *held*, that something more was required to support a patent. *International Tooth Crown Co. v. Gaylord, 55 O. G. 865, C. D. 1891.

218. The knives of the cutter-head were set at an angle, or between forty-five and eighty-five degrees, but "the change was only in degree and consequently not patentable." (Guidet v. Brooklyn, 105 U. S. 550.) *Caverly v. Deere, 52 Fed. Rep. 758 (1892).

219. Cutter-heads with knives set with some degree of angularity were known and in use long prior to the alleged invention by Caverly, and the change to an angle of forty-five degrees is such as any skilled mechanic could make, and did not involve invention. *Id.

220. A device which is 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 of de-

gree only. *Williams v. The Goodyear Metallic Rubber Shoe Co., 58 O. G. 1257, C. D. 1892.

221. Where the cross reeling and lacing in the skein of the patent perform substantially the same function in substantially the same way as in the earlier skeins, but at a later and different stage or condition of the silk thread forming the skein, *held*, that the improvement constitutes, simply, a mere carrying forward or extended application of the original device with the change only in degree, but doing substantially the same thing in the same way by substantially the same means with some better results, and that it is therefore not patentable. (Smith v. Nichols, 21 Wall. 112.) *Grant v. Walter, 63 O. G. 910, C. D. 1893.

222. A combination superior to an old one, but one differing in degree only, does not rise to the dignity of patentable invention. *Wright v. Yuengling, 69 O. G. 639, C. D. 1894.

223. It is not sufficient that the patentee has produced a better or more merchantable article, but there must be some invention in the article itself. *Andrews v. Thum, 72 O. G. 899, C. D. 1895.

224. Though the patentees may have produced a more perfect counter-die than their predecessors, if they have added no novel mechanism and no new principle of operation they have produced no new product of a creative mental conception. *National Folding Box and Paper Co. v. Stecher Lithographic Co., 78 O. G. 1253, C. D. 1897.

225. It involves only the exercise of ordinary faculties to vary the temperature required in a certain process in which heat is essential, even when this variation is great. *Musgrave and Nye v. Commissioner of Patents, 78 O. G. 2047, C. D. 1897.

(e) *Double or Analogous Use.*

226. A difference in location is immaterial where the function performed, the result attained and the mode of operation are the same so far as the essential purpose of the invention is concerned. *Kirk v. Du Bois, 42 O. G. 297, C. D. 1888.

227. A patent covers a device in all the uses to which it may be applied. (Roberts v. Ryer, 91 U. S. 157.) *McClain v. A. Ortmayer & Son, 42 O. G. 724, C. D. 1888.

228. The chilling of wearing surfaces being old there is no invention in chilling a particular wearing surface. *Gates Iron Works v. Fraser, 42 Fed. Rep. 49 (1890).

229. The use of a deflector on an automatic fire-extinguisher, which had been used on hand hose, is not a patentable novelty. *Grinnell v. Walworth Mfg. Co., 43 Fed. Rep. 590 (1890).

230. There was no invention in applying steam-pipes to the interior of a cask for the purpose of heating the wine contained therein, steam-pipes having been previously applied to the interior of a closed tub for the purpose of heating water in the same. *Dreyfus v. Searle, 42 O. G. 491, C. D. 1888.

231. Where the same combination was employed in square-cornered safes it was simply an unpatentable aggregation to employ it in round-cornered safes. *Mosler Safe and Lock Co. v. Mosler, Bahmann & Co., 43 O. G. 1115, C. D. 1888.

232. 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 a vulcanizable gum was used to envelop a metal core. *Rubber and Celluloid Harness Trimming Co. v. India Rubber Comb Co., 44 O. G. 343, C. D. 1888.

233. Where it appeared that a turn-over 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 the perspiration, *held* not to be an 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 Mfg. Co. v. Davis Sewing Machine Co., 49 O. G. 1214, C. D. 1889.

234. Where the employment of a device to effect a certain purpose was such as would naturally suggest itself to any mechanic, and the same device was used in the new relation to perform an office analogous to that in which it had been frequently formerly used, *held*, such employment of said device did not constitute invention. *Day v. The Fair Haven and Westville Ry. Co., 49 O. G. 1364, C. D. 1889.

235. The mere application to a new situation of old devices which had been previously applied to analogous uses does not constitute new invention. *Aron v. The Manhattan Ry. Co., 49 O. G. 1365, C. D. 1889.

(Same. *Royer v. Roth, 49 O. G. 1987, C. D. 1889.)

236. It does not constitute invention to put up paper in the form of an oblong or oval shaped roll when it appears that it was old to put it up in that exact form, though in rolls of smaller size. *Morgan Envelope Co. v. The Albany Perforated Wrapping Paper Co., 50 O. G. 303, C. D. 1890.

237. 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. *The Howe Machine Co. v. The National Needle Co., 51 O. G. 475, C. D. 1890.

238. The application or adaptation of an old device, which had previously been used with the roller of a washing-machine to reverse the motion of the roller periodically, to the drum of a fulling-machine to make it revolve in different directions at intervals, is merely an exercise of ordinary mechanical skill. *Royer v. Schultz Belting Co., 50 O. G. 557, C. D. 1890.

239. 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, 51 O. G. 1129, C. D. 1890.

(*Consolidated Roller-Mill Co. v. Walker, 54 O. G. 130, 1415, 1891.)

240. Where the prior art disclosed that it was old and well known to apply electrical energy to the propulsion of a boat by means of a battery, mounted upon the boat, capable of being regenerated, and also to propel a locomotive engine or vehicle by means of electricity supplied by a primary battery mounted thereon, and that such contrivances were successful in the sense of being operative, although they involved great expense and were not successful commercially, *held*, that no invention was exercised in applying the Faure secondary battery to the propulsion of vehicles, no adaptation being required to make it available for the specified purpose. Ex parte Faure, 52 O. G. 752, C. D. 1890.

241. *Held*, that a patent 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. *Faure v. The Commissioner of Patents, 52 O. G. 754, C. D. 1890.

242. *Held* further, that otherwise the monopoly granted by applicant's patent upon his storage battery would be prolonged. *Id.

243. *Held*, that the propulsion of vessels through water by a secondary battery comes within the same principle as locomotion upon land. *Id.

244. A combination of parts to perform a certain function when patented entitles the patentee to that combination in all situations for all analogous purposes, and a claim for a construction for raising, lowering and fastening the grain platform of a harvester is anticipated by a device for doing the same thing to a window-sash, there being no mechanical difference between the functions of the two devices. *Deering v. McCormick Harvesting Machine Co., 52 O. G. 1223, C. D. 1890.

245. The patentee 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 a double use. *County of Fond du Lac v. May, 53 O. G. 1884, C. D. 1890.

246. The application of a well-known form of blade, used in the old hand-tool for trimming sole-edges, to a metal milling-cutter, also old and well known, for the purpose of producing a rotary cutter for trimming sole-edges, is a mere case of double use and therefore not patentable. *Busell Trimmer Co. v. Stevens, 53 O. G. 2044, C. D. 1890.

247. The difference in configuration between a certain old and well-known device and the patentee's *held* not patentable, even though the one was used in the metal art and the other in the leather art. *Id.

248. A method of charging beer having been practiced for treating water or neutral liquids, *held* to be the mere application of an old process to a new but analogous subject. *Zinsser v. Krüger, 58 O. G. 805, C. D. 1892.

249. 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 before been contemplated. *Ansonia Brass and Copper Co. v. Electrical Supply Co., 58 O. G. 1692, C. D. 1892.

250. The use of a mechanical contrivance for subjecting bretzels to a hot alkaline bath, when an analogous appliance has long been employed for steaming crackers, shows nothing more than ordinary mechanical skill. *Stauffer v. Spangler, 59 O. G. 632, C. D. 1892

251. The use of a single sheet of metal and the absence of "joint, seam or interior angle" do not confer patentability, since these features are old in analogous devices. *Kilbourne v. W. Bingham Co., 60 O. G. 577, C. D. 1892.

252. Applying an old process to an analogous subject, with no change in the manner of the application, is a "double use." *McKay & Copeland Lasting Machine Co. v. Claflin, Same v. Dizer, 58 Fed. Rep. 353 (1893).

253. The public cannot be deprived of an old process because some one has discovered that it is capable of producing a better result or has a wider range of use than was before known. (Citing Smith v. Nichols, 21 Wall. 112; Roberts v. Ryer, 10 O. G. 204, 91 U. S. 150; Hollister v. Benedict Mfg. Co., 113 id. 59.) *Lovell Mfg. Co. (Limited) v. Cary, 62 O. G. 1821, C. D. 1893.

254. It is not patentable invention to apply old and well-known devices and processes to new uses in other and analogous arts. *Id.

255. Skeins of raw or gummed silk diagonally reeled and tightly laced across the width so as to separate the skein into two or more sections, being old in the art, *held*, that a skein of ungummed silk diagonally reeled and loosely laced across the width presents at most a discovery of a new use for an old device, which does not involve patentability. *Grant v. Walter, 63 O. G. 910, C. D. 1893.

256. Where the patent in suit described an ink and claimed only a rubber fabric having ornamental figures printed in such ink on its surface, *held*, that the case then reduces itself to the single question whether there is any novelty in printing a rubber fabric with such an ink. (Underwood v. Gerber, 63 O. G. 1063.) *Brigham v. Coffin, 63 O. G. 1385, C. D. 1893.

257. Where the devices claimed were parts of a watch mechanism, *held*, that a use in a watch mechanism of a different type would not be a use in other relations. Ex parte Learned, 63 O. G. 1962, C. D. 1893.

258. It is settled law that the patentee of a device is entitled to all its uses whether described or not. *Miller v. Eagle Mfg. Co., 66 O. G. 845, C. D. 1894.

259. When the identity of the two devices is admitted, they cannot be patentably distinguished by a suggested distinction in the purpose to which they are respectively applied. (Knapp v. Morse, 65 O. G. 1593.) *Wollensak v. Sargent & Co., 66 O. G. 1007, C. D. 1894.

260. A rectangular terra cotta conduit-pipe having partitions made in one integral piece by forcing the material, while plastic, through a die, and burning it, does not distinguish it as a new article, the making of sewer-pipe of clay by the same process being old, and hollow rectangular blocks of terra cotta divided into ducts by partitions being old, although used as building material rather than as conduits for wire. *Browning v. Colorado Telephone Co., 68 O. G. 1145, C. D. 1894.

261. The use of lugs to prevent lateral movement being well known, their employment in an excelsior machine to prevent lateral movement of the sliding plate involves no invention. *Johnson v. Olsen, 68 O. G. 1146, C. D. 1894.

262. There was no invention in applying the lubricator to a peculiar car, and, moreover, the lubricators of the prior patents were capable of like application. *Market Street Cable Ry. Co. v. Rowley, 70 O. G. 632, C. D. 1895.

263. Where it was old to make Cardigan jackets by a peculiar stitch and to sew their parts together in a certain manner, *held* not to involve invention to apply the same stitch and manner to the making of undershirts. *Dalby v. Lynes, 71 O. G. 1317, C. D. 1895.

264. A patentee is entitled to any beneficial function of his invention, whether he then knew all its beneficial uses or not. (Cases cited.) *Goshen Sweeper Co. of Grand Rapids, Mich., v. Bissell Carpet-Sweeper Co., 72 Fed. Rep. 67 (1895).

265. Under the doctrine that the patentee is entitled to all known and unknown uses to which his invention may be applied, the public is entitled to all uses of devices covered in expired patents, and the discoverer that old means will do a new work is not entitled to a monopoly. *Wright & Colton Wire-Cloth Co. v. Clinton Wire-Cloth Co., 72 O. G. 1046, C. D. 1895.

266. A claim that an older device was not designed for the particular use to which a new device is peculiarly adapted is no answer to the fact that the older device would perform the same functions. *Codman v. Amia, 74 O. G. 1738, C. D. 1896.

267. Where the elements of a syringe are found operating together in a pump in the same way as in the syringe and for the same purpose, *held* that, a syringe being a kind of pump, the uses of the elements in each are closely analogous. The difference, if any, is only in size, which does not, however, affect the relation or operation of the elements. *Tagliabue v. Sondermann, 75 O. G. 188, C. D. 1896.

268. The mere adaptation from a different art of devices which successfully accomplish in a given apparatus results hitherto imperfectly accomplished by crude and inefficient apparatus does not involve invention. *Excelsior Elevator Guard and Hatch Cover Co. v. Foote, 75 O. G. 1364, C. D. 1896.

269. The use of a rack and pinion for raising and lowering a cutter-head used in an ice-planer does not involve invention in view of the previous use of such rack and pinion for adjusting a wood-planer. Ex parte Briggs, 75 O. G. 1854, C. D. 1896.

270. It does not require invention to provide an old form of garment-stay with projections, which are also old, for the same purpose in devices of a similar character, by means of which the stay may be attached to a garment. *Ypsilanti Dress Stay Mfg. Co. v. Van Valkenburg, 76 O. G. 333, C. D. 1896.

271. There is no patentable novelty in adding end caps to the steel of a particular garment-stay when such caps had previously been attached to similar steels. *Id.

272. The fact that an inventor claims only certain functions for his invention does not prevent him from reaping the advantage of any other function within the claim, as properly construed, although known to him and omitted in the specification without fraud, or not known to him. (Reece Co. v. Globe Co., 61 Fed. Rep. 958.) *Long v. Pope Mfg. Co., 77 O. G. 1428, C. D. 1896.

273. The decision in Potts v. Creager does not apply to the circumstances of this case, in which an old construction of cutter-head used in a wood-planing machine is applied to an ice-planing machine, since the uses are analogous. *Briggs v. Seymour, Com'r of Patents, 78 O. G. 169, C. D. 1897.

274. The patentee is entitled to all the uses of which his invention is capable, whether or not he foresaw them at the time of making his invention. *Edward Miller & Co. v. Meriden Bronze Co., 79 O. G. 1520, C. D. 1897.

275. Where the disintegration and shredding of clay had been accomplished by means of bars running across the face of rollers, *held*, that no invention was involved in adapting a mill for grinding or grating apples to the purpose of disintegrating and shredding clay, where the only change required was the substitution of bars of steel running across the face of the roller, parallel with the axis, in place of rows of thick steel knives. *Potts & Co. v. Creager, 80 O. G. 186, C. D. 1897.

276. The circumstance that the same congregation of devices has never been assembled in a new location is not controlling and is often of little value in determining the question of patentable novelty. Their assemblage may be nothing but another instance of a double use, and when they require special adaptation to the new arrangement and occasion it still remains to inquire whether this has required invention. (76 O. G. 788, reversed.) *Dunbar v. Eastern Elevating Co., 80 O. G. 1127, C. D. 1897.

(f) *Mechanical Process or Method.*

277. The necessary effects or operations of specific mechanism are not necessarily processes or methods within the meaning of the patent laws. A method or process such as the law recognizes as patentable must have an existence independent of the machine or apparatus by which it is carried out to a result. It must be a method or process that can be carried out by hand or by various kinds and forms of mechanism or apparatus. Ex parte Herr, 41 O. G. 463, C. D. 1887.

278. If the act or result is simply that of the mechanism itself, so related to it that it cannot exist independently, and is the sole utterance of the machine, then the supposed method or process does not exist. The function of a machine can have no separate existence, and is completely and sufficiently covered by a patent for the latter. Id.

279. It being conceded that a process is not patentable which is merely the effect or function of 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 ordinary tools or by hand. Ex parte Young, 46 O. G. 1635, C. D. 1889.

280. A method or process which depends for its novelty upon the preparation of an adhesive stay and the various steps employed to carry such article forward to the final act of affixing it to the corners of boxes for the purpose of strengthening the corners, *held* to be not a proper method or process, but the mere operation of the machine. Ex parte Jaeger, 46 O. G. 1637, C. D. 1889.

281. Where it appeared that all that applicant professed to do was to take an old and well-known bolt and nut and to screw them together in the ordinary way, and then to take an old and well-known chisel and make an in-

cision in the bolt lengthwise and nearest the upper surface of the nut in order to prevent the bolt from rotating, *held*, that applicant had only displayed the expected skill of the calling and accomplished what a skilful mechanic would do whenever required. Ex parte Shields, 54 O. G. 387, C. D. 1891.

282. Processes which consist solely in the operation of a machine are not patentable. The function of a machine is entirely independent of any chemical or other similar action. *Risdon Iron & Locomotive Works v. Medart, 71 O. G. 751, C. D. 1895, 158 U. S. 68.

(Followed in Travers v. Gem Hammock & Fly Net Co., 75 O. G. 678; Wells Glass Works v. Henderson, 72 O. G. 285.)

283. The decisions in the cases of Neilson v. Harford (1 Web. Pat. Cas. 331); Hauschill Coal and Iron Co. v. Neilson (1 Web. Pat. Cas. 673); O'Reilly v. Morse (15 How. 62, 115); Tilghman v. Proctor (19 O. G. 859, 102 U. S. 707, 724); Mowry v. Whitney (14 Wall. 620); Cochrane v. Deener (11 O. G. 687, 94 U. S. 780); New Process Fermentation Co. v. Mauss (39 O. G. 1419, 122 U. S. 413); Bell Telephone Co. (43 O. G. 377, 126 U. S. 1); Wyeth v. Stone (1 Story, 273); Corning v. Burden (15 How. 252), reviewed. *Id.

284. A process consisting of purely mechanical steps, *held* not patentable in view of decision in Risdon, etc. v. Medart (158 U. S. 68). Ex parte Rowe & Heys, 60 MS. D., Dec., 1896 (Seymour, Com'r).

285. A "method consisting of mechanical steps and involving no action which is separable or distinguishable from the function of the several mechanical devices which are employed to effect the result" is not patentable. (*Risdon Iron and Locomotive Works v. Medart, 71 O. G. 285, and other cases cited.) Ex parte Over & Schwan, 62 MS. D., July, 1897 (Butterworth, Com'r).

286. Letters Patent No. 524,965, granted to Matthew Gindorff for a method of and machine for serrating sickle-sections, examined, and claims 4 and 5 *held* void for lack of patentability, in view of Risdon Iron and Locomotive Works v. Medart (71 O. G. 751, 158 U. S. 68). *Gindorff v. Deering & Co., 80 O. G. 653, C. D. 1897.

287. Where, except for the described functions of a machine, there is nothing stated in a claim save the manual transposition or turning of the articles undergoing operation, so that a fresh part may be treated, such transposition, superadded to the function of the machine, does not make the process which the patent law contemplates. *Id.

(Corning v. Burden, 15 How. 252, 1 Whitman, 687; The Telephone Cases, 126 U. S. 1, 43 O. G. 377, C. D. 1888.)

(g) *Omission of Mechanical Parts.*

288. A reconstruction 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, so that the retained parts do just what they did before in the combination, cannot be other than a mere matter of judgment, depending upon whether it is desirable to have the machine do all or less than it did before. *McClain v. Ortmayer & Son, 42 O. G. 724, C. D. 1888.

289. Hence, where a device is made double, and experience shows that one-half of it is superfluous, no invention is required to dispense with such superfluous portion, and a patent for the part retained will be held void. *Id.

290. An original patent for a device covered duplicate parts which performed similar functions and one of which was superfluous and unnecessary. A patent for improvement of the same, which merely dispenses with this unnecessary duplicate part and shows no material difference in the method of operation, is void for want of patentable novelty. *McClain v. Ortmayer, 57 O. G. 1129, C. D. 1891.

291. If a person has invented a combination of three elements, all of which are necessary to the operation of his device, he cannot by making a claim for two of them forestall another who has so combined these two elements that they perform the same function that the three elements of the former patent performed; but otherwise if the third element of the first device is not essential to its operation, and if by the mere omission of such third element the two devices perform substantially the same function. *National Hat Pouncing Machine Co. v. Hedden, 63 O. G. 466, C. D. 1893.

292. Where a patented hat-pouncing machine contained as an element a feed-roll for feeding the hat in a direction opposite to that of the motion of the pouncing cylinder, and it appeared that the feed-roll might be omitted and the hat fed in the opposite direction, *held*, that the hat-support and pouncing-cylinder would accomplish practically the same functions as the corresponding parts of a subsequently patented machine having no feed-roll,

and that it required no invention to omit the feed-roll of the former machine and to make the subsidiary changes necessary to produce a working device. *Id.

293. When the only difference between two apparatuses consists in the omission in the later apparatus of an important feature of the prior device, *held*, that the change consequent upon such omission does not rise to the dignity of invention and is not patentable. *Magin v. Karle, 65 O. G. 2060, C. D. 1893.

294. While the omission of an element in a combination may constitute invention if the result of the new combination be the same as before, yet if the omission of an element is attended by a corresponding omission of the function performed by that element there is no invention if the elements retained perform their same function as before. (Stow v. Chicago, 3 Ban. & Ald. 32; Edwards v. Chase Elevator Co., 73 O. G. 1710, C. D. 1895.

(h) *Product of Nature.*

295. A product of nature, although conceded to be valuable and useful, such as fiber which is procured, derived or freed from a certain species of pine, by means of a new and novel process for which patent has been granted to applicant, *held* to be not such a patentable invention as is required by the statute. Ex parte Latimer, 46 O. G. 1638, C. D. 1889.

296. The product has not been affected, changed or altered by the process, and whatever there is of an invention resides in or consists of the process itself, by which the fiber can be taken from the natural sheath or membrane of the leaf or pine-needle in which it has been developed or produced by the processes of nature. Id.

297. A contrary ruling would result in granting to one inventor the exclusive use of one species of fiber, and so on, successively, patents might be obtained upon the fibers of the various trees of the forest and the plants of the earth, which, because being natural products, are no more the subjects of patents when eliminated from their surroundings than wheat which has been cut by some new method of reaping can be patented *as wheat* cut by such a process. Id.

(i) *Process or Method.*

(See ART.)

298. The application of artificial heat to ripen wine being old and the application of artificial heat to the outside of casks to ripen wine contained therein being old, it did not require invention to apply artificial heat to the inside of the casks to ripen the wine in the same. *Dreyfus v. Searle, 42 O. G. 491, C. D. 1888.

299. Where the art of advertising as claimed produces no physical effects, but only a state of mind in the purchaser of the newspaper amounting to a predisposition to read the advertisements, and there ends unless the reader wills otherwise, *held*, that such art of advertising is not a patentable art. Ex parte Turner, 66 O. G. 1593, C. D. 1893.

300. Where the art as claimed omits a step necessary to its lawful practice, *held*, that such omission was a proper ground for the rejection of the claims. Id.

301. The change in a process of making yeast, the chief feature of the improvement consisting in treating grains of cereals whole or only slightly broken instead of reducing them to small fragments, *held* to be invention. (Lawther v. Hamilton, 42 O. G. 487, 124 U. S. 1, wherein the step of "grinding" was omitted, discussed and followed.) Ex parte Blumer and Slagenhaufer, 72 O. G. 1783, C. D. 1895.

302. The discovery that the old process of fumigating plants and trees by hydrocyanic acid gas, after covering them with an oiled tent, is more effective in the absence of the actinic rays of the sun gives no right to a patent for the use of that process at night or in cloudy or foggy weather, when such rays are excluded by the processes of nature. (68 O. G. 1273, 61 Fed. Rep. 291, followed.) *Wall v. Leek, 74 O. G. 877, C. D. 1896.

303. In a process of purifying oil the use of pulverized copper matte to remove the "skunk" from the oil is an improvement upon the use of a mixture of pulverized copper oxid and pulverized iron oxid of such character as is not to be expected from those versed in the art, and required invention. Ex parte Frasch, 77 O. G. 1427, C. D. 1896.

304. A process which employs low heat for a long time is not patentable over another which uses a high heat for a short time when the result — namely, the partial distillation of coal — is the same in both cases. Ex parte Musgrave and Nye, 78 O. G. 2046, C. D. 1897.

305. The discovery of a new process in any art by the addition of heat as a material factor, where heat had never before been applied or suggested, would constitute invention; but the adoption of a discretionary temperature in treating coal, subject to increase or diminution,

as experience, as well as the varying character of the material treated, may suggest, does not amount to invention. *Musgrave and Nye v. Commissioner of Patents, 78 O. G. 2047, C. D. 1897.

(j) *Substitution of Materials or Parts.*

306. An applicant who has done nothing but exercise his judgment and knowledge in selecting a better but well known material for use in constructing an old and well-known instrument, notwithstanding the results produced may be superior, has not displayed invention. Ex parte Krell, 44 O. G. 1505, C. D. 1888.

307. When a T lever had already been used for operating a saw-mill dog, there was no invention in the substitution of an eccentric-lever which was used to perform the same function in a no more effectual manner. *Rodebaugh v. Jackson, 47 O. G. 658, C. D. 1889.

308. Where the only change involved is a change of material, accompanied by the expected skill of the calling in effecting the substitution and making it efficient, the result is not patentable. Ex parte Odenheimer, 49 O. G. 1693, C. D. 1889.

309. It does not constitute invention to stir by a well-known and simple mechanical device a liquid which had before been stirred by hand. *Marchand v. Emken, 49 O. G. 1841, C. D. 1889.

309a. The mere substitution of a revolving screw, driven from a power shaft, for paddles operated by hand, for stirring such liquid is not patentable. *Id.

310. The substitution of one material for another, which does not involve change of method nor develop novelty of use, even though it may result in a superior article, is not necessarily a patentable invention. *Florsheim v. Schilling, 53 O. G. 1737, C. D. 1890.

311. No valid claim can be founded upon the use of an inferior article when it is shown that the use of the superior article or material is old. *Brush Electric Co. v. Electrical Accumulator Co., 56 O. G. 1334, C. D. 1891.

312. A mere change of material, with no advantages except such as were known in advance would be attained by the selection of the material in question, does not confer patentability. Ex parte Foss, 56 O. G. 1564, C. D. 1891.

313. A claim for a patent for an inside slipper of bladder or other thin animal tissue, which is met by the references cited on every point except that of material, has not patentable novelty. Ex parte Foss, 57 O. G. 1277, C. D. 1891.

314. The use of wrought iron or steel in lieu of cast metal is a mere substitution of materials and is not patentable, notwithstanding the superior results obtained. *Kilbourne v. W. Bingham Co., 60 O. G. 577, C. D. 1892.

315. This view is substantiated by the decisions in Hotchkiss v. Greenwood, 11 How. 248; Hicks v. Kelsey, 5 O. G. 94, 18 Wall. 670; Phillips v. Detroit, 17 O. G. 121, C. D. 1880, 4 Sup. Ct. Rep. 580; Brown v. Dist. Col., 47 O. G. 398, C. D. 1889; Florsheim v. Schilling, 53 O. G. 1737, C. D. 1890. *Id.

316. As an article of manufacture, a bicycle frame of a known and aluminum alloy, cast in one piece, is not a patentable invention merely by reason of its material. Ex parte Grayson and Crecelius, 68 O. G. 1021, C. D. 1894.

317. It is not every new and useful improvement produced by the adaptation or substitution of one well-known material for another that will entitle a party to a patent. The improvement must be the result of invention. *Cheneau v. Commissioner of Patents, 70 O. G. 924, C. D. 1895.

318. Where the article sought to be patented differs from prior like articles merely in the difference and superiority of the material of which it is composed, the material and its properties being old and known, *held*, that such article involves the mere substitution of one old material for another. *Id.

319. There is no invention apparently involved in putting some other mechanism well known in the art and well adapted for such use in the place of previously-used mechanism in an old device operating in an old way when such substitution does not involve any material re-arrangement. *New Departure Bell Co. v. Bevin Brothers Mfg. Co., 75 O. G. 2196, C. D. 1896.

320. There is no presumption in favor of invention in a device which embodies the substitution of an old form of mechanism for one which did not render the device practicable, though such substitution renders the device simple, durable, reliable, convenient and attractive, when there is no showing that the old form of mechanism was known to workers in the art. *Id.

(k) *Particular Cases.*

321. An improvement in the nail-carrier of a nailing machine which consists in making the edge of the carrier smooth instead of corrugated cannot be held to be an invention. *Cross v. Union Metallic Fastening Co., 39 O. G. 361, C. D. 1887.

322. Placing a large register in a stove-oven door where a small register had been used previously is not patentable invention. *Filley v. The Littlefield Stove Co., 39 O. G. 1203, C. D. 1887.

323. Self-feeding regulated lubricators where the drip of the oil from a reservoir was visible being old and well known, and self-feeding regulated lubricators where the oil flowed from a reservoir into a transparent pipe having been described in an earlier English provisional specification, it required no invention to make a self-feeding regulated lubricator where the oil was delivered in drips from the reservoir into a transparent chamber below the same. *McNab and Harlem Mfg. Co. v. Nathan Mfg. Co., 40 O. G. 1240, C. D. 1887.

324. Neither did it require invention to employ a transparent chamber to avoid the effects of wind and dirt upon the old and well-known unprotected drips. *Id.

325. The use of a piece of tape, linen or other suitable material as a re-enforce piece to strengthen the parts of the files in places where they were weak, was not the discovery of anything new nor the application of genius to things known, but simply mechanical skill, and does not cover a patentable invention. *Cooke v. Globe Files Co., 40 O. G. 1244, C. D. 1887.

326. The addition simply of a non-elastic tape measure in connection with the ribs of a dress-form does not involve invention. Morss v. Manchester, 41 O. G. 1392, C. D. 1887.

327. A claim for a "circular stove" having a perforated fire-pot with a grate-bottom having provision for the admission of air below the point of suspension of said fire-pot, *held*, to be met by prior patents showing all the elements of the claim save the circular cylinder, that element being old *per se*, on the ground that no invention was required to combine these features. *Hailes v. The Albany Stove Co., 42 O. G. 95, C. D. 1888.

328. It being old to put a flanged bottom into an iron shell, or into an iron shell washed with tin, or into an iron shell with a lining of sheet-tin adhering thereto, and old also to provide a soda-fountain with a separable sheet-tin lining, it did not require the exercise of the inventive faculty to place a flanged bottom covered with a separable sheet-tin lining into a shell lined in a similar manner. *Matthews v. Iron Clad Mfg. Co., 42 O. G. 382, C. D. 1888.

329. 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. The Golden State and Miners' Iron Works, 43 O. G. 1117, C. D. 1888.

330. There is no patentable combination between rollers which make the support movable and a feeding-cylinder mounted on such support. *Id.

331. A speculum consisting of a tube with a slide and a closed end was old. *Held*, that adding an incline to the closed end to prevent the impaction of pile-tumors did not involve invention. *Brinkerhoff v. Aloe, 46 O. G. 338, C. D. 1889.

332. The second claim of the Brinkerhoff patent covers a slotted tube having an incline and a slide. *Held*, that the incline acted precisely as it did when placed in the forward end of a slotted tube not provided with a slide, and that therefore the claim covered an aggregation only and was void. *Id.

333. There was no invention in providing a bearing-surface upon the frame of a dash, to which the foot of a brace was to be attached to support the brace and dash, either by an increase in the quantity of metal or otherwise, so as to strengthen the proper part, in a proper way, for its proper duty. *Peters v. Hanson, 47 O. G. 945, C. D. 1889.

334. Where it appears that plackets in drawers have been bound in substantially the same manner as the applicant's alleged invention, it is not invention to extend that idea and make the binding include the opening for the wrist or neck or body in a shirt or other garment, or to slightly or obviously modify the manner in which the binding is turned, or to omit a cord from the binding which is simply a strengthener, or to merely prolong the binding itself. Ex parte West, 47 O. G. 1731, C. D. 1889.

335. The cases of Smith v. Nichols (21 Wall. 112) and Hollister v. Benedict Mfg. Co. (113 U. S. 59) followed in this respect. Id.

336. It does not seem to involve invention to put up paper in an oblong or oval-shaped roll when it had been put up in the form of

cylindrical rolls. *Morgan Envelope Co. v. The Albany Perforated Wrapping Paper Co., 50 O. G. 303, C. D. 1890.

337. 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 v. Steckel, 53 O. G. 1090, C. D. 1890.

338. To make a suspender-end of flat cord in substantially the same way that suspender-ends of round cord had been made and in substantially the same way in which flat button ends had been made for the purpose of fastening or securing other articles of wearing apparel than trousers does not involve invention. *Shenfield v. The Nashawannuck Mfg. Co., 53 O. G. 1092, C. D. 1890.

339. It being old to bind the cut edges of cloth, either for ornament or to prevent raveling, and also old 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. *Cluett v. Claflin, 55 O. G. 990, C. D. 1891.

340. The first claim is for a continuous rubber sole, with projections at the heel and tread, all moulded from a single blank. The second claim adds to the first that the projections shall be conoidal and arranged in certain regular order. *Held*, that the claims involved trivial detail but without result and lacked patentability. (Citing Burt v. Evory.) *Marshall v. Packard, 51 Fed. Rep. 755 (1892).

341. An applicant for a patent for an improvement in letter files already held a patent for an indexed letter file consisting of a series of perforated index sheets arranged at one end to hinge and slide upon an upright rod and being free at the other end to permit of their being lifted from their position. The perforations in the sheets were circular and little larger than the rod itself. *Held*, that an improvement which consisted merely in making these perforations elliptical to admit of freer action upon the rod does not constitute patentable invention. *Odell, Adm'r, v. Commissioner of Patents, 60 O. G. 580, C. D. 1892.

342. Where the only difference between the attachments in the references and those in the claims resided in the particular means by which the attachments were secured in place for use and the means simply involved a selection for the purpose, *held*, that there was no invention in selecting the particular means employed by the applicant regardless of whether his particular means had ever been used to attach the device to its place or not. Ex parte Fergusson, 66 O. G. 651, C. D. 1894.

343. Where the only differences between the pumps in the application and the references consist in mere varintions of detail in the applicant's construction of the pump to adapt it to the particular uses he has in mind, *held*, that such differences do not show invention nor mechanical skill in advance of that revealed in the references. Ex parte Thomson, 66 O. G. 1447, C. D. 1894.

344. Where a claim in an application for a striker plate had been rejected by the commissioner for want of patentable novelty and such rejection acquiesced in, a claim by the same inventor in another application for the combination of a door or casing and the striker plate *held* not patentable. *In re Forg, 66 O. G. 515, C. D. 1894.

345. Where the change consisted in widening a pawl of a ratchet-wheel so that its heel would rest upon the tooth behind it and be prevented from turning, *held*, to be a modification so obvious to a person skilled in that subject as not to have required anything more than the ingenuity which such a person might be expected to possess. *Wells v. Curtis, 74 O. G. 495, C. D. 1896.

346. There is no invention in simply clamping an open ring of metal around a braided or twisted rope to prevent unbraiding or untwisting. *Covert v. Travers Brothers Co., 75 O. G. 349, C. D. 1896.

347. It is not invention to insert an additional gear and pinion-wheel in a train of such wheels; nor is it invention to substitute a reacting spring at one end of the train of motion for a similar spring at the other end. *New Departure Bell Co. v. Bevin Bros. Mfg. Co., 75 O. G. 2196, C. D. 1875.

348. It does not require invention merely to unite two short cars so as to make a single long car with a transverse platform running across its center. *Chesterman v. Lindell Ry. Co., 76 O. G. 479, C. D. 1896.

349. There is no patentable invention involved in swaging or striking up by means of a die, from a blank of iron or steel, a rail-brace of a form which had previously been made of cast metals. (Kilbourne v. W. Bingham Co.,

60 O. G. 577, 1 C. C. A. 617, 50 Fed. Rep. 697, followed.) *Strom Mfg. Co. v. Weir Frog Co., 77 O. G. 1125, C. D. 1896.

350. Notwithstanding that appellant's device may be superior in finish, neater in appearance and generally better adapted for the uses for which it was intended than the devices which it might have displaced, yet it is not a patentable device. Ex parte Ellison, 61 MS. D. 435, June, 1897 (Butterworth, Com'r).

351. It does not involve invention to provide channels or grooves in the counter-die of a press to co-operate with the embossing-rules of the die for creasing the fold-line of a paper-box blank. *National Folding Box and Paper Co. v. Stecher Lithographic Co., 78 O. G. 1253, C. D. 1897.

352. The particular way of hanging a door does not involve invention and is not sufficient to sustain the validity of a patent. *Green v. American Soda Fountain Co., 78 O. G. 1105, C. D. 1897.

353. The mere enlargement of a covering-box, shield or plate of a holding-stud of a garment-supporter, so as to allow greater space within said box, is not the result of an application of the inventive faculty. *Draper v. Seymour, Com'r of Patents, 79 O. G. 804, C. D. 1897.

354. A claim for a ring having an inwardly-extending flange and a cross fastened down on the latter, for the purpose of holding a paper-pulp barrel while drying, is doubtfully patentable, in view of the use of rings for similar purposes in this and analogous arts. It is not infringed by the use of a plain, angle iron ring, having no similar flange nor supporting cross. *Keyes v. United Indurated Fibre Co., 82 Fed. Rep. 32 (1897).

PATENTED ARTICLE OR MACHINE.

(See RIGHT TO MAKE, USE AND SELL.)

PATENTS.

(See ANTICIPATION; CLAIMS—PATENTABILITY; INTERFERING PATENTS; SUBSEQUENT APPLICATIONS; WITHDRAWAL FROM ISSUE; WITHHOLDING FROM ISSUE.)

I. PATENTS, IN GENERAL.
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XII. CLAIMS CONSTRUED BY REFERENCE LETTERS IN DRAWING.
XIII. TO ASSIGNEES.
XIV. TO DECEASED INVENTORS.

I. PATENTS, IN GENERAL.

1. There may be many modes of effecting a desired result, but every patent must rest upon its mechanical devices therefor. *Steam Gauge and Lantern Co. v. St. Louis Railway Supplies Mfg. Co., 38 O. G. 107, C. D. 1887.

2. The constitutional grants of power to congress to legislate upon patents for lands and for inventions are substantially alike, and such patents are of the same nature, character and validity. *The United States v. The American Bell Telephone Co., 45 O. G. 1311, C. D. 1888.

3. A patent is addressed to those having a peculiar and technical knowledge of the subject. (Loom Co. v. Higgins, 105 U. S. 580.) *Electrical Accumulator Co. v. Julien Electric Co., 38 Fed. Rep. 117 (1889).

4. A patent for an invention conveys nothing which the government owns or its predecessor ever owned, is the evidence of the inventor's exclusive right, and creates for him a property interest, which government secures to him by a grant. *Marsh v. Nichols, Shepherd & Co., 46 O. G. 239, C. D. 1889.

5. This grant, however, is regulated by statute, and requires the signatures of all the officials required by statute. *Id.

6. A patent issued to an applicant is only *prima facie* evidence that he is the inventor. *Kennedy v. Hazelton, 46 O. G. 973, C. D. 1889.

7. Theoretically, an inventor in taking out a patent under the statutes of the United States subtracts nothing from and adds nothing to his actual invention, and, except for the provisions which for public interests require in a patent a description and claim, the same unrestricted rules of the common law would protect an inventor's statute right as are relied on to support a trade-mark or business goodwill. *Reece Button-Hole Machine Co. v. Globe Button-Hole Machine Co., 67 O. G. 1720, C. D. 1894.

8. A monopoly depending upon the merits of an invention to which it is a mere incident is neither obnoxious to public policy nor an illegal restraint of trade. *Heaton-Peninsular Button Fastener Co. v. Eureka Specialty Co., 78 O. G. 171, C. D. 1897.

9. The property right of a patentee is but a property right and is subject to the general law of the land. He may not, by virtue of his patent, make illegal contracts or do any other illegal acts. A prohibited business is not protected by the patent laws because it is conducted through instrumentalities which are the subject of patent-rights. *Id.

(A right of property may legally exist in an unpatented invention or discovery, if kept secret, which a court will protect. ‡Salomon v. Hertz, 35 O. G. 1109, C. D. 1886, following Peabody v. Norfolk, 98 Mass. 452.)

II. Presumption of Validity.

10. To overthrow the presumption arising from the patent the evidence should be satisfactory, convincing. *Vulcanite Paving Co. v. American Artificial Stone Pavement Co., 42 O. G. 828, C. D. 1888.

11. A presumption of validity arising from a successful interference in the patent office only applies against the parties to the interference and their privies. It does not extend to litigants who do not make the infringing article under a grant from the interferer. *Edward Barr Co. (Limited) v. New York and New Haven Automatic Sprinkler Co., 43 O. G. 392, C. D. 1888.

12. The rule is well settled that the production of letters patent for a design establishes a *prima facie* right in the patentee which can only be defeated by proofs which are of convincing force. *Untermeyer v. Freund, 47 O. G. 527, C. D. 1889.

13. The fact that in its progress through the patent office the specification and claims of the patent in suit were made more clear and accurate, so as to express the patentee's actual invention, affords no reason for casting doubt upon the validity of the patent. *Pullman's Palace Car Co. v. Boston and Albany R. Co., 53 O. G. 1255, C. D. 1890.

14. 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 patent. *National Typographic Co. v. New York Typograph Co., 56 O. G. 661, C. D. 1891.

15. 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 existing in favor of 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, but was fifteen months behind him in filing his application. Hisey v. Peters, 58 O. G. 1691, C. D. 1892.

16. The rule is well settled that complainant's introduction in evidence of his patent in due form is sufficient to show that he is the first and original inventor of his device or improvement, as defined and construed by the courts, unless sufficient evidence to overcome that presumption and to establish the contrary allegation of the answer is exhibited in the record. The burden of proof is on the defendant to show that the patentee was not the original and first inventor. *Page Woven Wire Fence Co. v. Land, 59 O. G. 159, C. D. 1892.

17. A patent subsequently granted to the defendant does not overcome this *prima facie* presumption in favor of the prior patentee. (Citing Goodyear Dental Co. v. Gardner, 4 Fish. 224.) *Id.

18. Where the question of invention is closely balanced, the presumption in favor of the patentee arising from his recognition as an inventor by the patent office will incline the court to sustain his patent. *Watson v. Stevens, 60 O. G. 1884, C. D. 1892.

19. The law is settled that, as to every point touching the validity of a claim, the patent itself is *prima facie* evidence (Mitchell v. Tilghman, 19 Wall. 287), although often very slight and purely technical. *Chase v. Fillebrown, 58 Fed. Rep. 374 (1893).

20. The existence of letters patent issued in due form is *prima facie* evidence of the validity of the patent. *Hunt Bros. Fruit Packing Co. v. Cassidy, 62 O. G. 1965, C. D. 1893.

21. The presumption is against the suggestion of inadvertence in the grant of a patent, and is always, in the absence of proof or substantial identity of claim, that the patent was granted in full view of the application. Edison v. Ball, 71 O. G. 1313, C. D. 1895.

22. "Not only in the courts, but within the office as well, the patent as it stands is *prima facie* correct and valid. . . . Once they are

issued, patents no longer come within the jurisdiction of the commissioner, except so far as they may be indirectly affected by a decision upon the question of priority upon a clear showing that against the presumption attaching to a patent another patent for the same invention to another person is decreed to issue." Carty v. Kellogg, 73 O. G. 285, C. D. 1895.

23. *Prima facie* letters patent are evidence that all the requirements of the statute have been fully complied with, and if it be true that the patentee has been at no pecuniary expenditure in realizing the conception of the designs it follows, presumably, that no such expenditure was demanded by the circumstances. The burden of showing the necessity of such expenditure is upon the defendant in any case. *Matthews & Willard Mfg. Co. v. Trenton Lamp Co., 75 O. G. 674, C. D. 1896.

III. Defective or Void.

(See Claims for Combination.)

24. Where only mechanical skill is required to supply defects in the invention as described, such defects do not render the patent invalid. *Temple Pump Co. v. The Goss Pump and Rubber Bucket Mfg. Co., 39 O. G. 467, C. D. 1887.

25. Where the patent describes an element as concavo-convex, the decree of concavity or convexity is left to practical experience and judgment, and the validity of the patent is not affected. *Id.

26. In the particular instance the claims were for the combination of the two elements, no matter how or by what means it might be effected, and such a patent cannot be sustained. *The Thatcher Heating Co. v. Burtis, 39 O. G. 587, C. D. 1887.

27. A patent based on an alleged combination which is inoperative without the addition of another element is void. *Tarrant v. Duluth Co., 39 O. G. 1425. C. D. 1887.

28. A patent covering an article possessing no novelty in the features claimed, and only in a feature unclaimed, cannot be sustained. *Ingham v. Pierce, 42 O. G. 1062, C. D. 1888.

29. It is fatal to a patent for a process that a patentee claims as essential a step which is unnecessary. *Van Camp v. The Maryland Pavement Co., 43 O. G. 884, C. D. 1888.

30. The taking of the oath is in no degree essential to the validity of a patent. *The Holmes Burglar Alarm Telegraph Co. v. The Domestic Telegraph and Telephone Co., 51 O. G. 2083, C. D. 1890.

31. Where a patent is void *ab initio*, no rule of estoppel can be invoked to aid a complainant thereon, since no act of an individual can vitalize and make valid a patent which never had validity or took effect as a grant. *De La Vergne Refrigerator Machine Co. v. Featherstone, 58 O. G. 1842, C. D. 1892.

32. Where experiment and inventive skill on the part of a skilled operator or user are necessary in addition to the instructive statements of the specifications to render the invention available and the use successful, *held*, that the patent is fatally defective and the patent based thereon void. (Lockwood v. Faber, 27 Fed. Rep. 63; McNamara v. Hulse, 2 Web. 128; Tyler v. Boston, 7 Wall. 327.) *The Tannage Patent Co. v. Zahn, 71 O. G. 1161, C. D. 1895.

33. Where a specification fails in any material respect to make the invention fully known and accessible to the public skilled in the art to which the invention relates, *held*, that it is fatally defective, and the patent based upon it *ipso facto* becomes void. (Wayne v. Holmes, 2 Fish. 20.) *Id.

34. The very fact that a machine is patented is some evidence of its operativeness as well as of its utility, and where a model is constructed after the design shown in a patent which is not perfectly operative, but can be made so by a slight alteration, the inference is that there was an error in working out the drawings, and not that the patentee deliberately took out a patent for an inoperative device. *Dashiell v. Grosvenor, 75 O. G. 507, C. D. 1896.

35. Where the patentee at the time of his application considered that a dye to be used should be waterproof and that the yielding surface used in polishing must be an inflated air-cushion, neither of which facts was disclosed by the specification, *held*, that the patent is void because of implied purpose to deceive the public. *Electric Boot and Shoe Finishing Co. v. Little, 77 O. G. 456, C. D. 1896.

IV. Construction of, in General.

36. In determining the question whether a patent is operative, the workings, not of a machine made as a literal copy of the drawings of the patent, but of one made with the mechanical devices which will tend to make a machine practical and operative, and which are within the duty of the mechanic, are to be considered. *Royer v. Coupe, 39 O. G. 239, C. D. 1887.

37. A claim in a patent cannot be changed by intendment when the effect of such change will make such claim precisely like another claim in the same patent. *Filley v. Littlefield Stove Co., 39 O. G. 1203, C. D. 1887.

38. The specification and the claim of the patent described the invention as a method of "tempering." The word "tempering" is to be construed as the particular method described, and not as the usual method of "tempering." *Cary v. Lowell Mfg. Co. (Limited), 40 O. G. 1239, C. D. 1887.

39. It being expressly stated in the specifications attached to a patent that the claimant makes no claim to a certain combination patented by another, *held*, that the patent conferred no right to the use of such combination. *Shaver v. Skinner Mfg. Co., 41 O. G. 232, C. D. 1887.

40. The sound of articulate speech is one of the "vocal or other sounds" referred to in Bell's patent. The art or process described in said patent consists in 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, and devising a way in which these changes of density could be made and speech actually transmitted put the art in a condition for practical use. 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. *Dolbear v. American Bell Telephone Co., 43 O. G. 377, C. D. 1888.

(Decision of United States supreme court in "The Telephone Cases.")

41. What Bell claims is the art of creating changes of intensity in a continuous current of electricity exactly corresponding to the changes of 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. *Id.

42. This claim is not in opposition to the decision in O'Reilly v. Morse, but is sustained by it, as this 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. *Id.

43. It may be that electricity cannot be used at all for the transmission of speech except in the way Bell has discovered, and that therefore, practically, his patent gives him its exclusive use for that purpose; but that does not make his claim one for the use of electricity distinct from the particular process with which it is connected in his patent. *Id.

44. A claim in the following words, namely: "In a concrete pavement, the use of crushed and pulverized rock, when the same is heated and saturated with dead-oil, crude petroleum or the residuum of petroleum, and mixed with natural asphaltum, Cuban, Trinidad or California, previously dissolved to a pitch by crude petroleum or the residuum of petroleum, substantially as described, and for the purpose set forth," construed as for a *process*, and also as for a process in which the previous saturation of the rock with dead-oil, crude petroleum or the residuum of petroleum is one of the essential steps. *Van Camp v. The Maryland Pavement Co., 43 O. G. 884, C. D. 1888.

45. Under a proper construction of the language such a claim as the foregoing cannot be held to cover both a process and also a composition of matter. *Id.

46. A claim for a composition of matter which is described by the process of making it, sustained. *Id.

47. Where an applicant's specification describing a process closed with the words "and then coated with a thin layer of varnish," but his claims omitted any mention of this step, and it appearing it was not mentioned in the original statement of invention, nor in the original claims, such step need not be treated as an essential part of the invention. Ex parte Koller, 41 MS. D. (1 G. W. D.), Nov., 1889 (Mitchell, Com'r).

48. The first six claims of Patent No. 219,208, granted September 2, 1879, to Charles F. Brush, in view of the fact that he was a pioneer in this branch of electrical construction, construed to cover all forms of mechanism constructed to separate the two or more pairs of carbons "dissimultaneously" or successively, in order that the light may be established between the members of but one pair or set at a time, while the members of the remaining pair are maintained in a separated relation. *Brush Electric Co. v. Western Electric Light and Power Co., 52 O. G. 1950, C. D. 1890.

49. The word "dissimultaneous" used in said claims of said patent construed as referring to that separation which results in the production of a single arc. *Id.

50. The claim involved a friction-plate or pressure contrivance for retarding the force of rebound; *held*, that it must be construed to be one for the application of friction to retard movement unlimited to any particular form or character of mechanical means for effecting such application, and could not be upheld. *Dederick v. Seigmund, 52 O. G. 1537, C. D. 1890.

51. A correspondence between the inventor and the patent office prior to the grant of the patent cannot control the import of claims the terms of which are not ambiguous. *Sugar Apparatus Mfg. Co. v. Yaryan Mfg. Co., 53 O. G. 920, C. D. 1890.

52. The act of July 4, 1836, provides for granting a patent for any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement in any art, machine, manufacture or composition of matter. *Held*, that this patent, which is for an apparatus for improvement in the construction of prisons, was not granted for an art or a process, and that it was not a manufacture or a composition of matter. *County of Fond du Lac v. May, 53 O. G. 1884, C. D. 1890.

53. The result or operation of the Day and Brush lamps held to be widely different; the complainants' lamp burns its carbons by alternate arcs between each pair, necessarily producing a light unsteady and unsatisfactory and varying in intensity, because the increase of distance between the burning carbons causes the light to weaken and finally to form the arc between the other pair of carbons, to repeat the same process of weakening the light until it shifts back to the first pair, and so on, while in defendants' lamp the light burns steadily until the pair of carbons between which it is first produced are wholly consumed, when it shifts to the other pair and consumes those. *Seeley v. The Brush Electric Co., 54 O. G. 661, C. D. 1891.

54. It is the duty of courts to construe a patent by a reference to the language of its claims and an examination of the specifications and drawings accompanying the same. *Norton v. Jensen, 60 O. G. 1326, C. D. 1892.

55. The question of the construction of the claims of a patent is the province of the court and does not rest with the jury. *Marsh v. Quick Meal Stove Co., 60 O. G. 1056, C. D. 1892.

56. Where a claim of a patent reads "In a gasoline stove, etc.," and then enumerates a number of other elements, the words "In a gasoline stove" will be understood as including the well-known essential elements of such stoves, and to enable the plaintiff to recover the other elements of the claim or their substantial equivalents must be all found in the defendant's stove. *Id.

57. Broad and narrow claims on the same invention are not to be so construed as to render their expressed distinctions meaningless. The distinction between them must be maintained, that both may be given effect. *National Cash Register Co. v. American Cash Register Co., 62 O. G. 449, C. D. 1893.

58. The language of a claim is to be read with reference to the purpose to be accomplished by the invention, and the phrase "a continuous-cutting edge" when applied to a fruit-parer means a cutting edge continuous in action, an edge which continuously cuts, and is not limited to an edge free from any nick or notch whatsoever therein. *Sayre v. Scott, 63 O. G. 1818, C. D. 1893.

59. The supreme court, construing the claims of the telephone patent, says: "The claim is not for these several things in and of themselves, but for an electric telephone in the construction of which these things or any of them are used." *American Bell Telephone Co. v. Cushman, 65 O. G. 135, C. D. 1893.

60. The construction of two patents and determination of the identity of the inventions described and claimed therein are matters of law for the court to determine. (Heald v. Rice, 21 O. G. 1443, 104 U. S. 749.) *Miller v. Eagle Mfg. Co., 66 O. G. 845, C. D. 1894.

61. In construing a patent the courts are necessarily subject to the restraints arising from the incorporation into them of the description and claim which the statutes require, but it must be the rule in interpreting these that it is to be presumed the inventor did not intend to split up his invention. *Reece Button Hole Machine Co. v. Globe Button Hole Machine Co., 67 O. G. 1720, C. D. 1894.

62. The maxim *enumeratio unius exclusio alterius* by reason of the doctrine of equivalents does not apply as fully to patents as to instruments in general. *Id.

63. If the recitals of the state of the art in the specification do not tend to limit, explain or nullify the grant, they are of no possible pertinence; but if they do have such tendency the patentee is bound thereby, and the patent must

be construed in the light of the facts so recited. *Heaton Peninsular Button-Fastener Co. v. Schlocht-Meyer Button-Fastener Co., 69 Fed. Rep. 592 (1895).

64. The claim of E., copied from B.'s patent, *held* not the same as the original method claim of E., reciting a different sequence of steps. Edison v. Ball, 71 O. G. 1313, C. D. 1895.

65. Where a claim of a patent does not in terms include a certain element included in another claim, but such element is recognized in the specification as being necessary, the attempt to create a distinct and separate invention out of the first claim and to differentiate it from the actual invention of the second claim has the fault of adhering to technicality without regard to substance. *Appleton v. Ecaubert, 71 O. G. 1617, C. D. 1895.

66. After a disclaimer under the statute a patent is to be construed by what remains. *Schwarzwalder v. New York Filter Co., 72 O. G. 1043, C. D. 1895.

67. In comparing patents, in order to ascertain whether they cover the same or different inventions, not only the face of the patents but also evidence concerning the construction and operation of devices made in alleged exemplification of the patented devices should be considered. *Thomson-Houston Electric Co. v. Western Electric Co., 75 O. G. 347, C. D. 1896.

68. Distinctly different results perceived and understood by the mere practical use of the devices of different patents constitute a fair and liberal test for diversity of invention. *Id.

69. In a claim for a particular form of spindle and support there is no necessity for expressing in terms the devices for revolving the spindle, since the appropriate means for operating it will be understood. *Taylor v. Sawyer Spindle Co., 77 O. G. 452, C. D. 1896.

70. The terms "inward delivery" in a claim for an excavator have direct reference to the mechanism itself, and cannot properly be limited to the description or effect of such mechanism. The clear meaning of a claim to "an excavator having inward delivery" or "with inward delivery through itself" is an excavator so constructed as to produce an inward delivery. *Von Schmidt v. Bowers, 80 O. G. 347, C. D. 1897.

71. The unnecessary designation of certain elements in a claim does not invalidate it. *American Street Car Advertising Co. v. Newton Street Ry. Co., 81 O. G. 306, C. D. 1897.

V. Construction of, Liberal or Broad.

72. Where it does not appear in evidence that the object desired and claimed has been accomplished by any analogous method before the patentee conceived and described the means of effectuating it, he is fairly entitled to all the benefits his patent was intended to confer upon him. *Kirk v. Du Bois, 42 O. G. 297, C. D. 1888.

73. Where a claim calls for a device "as an attachment" to something it may be subject to the construction that it is a claim for the device baldly, and the words descriptive of its use rejected as surplusage, on the theory of Roberts v. Ryer (91 U. S. 157), that a patent covers a device in all the uses to which it may be applied. *McClain v. A. Ortmayer & Son, 42 O. G. 724, C. D. 1888.

74. Where a patentee says that he expects in practical operation to use a device—as, for example, a rivet—to accomplish a certain thing, but does not confine himself specifically to it, any other device which secured the result intended would be allowable and open to him. *Id.

75. While a patent is to be liberally construed, so as to sustain it as a grant of the invention actually made and actually claimed, it can never by judicial construction be made to cover an invention nowhere claimed in it, and which the public has had no fair notice that the patentee intended to claim. *Van Camp v. The Maryland Pavement Co., 43 O. G. 884, C. D. 1888.

76. A claim to a combination covers all the effects produced by the combination, even when such effects are not specifically set forth in the specification. *Thompson v. American Bank Note Co., 45 O. G. 347, C. D. 1888.

77. A patent for a primary invention will not receive a liberal or broad construction where the invention is of a very low order. *Dederick v. Seigmund, 60 O. G. 1193, C. D. 1892.

78. Courts do not construe letters patent for the purpose of their destruction nor in the critical and hostile spirit which a plea in abatement formerly encountered. *Electrical Accumulator Co. v. Brush Electric Co., 61 O. G. 886, C. D. 1892.

79. The claim of a patent for a primary invention should be as liberally interpreted as its fair import will allow, to the end that the inventor's conception shall be justly protected to

its true extent and in its broad and actual scope. *National Cash Register Co. v. American Cash Register Co., 62 O. G. 449, C. D. 1893.

80. In such a claim, while it may be true that particular mechanism is mentioned, it does not necessarily result that the patentee intended to limit the claim to any special devices or that the law will so restrict it. *Id.

81. Where a patentee has made a meritorious invention the court should not be overzealous in trying to defeat him by an illiberal construction of the patent. On the contrary, the court should seek a construction which gives life to the patent and protection to the inventor. *Lalance & Grosjean Mfg. Co. v. Habermann Mfg. Co., 62 O. G. 452, C. D. 1893.

82. While courts have no right to enlarge a patent beyond the scope of its claims as allowed by the patent office, the inventor is entitled to a liberal construction to secure to him his actual invention. (Citing Winans v. Denmead, 15 How. 341). *Brush Electric Co. v. Electric Improvement Co. of San José, 62 O. G. 1651, C. D. 1893.

83. Unambiguous terms in a claim should not be given a narrow or forced construction not required by the state of the art which practically would defeat the patent. *Sayre v. Scott, 63 O. G. 1818, C. D. 1893.

83a. While a claim should not be construed so as to expand it, on the other hand it should not be given a narrow interpretation which would defeat the patent, unless absolutely required by the state of the art. *Id.

84. Meritorious inventions of primary character call for liberal interpretation. (Tilghman v. Proctor, 19 O. G. 859, 102 U. S. 707; Morley Machine Co. v. Lancaster, 47 O. G. 267, 129 U. S. 263; Béné v. Jeantet, 47 O. G. 402, 129 U. S. 683.) *Celluloid Mfg. Co. v. Arlington Mfg. Co., 64 O. G. 1263, C. D. 1893.

85. Patentee is entitled to all the advantages incident to the patented apparatus, even though not described in the specification or originally perceived by the inventor. (Roberts v. Ryer, 10 O. G. 204.) *Aerated Fuel Co. v. Woodbury Glass Co., 64 O. G. 1266, C. D. 1893.

86. Although the complainants have not made a pioneer invention in the broad sense of the term, they are entitled to a construction liberal enough to cover a machine which in the same art performs the same work in manner almost identical. *Loewer and Schelter v. C. P. Ford & Co., 64 O. G. 1536, C. D. 1893.

87. The fact that the pioneer machine, when first produced, failed to produce an absolutely perfect "linotype," which fault was remedied, however, by the patentee, and perfect justification produced by improved machines subsequently made by others, is no reason for denying relief to the pioneer patentee to the full extent of his invention. *Mergenthaler Linotype Co. v. Press Publishing Co., 65 O. G. 2062, C. D. 1893.

88. *Held*, that an inventor is entitled to all the necessary and legitimate results attained by his invention, including such as were not foreseen. It is the thing, and not the uses which it may be found capable of, which is patentable. *National Meter Co. v. Thomson Meter Co., 70 O. G. 925, C. D. 1895.

89. Commercial success of a patented article due to the demand caused by a change of fashion and to extensive and seductive advertisement will not serve to broaden the scope of the patent. *Richardson v. America Pin Co., 75 O. G. 351, C. D. 1896.

90. Where the true value of the invention lies in one element of a combination, and an infringer has appropriated that, he should not be permitted to escape upon the plea that he has omitted a subordinate and comparatively non-essential feature unless it is clear that he has omitted it. To find an invention meritorious and then defeat it by an illiberal construction is as inconsistent as it is unfair. To decide that an inventor has conferred a benefit upon mankind and subsequently destroy his patent by a harsh construction is condemned both by the general principles of equity and by express authority. The court should be diligent to give him the rewards of his genius and labor and resolve doubtful points in favor of the patent. *Gould Coupler Co. v. Pratt, 75 O. G. 1547, C. D. 1896.

91. The circumstance that a patentee, when an applicant, had no attorney is no reason for adopting any peculiarly liberal construction of his patent. *Gould Coupler Co. v. Trojan Car Coupler Co., 75 O. G. 2009, C. D. 1896.

92. So much of the mere form given in the specification, drawings and claim as is necessary to accomplish all the functions expressly enumerated is essential and must be retained. A function afterward discovered cannot be used to broaden a claim, and such function is available to the patentee only when the patent, construed in the light of the circumstances existing when it is applied for, is broad enough to embrace it. When there is nothing to show that the new function was in the mind of either the inventor or of the patent office when

the patent issued, it cannot be said that if the patent be narrow on its face it should be broadened out by construction to cover this new function. It would establish a very dangerous precedent to give to a mere paper patent which has lain dormant for years a breadth not contemplated on its face by reason of some new function discovered long after its issue and after that function had been availed of in practice by others. Such precedent, if established, would on the whole operate more to entrap honest manufacturers than to advance the useful arts. *Long v. Pope Mfg. Co., 77 O. G. 1428, C. D. 1896.

93. The principle that a patent should be construed in a liberal spirit to sustain the just claims of the inventor is not to be carried so far as to exclude what is in it or to interpolate anything which it does not contain; but liberality, rather than strictness, should prevail where the fate of the patent is involved and the question to be decided is whether the inventor shall hold or lose the fruits of his genius and his labors. *Matheson v. Campbell, 79 O. G. 684, C. D. 1897.

94. The Bowers patents disclose and cover inventions of a pioneer character, standing at the head of the art, and their claims are entitled to a broad and liberal construction. *Von Schmidt v. Bowers, 80 O. G. 347, C. D. 1897.

95. Said claims are not functional in form, nor are they claims for results, nor are they limited to any particular form of construction of the elements which make up the combinations, but they are broad generic claims without any limitation as to the form of construction of the particular elements. *Id.

96. If a reasonable doubt exists as to the novelty of an invention covered by a patent, it is to be resolved in favor of the patent. *Kinnear & Gager Co. v. Capital Steel Metal Co., 81 Fed. Rep. 491 (1897).

97. This patent held to cover a digester having a structural lining composed of materials possessing plastic, adhesive, cohesive and acid-resisting characteristics, and not to be limited to a lining of hydraulic cement or any other particular cementitious ingredient. *American Sulphite Pulp Co. v. Howland Falls Pulp Co., 80 O. G. 515 (1897).

98. The law applicable to the patent distinguished from that in the Incandescent Lamp Patent (159 U. S. 465). In the latter Sawyer and Mann did not limit themselves to a particular material, or even to a class; but the patentee limits himself to a class of material, and, still further, within that class to a material possessing the required acid-resisting qualities. *Id.

99. A pioneer inventor is entitled to a patent covering his adaptation of the forces in matter which he has discovered and the compositions with which he has successfully experimented and such as would naturally develop in the growth of the art without invention, as well as those which he has described. *Id.

100. Where an invention consists of great merit and is a substantial advance over mechanical constructions heretofore used in the art to which it appertains, the claims of the patent should be such a construction as will give the patentee the full benefit of the mechanical advance which he has contributed to the mechanical arts and claimed. *Mitchell v. Ewart Mfg. Co., 80 O. G. 1762, C. D. 1897.

101. The device is wholly new. Nothing in anticipation thereof has been brought to the attention of the court nor cited by way of reference in the patent office. *Held*, patent is entitled to have such a broad construction put upon it as will enable the patentee to obtain the benefit of the full scope of his invention. *Forgie v. Duff Mfg. Co., 81 O. G. 1113, C. D. 1897.

VI. Construction of, by Drawings.

102. One part of the invention is properly described in the body of the specification, but the second part is not, although shown in the drawings. Doubtful and ambiguous specifications can be aided and made plain by drawings but the latter cannot supply an entire absence of description. The claim, which is broad enough to cover the second part of the invention, cannot be sustained. *Gunn v. Savage, 30 Fed. Rep. 366 (1887).

103. The drawings of a patent may be appealed to in construing its claims, if the language is ambiguous and leaves something for construction, but in this case the language of the claim is plain and the drawing, being inconsistent with it, cannot be used to elucidate it. *Kidd v. Horry, 33 Fed. Rep. 712 (1888).

104. The court below having decided where certain devices were shown in the drawing of the patent but not in terms referred to either in the specification or in the claims as a part of the invention, nor in any way alluded to, except incidentally in the specification, that the claims could not be thereby limited by construction to make such devices an essential feature of the invention, *held*, that the construction the court gave to the claims of the

patent as originally issued was indisputably correct. *Roemer v. Neumann, 49 O. G. 1535, C. D. 1889.

105. A claim containing as elements certain tubes, without specifying vertical or horizontal tubes, is not confined to vertical tubes, though the drawings show them only in this position, and their ends are designated as "upper" and "lower," where the invention clearly includes horizontal tubes, especially where, in other claims, the patentee intends to confine himself to vertical tubes, and he so expresses himself in plain language. *Sugar Apparatus Co. v. Yaryan Mfg. Co., 53 O. G. 920, C. D. 1890.

106. The drawings are illustrative and explanatory, but not definitive, and are only to be treated as part of the description of the thing patented. *Perrin v. Manhattan Ry. Co., 62 O. G. 1209, C. D. 1893.

107. Although the drawing of a patent shows knives of a cutter-head set at a certain angle, this will not enable the patentee to rest his invention on that particular degree of angularity when there is nothing in the specification to show that it is intended to limit the pitch of the knives to that angle. *Caverly v. Deere, 73 O. G. 1711, C. D. 1895.

VII. Construction of, by Specification.

108. Where the patented invention is but one of a series of improvements, all having the same general object and purpose, the claims of the patent must be restricted to the precise form and arrangement of the parts as described in the specification and to the purpose indicated therein. *Bragg v. Fitch, 39 O. G. 329, C. D. 1887.

109. Claims must be construed by the language which the patentee has employed in his specification, and not by the language which he might have employed. *Patent Clothing Co. (Limited) v. Glover, 40 O. G. 1135, C. D. 1887.

110. Admitting the rule to be that a claim in a patent is to be construed with reference to the specification, yet, when the claim, considered with reference to the specification, is ambiguous, special significance should be attached to correspondence between the patentee and the patent office, showing how the latter construed it, and what was the extent of the monopoly intended to be granted. *Royer v. Schultz Belting Co., 50 O. G. 558, C. D. 1890.

111. Though a claim is to be construed in connection with the explanation contained in the specification, and it may be so drawn as in effect to make the specification an essential part of it, yet the specification and drawings are usually looked at only for the purpose of better understanding the meaning of the claim and certainly not for the purpose of changing it and making it different from what it is. *The Howe Machine Co. v. The National Needle Co., 51 O. G. 475, C. D. 1890.

112. A patentee's claim is the measure of his right of relief, and while the specification may be referred to to limit the claim it can never be made available to expand it. *McClain v. Ortmayer, 57 O. G. 1129, C. D. 1891.

113. While the drawings only illustrate the invention in its application to railroad cars and to railroad cars having each two four-wheeled trucks, from the language of the specification it is apparent that the invention was designed to be applied to a series of vehicles of kinds that are not provided with four-wheeled trucks, but are usually provided with two-wheeled trucks. *Perrin v. Manhattan Ry. Co., 62 O. G. 1209, C. D. 1893.

114. The terms of the claim are co-extensive with the description of the patent. *Id.

115. The true meaning of claims must be gathered by comparing them with the context of the specification. *Celluloid Mfg. Co. v. Arlington Mfg. Co., 64 O. G. 1263, C. D. 1893.

116. Where claims in a patent are not supported by a description in the patent, such claims are of no validity. *Pacific Cable Ry. Co. v. Butte City Street Ry. Co., 66 O. G. 1758, C. D. 1894.

117. The specification in the case at bar was so referred to in the claims that either may aid in the interpretation of the other. (Pearl v. Ocean Mills, 11 O. G. 2, 3 Ban. & A. 469, Fed. Cas. No. 10, 876; Rob. on Pat., sec. 517.) *American Sulphite Pulp Co. v. Howland Falls Pulp Co., 80 O. G. 514, C. D. 1897.

VIII. Construction of, by State of Art.

(See X, Claims Limited by Their Terms.)

118. Claims must be construed with reference to the prior state of the art. *Grier v. Wilt, 38 O. G. 1365, C. D. 1887.

119. Hammerschlag, being a pioneer in the art described in his patent, is entitled to a broad construction of his claim in controversy. *Hammerschlag Mfg. Co. v. Bancroft, 40 O. G. 1339, C. D. 1887.

120. Where it does not appear in evidence that the object desired and claimed has been accomplished by any analogous method before the patentee conceived and described the means of effectuating it, he is fairly entitled to all the benefits his patent was intended to confer upon him. *Kirk v. Du Bois, 42 O. G. 207, C. D. 1888.

121. A claim for a process consisting of several steps may be limited by the state of the art and the description in the patent to the instrumentalities or their equivalents as thus described, which are essential in the carrying out of the process claimed. *Lawther v. Hamilton, 42 O. G. 487, C. D. 1888.

122. In cases where none of the elements of a combination is new nor is claimed separately and there are other similar kindred combinations in use, the evident tendency of late decisions is to limit the patentee to the particular form of the various elements composing the combination shown by his drawings. *Heine Safety Boiler Co. v. Smith Feed Water Heater and Purifier Co., 47 O. G. 1634, C. D. 1889.

123. The prior state of the art and the express language of the specification in Letters Patent No. 180,857 combine to restrict the second claim to the use of a stencil made by electric pen. *Edison v. Klaber, 47 O. G. 1486, C. D. 1889.

124. 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. (Winans v. Denmead, 15 How. 330; Van Martyr v. Miller, 15 Blatchf. 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 the claims. (Manufacturing 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, 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, the courts will, if possible, construe the language of his claim so as to give him the full benefit of his improvement. (Turrill v. Railroad Co., 1 Wall. 491; Rubber Co. v. Goodyear, 9 id. 788.) *Consolidated Roller Mill Co. v. Coombs, 48 O. G. 255, C. D. 1889.

125. When a patentee is a pioneer in a branch of invention, his claims may be construed to cover all forms of mechanism constructed to effect the same result as the particular mechanism covered by said claims. *Brush Electric Co. v. Western Electric Light and Power Co., 52 O. G. 1950, C. D. 1890.

126. In construing a claim, in view of the prior art, it cannot be limited beyond the plain import of its terms. It must have this effect or be disallowed. *Enterprise Mfg. Co. v. Deissler, 56 O. G. 1205, C. D. 1891.

127. It is true that when the invention is of a primary character a larger latitude is given to the equivalents which the patent includes than if the invention was a modification of a well-explored art; but this doctrine cannot be applied to primary invention of low order. *Dederick v. Seigmund, 60 O. G. 1193, C. D. 1892.

(See, also, *Vincent v. Rigby, 64 O. G. 861, C. D. 1893, and *Carter Mach. Co. v. Hanes & Co., 74 O. G. 1277, C. D. 1896.)

IX. Claims for Combination.

(See Construction of Claims; Patentability—Combination; Patents Defective and Void.)

128. Where a part of a machine covered by a combination patent is described in a claim as having a certain motion, that motion, as distinguished from the means of producing it, is not covered by the claim. *Royer v. Schultz Belting Co., 38 O. G. 898, C. D. 1887.

129. A claim for a combination of mechanical elements cannot be construed to cover a process or mode of operation, but must be limited to the mechanical features claimed and their equivalents. *Grier v. Wilt, 38 O. G. 1385, C. D. 1887.

130. Where the claim covered the combination of three elements, each designated by letter and by general description, it does not follow that the invention is confined to other particulars of construction of these elements described in the specification. *Temple Pump Co. v. The Goss Pump and Rubber Bucket Mfg. Co., 39 O. G. 467, C. D. 1887.

131. Claims must be construed with reference to the specification; and where the latter imposes a restriction or limitation upon an element of a combination, a claim for the combination cannot be so construed as to avoid such limitation. *Snow v. The Lake Shore and Michigan Southern Ry. Co., 39 O. G. 1081, C. D. 1887.

132. Where a claim in a patent is for a combination of several elements, and it appears in evidence that the combination is inoperative without the addition of another element, such

claim is void. *Tarrant v. Duluth Lumber Co., 39 O. G. 1425, C. D. 1887.

133. In claims for combinations it is unnecessary to include any elements except such as are essential to the peculiar combination and affected by the invention. *Rapid Service Store Ry. Co. v. Taylor, 42 O. G. 721, C. D. 1888.

134. Where a claim covered the combination of one element named with another element named, "or other part," these last words would mean some other equivalent part and the claim would be sufficiently certain. *Babcock & Wilcox Co. v. Pioneer Iron Works, 43 O. G. 756, C. D. 1888.

135. While the law recognizes the patentability of a combination of old devices producing a new and useful result, it patents the entire combination, and not any single element of it, nor any combination containing different or other elements. *Dudley E. Jones Co. v. Munger Improved Cotton Machine Mfg. Co., 5[illegible] O. G. 274, C. D. 1892.

136. The claims being for combinations expressed in broad and general terms, they are to be construed in the light of the specification and each claim is to be "regarded as including such devices and combinations as are necessary to meet the requirements of the general terms in which it is expressed." *Illinois Watch Co. v. Robbins and Avery, 61 O. G. 721, C. D. 1892.

137. In a combination patent it is permissible for the patentee, after claiming the whole machine, to claim the combination of fewer parts than the whole, if this combination of parts is new, even though, taken alone, it will not result in any known useful product. (Wells v. Jaques, 5 O. G. 364, followed.) *Roberts v. H. P. Nail Co., 63 O. G. 613, C. D. 1893.

138. The claim is not invalid because inoperative for want of additional elements. The appropriate means for rendering the combination operative will be understood in any such case. *Deering v. Winona Harvester Works, 69 O. G. 1641, C. D. 1894.

139. In claims for combination of a spindle, supporting tube and other connected parts, it is not necessary to specify, in terms, the device for revolving the spindle. Any suitable means will be understood. *Taylor v. Sawyer Spindle Co., 75 Fed. Rep. 301 (1896).

140. It is not requisite to include in a claim as elements thereof parts of the machine which are necessary to its action so far as they may be understood and can be supplied by those who are ordinarily skilled in the art. *American Street Car Advertising Co. v. Newton Street Ry. Co., 81 O. G. 506, C. D. 1897.

X. Claims Limited by Their Terms.

(See VIII, State of Art, *supra*.)

("The claim is a statutory requirement prescribed for the very purpose of making the patentee define precisely what his invention is, and it is unjust to the public as well as an evasion of the law to construe it in any manner different from the plain import of its words." White v. Dunbar, 26 O. G. 353, 119 U. S. 47, C. D. 1884.)

141. Where certain of the claims of a patent give to an element in a combination a particular mechanical construction, the same element without such description of mechanical construction occurring in combination in other claims must be limited to the particular mechanical construction, where no other mechanical construction is described in the patent. *Railway Register Mfg. Co. v. Third Avenue Ry. Co., 42 O. G. 379, C. D. 1888.

142. Where the import is plain, resort cannot be had to the specification for the purpose of enlarging the scope of claims. *Id.

143. A patentee claiming a cement consisting of eight ingredients is limited thereto, although the specification states that one of said ingredients is to be used only when the cement is to be applied upon rough or uneven surfaces. The patent must stand or fall by the combination claimed. *Otley v. Watkins, 36 Fed. Rep. 323 (1888).

144. While the specification makes many references to the use of the skein in the process of dyeing, which process of using might be patentable, it is not covered by the claims, and they rigidly control. *Grant v. Walter, 47 O. G. 1220, C. D. 1889.

145. Where persons so skilled in the construction of mechanical devices as in the present case disagree, the safer course to pursue is to take each patent—Pullman and Sessions—as it stands and give to each inventor no more and no less than what he describes and claims as his invention. *Pullman's Palace Car Co. v. Boston and Albany R. Co. 56 O. G. 1255, C. D. 1890.

146. When an inventor applies for a patent and clearly specifies and limits his invention and afterwards amends his application without disclosing any change of subject, and is granted a patent on his amendment, he is limited to the invention as he originally set it forth and is estopped from claiming that it covers something not included in the original application. *Will-

iams v. Goodyear Metallic Shoe Co., 58 O. G. 1257, C. D. 1892.

147. The patentee conceived the idea of gradually stopping the backward movement of the plunger in a rebound baling-press by applying a friction-brake. *Held*, that as friction-brakes are very old it was a low order of invention to apply such a brake to a baling-press, and a patent which with difficulty maintains its right to patentability must receive a narrow construction. *Dederick v. Seigmund, 60 O. G. 1193, C. D. 1892.

148. If the Fox machine could be held to show patentable invention, it constitutes one of a series of improvements, all having the same general object and purpose, and the patent must therefore be limited to the precise form and arrangement of parts described in the specifications and to the purpose indicated therein. (Bragg v. Fitch, 39 O. G. 829, 7 Sup. Ct. Rep. 980, 121 U. S. 483, and Phœnix Caster Co. v. Spiegel, 50 O. G. 1591, 10 Sup. Ct. Rep. 409, 133 U. S. 360, followed.) *Fox v. Perkins, 62 O. G. 160, C. D. 1893.

148a. This construction of the patent is also rendered necessary by the fact that various broader claims were rejected and abandoned under both the original and the re-issue applications. *Id.

149. Appellants' exclusive right may not be expanded by construction beyond the terms chosen to express the invention to include all means however differing in mode of action and principle from the process described in the patent. (McClain v. Ortmayer, 57 O. G. 1229, 141 U. S. 419.) *Celluloid Mfg. Co. v. Arlington Mfg. Co., 64 O. G. 1263, C. D. 1893.

150. The cancellation of the phrase "mechanical or cohesive action" from application by his own voluntary act indicated intention clearly inconsistent with defendant's present insistance. *Id.

151. *Held*, that where a claim calls for a particular device, the procuring by the patentee of a subsequent patent for a different device, which the defendants' device resembles, operated at least as a recognition on the part of the patentee and of the patent office that there is a patentable difference between the two, which may be fairly invoked to limit the patent to the specific means described in the claim. McCormick Harvesting Machine Co. v. C. Aultman & Co., 64 O. G. 1791, C. D. 1893.

152. There is no support for the proposition that, for the purpose of preserving the possibility of a function which the patentee had repudiated before the patent issued, the claims, though worded differently, should be so read as to cover only the exact construction and relation of parts illustrated in the drawings. *Western Electric Co. v. Sperry Electric Co., 65 O. G. 597, C. D. 1893.

153. In construing a claim elements will not be imported into it that would operate to so enlarge its scope as to cover an invention not indicated upon the face of the invention. (Day v. Railway Co., 49 O. G. 1364, 132 U. S. 98.) *Wollensak v. Sargent & Co., 66 O. G. 1007, C. D. 1894.

154. Where the claims are respectively drawn, the fact that the invention is a pioneer cannot serve to do away with the restrictions specified in the claims. *Groth v. International Postal Supply Co., 68 O. G. 413, C. D. 1894.

155. Where an element is described, declared to be an essential feature of the invention, and made an element in the claims, *held*, that the patentee is not at liberty to say that it is immaterial or that a device which dispenses with it is an infringement. (Vance v. Campbell, 1 Black, 427; Water-Meter Co. v. Desper, 101 U. S. 332; Gage v. Herring, 23 O. G. 2179, 107 U. S. 640, 648; Gould v. Rees, 15 Wall. 187; Brown v. Davis, 34 O. G. 435, 116 U. S. 237, 249.) *Wright v. Yuengling, 69 O. G. 639, C. D. 1894.

156. If patentable at all, a combination of old means with improvements adapting it to new and non-analogous material and use, a patent will be limited to the combination modified by the improvements. *Wright & Colton Wire-Cloth Co. v. Clinton Wire-Cloth Co., 73 O. G. 1046, C. D. 1895.

157. While a feature may be read into a claim with a view of showing the connection in which a device is used and proving that it is an operative device, an element which is not present may not be read into the claim for the purpose of making out a case of novelty or infringement. *McCarty v. Lehigh Valley R. Co., 73 O. G. 1707, C. D. 1895.

158. A statement in the specification that in the best methods of applying their invention the patentees use a supplemental device there described is not to be read, as a limitation, into a claim which contains no reference to it, especially when the significance of its omission is emphasized by its incorporation into a subsequent claim. *American Dunlop Tire Co. v. Erie Rubber Co., 74 O. G. 963, C. D. 1896.

159. Mere improvers in combinations of old elements and ingredients should be limited by

a strict construction of their patents, so as to leave the unappropriated field of art open to other improvers, that they may be encouraged to exercise their industry and inventive genius. *Carter Machine Co. v. P. H. Haines & Co., 74 O. G. 1277, C. D. 1896.

160. The fact that a patented device is meritorious is no reason why the patent should be construed to cover any other construction than that which was evidently in the inventor's mind and expressed in the specification. *Gould Coupler Co. v. Trojan Car Coupler Co., 75 O. G. 2009, C. D. 1896.

161. A claim for a street-car platform guard made of wire, *held* not so far limited that it would not be infringed by any screen in that place save one made of wire. *Johnson v. Brooklyn Heights R. Co., 75 Fed. Rep. 668 (1896).

162. The law is imperative that the language of the description and claims, when clear and unambiguous, must be adhered to, even though the court be of the opinion that the patentee has unnecessarily restricted his claims. *Beale v. Spate, 76 O. G. 965, C. D. 1896.

163. The statement of the specification that the patented pulleys are to be made of wood governs the construction of the patent, subject only to the expressed exceptions stated in a subsequent part of the specification. *Dodge v. Post & Co., 78 O. G. 339, C. D. 1897.

164. The duty of the court is to construe the claims according to the plain meaning of their words, and if the claims are susceptible of two interpretations that one should be chosen which upholds and vitalizes the patent; but this cannot be held to include the formulation of claims by reading into or adding to them elements or restrictions which are not therein set out and not referred to in the specification except by implication. *Paul Boynton Co. v. Marius Chute Co., 80 O. G. 1894, C. D. 1897.

XI. Claims Limited by Amendments in the Patent Office.

165. A patentee having, in compliance with the requirements of the patent office, excluded by amendment certain matter from his original specification, is not at liberty to insist upon a construction of his patent which will include what he was expressly required to abandon and disavow in it. *Sutter v. Robinson, 38 O. G. 230, C. D. 1887.

166. It is wholly irrelevant to inquire whether the patentee was obliged to limit himself by the ruling of the patent office. It is enough to say that he did so limit himself. *Toepfer v. Goetz, 41 O. G. 933, C. D. 1887.

167. Where the applicant in soliciting a reissue limits his claims in view of the objections of the patent office, he is bound by such limitation in subsequent suits upon that re-issue. *Crawford v. Heysinger, 42 O. G. 197, C. D. 1888.

168. As thus limited, the first and second claims of the Heyl re-issue cover only the precise combinations set forth in them, as described in the specifications and illustrated in the drawings of such re-issue. *Id.

169. The applicant adopted the advice of the examiners-in-chief and accepted a certain claim. If, now, the narrow construction which must be adopted by the court will render the patent virtually useless, it is a sufficient answer that the patent office contemplated this construction and would not otherwise have granted the patent. A broader construction would have given him precisely what the office refused. *Geis v. Kimber, 36 Fed. Rep. 105 (1888).

170. The intimation in Sargeant v. Hall (114 U. S. 38) that the limitations introduced into an application after it was persistently rejected must be strictly construed against the inventor and in favor of the public, and looked upon as in the nature of disclaimers, means no more than that when under the state of the art and the action of the office a patentee of a combination has modified and limited his claim he shall be held strictly to the combination as he has described it. It does not debar the patentee from the benefit of the doctrine of equivalents. *Rodebaugh v. Jackson, 47 O. G. 658, C. D. 1889.

171. Where a claim in complainants' application broad enough to cover the machine used by defendants was rejected on reference to a prior patent, and the applicant was compelled to present a new claim having a limitation not found in the claim first presented, the new claim cannot be enlarged to cover what was first rejected. *Rodebaugh v. Jackson, 47 O. G. 660, C. D. 1889.

172. A patentee will not be permitted to say that certain specified elements of his combination claim are not essential to the combination. *Watson v. The Cincinnati, Indianapolis, St. Louis & Chicago Ry. Co., 47 O. G. 1843, C. D. 1889.

173. The claim as allowed defines the patentee's invention, and it ought not to be enlarged beyond the fair interpretation of its terms. It would not be justifiable to import

into the claim an element which would operate to so enlarge its scope as to cover an invention in no manner indicated upon its face. *Day v. The Fair Haven and Westville Ry. Co., 49 O. G. 1364, C. D. 1889.

174. Where a patentee has modified his claim in obedience to the requirements of the patent office, he cannot have for it an extended construction which has 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 Phœnix Caster Co. v. Spiegel, 50 O. G. 1591, C. D. 1890.

175. A restricted claim as finally formulated by an applicant for a patent and allowed by the office after the rejection of broader claims is strictly binding upon the patentee, and he is precluded from afterward insisting on a broader construction. *Lane v. Park, 59 O. G. 788, C. D. 1892.

176. Where the defendants claimed that while the claims originally presented by Brush were broad enough to cover the feature of the successive burning of the two pairs of carbons, yet these had been rejected as functional, and he had subsequently accepted narrower claims, and that consequently he could not thereafter claim by construction such feature. *Brush Electric Co. v. Western Electric Light & Power Co., 52 O. G. 1950, C. D. 1890.

177. Where it appeared that the original application for the first patent in suit included the device afterward patented in the second, and that in erasing a description of this there was also erased a description of a modification of the first, in which a "dome" placed above the evaporating tubes was dispensed with, and that the claims in issue did not include the dome as an element of the combination, *held*, that the claims should be construed to cover the combination set out therein, and that the word "dome" should not be read into the claims. *Sugar Apparatus Mfg. Co. v. Yaryan Mfg. Co., 53 O. G. 920, C. D. 1890.

178. A letter from applicant for patent replying to a rejection by the patent office, distinguishing a claim from the references cited against it by calling attention to the fact that the surfaces made an element therein were vertical, not horizontal, as in the alleged anticipation, affects no claim but the one rejected. *Id.

179. Where an applicant before the patent office originally presents broad claims, and being rejected upon them by references 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, 58 O. G. 948, C. D. 1892.

180. Whatever the date of the invention it must be construed with the limitations imposed by the patent office as a condition of the grant. *Id.

181. Where an applicant has acquiesced in the rejection by the patent office of his original claims by submitting amended claims and taking a patent therefor, the court will limit him to a strict construction of the allowed claims. *J. L. Mott Iron Works v. Standard Mfg. Co., 59 O. G. 2067, C. D. 1892.

182. Where a patentee, on the rejection of his application, inserts 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 it would have been if such limitations and constructions were not contained in it. *Royer v. Coupe, 62 O. G. 318, C. D. 1893.

183. Letters Patent No. 207,058, issued August 13, 1878, to Miller & Coll, for an improvement in sheet-metal cans, is, by reason of the rejection and abandonment of a broader claim, strictly limited to the form therein described. *Coll v. Seneca, 64 O. G. 1132, C. D. 1893.

184. Letters Patent No. 150,506, February 9, 1875, to Marquis L. Gorham, having been surrendered for a re-issue, which re-issue application contained claims substantially, if not identically, the same as the claims in the patent, together with other claims which were broader than the claims in the patent, and which broader claims and certain of the other claims as well were rejected, and which certain of the other claims are here sued on, and the rejection having been acquiesced in and the original patent returned to the owners — *McCormick Harvesting Machine Co. v. C. Aultman & Co., 64 O. G. 1791, C. D. 1893.

185. *Held*, that the same principle is applicable to a re-issue proceeding where a party voluntarily resubmits his patent to the examination and revision of the patent office and acquiesces in a rejection of claims or in a construction placed thereon which operates to

restrict or narrow the patent that obtains in acquiescences in rejections upon original proceedings. *Id.

186. *Held*, that by the presentation of claims meaning substantially or identically the same things as the claims sued on, which were rejected and the rejections acquiesced in, the claims sued on had become destroyed by the re-issue proceedings and the patent amended to the extent of the original claims rejected. *Id.

187. *Held*, that after an adverse decision by the patent office on certain claims the patentee or his successor in right and interest is not entitled to assert the validity of such claims or insist upon the benefit thereof unaffected by the re-issue proceedings and adverse action. *Id.

188. *Held*, that claims having been voluntarily resubmitted to the revising jurisdiction of the patent office by an application for re-issue, which repeated them literally or in substance, and having been rejected or adjudged against the patentee, not on formal grounds, but for reasons and on references to prior patented devices, and no appeal having been prosecuted from such decision, the effect of such adverse decision should be regarded as fatal to said claims to the same extent as their rejection upon the original application would have been. *Id.

189. Where it appears, on an examination of the file-wrapper and contents of the original application, that the applicant sought broad claims, but narrowed them on citation of references and rejection by the patent office in order to obtain the patent, *held*, that the patentee and those holding under him are estopped thereby from insisting upon such construction of the allowed claim as would cover what had been previously rejected, and also re-issuing to broaden such narrow claim by including what had been previously rejected and canceled in the original application. *Corbin Cabinet Lock Co. v. Eagle Lock Co., 65 O. G. 1066, C. D. 1893.

190. Where the applicant has acquiesced in the rejection of a claim, he is estopped thereby, when a patentee, to claim the benefit of his canceled claim or such a construction of his patented claim as would be equivalent thereto. This rule is applicable both when the canceled claim is broader and narrower than the patented claim. *Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co., 67 O. G. 271, C. D. 1894.

191. Words which might otherwise be regarded as non-essential may be introduced in such manner as to make them essential, as those introduced by way of amendment. *Reece Button-Hole Mach. Co. v. Globe Button-Hole Mach. Co., 67 O. G. 1720, C. D. 1894.

192. It would defeat the ends of justice to rigidly hold that phrases inserted or omitted by amendment were emphasized. *Id.

193. The patentee, having altered his specification to accord with the views of the patent office examiner, cannot now claim any broader construction of his patent. (Cases cited.) *Kennedy v. Solar Refining Co., 69 Fed. Rep. 715 (1895).

194. *Held*, that where a patentee during the pendency of his application presented matter whereby he described and sought to include a device substantially identical in form and in details of construction with that made by the defendants, which matter the patent office regarded as for an entirely distinct and independent invention from that embraced in the invention as originally filed, and which matter was for such reason excluded, and the applicant acquiesced in such ruling, he cannot be heard to insist that the matter so excluded is nevertheless covered by the patent. *Wells Glass Co. v. Henderson, 72 O. G. 285, C. D. 1895.

195. Patentee, when applicant, having been obliged, in view of certain references cited by the office, to elect to prosecute one of two features as the essential characteristic of his invention, and electing to show, describe, claim and insist upon his invention as consisting in one feature having certain functions, is bound by his admission, and is not in a subsequent suit in a position to claim that his invention consisted in the feature which he ignored in making his election. *Richardson v. American Pin Co., 75 O. G. 351, C. D. 1896.

196. When, in order to obtain an allowance of a claim, it is amended by the insertion of certain limiting words, it cannot afterward be construed to be the same as the original claim. To hold that words inserted with such formality mean nothing is going beyond any reported authority. *Beale v. Spate, 76 O. G. 965, C. D. 1896.

197. Where the patentee acquiesced in the ruling of the patent office that the application of hand-wheels to a road-grading machine for imparting motion to the devices for raising and depressing the scraper-blade was old, and, for the purpose of obtaining his patent, restricted his claims in this particular to momentum or balance wheels, *held*, that he is bound by such restriction. *American Road

Machine Co. v. Pennock & Sharp Co. (Limited), 77 O. G. 633, C. D. 1896.

198. When a patentee accepts his original patent without objection and without applying for re-issue, he must be assumed to have assented to such changes as were made by his solicitor while the application was on its way through the office. *Matheson v. Campbell, 79 O. G. 686, C. D. 1897.

XII. Claims Construed by Reference Letters in Drawing.

199. The claims are not narrowed by any letters of reference to the drawing. *Perrin v. Manhattan Ry. Co., 62 O. G. 1209, C. D. 1893.

200. *Held*, that where the elements which go to make up the combination of a claim are mentioned specifically and by reference letters, such specific reference operates to confine and restrict the claim to the particular devices described. *McCormick Harvesting Machine Co. v. C. Aultman & Co., 63 O. G. 1791, C. D. 1893.

201. In addition to the limitations made necessary by the prior art the language employed narrows the first claim of Letters Patent No. 266,895 to the precise mechanism of the patent. Every element is restricted by a reference letter to the structure described and shown. A claim so explicit cannot be enlarged by construction. *Parry Mfg. Co. v. Hitchcock Mfg. Co., 64 O. G. 860, C. D. 1893.

202. The rule is that where the applicant acquiesces in the rejection of claims by the patent office or in a construction which narrows or restricts them, and where the elements which go to make up the combination of the claim are mentioned specifically and by reference letters, leaving no room for question as to what was intended, the claim must be confined and restricted to the particular device described. (Knapp v. Morss, 65 O. G. 1593, 150 U. S. 221.) *Lehigh Valley R. Co. v. Kearney, 72 O. G. 139, C. D. 1895.

203. The mere use of reference letters in the claims of a combination patent does not of itself, where the invention is really of a primary and pioneer character, limit the scope of the claims to the exact form shown. On the contrary, nothing will restrict a pioneer patentee's rights save the use of language in his specifications and claims which permits no other reasonable construction than that he positively intended to limit the scope of his invention to the particular form shown, thus indicating a willingness to abandon to the public any other form. (58 Fed. Rep. 773.) *McCormick Harvesting Machine Co. v. C. Aultman and Co., 73 O. G. 1999, C. D. 1895.

204. If the invention is broad and meritorious, and a decided advance in the art, reference letters alone in the claims will not limit them to the exact form of the device described. (Cases cited.) *Muller v. Lodge and Davis Machine Tool Co., 77 Fed. Rep. 621 (1896).

XIII. To Assignees.

(See Assignment — Disputed Title.)

205. The legal title to a patent vests *ut* once on its issuance to the person who by the record is entitled to it; but it is not mandatory under the language of the statute that the patent run in form to such record owner. (Gaylor v. Wilder, 10 How. 477.) *Consolidated Electric Light Co. v. McKeesport Light Co., 44 O. G. 110, C. D. 1888.

206. The purpose of section 4895 of the Revised Statutes is to permit a patent to issue to the person who has the record title to the invention, and is attained when the patent runs to the ultimate assignee, and therefore a patent may issue to the person who by the records of the office is assignee of the invention, although not technically the assignee of the inventor. (Selden v. Stockwell Gas Burner Co., 19 Blatch. 544; S. C., 9 Fed. Rep. 390.) *Consolidated Electric Light Co. v. McKeesport Light Co., 44 O. G. 110, C. D. 1888.

207. A patent is properly issued to any assignee whose assignment is duly recorded when it can be done without impairing the rights of any other person having a paramount title to the invention, and is therefore valid when issued to any such assignee of record. (Consolidated Electric Light Co. v. Edison Electric Light Co., 33 O. G. 1597.) *Id.

208. 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, 47 O. G. 528, C. D. 1889.

209. Gaylor v. Wilder, 10 How. 477, and Consolidated Electric Light Co. v. Edison Electric Light Co., 33 O. G. 1597, expressly hold that section 4895, Revised Statutes, does not make it obligatory upon the commissioner of patents to issue a patent to the assignee of an inventor, and the decisions and the rules of the patent office prescribe that patents can issue to the

assignee only where the invention is clearly and unmistakably identified. Ex parte Samuel J. Murray, 44 MS. D. (2 G. W. D.), Aug., 1890 (Fisher, Acting Com'r).

210. The mere fact that an assignment and application bear the same date and refer to the same general class of invention is not sufficient to make it imperative upon the office to issue the patent to the assignee named in the assignment. Ex parte Samuel J. Murray, 47 MS. D. (2 G. W. D.), May, 1891 (Mitchell, Com'r).

211. It is not obligatory upon the office to issue a patent to an assignee. The commissioner may issue the patent to the inventor and relegate the parties to the courts for the settlement of their rights. Ex parte Spielman, 49 MS. D. (3 G. W. D.), Dec., 1891 (Simonds, Com'r).

212. Although a transfer of the exclusive right to a patent within and throughout a specified part 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, yet section 4895 of the Revised Statutes, as interpreted by section 4916 thereof, and as always and consistently understood by the framers of the Rules of Practice, authorizes the commissioner to grant a patent only to assignees of the entire interest or undivided parts thereof. Ex parte Buchanan, 56 O. G. 140, C. D. 1891.

213. The statute 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. Ex parte Spielman, 58 O. G. 141, C. D. 1891.

214. It is the uniform practice of the office to issue a patent to an assignee upon a request contained in an assignment which is in proper form and was filed before the payment of the final fee. An assignment to a company alleged to have been defunct from the start will nevertheless be followed as to direction to issue the patent to such company as assignee. Ex parte Fowden, 53 MS. D., Nov., 1893 (Fisher, Ass't Com'r).

215. Where two joint inventors appoint an attorney to prosecute an application and receive the patent and one of the inventors assigns his entire interest to a third party and requests that the patent issue jointly to the other inventor and the assignee, and the said attorney does not indicate that there was any objection on the part of the other inventor to so granting the patent, *held*, that there was no mistake on the part of the office in granting the patent as requested. Ex parte Fowler and Hutton, 64 O. G. 1131, C. D. 1893.

216. Where there has been an assignment of an undivided interest in an invention, accompanied by a request that the patent issue jointly to the inventor and assignee, no legal objection seems to exist why the patent should not be so issued. Id.

217. Where the assignment is recorded in the patent office the day after the payment of the final fee, it is too late to have the patent issue to the assignee, although the assignment may contain a request that the patent should issue to the assignee. †Ex parte Coté Co., 65 O. G. 1915, C. D. 1893.

218. The duty of the commissioner of patents under the rule does not require the exercise of judgment or discretion, nor is it imposed by acts of congress; but it is a duty under the rules of office practice, approved by the secretary of the interior, and consequently is subject to the appellate jurisdiction of the secretary of the interior. (Houston v. Barker, v. Bannister, v. Eastman, C. D. 1888, 173, 44 O. G. 697.) †Id.

219. The provisions of the rule in this matter are never departed from except in cases where both the inventor and the assignee request that the patent shall issue to the assignee, the assignment being on record not later than the day of closing the weekly issue—namely, Thursday of every week. †Id.

220. Where an assignment from one of several joint inventors contains a request that the patent shall issue to his assignee, *held*, that the request will be observed and the patent be issued jointly to the remaining inventors and the assignee. Ex parte Fowler, 69 O. G. 1641, C. D. 1894.

221. An assignment of an unpatented invention which does not contain a request that the patent issue to the assignee does not convey a legal title to the patent when granted, but gives only an equitable interest. ‡Harrison v. Morton, 76 O. G. 1275, C. D. 1896.

222. It is not mandatory on the commissioner to issue a patent to the assignee of an inventor. (Ex parte Gallatin, C. D. 1892, 106, 59 O. G. 1104.) Ex parte McFarlane, 76 O. G. 1418, C. D. 1896.

223. The question that should govern the patent office in issuing patents is who on the record possesses the *legal* title to the invention, and the patent should issue accordingly, provided the requirements of the office in such

case have been complied with. Ex parte Nichols, 80 O. G. 1891, C. D. 1897.

224. A request that a power of attorney given by an alleged assignee be approved and that a patent issue to said assignee denied, as the assignment fails to fully identify the application and to specifically request the issue of the patent to the assignee. Ex parte Chillingsworth, 80 O. G. 1892, C. D. 1897.

(*Held*, that if an assignment be of record in the patent office before patent issued, conveying all rights, etc., it was sufficient to transfer the right to the assignee, although a patent was afterward issued to the assignor. Gaylor v. Wilder, 10 How. 477. See, also, United States Stamping Co. v. Jewett, 7 Fed. Rep. 809, for substantially same doctrine.

A transfer of the exclusive right to a patent within and throughout the United States is an assignment in the proper sense, yet under the statute it does not warrant issuing the patent to the assignee. For that purpose there must be a transfer of the whole or an undivided interest in the patent. Ex parte Buchanan, 56 O. G. 140, C. D. 1891.)

XIV. Deceased Inventors.

(See Attorneys.)

225. Section 4896, Revised Statutes, construed in connection with the right of the executor or administrator to prosecute the application of a deceased inventor or to file a new application for the invention of the decedent. Ex parte Smith, 43 O. G. 505, C. D. 1888.

226. A 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. *De La Vergne Refrigerating Machine Co. v. Featherstone, 58 O. G. 1842, C. D. 1892.

(Circuit court, Blodgett, J.)

227. The word "heirs" in a grant of a patent for an invention has the same significance as in a grant or deed of lands—it limits or defines the grantee's estate therein, and is not a word of purchase. *Id.

228. The statute having in clear terms provided what shall be done to preserve an inventor's right to a patent in the event of his death before the patent is granted, it is only by following this mode that a valid patent can be obtained in such a case. *Id.

229. A patent to a man dead at the time of the grant is not void for want of a grantee, since the phrase "his heirs or assigns" must be construed as creating a grant in the alternative, and the use of the word "heirs" in a patent grant raises no limitation in the sense of the strict common-law rule applied to realty. (Reversing De La Vergne Refg. Co. v. Featherstone, 58 O. G. 1842.) *De La Vergne Refrigerating Machine Co. v. Featherstone, 62 O. G. 741, C. D. 1893.

(United States supreme court.)

230. Where objection was made to the validity of a patent because of an amendment made by the attorneys after the applicant's death, no new power of attorney having been filed in the patent office, and no new administrator having intervened and filed a new oath, *held*, (1) the amendment was within the scope of the original specification and required no new oath; (2) it appearing that the attorneys had power in fact to act, and that their acts were subsequently ratified by both administratrix and assignee, the amendment did not invalidate the patent. (Distinguishing Eagleton Mfg. Co. v. West, C. D. 1884, 261, 27 O. G. 1237, 111 U. S. 490.) *Id.

PETITION IN APPLICATION.

1. A petition that fails to refer to or identify the specification is defective and must be amended to contain a reference to the specification for a full disclosure of the invention. Ex parte Mason, 43 O. G. 627, C. D. 1888.

2. The petition failed to refer to or identify the specification. *Held*, that the petition was defective and must be amended to contain a reference to the specification for a full disclosure of the alleged invention. Id.

PETITION TO COMMISSIONER.

(See Appeal.)

PLEADING.

(See Defenses; Equity; Practice in the Courts.)

I. In General.
II. Demurrer.
III. Multifariousness.

I. In General.

1. Where the answer sets up generally want of equity in the bill to defeat an injunction without alleging reasons why the injunction would be inequitable, the court will not consider such defense. *Puetz v. Bransford, 39 O. G. 1083, C. D. 1887.

2. If a defendant relies on the complainant being estopped from enforcing his rights against the defendant, such estoppel must be set up in the pleadings or the court will take no notice of it. *Puetz v. Brausford, 39 O. G. 1427, C. D. 1887.

3. The defense of no patentable invention can be made without setting it up in an answer. *Hendy v. The Golden State and Miners' Iron Works, 43 O. G. 1117, C. D. 1888.

4. Where notice is not given in the answer of a specified prior use of the invention described in the patent, it cannot be set up as an anticipation of such invention; but, as exhibiting the state of the art, the evidence is competent to aid the court in putting a proper construction on the patent. *Stevenson v. Magowan, 42 O. G. 1063, C. D. 1888.

5. The defendant pleaded that he should not be called upon to answer, because by reason of the expiration of a foreign patent for the same invention the patent in suit had expired, and the complainant had a plain, adequate and complete remedy at law, and the court should not take cognizance in equity of the suit. The complainant contended that such a defense could not be raised by plea, and if it could that the plea was insufficient both in matters of form and substance to present such a defense. *Edison Electric Light Co. v. United States Electric Lighting Co., 43 O. G. 1456, C. D. 1888.

6. Although under the acts of congress the power of the courts of the United States with respect to the amendment of equity pleadings is plenary, the allowance of such amendment is a question of judicial discretion depending largely on the special circumstances of the cases. *United States of America v. American Bell Telephone Co., 49 O. G. 284, C. D. 1889.

7. One of the defendants, C., filed a general answer to the bill and another defendant, B., filed a plea and answer in support thereof. Before any evidence had been taken in the cause the defendant C. asked leave to withdraw its answer and to file the same plea and answer in support thereof which had been filed by the defendant B. *Held*, that the motion was not open to the objection of introducing a new defense on a new state of facts, or of changing the substance of the case made by the bill, or of setting up a merely technical defense, and that, as the convenience of the case would be best promoted by having the issues proceed *pari passu* as to each defendant, the motion should be granted. *Id.

8. Where the bill alleged that a certain foreign patent, granted previous to and for the same invention as the patent sued on, had not expired; that it was granted for the term of fifteen years from its date, and was then in full force and effect, and the defendant pleaded, among other things, that said foreign patent had expired before the commencement of the suit, *held*, that the plea was insufficient, and ordered that it stand as an answer or part of an answer to the bill. *The Edison Electric Light Co. v. Westinghouse, Church, Kerr & Co., 50 O. G. 806, C. D. 1890.

9. Revised Statutes of United States, section 4919, provide that damages for infringement of a patent may be recovered by an action on the case. Section 4920 prescribes the nature of pleadings to be used in the action, and was passed in 1874. Section 914, which provides that the practice, pleadings, etc., in the federal courts shall conform as near as may be to those "in like causes" in the state courts of the state where such federal courts are held, was passed in 1872. *Held*, that, as actions for infringements of patents are within the exclusive jurisdiction of the federal courts, the pleadings therein are governed by section 4920, and a declaration in such an action, conforming to a common-law declaration in an action on the case, is sufficient, though a different form is prescribed by the statutes of the state where the court is held, and that the answer in such an action should comply with the common-law pleadings in actions on the case in form covering one or more of the defenses permitted in section 4920. *Myers v. Cunningham, 54 O. G. 1417, C. D. 1891.

10. Where there are joint defendants to a bill for infringement, it is sufficient if the bill contains a general allegation of infringement, and it need not in terms allege a joint infringement. *Indurated Fibre Industries Co. v. Grace, 60 O. G. 896, C. D. 1892.

11. Where there were several related suits and in one of them a patent was introduced in rebuttal, but not mentioned in pleadings of either party and no testimony taken respecting it, the pleadings require amendment in order that the patent may be set up in any other of the same suits. *Vermont Farm Machine Co. v. Gibson, 64 O. G. 300, C. D. 1893.

12. In an action at law for infringement of a patent, defendants, although they plead the general issue, may also maintain a special plea that the combination covered by the patent was not an invention, and also a further plea that the combination covered by the patent re-

quired for its production nothing but mechanical skill, in view of the prior state of the art. *Brickill v. City of Hartford, 65 O. G. 892, C. D. 1893.

13. In an action at law for infringement of a patent defenses which have been raised by demurrer to the complaint and overruled cannot be made part of the answer without leave of court. *Id.

14. But in Connecticut the court will allow such defenses to be set up by plea for the purpose of saving a right to review on writ of error to the circuit court of appeals, it being uncertain whether, under the code pleading, an assignment of error in the ruling on the demurrer is sufficient to secure such right when the demurrant does not allow final judgment to go against him upon it. *Id.

15. A plea alleging want of novelty because the alleged invention had been previously patented, on specified dates, to other parties is insufficient, for Revised Statutes, section 4920, require an allegation that the invention had been patented or described in some printed publication before the time of the supposed invention. *Id.

16. Where the answer alleged that the invention had been in two years' public use and on sale without stating that such two years' public use or sale occurred in this country, such allegation may not be technically accurate; but the point cannot be raised for the first time on appeal. *Smith & Davis Mfg. Co. v. Mellon, 66 O. G. 173, C. D. 1894.

17. The defense of prior use should be pleaded, or notice of when, where and by whom the prior use was made, be given before the trial. *Klein v. City of Seattle, 17 O. G. 131, C. D. 1895.

18. After alleging the invention and grant of the patent and the assignment the pleader averred that the defendants, knowing the premises, infringed. This is not an averment that they had notice or knew that their machines infringed. The allegation in regard to infringement was traversed, but nothing was said below upon the subject of notice. It is too late to raise for the first time in an appellate court technical questions of pleading or proof which are not jurisdictional in their character. *Tuttle, Trustee, etc. v. Claflin, 77 O. G. 973, C. D. 1896.

II. Demurrer.

19. Where a bill filed in 1886 stated that between the issue of the patent (in 1874) and the filing of the bill and at divers times and occasions the defendants had infringed the patent, *held*, that the bill did not show affirmatively that there had been a continuous use for such period, and a demurrer on the ground of laches was overruled. *Kaolatype Engraving Co. v. Hoke, 39 O. G. 589, C. D. 1887.

20. Where the bill of complaint made the usual averments as to invention, the procurement of letters patent, ownership of the same, and to an infringement, and the demurrer was general and set up no particular ground, the court below erred in sustaining demurrer and in dismissing the bill. *McCoy v. Nelson, 39 O. G. 831, C. D. 1887.

21. Under Revised Statutes of the United States, section 4919, providing that "damages for the infringement of any patent may be recovered by action on the case," it is sufficient that the plaintiff's pleading, in an action to recover such damages, contains all the allegations material to make an action on the case, and it will not be demurrable because called a "petition," the code term, instead of "declaration," the common-law term. *May v. Mercer County, 41 O. G. 815, C. D. 1887.

22. After complainants had made out a *prima facie* case, it is too late for defendants to withdraw answer and file a demurrer. *Huber v. N. C. Nelson Mfg. Co., 44 O. G. 284, C. D. 1888.

23. The facts showing want of jurisdiction appearing upon the face of the bill, and the defendant not appearing generally, but specially to demur, the demurrer must be sustained. *Halctead v. Manning, Bowman & Co., 44 O. G. 344, C. D. 1888.

24. A bill by vendee against vendor for specific performance, which does not show any title in defendant, is bad on demurrer. *Kennedy v. Hazelton, 46 O. G. 972, C. D. 1889.

25. A demurrer may not only attack a bill in its entirety, but there may be special grounds of demurrer which relate to each of several letters patent separately. *International Terra Cotta Lumber Co. v. Maurer, 44 Fed. Rep. 618 (1890).

26. Where a bill for injunction alleged that the patentee was the original, first and sole inventor of the patented improvement, which had not been patented to himself or to others with his knowledge or consent in any country, and had not, to his or the orator's knowledge, been in public use or on sale in the United States for more than two years before his application for patent, and had not ever been known or used or described in any printed publication in this

or any foreign country prior to his invention and discovery thereof and application for letters patent therefor, *held*, on a general demurrer, that said allegations were adequate, and stated facts which are prerequisites to a valid patent. *American Cable Ry. Co. v. Mayor, etc. of New York City, 52 O. G. 161, C. D. 1890.

27. The joining of the president of a corporation as co-defendant on a complaint alleging that the corporation and the president have infringed complainant's patent is no ground for demurrer. *Cleveland Forge and Bolt Co. v. United States Rolling Stock Co., 52 O. G. 1808, C. D. 1890.

28. Where in a suit for infringement it appeared that the patent in suit was not set out in the bill or attached thereto as an exhibit, and that the bill did not contain any substantial description of the complainants' invention, *held*, that a demurrer to the bill should be sustained. *Stirrat v. Excelsior Mfg. Co., 53 O. G. 1094, C. D. 1890.

29. For the purpose of determining what construction or breadth should be given to the claims of the patent in suit and the patent under which, as plaintiffs allege, the defendant pretends to be manufacturing the alleged infringing device, it may be proper, or even necessary, on final hearing to consider what took place in the patent office when the interference proceedings between the applications on which said patents issued were pending; but a clause in the bill containing a recital of such proceedings is mere surplusage. *Id.

30. The point attempted to be raised that such clause is mere surplusage cannot well be raised by demurrer, but only by way of exceptions to the bill. *Id.

31. Where the question of the validity of a patent is doubtful, a demurrer to a bill for its infringement will be overruled and the question reserved for further consideration on final hearing. *Standard Oil Co. v. Southern Pacific Co., 53 O. G. 1259, C. D. 1890.

32. A demurrer to a whole bill must be overruled if the bill taken altogether entitles complainant to some kind of relief. *Merriam v. Holloway Publishing Co., 53 O. G. 1409, C. D. 1890.

33. Where in a suit for infringement the bill alleged that the defendant had "since the date of" the patent in suit, "since September 2, 1879," infringed upon complainant's rights, it appearing elsewhere in the bill that the complainant had no rights under the patent until September, 1880, *held* upon demurrer that it could not be said that the complainant intended to aver that the defendant had infringed upon the complainant's rights continuously since September, 1879. *The Brush Electric Co. v. Ball Electric Light Co., 53 O. G. 1573, C. D. 1890.

34. With reference to claims 2 and 3, *held*, that as they might fairly be regarded as confining the patentee to the specific design shown and described in the patent, the demurrer to the bill should have been overruled. *The New York Belting and Packing Co. v. The New Jersey Car Spring and Rubber Co., 54 O. G. 135, C. D. 1891.

35. Objection to allegations as being not material and pertinent should be made by exception and not by demurrer. *Stonemetz Printers' Machinery Co. v. Brown Folding Machine Co., 56 O. G. 263, C. D. 1891.

36. Complaint did not aver defendants to be the owners of the alleged interfering patent. *Held* bad on special demurrer, because the only point in issue in a suit brought, as this is, under section 4918 of the Revised Statutes is the question of priority of invention between the owners of interfering patents. *Nathan Mfg. Co. v. Craig, 57 O. G. 1887, C. D. 1891.

37. In an action for infringement of letters patent a complaint which did not allege that the invention was not in public use or on sale for more than two years prior to the application for patent *held* bad on demurrer. *Id.

38. A bill which sets forth a patent for a "process" of making furniture-nails and then alleges that defendant, "in infringement of the aforesaid letters patent," did wrongfully "make, use, and vend to others to be used, furniture-nails embracing the improvement set forth and claimed" in said patent, *held* bad on demurrer as not alleging an infringement of the process. *American Solid Leather Button Co. v. Empire State Nail Co., 60 O. G. 1609, C. D. 1892.

39. Under Revised Statutes, section 4886, providing for the issuing of a patent where *inter alia* the invention has not been patented or described in any foreign country before the date of the invention, a bill for infringement of a patent is demurrable which does not allege such facts. *Overman Wheel Co. v. Elliott Hickory Cycle Co., 60 O. G. 1478, C. D. 1892.

40. Where in a joint complaint by two or more parties the facts stated do not show a joint cause of action in them, a demurrer on the ground that the complaint does not state

facts sufficient to constitute a cause of action must be sustained. *Blair v. Lippincott Glass Co., 61 O. G. 1792, C. D. 1892.

41. In a suit for infringement of a patent the bill may be met by a demurrer when it makes profert of the patent and the same appears on its face to be invalid for want of patentable invention. (Post v. Hardware Co., 35 O. G. 1226, 26 Fed. Rep. 618, followed.) *United States Credit System Co. v. American Credit Indemnity Co., 63 O. G. 318, C. D. 1893.

42. The mere fact that eight years elapse between the rendition of a judgment declaring a patent valid and the filing of a bill to restrain its infringement does not render the bill demurrable on the ground of laches. *Bragg Mfg. Co. v. City of Hartford, 64 O. G. 1537, C. D. 1893.

43. A bill for an injunction to restrain the infringement of a patent filed only four days before the term of the patent expires is demurrable where no preliminary injunction is asked, since it would be impossible to obtain a final decree before expiration of the patent. (American Cable Ry. Co. v. Chicago City Ry. Co., 52 O. G. 1666, 41 Fed. Rep. 522, followed.) *Bragg Mfg. Co. v. City of Hartford, 64 O. G. 1537, C. D. 1893.

44. The objection that public policy forbids the issuance of an injunction cannot be raised by demurrer to the bill, since that is a question addressed to the discretion of the court, especially where the bill alleges that complainant has reason to fear that defendant will continue his infringements. *Id.

45. On demurrer to a bill for infringement the patent will be declared invalid for want of novelty appearing on its face only where the case is free from doubt, and the court will only take judicial notice of matters within the field of common knowledge. *Hanlon v. Primrose, 65 O. G. 134, C. D. 1893.

46. In a bill for infringement the omission to aver that the invention had not been patented or described in any printed publication in this or any foreign country before the date of the invention is a defect of form which may be taken advantage of by special demurrer. *Id.

47. While ordinarily the determination of a demurrer setting up the identity of the patents to the same patentee in the bill of complaint would be left to final hearing, *held* that, as the question of identity is one of law, to be ascertained solely from the face of the patents, exception may well be made in favor of disposing of the demurrer without waiting for the final hearing. *Russell v. Kern, 69 O. G. 1208, C. D. 1894.

48. While patent cases are usually disposed of upon bill, answer and proof, there is no objection, if the patent be manifestly invalid upon its face, to the point being raised on demurrer and the case being determined upon the issue so formed. The supreme court has repeatedly held that a patent may be declared invalid for want of novelty, though no such defense be set up in the answer. (Dunbar v. Myers, 11 O. G. 35, 94 U. S. 187; Slawson v. Grand Street R. Co., 24 O. G. 99, 107 U. S. 649; Brown v. Piper, 10 O. G. 417, 91 U. S. 37.) *Richards v. Chase Elevator Co., 71 O. G. 1456, C. D. 1895.

49. When the patent sued on is void on its face, the right of the court to dispose of the case on demurrer is well settled; but the right should not be exercised unless the case is plain and the conduct of the parties warrants it. (West v. Rae, 33 Fed. Rep. 45; Studebaker Bros. Mfg. Co. v. Illinois Iron & Bolt Co., 42 Fed. Rep. 51.) *American Fibre Chamois Co. v. Williamson, Executor, 72 O. G. 143, C. D. 1895.

50. A patent manifestly invalid upon its face may be so declared on demurrer to the bill; but this power should be exercised with the utmost caution and only in the plainest cases. All doubts should be resolved in favor of the patent. (Button-Fastener Co. v. Schlochtmeyer, 69 Fed. Rep. 592, followed.) *Covert v. Travers Brothers Co., 75 O. G. 349, C. D. 1896.

51. Demurrer was sustained where it appears from an inspection of the patent in suit and by the exercise of common knowledge that the device patented is destitute of patentable novelty. *Chesterman v. Lindell Ry. Co., 76 O. G. 479, C. D. 1896.

52. Where a bill is demurred to on the ground that letters patent are void for want of patentable novelty, *held*, that while it is competent to raise the question of non-patentability by demurrer, yet a case should not be disposed of upon such a demurrer unless the invalidity of the patent be plain and the common knowledge relied upon to defeat it be of matters of which the court may properly take judicial notice. *Caldwell & Co. v. Powell, 75 O. G. 1206, C. D. 1896.

53. A design for a college badge, consisting of a pin having the shape of a guidon flag, upon which the letters "U. P." are placed, is not so absolutely void of invention upon its

face as to justify the court in sustaining a demurrer upon that ground. *Caldwell v. Powell, 77 O. G. 1272, C. D. 1896.

54. The effect of a demurrer is to admit the truth of the charge in the bill when the latter is well pleaded. *Id.

55. The fact that plaintiff and defendant are citizens of the same state will not sustain a demurrer to a bill brought under Revised Statutes, section 4915. *Bernardin v. Northall and Seymour, Com'rs of Patents, 78 O. G. 1740, C. D. 1897.

56. A demurrer brought against a bill for infringing a copyright of different portions of an index which, though a possible subject for a patent, is not a good subject for copyright, is well taken. *Amberg File & Index Co. v. Shea, Smith & Co., 79 O. G. 514, C. D. 1897.

57. The cause should be considered upon the merits on demurrer to the bill whenever it appears upon the face of the patent that it lacks invention. (Risdon Iron and Locomotive Works v. Medart, 71 O. G. 751, 15 Sup. Ct. 745, 158 U. S. 63, followed.) *Strom Mfg. Co. v. Weir Frog Co., 77 O. G. 1125, C. D. 1896.

58. In a bill of complaint it was alleged that the defendants have conspired to threaten, intimidate and prevent the customers of complainants from dealing with them by distributing false and threatening circulars, with intent to destroy complainant's business. A demurrer was overruled, but without prejudice and with leave to present the matter of the demurrer — namely, that the patent sued upon is invalid, or, if valid, is not infringed, and that the bill does not show title to the relief sought — by answer. *Lewin v. Welsbach Light Co., 79 O. G. 1867, C. D. 1897.

59. The only legitimate inquiry upon a demurrer alleging invalidity, non-infringement and no title in complainants is, are the acts and conduct of the defendant, alleged in the bill to be distributing false and threatening circulars with intent to injure complainant's business, such as a court of equity should restrain the owner of a presumptively valid patent from doing. *Id.

III. Multifariousness.

60. Five distinct causes of action united in one suit in equity without allegation in the bill that the inventions were capable of conjoint use, or that the defendants' structure combined all the patented features. Bill held multifarious. *Griffith v. Segar, 29 Fed. Rep. 707 (1887).

61. Where a suit is brought against A. B. and *C. D.*, doing business under the name of "A. B. Engraving Plate Co.," without stating whether the concern was a firm or corporation, *held*, that a conjoint use was shown, and a demurrer to the bill on the ground of multifariousness was not well taken. *Kaolatype Engraving Co. v. Hoke, 39 O. G. 589, C. D. 1887.

62. A bill in equity brought to repeal patents is not multifarious where the patents relate to the same invention, belong to the same parties and can be conveniently considered together, and the defendants have a common interest in sustaining the validity of both patents. *The United States v. The American Bell Telephone Co., 45 O. G. 1311, C. D. 1888.

63. There appears to be no objection to joining in the same bill a count for infringement and a count under section 4918, Revised Statutes of the United States. *American Roll Paper Co. v. Knopp, 54 O. G. 391, C. D. 1891.

64. A bill claiming relief for two causes — one, an interference between the patents of the plaintiff and defendant; the other, an alleged infringement by the defendant of plaintiff's patent — is not multifarious. *Stonemetz Printers' Machinery Co. v. Brown Folding Machine Co., 56 O. G. 263, C. D. 1891.

65. Where a complainant's bill asks for the specific performance of a contract set out, and also contains expressions looking to relief, as on a bill for infringement, *held* impossible to sustain the bill as one for a double aspect, because in a bill for infringement the determination who are necessary parties must be made from a standpoint different from that in a bill for specific performance, and the title to relief is not the same in each event. The bill must be treated as multifarious. *American Box Machine Co. v. Crosman, 60 O. G. 1750, C. D. 1892.

66. It has been repeatedly decided that a bill which omits to allege joint use of several inventions covered by several patents is demurrable for multifariousness. (Cases cited.) *Union Switch & Signal Co. v. Philadelphia and R. R. Co., 69 Fed. Rep. 833 (1895).

67. Where devices covered by several patents are capable of embodiment and conjoint use in a single machine, a bill which seeks to recover in a single suit for the infringement of all the patents is not multifarious. *Kansas City Hay-Press Co. v. Devol, 81 O. G. 1277, C. D. 1897.

POWER OF ATTORNEY.

(See ATTORNEYS AND POWERS.)

PRACTICE.

I. IN PATENT OFFICE.
II. IN UNITED STATES COURTS.
III. IN BRITISH COURTS.

I. IN PATENT OFFICE.

(See AMENDMENT OF APPLICATION; APPEAL; APPLICATION FOR PATENT; ATTORNEYS; CLAIMS; DISCLAIMER; DESIGNS; DIVISION OF APPLICATION; DIVISIONAL APPLICATION; EXAMINATION OF APPLICATION; FEES; INTERFERENCE; JURISDICTION; PATENTS; PATENTABILITY; WITHHOLDING FROM ISSUE; WITHDRAWAL FROM ISSUE.)

1. Whatever may be the opinion or views entertained by an inferior tribunal of the action or rulings of the superior tribunal, it is manifestly improper to express them in their recorded decisions. Such practice tends seriously to impair the discipline and harmony of the office and destroys confidence in its rulings. Ex parte Finch, 40 O. G. 1027, C. D. 1887.

2. A disrespectful official letter from an examiner to an applicant ordered stricken from the files and another respectful one substituted. Ex parte Sturtevant & Davis, 33 MS. D., Feb., 1887 (Montgomery, Com'r).

3. The orders and practice of courts of equity govern in the patent office as far as practicable, but cases may arise in which they should not be rigidly enforced. Osgood v. Badger, v. Bennett, 44 O. G. 1065, C. D. 1888.

4. Since the commissioner of patents exercises the function of a court, reasonable rules and regulations, based upon analogies derived from the procedure in courts of law, are valid rules and regulations when prescribed by the competent authority. *Daniels v. Morgan, 47 O. G. 811, C. D. 1889.

5. The commissioner refused to pass upon the patentability of a claim when the question had been decided by the examiner. Walker v. Diescher and McGill, 56 O. G. 927, C. D. 1891.

6. Whatever doubts may exist with reference to an act prescribing duties for the patent office, it remains for the office to treat it as a valid part of the law until the supreme court declares it unconstitutional. Ex parte Palmer, 58 O. G. 383, C. D. 1892.

7. Irrelevant personal reflections on an attorney struck out of the office letter, and the reply of the attorney thereto returned under rule 22. Ex parte Oliver, 76 O. G. 961, C. D. 1896.

8. The proceedings of the patent office are not controlled by the ordinary rules of practice that obtain in the courts of the country, but are controlled by statutory provisions and a code of rules made in pursuance of statutory provisions wholly unlike the rules of practice enforced in the courts. *Ross v. Loewer, 77 O. G. 2141, C. D. 1896.

(The practice of the patent office is not a matter for regulation by the court of appeals of the District of Columbia, and irregularities therein, even if patent on the record, would only be considered by this court when some substantial right of a party has been denied and the point saved for presentation on appeal. *Neill v. Commissioner of Patents, 82 O. G. 749.)

II. PRACTICE IN UNITED STATES COURTS.

9. Where a bill was filed for infringement of two patents, and upon the final hearing the following questions were presented: first, whether the plaintiff S. or the defendant H. was the first inventor of the device claimed in one of the patents, and second, had the invention been in public use more than two years before application for said patent?—*held*, that the first question presented a simple issue of fact, proper for the determination of a jury, and that the second question, which depended upon conflicting testimony, could be more satisfactorily determined by hearing of the witnesses in person. *Gray v. Halkyard, 38 O. G. 784, C. D. 1887.

10. Where, in the trial before a jury of a suit at law for the infringement of a patent, the plaintiff introduces evidence to show infringement, and closes that branch of his case, and the defendant demurs to the evidence, it is the province of the judge to decide whether or not the plaintiff has made out a *prima facie* case of infringement, and if of the opinion that he has not, he should charge the jury to find for the defendant. †Royer v. Schultz Belting Co., 38 O. G. 898, C. D. 1887.

11. After the validity of a patent has been established in a suit it may always be shown in another suit on the patent against another defendant, and even in answer to an application for a preliminary injunction, that the right claimed by the plaintiff in the new suit was not fairly in controversy in the former suit. *National Hat Pouncing Machine Co. v. Hedden, 38 O. G. 1129, C. D. 1887.

12. Prior patents not set up in the answer may be introduced in evidence to show the state of the art and to aid in the construction of the plaintiff's claim, though not to invalidate that claim on the ground of want of novelty when properly construed. Doctrine in Vance v. Campbell (1 Black, 427, 430) and similar cases affirmed. *Grier v. Wilt, 38 O. G. 1365, C. D. 1887.

13. Where an assignment is made to a defendant conveying to him an interest in an invention described in a certain application for patent, a broad claim of which was canceled after objection by the commissioner to allowing the claim, and the defendant did not attempt to show that he could have convinced the commissioner that he should allow the claim if he had been aware of its rejection, *held*, that the court will not assume that the defendant could have overcome the objection to allowing the claim. *Puetz v. Bransford, 39 O. G. 1427, C. D. 1887.

14. Where a bill has been filed, pleadings perfected, proofs taken, and an application made at the hearing to dismiss the bill without prejudice as to one of the defendants, *held*, that the application should be denied. *Archer v. Arnd, 40 O. G. 1032, C. D. 1887.

15. The practice adopted by an executive department of the government does not apply to the validity of patents by reason of pre-existing acts or omissions of the inventor of the character involved in this suit, but is properly a judicial question. *Andrews v. Hovey, 42 O. G. 1285, C. D. 1888.

16. The determination of questions like those involved here by the commissioner of patents in the grant of a patent is not conclusive upon the courts as to the questions respecting the validity of such patents, and much less so as regards other patents. *Id.

17. A stipulation in the suit included the evidence taken in another suit, and a certified copy of Fisher's original patent appearing in the record under the certificate of the clerk of the circuit court that it was a part of the record and of the proceedings in the cause, although there was no separate memorandum in the record of introduction of the original patent in evidence, this court assumes the same to be properly in the case. *Hoskin v. Fisher, 43 O. G. 509, C. D. 1888.

18. The re-issue in suit being a second re-issue, and the first re-issue not being found in the record, no presumption of law arises that the first and the second re-issues were for the same invention with similar second and third claims. To have the advantage of the first re-issue it should have been put in evidence. *Id.

19. The original patent and the second re-issue being properly before the court, a comparison of the two may be made to determine the validity of the second re-issue. *Id.

20. In a suit to restrain the infringement of a patent complainant was defeated because he sued on one only of two patents relating to the same invention. (48 O. G. 116.) The evidence introduced would be necessary under a bill based on the omitted patent. *Held*, that he should be permitted to amend by bringing in the other patent and alleging its infringement, and that the case should be opened for taking additional testimony, but that relief should be granted only on condition that complainant give an undertaking to pay the expense of such additional testimony, including witness fees, mileage, master's or examiner's fees and printing. *Underwood v. Gerber, 48 O. G. 675, C. D. 1889.

21. Upon a motion for an attachment against the defendants for contempt in violating an injunction granted at final hearing, *held*, that as the present alleged infringing device differs from that adjudged to be an infringement, and also from the patented device, the question presented ought not to be determined upon such a motion as this, but only by an original suit. *The Pennsylvania Diamond Drill Co. v. Simpson, 48 O. G. 676, C. D. 1889.

22. In an action at law for damages for the infringement of claims a motion was made at the close of the testimony in the court below for a verdict in favor of the defendant on certain grounds, which motion was sustained, and the jury was directed to return a verdict for the defendant, which was done. To this ruling the plaintiff excepted. *Held*, that the motion to direct a verdict for the defendant was broad enough to cover the question of the invalidity of the patent—a defense set up in the answer—although that ground was not then distinctly urged, and that the judgment of the circuit court should be affirmed. *May v. County of Juneau, 50 O. G. 1888, C. D. 1890.

23. In a suit for infringement of a patent for an improvement in chutes for delivering timber, it is not error for the court to remark to the jury that counsel upon both sides had used the terms "flume" and "chute" synonymously, that the words of the patent were "an improved chute," but that in discussing it the terms had been used as of the same significa-

tion, where it appeared that plaintiff contended that his invention was a combination of a "flume" and a "chute" and the distinction contended for as existing between them was insisted on in that connection and made entirely clear throughout the case. *Haines v. McLaughlin, 51 O. G. 1465, C. D. 1890.

24. It is not error to refuse to instruct as to an abstract question, and instructions should never be given upon hypothetical statements of fact of which there is no evidence. *Id.

25. In a case of infringement it is for the jury to determine whether the invention is of a primary character, and whether plaintiff's is a pioneer patent, and also whether defendant's machine infringes its claims. *Royer v. Schultz Belting Co., 52 O. G. 157, C. D. 1890.

26. Where in a suit for infringement it appeared that the defendants held and were operating under a patent granted before plaintiff's patent was granted, *held*, that it was incumbent on the plaintiff to proceed in the first instance under section 4918, Revised Statutes of the United States, to have the invalidity of the defendants' patent, in whole or in part, judicially ascertained and declared, although the application upon which plaintiff's patent was granted was filed before that on which the defendants' patent issued. *American Paper Roll Co. v. Knapp, 54 O. G. 391, C. D. 1891.

27. Where a suit has been pending several years and defendant has sought affirmative relief in his answer, even if he has not filed a cross-bill, a motion to dismiss the case before hearing will be denied, and it is immaterial that plaintiff has sold his patent. *Electrical Accumulator Co. v. Brush Electric Co., 55 O. G. 573, C. D. 1891.

28. In an action at law for royalty the finding of the circuit court, upon the evidence offered by both parties as to the novelty of the invention covered by the patent, is a conclusion of fact and will not be reviewed by a higher tribunal. *St. Paul Plow Works v. Starling, 55 O. G. 1821, C. D. 1891.

29. After the introduction of evidence as to the question of novelty by the grantee and rebutting evidence on the same point by the grantor, it is within the discretion of the court to refuse to consider further evidence on the same point, which evidence might have been offered in the first instance. *Id.

30. After the grantee has introdued in evidence certain earlier patents, it is proper for the grantor or patentee to show that prior to the date of any of them he had reduced the invention to practice in a working form. Proof of the date of the grantor's invention is strictly a matter of rebuttal after the grantee has put in the patents which were prior in date to the grantor's patent. *Id.

31. When the complainants themselves raise the question of priority of a foreign patent over the patent upon which suit was brought and this issue is accepted by the defendants in their answer, *held*, that there is no doubt as to the relevancy of that question in disposing of the case on its merits. *Clark Thread Co. v. Willimantic Linen Co., 56 O. G. 895, C. D. 1891.

32. In an action for the infringement of a patented improvement of a former patent owned by the same party but not included in the suit, the court will assume, for the purposes of the particular case under discussion, that defendant was entitled to the use of the former patent. *McCreary v. Pennsylvania Canal Co., 57 O. G. 1131, C. D. 1891.

33. To hold otherwise is to assume plaintiff's ownership of the earlier patent, its validity and its infringement by the defendant — questions not properly before the court in a collateral proceeding. For the purposes of this suit the master was bound to assume that the former patent was open to the defendant; otherwise he might be led into inquiries entirely foreign to the subject of his investigation. *Id.

34. *Quære:* Whether, if there had been an earlier patent for the same device outstanding at the date of the infringement and owned by a third person, defendant could claim that the device described in such patent was open to it. In such case it might perhaps be held that plaintiff was entitled to stand upon the *prima facie* validity of the earlier patent. *Id.

35. A bill may be dismissed by the court on its own motion where the proper allegations as to citizenship of the parties are not contained in the introductory part and are not pointed out by counsel elsewhere in the bill or where the prayer for subpœna does not contain the names of the defendants, as required by the rules. *City of Carlsbad v. Tibbetts, 61 O. G. 1166, C. D. 1892.

36. Whether there was invention in the patent, whether plaintiff was the first inventor, and whether the use of gravity-catches as mechanical equivalents of spring-catches was known at the time of plaintiff's application were questions of fact for the jury. *Hunt Brothers Fruit Packing Co. v. Cassidy, 62 O. G. 1965, C. D. 1893.

37. An exception to the court's refusal to di-

rect a verdict for defendant at the close of plaintiff's evidence is waived by proceeding in the cause and introducing evidence for the defense. (Railway Co. v. Cummings, 1 Sup. Ct. Rep. 493, 106 U. S. 700, and Insurance Co. v. Crandal, 7 Sup. Ct. Rep. 685, 120 U. S. 527, followed.) *Id.

38. The circuit court of appeals for one circuit having on a matter before it on appeal reached a conclusion opposite to that reached by the circuit court of appeals in another circuit under similar circumstances certified the case to the supreme court solely for this reason; *held*, that the certificate was essentially defective in that it did not specifically set forth the question to be determined aud did not state that instruction was desired for the proper decision of such question. *Columbus Watch Co. v. Robbins, 63 O. G. 154, C. D. 1893.

39. In a suit for the infringement of letters patent defendants introduced in evidence a pamphlet of about twenty-five pages, published two years after the patents were issued, entitled "An Exposé of the Assumptions and Business Methods of a Dealer and Reputed Inventor," which was prepared and published by a rival manufacturer apparently for the purpose of discrediting the inventions of the complainant and his personal character and business methods. The greater part of the pamphlet was scandalous matter irrelevant to the issues. The author testified that, so far as it referred to the patents he had studied, the pamphlet correctly expressed his views respecting the same. *Held*, that the contents of the pamphlet could not be considered competent evidence upon the issue of novelty and that complainant's counsel was justified in refusing to cross-examine the author. *Waterman v. Shipman, 64 O. G. 713, C. D. 1893.

40. If defendants in a suit for infringing letters patent plead want of novelty and set up in their answer and offer in evidence a large number of patents prior in date to those of the complainant, the court will not examine these patents, in the absence of expert testimony to explain them or to indicate what they contain, to negative the novelty of the complainant's patents, unless the character of the invention has so little complexity that expert testimony is not required for that purpose. *Id.

41. In a suit to restrain alleged infringement of patents for rasps and files and the process of and machinery for making the same, plaintiffs failed for more than six months after the answer was filed to take any evidence, and then applied for an order that they be allowed to inspect fully defendants' factory. Defendants denied infringement, and alleged that for years before the patents were granted they made files under a secret process, not patented, which they still use. They also produced files made by such process before the date of the patent, which were apparently the same as plaintiffs' files. *Held*, that the order for the examination would not be granted. *Stokes Brothers Mfg. Co. v. Heller, 64 O. G. 1654, C. D. 1893.

42. Where a corporation charged with infringing a patent was found with a small capital in order to avoid liability for such infringement, it is proper, as a condition of refusing a preliminary injunction against such corporation, to require it to give security for observing the decree in case it should be defeated in the suit. *Edison Electric Light Co. v. Columbia Incandescent Lamp Co., 65 O. G. 133, C. D. 1893.

43. In a suit for the infringement of a patent, when the defense is that complainant had parted with all his interest therein by assignment before filing his bill, and a copy of the record of such assignment in the patent office is introduced in support thereof, while, perhaps, such copy, if standing alone and seasonably and properly objected to, would be inadmissible, yet the objection that no foundation was laid for the introduction of secondary evidence will not be considered on appeal when it was not raised below. *Paine v. Trask, 65 O. G. 298, C. D. 1893.

44. Where the decision of the patent office was that there had been no such delay in the prosecution of the claim as to work an abandonment of the application, the court, even if it had the power, is not required to review the decision when the answer alleges abandonment of the invention and not of the application. *Western Electric Co. v. Sperry Electric Co., 65 O. G. 507, C. D. 1893.

45. The facts touching the prosecution of the application being matters of record in the patent office, easily accessible, the respondents must, if they propose to tender an issue of abandonment of the application, do so by averments to that effect, specific and clear enough to be understood. *Id.

46. Where an interlocutory decree in the first suit was alleged in the second bill, a final decree in the first suit, rendered pending the second suit, may be shown in evidence therein without supplemental pleading, where defendant took no exceptions to the bill, consented to

the introduction of the final decree in evidence so far as the same was material, and only objected thereto on the ground that in rendering such decree the court erred through failure to understand the operation of an alleged anticipatory invention. *David Bradley Mfg. Co. v. Eagle Mfg. Co., 66 O. G. 315, C. D. 1894.

47. Taking testimony in the second suit as to the validity of the patent is not a waiver of the bar of the final decree in the former suit where such testimony was taken before said final decree was rendered, since until rendition of the final decree the proceedings in the first suit were no bar. *Id.

48. The plaintiffs having failed to stand upon an exception and having accepted the ruling of the lower court in the conduct of the trial, *held*, a waiver of error assigned. *Campbell v. City of Haverhill, 70 O. G. 385, C. D. 1895.

49. Where defendant put in evidence a number of patents prior in date to the plaintiff's and asked the court to compare the inventions and devices therein described with those claimed by the plaintiff and no extrinsic evidence was given or needed to explain terms of art or to apply the descriptions to the subject-matter, so that the court was able, from mere comparison, to say what was the invention described in each and to affirm from such comparison whether the inventions were or were not the same, the question was one of pure construction and not of evidence, and consequently was a matter of law for the court, without any auxiliary fact to be passed upon by the jury. *Market-Street Cable Ry. Co. v. Rowley, 70 O. G. 632, C. D. 1895.

50. *Held*, that whether the thing defined by the claims of the patent in suit is infringed by that used by the defendant is a question of fact to be determined by the jury under instructions by the court as to the scope of the patent and the character of the defendant's device. *Coupe v. Royer, 70 O. G. 779, C. D. 1895.

51. Where there was evidence in the form of interviews between plaintiff and defendant, from which the plaintiff sought to infer the fact of actual notice of infringement, and the defendant offered evidence to show that he had never received any notice, actual or constructive, of the patent or any infringement of it, *semble*, that the question of notice ought to be submitted to the jury for their decision. *Id.

52. Whether Berliner's later patent is void on the ground that the earlier patent "was granted upon the same application, to the same applicant, and for the same invention," will not be determined by the court in a suit by the United States to cancel the later patent, it appearing that the officials of the patent office had before them all the facts bearing on this subject which the court had and understood the law, so that the patent was issued under no mistake of either law or fact. *American Bell Telephone Co. v. United States of America, 71 O. G. 1903, C. D. 1895.

53. Where the defendant had obtained extension of time to plead, answer, demur or take such other action as it may be advised, *held*, this is equivalent to a general appearance. *Hupfeld v. Automaton Piano Co., 72 O. G. 287, C. D. 1895.

54. In a suit for infringement of a patent, defendant while testifying volunteered the statement that after the action was commenced he had offered $250 in settlement and that plaintiffs demanded $350 and required that defendant should agree to pay a royalty and to sell no carts below a certain price. *Held*, that the court properly refused defendants' request to charge that this offer of compromise should not be construed as an admission of any right in plaintiffs, for, while correct as a proposition of law, it was misleading, because it ignored the evidence relating to plaintiffs' proposition in response to that of defendants. *Holmes v. Truman, 73 O. G. 448, C. D. 1895.

55. Where counsel for an appellant or a plaintiff in error files a brief and makes an oral argument and does not allude in either to one or more of his assignments of error, he must be taken to have waived them. The court cannot be expected to examine the assignment of error and find the reason for reversal itself. *American Fibre Chamois Co. v. Buckskin Fibre Co., 75 O. G. 833, C. D. 1896.

56. An objection that complainant has failed to prove title might be fatal if made when the certified copies from the patent office were offered, but comes too late when offered at the final hearing. *A. B. Dick Co. v. Henry, 75 O. G. 1204, C. D. 1896.

57. When after arduous litigation the equities and presumptions are all with the complainant, if either party should suffer during final decree it should be the defendant. New York Filter Mfg. Co. v. Niagara Falls Waterworks Co., 77 O. G. 1255, C. D. 1897.

III. In British Courts.

58. In England the repeal of a patent for an invention might be by a bill in chancery, or by

scire facias in a court of chancery or in any proper court. *The United States v. The American Bell Telephone Co., 45 O. G. 1311, C. D. 1888.

59. The English practice grows out of royal prerogative, of which there is nothing corresponding in this country, and all patents issue under the authority of the United States. *Id.

PRINTED PUBLICATIONS.

(See ANTICIPATION.)

PRINTING TESTIMONY.

(See TESTIMONY.)

PRESUMPTION OF VALIDITY.

(See PATENTS.)

PRINTS.

(See LABELS; TRADE-MARKS.)

1. Under section 3 of the act of June 18, 1874, relating to patents, trade-marks and copyrights, "prints" as well as "labels" are entitled to registration. Ex parte H. J. Heinz Co., 63 O. G. 1064, C. D. 1893.

2. The device sought to be registered as a print *held* to have sufficiency of novelty and intellectual creation to merit it. Id.

3. A print, to be used for foods, including canned goods, and consisting of a pictorial representation of a disorderly school, *held* registrable, although showing arbitrary and fanciful matter, in view of Ex parte Heinz Co., 62 O. G. 1064; Palmer, 58 O. G. 383; Eldridge & Co., 55 O. G. 1278, and Higgins v. Keuffel, 55 O. G. 1139; Ex parte Bovril (Limited), 53 MS. D., July, 1893 (Fisher, Acting Com'r).

4. Registration of a print exhibiting a number of designs on a sheet of paper refused because not for a copyrightable subject (in view of Higgins v. Keuffel, 55 O. G. 1139). Ex parte Schlegel, 53 MS. D., Aug., 1893 (Fisher, Ass't Com'r).

5. The word "prints" as used in the statute authorizing the registration of prints in the patent office means a picture similar in kind to an engraving, cut or photograph. *Held*, therefore, that a sheet of paper with several multicolored designs on both sides, with no attempt to produce such unitary effect as is produced by a single cut or engraving, was not such a print as could be registered. Ex parte Schlegel, 64 O. G. 1132, C. D. 1893.

6. To be registrable a print must have by itself some value as a composition, at least to the extent of serving some purpose other than as a mere advertisement. Id.

(Up to 1893 it was the practice of the patent office to construe as synonymous the words "prints" and "labels" in section 3 of the act approved June 18, 1874.)

PRIOR ADJUDICATION.

(See COMITY; INJUNCTION; PRIOR JUDGMENT.)

1. The question of priority of invention as between rival inventors having been once thoroughly tried and decided, and the defeated party's assignee having in consequence disclaimed the invention as the condition of obtaining a decree on a narrower and different invention, a renewal of a discussion of the question of priority by that assignee in a suit against it for infringement of the rival inventor's patent is useless. *Electrical Accumulator Co. v. Brush Electric Co., 61 O. G. 886, C. D. 1892.

2. Where the question upon the merits was determined in a former suit between the parties, though the judgment by reason of the small amount in dispute was not reviewable by a court of appellate jurisdiction, *held*, that the court below did not err in holding that the judgment in the former suit concluded the question between the parties, regardless of the fact that the judgment in the first suit was not subject to review by an appellate court. *Johnson Street Steel Rail Co. v. William Wharton, Jr., & Co., Limited, 67 O. G. 274, C. D. 1894.

3. The conclusion of the commissioner of patents that the addition to the original claim of a feature shown and described in the original patent does not confer patentability on the re-issue claim was right, since the whole combination was substantially passed upon by the circuit court of appeals. *Briggs v. Seymour, Com'r of Patents, 78 O. G. 169, C. D. 1897.

PROCESS.

(See PATENTABILITY.)

PRODUCT OF NATURE.

(See PATENTABILITY.)

PROTEST AGAINST ISSUANCE OF PATENT.

1. A protest against the issuance of a patent to an applicant is fatally defective unless it embodies something equivalent to a distinct denial of the applicant's sworn statement of invention. Riley v. Barnard, 59 O. G. 1021, C. D. 1892.

2. Where a protestant only filed an affidavit without model or drawing of the alleged anticipating device, *held* insufficient. Fay v. Conradson, 65 O. G. 751, C. D. 1893.

PUBLIC FAVOR.

(See PATENTABILITY, EVIDENCE OF EXTENSIVE USE.)

PUBLIC USE OR SALE.

I. IN GENERAL.
II. KNOWLEDGE AND CONSENT OF INVENTOR.
III. IN FOREIGN COUNTRIES.

I. IN GENERAL.

1. Where an invention had been publicly known and practiced more than two years before the date of filing the application, adding to such application new features which did not require invention does not avoid the bar of the previous public knowledge and use. *International Tooth-Crown Co. v. Richmond, 39 O. G. 1550, C. D. 1887.

2. Where the defense to a suit for the infringement of a patent process is that machines embodying the process claimed were sold and in public use more than two years before the date of the application for the process patent, such defense is not sustained by proof that the use made of the machine before that date was experimental only and not capable of working the process. There is no real invention of a process until a machine is constructed to work the process. *Eastern Paper Bag Co. v. Standard Paper Bag Co., 41 O. G. 231, C. D. 1887.

3. When a machine was used by a manufacturer in the regular conduct of his business by his own workmen, and in the view of such part of the public as resorted to his establishment for the purpose of buying or selling, such use was a public use. *Smith & Griggs Mfg. Co. v. Sprague, 41 O. G. 1037, C. D. 1887.

4. Where the machine in question consisted in the new combinations of old elements, each of which constituted a new invention, and the machine was practically useful, and its product was used commercially and profitably in the ordinary course of business, such use was not experimental, although the inventor was engaged in the improvements by which it was hoped and expected that the machine would be made more valuable and useful. *Id.

5. Use by the inventor of a machine in order to devise by experiment improvements upon the same to perfect it is permissible even where, as an incident, the product of the machine is sold; but where the use is mainly for trade and profit and the experiments for improvement are incidental, then the principal and not the incident gives character to the use, and the latter is a public use under the statute and comes within its prohibition if it takes place more than two years before the application for the patent. *Id.

6. When the purchase or construction of the patented machine or article took place at a time more than two years prior to the application, whether with or without the knowledge, consent or allowance of the patentee, the patent is invalid, and that is the effect of section 24 of the act of 1870 and of section 4886 of the Revised Statutes. *Andrews v. Hovey, 41 O. G. 1162, C. D. 1887.

7. If the invention is in public use or on sale at a date more than two years before the application for a patent upon it, it will be conclusive evidence of abandonment and the patent will be void. *Id.

8. The period of two years' public use or sale is to be reckoned from the date when the application is filed in the patent office, and not from the date of its execution. *Campbell v. Mayor, etc. of New York, 44 O. G. 1185, C. D. 1888.

9. A "sale" to invalidate a patent must have been completely effected more than two years before the application for the patent. *Campbell v. Mayor, etc. of New York, 45 O. G. 345, C. D. 1888.

10. The putting of a patent on sale by assigning it more than two years prior to the application for it is not a sale of the invention in the sense of section 4886 of the Revised Statutes.

*United States Electric Lighting Co. v. Consolidated Electric Light Co., 33 Fed. Rep. 869 (1888).

11. Use of an invention for business purposes or profit and in which the test of its success and value was only incidental will defeat a patent if it occurred more than two years before application. *Root v. Third Avenue R. Co., 46 O. G. 1393, C. D. 1889.

12. Where a patent had been issued to joint inventors and more than two years of public use had occurred before the filing of a separate application by one of the joint inventors, and the applicant in the separate application claimed to be the sole inventor of the device claimed in the joint patent, *held*, that said public use was a bar to his obtaining a patent on his sole application. Ex parte MacLay, 49 O. G. 1043, C. D. 1889.

13. Where the mechanism of the anticipating device was such as to be necessarily concealed from view during its legitimate use and would not operate as perfectly as that of the patented invention, *held* not to be sufficient objections to overcome the defense of anticipation. *Brush v. Condit, 49 O. G. 1211, C. D. 1889.

14. 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 the invention was then taken from the lamp and was not afterward used with carbon pencils, it was an anticipation of the patented device under the established rules upon the subject. *Id.

15. The statutory bar of public use is not avoided by a caveat. In other words, applicant cannot take any benefit, as against the allegation of prior public use as a bar or defense, from any act which falls short of such an application as the statutes authorize and make provision for. Ex parte Meucci, 51 O. G. 299, C. D. 1891.

16. In determining whether A. should receive a patent the record should be carefully examined by the primary examiner with reference to the question whether more than two years of public use preceded his application, and in view of certain prior printed publications the examiner should inquire whether the claims of A. are anticipated. Stanley v. Slattery, 54 O. G. 1709, C. D. 1891.

17. Where an inventor disclosed his invention to a company which adopted it and put it into complete and practical operation in and for the ordinary purposes of trade and commerce, and where it appears that the inventor regarded his invention as complete at the time of its adoption by such company, such use for more than two years before application for patent is a public use within section 4886, Revised Statutes, and not one of experiment. *Root v. Third Avenue Ry. Co., 61 O. G. 1947, C. D. 1892.

18. Elizabeth v. Pavement Co. (97 U. S. 126), distinguished, and Smith & Griggs Mfg. Co. v. Sprague (41 O. G. 1037, 123 U. S. 249), and Hall v. Macneale (23 O. G. 937, 107 U. S. 90), cited and commented on. *Id.

19. The experimental use of an invention by the inventor or by persons under his direction, if made in good faith, solely in order to test its qualities, has never been regarded public use. (Cases cited.) *Harmon v. Struthers, 57 Fed. Rep. 637 (1893).

20. The inventor's device was applied to an engine that went out from the shop of his employers and was sold and delivered more than two years before the application for a patent. *Held*, that the sale was for the purpose of a test or for experimental use, and did not involve public use or sale constituting a statutory bar. *Id.

21. Where a manufacturer places an article upon the market, in the usual and accustomed line of business, more than two years before applying for a patent, to see what his customers think of it, it cannot be said that it was an experiment within the meaning of the statute. "It is a trader's and not an inventor's experiment." *Smith & Davis Mfg. Co. v. Mellon, 66 O. G. 173, C. D. 1894.

22. Where more than two years' public use are proved, the evidence that a change was made in the invention within the two years prior to the application for the patent, but which change is described only as a preferable form, will not save the patent. *Id.

23. Where the device set up establishing prior public use did not contain one of the features of the patented device, and which feature was useful and novel, *held*, that the public use was not established. *Costa v. Drobaz, 69 O. G. 374, C. D. 1894.

24. The evidence of use by one Heller, in 1877–78, of an extension butt-adjuster connected with an Appleby machine is not sufficient to create the bar of public use. *Deering v. Winona Harvester Works, 69 O. G. 1641, C. D. 1894.

25. Where it appears that a fire-alarm box was offered for sale in no other manner than as a part of a fire-alarm system to be installed by the seller and nothing was done evincing an intention on his part to transfer to the buyer a fire-alarm box except upon an executory contract containing conditions and requiring of the buyer much to be done precedent to the transfer of title, *held*, that the fire-alarm box was not on sale within the meaning of section 4886, Revised Statutes, although the box was completed, tested and ready for immediate use at the date of the contract. (Burton v. The Town of Greenville, 18 O. G. 411, 3 Fed. Rep. 642, and other cases referred to.) Ruddick v. Milliken, 72 O. G. 1651, C. D. 1895.

26. Importation of goods by a firm shown to have been accustomed to exhibit goods of that character promptly, though admissible as evidence, is insufficient to establish public use or sale within the United States. *Hanifen v. E. H. Godshalk Co., 79 O. G. 510, C. D. 1897.

27. A defense of two years' public use must relate back to the first or original application and not to the second application filed as a devision thereof. *Stirling Co. v. St. Louis Brewing Ass'n, 79 Fed. Rep. 80 (1897).

(Experimental use distinguished in Elizabeth v. Pavement Co., 97 U. S. 126; also secret use in Egbert v. Lippman, 21 O. G. 75, C. D. 1882. Article may be made more than two years before application for patent. Sandusky Seat Co. v. Comstock, 13 Brodix, 222. Secret use distinguished from proper concealed use. Brush v. Condit, 49 O. G. 1211, C. D. 1889. Public and private use distinguished. Manning v. Cape Ann Co., Ising Glass & Glue Co., 23 O. G. 2413, C. D. 1883.)

II. Knowledge and Consent of Inventor.

28. The inventor's consent to or allowance of the public use or sale of his invention is not requisite to invalidate a patent. (Andrews v. Hovey, 42 O. G. 1285.) *Campbell v. Mayor, etc. of New York, 44 O. G. 1185, C. D. 1888.

29. The circuit courts having in several instances held that under the section in question a patent was not invalid by a public use and sale without the consent or allowance of the inventor, these decisions are not controlling in the supreme court of the United States where no direct adjudication has been made by that court upon the particular point. *Andrews v. Hovey, 42 O. G. 1285, C. D. 1888.

30. The fact that in an interference in the patent office, where the question has been distinctly raised, a patent was issued to Green with the knowledge on the part of the patent office that there had been a public use of the invention more than two years before his application, is not controlling upon this court. *Id.

31. The promulgation and enforcement of a rule of the patent office, that a patent would not be granted if the invention had been in public use or on sale, with the consent or allowance of the inventor, for more than two years before his application, cannot be regarded as having the effect of a judicial or authoritative adjudication of the question. *Id.

32. Under sections 6, 7 and 15 of the act of 1836, in connection with section 7 of the act of 1839, purchase, sale or use of the invention more than two years before the application, without regard to the consent or allowance of the inventor, renders the patent invalid. *Id.

33. The invalidating two years' public use of the statute does not require the knowledge, allowance or consent of the inventor. Ex parte Drawbaugh, 57 O. G. 693, C. D. 1891.

34. An inventor using due diligence by experiments toward perfecting his invention, and making application for a patent within two years after its completion, will not be deprived of his right to a patent for it because of the construction and sale of a form of it by another, without his knowledge, during the time of experiments and before its completion, although more than two years before his application. *Campbell v. Mayor, etc. of New York, 57 O. G. 1427, C. D. 1891.

35. The plain import of the words "not in public use or on sale for more than two years prior to his application" is the creation of a limitation of two years within which a patent for an invention must be applied for after it has gone into public use, either with or without the knowledge, consent or allowance of the applicant for the patent. *In re Drawbaugh, 67 O. G. 929, C. D. 1894.

III. In Foreign Countries

36. Sections 4886 and 4887 of the Revised Statutes must be construed together, and when this is done the two years' prior public use or sale, which under section 4886 operates as a

bar to the grant of a patent, is such a use or sale within the United States and has no reference to foreign countries. *Gandy v. Main Belting Co., 59 O. G. 1106, C. D. 1892.

37. There is no inconsistency between the law providing that a foreign public use shall not in itself invalidate a patent and the law of evidence under which it is competent to prove such foreign use and sale in order to fix the date of an invention. *Hanifen v. E. H. Godshalk Co., 79 O. G. 510, C. D. 1897.

PUBLIC-USE PROCEEDINGS.

(Public-use proceedings date from the decision of Commissioner Marble in In re Von Hefner-Alteneck, 23 O. G. 2233, C. D. 1883.)

1. The commissioner has authority to refer a case to the examiner of interferences for investigation of the question of public use or sale. Such examiner may, according to the nature of the order of reference to him, report the facts with his conclusions to the commissioner, or he may decide the questions investigated by him. The commissioner may remand the case to the primary examiner with such instructions as he may see proper. The primary examiner only has authority to *reject* the application on the findings in the first instance. From such rejection an appeal lies, upon payment of fees, to the examiners-in-chief, as in any other *ex parte* case. Ex parte Finch, 40 O. G. 1027, C. D. 1887.

2. The examiners-in-chief acted without authority in entertaining jurisdiction of the appeal taken in the present case from the decision of the examiner of interferences. Id.

3. When an allegation of public use comes up for consideration in connection with an application which is being considered *ex parte* after the termination of interference proceedings, the proper practice is for the examiner to pass upon the question whether or not a *prima facie* case of public use has been established, rejecting the claims in the case if he decides the question in the affirmative. Ex parte Beatty, 56 O. G. 1563, C. D. 1891.

4. Unsworn statements not identifying with certainty the thing alleged to have been in public use do not constitute a *prima facie* case. Id.

5. When public use is alleged it should be set forth in the affidavits by specific acts. Ex parte Shettler, 60 O. G. 158, C. D. 1892.

6. With the small sum appropriated by congress for conducting public-use proceedings the patent office is not justified in instituting such proceedings unless a strong *prima facie* case is presented. Fay v. Conradson, 65 O. G. 751, C. D. 1893.

7. Where a protestant against the issue of a patent only filed an affidavit describing a device which he alleged had been in public use more than two years before the applicant had filed his application and failed to file an exhibit model or drawing clearly showing the nature of the device so alleged to have been in public use, *held*, that such affidavit was insufficient to warrant public-use proceedings. Id.

REHEARING IN PATENT OFFICE.

(See AMENDMENT AFTER FINAL REJECTION; RE-OPENING; WITHDRAWAL FROM ISSUE; JURISDICTION OF COMMISSIONER OF PATENTS; NEW TRIAL.)

I. EX PARTE.
II. INTERFERENCE.

I. EX PARTE.

1. Petition that a rehearing be granted in case of an appeal decided by the assistant commissioner, the sole reason for such petition being that a decision 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 such duties are directly prescribed by statute. Ex parte Hughes, 56 O. G. 1448. C. D. 1891.

2. A motion for rehearing ought to be governed, as far as practicable, by rules which in courts govern new trials. Ex parte Spielman, 56 O. G. 1707, C. D. 1891.

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

4. A finding of fact by a former commissioner should not be reconsidered, unless no evidence was presented at the hearing on which such a finding might be based, or unless the finding was clearly against the weight of evidence. Id.

5. Where a party who, with full knowledge at the outset of the other party's ground of contention, has underestimated the importance of it and set up his defense on a different line, a

motion for rehearing simply to make a different defense will not be considered. Ex parte Spielman, 58 O. G. 141, C. D. 1892.

6. A motion for a rehearing will not be entertained by the commissioner for the purpose of enabling an applicant to make a fuller presentation of his case when there is no satisfactory showing that he might not have done so in the first instance. Ex parte Utley, 58 O. G. 1091, C. D. 1892.

7. Motion for rehearing in matter of protests of Riley v. Barnard denied in view of certain evidence herein quoted. Ex parte Riley, 62 O. G. 1515, C. D. 1893.

8. Rehearings are not favored in any case, and only upon special circumstances. Motion for rehearing will not be entertained where there has been long delay in bringing it. Rehearings must be applied for within the limit of appeal. Ex parte Messinger, 78 O. G. 1903, C. D. 1897.

II. Interference.

9. Rule 144, based upon the procedure in courts of law, does in terms confer, and was intended to confer, upon the commissioner jurisdiction to rehear the decisions of his predecessor when grounds other than those based on fraud, error in computation, or newly-discovered evidence are alleged and set forth in motions filed for the rehearing of such decisions. *Daniels v. Morgan, 47 O. G. 811, C. D. 1889.

10. It certainly would be a hardship if in an interference proceeding, when the commissioner who rendered the decision would on sufficient showing have been swift to afford a rehearing, the defeated applicant should be without remedy because of the succession to office of a new commissioner, and a rule adapted to prevent such a result certainly commends itself as a part of a system of procedure designed to do justice between parties who are asking the patent office to determine which of them is the prior inventor of an invention which can be patented to but one of them. *Id.

11. The practice of splitting up cases and allowing separate parties to file separate motions and present them at different times condemned. In interference proceedings motions for rehearings presented by the parties thereto ought to be heard at the same time, in order that the entire case may be disposed of at once. Green v. Hall, v. Siemens, v. Field, 47 O. G. 813, C. D. 1889.

12. Green's motion for rehearing overruled because (*first*) it involves a question of merits which is *res adjudicata* by reason of the previous decision of the commissioner and also that of his predecessor, and (*second*) because it shows no error in the former decision which Green seeks to have set aside. Id.

13. Manifest error in law, being ground for new trial, is also ground for a rehearing under the patent office rule relating to such matters. Green v. Hall. v. Siemens, v. Field, 47 O. G. 1631, C. D. 1889.

14. Where the junior party to an interference proved that before any date of invention which could be given to the senior party he had in his possession and sent to his son in this country a full description of the invention in controversy, and his *prima facie* standing as an original inventor was not challenged by any testimony to the contrary, and a judgment of priority was rendered upon final hearing in favor of said junior party, *held*, upon a motion for rehearing upon the ground that there was error in not requiring further proof of the *fact* of his invention, that the supposed error was no error. Gessner v. Miller, 50 O. G. 433, C. D. 1890.

15. *Held* further, that it was not necessary to consider that part of rule 110 which provides that when the invention was made abroad the preliminary statement must set forth that the applicant made the invention, it appearing that there was no such provision in the rule when the testimony was taken. Id.

16. Where in a motion for a rehearing the claim that the evidence had been newly discovered simply amounted to an assertion that a party litigant erred in judgment, and that in consequence of such error he failed to introduce testimony of the existence of which he had knowledge before the submission of the case for hearing and which subsequently to the decision thereof he came to regard as material and important, *held* not to bring the case within the general rule relating to rehearings. Evidence does not become newly discovered when errors in judgment as to its legal effect are rectified. Lorraine v. Thurmond, 52 O. G. 1949, C. D. 1890.

17. *Held* further, that a rehearing should be denied because the exhibits referred to in the affidavits upon which the motion for rehearing was based do not show the invention embodied in the issue, so that if in the case as originally heard they would not have altered the result. Id.

18. Except under extraordinary circumstances the commissioner will consider only alleged errors of law upon a motion for re-

hearing. Clark v. Broad, 57 O. G. 1426, C. D. 1891.

19. On a motion for rehearing of a case originally heard and determined by the acting commissioner, upon the ground of decision contrary to evidence, the commissioner will not disturb the prior decision upon a showing that the testimony was closely balanced and admitted the possibility of a contrary conclusion; but it must appear that the decision was clearly against the weight of testimony. Webb v. Blickensderfer, 62 O. G. 159, C. D. 1893.

20. Where on a motion for rehearing no suggestion is made that anything would be brought to the attention of the commissioner beyond a representation of the same arguments and the same facts, and there is no pretense that evidence has been omitted or overlooked, or that the case could be strengthened in any way, and where every point alluded to in the motion was carefully considered before a conclusion was reached, *held*, that the motion should be denied. Scott v. Brooks, 71 O. G. 1314, C. D. 1895.

21. Where it was urged that the commissioner has discretion to grant rehearings even after a decision upon the question of priority by the court of appeals, *held*, that cases are conceivable in which, to prevent failure of justice, this may be so; but the discretion is governed and determiued by well-established principles. (Giant Powder Co. v. California Co., 5 Fed. Rep. 197.) Id.

22. Where it appeared that S. attempted to take an appeal to the court of appeals of the District of Columbia, but failed without any fault of his own, and on that account was not heard upon the merits before the appellate court, and the case having been dismissed and a motion to reinstate was made to that court and denied, *held*, that these facts do not appear to enlarge the discretion of the commissioner in rehearing cases, but would seem to indicate that what was denied by the appellate court, for reasons satisfactory to it, should not be presented here, except upon special circumstances clearly shown and calling for such an extraordinary course. Id.

23. Following the settled practice in the courts, when rehearings are sought upon alleged errors of law, that application must be made for the rehearings before the time for appeal has gone by, *held*, that whenever the time for appeal from the patent office to the court of appeals has gone by the time for a rehearing has elapsed with it. Id.

24. An applicant's contention upon a rehearing that he was "surprised" by the interpretation put upon his application in the former hearing is without foundation, since the application itself was his evidence, and was examined like other evidence. Dewey v. Colby, 75 O. G. 1360, C. D. 1896.

REHEARING IN THE COURTS.

(See NEW TRIAL.)

RE-ISSUE.

(See CORRECTION OF PATENTS.)

I. IN GENERAL.
II. DELAY IN APPLYING FOR.
III. IDENTITY.
IV. ENLARGEMENT VALID.
V. ENLARGEMENT INVALID.
VI. NEW MATTER.
VII. INADVERTENCE OR MISTAKE.
VIII. TO CORRECT ERROR OF PATENT OFFICE.

I. IN GENERAL.

1. An applicant for re-issue who has assigned his entire interest in the invention is not merely a "perfunctory affiant" in making oath to inadvertence, accident or mistake, because he is the only person who is supposed to be possessed of the requisite knowledge upon which to make and base such affidavit. Ex parte Mahnken, 41 O. G. 1269, C. D. 1887.

2. The right of the assignee under the statute comes from the inventor, and he can secure no broader patent than the inventor can apply for. If an applicant purposely or intentionally limits the scope or extent of the claims, his assignee cannot obtain a re-issue for an invention broader or greater than that claimed by the inventor. Id.

3. The rule in Parker & Whipple Co. v. Yale Lock Co. (123 U. S. 87, 25 O. G. 290) affirmed that the patent office model alone is not to be considered the basis for a re-issue in which a change of the invention of the original patent is sought. *Flower v. City of Detroit, 43 O. G. 1348, C. D. 1888.

4. The specifications and claims of the original patent and re-issue being substantially the same in scope, and the re-issue having been applied for within a few months, it was held valid, although no reason for the re-issue was shown. *Maltby v. Graham, 37 Fed. Rep. 689 (1889).

5. When the office has given a wrong title in a patent, the latter should be canceled and a new one issued. (Railway Register Mfg. Co. v. North Hudson C. R. Co., C. D. 1885.) Ex parte McManus and Hoch, 53 MS. D., Sept., 1893 (Fisher, Acting Com'r).

6. *Held*, that patentees should not be allowed to experiment and take chances in attempts to secure re-issues, to extend, enlarge or broaden their inventions, without taking the risk and subjecting themselves to the same rules and principles which apply and govern in original applications. *McCormick Harvesting Machine Co. v. C. Aultman and Co., 63 O. G. 1791, C. D. 1893.

7. *Held* that, if the claims survived the revisory action and rejection thereof by the patent office on the original application, still the unsuccessful attempt made in the re-issue proceeding to broaden or expand them must, upon well-settled principles, be held to so limit and restrict their construction as to exclude what was thus rejected and to confine them to the specific devices and combinations therein described. *Id.

8. Since patents are now re-issued strictly for the same invention covered by the original patent, the re-issue application ought to have the same standing as the original patent as to burden of proof. Huson v. Crowell, v. Yates, 64 O. G. 1006, C. D. 1893.

9. Where the office holds an applicant to be entitled to a re-issue for broader claims, it in effect holds that it was by reason of inadvertence, accident or mistake that applicant did not make the broad claims in the patent; that he has been reasonably diligent in applying for such re-issue, and therefore that there has been no such dedication to the public of the inventions covered by the broad claims as should prevent the office from considering the re-issue application a continuation of the original application. Id.

10. *Quære:* If a patentee applies for a re-issue of his patent, and includes among the claims under the new application the same claims as those which were included in the old patent, and the examiner of the patent office rejects some of such claims and allows others, both old and new, does the patentee by abandoning his application for a re-issue and by procuring a return of his original patent hold his patent invalidated as to those claims which the examiner rejected? (The above question is certified by the circuit court of appeals to the supreme court for decision.) *McCormick Harvesting Machine Co. v. C. Aultman & Co., 73 O. G. 1999, C. D. 1895.

11. Where a re-issue application is filed without fee for the purpose of correcting a mistake made by the office, *held*, that not only the mistake may be corrected, but that, if the office chooses, a full re-examination of the case may be made, as it would be improper for the office to re-issue a patent when it is known that a statutory bar exists. Ex parte Weaver, 76 O. G. 1715, C. D. 1896.

12. When an application for a re-issue of a patent is made, the original patent continues to be a valid patent until it is re-issued, when it becomes inoperative; if a re-issue be refused, the surrender never takes effect, and the patent stands as if no application had ever been made for a re-issue. *Allen v. Culp, 79 O. G. 1523, C. D. 1897.

13. While it is true that in making his surrender the patentee declares that his patent is inoperative and invalid, yet this is not necessarily so for all purposes, but for the purpose for which he desires to have it re-issued. Such a patent might be inoperative and invalid as against certain persons who had pirated the underlying principle of the patent and avoided infringing the exact language of the claims and yet be perfectly valid as against others who were making machines clearly covered by their language. *Id.

14. If the application for a re-issue be rejected, the original patent stands precisely as though a re-issue had never been applied for, unless at least the re-issue be refused upon some ground equally affecting the original patent. *Id.

(The settled law in respect to re-issues is declared by the supreme court in Topliff v. Topliff, 145 U. S. 56, 12 Sup. Ct. 825. See, also, Gaskill v. Myers, 81 Fed. Rep. 854, 1897.)

II. Delay in Applying for.

15. A delay of nearly three years after the date of the original patent before applying for its re-issue with broader claims is not excused by the mistake of the solicitor who applied for and procured the original patent with claims more narrow than those which he was instructed by the inventor to make. *Ives v. Sargent, 38 O. G. 781, C. D. 1887.

16. The right to a re-issue with a broadened claim is lost by a delay of four years in making application therefor. *Curran v. St. Louis Refrigerator and Wooden Gutter Co., 39 O. G. 590, C. D. 1887.

17. The delay in filing the application for the re-issue in suit not accounted for nor shown to be reasonable renders such re-issue invalid. *Hoskin v. Fisher, 43 O. G. 509, C. D. 188.

18. If it be conceded that the inventions claimed in the re-issue were described in the original, then, such claims being expansions and more than three years having elapsed after the original was granted before the re-issue was applied for, the doctrine of laches applies and the delay must be held unreasonable in the absence of explanatory averments in the bill. *Philadelphia Novelty Co. v. Rouss, 48 O. G. 1664, C. D. 1889.

19. 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. *Electric Gas Lighting Co. v. Boston Electric Co., 55 O. G. 429, C. D. 1891.

20. The presumption is in favor of the validity of a re-issue applied for and obtained in less than two years after issue of the original patent. *Alaska Refrigerator Co. v. Wisconsin Refrigerator Co., 57 O. G. 125, C. D. 1891.

21. 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, 59 O. G. 1257, C. D. 1892.

22. Where there was a period of eight years between the date of the original patent and the application for the re-issue, *held*, that the delay was unreasonable and cannot be excused on the ground that the patentee would have seasonably applied for the re-issue but for the advice of his solicitor to wait. (Dobson v. Lees, 53 O. G. 1740, 137 U. S. 258). *Wollensak v. Sargent & Co., 66 O. G. 1007, C. D. 1894.

23. Where, after the issue of an original patent and before an application for the re-issue of the same, it was shown that other parties were using the subject-matter not claimed, *held*, that the patentee has abandoned his right to a re-issue to claim such matter by his laches in not applying for the re-issue before the rights of other parties accrued. Loewer v. Ross, 76 O. G. 1711, C. D. 1896.

(The rule as to laches is more rigid in cases where applicant seeks to broaden claims. *Held*, six months was not (in the particular case) unreasonable delay. Ex parte Matthews & Race, 26 O. G. 823, C. D. 1884, Butterworth, Com'r.)

III. Identity.

(See Enlargement; New Matter.)

24. Under the statute the commissioner of patents has no jurisdiction to grant a re-issued patent for an invention substantially different from that embodied in the original patent, and it does not follow that what was indicated in the original specifications, drawing or model is to be considered as a part of the invention, unless the court can see from a comparison of the two patents that the original patent embodied as the invention intended to be secured by it what the claims of the re-issue are intended to cover. *Parker & Whipple Co. v. Yale Clock Co., 41 O. G. 811, C. D. 1887.

25. It is well settled that a re-issue can only be granted for the same invention intended to be embraced by the original patent, and the specification cannot be substantially changed, either by the addition of new matter or the omission of important particulars, so as to enlarge the invention as intended to be originally claimed. *Pattee Plow Co. v. Kingman & Co., 46 O. G. 1107, C. D. 1889.

25a. Re-issued letters patent, granted May 2, 1871, to John J. Schillinger, for concrete pavement, as it stood after the filing of the disclaimer, held to include no new matter. *Hurlbut v. Schillinger, 47 O. G. 1067, C. D. 1889.

26. Letters patent issued for the following claim: "The rod with its knob E and the oscillating lever C, for the purpose of releasing a suspended weight by the direct action of a gong-hammer, substantially as and for the purpose herein described." The re-issued patent contained these claims: "The trip-rod D, arranged as described, and the oscillating lever C, for the purpose of releasing a suspended weight by the movement of a gong-hammer, substantially as and for the purpose described," and "the trip-rod D, oscillating lever C, and suspended weight B, in combination with the hammer of a gong, for the purpose of operating mechanism distant from the gong, substantially as above described." *Held*, that the claims of the re-issue were fairly embraced in the claim of the original. *Walker v. City of Terre Haute, 54 O. G. 507, C. D. 1891.

27. It has been repeatedly declared by the supreme court that a re-issue can be permitted only to secure the invention which was described in the original patent, and which it was the intention of the patentee, manifest upon the face of the patent itself, to secure thereby.

*Featherstone v. George R. Bidwell Cycle Co., 57 Fed. Rep. 631 (1893).

28. It is settled by the authorities that to warrant new or broader claims in a re-issue such claims must not only be indicated in the original application, but it must further appear (1) that they constituted a part of the original invention and (2) were sought and intended to be covered or secured by the original patent. (Bantz v. Frantz, 21 O. G. 2037, 105 U. S. 160; Heald v. Rice. 21 O. G. 1443, 104 U. S. 737; Miller v. Brass Co., 21 O. G. 201, 104 U. S. 350; James v. Campbell, 21 O. G. 337, 104 U. S. 356; Topliff v. Topliff, 59 O. G. 1257, 145 U. S. 156.) *Corbin Cabinet Lock Co. v. Eagle Lock Co., 65 O. G. 1066, C. D. 1893.

IV. Enlargement Valid.

(See Identity; New Matter.)

29. A re-issue is not rendered void by a new description or statement in the specification of the difficulties and defects of prior inventions in the same line. The specification may also state how the patentee has avoided such difficulties and defects. *Kearney v. Lehigh Valley R. Co., 32 Fed. Rep. 320 (1887).

30. The new and broader claims of the re-issue are not for a different invention from that describing the original patent. A subcombination may be claimed in a re-issue if it was shown in the original as performing the same functions, even though it was claimed only as a part of a larger combination. (Walker on Patents, sec. 245, and cases there cited.) *Jenkins v. Stetson, 32 Fed. Rep. 398 (1887).

31. Under recent decisions of supreme court a patentee is not precluded from obtaining a re-issue with broader claims than those of the original patent, provided he is not guilty of laches and the re-issue is for the same invention as the original. In re-issues made for the purpose of enlarging the scope of the patent, the rule of laches should be strictly applied. (Citing Miller v. Brass Co., 104 U. S. 350.) *Id.

32. Certain matters found only in the re-issued patent; *held*, that all these additional features were matters of reasonable inference from the language of the original specification, as explained by testimony or by common knowledge. *Eames v. Andrews, 39 O. G. 1319, C. D. 1887.

33. Where matters found only in the re-issue, or matters where a change has been made from that described in the original patent, occur, if the additions and changes do not in fact amount to a different invention, the case is simply one of a defective specification and a proper subject of amendment. *Id.

34. If the amended specification does not enlarge the scope of the patent by extending the claim so as to cover more than was embraced in the original, and thus cause the patent to include an invention not within the original, the rights of the public are not thereby narrowed, and the case is within the remedy intended by statute. *Id.

Original.	*Re-issue.*
35. The herein-described process of sinking wells where no rock is to be penetrated, viz.: by driving or forcing a rod to and into the water under ground and withdrawing it and inserting a tube in its place to draw the water through, substantially as herein described.	The process of constructing wells by driving or forcing an instrument into the ground until it is projected into the water without removing the earth upward, as it is in boring, substantially as herein described.

Held, that each of these claims is for the same invention. *Id.

36. The patent office held that a compound disk constituted but a single adjustable device or single disk, and rejected the third claim, to which rejection the owners of the patent assented. *Held*, that they did not thereby abandon the right to claim in a subsequent re-issue a double or compound disk and obtain a valid patent therefor. *Yale Lock Mfg. Co. v. New Haven Savings Bank, 43 O. G. 115, C. D. 1888.

37. While a comparison of the two patents evinces that the specification of the re-issue is amplified, yet this amplification is in matters of an explauatory nature and embraces nothing of any importance which is not plainly disclosed in the original specification and accompanying drawings. *Putnam v. The Keystone Bottle Stopper Co., 48 O. G. 113, C. D. 1889.

38. A re-issue cannot be held invalid because of enlargement of claims when the original patent is not in the case and no evidence is offered to show expansion in the re-issue beyond what is justified by the original specification and drawings. *Alaska Refrigerator Co. v. Wisconsin Refrigerator Co., 57 O. G. 125, C. D. 1891.

39. 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 pro-

vided the error arose by inadvertence, accident or mistake, and without any fraudulent or deceptive intention. Ex parte Pepper, 46 MS. D. (3 G. W. D.), May, 1891 (Mitchell, Com'r).

40. All the authorities are to the effect that where, under such circumstances, the application for a re-issue merely seeks to make the claim broader and more comprehensive, it may be granted, in order to secure to the patentee his actual invention, provided he has not been guilty of any inexcusable laches, and no adverse rights have accrued. (Cases cited.) *Featherstone v. George R. Bidwell Cycle Co., 53 Fed. Rep. 113 (1892).

41. Where the amendment of the application as first filed is within the scope of the original invention, no charge of undue expansion can be sustained and no new oath is necessary because the amendment introduces no new invention. *Beach v. American Box Machine Co., Inman et al., 69 O. G. 1067, C. D. 1894.

42. A re-issue held allowable where it appeared it was the intention of the patentee to make a broader claim than was allowed, and no intervening rights have accrued, and when the patentee inadvertently omitted to mention all the points involved to his attorney, and the associate attorneys limited the claim in ignorance of the operation of the device. Ex parte Mock, 62 MS. D., July, 1897 (Butterworth, Com'r).

43. The claims of a re-issued patent were held valid which omitted all reference to certain parts or elements embraced in the original claims, which parts really constituted no part of the invention. *Gaskill v. Myers, 81 Fed. Rep. 854 (1897).

44. Re-issue Letters Patent No. 11,383 *held* to be valid, although the claims of the original patent had been broadened by the omission of certain unpatentable elements. *Gaskill v. Myers, 81 O. G. 1111, C. D. 1897.

45. A claim which made what was no part of the invention one of the elements, was defective, and the defect was properly cured by omitting the improper element from the re-issue. *Id.

V. Enlargement, Invalid.

(See Identity; New Matter.)

46. A re-issue whose claims have been expanded to twelve from a single original claim, and in which material changes and additions have been made in the specification, is invalid. *Columbia Rubber Co. v. Klous, 33 Fed. Rep. 275 (1887).

47. A claim allowed in a re-issued patent, which was stricken out by the solicitor in the original application, held invalid. The patentee is bound by the acts of his counsel. *Dobson v. Lees. 30 Fed. Rep. 625 (1887).

48. Where the specification of the original patent is so changed in the re-issue as to admit of a claim which could not have been made in the original specification, there has been a substantial alteration and the claim based thereon is void. *Hartshorn v. Saginaw Barrel Co., 88 O. G. 540, C. D. 1887.

49. Where the original patent described and claimed a lever applied to a whip-socket, and the re-issue described and claimed a lever applied to a part of a whip-socket, the re-issue was unduly enlarged, and is invalid. *Worden v. Searls, 39 O. G. 359, C. D. 1887.

50. Where the claim in the re-issue omitted certain words in the corresponding original claim, if the same effected an enlargement of the invention, the re-issue is invalid. *Matthews v. Iron Clad Mfg. Co., 42 O. G. 827, C. D. 1888.

51. The original patent and the first re-issue having been distinctly limited to a bushing having a notch, the second re-issue, obtained nearly seven years afterward, for a bushing without any such notch, is an unwarrantable enlargement. *Cornell v. Weidner, 43 O. G. 985, C. D. 1888.

52. Where it does not appear that any attempt has been made to secure by the original patent the inventions covered by the new claims in the re-issue, those inventions must be regarded as having been waived or abandoned so far as the re-issue is concerned. *Hoskin v. Fisher, 43 O. G. 509, C. D. 1888.

53. A re-issue for an invention not disclosed nor suggested in the original, and there being no defective nor insufficient specification, and no inadvertence nor mistake in the wording of the claim of the original, held void. *Brewster v. Shuler, 37 Fed. Rep. 785 (1889).

54. A claim in a re-issue for an article or product, which claim was rejected by the patent office in the original application and deliberately struck out, held invalid, because there was no mistake inadvertently committed, and the re-issue was for the mere purpose of enlarging the monopoly of the patent. Under the circumstances it is quite immaterial that the application for re-issue was made within two years from the date of the original patent.

(Cases cited.) *Union Paper Bag Machine Co. v. Waterbury, 39 Fed. Rep. 389 (1889).

55. A re-issue patent which contains claims that had previously been abandoned by the patentee in order to obtain his original letters patent must be held to be invalid as to such claims. *Yale Lock Mfg. Co. v. The Berkshire National Bank, 51 O. G. 1291, C. D. 1890.

56. Where Sargent made such a claim as claim 3 of the re-issue in his application of May, 1874, and abandoned it and filed a new application in March, 1875, on which his original patent issued, *held*, that said claim 3 of the re-issue was invalid. *Id.

57. A re-issue is invalid, first, if its claim is broadened after inexcusable delay by the patentee; and second, if the claim covers a different invention from the one actually described and shown in the original. The statute (sec. 4916) provides for "a new patent for the same invention" as such invention appears from the specification and claims of the original (many authorities cited). *Carpenter Straw-Sewing Machine Co. v. Searle, 52 Fed. Rep. 809 (1892).

58. Where a broad invalid claim has been permitted to remain unchanged for a long period of years, until adverse equities have arisen, and a re-issue is granted with a new claim which, though for a larger combination, seeks to hold, as infringements, machines which have been lawfully made for years, the re-issue is broadened, and is therefore invalid. (Hubel v. Dick, 28 Fed. Rep. 132.) *Id.

59. A re-issue cannot be permitted to enlarge the claims of the original patent by including matter once intentionally omitted. Acquiescence in the rejection of a claim; its withdrawal by amendment, either to save the application or to escape an interference; the acceptance of a patent containing limitations imposed by the patent office, which narrow the scope of the invention as at first described and claimed,—are instances of such omission. *Dobson v. Lees, 53 O. G. 1740, C. D. 1890.

60. 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 therein were not for the same invention set forth in the claims of the original patent. *Electric Gas-Lighting Co. v. Boston Electric Co., 55 O. G. 429, C. D. 1891.

61. The claim of an original patent was for an inelastic bridge or check piece arranged across the crotch of pantaloons, whereby the strain is received by this bridge or check piece, instead of at the angle of the crotch itself. The re-issue contained two claims, and in an action brought for its infringement it was successfully contended by the defendant in the lower court that the re-issue was broader than the original patent. *Patent Clothing Co., Limited, v. Glover, 57 O. G. 1281, C. D. 1891.

62. Where the sole claim of the original patent covered a process of lining barrels, casks, etc., with glue, and the re-issue included not only the claim of the original patent, but also a claim for a barrel, cask, etc., coated or sized with glue by the process described, *held*, that this was in effect an expansion of the claims in order to embrace an invention not specified in the original patent, and that the second claim of the re-issue was therefore invalid. *Leggett v. Standard Oil Co., 63 O. G. 1201, C. D. 1893.

63. Where the claim sought to be re-issued is similar to one that was presented in the original application and rejected by the office and canceled by the applicant in order to obtain his patent, *held*, that under such circumstances the applicant is estopped from setting up such claim in an application for a re-issue. Ex parte Bowman, 66 O. G. 1360, C. D. 1894.

64. Where the original patent made no reference to an alternative construction of the device wherein one of the elements might be omitted, while the re-issue merely retains the said element, "preferably," as another form of the device, *held*, that the effect of the insertion of the word "preferably" was to render this element non-essential, and unduly to expand the original. *Olin v. Timken, 69 O. G. 1361, C. D. 1894.

65. It is now settled that when a re-issue is sought for the purpose of enlarging or broadening claims the application must be made within a reasonable time. (Miller v. Brass, 104 U. S. 350, and other cases cited.) It must also be shown that there was a mistake, inadvertently committed. (Cases cited.) Re-issue in this case held invalid, because it broadens the original patent and was not applied for till nearly three years after the issuance of the latter. *Mast, Foos & Co. v. Iowa Windmill & Pump Co., 68 Fed. Rep. 213 (1895).

66. Where a re-issue was obtained for the

purpose of broadening the claims of the original patent to cover that which is presumed to have been once abandoned to the public, *held*, that the re-issue is void. (White v. Dunbar, 37 O. G. 1002, 119 U. S. 47; Ives v. Sargent, 38 O. G. 781, 119 U. S. 652; Dunham v. Dennison Mfg. Co., 67 O. G. 1571, 154 U. S. 103.) *Eby v. King, 71 O. G. 1454, C. D. 1895.

VI. New Matter.

(See Enlargement; Identity.)

67. Where an element of the invention was shown in the original drawings only as a connected portion of a certain mechanism and was so described in the original patent, the description of such element in a re-issue as an independent invention is new matter, and claims based thereon are invalid. *Ives v. Sargent, 38 O. G. 781, C. D. 1887.

68. If by the re-issue the scope of the original is so enlarged as to cover and claim as a new invention that which was not in the original specification as a part of the invention described, or, if described, was by reason of not being claimed and virtually abandoned and dedicated to public use, the re-issue is unauthorized. *Eames v. Andrews, 39 O. G. 1219, C. D. 1887.

69. The fact that courts have so uniformly sustained the validity of original patents containing different inventions is probably due to their recognition of the discretion of the commissioner in their issuance; but in the case of re-issue patents no such discretion exists, no new matter can be introduced, and the re-issue must be for the same invention shown and described in the original patent. Consequently the courts have constantly held void re-issue patents embracing any new or other invention than that defined in the original patent. Ex parte Herr, 41 O. G. 463, C. D. 1887.

70. There was new substantive matter introduced into the re-issued patent for the description in the specification as a foundation for the first eight claims, and these claims themselves might have been the subject of another application for a patent at the time the original patent was applied for and taken out, leaving that patent valid and operative in respect to the claims it covered. *Parker & Whipple Co. v. Yale Clock Co., 41 O. G. 811, C. D. 1887.

71. Complainant's original patent embraced hair-crimpers of two kinds — one in which the fabric is stitched to the soft-metal core, the other in which the fabric is fastened to the core by a metal fold made by turning over the thin edges of the core, or of a strip of sheet-lead inside the fabric over the core. The original contained the clause: "I also modify my invention in various other equivalent ways, such as would suggest themselves to any intelligent mechanic," etc. The re-issued patent contained claims for fastening the fabric to the core by cementing them together. *Held*, that the re-issue was invalid, being an expansion of the original and embracing a new invention. *Philadelphia Novelty Mfg. Co. v. Rouss, 48 O. G. 1664, C. D. 1889.

72. Re-issued patent No. 6,018 *held* void because for an invention not disclosed or suggested in the original. *J. B. Brewster & Co. v. Shuler, 49 O. G. 1485, C. D. 1889.

73. The rule of law in Railway Co. v. Sayles, 15 O. G. 243, 97 U. S. 554, that an amendment seeking to introduce a material variation in the original application cannot be allowed, is not applicable where it introduces no new matter. *Beach v. American Box Machine Co., Inman et al., 69 O. G. 1067, C. D. 1894.

VII. Inadvertence or Mistake.

74. The re-issue was applied for in less than six months after the grant of the original patent. The court held that it was not prepared to hold the re-issue void because no inadvertence or mistake was shown, when the object was to enlarge a claim. *Jenkins v. Stetson, 32 Fed. Rep. 398 (1887).

75. The re-issue was applied for more than thirteen years after the date of the original patent, after the defendants had begun to make plows like those complained of. The first claim of the re-issue included elements in addition to those enumerated in the corresponding first claim of the original. The re-issue was evidently taken to cover defendants' machine, which did not infringe the first claim of the original patent, and no inadvertence or mistake in the original patent was shown. *Newton v. Furst & Bradley Mfg. Co., 38 O. G. 104, C. D. 1887.

76. The plaintiff testified "that he thought there 'was a mistake and a deficiency in the patent;' that he did not consider that other manufacturers respected it; that he considered it deficient because it applied the friction-brake to the periphery of the wheel, and that he believed the patent was entitled to cover different friction-clutch devices, so as to be a better protection against infringers." This was not

regarded as proof of inadvertence or mistake in the original patent. *Id.

77. A re-issue application claiming subject-matter shown, but *intentionally* not claimed in the original patent, filed to effect a dissolution of an interference between said patent and a pending application, and for the purpose of declaring a redeclaration of the interference between the re-issue and said pending application, refused. *Held*, that the showing did not establish a case of "inadvertence, accident or mistake," but exhibited an error of judgment. Ex parte Mahnken, 40 O. G. 915, C. D. 1887.

78. An applicant's "opinion" that the claim now asserted in the re-issue application was not considered by him to be patentable at the time of prosecuting the original application is not an instance of an actual mistake, nor a mistake inadvertently committed. Applicant accepted his patent without objection or evidence of dissatisfaction, and with full knowledge that another application was pending in the office containing interfering claims. Id.

79. Applicant's "mistake," so called, being clearly an error of judgment or opinion, cannot avail him, and a re-issue of his patent is refused. Id.

80. It is not every inadvertence or mistake which can be corrected by re-issue. Inadvertence or mistake, within the meaning of section 4916, Revised Statutes, must be shown to exist in the form of the specification or claim in consequence of which the application does not describe or claim that which the applicant intended at the time he prepared his papers. The defect must relate to the *application* and not to the *invention*. "A re-issue can only be granted for the *same invention* which was originally patented." If applicant designedly omitted to originally claim the entire subject-matter, such failure does not present a case of inadvertence or mistake within the purview of the statute. If the omission to make such claim was the result of inadvertence or mistake in preparing the application, as if in preparing a conveyance of land a covenant is by mistake omitted, this is within the statute. Ex parte Mahnken, 41 O. G. 1269, C. D. 1887.

81. A party who voluntarily takes his patent with full knowledge at the time that the specification or claims are defective and fails to cover his entire invention, or that the patent in other respects is inoperative or invalid, because of the omission of an amendment which he petitioned the commissioner to admit, which petition was refused because of insufficient showing, cannot thereafter maintain an assertion of inadvertence, accident or mistake, such as would justify the office in granting him a re-issue to correct the errors. Ex parte Page and Krausse, 43 O. G. 1455, C. D. 1888.

82. The inadvertence, accident or mistake contemplated by the statute relates to the form and character of the specification and claims as they stand at the date of issue. (Ex parte Mahnken, 40 O. G. 915, 41 O. G. 1269.) Id.

83. A patent for an invention cannot be re-issued for the mere purpose of enlarging the claim unless there has been a clear mistake inadvertently committed in wording the claim. *J. B. Brewster & Co. v. Shuler, 47 O. G. 1485, C. D. 1889.

84. Re-issued Letters Patent No. 6,018, granted to Thomas H. Wood August 18, 1874, for an improvement in carriage springs, *held* void, not only because it is for an invention not disclosed or suggested in the original, but also because, as in the case of Coon v. Wilson (30 O. G. 889, 113 U. S. 268), there was no defective or insufficient specification and no mistake inadvertently committed in the wording of the claim of the original. *Id.

85. Where an applicant, desiring to secure a patent on a combination of old mechanical devices, included a certain element in each claim because he thought it necessary to the usefulness of the machine as a whole, and after the grant of his patent another patent for a similar machine was granted with claims which he thought broader than his own, and in order to invalidate said second patent the first patentee applied for and obtained a re-issue with claims so broad that they substantially claimed as a separate device one of the original elements which was old, *held*, that there had been no such inadvertence, accident or mistake as to warrant a re-issue and that said broadened claims were void. *Id.

86. A finding of the commissioner of patents as to an original patent being inoperative by reason of inadvertence, accident or mistake may be reviewed in a suit for infringement, at least to the extent of determining whether as a matter of law what was described and alleged to be a mistake was such a mistake as will warrant a re-issue. *Id.

87. The mere fact that re-issue No. 7,947 was applied for only thirteen days after the grant of the original patent does not establish its validity; for a clear mistake, inadvertently committed, in the wording of a claim is necessary without reference to length of time. *Yale

Lock Mfg. Co. v. The Berkshire National Bank, 51 O. G. 1291, C. D. 1890.

88. Where it appeared that the attorneys whom the inventor employed to prepare his application, either through mistake on their own part or from want of clear description on the inventor's part, failed to state the claims as broadly as the device and the invention justified, and that the inventor was in poor health and his circumstances such as to explain his claim that his application was not carefully examined before being forwarded, and there was evidence to show that when the original patent was issued he recognized its defective features, made complaint concerning it, and stated that he proposed to have the error corrected, *held*, that there was such mistake as the statute contemplated and that proper means had been taken to correct it by the re-issue. *Peoria Target Co. v. Cleveland Target Co., 52 O. G. 1069, C. D. 1890.

89. Where it appeared that the claim of a re-issued patent was not covered by the original patent, and that before the issue of the latter the claim was passed upon and rejected, withdrawn, and erased by applicant's attorney; that an interference was dissolved upon condition of the amendment, and that the issue of the original was predicated upon its abandonment, *held*, in view of the protracted proceedings in the patent office, that the applicant should not be permitted to treat the deliberate acts of his attorney as the result of inadvertence, accident or mistake; and *held*, further, that the repeated official decisions and orders, and the repeated efforts to maintain said claim, indicated anything but negligence on the part of the solicitors employed. *Dobson v. Lees, 53 O. G. 1740, C. D. 1890.

90. 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, 59 O. G. 1257, C. D. 1892.

91. Where an applicant for a patent in assigning his invention said that it was "fully described in the specification pertaining to said application, which I have signed under oath," and his assignee applied for a re-issue at a time when the law did not require inventor's oath to the re-issue specification, *non sequitur* that the inventor himself would ever have asserted that the original application contained error arising from fraud, accident or mistake, and this fact taken into consideration by the court in determining that question. *Freeman v. Asmus, 59 O. G. 1432, C. D. 1892.

92. Where a patent was re-issued for the purpose of enlarging the claims to cover apparatus patented subsequently to the date of complainant's original patent, and where the element omitted from the claims of the re-issue was shown, described and claimed in the original application and patent as an essential element of each of the combinations claimed, *held*, that the failure to claim the particular combination not claimed in the original patent, but claimed in the re-issue, was not due to any such inadvertence or mistake as would authorize the claiming of it in the re-issue, and that the re-issue is not for the same invention as the original patent and is therefore void. *Huber v. N. O. Nelson Mfg. Co., 63 O. G. 311, C. D. 1893.

93. It must appear by the description in the original patent that it was the purpose of the patentee to secure the thing specified in the claim of the re-issue, and a patent cannot be lawfully re-issued unless there has been a clear mistake, inadvertently committed, in the wording of the claim. (Cases cited.) *Featherstone v. George R. Bidwell Cycle Co., 57 Fed. Rep. 631 (1893).

94. Where there was nothing in applicant's world of fact existing at the time he took his patent upon which the alleged errors of judgment could have been based, *held*, that there was no mistake of fact and no mistake of judgment upon facts that could be recognized in an application for a re-issue of his patent. Ex parte Bowman, 66 O. G. 1310, C. D. 1894.

95. Where there was a mistake in the drawings, which, however, did not render the patent wholly inoperative and probably would have been discovered by a mechanic, but was of such a character that a machine constructed from the drawings would have been inoperative for some purposes which the patentee was entitled to cover by his claims, *held*, that a re-issue to correct the drawings was proper and lawful. *Beach v. American Box Machine Co., Inman et al., 69 O. G. 1067, C. D. 1894.

96. Where an applicant acquiesced in the limited construction put on his invention, and at no time during the prosecution of his original application suggested or intimated that the invention resided in the broad device now sought to be claimed in the re-issue applica-

tion, *held*, that the failure to make the claim in the original patent did not arise through inadvertence, accident or mistake, and the reissue claim refused. Ex parte Bryant, 77 O. G. 451, C. D. 1896.

VIII. To Correct Error of Patent Office.

97. Where, by an error of the examiner, a claim was not entered and the patent issued without it, *held* that, the error being chargeable to the office (cases cited), the patent should be re-issued upon the original papers and drawings without any expense to the patentee. Ex parte Thomson, 44 MS. D. (2 G. W. D.), Aug., 1890 (Fisher, Acting Com'r).

RENEWAL OF FORFEITED APPLICATION.

(See Fees, Payment of.)

1. The right to file a renewed application within two years from the date of the allowance of the original is based upon and governed by a different section of the law from that which governs cases which have become abandoned or forfeited for want of prosecution for a period of two years. Ex parte Barnitz, 41 O. G. 575, C. D. 1887.

2. Under section 4897 an applicant who has failed to make payment of the final fee within six months from the time his case was passed to issue and allowed, and notice thereof was sent to him, has the right to make a second or renewed application; but such second application must be made *within* two years, and the commissioner of patents has no discretion to extend the time in which this right may be exercised. Id.

3. The commissioner's decision in Ex parte Barnitz (41 O. G. 575) was not designed to apply to a second application filed after the right of applicant to *renew* his original and first application had lapsed by reason of the expiration of the two years, as provided by section 4897, Revised Statutes. Ex parte Barnitz, 42 O. G. 1061, C. D. 1888.

4. Under section 4897, a definite and well-recognized practice of the office exists, and until congress shall see proper to change the statute the practice of the office should not be disturbed. Id.

5. There is no statute or rule authorizing an applicant to forfeit an application which has been allowed, file a renewal application, and pay the application fee within the six months following such allowance. Ex parte Manny, 44 O. G. 700, C. D. 1888.

6. There is no authority of law permitting the renewal of an application, or the acceptance of the fee for such renewal, before the date on which the application would actually become forfeited for non-payment of the final fee. Ex parte Nicholson, 52 O. G. 310, C. D. 1890.

7. Where it appeared that an application was filed June 25, 1887, and allowed December 9, 1887; that due notice was given to applicant to pay the final fee, which was not paid within the six months prescribed by statute; that December 4, 1889, applicant renewed his application under section 4897, Revised Statutes of United States; that said renewed application was duly allowed and applicant notified to pay the final fee under the statute, which fee applicant neglected to pay, and that on Juue 7, 1890, applicant filed a second application for renewal accompanied with the renewal fee, *held*, that applicant was not entitled to allowance of letters patent, as the application for renewal now claimed under was not made within two years after the allowance of the original application, as required by Revised Statutes of the United States, section 4897. Ex parte Nicholson, 53 O. G. 1574, C. D. 1890.

8. *Held* further, that said facts do not raise the question whether a second application for renewal may be filed within two years after the allowance of the original application, but after the forfeiture of the first renewal application, which question is therefore not decided. Id.

9. When applicant seeks protection for the process in a separate application, which he subsequently allows to become forfeited, his relief is to be found in section 4897 of the Revised Statutes, which provides that applicant may file a second or renewed application for such invention or discovery within two years after the allowance of the original application. A specific relief having been thus provided, the statute would seem to impliedly prohibit relief by other methods. Ex parte Hopkinson, 54 O. G. 264, C. D. 1891.

10. 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 also has that right. Ex parte Barrett, 56 O. G. 930, C. D. 1891.

11. In renewing an application the applicant

has the right to present new claims if he desires. Ex parte Barrett, 56 O. G. 1564, C. D. 1891.

12. The right of an applicant to renew a forfeited application under section 4897 is exhausted when once exercised. †Decisions of the Secretary of the Interior, 69 O. G. 639, C. D. 1894.

13. Under section 4897, Revised Statutes, a second application for renewal cannot be made, but a new application for a patent can be made. Decision of the Secretary of the Interior, 69 O. G. 639, construed. †Renewal of Forfeited Applications, 70 O. G. 493, C. D. 1895.

14. Although the third renewal of an application was received, acted upon on the merits, and pending at the date of the secretary's decision as to the right of renewal of an application (69 O. G. 639). *held*, under the decision, that application cannot be prosecuted. Ex parte Vulte, 70 O. G. 631, C. D. 1895.

15. An application renewed more than once prior to the date of the said decision of the secretary cannot be treated as an incomplete application. Id.

16. The papers in an application, forfeited and abandoned by operation of law under section 4897, cannot be withdrawn from the case to be used in a new application. Id.

RE-OPENING CASES IN PATENT OFFICE.

(See REHEARING; WITHDRAWAL OF CASES FROM ISSUE; AMENDMENT AFTER FINAL REJECTION; JURISDICTION OF COMMISSIONER OF PATENTS; NEW TRIAL.)

I. EX PARTE.
II. INTERFERENCE.

I. EX PARTE.

1. Entry of amendment in an application on which appeal had been heard and decided by the examiners-in-chief refused, in absence of a showing that any irreparable damage would result by requiring the applicant to file a new application. Ex parte Berger, 34 MS. D., April, 1887 (Montgomery, Com'r).

2. Ordinarily, cases which have been appealed from the primary examiner to the examiners-in-chief, and been heard and decided by them, can be re-opened by the primary examiner only by authority of the commissioner, upon a certain showing and for a certain purpose. Ex parte Holt, 38 O. G. 220, C. D. 1887.

3. In such appeal cases, however, when the examiners-in-chief have annexed to their decision the "statement" and "recommendation," applicant may, if he do not appeal further, without authority from the commissioner go back to the primary examiner and propose what seems to be within the contemplation of such recommendation. Id.

4. If the primary examiner "should refuse to receive an amendment which might be so recommended by the board, or should refuse to act at all in pursuance thereof, applicant may petition the commissioner to order the same in the usual way; or, if he should receive an amendment in conformity to such recommendation and then reject, applicant might again go to the board on appeal." Id.

5. A mere suggestion upon the part of the examiners-in-chief, however, unaccompanied by any recommendation, would not authorize the re-opening of the case without the authority of the commissioner. Id.

6. To authorize the primary examiner to reopen a case for amendment after appeal and affirmance by the examiners-in-chief, the statement and recommendation of the board must point out with reasonable clearness and certainty "the apparent grounds, not involved in the appeal, for granting letters patent," so as to enable the examiner, who, upon a careful examination, has rejected the case, and whose decision is affirmed by the board, to understand what feature or invention in the form as claimed, or in any other form, is recommended for amendment or consideration. Ex parte Peterson, 40 O. G. 692, C. D. 1887.

7. A mere suggestion in the following form: "If applicant has approved upon Stover (the reference cited), he should clearly set forth the improvement, as provided by statute," does not come within the rule, nor does it obviate the necessity for the applicant, when presenting his amendment, to make a showing and furnish reasons why it was not offered earlier. Such a suggestion could be made in every case, and would leave the examiner to re-open the application generally, limited, if at all, only by the decision. Id.

8. The marginal indorsement, "Approved," signed by the board and the acting commissioner, *held* not to give any additional force to the suggestion in the decision. The case being *ex parte*, the jurisdiction of the examiners-in-chief ceased after their decision, and the case was not before the acting commissioner by petition or otherwise. Id.

9. The jurisdiction to pass upon amendments in such cases is with the primary examiner, subject to the applicant's right of appeal; following Ex parte Pearson (40 O. G. 244) and other cases cited. Id.

10. An application which has been finally rejected by the primary examiner, and such rejection affirmed by the examiners-in-chief, will not be re-opened on petition averring, first, that the invention was originally misunderstood by the counsel then employed and by the primary examiner, and that the references cited related to the case thus misunderstood; second, that the claim appealed to the examiners-in-chief is not broad enough to protect the actual invention, and the description is incorrect and not sufficiently clear. Ex parte Greene, 41 O. G. 1161, C. D. 1887.

11. Amendments after appeal may be admitted for the purpose of putting the rejected claim in better form for consideration on appeal. Such amendments should not vary the scope of the claim. If [illegible]ave been admitted and do vary the sco[illegible]he claim, the appellate tribunal should no[illegible]s upon the merits, but the case should be sent [illegible]ck to the primary examiner for action. Ex parte Hooper and Clark, 56 O. G. 929, C. D. 1891.

12. A case will not be re-opened for further amendment on allegation of remissness on the part of the previous attorney, when the present attorney is also exhibiting tardiness. Ex parte Knecht, 61 MS. D. 267 (9 G. W. D.), April, 1897 (Fisher, Acting Com'r).

13. The original attorney having been disbarred, without applicant's knowledge, and having failed to take due action in the case, this, with applicant's poverty, makes a reasonable case of unavoidable delay. Ex parte Hughes, 62 MS. D., Sept., 1897 (Greeley, Ass't Com'r).

14. The examiner cannot, under the rules, after a decision by the examiners-in-chief, admit even allowable claims, unless such claims are recommended by the examiners-in-chief, without written authority from the commissioner. Ex parte Hunter, 81 O. G. 504, C. D. 1897.

15. To permit an applicant after decision upon appeal to present additional claims to be considered by the examiner, and if rejected by him again brought before the examiners-in-chief on appeal, is not proper practice. Id.

16. A petition for re-opening a case is improper when filed more than two years after appeal to the commissioner and no action has meanwhile been taken. Ex parte Redgrave, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

17. Where on appeal only broad claims were presented, which were refused, *held*, that the case should not be re-opened to admit narrow claims. Ex parte Firsching, 80 O. G. 1272, C. D. 1897.

18. An applicant should present his whole case at one time by both broad and narrow claims. It is not considered good practice to allow an applicant to present broad claims, try them through all the tribunals of the office, and when such broad claims are refused go back to the examiner and present narrow claims. Id.

19. Applicants insisting upon broad claims only and appealing such claims have no vested right in a further examination if they fail to prevail on the appeal. Id.

II. Interference.

20. Statement of the litigation growing out of the several interferences declared between the patents granted to A. G. Bell and the applications of later applicants; the inventions distinguished and compared with the previous state of the art, and the decisions rendered by the various tribunals in the office considered and discussed. McDonough v. Gray, 46 O. G. 1245, C. D. 1889.

21. *Held*, that the petition "is of no avail for any purpose whatever;" that Gray proposes no new evidence as to dates, nature or the character of his own invention; that it was conclusively shown in the evidence that Gray, at the time of filing his caveat, while having a conception of the telephone, did not understand the invention, and was unable to explain the mode of its operation; that he adhered to the idea that articulate speech must be transmitted upon the multiple-telegraph principle; that he positively conceded that he did not reduce his invention to practice for a long time after the issuance of patent to Bell; that he regarded the invention patented to Bell as trivial, and called it a "scientific toy," and turned his attention to other and, in his opinion, more important inventions; that he negligently omitted to file his application for a patent until two years after the grant of Bell's patent, and was then stimulated to do so only by other parties who had acquired an interest in his inventions; and that his present petition, filed without notice to the adverse parties, was delayed for

three years and five months after the decision of the examiner of interferences awarding priority to Bell, and was then accompanied by a request that it should not be acted upon until further motion was made. Id.

22. For reasons stated, the charges in Gray's petition that Bell had fraudulently secured access to his caveat, purloined his invention and interpolated a description thereof in his application, *held* not sustained. Id.

23. As to the petition of McDonough that he be allowed to demonstrate the operativeness of the make-and-break principle, the commissioner holds the decisions of his predecessors are conclusive on that question; that McDonough never claimed to be the original inventor of the telephone, but a mere improver upon Reis' instruments; that he accepted and still accepts the make-and-break system of Reis as the foundation of his invention; and, in view of the settled judgment of the patent office that speech cannot be transmitted by an instrument which operates solely by the making and breaking of the circuit, and also in view of the fact that the supreme court of the United States has also definitely settled this question with reference to Reis, he must regard the matter *res adjudicata*. Id,

24. *Held*, that the decision of Commissioner Butterworth, of March 3, 1885, was elaborately considered and deliberately rendered, and that a rehearing could only be justified upon clear and satisfactory evidence showing in such decision error in the conclusions of fact or in the application of the law, and that evidence could be produced establishing that Gray could antedate Bell's invention, that he could prove a prior conception and reduction to practice, or that, having made an earlier conception, he had diligently prosecuted it to a reduction to practice. In the absence of showing the existence of such evidence, upon the testimony filed before and considered by the various tribunals in the office, *held*, that "the award of priority of invention was justly given to Bell," and in view of the construction given by the office and the courts to the patent, the grant was properly issued, and the protection afforded the inventor was authorized. Id.

25. As to the petition to re-open on the merits, the commissioner holds that McDonough's original claim for the receiver having been rejected on reference to Bell's patent, and he submitting thereto and canceling the claim, and McDonough having been brought into the interference in consequence of the later applicants, so as to compel them to establish an earlier date of invention than himself, it follows, inasmuch as there could have been no interference between McDonough and Bell alone, that when Gray and the other later applicants were defeated and taken out of the interference there could be left no contest between McDonough and Bell. Id.

26. Petitions denied because the showing is deemed sufficient to justify the commissioner in setting aside former decisions and decrees, since he is fully convinced that another trial on the question of priority would result in another award in favor of Bell. Id.

27. A decree of conclusiveness attaches to a correct decision based upon the record and the evidence which cannot be disturbed by a motion which admits a party's wilful and deliberate omission to take evidence and 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. Id.

28. A patentee involved in interference who refused to take testimony, relying upon his record dates, and rested his case upon the weakness of his adversary's presentation rather than upon the strength of his own, will not be permitted, after testing the opinion of all the tribunals in the office and after final decision, to have the case re-opened on the ground "that the public interests require an investigation as to prior knowledge or use, and that two patents ought not to issue for the same invention." Beardslee v. Moeslein, 46 O. G. 1640, C. D. 1889.

29. On motion to re-open, based on newly-discovered evidence found in a printed copy of testimony given in another case eighteen months before the testimony in the present case was closed, *held* a lack of diligence on the part of the moving party not to have discovered the evidence at the proper time. Edison v. Maxim, v. Swan, 51 O. G. 696, C. D. 1891.

30. The decision of examiner of interferences dismissing a motion to re-open the interference for want of jurisdiction overruled, and *held*, that the motion being noticed for hearing within the time originally limited for appeal operated to stay the running of the time limited, and therefore the examiner had jurisdiction to hear and act upon the motion. Shinn v. McElroy, 54 O. G. 1115, C. D. 1891.

31. An application for the 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. Bowen v. Bradley, 56 O. G. 1707, C. D. 1891.

32. If the newly-discovered evidence which is submitted would not change the result which has been arrived at, the interference should not be re-opened. Id.

33. 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. Schniedl v. Booth, 57 O. G. 695, C. D. 1891.

34. 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. Id.

35. The question of materiality is not the first to be considered in determining the motion. If it becomes a question at all, it is one of secondary consideration. Id.

36. Motions seeking to re-open an interference case must be brought in the first instance before the examiner of interferences. Bowen v. Bradley, 58 O. G. 386, C. D. 1892.

37. Where a party to an interference moved to re-open the same for the correction of his record, alleging that certain testimony therein attributed to him was spurious, it having been in fact dictated by his attorney during witness' temporary absence from the room, *held*, in view of material discrepancy between party and attorney as to the exact testimony so interpolated, and since it appears that the correction asked for would not affect the decision already rendered, the motion must be denied. Bowen v. Bradley, 58 O. G. 1416, C. D. 1892.

38. The commissioner will not authorize the re-opening of a case by a primary examiner, in the absence of good and sufficient reason for long delay on the part of the applicant in presenting his reasons therefor, or of a showing of great hardship or irreparable injury. Ex parte Goldsmith, 58 O. G. 1092, C. D. 1892.

39. Where a contestant in interference was put upon notice at the time of the hearing before the examiner of interferences that there was a weak point in his evidence, and notwithstanding this he waited until an appeal had been taken to the board of examiners-in-chief and thence to the commissioner before making an effort to amend his testimony, *held*, that it was then too late to have the case re-opened for the purpose of introducing evidence known and accessible to him at the time his testimony was taken. Webb v. Blickensderfer, 64 O. G. 857, C. D. 1893.

40. Notwithstanding the presentation of evidence tending to establish a fact not before in the record, the commissioner, in view of doubt as to his authority in the matter and also in view of the petitioner's remedy by bill in equity, will not re-open a case after it has been considered and decided by the court of appeals of the District of Columbia. Northall v. Bernardin, 75 O. G. 1853. C. D. 1896.

41. The proper procedure in seeking to have an interference case, after decision by the court of appeals, re-opened for consideration of a motion for dissolution is to file a motion before the commissioner for re-opening the case, in order to permit consideration by the examiner of interferences of a motion to transmit to the primary examiner the motion for dissolution. *Breul v. Smith, 79 O. G. 153, C. D. 1897.

REPAIR OF PATENTED MACHINES.

1. Where a patent covers as an entirety a machine composed of several and distinct parts, the rightful purchaser of such machine does not infringe by replacing such temporary parts as wear out, so long as the identity of the machine is retained; but, if the patent is for a distinct part or element, a purchaser will infringe by replacing it. *Singer Mfg. Co. v. Springfield Foundry Co., 34 Fed. Rep. 393 (1888).

2. A machine purchased of the complainant, the patentee, by the employer of the defendant was repaired and its construction somewhat changed by the defendant in his capacity as an employee of the purchaser. *Held*, that the purchaser was at liberty to repair and improve it within the limits of his contract, and that so long as the identity of the machine was not destroyed its owner had the right to discard useless parts and add new ones which might improve its action. *Young v. Foerster, 47 O. G. 1353, C. D. 1889.

3. One who has a license to use the whole of a machine does not become an infringer by the use of a part only. *Id.

4. The right to repair a patented device is incidental to ownership. The fact that it is patented does not lessen the owner's right to put it in order when it gets out of repair, unless, considered as a whole, it is worn out and useless. *Schickle, Harrison & Howard Iron Co.

v. St. Louis Car Coupler Co., 77 O. G. 2142, C. D. 1896.

5. When a patented machine is accidentally destroyed or when it is practically worn out, the owner thereof, under the guise of repairing it, cannot make a new machine. In such cases he must cast it aside and buy a new one from the patentee. *Id.

RESERVATION IN APPLICATIONS.

(See CROSS-REFERENCES; SUBSEQUENT APPLICATIONS; INTERFERING PATENTS.)

1. Rule 42, requiring disclaimers in cases where two or more applications are pending, all showing but only one claiming the same subject-matter of invention, is directory and not jurisdictional, and the issue of the first patent is not a bar to the issue of the second. Ex parte Roberts, 40 O. G. 573, C. D. 1887.

2. In cases of inventions capable of division the presumption of dedication to the public resulting from taking out a patent for part of the invention may be rebutted by incorporating in the first application a reservation of the right to apply for the unclaimed features in a second application or by filing subsequently a second application. Id.

3. Ex parte Roberts (40 O. G. 573) discussed, and distinction pointed out between cross-references and reservation clauses. Ex parte Blair, 43 O. G. 113, C. D. 1888.

4. The introduction of reservation clauses covering subject-matter intended to be incorporated in future applications erects a warning by which the public is deterred from entering upon the particular field of invention, and also prevents the public from knowing just what property it is purchasing in dealing with patents containing reserved rights. Id.

5. The natural and necessary effect of reservation clauses is to unlawfully prolong the monopoly of the invention. If as a matter of fact and law the subject-matter is properly divisible, the office is open at all times to applicant and his rights are safe without any reservation clause. If such be not the case applicant has ample protection by filing his second application and have it pending concurrently with the first. Id.

6. A former patent, No. 265,027, granted October 10, 1882, to Marmon jointly with one Warrington, construed, and *held*, that no one can take out a patent either jointly or severally for an invention, and, after the patent is issued without reservation in his original application, obtain a second patent with broader claims for the device. *Consolidated Roller Mill Co. v. Coombs, 48 O. G. 255, C. D. 1889.

7. When an applicant is detained in the office to contest priority, or for any other reason not involving his own laches, and meanwhile applies for and takes out patents for improvements upon the invention described in the first application, the improvement patents referring to the earlier application and reserving the right to obtain a patent thereon, such intermediate patents do not bar the right to a patent upon the subject-matter of the earlier application whenever the office is ready to grant the same. Ex parte Edison, 49 O. G. 1691, C. D. 1889.

8. Where a patent fully describes an invention which could be claimed therein and makes no reservation and gives no warning to the public, a second patent granted upon an application filed after the first patent was issued which claims simply the invention previously made public is invalid. (Cases cited.) *Brush Electric Co. v. Julien Electric Co., 41 Fed. Rep. 679 (1890).

9. No presumption of dedication arises from the failure to make reservation or to file a concurrent application where the improvement described and claimed in the first patent is an independent invention from the improvement described and not claimed in the first patent. Ex parte Mullen & Mullen, 42 MS. D. (2 G. W. D.), Jan., 1890 (Mitchell, Com'r).

10. Where the patent on the endwise-thrust machine contained a reservation saying that "the feed-chute, guideway, and means for pushing the assembled links forward, a delivery wheel or device, the fulcrum plate or corner, operating mechanism, and such details of construction as are not herein broadly claimed form the subject of a separate application," *held*, that such reservation meant that the invention was broadly claimed in the patent, and that the patentee meant to reserve only the right to claim the elements specifically in his separate application, and that a patent on such separate application, claiming the features mentioned in the reservation broadly and generically, could not be sustained as covered by the reservation. *Fassett v. Evart Mfg. Co., 64 O. G. 439, C. D. 1893.

11. A patentee cannot split up his invention for the purpose of securing additional results or of extending or of prolonging the life of any or all of its elemental parts. This conclusion

is in no way affected by the reservation attempted to be made in the earlier patent of the "broad idea of a lifting-spring which acts with increased force as the beam rises," for the reason that the broad idea sought to be reserved is embodied in identically the same mechanical device constituting the invention and covered by the first patent, which completely occupies all the ground that was reserved. *Miller v. Eagle Mfg. Co., 66 O. G. 845, C. D. 1894.

RIGHT TO MAKE, USE AND SELL—IN GENERAL.

1. The purchaser of a patented machine has the right to use the machine until worn out in the manufacture of the product it is designed to make, and sell the same in the market, and to designate it by label or otherwise as the product of the invention. *Martha Washington Creamery Buttered Flour Co. of the United States (Limited) v. Martien, 47 O. G. 1488, C. D. 1889.

2. The first inventor is entitled to all the benefits which spring from the obvious uses of his invention. Others may patent the means by which they adapt it to uses not antecedently obvious; but the inventor is entitled to a free field for the exercise of all the qualities and special adaptations that belong to his invention. So, too, the public are entitled to practice the invention in all its obvious utilities when the patent has expired and may not lawfully be debarred from the enjoyment of it 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. Ex parte Faure, 52 O. G. 752, C. D. 1890.

3. If an inventor construct and sell a new machine or put it into use before applying for a patent thereon, he cannot afterward take out a patent and maintain a suit against his purchaser or user for infringement thereof by use of such machine. *Dable Grain Shovel Co. v. Flint, 52 O. G. 1537, C. D. 1890.

4. In such case a demand for compensation made by the inventor after he receives his patent will not affect the rights of the purchaser or user of the machine, because if the inventor had no right to compensation a demand therefor would not give him any such right. *Id.

5. Where in a suit for infringement it appeared that the alleged infringing machines were constructed and put in use in the defendant's grain-elevators by the inventor himself, and with his knowledge and consent, while he was in their employment as superintendent of machinery, and before his application for either patent in suit, *held*, that according to the express terms of the statute the defendants had the right to continue to use these specific machines without paying any compensation to him or his assigns, whether asked for or not. *Dable Grain Shovel Co. v. Flint, 53 O. G. 1093, C. D. 1890.

6. The said act does not deprive the inventor of his property without compensation, and is constitutional, because the patentee has no exclusive right of property in his invention except under and by virtue of the statutes securing it to him, and according to the regulations and restrictions of those statutes, and because the machines had been set free from his monopoly by his own act, consent and permission. *Id.

7. The right to use a process apart from the things sold, which things are adapted for carrying out the process, does not follow from the sale merely of the things themselves. *Vermont Farm Machine Co. v. Gibson, 56 O. G. 1566, C. D. 1891.

8. Where the defendant bought from the patentee a creamery containing four cans made under the patent, *held*, that the defendant thereby became a licensee to use the process in connection with that creamery and its cans and their necessary repairs, but no further. *Vermont Farm Machine Co. v. Gibson, 64 O. G. 300, C. D. 1893.

9. Where the defendant purchased of the patentee an apparatus for toilet paper with which the latter was accustomed to send a roll of paper used in the same, *held*, that the sale of the apparatus carried with it the right to use and sell the apparatus upon a replenishment of the paper. *Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co., 67 O. G. 271, C. D. 1894.

10. The rights to make, use or sell are completely severable rights and involve the right to confer on others such qualified privilege as the owner of the patent sees fit, whether within specified limits or under limitations of quantity, or numbers, or restricted use. *Heaton-Peninsular Button Fastener Co. v. Eureka Specialty Co., 78 O. G. 171, C. D. 1897.

(A state may require the taking out of a license for the sale of an article manufactured under a patent; but it cannot discriminate against non-resident manufacturers and favor resident manufacturers. *Webber v. State of Virginia, 20 O. G. 369, 1881.)

RIGHT OF PUBLIC TO USE NAME OF PATENT OR PATENTED ARTICLE.

(See TRADE-MARKS; NAME OF PATENTED ARTICLE.)

RIGHT OF SALE AND USE OF PATENTED ARTICLE IN OUTSIDE TERRITORY.

1. Hatch had an assignment of the patent in suit from the owner of the same "for, to and in the state of New York" "as fully and entirely as the same would have been held and enjoyed by" him "if this assignment and sale had not been made." Hatch gave an exclusive license to the defendant "to make, use and sell" the patented improvement in the cities of New York and Brooklyn, "and sell in the state of New York and elsewhere." The owner of the remaining interest in the patent gave an exclusive license to certain parties to make and sell the patented invention in certain territory other than the state of New York, and joined with his licensees as complainant in the suit. The actual sales, which were the infringements complained of, appear to have been made to dealers (apparently in the state of New York) with knowledge that their sales would be to persons outside of that state. In this case it was *held* that defendant's license did not authorize him to sell the patented article to dealers for sale outside of the state of New York. *Hatch v. Hall, 40 O. G. 1342, C. D. 1887.

2. A purchaser of a patented article, sold by the patent owner or assignee for a certain defined territory, cannot, in the course of trade, *sell* the article in another territory for which another person has the exclusive territorial rights. (Following Hatch v. Adams, 22 Fed. Rep. 434; Hatch v. Hall, id. 438, 30 Fed. Rep. 613.) *Standard Folding Bed Co. v. Keeler, 37 Fed. Rep. 693 (1889).

3. Where an assignment of territorial rights has been made, the subsequent purchase of the patented article from the inventor or a later assignee (with notice) will not entitle the purchaser to use said article within the territory of the first-mentioned assignee. *Sheldon Axle Co. v. Standard Axle Works, 48 O. G. 117, C. D. 1889.

4. Adams v. Burks (33 O. G. 114) commented upon, and *held* not to conflict. *Id.

5. The purchaser who buys a machine or device, patented or unpatented, without any restriction as to the mode or extent of the use to which he may apply it, acquires all the rights of the seller and may do with it whatever the seller might have done if he had not parted with it. *Morgan Envelope Co. v. The Albany Perforated Wrapping Paper Co., 50 O. G. 303, C. D. 1890.

6. A dealer residing in the United States cannot purchase in another country articles patented there, from a person authorized to sell them, and import them to and sell them in the United States, without the license of the owners of the United States patent. *Boesch v. Graff, 51 O. G. 477, C. D. 1890.

7. One who purchases a patented article from the owner of the patent right for a certain territory has no right to sell the same in the course of trade in territory for which another owns the exclusive territorial right. *Standard Folding Bed Co. v. Keeler, 51 O. G. 480, C. D. 1890.

8. The sale of a patented article by an assignee of the patent within his own territory carries the right to use it within territory owned by another, though it be known to both parties that a use outside the vendor's territory is intended. *Hobbie v. Jennison, 51 O. G. 624, C. D. 1890.

9. Where an assignee for a specified territory holds title under an otherwise unconditional and unrestricted assignment, the sale of the patented article by the assignee within his territory carries the right to use it everywhere, notwithstanding the knowledge of both parties that a use outside the territory is intended. (Following Adams v. Burke, 33 O. G. 114; 17 Wall. 453.) *Hobbie v. Jennison, 63 O. G. 1204, C. D. 1893.

10. One who buys patented articles of manufacture from an assignee for a specified territory, holding title under an otherwise unconditional and unrestricted assignment, becomes possessed of an absolute property in such articles unrestricted in time or place. *Keeler v. Standard Folding Bed Co., 71 O. G. 451, C. D. 1895.

11. Whether a patentee may protect himself and his assignees by special contracts brought home to the purchasers is a question that would arise as a question of contract and not as one under the inherent meaning and effect of the patent laws. *Id.

12. Articles may be purchased from a licensee of certain territory, and imported into and sold in other territory which the patentee had reserved, although the purchaser had knowledge of an agreement by said licensee not to thus trespass on the territory reserved. *Jackson v. Vaughn, 73 Fed. Rep. 837 (1896).

13. It is now well settled that one who buys patented articles of manufacture from one authorized to sell them at the place where they are sold becomes possessed of an absolute property in such articles, unrestricted in time or place. (Wilson v. Rousseau, 4 How. 646, 648; Bloomer v. McQuewan, 14 How. 539; Chaffee v. Belting Co., 22 How. 217, 223; Mitchell v. Hawley, 16 Wall. 544; Adams v. Burke, 17 Wall. 453, 456; Birdsell v. Shaliol, 112 U. S. 485, 487, 5 Sup. Ct. 244; Hobbie v. Jennison, 149 U. S. 355, 13 Sup. Ct. 879; McKay v. Wooster, 2 Sawy. 373, and others.) *Id.

14. The defendant was not a party to the license which prohibited the licensees from permitting the patented articles to be sold, directly or indirectly, west of the Rocky Mountains. The contract was not binding on Vaughn nor any other purchaser not a party to the contract. It is difficult to see how Vaughn's knowledge of the agreement could impair his right to purchase from the licensees within their territory or affect his absolute right of property in the vended articles. Having purchased them he had the right to put them to any use or dispose of them as he saw fit. By the sale from the authorized licensee they passed outside the monopoly. *Id.

15. The sale of a patented article by the patentee frees it from the grasp of the monopoly, and the purchaser may thereafter exercise the same dominion over it which he exercises over his other property. *Schickle, Harrison and Howard Iron Co. v. St. Louis Car Coupler Co., 77 O. G. 2142, C. D. 1896.

16. A patentee may lawfully prevent his machine from passing beyond the monopoly of the patent by a license which defines the boundaries of lawful use. *Heaton-Peninsular Button Fastener Co. v. Eureka Specialty Co., 78 O. G. 171, C. D. 1897.

RIGHT OF UNITED STATES GOVERNMENT TO USE PATENTED ARTICLES.

(See SUITS FOR INFRINGEMENT AGAINST THE UNITED STATES; EMPLOYER AND EMPLOYEE — GOVERNMENT.)

1. The consent of the owner of a patented device is not positively necessary in order to enable the United States to use the invention described in the letters patent, particularly in cases where it relates to the mode of construction of implements of warfare required by the government. *Dashiell v. Grosvenor, 74 O. G. 500, C. D. 1896.

2. The United States have no more right than any private person to use a patented invention without license of the patentee or making compensation to him, but they cannot be impleaded in a judicial tribunal except so far as they have consented to be sued. *Belknap v. Schild, 74 O. G. 1121, C. D. 1896.

(The United States government cannot use a patented invention without compensating the patent owner. United States v. Burns, 12 Wall. 246; James v. Campbell, 21 O. G. 337, C. D. 1882; United States v. McKeever, 23 O. G. 1530, C. D. 1883; Cammeyer v. Newton, 11 O. G. 287, C. D. 1877.)

ROYALTIES.

(See SUITS; DAMAGES AND PROFITS, ESTIMATION AND MEASURE OF—LICENSE AND ROYALTIES.)

SALE OF PATENT-RIGHTS ON EXECUTION.

(A patent-right may be subjected by bill in equity to the payment of a judgment debt of the patentee. A trustee may be appointed to execute an assignment if the patentee himself should not execute one. *Ager v. Murray, 21 O. G. 1107, C. D. 1882, U. S. Sup. Ct.; *Stephens v. Cady, 14 How. 528.)

SERVICE OF NOTICE.

(See INTERFERENCE.)

SERVICE OF PROCESS.

(See WITNESSES, COMPELLING ATTENDANCE OF; INTERFERENCE, SERVICE OF NOTICE.)

1. Where the invalidity, irregularity or defect in the service of the writ appears upon the face of the return, a motion to quash the service or abate the writ is the proper mode of bringing the matter to the attention of the court; but where the objection does not appear upon the face of the papers the better rule of practice, where it is sought to question or dispute the facts stated therein, is to do so by plea in abatement, on which an issue may be regularly taken and tried. *United States v. American Bell Telephone Co., 38 O. G. 1237, C. D. 1887.

2. While the interest of a non-resident partner in a partnership doing business in Ohio in respect to such business may be subject to the

local jurisdiction if the partnership is properly served in conformity with the statutes of the state, it is, however, well settled that the non-resident partner cannot be brought personally before even the local courts, or be subjected to judgment *in personam* by service upon the resident partners. *Id.

3. The return of the subpœna which recited that the marshal had served the same upon the "American Bell Telephone Company (which is a corporation found and doing business in the southern district of Ohio) by reading the same to A. D. Bullock, the president of the City & Suburban Telegraph Company (the said City & Suburban Telegraph Company being an agent and partner of the said the American Bell Telephone Company within said district)," fails to show affirmatively the facts required to constitute a valid service, either under the judiciary acts, the rules of practice governing the court, or the statute of Ohio providing for service upon a foreign corporation having a "managing agent" in the state. No presumptions are to be indulged in favor of such a return, so as to give the court jurisdiction over a non-resident corporation. The return is also irregular and open to the objection that the marshal did not confine himself to a statement of what he did in executing the subpœnas, but states conclusions of law and fact apart from what was done. *Id.

4. In the absence of a voluntary appearance, three conditions must concur or co-exist in order to give the federal courts jurisdiction *in personam* over a corporation created without the territorial limits of the state in which the court is held, viz.: (1) It must appear, as a matter of fact, that the corporation is carrying on its business in such foreign state or district; (2) that such business is transacted or managed by some agent or officer appointed by and representing the corporation in such state; and (3) the existence of some local law making such corporation, or foreign corporations generally, amenable to suit there as a condition express or implied of doing business in the state. *Id.

5. The judiciary acts (R. S., sec. 739) and act of March 3, 1875, providing that no civil suit or action shall be brought against any person outside of the district in which he resides or may be found at the time of the service of process, do not affect the general jurisdiction uf this court, but merely confer a personal privilege or exemption upon the defendant, which can be waived and is waived by a foreign corporation not only by a voluntary appearance to the suit, but by doing business in a state imposing the condition of liability to suit there by service of process on its agent. *Id.

6. It is not sufficient to give this court jurisdiction *in personam* over a foreign corporation that it has property rights, however extensive, within the district, or that it has pecuniary interests, however valuable, in business managed and conducted by others. *Id.

7. An agent of a foreign corporation upon whom service can be made must be one actually appointed by or representing the corporation as a matter of fact, not one created by implication or construction contrary to the intention of the parties. *Id.

8. The term "managing agent" implies the carrying on of the corporate business, or some substantial part thereof, by means of an agent who manages and conducts the same within the limits of the state for and on account of the foreign corporation. *Id.

9. Allegations in a plea of abatement, showing that the cause of action and the subject-matter of the suit did not have its origin in Ohio, such plea being presented solely to object to the jurisdiction of the court and to quash the return of service, do not amount to an appearance of the defendant. *Id.

10. A corporation not a resident of this district cannot be sued in this court. Service of process upon the agent or officer of a non-resident corporation insufficient. *Preston v. Fire Extinguisher Mfg. Co., 46 O. G. 124, C. D. 1889.

11. A corporation created and existing solely under the laws of another state, and having its principal office and place of business in another state and district, cannot be said to be an inhabitant of this district and be sued here, even though such corporation may do business in this district through agents. *Id.

12. In a suit in equity to have an assignment of patent-rights declared void, etc., where the parties by whom the assignment was made are non-residents, an order of publication made against them and personal service thereof upon them in another jurisdiction, but to which no heed was taken, will not have the effect of personal service of process within the jurisdiction. Upon such foreign service merely the court cannot proceed as if the parties were before it and subject them to its decree passed *in personam*. Section 787, Revised Statutes of the District of Columbia, has no application to

such case. *Backus Portable Steam Heating Co. v. Commissioner of Patents, 66 O. G. 1893, C. D. 1894.

SKILL.

See PATENTABILITY, INVENTION AND SKILL.

SPECIFICATION.

I. IN GENERAL.
II. SUFFICIENCY OF DESCRIPTION.

I. IN GENERAL.

1. If the use of a proper name to designate an invention is permissible in a specification, it is only when the invention referred to has become known in the prior art by the name of its inventor or maker. Ex parte Forbes, 4 MS. D. (1 G. W. D.), Oct., 1889 (Mitchell, Com'r).

2. An applicant should not, under any circumstances, be allowed to make statements derogatory to the inventions of others, clearly designated by the name of the inventor or otherwise, but he may within reasonable limits point out in his specification the advantages of his invention, and also what he regards as the defects or deficiencies common to the structures representing the unimproved art. Ex parte Shaw, 50 O. G. 1129, C. D. 1890.

3. An applicant will not be permitted to use words in his specification that are likely to create an ambiguity in the strict construction of his claims, and an objection by the primary examiner in such a case is properly taken. Ex parte Petzold, 58 O. G. 1091, C. D. 1892.

II. SUFFICIENCY OF DESCRIPTION.

(For full discussion of this subject, see decision of supreme court (Justice Bradley) in *The Webster Loom Co. v. Higgins, 21 O. G. 2031, C. D. 1882.)

4. The theory of the operation of a patented invention may be derived wholly from the testimony of experts, and need not be stated in the specification of a patent if the thing to be done is so described in the specification that it can be produced. *Eames v. Andrews, 39 O. G. 1319, C. D. 1887.

5. It being contended that the patent did not disclose the character of the celluloid sheets to be employed, *held*, that as there was only one kind of celluloid sheet at the date of the patent which could be used for the purpose, and the mechanic had no need of definite instructions, the description in the patent was sufficient. *Celluloid Mfg. Co. v. American Zylonite Co., 40 O. G. 1453, C. D. 1887.

6. A patent sufficiently describes a process when by the aid of the knowledge derived from the state of the art the same may be carried out from the description in the patent by those skilled in the particular manufacture. *Lawther v. Hamilton, 42 O. G. 487, C. D. 1888.

7. 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 also if he points out some practical way of putting it in operation. *Dolbear v. American Bell Telephone Co., 43 O. G. 377, C. D. 1888.

8. 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. Ex parte Borde, 44 O. G. 700, C. D. 1888.

9. The description in the specification of the patent, which, it should be remembered, is addressed to persons skilled in the particular art to which the invention relates, is sufficiently explicit to enable a person skilled in the art to practice the invention. *Am Ende v. Seabury & Johnson, 47 O. G. 1354, C. D. 1889.

10. It cannot be recognized as good practice to refer in the description of a process for which a patent is sought to a very few of the letters upon the drawings which illustrate a complicated machine for carrying out that process. Ex parte Borgfeldt, 49 O. G. 132, C. D. 1889.

11. The word "filament," used as descriptive of the size of the burner, is sufficiently definite in view of illustrations in the specification, and it is not necessary that its maximum and minimum dimensions should be specified, especially since defendant's burners indisputably lie wholly on one side of the dividing line between rods and filaments. *Edison Electric Light Co. v. United States Electric Lighting Co., 61 O. G. 564, C. D. 1892.

12. A patent is not invalid for insufficiency of description, in that it does not state what one skilled in the art would know. *Lalance & Grosjean Mfg. Co. v. Haberman Mfg. Co., 63 O. G. 1816, C. D. 1893.

13. The patent clearly describes and claims the construction of the invention whereby the

improvement in the art of glass-annealing is accomplished, though the description is silent as to the philosophical principles which cause the invention to produce the improved annealing. *Held*, that the description is sufficient, and that the patentee ought not to lose the statutory benefits of his invention because he was perhaps not aware to what the improvements effected by his device were due. *Dixon Wood Co. v. Pfeifer, 64 O. G. 156, C. D. 1893.

14. When a specification requires to be supplemented by experiment and inventive skill, it is fatally defective and the patent is void. *The Tannage Patent Co. v. Zahn, 71 O. G. 1161, C. D. 1895.

15. A specification which fails to describe any material part of an invention in a comprehensible manner is fatally defective. *Id.

16. It is not material that a patentee has not described in full all the beneficial functions to be performed by the parts of his machine if those functions are evident in the practical operation thereof and are seen to contribute to the success of his device. (Eames v. Andrews, 39 O. G. 1319, 7 Sup. Ct. 1073, 122 U. S. 40, followed.) *McCormick Harvesting Machine Co. v. Aultman & Co., 73 O. G. 1999, C. D. 1895.

17. In view of the antiquity of the art of swaging, *held*, that claims 1, 2, 3, 9 and 10 are not void for want of a sufficient description to comply with Revised Statutes, section 4888, though the process not stated in full. (Kilbourne v. W. Bingham Co., 60 O. G. 577, 1 C. C. A. 617, 50 Fed. Rep. 697, followed.) *Storm Mfg. Co. v. Weir Frog Co., 77 O. G. 1125, C. D. 1896.

18. Where a patent fails to state the inventor's conception of the state of the art, the particular advance which he understood himself to have accomplished, or the parts of his device or its functions, except incidentally and in a crude and incomplete manner, *held*, that if judicial tribunals misapprehended the scope of the invention the cause will lie in the want of a full and frank disclosure on the face of the patent of what it was, and as this is the fault of the inventor, or in law attributable to him, he must accept the result as one of his own making. *Long v. Pope Mfg. Co., 77 O. G. 1428, C. D. 1896.

19. Patents for processes should be so plain that an ordinary manufacturer in the art having such ordinary knowledge as would exist in this country at the date of the patent should be enabled by the instructions of the patent to carry out successfully its processes. *Matheson v. Campbell, 79 O. G. 686, C. D. 1897.

20. As a rule an applicant is bound by the acts of his solicitor, but this rule will not be extended to include the case of one who seeks to void a patent upon the theory of fraudulent concealment or misrepresentation because through the solicitor's ignorance the specification, when describing the process of manufacture, contains some immaterial omission which could not mislead a person skilled in the art. *Id.

21. In a case like the present the patent should state and fully disclose the component parts of the composition claimed with clearness and precision and not leave a person attempting to use the discovery to find it out by experiment. If the description be so vague and uncertain that no one can tell with certainty, except by independent experiment, how to apply the discovery and what exact result may be expected therefrom, the patent is void. (Wood v. Underhill, 5 How. 1, 5; Tyler v. Boston. 7 Wall. 327, 330; The Incandescent Lamp Patent, 73 O. G. 1289, 159 U. S. 465, 474-75.) *Stevens v. Seher, 81 O. G. 1932, C. D. 1897.

STATUTES, CONSTRUCTION OF.

I. In General.
II. Re-issue.

I. In General.

1. The word "unavoidable," as used in section 4894, Revised Statutes, should not be construed in its broad significance. The statute itself is one regulating a mere practice in the office and is not intended to affect *substantial* rights. Ex parte Pratt, 39 O. G. 1549, C. D. 1887.

2. The primary examiner mentioned in section 4904 is the examiner of interferences, while the primary examiner mentioned in section 4909 is one of the primary examiners named in section 440, Revised Statutes. Faure v. Bradley, 40 O. G. 243, C. D. 1887.

3. The expression "found in his possession," in section 4965 of the Revised Statutes, means found in the possession of the defendant before the cause of action accrues, and does not refer to the finding of the jury. *Thornton v. Schreiber, 42 O. G. 1165, C. D. 1888.

4. The "possession," under this statute, is not

the possession of an employee, but of his principal. *Id.

5. The argument sought to be founded upon the various phases assumed by the provisions of the act of July 8, 1870, in its passage through the two houses of congress is very unsafe and unreliable as a basis of judicial action, particularly when the only inference to be drawn is one as to what view congress took of the act of 1839 in enacting the act of 1870. *Andrews v. Hovey, 42 O. G. 1285, C. D. 1888.

6. The seventh section of the act of 1839 includes a process as well as "a machine, manufacture or composition of matter." *Id.

7. If there is no ambiguity in the statute it is the duty of the court to give effect to its obvious meaning, without entering into any inquiry as to the supposed intention of congress, notwithstanding the statute may be thought to make an unreasonable and harsh innovation. *Edison Electric Light Co. v. United States Electric Lighting Co., 43 O. G. 1456, C. D. 1888.

8. Where the meaning of the Revised Statutes is plain, the court cannot look into the source of the revision to ascertain whether errors have or have not been committed by the reviser. *Id.

9. The statute does not provide 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* any new art, machine, etc. Ex parte Gibford, 45 O. G. 1457, C. D. 1888.

10. *Held*, that the words "filing of the application" in section 4894 do not mean the filing of the completed application, but only the depositing of the application referred to in section 4893 and preceding sections, which may or may not be accompanied by the fee. Ex parte Fenno, 52 O. G. 1665, C. D. 1890.

11. The words "every party to an interference" in section 4909 of the Revised Statutes evidently mean every defeated party to an interference. Shinn v. Baker, v. Gold, 56 O. G. 1204, C. D. 1891.

12. The word "*decision*" in the last clause of section 9 of the act of February 9, 1893, providing that "any party aggrieved by a decision of the commissioner of patents in any interference case may appeal therefrom to said court of appeals," interpreted and *held* to mean only a decision of the commissioner of patents awarding priority of invention. *Westinghouse, Jr., v. Duncan, 66 O. G. 1009, C. D. 1894.

13. It is a sound rule of construction of a statute, where the words of an act or part of an act are plain and clear and not inconsistent with the general object of the statute and lead to no absurd result, that the courts have no right to refuse their operation or to limit their effect by a construction based upon conjecture. *In re Drawbaugh, 67 O. G. 929, C. D. 1894.

14. The meaning of the words "surreptitiously" or "unjustly" in section 4926, Revised Statutes, and prior statutes discussed. *Yates v. Huson, 74 O. G. 1732, C. D. 1896.

II. Re-issue.

15. The language of section 4916 of the Revised Statutes, that the "surrender shall take effect upon the issue of the amended patent," is not to be construed to mean that the status of the original patent is unchanged after its return to the commissioner. *Burrell v. Hackley, 44 O. G. 1400, C. D. 1888.

16. The supreme court has never so construed the statute which authorizes re-issues as to deny to a 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, 54 O. G. 507, C. D. 1891.

17. The commissioner is authorized to reissue patents in certain specified cases, and if the petition makes no pretense of setting forth facts entitling the patentee to a re-issue it is exceedingly doubtful whether he obtains any jurisdiction under section 4916, Revised Statutes, to act upon such petition. *Eby v. King, 71 O. G. 1754, C. D. 1893.

STATE STATUTES OF LIMITATION.

1. Under Revised Statutes of the United States, section 721, providing that "the laws of the several states, except where the constitution, treaties or statutes of the United States otherwise require or provide, shall be regarded as rules of decision in trials at common law in the courts of the United States in cases where they apply," an action in a federal court to recover damages for infringement of a patent is not subject to a state statute of limitations. *May v. Buchanan County, Iowa, 39 O. G. 120, C. D. 1887.

2. But such action is subject to a state statute requiring a demand against a county for unliquidated damages to be presented to the

board of supervisors of the county and payment demanded before bringing action upon it. *Id.

3. State statutes of limitations have no application to actions arising out of the infringement of patents, even though there is no federal statute in existence. *May v. County of Ralls, 40 O. G. 575, C. D. 1887.

4. There is no federal statute of limitations in force respecting infringements committed since June 22, 1874. *May v. Logan County, 41 O. G. 1387, C. D. 1887.

5. State statutes of limitations have no application to actions arising out of the infringement of patents. *Id.

6. A state statute of limitations has no effect upon suits in the federal courts for the infringement of patent-rights, and is not pleadable in bar of an action at law for such infringement. *Brickill v. City of Hartford, 58 O. G. 1417, C. D. 1892.

7. 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., 55 O. G. 718, 45 Fed. Rep. 91.) *California Artificial Stone Paving Co. v. Starr, 58 O. G. 1094, C. D. 1892.

8. Defendant in an action at law for infringement of patent pleaded state statutes of limitation, to which plaintiff demurred. Demurrer sustained for the purposes of this particular case; but the applicability of such statutes to actions for infringement under the patent laws discussed and upheld. *Brickill v. Mayor, etc. of Baltimore, 61 O. G. 1791, C. D. 1892.

STAY OF ISSUE.

(See WITHHOLDING FROM ISSUE.)

SUBSEQUENT APPLICATIONS.

(See INTERFERING PATENTS; DIVISIONAL APPLICATIONS; CROSS-REFERENCES; RESERVATION IN APPLICATIONS; CONTINUING APPLICATIONS.)

1. 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. (Ex parte Langlois, 14 O. G. 84.) The true course for the examiner is pointed out in Ex parte Gaboury, 37 O. G. 217. Ex parte Feister, 44 MS. D. (2 G. W. D.), Oct., 1890 (Mitchell, Com'r).

2. There is nothing in the provisions of Revised Statutes, section 4894, to prevent the filing of a subsequent application for a patent for subject-matter of a previously-abandoned application. Ex parte Beggs, 50 O. G. 1130, C. D. 1890.

3. The specification of a patent originally embraced matter which was erased before issue, and was after the issue presented in another application and patent issued thereon. *Held* not an abandonment of the parts erased from the first specification. *Sugar Apparatus Mfg. Co. v. Yaryan Mfg. Co., 53 O. G. 920, C. D. 1890.

4. Where the earlier of two pending applications of the same applicant was in condition for allowance, and the examiner refused to pass it until the later application had been formally abandoned, or until such claims in the earlier application as applied to what was shown and claimed in the later had been erased, for the reason that the later application contained substantially the same claims as the earlier, *held*, that the later application was no bar to the allowance of the earlier application. (Following Ex parte Langlois, 14 O. G. 84.) Ex parte Feister, 53 O. G. 1089, C. D. 1890.

5. The formal abandonment of an application should not be required as a condition precedent to allowing another application of the same inventor pending concurrently and in condition for allowance to proceed to issue, nor should the examiner require the erasure of any claims which would be allowed if no other application awaited consideration. The true course to be pursued is that pointed out in Ex parte Gaboury, 37 O. G. 214. Id.

6. Where an application was rejected on applicant's prior patent, the application for which was pending concurrently with the present application, and it appeared that the claims of said patent and 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 subject of invention, *held*, that the application was rightly rejected because of want of divisibility of invention between it and said patent. Ex parte Woodward, 53 O. G. 1090, C. D. 1890.

7. Where an applicant has two applications pending for 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 be made 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 allowance of the later application. Ex parte Woodward, 58 O. G. 1554, C. D. 1892.

8. The lapse of two years from and after the allowance of a patent to an applicant without responsive action on his part does not *per se* work such a forfeiture of rights as will bar the applicant from making a subsequent application for the same improvements and taking a patent therefor. (Discussing and construing sections 4885, 4886 and 4887 of the Revised Statutes.) Sibbald v. Cassidy and Smith, 61 O. G. 1165, C. D. 1892.

SUBSEQUENT PATENTS.

(See SUBSEQUENT APPLICATIONS; CONTINUING APPLICATIONS; DIVISIONAL APPLICATIONS; RESERVATION IN APPLICATIONS; CROSS-REFERENCES.)

SUBSTITUTION OF PARTS.

(See PATENTABILITY.)

SUSPENSION OF ACTION ON APPLICATION.

1. It is against public policy to permit an application for patent to lie dormant and suspended upon request of applicant or his assignee for a long term of years, and the practice of suspending action on applications for indefinite periods upon the request of the parties in interest is not sanctioned. There is no authority of law for such procedure, and a case cannot be suspended as a matter of right on the part of the applicant. Ex parte Norton, 42 O. G. 296, C. D. 1888.

2. A request by the parties in interest that further action should not be taken waived action by the office, and put the case in the same condition as though the office had acted and was awaiting further action on the part of the applicant or his assignee. Id.

3. Action should not be suspended on an application when it appears that its claims are patentable over all the disclosures of a prior application by the same applicant in interference and over all the disclosures of the interfering applications. Ex parte Willson, 59 O. G. 1257, C. D. 1892.

4. While the office cannot determine disputed questions of title, it is the rule to refuse petitions to suspend action on applications, when such petitions are based on the fact that a bill in equity has been filed by the inventor or assignee. (Cases cited.) Ex parte Martin, 63 MS. D., Dec., 1897 (Greeley, Acting Com'r).

SUITS.

(See APPEAL; DAMAGES AND PROFITS; DEFENSES; DEMURRER; INFRINGEMENT; INJUNCTION; PRACTICE IN THE COURTS.)

I. INFRINGEMENT, IN GENERAL.
II. INFRINGEMENT, AGAINST STATE, COUNTIES AND CORPORATE BODIES.
III. INFRINGEMENT, AGAINST THE UNITED STATES AND UNITED STATES OFFICERS.
IV. INFRINGEMENT, ROYALTIES; LICENSE.
V. EQUITY, SPECIFIC PERFORMANCE.
VI. PARTIES.
VII. DELAY IN BRINGING.
VIII. COSTS OF.

I. INFRINGEMENT, IN GENERAL.

1. In suits in equity the federal courts are regulated, not by state statutes, but by the judiciary acts and the rules of equity practice. *United States v. American Bell Telephone Co., O. G. 1237, C. D. 1887.

2. The owner of an equitable interest in a patent is not answerable in a suit for its infringement to the owners of the legal interest in the same patent. *Aspinwall Mfg. Co. v. Gill, 40 O. G. 1133, C. D. 1887.

3. An assignment by an administrator purporting to transfer to the assignee "all the right, title, interest, claims and demands whatsoever which the estate has in, to, by, under and through" specified letters patent, and extensions thereof, covers rights of action theretofore accrued for infringements. May v. Logan County, 41 O. G. 1387, C. D. 1887.

4. Where the contention of the plaintiff was that the inventor only knew of the invalidity of his first re-issue by the result in an earlier suit upon the same, and did not have evidence of these facts in the record, he should have brought by *certiorari* before this court such parts of the record as the defendants had omit-

ted to bring before us. *Hoskin v. Fisher, 43 O. G. 509, C. D. 1888.

5. Where in a suit against two defendants for a joint infringement, one of the defendants had made a settlement by a writing under seal for the costs and damages by the infringement of such defendant, but by such writing the other defendant was expressly not included in such settlement, the settlement was a satisfaction of the infringement by both defendants both as to damages and costs. *Babcock & Wilcox Co. v. Pioneer Iron Works, 43 O. G. 756, C. D. 1888.

6. An action for the infringement of a patent cannot be maintained while said patent is surrendered to the commissioner of patents pending an application for re-issue on the ground that the patent is inoperative and void. *Burrell v. Hackley, 44 O. G. 1400, C. D. 1888.

7. The right of action is suspended during the time the commissioner retains jurisdiction of the patent upon the question of re-issue. *Id.

8. The complainants insist that their position is precisely the same as if they held a single patent with two claims — one for the process or composition of matter producing the coloring substance, the other for the combination of that substance with paper. This might be so if they could be considered as holding both patents; but in this suit they have carefully abstained from declaring upon the first patent or even in any way referring to it. By not declaring upon it as its present owner, they leave it to the defendant to be availed of as if it were the property of a stranger. *Underwood v. Gerber, 48 O. G. 116, C. D. 1889.

9. A suit may be entertained and decided by a state court, even though there may be pending at the same time an appeal in the United States supreme court from a judgment of the circuit court dismissing a suit brought by the patentee against the complainant for infringement of the patent. *Marsh v. Nichols, Shepard & Co., 56 O. G. 259, C. D. 1891.

10. When a patent has been surrendered and a re-issue obtained and such re-issue is held to be void, the patentee cannot proceed upon his original patent. (Moffitt v. Garr, 1 Black, 273; Reedy v. Scott, 7 O. G. 463, 23 Wall. 352, 364; Peck v. Collins, 19 O. G. 1137, 103 U. S. 660; McMurray v. Mallory, 27 O. G. 915, 111 U. S. 97, referred to and reviewed.) *Eby v. King, 71 O. G. 1454, C. D. 1893.

(See *Burrell v. Hackley, *supra*; also, *Allen v. Culp, 79 O. G. 1523, C. D. 1897.)

11. In a suit under section 4915, Revised Statutes, whether the specification in the patent issued to the defendant is sufficient is not involved in the case. It is wholly incompetent and cannot be inquired into. The question is one of priority. *Standard Cartridge Co. v. Peters Cartridge Co., 72 O. G. 742, C. D. 1895.

12. The expression "was awarded to the Western Electric Company through its agent, Mr. Kaelber," is not sufficient to establish the character of Mr. Kaelber's agency or to justify an apprehension of infringement from him. A *quia timet* action will not lie unless there is something to fear. *Edison Electric Light Co. v. Kaelber, 77 O. G. 1430, C. D. 1896.

13. The joinder in one suit of claims for infringement of two patents relating to the same subject-matter is in the interest of the public as well as of private litigants and should not be discouraged by too stringent rules as to costs or otherwise. *Green v. City of Lynn, 80 O. G. 1480, C. D. 1897.

II. Infringement, Against States, Counties and Corporate Bodies.

(See Trusts.)

14. Congress has the exclusive control over the grant of patents, and may authorize suits to be brought against such persons and corporations as it deems expedient, and a state cannot exempt counties from liability for infringement of letters patent because exclusive jurisdiction over that subject-matter has been vested in the federal government. *May v. County of Ralls, 40 O. G. 575, C. D. 1887.

15. A suit cannot be maintained against a sovereign state under the eleventh amendment of the constitution; but no reason is seen why a suit cannot be maintained against a *quasi*-municipal corporation like a county, which has been created by the laws of the state (and under the state laws may be sued for certain purposes), no matter what may be the particular policy of the state with reference to relieving counties therein from liability for acts of non-feasance of county officials. *Id.

16. No exception has been made by act of congress in favor of any wrong-doer. The provision is general in its terms, and may as well include counties as other corporations or individuals. *Id.

17. A patent is personal property, and if a county wrongfully appropriates such property

it should not be exempt from liability any more than an individual. *Id.

18. Obligations to do justice rest upon all persons, natural and artificial, and if a county obtains money or property of others without authority of law, the law, independent of any statute, will compel restitution or compensation. *Id.

19. A county has the physical power to appropriate property, and, if it does so wrongfully, it will not be exempt from liability any more than an individual. *Id.

20. The officers of a corporation engaged in a manufacture in violation of the injunction of the court cannot shelter themselves from individual liability by the plea that they are acting merely as agents for the corporation. *Iowa Barb Steel Wire Co. v. Southern Barb Wire Co., 40 O. G. 577, C. D. 1887.

21. A Kentucky county is a corporation, and an action can be maintained against it for the infringement of a patent. *May v. Mercer County, 41 O. G. 815, C. D. 1887.

22. Where the officers of a corporation are made co-defendants in an action for infringement of letters patent, a decree for an injunction and accounting will not issue against them individually where the corporation is solvent and they have not as individuals violated, and are not threatening to violate, any rights of complainant. *Howard v. St. Paul Plow Works, 45 O. G. 1007, C. D. 1888.

23. Notwithstanding the merger of the complainant with another company into a new corporation, the law of the state of New York providing that pending suits shall not be deemed to have been abated or discontinued by reason of any such consolidation is effective to accomplish that end. *Edison Electric Light Co. v. United States Electric Lighting Co., 61 O. G. 504, C. D. 1892.

III. Infringement, Against the United States and United States Officials.

24. Where an officer of the government, having been sued for the infringement of patents in his official employment, pleads to the jurisdiction and alleges that the government, being the real defendant, is a necessary party, *held*, that the plea must be overruled and that public employment is not a sufficient defense. *Head v. Porter, 60 O. G. 1052, C. D. 1892.

25. Action against the United States to recover damages for the alleged wrongful use of the invention secured by a patent, No. 105,509, issued July 19, 1870, and re-issued May 2, 1871, No. 4,364, to John J. Schillinger, for an improvement in concrete pavements, *held* to be an action "sounding in tort" and not maintainable. *Schillinger v. United States, 69 O. G. 1505, C. D. 1894.

26. The patentee of an improvement in breeching-loading cannon brought suit against an officer of the United States navy connected with the bureau of ordnance and having charge of the manufacture of cannon at a navy yard for an alleged infringement of his patent, praying not only for an accounting and damages, but for an injunction restraining defendant and all persons acting under his authority from making the cannon alleged to infringe complainant's patent. *Held*, that the suit was, in substance, one to prevent the making of breech-loading cannon of a certain character at the navy yard, and that public policy and the rights of the government would not permit such a suit to be maintained. (62 Fed. Rep. 584, reversed.) *Dashiell v. Grosvenor, 74 O. G. 500, C. D. 1896.

27. The United States having, by act of congress, consented to be sued upon their contracts, may accordingly be sued by a patentee for their use of his invention under a contract made with him by the United States or their authorized officers. *Belknap v. Schild, 74 O. G. 1121, C. D. 1896.

28. But the United States have not consented to be liable to suits sounding in tort for wrongs done by one of their officers, though in the discharge of his official duties. They are therefore not liable to a suit for an infringement of a patent, that being an action sounding in tort. *Id.

29. A public officer is not personally liable on a contract made by him in the line of his duty and on account of the United States and inuring to their benefit and not to his own; but he is personally liable to be sued for his own infringement of a patent. *Id.

30. Where the infringing device was the property of the United States and held and used by them for the public benefit through officers, the United States were an indispensable party to the suit to enable the court to grant the relief sought. *Id.

IV. Infringement, Royalties, License.

31. In a suit for infringement, where the defense was a license to make one hundred machines, and it appeared that the licensee had

made more than that number, the hostile conduct of the licensor might make him liable to the licensee for damages, but would not extend the terms of the license. *Aspinwall Mfg. Co. v. Gill, 40 O. G. 1133, C. D. 1887.

32. The defendant is a licensee of the Detroit Lubricating Company under a license which is limited upon its face to patents owned by that company. The Detroit Lubricating Company is the licensee of the complainant under a contract which does not grant an exclusive license for the manufacture or use of the Gates patent owned by the complainant, and which is infringed. *Held*, that the defendant was not protected by its license in the manufacture of articles under the Gates patent. *The Seibert Cylinder Oil Cup Co. v. The William Powell Co., 47 O. G. 1072, C. D. 1889.

33. Where in a suit to recover royalties under a license it appeared that it was sufficiently alleged in the declaration that the defendant accepted the license and manufactured goods under it, *held*, that this was sufficient to show an implied undertaking to pay the royalties provided for in the license. *National Rubber Co. v. Boston Rubber Shoe Co., 50 O. G. 559, C. D. 1890.

34. *Held* further, that it was no defense that said goods did not contain the improvements described in any of the licensor's patents, excepting one that had expired long before the period for which recovery was sought, since it was evident that the goods made by defendant embodied inventions described in two of said patents that were still in force. *Id.

35. When the validity of the patent and the license are admitted, a suit by a licensee to restrain a subsequent assignee from manufacturing and selling the patented article, and to recover damages, involves no question under the patent laws and was properly in the state court for determination. ‡Mayer v. Hardy, 56 O. G. 527, C. D. 1891.

36. When a license to make, use and sell a patented article is granted, coupled with a covenant to grant only one other license, and when the patentee was not by the terms of the agreement denied the right to manufacture and sell the patented article and was not by any express provision in it required to retain the title, a subsequent assignee of all the patentee's right, title and interest is not liable as a trespasser against the rights granted by the license. ‡Id.

37. If the bill of the licensee who has the exclusive right to manufacture and sell a patented article alleges a combination between the owner of the patent and other persons, who are made parties defendant with the owner, to deprive the complainant of the benefits and advantages of his license, and the evidence shows that a license granted by the owner of the patent to his co-defendants was granted by him, and procured by them, for the paramount purpose of preventing the complainant from enjoying the monopoly conferred by his license, the defendants are joint infringers of the complainant's rights, and he is entitled to relief against all the parties defendant. *Waterman v. Shipman, 64 O. G. 713, C. D. 1893.

V. Equity, Specific Performance.

(See Equity.)

38. A suit against a patentee for the specific performance of an alleged contract between the complainant and patentee, by which the former was to have the right, if the latter obtained a patent on the improvement in question, to make, use and vend said patented article, and to enjoin the patentee from interfering with such right, is not a question arising under the patent laws, since neither the validity of the patent, nor its construction, nor the patentability of the device, was brought under consideration. *Marsh v. Nichols, Shepard & Co., 56 O. G. 259, C. D. 1891.

39. A court of chancery cannot decree specific performance of an agreement to convey property which has no existence, or to which defendant has no title. *Kennedy v. Hazelton, 46 O. G. 973, C. D. 1889.

40. A contract which, entirely aside from any question of its validity in law, is unusual and oppressive in its terms, is not enforcible in equity. Specific performance is not an absolute right, but rests entirely in judicial discretion. (Citing Hennessy v. Woolworth, 128 U. S. 438.) *Pope Mfg. Co. v. Gormully, 59 O. G. 464, C. D. 1892.

41. An oral agreement for the sale and assignment of the right to obtain a patent for an invention is not within the statute of frauds, nor within section 4898 of the Revised Statutes requiring assignments of patents to be in writing, and may be specifically enforced in equity upon sufficient proof thereof. *Dalzell v. Dueber Watch Case Mfg. Co., 63 O. G. 1381, C. D. 1893.

42. A court of chancery will not decree specific performance unless the agreement is "cer-

tain, fair and just in all its parts," nor "if it be doubted whether an agreement has been concluded or is a mere negotiation," nor "unless the proof is clear and satisfactory both as to the existence of the agreement and as to its terms." *Id.

43. When there is a decree for specific performance of two contracts, one for a transfer of part interest of all inventions relating to a particular subject and the other for a transfer of part interest of certain specified patents relating to that subject, the assignee's rights are merged in the decree and he has no title or claim under his contracts to any other patents of the assignor or to any improvements thereon. *Independent Electric Co. v. Jeffrey Mfg. Co., 78 O. G. 797, C. D. 1897.

VI. Parties.

(See Suits Against States, Counties and the United States.)

44. Where one makes and others sell infringing articles, they are liable jointly and severally. *Jennings v. Dolan, 38 O. G. 1018, C. D. 1887.

45. Where the complainant in a bill for the infringement of a patent is only a licensee, and the patent had been assigned to another party before the suit as security for a debt not yet due, the last-named party must be joined as a complainant, and a subsequent assignment to the complainants of the assignor's entire interest in the patent will not change the legal status of the parties. *Waterman v. Mackenzie, 39 O. G. 122, C. D. 1887.

46. There is no necessity for making those parties to the suit who have been settled with and had no interest in the controversy. *Rogers v. Riessner, 41 O. G. 351, C. D. 1887.

47. Rights of action for infringements of patents survive to the personal representatives of the patentee. *May v. Logan County, 41 O. G. 1387, C. D. 1887.

48. The executor or administrator of the patentee may not only sue on such causes of action, but may assign and transfer the same to another. *Id.

49. The assignee may, in his own name, maintain an action thereon in any state the law whereof allows an assignee of a chose in action to sue thereon in his own name. *Id.

50. An interest in the net proceeds of collections for infringements of a patent does not necessarily involve an interest in the patent itself. *Tilghman v. Proctor, 43 O. G. 628, C. D. 1888.

51. After litigation is closed in suit for infringement of a patent, a petition in behalf of a party for leave to intervene as a defendant alleging that he had actually defended respondent's case and was most interested in the defense against complainant's patent must be dismissed. *Zinsser v. Kremer, 49 O. G. 414, C. D. 1889.

52. Where a patentee granted to a complainant "the exclusive right, liberty and privilege to make, use and sell" a patented invention "during the full unexpired term thereof, and of all re-issues, renewals and improvements," throughout the United States and the territories, the complainant to pay the royalties agreed upon in a separate agreement, and it did not appear whether such grant was an absolute or defeasible conveyance, *held*, that the complainant must join the owner of the legal title in a suit to enjoin the infringement of the patent. *Clement Mfg. Co. v. Upson & Hart Co., 50 O. G. 840, C. D. 1890.

53. In such suit complainant's allegations that, by mesne assignments and grants, it became, prior to the suit, and now is, the party interested in said letters patent, "all of which, by said assignments and grants now in court produced and shown, will more fully appear," sufficiently show complainant's interest, when coupled with the profert and exhibit. *Id.

54. Where in a suit for the infringement of a patent it appeared that an individual defendant had no interest in the alleged infringing machines except as an officer of a defendant corporation, and that there was no evidence that he as an individual had violated any of the complainant's rights, or that the defendant corporation was insolvent, or that a decree against it would not protect the complainant, *held*, that the suit should be dismissed as to him. *Woven Hose Co. v. Star Rubber Co., 50 O. G. 1450, C. D. 1890.

55. The joining of the president of a corporation as co-defendant, on a complaint alleging that the corporation and the president have infringed complainant's patent, is no ground of demurrer, though there is no specific allegation in the bill that he personally directed or participated in the infringement complained of. *Cleveland Forge and Bolt Co. v. United States Rolling-Stock Co., 52 O. G. 1808, C. D. 1890.

56. When a mortgage has been recorded in the patent office, the title of the mortgagee is

complete and he is the only person who can thereafter sue for an infringement of the patent by third persons. *Waterman v. Mackenzie, 54 O. G. 1562, C. D. 1891.

57. A mere licensee, or one having no title in and exclusive right under the patent, cannot sue at law in his own name for an infringement. *Id.

58. A grantee, if he seeks to maintain an action in his own name, must be supreme within the assigned territory and be able to do all that the patentee could do if the conveyance had not been made, and if he does not occupy this position and possess these rights he is only a licensee. *Rice v. Boss, 55 O. G. 999, C. D. 1891.

59. Where final decrees were rendered in the circuit court in favor of two joint owners of certain patents, not being partners, and one of the complainants died after said decrees were rendered and appeals were filed and allowed and the citation ran to the surviving complainant, and no order was procured, directed to the proper representatives of the estate of the deceased owner, or notifying them of the appeals, and they did not voluntarily appear, *held*, that the cause of action did not survive to the remaining owner and that the supreme court had no jurisdiction. *Dolan v. Jennings, 55 O. G. 141, C. D. 1891.

60. The petition of a third party to be admitted as a party defendant in a suit for infringement, alleging that the petitioner makes and sells machines which he is informed the complainant claims are an infringement of the patent upon which suit is brought, and alleging that the petitioner is informed that the complainant intends, if successful in that case, to sue the petitioner on the use of machines made by petitioner, but not stating or claiming that the machines which petitioner makes are identical in structure or mode of operation with the machines made by defendant, and not stating any fact showing that petitioner is in privity in any way with the defendant, *denied*. The granting of such a petition would, in effect, be to hold that the complainant must join in the same suit all persons who have infringed the patent in question, whether acting together or not. *Thomson-Houston Electric Co. v. Sperry Electric Co., 57 O. G. 275, C. D. 1891.

61. The owner of a patent, pending a suit for damages for infringement of it, assigns his interest, reserving back damages. Upon motion by the assignee for leave to file a supplemental bill, *held*, there being no proof or claim of infringement subsequent to the assignment, the assignee should not be joined as complainant. *New York Belting and Packing Co. v. New Jersey Car-Spring and Rubber Co., 57 O. G. 1888, C. D. 1891.

62. A corporation, owner by assignment of certain patent-rights, licensed another corporation exclusive rights to sell within limited territory. In an action brought by the licensee against another corporation infringing its territorial rights, *held*, that the licensee has, *prima facie*, implied power to join the licensor corporation, even against its will and although it appears that the infringing corporation holds a controlling interest of the stock of the licensor. *Brush-Swan Electric Light Co. v. Thomson-Houston Electric Co., 58 O. G. 807, C. D. 1892.

63. The holder of a specified territorial right in a patent, either as licensee or assignee, is not a necessary party complainant to a suit for infringement outside his own territory. *Canton Steel Roofing Co. v. Kanneberg, 61 O. G. 424, C. D. 1892.

64. A joint suit for infringement of a patent cannot be maintained by the patentee and the licensee whose license conveys no exclusive monopoly. *Blair v. Lippincott Gas Co., 61 O. G. 1792, C. D. 1892.

65. A license to manufacture lime-glass chimneys under a patent granted by the patentee with others does not estop the licensee from objecting that such other parties cannot be joined with the patentee in an action against the licensee for infringement by manufacturing lead-glass chimneys without a license. *Id.

66. A licensee may prosecute suit for infringement of a patent in his own name where the defendant is the owner of the legal title to the patent. (Citing Littlefield v. Perry, 7 O. G. 964, 21 Wall. 205.) *Adriance, Platt & Co. v. McCormick Harvesting Machine Co., 63 O. G. 1688, C. D. 1893.

67. A licensee who has the exclusive right to manufacture and sell a patented article can maintain a suit in equity against the patentee, if the latter is guilty of an infringement by making and selling himself, to redress the wrong occasioned thereby, and such suit arises under the patent laws of the United States. *Waterman v. Shipman, 64 O. G. 718, C. D. 1893.

68. Courts of the United States are bound to take notice of the persons who occupy the positions of heads of departments, etc., including that of the patent office. The commissioner made a party defendant in this suit having been succeeded in that office by another person, no decree made against him would bind the pres-

ent incumbent of the office. *Backus Portable Steam Heater Co. v. Commissioner of Patents, 66 O. G. 1893, C. D. 1894.

69. Where there are adverse parties the commissioner of patents is not a necessary party to and cannot be joined in a suit under section 4915, Revised Statutes of the United States. *Mergenthaler Linotype Co. v. Commissioner of Patents, 66 O. G. 1311, C. D. 1894.

70. Where the infringing device was the property of the United States and held and used by them for the public benefit through officers, the United States were an indispensable party to the suit to enable the court to grant the relief sought. *Belknap v. Schild, 74 O. G. 1121, C. D. 1896.

71. All parties interested in the subject-matter or issue of the suit must be made parties thereto; but employees receiving in return for their services fixed salaries are not such parties. Every agent, however, who performs acts of infringement and all officers who in the prosecution of business authorize said acts are responsible and should be enjoined. *Matthews & Willard Mfg. Co. v. Trenton Lamp Co., 75 O. G. 674, C. D. 1896.

72. It is not necessary that a person should appear upon the record as a technical party to the proceedings in order to be bound by a judgment. If he be a substantial party he will be bound by the finding in the case. *Drawbaugh v. Seymour, Com'r of Patents, 77 O. G. 313, C. D. 1896.

73. A mere licensee has no authority to sue infringers in his own name. *Chauche v. Pare, 77 O. G. 1123, C. D. 1896.

VII. Delay in Bringing.

74. Demurrer to an equity action for infringement of a patent which expired three weeks after the commencement of the action, not sustained. *Kittle v. De Graaf, 30 Fed. Rep. 689 (1887).

75. In an action for infringement of letters patent, where it is shown that defendants took a license from plaintiff to make and vend the patent, and subsequently denied plaintiff's rights and claimed to make under another patent; that shortly after such denial plaintiff became bankrupt and the assignee in bankruptcy sold the patent after two years; that plaintiff entered into negotiations to get the patent back from the vendee; that, though the vendee took no steps to prevent the patent being plundered, plaintiff gave defendants notice he intended to hold them accountable for their infringements; that after his discharge from bankruptcy, and when he had re-acquired the patent, plaintiff commenced action against defendants for infringement, the court sitting in equity will, considering all the circumstances, take jurisdiction of the cause, notwithstanding a delay of about seven years in the prosecution by plaintiff of his rights. *Kittle v. Hall, 39 O. G. 707, C. D. 1887.

76. The objection that the applicant failed to prosecute his application for a patent within two years after the last action thereon, of which notice was given (section 4894), applies to a suit in equity for a patent under section 4915. *Gandy v. Marble, 39 O. G. 1423, C. D. 1887.

77. Such a suit is in fact and necessarily a part of the application for the patent, and is to be governed by the rule as to laches and delay declared by section 4894 to be attendant upon an application. *Id.

78. In such a suit it may be shown to the satisfaction of the court that the delay in the prosecution of the application was unavoidable in support of an allegation to that effect in the bill. *Id.

79. Where an invention was assigned to the complainant in the year 1869, and shortly thereafter the defendant alleged to the complainant that the embodiment of it (said invention) in a working machine proved it to be impracticable and unsatisfactory, and where the complainant, by reason of the representations of the defendant, was led to believe that said invention had been abandoned and thrown aside, and, relying upon said representations, rested for a period of nineteen years before asserting his rights in and to said invention, having only a short time before asserting said rights become aware of the fact that said assigned invention had not been abandoned, but that it was in fact the same in principle and mode of operation as an invention at that time alleged by the defendant to be a practical one, a court in equity will consider that the complainant had a right to rely on the statements of the defendant, and that in such a case no laches could be attributed to him. *Wilson v. Keely, 43 O. G. 511, C. D. 1888.

80. While there was such delay in bringing suit as to preclude recovery of damages for prior infringement, there was neither conduct nor negligence which could be held to destroy the right to prevention of further injury. *Menendez v. Holt, 46 O. G. 971, C. D. 1889.

81. Equity will not entertain a bill for in-

fringement of letters patent which expired between the date of service and the return day, there being no special case made by the bill showing that an injunction was part of the remedy to which the complainant would be entitled by reason of special facts alleged. *American Cable Ry. Co. v. Chicago City Ry. Co., 52 O. G. 1666, C. D. 1890.

82. The defendants were notified to desist from infringement about eight months after knowledge thereof came to the plaintiff, and suit was begun within four months thereafter. *Held*, that under the circumstances the delay did not constitute laches. *Loring v. Booth, 61 O. G. 1483, C. D. 1892.

83. A party who has used a patented structure openly for a period of eleven years with the full knowledge of the patentee and without objection from him cannot be held an infringer. (Cases cited.) *Edison Electric Light Co. v. Equitable Life Assurance Society, 55 Fed. Rep. 478 (1893).

84. Where the complainant claimed to have disclosed his process to the defendant on the promise that no use would be made of it without his consent, and the bill seeking relief thereon was not filed until some fourteen or fifteen years later, *held*, that this lapse of time not only constitutes a bar such as the statute of limitations interposes, but shows such laches as will clearly preclude any right of relief. *Leggett v. Standard Oil Co., 63 O. G. 1201, C. D. 1893.

85. Poverty or pecuniary embarrassment of a party is not a sufficient excuse for postponing the assertion of his rights. (Hayward v. National Bank, 96 U. S. 611, 618.) *Id.

86. Where the facts in the case are such as are above stated, and it further appears that the patentee permitted a period of twelve years to elapse before he resorted to his remedy in court, *held* that, in the absence of any excuse for such laches, except that he preferred to receive a salary from his employer rather than to demand a royalty, the patentee is entitled to a less favorable consideration by a court of equity than if his conduct had been that of mere inaction. *Lane & Bodley Co. v. Locke, 65 O. G. 1406, C. D. 1893.

87. Complainant and its predecessors knew of the alleged infringement and acquiesced in it for a period of fourteen years. The acquiescence of the former owners has equally the same effect upon complainant's rights as its own subsequent neglect. (Cases cited.) *Held*, the bill should be dismissed for inexcusable laches. (Cases cited.) *Woodmanse & Hewitt Mfg. Co. v. Williams, 68 Fed. Rep. 489 (1895).

88. Letters Patent Nos. 133,898, 137,495, 154,770 and 158,992, to George T. Smith for middlings purifiers, having expired prior to the commencement of the suit, afford no basis for equitable relief. *Russell v. Kern, 72 O. G. 590, C. D. 1895.

89. Letters Patent No. 164,050, granted June 1, 1875, to George T. Smith, for middlings purifier, having expired after the filing of the original bill, but before the return day of the subpœna, it was within the discretion of the court to dismiss the bill for want of equity. *Id.

90. Mere delay in prosecuting infringers, unaccompanied by circumstances amounting to equitable estoppel, will not prevent a patent owner from maintaining suits for equitable relief. *Taylor v. Sawyer Spindle Co., 77 O. G. 452, C. D. 1896.

91. The mere fact of even long-continued infringement without protest on the part of complainant does not of itself constitute such laches as should defeat a recovery. *Imperial Chemical Mfg. Co. v. Stein, 78 O. G. 635, C. D. 1896.

92. The fact that the composition of the infringing article could not readily be determined, that its trade-name gave no indication of its composition, and that there were many other articles of the same class upon the market are to be considered in determining laches. *Id.

93. Notice of infringement was given in 1883, but suit was not begun until 1893. Even before 1883 the owners of the patent had acquiesced in its infringement. A most flagrant case of laches is presented, and the action cannot be maintained. (Cases cited.) *Richardson v. D. M. Osborne & Co., 82 Fed. Rep. 95, 80 O. G. 812, C. D. 1897.

VIII. Costs of.

94. In the second circuit a docket-fee of twenty dollars is not taxable for defendant when the bill is dismissed by complainant after joinder of issue on the pleadings and notice by the defendant for final hearing and a call upon the calendar. *Ryan v. Gould, 41 O. G. 1892, C. D. 1887.

95. On such dismissal the defendant cannot tax for certified copies of the file-wrapper and contents of the patent in suit or for certified copies of other patents essential to the defense. *Id.

96. Where a party to a suit incumbers the printed record with copies of some fifty imma-

terial patents, *held*, it is a proper case for the application of the tenth rule, which authorizes the court (paragraph 9) to impose costs upon the party so guilty. (Railway Co. v. Stewart, 95 U. S. 279, 284). *Ball and Socket Fastener Co. v. Kraetzer, 65 O. G. 1591, C. D. 1893.

97. When it appeared that so much irrelevant testimony was introduced into the case as to make it inequitable that defendant should pay costs, *held*, that costs should not be paid by defendant in the appellate court nor costs in the circuit court which were caused by this class of evidence. *Appleton v. Ecaubert, 71 O. G. 1617, C. D. 1895.

98. Where two patents relating to the same subject-matter were sued on in the same suit and a decree was entered for complainant on one of them and for defendant in respect to the other, the costs disbursed in regard to the patent adjudged against the complainant were not, under the circumstances, adjudged in favor of either party. *Green v. City of Lynn, 80 O. G. 1480, C. D. 1897.

SUPPLEMENTAL BILL.

(See EQUITY — BILLS.

SUPPLEMENTAL OATH.

(See OATH)

SUPREME COURT OF THE UNITED STATES.

(See JURISDICTION.)

TECHNICAL TERMS.

1. The words "means," "mechanism" and "connections" are proper terms when applied to devices forming no part of the invention, but which are in common use in various kinds of machinery — for instance, when the operation of rollers is governed by gearing, belting, cranks or other appliances which in themselves are simple and have little or nothing to do with the real invention. Or, as in the present case, the term "means," when applied to the operation or shaking of certain movable screens, is proper, because evidently the same movement of the screen can be effected by an infinite variety of mechanism which would produce the same result and be simply the equivalent of that employed by applicant. Ex parte Stoughton, 43 O. G. 1345, C. D. 1888.

2. The term "mechanism" is not permissible when applied to various and different devices in the several claims which are not adjunctive devices. Ex parte Stanbridge, 43 O. G. 1345, C. D. 1888.

3. The words "carbonaceous anode" in claim 2 cover both anodes made partly of and wholly of carbon. *Pittsburgh Reduction Co. v. Cowles Electric Smelting and Aluminum Co., 69 O. G. 789, C. D. 1894.

4. The word "automatically" in the patent claim is to be given its ordinary and general meaning as used in common speech. It does not apply to a case where a man of his own volition acts upon one mechanical part by means of another. *Gould Coupler Co. v. Trojan Car Coupler Co., 74 Fed. Rep. 794 (1896).

5. By a "detachable clip" is meant a removable clip, or one which is not positively attached by riveting or soldering. It is an attachment which accomplishes connection without creating union. *Bennett v. Schooley, 76 O. G. 335, C. D. 1896.

TESTIMONY.

(See WITNESSES — INTERFERENCE, TESTIMONY; EQUITY, MASTER'S REPORT; EVIDENCE; INFRINGEMENT; INJUNCTION; INTERFERENCE.)

I. IN A FOREIGN COUNTRY.
II. IN A FOREIGN LANGUAGE.
III. OF EXPERTS.
IV. PRINTING.

I. IN A FOREIGN COUNTRY.

1. Testimony cannot properly be taken in foreign countries otherwise than as prescribed by rule 158 (3) unless this procedure be waived *by stipulation of the parties.* [Rule 158 (5.)] Raffard v. De Ferranti, 60 O. G. 439, C. D. 1892.

2. Where a party seeks to take testimony abroad under the provisions of rule 158, a mere formal allegation in his affidavit that the testimony cannot be taken in this country without "injury to the moving party greatly exceeding that to which the opposite party will be exposed by the taking of such testimony abroad" is not sufficient to satisfy the requirements of the rule in that particular. Hall v. Latta, 60 O. G. 736, C. D. 1892.

3. In order to constitute a proper foundation for taking testimony in a foreign country, a publication must disclose the invention in controversy and must disclose it as the invention of the party seeking to take such testimony. Parkin and Wright v. Jenness, 63 O. G. 759, C. D. 1893.

4. Testimony cannot be taken to prove conception, disclosure and reduction abroad, but may be to prove knowledge of introduction into this country. Hadfield v. Washburn, 61 MS. D., March, 1897 (Fisher, Ass't Com'r).

5. Testimony cannot be taken as to matters which took place in a foreign country tending to prove priority; but the question of originality stands on a different footing. (Parkin and Wright v. Jenness, 63 O. G. 759.) Shiels v. Lawrence and Kennedy, 81 O. G. 2085, C. D. 1897.

6. Although a party may not be able to prove priority of invention in this country by reason of the fact, appearing from his preliminary statement that he was not the first to introduce the invention into this country, *held*, that he may nevertheless establish that his opponent is not entitled to an award of priority by proving that such opponent is not an original inventor, but received a disclosure of it from him. Id.

7. Judgment of priority may properly be rendered on the record under these circumstances; but where afterward a reasonable suggestion is made that the successful party received a disclosure of the invention from his opponent, *held*, that the judgment should be vacated as to matters relating to originality and times set for taking testimony on this question. Id.

II. In a Foreign Language.

8. Testimony given by a witness in a foreign language, and translated into English by an interpreter who was not sworn, *held* admissible. When a commissioner understands the language of a witness who cannot speak English, he may translate the witness' answers and write them down. (Authorities cited.) Rothe v. Meyer, v. Foulds, 63 MS. D., Dec., 1897 (Greeley, Acting Com'r).

III. Of Experts.

9. Where expert testimony does not seem necessary to the court, it can proceed to determine the question of infringement without its aid. *Sugar Apparatus Mfg. Co. v. Yaryan Mfg. Co., 53 O. G. 920, C. D. 1890.

10. Where in a suit for infringement it appeared that one of the defendants, who was conversant with the art, had made application for a patent for evaporating apparatus, which was rejected on said patent in suit, and thereupon amended his application to avoid said patent, *held*, that his admissions in the patent office should be regarded as the expressions of a competent expert and as evidence in support of the validity of the patent in suit. *Id.

11. On 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. *American Linoleum Mfg. Co. v. Nairn Linoleum Co., 55 O. G. 142, C. D. 1891.

12. Persons skilled in the art to which the specification is addressed are those of ordinary and fair information, but not those having very great technical knowledge relating to the subject-matter of the invention. *Tannage Patent Co. v. Zahn, 71 O. G. 1161, C. D. 1895.

13. The testimony of a witness can be taken abroad, as an expert, only in very unusual cases, in which the most satisfactory and convincing showing has been made, and in which it also appears that no competent expert can be gotten in this country. McDonough v. Joly, 61 MS. D., April, 1897 (Fisher, Ass't Com'r).

IV. Printing.

14. Rule 162, requiring printed copies of the testimony to be furnished to the office and opposing parties, *held* to be of binding authority. Plummer v. Penniston, 67 O. G. 928, C. D. 1894.

TRADE-MARKS.

I. Alternatives.
II. Anticipation.
III. Arbitrary.
IV. Arbitrary — Descriptive.
V. Assignment.
VI. Class of Goods.
VII. Coats of Arms, Society Emblems and Symbols.
VIII. Descriptive.
IX. Division of Application.
X. Drawings or Fac-similes.
XI. Equity.
XII. Essential Features.

XIII. EVIDENCE.
XIV. FEES.
XV. FEE, REFUNDMENT OF.
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XVII. FOREIGN COMMERCE.
XVIII. FOREIGN WORDS.
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(a) *In General.*
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XXXII. RIGHT TO USE NAME OF PATENTED ARTICLES.
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XXXV. TREATY.
XXXVI. USE AND SALE AS ESTABLISHING TITLE.
XXXVII. WHAT CONSTITUTES.
XXXVIII. WITNESSES.

I. ALTERNATIVES (OR EQUIVALENTS).

1. A trade-mark must be definitely described in the statement and the essentials given. Symbols that are not alternatives in fact cannot be allowed registration. The letters "O C" and "O A" and "O E C" for copper ingots cannot be registered for alternative use. Ex parte Orford Copper Co., 36 MS. D., March, 1888 (Hall, Com'r).

2. The word "Crucible" and the representation of a crucible, *held* not true alternatives. Ex parte The Iowa Farming Tool Co., 51 MS. D., Aug., 1892 (Frothingham, Acting Com'r).

3. The word "Phœnix" and the representation of a phœnix, as a trade-mark for candles, etc., refused on the ground that they are not true alternatives. Ex parte Phœnix Candle Co., 53 MS. D., Aug., 1893 (Fisher, Acting Com'r).

4. The words "White Lily" and the representation of a white lily, as a trade-mark for gin, *held* not registrable because not true alternatives. Ex parte Richards & Sons, 54 MS. D., May 18, 1894 (Fisher, Ass't Com'r).

5. The symbol eagle and word "Eagle," for slates, allowed registration as alternatives. Ex parte Pritchard, 57 MS. D., Aug., 1895 (Fisher, Acting Com'r).

6. The word "Squirrel" and figure of a squirrel, for ammunition, *held* not true alternatives. Ex parte Fowler, 59 MS. D., June, 1896 (Fisher, Acting Com'r).

7. The word "Star" and the symbol of a star adopted and used during many years by manufacturers of shirts, waists, underwear and furnishing goods to mark and designate their goods, in combination with the words "Star Shirts" and other words describing the articles, so that the goods become well known by such mark and by the designation of "Star Goods," constitute a valid trade-mark. *Hutchinson v. Blumberg, 61 O. G. 1017, C. D. 1892.

(The words "The Star Shirt" and the figure of a star were registered and used as alternative marks (for shirts), and so regarded by the court in Morrison v. Case, 2 O. G. 544, C. D. 1872.

See decision in *Hutchinson v. Covert, 50 Fed. Rep. 832.)

8. The application was for registration of the word "Squirrel" and the representation of a squirrel. A word and a picture which are true alternatives and invariably express the same idea may be covered by one trade-mark registration; but the rule will not cover the case of a word and a picture capable of such a variety of modifications that two of them might appear as substantially different things to an ordinary purchaser. Ex parte Adam Roth Grocery Co., 62 O. G. 315, C. D. 1893.

9. The word "Crescent" and the representation of a crescent-shaped figure refused registration on the ground that they are not true alternatives. Ex parte Lazarus, Schwarz and Lipper, 64 O. G. 1396, C. D. 1893.

10. The representation of a rosebud and the word "Rosebud" are registrable in one application, it appearing that the trade-mark is a lawful common-law mark and the prescribed statutory requisites are present. Ex parte Kinney, 72 O. G. 1349, C. D. 1895.

11. The figure of Columbia cannot be regarded as more than a mere amplification of the word "Columbia" which had been previously appropriated. It conveys no further or other idea than the word and can be regarded

only as a different way of expressing it. *Morgau Envelope Co. v. Walton, 81 O. G. 1615, C. D. 1897.

12. The red cross speaks to the eye, and the article becomiug knowu by that designation speaks also by that name to the ear. (Cases cited.) *Johnson & Johnson v. Bauer & Black, 82 Fed. Rep. 662 (1897). (Reverses former decision.)

II. Anticipation.

(See Class of Goods — Registration.)

13. The word "Magnolia" and the representation of the flower of that name, for flour, refused on registered mark "Magnolia Mills" in connection with the flower. Ex parte Camp, 35 MS. D., Sept., 1887 (Vance, Actiug Com'r).

14. The words "Rough on Dinner," for "Medicinal Bitters," *held* anticipated by registered mark "Rough on," for proprietary remedies and compounds. Ex parte Knight, 38 MS. D., Oct., 1888 (Hall, Com'r).

15. The letter "G" with the word "Anti" printed upon it is anticipated by the same letter bearing the word "Big." Ex parte Klyce, 40 MS. D., May, 1889 (Fisher, Ass't Com'r).

16. "Royal," for chocolate, *held* anticipated by "Royal Dutch," previously registered. Ex parte Hillyard, 41 MS. D., Nov., 1889 (Fisher, Ass't Com'r).

17. "Medical Lake Salt," *held* substantially the same as the trade-mark "Medical Lake," to which another party had a prior right. Ex parte Hall, 48 MS. D. (3 G. W. D.), Nov., 1891 (Frothingham, Ass't Com'r).

18. Registration of the words "White Lillie" refused in view of registration of the same words under the act of 1870, no abandonment having been proved. Ex parte Empire Mill Co., 49 MS. D. (3 G. W. D.), Dec., 1891 (Frothiugham, Ass't Com'r).

19. After the registration of a trade-mark for an article a second trade-mark should not be registered for merchandise of substantially the same descriptive properties. Ex parte Kyle & Co., 57 O. G. 274, C. D. 1891.

20. The pictorial representation of a beaver, for "mixed paints and roofing composition," is anticipated by the same mark registered for "roofing composition or materials." Ex parte Beaver Mfg. Co., 50 MS. D., June, 1892 (Frothingham, Ass't Com'r).

21. Registration of the word "Yucca," arranged over a representation of the Yucca plant — for soap — refused in view of registered mark consistiug of a representation of the same plaut. Ex parte Bogardus, 50 MS. D., March, 1892 (Frothingham, Ass't Com'r).

22. The question presented in a case of alleged anticipation is whether the trade-mark sought to be registered is so similar to any mark already registered for use on the same class of articles as to be calculated to work deception upon a purchaser using ordinary caution. (See Ex parte Coon, 58 O. G. 946; McLean v. Fleming, 13 O. G. 913.) Ex parte George B. Hurd, 59 O. G. 1763, C. D. 1892.

23. "Splendid" *held* anticipated by "Esplendido," already registered for the same goods (flour); also, descriptive. Ex parte Stokes, 52 MS. D., June, 1893 (Fisher, Ass't Com'r).

24. The words "Monarch Distilling Co.," inclosed between "concentric circles of broken lines and surrounded by a circle of radiating scrolls," *held* anticipated by the registered mark "M. V. Monarch." Ex parte Corning & Co., 53 MS. D., Sept., 1893 (Fisher, Acting Com'r).

25. Application for the registration of the word "M. V. Monarch" refused on a prior trade-mark, "Monarch Distilling Co.," used upou the same class of merchandise. Ex parte Corning & Co., 65 O. G. 751, C. D. 1893.

26. The representation of the human eye and the letter "C," as a trade-mark for optical goods, *held* anticipated by the previously registered mark composed of the letters "I," "C." Ex parte Short, Nerney & Co., 54 MS. D., May, 1894 (Fisher, Ass't Com'r).

27. "Antalgia," as a trade-mark for medicines, anticipated by "Antialgia." Ex parte Heyer, 54 MS. D., April, 1894 (Fisher, Ass't Com'r).

28. The word "Capitol," and the words "Capital Coffee" with a group of flags before and after the latter, *held* to be essentially the same mark. Dissolution of interference denied. Lown v. The Ohio Coffee & Spice Co., 57 MS. D., Aug., 1895 (Fisher, Acting Com'r).

29. "Queen Bess," for flour, *held* anticipated by "Queen Bee." Ex parte Blanton Milling Co., 57 MS. D., Aug., 1895 (Fisher, Acting Com'r).

30. The head of an Indian and the words "North America" refused registration on the ground that the words are geographical, and the head had been anticipated. Ex parte Spencer, 57 MS. D., Sept., 1895 (Fisher, Acting Com'r).

31. A representation of a right hand in horizontal position, as a trade-mark for foot-wear, *held* anticipated by the represeutation of a left-hand in the vertical position. Ex parte Foot, Schulze & Co., 58 MS. D., Jan., 1896 (Fisher, Ass't Com'r).

32. "Gold Leaf," as a trade-mark for baking powder, anticipated by the words "Silver Leaf," and a picture of a leaf used for the same class of goods. Ex parte Gold Leaf Baking Powder Co., 58 MS. D., Jan., 1896 (Fisher, Ass't Com'r).

33. Registration of a star, for safety razors, refused in view of registration of the same mark in 1876 for cutlery, and lack of proof that such razors were not then and are not still manufactured and sold. Ex parte Kampfe, 58 MS. D., 306, Feb., 1896 (Fisher, Ass't Com'r).

34. "Emmet's Faultless," *held* anticipated by "Emmet's Professional," for mouth harmonicas. Ex parte Strauss, Sachs & Co., 58 MS. D., Feb., 1896 (Fisher, Ass't Com'r).

35. "Black diamond," as a trade-mark for blasting powder, *held* not registrable, because "Black" is descriptive and "Diamond" was already registered. Ex parte The New York Powder Co., 59 MS. D., June, 1896 (Fisher, Acting Com'r).

36. Registration of two circles or rings inclosing full-face bust portraits of the registrants (with other adjuncts), refused, on reference to registered mark of Smith Bros., No. 20,907. Ex parte Smith & Son, 59 MS. D., July, 1896 (Fisher, Acting Com'r).

37. "Armor clad," for leather shoes, refused registratiou in view of "Iron clad" previously used. Ex parte Cammeyer, 60 MS. D., 454, Jan., 1897 (Fisher, Ass't Com'r).

38. Registration of the word "Crown" and figure of a crown refused in view of a reference consisting of a garter of an oval form with a crown in the upper or center portion, since the crown in the reference could not be regarded as the non-salient feature. Ex parte Christine Baumert, 62 MS. D., July, 1897 (Greeley, Ass't Com'r).

39. The cheese to which the mark is applied would probably be known to the ordinary class of purchasers as the "crown brand." The crown is prominent, also claimed as an essential feature. Id.

40. "Brilhaute," for flour, *held* anticipated by "Brilliant," previously registered. Ex parte Lindsay, 60 MS. D., Sept., 1897 (Fisher, Acting Com'r).

III. Arbitrary.

41. A glove and the letters K. L. printed thereon, between which letters is arranged a circle exterior to a triangle, inclosing the word "of," *held* to be registrable, since the letters had no absolute or invariable significance, and the other elements had a due share of importance. Ex parte Turner, 34 MS. D., July, 1887 (Hall, Com'r).

42. The pictorial representation of "St. Nicholas" for tobacco, *held* registrable, although the words "St. Nicholas" had been registered. Ex parte The Pemberton & Hill Tobacco Mfg. Co., 36 MS. D., Dec., 1887 (Vance, Ass't Com'r).

43. The words "Jefferson Club" and a medallion picture of Thomas Jefferson, for liquors, *held* not anticipated by the registered mark "Jefferson Pure Old Rye Whiskey." Ex parte Magruder, 37 MS. D., July, 1888 (Hall, Com'r).

44. A heraldic eagle on a quadrilateral field and having on its breast an oblong figure bearing the word "Von Graef," for a cough remedy, *held* not anticipated by a fanciful crowned eagle and the words "Dr. Aug. Keyser's Celebrated German Elixir." Ex parte Jones, 38 MS. D., Aug., 1888 (Hall, Com'r).

45. "Kelphaline," for a remedy for neuralgia and headache, allowed registration over "Cephaline." Ex parte Baldwin, 38 MS. D., Oct., 1888 (Hall, Com'r).

46. A mark consisting of a block of compressed meat resting upon a plate, *held* not anticipated by a registered mark consisting of a block of meat having several slices cut off from it aud resting on a plate together with a knife and fork, an empty can and a filled can, all placed upon a table. Ex parte Armour Packing Co., 40 MS. D., May, 1889 (Fisher, Ass't Com'r).

47. A representation of a wagon-brake lock attached to a panel of a wagon-body, and a whip-socket and whip therein, *held* registrable for a wagon-brake lock. Ex parte Hurlburt Mfg. Co., 41 MS. D., Nov., 1889 (Mitchell, Com'r).

48. "Silk," as a trade-mark for soap and soap powders, may be registered. Ex parte Ross, 44 MS. D. (2 G. W. D.), July, 1890 (Fisher, Acting Com'r).

49. The word "Hygieniques" as applied to suspenders, *held* to be a valid trade-mark. †Bailey v. Nashawannuck Mfg. Co., 51 O. G. 970, C. D. 1890.

50. The words "Warren Hose-Supporter"

in connection with the cut of a hose-supporter engaged with a stocking, *held* to be a valid trade-mark. *Frost v. Rindskopf, 51 O. G. 1131, C. D. 1890.

51. The word "Cream" in connection with the words "Baking Powder," *held* a valid trade-mark. Price Baking Powder v. Fyfe, 45 Fed. Rep. 799 (1891).

52. The word "Magico" *held* not anticipated by the word "Magic" already registered for use on a similar class of goods. Ex parte American Chemical Co., 62 O. G. 588, C. D. 1893.

53. The combined words "Fibre Chamois," as applied to a fabric used as an interlining for women's dresses, *held* to have a significance as an arbitrary mark and name, whereby the goods made by complainant are identified and distinguished in the trade as carried on. *American Fibre Chamois Co. v. De Lee & Dernberg, 71 O. G. 1458, C. D. 1895.

54. "A series of stripes having contrasting colors," applied to wheel tires, *held* sufficiently definite to be registered. Ex parte Humber & Co., America, Limited, 59 MS. D., June, 1896 (Fisher, Acting Com'r).

55. "Imperceptible," for a starch, *held* not descriptive. Ex parte Durkee & Co., 62 MS. D., July, 1897 (Greeley, Ass't Com'r).

56. Registration of the British pound mark, accompanied by the word "Sterling," allowed, although the latter had been previously used, it appearing the pound mark was the most prominent feature and would attract the attention of the ordinary purchaser. Ex parte Hall, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

IV. Arbitrary — Descriptive.

57. "Honey," for a vermifuge, was declared by the examiner to be a well-known vehicle for medicines which the public have a right to use; but decision was reversed. Ex parte Mansfield & Co., 35 MS. D., Oct., 1887 (Vance, Ass't Com'r).

58. *Held*, that the word "Lightning" is not merely descriptive of the quality or characteristic of a knife to which it was applied. *Hiram Holt Co. v. Wadsworth, 41 Fed. Rep. 34, C. D. 1889.

59. "Handy," as applied to a vehicle, *held* not equivalent to "convenient" and hence not merely descriptive. Ex parte Bradley & Co., 41 MS. D., Aug., 1889 (Fisher, Acting Com'r).

60. "Ginger Champagne" *held* registrable for carbonated mineral water and ginger, "upon the benefit of a doubt." Ex parte Manitou Mineral Water Co., 44 MS. D., 2 G. W. D., Sept., 1890 (Mitchell, Com'r).

61. The words "Cough Cherries," as applied to a confection, are not descriptive of the qualities of the article, but are sufficiently arbitrary and fanciful to be appropriated as a trade-mark. *Stoughton v. Woodard, 50 O. G. 1297, C. D. 1890.

62. "O. K.," applied to root-beer, deemed "sufficiently arbitrary and fanciful" to warrant registration. Ex parte Heinle & Co., 57 MS. D., Sept., 1895 (Fisher, Acting Com'r).

63. "Better than Best," as a trade-mark for flour, *held* to be but partially descriptive, and sufficiently fanciful and arbitrary to be registrable. Ex parte Smith, 58 MS. D., Dec., 1895 (Fisher, Ass't Com'r).

64. The word "Royal" as a trade-mark for a baking powder is not descriptive of the latter. As conveying the idea of comparative excellence, it does so only through a metaphor which is in a high degree fanciful and remote. *Royal Baking Powder Co. v. Raymond, 70 Fed. Rep. 376 (1895).

65. The name "Momaja" is suggestive of a composition of Mocha, Maracaibo, and Java coffees, but is not sufficiently descriptive to invalidate it as a trade-mark. *American Grocery Co. v. Bennett, Sloan & Co., 71 O. G. 1770, C. D. 1895.

66. "Club Cocktails" allowed registration for spirituous beverages. Ex parte Heublein & Bro., 59 MS. D., May, 1896 (Seymour, Com'r).

67. If a word is merely suggestive or is figurative only it may be a good trade-mark, notwithstanding it is also indirectly or remotely descriptive. *Bennett v. McKinley, 65 Fed. Rep. 505 (1894).

68. The word "Kaiser" held not descriptive but a valid trade-mark. *J. M. P. Baltz Brewing Co. v. Kaiser Brauerie, Beck & Co., 74 Fed. Rep. 222 (1896).

69. "Cream of Wheat," applied to "breakfast foods," *held* registrable over the same words applied to flour, and also fanciful rather than necessarily descriptive. (Practically reversing decision in North Dakota Mills Co., 58 MS. D. 176.) Ex parte Cream of Wheat Co., 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

70. The word "Saponifier" *held* not descriptive, although its Latin derivation is suggestive. To the uneducated part of the community it would have no especial signification. Even if it suggested the ordinary chemical action of lye upon grease, such suggestiveness would not

be fatal. (Quoting "The Cottolene" Case, Fairbanks v. Central Lard Co., 64 Fed. Rep. 133.) *Pennsylvania Salt Mfg. Co. v. Myers, 79 Fed. Rep. 87 (1897).

(This case also involved fraudulent use of the mark.)

V. Assignment.

(See Good Will.)

71. It is well established that a person may associate his own name as a trade-mark with an article of trade manufactured by himself, and so transfer the business of manufacturing said article and using his name thereon as to deprive himself of the right thereafter to use his own name upon such articles. Richmond v. The Dr. S. A. Richmond Nervine Co., 52 O. G. 307, C. D. 1890.

72. The right of the owner of a trade-mark to assign the same to a partner or to a successor in business as an incident to its good will, affirmed. *Brown Chemical Co. v. Meyer, 55 O. G. 287, C. D. 1891.

73. Where one who claims to have invented or discovered a new means for treating disease transfers for a consideration all his rights therein to a corporation and afterwards acquiesces in the use of a certain trade-mark thereon by the corporation, *held*, in a subsequent contest between himself and the corporation over title to the trade-mark, that an absolute right is vested in the corporation. Sanche v. Electrolibration Co., 60 O. G. 1189, C. D. 1892.

74. Where parties entered into an agreement defining the right of each to use a trade-mark, such an agreement is not an attempt to transfer or license the use of a trade-mark, or any rights therein, or in any word thereof, but fixes and defines the existing trade-mark of each party to the agreement, and is not required to be recorded in the patent office under section 12 of the trade-mark act of 1881. *Waukesha Hygeia Mineral Springs Co. v. Hygeia Sparkling Distilled Water Co., 70 O. G. 1319, C. D. 1895.

(A trade-mark requires to be inventoried to pass in a general assignment in insolvency. *Bradley v. Norton, Cox's American Trade-mark Cases, 333.)

VI. Class of Goods.

(See Anticipation.)

75. The representation of a "Star" as a trade-mark for safety razors, *held* anticipated by the same mark used for cutlery in general. Ex parte Kampfe Bros., 58 MS. D., Feb., 1890 (Fisher, Ass't Com'r).

76. "Hopkins" (with certain minor accessories), applied to canned hulled corn or steamed hominy, *held* not anticipated by the same word registered for flour. Ex parte The Western New York Preserving and Mfg. Co., 59 MS. D., June, 1896 (Fisher, Acting Com'r).

77. The word "Diamond" applied to a dry paste and the same word to a semi-liquid mucilage, *held* same class of goods. Diamond Ink Co. v. Day, 60 MS. D., Oct., 1896 (Fisher, Ass't Com'r).

78. "Electric Light" for flour, and the same words for flour sacks, *held* not properly in interference, because not applied to similar goods. Arkell and Smith v. Kirby, v. McLaughlin & Co., v. Johnston, 60 MS. D., Oct., 1896 (Fisher, Acting Com'r).

79. "Kangaroo," for rubber tubing and tires, not barred by prior registration of the same word for velocipedes. Ex parte Consolidated Rubber Works, 62 MS. D., Oct., 1897 (Greeley, Acting Com'r).

80. "Cream of Wheat" applied to "breakfast foods," *held* registrable over the same words applied to flour. Ex parte Cream of Wheat Co., 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

VII. Coats of Arms, Society Emblems and Symbols.

81. A trade-mark adopted by a manufacturer or dealer in distilled spirits at Milwaukee, Wisconsin, in commerce with Germany, which contains the legends "Knights of Labor Whiskey" and "K. of L. Distillery, Sour Mash," and which clearly and distinctly refers the origin and ownership of the spirits so marked to the Knights of Labor of the United States, so that the public would be induced to purchase under the belief that they were manufactured by or under the auspices of that association, and therefore possessed the excellence or superior qualities usually characterizing the productions or workmanship of artisans, workmen, etc., belonging to that association, and also from sympathy with its sentiments and principles, is fraudulent and unlawful, and must be denied registry. Ex parte M. Bloch & Co., 40 O. G. 443, C. D. 1887.

82. A trade-mark, for writing paper, composed of the badge of the Grand Army of the Republic (the letters G. A. R. being a watermark), allowed registration upon the "benefit of a doubt." Ex parte King, 39 MS. D., Dec., 1888 (Hall, Com'r).

83. A red Greek cross with or without the words "Red Cross," *held* not registrable, irrespective of the question whether the Red Cross Society had registered the same matter, since it seems to indicate the goods are produced by such society. Ex parte Candy, 40 MS. D., Aug., 1889 (Mitchell, Com'r).

84. Applicant presented for registration as a trade-mark an exact representation of the well-known badge of the Grand Army of the Republic, which he proposed to use as a water-mark on writing paper. The fact that the Grand Army of the Republic have adopted a certain design for their badge, or for the letter-head of writing paper used by them, does not secure to such organization such exclusive property in the particular representation as would deprive an applicant who has complied with all the requirements of the statute of his right to register the same as a trade-mark. It is well settled that emblems which have been used by societies possess no sanctity or sacredness which precludes their being used and applied as trade-marks. Ex parte King, 46 O. G. 119, C. D. 1889.

85. The objection of the examiner that the trade-mark embellishes the paper is not approved. It may be said that scarcely any trade-mark can be applied to paper without incidentally embellishing it. If the design is a legitimate subject of a trade-mark and is not prohibited by law, the fact that it incidentally embellishes the page on which it appears cannot deprive it of its lawful quality as a trade-mark. Id.

86. The fact that the Grand Army of the Republic have previously obtained a design patent for this representation, the term of which has expired, does not constitute a legitimate bar to the employment of this design as a trade-mark in commerce with foreign nations. The mere fact that the organization originated the design would make no difference whatever if the design has been donated to the world to be used in all the ways of which it is capable. The Grand Army of the Republic retained no proprietary right after the term of their design patent expired. There is no property in the design itself vested in any one. Any person may apply the design as a trade-mark to a certain class of merchandise, and when thus applied it acquires the quality of property and becomes vested in him who first makes such new and distinct application of the design, and registration will be granted, provided the applicant has complied with all the requirements of the statute and the mark is used in commerce with foreign nations. Id.

87. The patent office has not the means to investigate the question whether the applicant in the present case is simply seeking to obtain the guise of security round his trade-mark, when he really means to use it as an attractive embellishment for a particular class of persons in this country. The office is bound by the oath of the applicant, and such a question as the above must be settled by the courts. Id.

("Square and Compass"—a Masonic emblem—refused registration. Ex parte Tolle, 2 O. G. 415, C. D. 1872 (Thacher, Acting Com'r). The word "Masonic" *held* not registrable. Ex parte Smith, 16 O. G. 764, C. D. 1879 (Payne, Com'r). *Contra*, Ex parte Thomas, 14 O. G. 821, C. D. 1878, Doolittle, Acting Com'r).

88. Registration of a trade-mark consisting, essentially, of "the red cross on black ground in a diamond-shaped border and accompanied by the words 'Red Cross,'" for a medical compound, refused. Ex parte Chichester Chemical Co., 52 O. G. 1061, C. D. 1890.

89. Such a trade-mark would naturally lead the purchaser to suppose that he was purchasing an article which, if not manufactured by the well-known Red Cross Society, had at least its sanction or indorsement. Id.

90. A label adopted by the International Cigar-Makers' Union, to be pasted on boxes containing cigars made by members, is not a legal trade-mark, it not indicating by what persons the cigars are made, but only that they are made by members of one of the local unions, the right to use it belonging equally to all members and continuing only while they are members. ‡Weener v. Brayton, 53 O. G. 275, C. D. 1890.

91. An injunction against the wrongful use of such label cannot be granted on the ground of special injury to plaintiffs, who are officers and members of the union, but are not manufacturers of or dealers in the cigars on which such label is used. ‡Id.

92. The seal of Minnesota with the title "Seal of Minnesota," refused registration, upon the broad ground that it is against public policy to register coats of arms of states. (Schmachtenberg Bros., 51 MS. D. 204.) Ex parte New Prague Flouring Mill Co., 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

93. The members of an association may adopt and use a trade-mark to indicate that the goods on which it is placed are manufactured or sold by some member of the association, in which case the trade-mark indicates a class of persons

or firms rather than any single one. ‡Gravel Roofers' Exchange v. Turnbull, 64 O. G. 441, C. D. 1893.

94. The symbol, a red Greek cross, cannot be registered as a trade-mark for medicinal bitters. Ex parte Zwack & Co., 76 O. G. 1855, C. D. 1896.

95. There is no real conflict between the decisions in the cases of Ex parte Chichester Chemical Co. (52 O. G. 1061) and Ex parte Candy (40 MS. D. 474) and the decisions in the cases of Ex parte King (46 O. G. 119) and Ex parte Turner (34 MS. D. 469). Id.

96. Authority conceded by the Red Cross Society in foreign country to applicant to use as a trade-mark the symbol "Red Greek Cross" does not extend beyond the boundaries of that country. Id.

97. As the International Union has not the force or effect of law in this country, applicant cannot claim, under article VI thereof, the privilege of registering in this country an unlawful mark. Id.

VIII. Descriptive.

98. The capital letters "LL" *held* not to be a valid trade-mark for cotton sheetings in view of the facts that they were well known in the trade to indicate a class or grade and had been previously used by others on cotton sheetings similar to those of the plaintiff. *Lawrence Mfg. Co. v. Tennessee Mfg. Co., 31 Fed. Rep. 776 (1887).

99. The word "Kaiser" is a name given to a number of mineral springs in different places in Europe long before its adoption by complainants. Their selection of it as a trade-mark for natural mineral waters is open to the objection that it was already descriptive of similar products, which others had a prior right to sell by the same name. *Luyties v. Hollender, 40 O. G. 119, C. D. 1887.

100. As against the complainants, it is legitimate for the owners of any of the "Kaiserquelle" waters of Europe to sell them in this country by the name of "Kaiser Spring" waters, or to sell them anywhere by a name which in any language would signify to a purchaser the true name of the article and its origin and ownership. *Id.

101. The words "Best Six Cord" are merely descriptive of quality, and the figures merely denote the size of the thread, and they could not be appropriated by the plaintiffs. *J. & P. Coats v. Merrick Thread Co., 45 O. G. 347, C. D. 1888.

102. The proper designation of an article cannot be appropriated as a trade-mark. *Colgan v. Danheiser, 35 Fed. Rep. 150 (1888).

103. The words "Taffy Tolu" *held* to be descriptive and hence incapable of exclusive appropriation. *Id.

104. The words "Iron Bitters" for bitters, *held* indicative of the composition of the article. (*Chemical Co. v. Myer, 31 Fed. Rep. 453.) *Brown Chemical Co. v. Frederick Stearns & Co., 37 Fed. Rep. 360 (1889).

105. "Acid Phosphate" *held* to be descriptive, and hence not capable of exclusive appropriation as a trade-mark for a preparation used as a medicine, condiment or beverage. *Rumford Chemical Works v. Muth, 35 Fed. Rep. 524 (1888).

106. The true test is whether the words as commonly used by those who understand their meaning are reasonably indicative and descriptive of the thing intended. If they are, they cannot become the exclusive property of any one. *Id.

107. The words "Indurated Fibre" *held* to be descriptive of the quality, ingredients or characteristics of the manufactured article. *Indurated Fibre Co. v. Amoskeag Indurated Fibre Ware Co., 37 Fed. Rep. 695 (1889).

108. The name "Goodyear Rubber Company" is not one capable of exclusive appropriation as a trade-mark. "Goodyear Rubber" are terms descriptive of well-known classes of goods produced by the process known as Goodyear's invention. Names which are thus descriptive of a class of goods cannot be adopted as trade-marks and be thereby appropriated to the exclusive right of any one. *Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co., 46 O. G. 122, C. D. 1889.

109. The word "Sleuth," being a word having a place and meaning in the language, cannot be appropriated as a trade-mark for a book or periodical. ‡Munro v. Beadle, 46 O. G. 448, C. D. 1889.

110. "Tablet" denied registration as descriptive for snuff compressed into tablets. Ex parte Reed, 44 MS. D., 2 G. W. D., Sept., 1890 (Mitchell, Com'r).

111. Complainants have no trade-mark in the word "Tycoon," as applied to a certain kind of tea, it appearing that the word was in common and general use, as descriptive of a certain class of teas, for many years before

complainants' adoption of it. *Corbin v. Gould, 51 O. G. 622, C. D. 1890.

112. The word "Elastic" as applied to suspenders *held* to be descriptive in the ordinary sense. ‡Bailly v. Nashawannuck Mfg. Co., 51 O. G. 970, C. D. 1890.

113. Words which are but inferentially or remotely descriptive, indicating neither origin nor ownership, but merely some special quality or peculiarity of the article itself, may properly be regarded as fanciful or arbitrary in the legal sense. ‡Id.

114. The words "Headache Capsules," applied to a medicine for curing headaches, refused registration as being descriptive. Ex parte Lichty, 46 MS. D., May, 1891 (Mitchell, Com'r).

115. The words "Cramp Cure," used as a trade-mark for a medicine for the cure of cramps, are descriptive of the nature and qualities of the medicine, and cannot be exclusively appropriated. *L. H. Harris Drug Co. v. Stucky, 46 Fed. Rep. 624 (1891).

116. Registration of "Nerve Food" refused because descriptive, and also because used by others at a prior date. Ex parte Robertson, 49 MS. D. (3 G. W. D.), Dec., 1891 (Frothingham, Ass't Com'r).

117. An exclusive right cannot be acquired to the use of words, letters or symbols to indicate merely the quality of the goods to which they are attached. *Lawrence Mfg. Co. v. Tennessee Mfg. Co., 55 O. G. 1528, C. D. 1891.

118. While, if the primary object of the mark be to indicate origin or ownership, the mere fact that the article has obtained such a wide sale that it has also become indicative of quality is not of itself sufficient to debar the owner from protection, and make it the common property of the trade, yet, if the device or symbol was not adopted for the purpose of indicating origin, manufacture or ownership, but was placed upon the article to denote class, grade, style or quality, it cannot be upheld technically as to a trade-mark. *Id.

119. It is well established that words which are merely descriptive of the character, qualities or composition of an article, or of the place where it is manufactured or produced, cannot be monopolized as a trade-mark. *Brown Chemical Co. v. Meyer, 55 O. G. 287, C. D. 1891.

120. "Tamarac Balsam," for medicines, *held* descriptive or deceptive. Ex parte Johnson, 51 MS. D., Aug., 1892 (Frothingham, Acting Com'r).

121. The word "Famous" is merely descriptive in its nature and not registrable as a trade-mark. Ex parte Brand Stove Co., Limited, 62 O. G. 588, C. D. 1892.

122. "Splendid" *held* descriptive, and also anticipated by "Esplendido," already registered for the same goods (flour). Ex parte Stokes, 64 O. G. 437, C. D. 1893.

123. "Silver Finish," for wire netting and cloth, *held* descriptive. Ex parte Clinton Wire Cloth Co., 52 MS. D., April, 1893 (Frothingham, Ass't Com'r).

124. "Zylonite" or "Xylonite," as a trade-mark for pyroxyline compounds, *held* to have been used descriptively. Ex parte The Celluloid Co., 52 MS. D., June, 1893 (Fisher, Acting Com'r).

125. "The Favorite," as a trade-mark for toilet boxes, *held* a "qualifying term," therefore not registrable. Ex parte Pattberg & Bros., 53 MS. D., Aug., 1893 (Fisher, Ass't Com'r).

126. "Surefit," as a trade-mark for garment patterns, *held* essentially descriptive. Ex parte Christiansen, 53 MS. D., Dec., 1893 (Fisher, Acting Com'r).

127. Generally any words, marks or symbols may be adopted as a trade-mark which are indicative of the origin or ownership of the manufactured article, but those used simply to describe the quality, kind or nature of the article cannot be so appropriated. *Improved Fig Syrup Co. v. California Fig Syrup Co., 64 O. G. 158, C. D. 1893.

128. Words in common use, with some exceptions, may be adopted, if, at the time of their adoption, they were not employed to designate the same or like articles of production. (*Canal Co. v. Clark, 13 Wall. 322—supreme court decision.) *Id.

129. "Standard," as a trade-mark for desks, *held* descriptive. Ex parte Standard Furniture Co., 54 MS. D., Jan., 1894 (Fisher, Ass't Com'r).

130. "Peerless," as a trade-mark for tea, *held* descriptive. Ex parte Butler, 54 MS. D., Feb., 1894 (Fisher, Ass't Com'r).

131. Descriptive words like "Cough Syrup" cannot be appropriated as trade-marks. *Meyer v. Dr. B. L. Bull's Vegetable Medicine Co., 66 O. G. 1755, C. D. 1894.

132. Numerals used by a medicine company to identify specific remedies for various ailments are in effect descriptive terms, and their use will not be protected as a trade-mark.

*Humphrey's Homeopathic Medicine Co. v. Hilton, 67 O. G. 1193, C. D. 1894.

133. It may be that numerals, which are arbitrarily selected, without any purpose of identifying the article to which they are affixed from other articles of a similar class, may become the subject of a trade-mark; but the use of numerals as a short method of identifying the several members of a class and distinguishing one of them from another is old. *Id.

134. "Bromo-Quinine" is a compound word descriptive of the preparation to which it is applied, indicating that it contains bromine or a bromide and quinine. If it does not contain bromide the description is false, and in either case the term is not a valid trade-mark. Ex parte Grove, 67 O. G. 1447, C. D. 1894.

135. The words "Cherry Pectoral," "Taffe Tolu," "Rye & Rock," "Straight Cut," "Macassar," "Cresylic Ointment" and "Iron Bitters," which have been claimed as trade-marks, were either originally descriptive, or have come to be recognized as descriptive of the articles they are applied to. *N. K. Fairbank Co. v. Central Lard Co., 70 O. G. 635, C. D. 1895.

136. The word "instantaneous" was applied to tapioca which "requires no soaking, but softens instantly." *Held* descriptive. *Bennett v. McKinley, 65 Fed. Rep. 505 (1895).

137. The words "Syrup of Figs" or "Fig Syrup" being descriptive cannot be sustained as a valid trade-mark or trade-name as applied to a syrup one of the characteristic ingredients of which is the juice of the fig. *California Fig Syrup Co. v. Stearns, 73 O. G. 140, C. D. 1895.

138. The use of the name "Syrup of Figs," in connection with a description of the preparation as a "Fruit Remedy," "Nature's Pleasant Laxative," applied to a compound whose active ingredient is senna, and containing but a small proportion of fig juice, which has no considerable laxative properties, is deceptive and deprives one so using it of any claim to equitable relief. (California Fig Syrup Co. v. Improved Fig Syrup Co., 61 O. G. 155, 51 Fed. Rep. 296; on appeal, 64 O. G. 158, 4 C. C. A. 264, 54 Fed. Rep. 175, distinguished.) *Id.

139. A facing strip for suspenders, with adjuncts, is not registrable. Applicant can have no exclusive right to such strip. Ex parte Silvermann & Co., 56 MS. D., March, 1895 (Seymour, Com'r).

(See Ex parte Silvermann & Co., 59 MS. D., 1896, *infra*.)

140. The words "Gauze" and "Scientific," applied to suspenders, *held* descriptive. Ex parte Silvermann & Co., 56 MS. D., March, 1895 (Seymour, Com'r).

141. "Hygienic," for graham flour and white oats, *held* descriptive. Ex parte Williams & Co., 57 MS. D., July, 1895 (Fisher, Ass't Com'r).

142. "Common Sense" *held* descriptive as applied to weather strips. Ex parte Yung, Jr., 57 MS. D., Sept., 1895 (Fisher, Acting Com'r).

143. "Crushed Roses," as a trade-mark for perfumes, *held* descriptive or deceptive. Ex parte De Moville & Co., 58 MS. D., Oct., 1895 (Fisher, Acting Com'r).

144. The word "Success" as a trade-mark for medical compounds, *held* a "descriptive and advertising term," and therefore public property. Ex parte The Success Remedy Co., 58 MS. D., Oct., 1895 (Fisher, Acting Com'r).

145. "The 'Formosa' Doubly Woven Finger Tips," as a trade-mark for gloves, refused registration on the ground that "Doubly Woven Finger Tips" is descriptive, and "Formosa" is geographical. Ex parte Lord & Taylor, 58 MS. D., Nov., 1895 (Fisher, Acting Com'r).

146. "Cold Tea," as a trade-mark for a medical compound, *held* descriptive or deceptive. Ex parte Andrews, 58 MS. D., Dec., 1895 (Fisher, Ass't Com'r).

147. "Superior Coffee Helper," as a trade-mark for a "coffee substitute," *held* descriptive. Ex parte Sipher & Friedman, 58 MS. D., Jan., 1896 (Seymour, Com'r).

148. "Honestrop," as a trade-mark for razor strops, *held* descriptive. Ex parte Brooks, 58 MS. D., Jan., 1896 (Fisher, Ass't Com'r).

149. "Steel-Porcelain," as a trade-mark for enameled metal wares, *held* descriptive. Ex parte Kny, 58 MS. D., Jan., 1896 (Fisher, Ass't Com'r).

150. The words "Royal-Salted-Codfish" refused registration on the ground that "Salted" and "Codfish" are merely descriptive, and "Royal" had been anticipated. Ex parte Pew & Son, 58 MS. D., Feb., 1896 (Fisher, Acting Com'r).

151. "Superior," as a trade-mark for clothes wringers, *held* descriptive. Ex parte The American Wringer Co., 58 MS. D., Feb., 1896 (Fisher, Ass't Com'r).

152. "Sterling," for wringers, *held* descriptive. Ex parte The American Wringer Co., 58 MS. D., Feb., 1896 (Fisher, Ass't Com'r).

153. The words "Astringent Pencil," applied to a stiptic cylinder or stick not tapered, *held*

descriptive; but registration was allowed upon adding the accessories of colored label, contrasting border and a symbol. Ex parte Harned, 58 MS. D., March, 1896 (Fisher, Ass't Com'r).

154. The words "Don't Cook Out," as a trade-mark for flavoring extracts, *held* descriptive. Ex parte Canz, 58 MS. D., March, 1896 (Fisher, Acting Com'r).

155. "Solvent," as a trade-mark for medicines, *held* descriptive or deceptive. Ex parte Packer, 59 MS. D., April, 1896 (Fisher, Acting Com'r).

156. "Bromo-Quinine" *held* descriptive or deceptive, as applied to a remedy for coughs, colds, etc. (rehearing). Ex parte Grove, 59 MS. D., May, 1896 (Fisher, Acting Com'r).

157. "The representation of a hole formed in the front or back facing-strip of a suspender or like article" is not entitled to registration. Other dealers in suspenders have a right to use true pictures of their goods." Ex parte Silvermann Co., 59 MS. D., May, 1896 (Seymour, Com'r).

(See Ex parte Silvermann & Co., 56 MS. D., 1895, *supra*.)

158. "Bromo-Celery," for medicines, *held* descriptive or deceptive. Ex parte Bromo-Celery Co., 59 MS. D., May, 1896 (Seymour, Com'r).

159. "Unrivalled" and "Excellent" as trade-marks for fish, *held* descriptive. Ex parte Pew and Son, 59 MS. D., June, 1896 (Fisher, Acting Com'r).

160. "Roman Punch," as a trade-mark for beverages, *held* descriptive. Ex parte Countie & Co., 59 MS. D., June, 1896 (Fisher, Acting Com'r).

161. "Black diamond," as a trade-mark for blasting powder, *held* not registrable, because "Black" is descriptive, and "Diamond" was already registered. Ex parte The New York Powder Co., 59 MS. D., June, 1896 (Fisher, Acting Com'r).

162. The representation of a bundle of cigars, with stripes across its face, as a trade-mark for cigars, *held* descriptive. Ex parte Rosenberger & Co., 59 MS. D., June, 1896 (Fisher, Acting Com'r).

163. "Kola-Malto," as a trade-mark for a certain powder, *held* descriptive. Ex parte The Thomson & Taylor Spice Co., 60 MS. D., Nov., 1896 (Fisher, Ass't Com'r).

164. The exclusive use of the word "Matzoon" as applied to a form of fermented milk, when such word is well known in a foreign country with the same application of meaning, cannot be permitted, although in this country, prior to the introduction of the compound, said word, save to a few persons acquainted with the language of the foreign country, possessed no significance. *Dadirrian v. Yacubian, 75 O. G. 1856, C. D. 1896.

165. The word "Imperial," though close to the border line between terms that signify quality and those that do not, *held* descriptive, since it is safer to protect the use of those terms only which clearly do not refer to grade or quality. *Beadleston & Woerz v. Cooke Brewing Co., 74 Fed. Rep. 229 (1896), 76 O. G. 1576, C. D. 1896.

(This decision discusses the element of quality or descriptiveness quite fully.)

166. The word "Imperial" is an adjective in general use to indicate superior quality and cannot be used as a valid trade-mark. *Id.

167. The word "Imperial" having been adopted and used by appellant to characterize a particular grade of beer, he is not entitled to be protected in the exclusive use of the word as a lawful trade-mark. *Id.

168. A descriptive word does not indicate origin or ownership. The monopoly of use granted by the law of trade-marks should not be extended to embrace terms of doubtful signification. *Id.

169. A trade-mark must be designed, as its primary object and purpose, to indicate the owner or producer of the commodity and to distinguish it from like articles manufactured by others, and the device or symbol employed cannot be sustained as a valid trade-mark if it be used for the purpose of identifying the class, grade, style or quality of the article. (Columbia Mill Co. v. Alcorn, 65 O. G. 1916, 150 U. S. 460.) *Id.

170. Color cannot be exclusively appropriated for packages of goods. The words "White Wrapper," *held* not registrable for canned salmon. (Ex parte Landreth, 31 O. G. 1441; Fleischmann v. Starkey, 25 Fed. Rep. 127; Fisher v. Blank, 33 N. E. Rep. 1040.) Ex parte Lord, 61 MS. D. 389, June, 1897 (Butterworth, Com'r).

171. The name "Air-Brush," applied to an instrument or machine for the distribution of pigments by means of an air-blast, is plainly descriptive and not arbitrarily selected as a mark of origin. *Air-Brush Mfg. Co. v. Thayer, 79 O. G. 683, C. D. 1897.

172. The word "Gyrator," if applied to bolting-machines having a gyratory motion, is used descriptively or, if applied to other bolting-machines, it is used deceptively, and in either case it should not be registered as a

trade-mark. Ex parte Wolf, 80 O. G. 1271, C. D. 1897.

173. Where a word is formed by joining or combining English, Latin or other words the meaning of which is understood, and said new word is descriptive of the goods to which it is applied, it should not be registered as a trade-mark. Id.

174. The word "Yale" refused registration as a trade-mark for locks on the ground that it is public property, being descriptive of a lock of a certain kind. Ex parte Yale & Towne Mfg. Co., 81 O. G. 801, C. D. 1897.

175. The word "peerless" being an adjective meaning "unequaled, unmatched, matchless, unsurpassed," etc., registration as a trade-mark refused on the ground that it is descriptive of the quality of the goods to which it is applied. To give to one person the exclusive right to its use as a trade-mark would be to deprive the public of its lawful use in language. Ex parte Peerless Carbon Black Co., Limited, 81 O. G. 803, C. D. 1897.

(Whether a word claimed as a trade-mark is fanciful or arbitrary, or whether obnoxious to objection of being descriptive, must depend upon the circumstances of each case. If it is merely suggestive, or is figurative only, it may be a good trade-mark, notwithstanding it is also indirectly or remotely descriptive. *Bennett v. McKinley, 65 Fed. Rep. 595, 1895.)

IX. Division of Application.

176. There is no authority for requiring division of an application for the registration of a trade-mark to accord with the subdivisions of the office classification. Ex parte Silvers, 67 O. G. 811, C. D. 1894.

X. Drawings or Fac-similes.

177. The Revised Statutes relating to the registration of trade-marks require that the mark shall be represented by *fac-simile*, the mode of application being indicated by a statement. Ex parte Hudson, 55 O. G. 1401, C. D. 1891.

178. The rules of the patent office provide 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. Id.

179. 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 permits. Id.

180. While perhaps it would be going too far to require in all cases that the trade-mark and nothing but the trade-mark be represented in the drawing, it is certainly within the discretion of the office to so insist where otherwise legitimate doubts would arise as to whether protection should not be sought through the law relating to designs. Id.

181. The cases are very rare in which the registration of a trade-mark requires or should permit of the representation of any other matter than the *fac-simile* of the trade-mark itself. Id.

182. Illustrations of a trade-mark presented for record by the applicant must conform substantially as to shape and size with the rules governing drawings of patents. Ex parte Archer, 57 O. G. 410, C. D. 1891.

XI. Equity.

183. An objection to the bill on the ground that it was uncertain whether complaint was made of the use of the words "Fig Syrup" or "Syrup of Figs" by themselves or in combination with other words, devices, etc., could not be sustained, it being enough for the purposes of a demurrer that complainant was entitled to relief in respect of the combined use, which was clearly set forth in the bill. *California Fig Syrup Co. v. Improved Fig Syrup Co., 61 O. G. 155, C. D. 1892.

184. The laxative medical compound manufactured by the California Fig Syrup Company under the name "Syrup of Figs" is a preparation which a court of equity will look upon with favor as entitled to protection under the trade-mark laws. *Improved Fig Syrup Co. v. California Fig Syrup Co., 64 O. G. 158, C. D. 1893.

185. The representations and statements on the bottles and packages of the California Fig Syrup Company's medical compound "Syrup of Figs" are not such as will deprive the California Fig Syrup Company of standing in a court of equity in respect to infringement of its trade-mark or trade-name. *Id.

XII. Essential Features.

186. A trade-mark must be described with definiteness and certainty; but it was suggested in this case that some statement might be made as to what change would be considered as substantially included in the scope of the registration. Ex parte Benge & Co., 41 MS. D., Sept., 1889 (Fisher, Acting Com'r).

187. 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. Ex parte Metropolitan Watch Co., 44 MS. D. (2 G. W. D.), Oct., 1890 (Mitchell, Com'r).

188. The representation of a dog as a trade-mark for flour cannot be properly registered without any described limitation as to attitude, position or view of the animal. (Rehearing.) Ex parte Duluth Imperial Mill Co., 52 MS. D., Aug., 1893 (Fisher, Ass't Com'r).

189. Registration of the words "Buffalo Brand" and head of a bison refused for indefiniteness of statement of essential features. Ex parte Lathrop & Co., 55 MS. D., Dec., 1894 (Fisher, Ass't Com'r).

190. The words "dark" and "light," used in a statement to describe a mark for dress-stays, *held* indefinite, and the substitution of the words "Contrasting Colors" suggested. Ex parte Janowitz, 56 MS. D., March, 1895 (Fisher, Ass't Com'r).

191. A figure described as "red or reddish and of definite shape and limited dimensions on or local to a portion of the tire having a definite outline," *held* too indefinite in description to be registrable. Ex parte Boston Woven Hose and Rubber Co., 59 MS. D., June, 1896 (Fisher, Acting Com'r).

XIII. Evidence.

(See Injunction; Infringement.)

192. The registry of a trade-mark under the act of March 3, 1881, may be evidence in a suit to restrain infringement of a common-law trade-mark used for the same article in domestic commerce to show what complainant really claimed. (Kohler Mfg. Co. v. Beshore, 59 Fed. Rep. 572, followed.) *Richter v. Reynolds, 67 O. G. 404, C. D. 1894.

193. Although registration of a trade-mark under the act of March 3, 1881, may not prevent the adoption of another device as a common-law trade-mark for the same article in domestic markets, such registry may be evidence, in a suit to restrain infringement of such common-law trade-mark, to show what complainant really claimed. Kohler Mfg. Co. v. Beshore, 67 O. G. 678, C. D. 1894.

194. Where affidavits are filed which are not entitled in the cause, they cannot properly be considered by the court. (Buerk v. Imhauser, 10 O. G. 907. See, also, Hawley v. Donnelly, 8 Paige, 415.) *Goldstein v. Whelan, 69 O. G. 124, C. D. 1894.

195. Testimony of witnesses hired to secure evidence against infringers that they purchased of defendant imitation bitters put up in genuine bottles procured for the purpose, *held* insufficient where they relied solely on opinions formed from tasting the liquid and where they were opposed by the testimony of defendant and his employees and others that the bitters so sold were genuine and that he had never procured or sold any imitation article. *Hostetter Co. v. Bower, 76 O. G. 1856, C. D. 1896.

XIV. Fees.

196. A petition that a fee for a trade-mark, registered under the act of 1870, be applied to the present application, granted. Hinrichs & Co., 54 MS. D., Jan., 1894 (Fisher, Acting Com'r).

XV. Fee, Refundment of.

197. There is no authority for the repayment of fees paid in trade-mark cases where registration is refused. †Ex parte Thayer, 54 O. G. 957, C. D. 1891.

198. The agent of a foreign corporation filed an application for the registration of a trade-mark used by the corporation, which was refused on the ground that he was not the exclusive owner. Subsequently the corporation by its proper officer filed its application as "exclusive owner." *Held*, upon a request for the refunding of the fee paid by Hill, as having been "paid by mistake," that the mistake, being one of law and not of fact, is not within rule 224, and that Hill's application having been rejected on the merits he is not entitled to have the fee refunded. Ex parte Coventry Machinist Co., Limited, 59 O. G. 1923, C. D. 1892.

199. A filing fee of ten dollars having been paid on an application for registration of a trade-mark in 1879, under the law and rules in force at that time, *held*, that it was not paid under a mistake and that it could not properly be refunded. Ex parte Leeson & Co., 60 O. G. 297, C. D. 1892.

200. Where the domestic branch of a business firm having offices in this country and abroad filed application for trade-mark registration, and subsequently learned that application for the same mark had already been filed through the London agent, *held*, that the second filing was a case of mistake under the law, and the fee refunded. Ex parte Finlayson, Bousfield & Co., 61 O. G. 152, C. D. 1892.

201. The registration fee in a trade-mark

case cannot be returned because of rejection of the application. Ex parte McDaniel & Morrow, 54 MS. D., March, 1894 (Fisher, Ass't Com'r).

202. A fee paid on an application for a trade-mark cannot be returned, whether registration be granted or not. Ex parte Zwack & Co., 55 MS. D., Aug., 1894 (Fisher, Ass't Com'r).

XVI. Firm Name.

(See Good Will.)

203. It is common for a dealer to retain on a label the name of a firm to which he has succeeded, and the public are not deceived nor injuriously affected by such course. *Jennings v. Johnson, 37 Fed. Rep. 364 (1888).

XVII. Foreign Commerce.

204. The statutory basis of the right to registration is the fact that the trade-mark is used in foreign commerce or commerce with Indian tribes. Ex parte Proctor, Jr., 51 O. G. 1785, C. D. 1890.

205. Inasmuch as the applicant invokes the right as it stands related to foreign commerce, it cannot be said that the absence of Cromarty herrings from the home market authorizes registration. Id.

206. Where an applicant for a trade-mark appears on the record as "located" in a foreign country other than that of which he is a citizen, his application will be governed by the existing treaty, convention or law of the country of location rather than that of citizenship. Ex parte Haggenmacher, 60 O. G. 438, C. D. 1892.

207. An applicant for trade-mark registration, relying upon commerce with Indian tribes to bring him within the statute, will be required in his oath to specify by name the tribe or tribes with which such commerce is carried on. Ex parte Schotten & Co., 60 O. G. 576, C. D. 1892.

208. Registration must be denied when there has been no foreign commerce prior to the application. Stewart v. Einstein, v. Sawhill, 64 O. G. 1533, C. D. 1893.

209. Upon an application showing the adoption of the trade-mark after the death of the originator, and its use in foreign commerce after the filing of the application, but not before, a supplemental application may be filed. Id.

210. The commissioner of patents under the trade-mark statute of March 3, 1881, is not invested with discretionary power to determine whether the applicant for registration is *lawfully* engaged in foreign trade. *United States ex rel. The State of South Carolina v. Commissioner of Patents, 65 O. G. 1221, C. D. 1893.

(Decision of supreme court of the District of Columbia.)

211. The discretion of the commissioner, under that statute, is to decide the presumptive lawfulness of claim to the ownership of the alleged trade-mark, not whether such mark is lawfully used in foreign commerce. *Id.

212. The commissioner having denied registration to the state of South Carolina on the ground that, in his judgment, the statute under which the state's officers and agents were acting did not authorize a trade with foreign nations, *held*, that that question was one for the courts in a proper case and the people of the state to determine, it not being a matter in which the United States, the commissioner of patents or the general public had any concern or interest. *Id.

213. The decision of the commissioner goes to the question of the lawful use of the trade-mark in commerce with foreign nations or the Indian tribes, and whether the applicant has actually used the trade-mark in such commerce. *United States ex rel. The State of South Carolina v. Commissioner of Patents, 66 O. G. 1167, C. D. 1894.

(Decision of court of appeals of the District of Columbia.)

214. Whether an isolated sale in a foreign country for the purpose of giving foundation to the affidavit is foreign commerce within the meaning of the law, *quære*. *Id.

215. There is nothing in the dispensary law of the state of South Carolina intended to give authority for trade in liquors outside the limits of the state. It follows, therefore, that the sale of a case of state liquors in Canada by the state commissioner was not authorized by the law and was not the act of the state, but of the officer. *Id.

216. The commissioner did not err in the conclusion that the trade-mark applied for had not been lawfully used in foreign commerce. *Id.

217. An Indian tribe or nation within the United States is not a foreign state, in the sense of the constitution, or the statutes creating and conferring jurisdiction on the federal courts. (Citing Cherokee Nation v. State of Georgia, 5 Pet. 1; Cherokee Nation v. Southern Kansas

Ry. Co., 135 U. S. 641; Karahoo v. Adams, Fed. Cas. No. 7,614, 1 Dill. 344.) *Paul v. Chilsoquie, 70 Fed. Rep. 401 (1895).

218. The first to adopt and use a trade-mark is the owner of it, and it is immaterial whether K. used her mark in foreign commerce before filing date of B.'s application for registration. Kirschbaum v. Berriman, 58 MS. D., March, 1896 (Fisher, Acting Com'r).

219. The question of foreign trade is *ex parte*, and has no influence on the question of priority in an interference proceeding (Hance v. Flower, 54 MS. D. 230), and it is not necessary for a party to take testimony to establish it. The oath to the application is *prima facie* evidence of such trade. Oberhaeuser & Landauer v. Pastor Kneipp Med. Co., 63 MS. D., Dec., 1897 (Greeley, Acting Com'r).

XVIII. Foreign Words.

220. The word "Matzoon," as applied to fermented milk, cannot be regarded in this country as descriptive, although the Armenians give the name "Maadzoon" to a semi-solid or custard-like preparation of fermented milk made in Turkey and there is sufficient resemblance in the sound to signify to them that the preparation "Matzoon" is some sort of fermented milk. ‡Dadirrian v. Theodorian, 74 O. G. 1902, C. D. 1896.

221. Where a foreign word has no descriptive character which anybody in this country could comprehend except the persons here who are acquainted with the foreign language, *held*, the word to be a valid trade-mark. ‡Id.

222. When the article was first imported or made in this country and called by the name "Matzoon," the right to such importation or making and to the use of the name belonged to any one, and there is no rule in law by which that right can be taken away or abridged. The fact that the plaintiff long monopolized the trade in the article in this country and introduced it to the trading public gives him no exclusive use in the word as a trade-mark. *Dadirrian v. Yacubian, 75 O. G. 1856, C. D. 1896.

223. The ignorance of people in this country touching "Matzoon," its uses and its name cannot be treated as property and be in a manner capitalized as an element in the good-will of the complainant, as would be the case if no one else were permitted to tell what it is and what a considerable portion of the race has long found it useful for. *Id.

XIX. Fraud or Unfair Competition.

(See Injunction; Infringement; Right to Use Personal Name.)

224. A manufacturer is not allowed to impose his goods upon the public as the goods of another manufacturer, and so derive a profit from the reputation of the latter. ‡McCann v. Anthony, 38 O. G. 333, C. D. 1887.

225. The imitation need not be exact. It is sufficient if it be so close as to deceive the incautious and unwary. ‡Id.

226. It is not necessary to prove that actual fraud was intended by the infringer. ‡Id.

227. A trade-mark which contains a misrepresentation, clearly and distinctly referring the origin or ownership of the article to another person, class of persons or nationality than the true one, and thereby evidently depriving the public from freedom of choice and the exercise of discrimination in selection and purchase, according to their tastes and judgment, is a fraudulent and unlawful trade-mark, not entitled to registry. Ex parte M. Bloch & Co., 40 O. G. 443, C. D. 1887.

228. The fraud or misrepresentation which renders a trade-mark unlawful is not restricted to cases where the trade-mark so nearly resembles that of another as to be calculated to deceive, but embraces those that mislead or deceive the public in any of the particulars by which they would mislead or deprive people from enjoying and realizing their choice of selection as to quality, character, etc., of the article marked or as to its origin, ownership, etc. It is not essential to the unlawfulness of such trade-mark that the articles sought to be purchased by the public do not actually possess the superior qualities attributed to them. It is sufficient that they are believed to possess them. Id.

229. It is the object of the law relating to trade-marks to prevent one man from unfairly stealing away another's business and good-will. Fair competition in business is legitimate and promotes the public good; but unfair appropriation of another's business by using his name or trade-mark, or an imitation thereof calculated to deceive the public, or in any other way, is justly punishable by damages, and will be enjoined by a court of equity. *Celluloid Mfg. Co. v. Cellonite Mfg. Co., 41 O. G. 603, C. D. 1887.

230. The Brown Chemical Company manufactured "Brown's Iron Bitters." The defendants sold "Brown's Iron Tonic." The two titles, being descriptive, were not technical

trade-marks, and the question, therefore, was whether there was unfair competition in trade. *Held*, that there was not, because "Brown's Iron Tonic" was prepared from a different formula by another Brown, and that the respective bottles and wrappers were unlike in form, shape and color, so that the public could not mistake one article for the other. *Brown Chemical Co. v. Meyer, 31 Fed. Rep. 453 (1887).

231. Plaintiff's and defendant's liniments bore the same title, namely, "Johnson's Anodyne Liniment," and the bottles were the same size, the wrappers similar in color and the labels differed but little. *Held*, the public were deceived, and injunction issued accordingly. *Jennings v. Johnson, 37 Fed. Rep. 364 (1888).

232. *Held*, that defendant's simulation of the trade-mark and labels of the Hostetter Company and of the bottles in which the bitters are put up prove that its purpose was to deceive the public. *Myers v. Thiller, 38 Fed. Rep. 607 (1889).

(See Hostetter Co. v. Sommers, 82 O. G. 753. Defendant enjoined.)

233. The use of the name "St. Louis" on white lead manufactured in Chicago tends to deceive and defraud the public and the complainant, who manufactures white lead in St. Louis. (Cases cited.) *Southern White Lead Co. v. Coit, 39 Fed. Rep. 492 (1888).

234. That the manufacturers of scythestones have sometimes put upon labels bearing their brand the names of jobbers to whom they have sold stones does not show that any deceit has been practiced upon the public, because the purchaser obtained the same goods which he would have purchased if the name of the jobber had not been upon them. *A. F. Pike Mfg. Co. v. Cleveland Stone Co., 45 O. G. 947, C. D. 1888.

235. Although there may be no infringement, a bill for an injunction may lie, and affords the only adequate relief when there is continuous fraud by simulating a trade-mark. *Adee v. Peck Bros. & Co., 48 O. G. 823, C. D. 1889.

236. The delivery of a soap called "Pride of the Kitchen" to fill orders for a soap called "Sapolio," *held* unlawful and fraudulent. *Enoch Morgan's Sons v. Wendover, 43 Fed. Rep. 420 (1890).

237. 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. *Brown Chemical Co. v. Meyer, 55 O. G. 287, C. D. 1891.

238. A trade-mark, clearly such, when wrongfully used by a third party, is in itself evidence of an illegal act. It is of itself evidence that the party intended to defraud, and to palm off his goods as another's. (Putnam Nail Co. v. Bennett, 43 Fed. Rep. 800.) *Lawrence Mfg. Co. v. Tennessee Mfg. Co., 55 O. G. 1528, C. D. 1891.

239. If the letters LL formed an important part of plaintiff's label, and the defendant had used them in such a way and under such circumstances as to amount to a false representation, which enabled it to sell and it did sell its goods as those of plaintiff, and this without plaintiff's consent or acquiescence, then plaintiff might obtain relief on the ground of deceitful representation. *Id.

240. The name "Webster's Dictionary" cannot be exclusively appropriated on editions the copyrights for which have expired, since it is not a trade-mark. But defendant cannot lawfully so advertise the book as to confuse his publication with the plaintiff's in the public mind. (Cases cited.) *Merriam v. Texas Siftings Publishing Co., 44 Fed. Rep. 944 (1892).

241. Defendants' labels are almost the exact reproduction of complainant's, and the cigar boxes, thus labeled, so closely imitate complainant's as to deceive an ordinarily careful purchaser. Although defendants do not themselves make, pack or sell the fraudulent cigars, their obvious purpose is to palm off their goods as those of complainants. *Cuervo v. Jacob Henkell Co., 50 Fed. Rep. 471 (1892).

242. "Cherry Cocktail," applied to "temperance or non-alcoholic beverages," *held* deceptive. Ex parte Bowe, 50 MS. D., May, 1892 (Frothingham, Ass't Com'r).

243. "Premium," as a trade-mark for "whalebone products," refused as deceptive, the goods having received no premium. Ex parte New England Whalebone Mfg. Co., 51 MS. D., Aug., 1892 (Frothingham, Acting Com'r).

244. Independently of any right of complainants to the exclusive use as a trade-mark of the name applied by them to their product, the sale by the defendants of a deleterious substance represented by the latter to be in part or in whole the same substance in which complainants are dealing, and of which they are the sole producers, and which is admittedly of a beneficial character, will be restrained. *City

of Carlsbad v. Tibbetts, 61 O. G. 1160, C. D. 1892.

245. While descriptive words like "Cough Syrup" and proper names cannot be appropriated by one to exclusion of another, they also may be used for the purpose of perpetrating a fraud which affects the public. (Cases cited.) *Meyer v. Dr. B. L. Bull Vegetable Medicine Co., 58 Fed. Rep. 884 (1893).

246. The controversy between the parties is the single question whether, comparing the two designs upon the upper ends of the spools, there is such resemblance between them as to indicate an intent on the part of defendants to put off their thread upon the public as that of plaintiffs', and thus to trade upon their reputation. *Coats v. Merrick Thread Co., 63 O. G. 1531, C. D. 1893.

247. Irrespective of the technical question of trade-mark, the defendants have no right to dress their goods up in such manner as to deceive an intending purchaser and induce him to believe he is buying those of the plaintiffs. *Id.

248. The plaintiffs' and defendants' devices examined and compared with each other and found to be hardly possible to mistake one for the other. *Held*, consequently, that the defendants had clearly disproved any intention to mislead purchasers. *Id.

9. The addition of the initials "L. F." to the surname "Pillsbury" is not such a difference as would prevent deception of the ordinary observer. *Pillsbury v. Pillsbury-Washburn Flour Mills Co. (Limited), 64 Fed. Rep. 841 (1894).

250. Descriptive words, like "Cough Syrup," cannot be appropriated as trade-marks. Nevertheless they may be used for the purpose of perpetrating a fraud which affects the public, and in which cases a court will, as against the fraudulent party, afford relief to the party injured. (Coats v. Merrick Thread Co., 63 O. G. 1531, 149 U. S. 866, and other authorities cited.) *Meyer v. Dr. B. L. Bull Vegetable Medicine Co., 66 O. G. 1755, C. D. 1894.

251. When the evidence warrants the conclusion that the dress of the article is only used in order to deceive purchasers into the belief that the goods are those of another, *held*, it is not required to establish that any particular person had been so deceived. *Von Mumm v. Frash, 68 O. G. 143, C. D. 1894.

252. "Quince & Shrub," for medicinal lotions, refused as deceptive. Ex parte Queenan, 59 MS. D., July, 1896 (Fisher, Acting Com'r).

253. Where the defendant used the name "De Long Hook and Eye Company" on their goods, with intent to identify its business with that of the plaintiffs, whose goods are known as "De Long's Hooks and Eyes," *held*, that defendant should be restrained from such use, although one of them was named De Long. ‡De Long v. De Long Hook and Eye Co., 74 O. G. 809. C. D. 1896.

254. While there might be slight differences in the name, variation of coloring, and size of package and shape of goods, and in printed matter on the package, yet similarity, not identity, is the usual recourse where one party seeks to benefit himself by the good name of another. (Celluloid Mfg. Co. v. Cellonite Mfg. Co., 41 O. G. 693, 32 Fed. Rep. 94.) ‡Id.

255. The real test in such cases is whether the thing offered for sale is so arranged and exhibited that when it strikes the eye of an intending purchaser possessed with ordinary intelligence and judgment a false impression is likely to be produced that the goods of another are being offered for sale; and when answered in the affirmative the courts will interfere to protect the public, as well as the plaintiffs, and to suppress unfair and dishonest competition. (Fischer v. Blank, 138 N. Y. 251; Coats v. Merrick Thread Co., 63 O. G. 1531, 149 U. S. 566; Lawrence Mfg. Co. v. Tennessee Mfg. Co., 55 O. G. 1528, 138 U. S. 537.) ‡Id.

256. The fact that defendants might have used another name which in another foreign country indicates the same product cannot be construed as indicating unfair competition. *Dadirrian v. Yacubian, 75 O. G. 1853, C. D. 1896.

257. The trade-mark "Cuticura" *held* infringed by the word "Curative," both applied to soap, it also appearing that defendant's article was put upon the market in such imitative manner as to deceive the public. *Potter Drug & Chemical Corp. v. Miller, 75 Fed. Rep. 656 (1896).

258. The good-will of a manufacture will be protected from a colorable artifice in the use of a name or from one who merely buys from an indifferent third person who happens to have the name which the buyer wants to use; but it is not unfair competition on the part of the defendants to use in their business the name of a man who is a stock-owner in their company and who has been for years engaged in the same line of manufacture. Such a man is not an indifferent third person. *American Cereal Co. v. Eli Pettijohn Cereal Co., 76 O. G. 610, C. D. 1896.

259. Although the corporate name of defendant, "The William Clark Company," was not improper, yet when he called his goods "Clark's Spool Cotton" he was attempting to make the public believe that the goods belonged to another Clark, and he was restrained from the use of the name. *Clark Thread Co. v. Armitage, 76 O. G. 1419, C. D. 1896.

260. The acts of the defendant in imitating the label of complainant are a fraudulent invasion of the good-will of complainaut and an unfair and inequitable competition, and defendant is enjoined against the use, by labels, circulars, etc., of the designation "Clark's" as the name of the thread manufactured by the William Clark Company and from selling thread manufactured by said company under the name of "Clark's," or "Clark's Spool Cotton," or "Clark's Thread," and from the use of the letters "N-E-W" upon labels, etc. *Id.

261. Where it is alleged that defendant deceives the public by purchasing spurious articles and sells to the public from packages which once contained the genuine article and still contain complainant's labels and trademarks, *held*, that the burden is upon complainant to establish the charge by clear preponderance of proof. *Hostetter Co. v. Bower, 76 O. G. 1856, C. D. 1896.

262. It is sufficient to justify the interposition of a court of equity if articles manufactured by the defendant are purposely constructed and marked in the similitude of those manufactured by the complainant, with the intention and result of deceiving the trade and the public and inducing them to purchase the articles of the defendant in the belief that they are purchasing those of the complainant. *Buck's Stove and Range Co. v. Kiechle, 77 O. G. 1785, C. D. 1896.

263. It is unfair to conspicuously use the name "Hoff" upon the face of the bottle containing malt extract made by Leopold Hoff and to use a small side label containing the statement that Leopold Hoff is the manufacturer, when another man by the name of Hoff was in the same business under his own name before Leopold Hoff. *Tarrant & Co. v. Hoff, 78 O. G. 1107, C. D. 1897.

264. It is unfair competition for the defendant to advertise that his chocolate business was established in 1785, though his ancestors of the same name had been engaged in a wholesale grocery business since about that date, when it appears that the complainant advertises truthfully of his chocolate business that it was established in 1780. *Walter Baker & Co. (Limited) v. Baker, 78 O. G. 1427, C. D. 1897.

(The court restrained the defendant from using in connection with his name the words "Established in Mercantile Business in 1785," and also from using yellow labels and otherwise using his name so that it would be confused with plaintiff's name.)

265. The use by a manufacturer of imitative labels and devices in connection with an inferior article which is sold to retailers at a reduced price with the purpose and result of enabling them to sell it to consumers as the goods of another will be enjoined. *Garrett v. T. H. Garrett & Co., 79 O. G. 1681, C. D. 1897.

266. While it is true in the abstract that every one has a right to use white paper, yet no one has a right to use it in such a way as to imitate another's labels and thereby appropriate the good-will of his business. *Id.

267. Where a corporation organized to manufacture and sell snuff had assumed the name of an employee holding a few shares of its stock with the evident purpose of appropriating the trade of others of the same name who had long used the name in connection with their snuff, *held*, that such corporation would be enjoined from using the name as part of its corporate name or in its business. *Id.

268. It is unfair competition to use names or symbols intended or calculated to represent that the business of one person is that of another; but equity will refuse to aid a complainant who is himself guilty of making materially false statements in connection with the property he seeks to protect. *Hilson Co. v. Foster, 80 Fed. Rep. 896 (1897).

269. If the word "Columbia" cannot be used as a trade-mark (Columbia Mills Co. v. Alcorn, 65 O. G. 1916, C. D. 1893), it is to be treated as a descriptive word to the benefit of which the first user is entitled; and no other person should be permitted to use the name as the sole mark for like goods, and in that manner mislead the public. *Morgan Envelope Co. v. Walton, 81 O. G. 1615, C. D. 1897.

XX. Geographical Names Indicating Merely Locality.

270. "Mexican," for plated silver ware, *held* geographical. Ex parte The Holmes & Edwards Silver Co., 36 MS. D., Dec., 1887 (Hall, Com'r).

271. "Atlanta," for pills, *held* geographical. Ex parte Rogers & Irwin, 38 MS. D., Oct., 1888 (Vance, Ass't Com'r).

272. Where a bill was filed for the purpose of enjoining the defendants from using the word "Rosendale" in describing their cement, and to obtain damages and an account of profits for such use, and it appeared that the suit was brought at the instance of a private party, who was only one of the many who manufactured cement at Rosendale and truly denominated their cement "Rosendale cement," *held*, that the bill should be dismissed, although conceding that the name "Rosendale cement" was understood by the public as designating the place where it was made and came from, and that the defendants untruly called their cement by that name. *New York and Rosendale Cement Co. v. Coplay Cement Co., 53 O. G. 1408, C. D. 1890.

273. If a person seeks to restrain others from using a particular trade-mark, trade-name or style of goods, he must show that he has an exclusive ownership or property therein. To show that he has a mere right, in common with others, to use it is insufficient. *Id.

274. Whether a geographical name may become a trade-mark, when adopted as such, where its owner is the owner of the place of origin, and has the monopoly of the vendible product, is perhaps an open question (cases cited); but that such a name will be protected against infringement by other persons not obtaining their products from the same locality is too well settled for discussion. (Following Canal Co. v. Clark, 13 Wall. 311, and other cases.) *La Republique Francaise v. Schultz, 57 Fed. Rep. 37 (1893).

275. The word "Columbia" is not a valid trade-mark, because it is not the subject of exclusive appropriation under the general rule that a word or words in common use as designating locality or section of a country cannot be appropriated by any one as his exclusive trade-mark. (Canal Co. v. Clark 13 Wall. 311; Hoehler v. Sanders, 122 N. Y. 65; Connell v. Reed, 128 Mass. 477; Glendon Iron Co. v. Uhler, 75 Pa. St. 467; Loughman v. Piper, 128 Pa. St. 1; Amoskeag Mfg. Co. v. Spear, 2 Sandf. 599.) *Columbia Mill Co. v. Alcorn, 65 O. G. 1916, C. D. 1893, 150 U. S. 160.

276. "Turkish" *held* not registrable for a veterinary remedy, because geographical. Ex parte Nau, 55 MS. D., July, 1894 (Fisher, Ass't Com'r).

277. "New England," as trade-mark for crackers, biscuit, etc., *held* geographical. Ex parte Schmidt Baking Co., 55 MS. D., July, 1894 (Fisher, Ass't Com'r).

278. "Columbia," as trade-mark for water-wheels, *held* geographical. Ex parte The James Leffel Co., 55 MS. D., Aug., 1894 (Fisher, Acting Com'r).

279. "Bay State," as trade-mark for optical goods, *held* geographical. Ex parte Bay State Optical Co., 57 MS. D., Aug., 1895 (Fisher, Acting Com'r).

280. "Crawford," for bicycles, *held* merely geographical, besides being objectionable as the name of the applicant. Ex parte The Crawford Mfg. Co., 57 MS. D., Aug., 1895 (Fisher, Acting Com'r).

281. "Cedar Valley," as a trade-mark for spirituous liquors, refused as geographical. Ex parte Bowman, 57 MS. D., Sept., 1895 (Fisher, Acting Com'r).

282. The head of an Indian and the words "North America" refused registration on the ground that the words are geographical and the head had been anticipated. Ex parte Spencer, 57 MS. D., Sept., 1895 (Fisher, Acting Com'r).

283. "The 'Formosa' Doubly Woven Finger Tips," as a trade-mark for gloves, refused registration on the ground that "Doubly Woven Finger Tips" is descriptive and "Formosa" is geographical. Ex parte Lord & Taylor, 58 MS. D., Nov., 1895 (Fisher, Acting Com'r).

284. "Argyle," as a trade-mark for bitters, *held* geographical. Ex parte Brunswig, 58 MS. D., Oct., 1895 (Fisher, Acting Com'r).

(This case subsequently remanded to examiner without prejudice, and, upon further consideration, registration allowed.)

285. The words "Green Mountain," applied to grapes and provisions and indicating local origin, *held* not to constitute a valid trade-mark. *Hoyt v. J. T. Lovett Co., 71 Fed. Rep. 173 (1895).

286. Injunction granted restraining defendants from combining the words "Genesee," "Salt," "Co." and "Factory Filled" to resemble plaintiff's combination, but denied as applied to the word "Genesee" alone, which represents the locality of the manufacture, and which the defendants are entitled to use. *Genesee Salt Co. v. Burnap, 73 O. G. 451, C. D. 1895.

287. The word "Cloverdale" primarily has a geographical meaning and should not be registered. (Columbia Mill Co. v. Alcorn, 65 O. G. 1916, followed.) Ex parte Hendley, 72 O. G. 1654, C. D. 1895.

288. The classes of geographical names which may not be registered as trade-marks are: 1. Common and well-known names, such

as New York, San Francisco, United States. 2. Terms having primarily a geographical meaning; for example, those ending with such words as "city," "town," "mount" or "mont," "shire." Id.

289. "Florence," as a trade-mark for knitted goods, *held* geographical. Ex parte Camden Knitting Co., 58 MS. D., March, 1896 (Fisher, Ass't Com'r).

290. The word "Genesee," as used, obviously refers to the place of production and is not a trade-mark. The defendants may rightfully call their salt "Genesee Salt" or "Genesee County Salt," provided they do not mislead the public into buying their salt as the salt of the complainant. *Genesee Salt Co. v. Burnap, 73 Fed. Rep. 818 (1896).

291. "Old Yorkshire Hills," as a trade-mark for paper, refused registration on the ground of being geographical, and also as being anticipated by "York Mills," previously registered. Ex parte The George C. Gill Paper Co., 62 MS. D., Sept., 1897 (Greeley, Acting Com'r).

292. The manufacture of artificial Carlsbad mineral water, begun before the importation of the natural water into this country, will not be restrained, though the manufacturer will be required to use the word "artificial" upon his labels in order to describe his product more fully. *City of Carlsbad v. Schultz, 79 O. G. 1361; C. D. 1897.

293. W. used the word "Columbia," and M. used the figure of the goddess Columbia with the name "Columbia." Both marks were applied to paper, which became known by the name "Columbia." W. then added a figure of Columbia similar to that used by M. Although W. was the first to use the word "Columbia" on his goods, it cannot be said that he acquired a technical trade-mark in the word "Columbia" in view of the decision in Columbia Mills Co. v. Alcorn (150 U. S. 160). *Morgan Envelope Co. v. Walton, 81 O. G. 1615, C. D. 1897.

294. Inasmuch as W. appeared to have been the first to put upon his goods the distinguishing mark "Columbia," and as his goods were the first to become known to purchasers as "Columbia," no other person should be permitted to use the name as the sole distinguishing mark for like goods, whether expressed in letters or figures, and in that manner mislead the general public into buying his goods as those of his competitors. If the word could not be used as a trade-mark, it is to be treated as a descriptive word, to the benefit of which W. is entitled. *Id.

XXI. Geographical Names Used Arbitrarily or Fancifully.

295. "Concord," for soap, *held* arbitrary. Ex parte Proctor & Gamble, 38 MS. D., Aug., 1888 (Hall, Com'r).

296. Complainant and its predecessors had for many years manufactured and sold scythe-stones under the trade-marks "Lamoille," "Green Mountain," "Black Diamond," "Indian Pond," "Magic" and "Willoughby Lake." Defendants, having succeeded to a company which had contracted to purchase complainant's scythe-stones for a series of years, refused to carry out that contract, but, having procured quarries near to some of complainant's quarries, were manufacturing and selling scythe-stones under the above names, except that they used in place of "Willoughby Lake" "Willoughby Ridge," and in place of "Black Diamond" "Diamond Gem," these names never having been used to designate stones taken from defendants' quarries. *Held*, that a preliminary injunction would be granted restraining defendants' use of all the names whatever the decision might be were the question alone as to the terms "Willoughby Ridge" and "Diamond Gem." *A. F. Pike Mfg. Co. v. Cleveland Stone Co., 45 O. G. 947, C. D. 1888.

297. It cannot be said that the above terms, as applied to scythe-stones, indicate alone quality of the stones; but they must be held to indicate a selection and care in manufacturing. *Id.

298. The manufacturer of goods who has for many years used as a trade-mark the geographical terms "Lamoille" and "Willoughby Lake" will be protected in their use as against one who does not carry on business in the districts so designated. *Id.

299. The word "Dover" *held* to be registrable as a trade-mark, it not being used by applicant in its geographical but in a fanciful or arbitrary sense. Ex parte Dover Stamping Co., 51 O. G. 1784, C. D. 1890.

300. The word "Cromarty," being the name of a town in Scotland famous for its herring fisheries, is not registrable as a trade-mark for cured fish. Others with at least equal truth might use it upon packages containing the same article of merchandise. Ex parte Proctor, Jr., 51 O. G. 1785, C. D. 1890.

301. The word "Vienna" declared entitled to registration as a trade-mark for flour, it appearing that no flour made in any town called "Vienna" in this country has been placed upon

the market under the name "Vienna;" that no flour is upon the market coming from Vienna, Austria; that the word was arbitrarily selected by the petitioner, and that it is the custom in the flour trade to use fanciful names to designate flour, rather than the names of places of production. Ex parte Jenkins, 53 O. G. 759, C. D. 1890.

302. While the fact that flour from Vienna, Austria, is not on sale upon this market would not of itself authorize registration, when foreign commerce is invoked as a basis of registration, it does not appear in the present case that flour from Vienna, Austria, has any reputation in the markets of the world or that the word "Vienna" would indicate to a purchaser that the flour upon which it was used came from that city. Id.

303. "Berlin" *held* registrable for cotton goods known as silesia, since it had no connection with the city of that name, and it was not shown that such place was well known as producing the article to which the mark was to be applied. Ex parte Hyde and Son, 45 MS. D., 246, 3 G. W. D., Jan., 1891 (Fisher, Ass't Com'r).

304. A mere geographical name is not registrable as a trade-mark unless from some unusual state of facts it has obtained an arbitrary or fanciful meaning of greater substance and value than its mere geographical sense. Ex parte American Saw Co., 58 O. G. 521, C. D. 1892.

305. The name "Columbia" as applied to a hotel is a fanciful name, indicating no people, no locality, and no particular service which a hotel will render, and the person first selecting it is entitled to its use. ‡Whitfield v. Loveless, 64 O. G. 412, C. D. 1893.

(See decision of supreme court in Columbia Mill Co. v. Alcorn, 65 O. G. 1916, C. D. 1893.)

306. A name, although generic and geographical, is within the rule of protection in law if it does not indicate that the business carried on is to be patronized by the people of any particular locality, or that any specific product is therein to be sold, or any particular language is there to be spoken. ‡Id.

307. The registration of the word "Florentine" as a trade-mark for glass granted, as Florence is not noted as a place for the manufacture of glass, and therefore no deception as to the quality or origin of the manufacture can occur. Ex parte Mississippi Glass Co., 64 O. G. 713, C. D. 1893.

308. As was held in Ex parte Green (8 O. G. 1875), "a geographical name, like any other word, may be chosen and arbitrarily applied, and in such instance become a lawful trade-mark." Id.

309. The word "Waverley," while it is used to designate localities, yet it is not "merely a geographical name" in the sense employed by the supreme court in Columbia Mill Co. v. Alcorn (65 O. G. 1916), and may be registered. Ex parte Indiana Bicycle Co., 72 O. G. 1654, C. D. 1895.

310. "Como," for water-closets, *held* not merely geographical in character. Ex parte L. M. Rumsey Mfg. Co., 58 MS. D., Jan., 1896 (Fisher, Ass't Com'r).

311. "Runnymede," as a trade-mark for whisky, *held* to be used in a romantic sense overcoming its geographical significance. Ex parte The Mellwood Distillery Co., 58 MS. D., Jan., 1896 (Fisher, Ass't Com'r).

312. "Berkeley," for whisky, registered upon evidence that it was a family name, used in New York, and had no connection with any place of that name, and that registration had been once granted to another party. (Rehearing.) Ex parte Nicholas, 58 MS. D. 315, Feb., 1896 (Fisher, Ass't Com'r).

313. The word "Alpine," as a trade-mark for medicinal lozenges, *held* fanciful, and not geographical. Ex parte Haviland, 59 MS. D., June, 1896 (Fisher, Acting Com'r).

314. Words which in their primary signification are not geographical, even though they appear in the Postal Guide or similar publications, are registrable. Such words as "Trilby," "Creole," "Puritan," "Volunteer," are good examples of this class. They are not words in common use as designating locality or section of a country. Ex parte Hendley, 72 O. G. 1654, C. D. 1895.

315. While it is true that "Menlo Park" is a geographical term, it does not stand on the same footing as the word "Columbia" or "Lackawanna" or "International" or "East India," all of which have been held not to be lawful trade-marks. (Columbia Mills v. Alcorn, 65 O. G. 1916.) Ex parte Hampden Watch Co., 81 O. G. 1282, C. D. 1897.

316. While it is true that Menlo Park is the name of a small town in New Jersey and is also the name of a town in San Mateo county, California, it does not appear that either of these localities is a manufacturing town. Certainly in neither of these towns is the manufacture of watch movements carried on. (Examiner reversed.) Id.

XXII. Good-Will.

(See Assignment, *supra.*)

317. Where the proprietor of a medicine transfers the right to use his trade-mark and formula without transferring the place of manufacture, or plant used, or the good-will of the business, and there is no exclusive right to manufacture the medicine in any one, and there is nothing in the trade-mark to indicate that the medicine comes from a particular manufactory, the grantee cannot restrain another person from using it, as the only effect of the trade-mark is to indicate a class of goods which any one who knows how may manufacture. ‡Chadwick v. Covell, 51 O. G. 2087, C. D. 1890.

318. Where the said proprietor of said trade-mark and formula had no exclusive right to the use of his formula, *held*, that his only right was to prevent any one from obtaining or using said formula through a breach of trust or contract, and that any one who came honestly to the knowledge of it could use it without the proprietor's permission and against his will. ‡Id.

319. *Held*, that the title "Prince's Metallic Paint" had become so localized — so identified with the Prince Mine and place of manufacture — that it was inseparable therefrom (cases cited), and the trade-mark passed as an incident of the property with the possession of the works. *Prince's Metallic Paint Co. v. Prince Mfg. Co., 57 Fed. Rep. 938 (1893).

320. A trade-mark is a means for rendering more distinctive and valuable the "good-will" of a business. The right to the mark will ordinarily pass, as incidental to the good-will, to a successor who takes the business, and it becomes extinct when the business, including the good-will, becomes extinct. *Royal Baking Powder Co. v. Raymond, 70 Fed. Rep. 376 (1895).

321. The good-will may persist for a time after the business itself has ceased. It, including the trade-marks used, may exist even for a series of years after the stoppage of business by accident or design, and may be found valuable upon resumption. *Id.

(The sale of a business is the sale of the good-will, and good-will need not be in evidence. *Browne on Trade-marks, sec. 522.)

XXIII. Infringement.

(See Fraud; Injunction.)

(a) *In General.*

322. The mere addition of the word "improved" will not justify the use of a trade-mark which is objectionable because of resemblance to a trade-mark in use by another person. ‡Russia Cement Co. v. La Page, 44 O. G. 823, C. D. 1888.

323. Where in suit for the infringement of a trade-mark exhibits of the devices used by both complainant and defendant accompany the bill, the court will sustain a demurrer to the bill where the exhibits show that there is no infringement. *Collins Chemical and Mfg. Co. v. Capitol City Mfg. Co., 52 O. G. 162, C. D. 1890.

324. The sale of merchandise in bulk under a trade-mark of the maker does not justify the vendee in using the same trade-mark on smaller and retail packages. *Krauss v. Jos. R. Peebles' Sons' Co., 58 Fed. Rep. 585 (1893).

325. The court may compare the trade-mark of complainant with the device used by the respondent to determine their identity, and does not necessarily require the testimony of witnesses to prove the likeness. *Von Mumm v. Frash, 68 O. G. 143, C. D. 1894.

326. Selling an imitation, as such, without any suggestion or arrangement that it be sold again for the genuine article, although with assent to such suggestions from others, does not infringe the right of the manufacturer of the genuine. *Hostetter Co. v. Van Vorst, 69 O. G. 1648, C. D. 1894.

327. The likelihood of deception of an ordinary purchaser exercising ordinary care is the test applied to alleged infringement of trade-marks, but regard must be had to the class of persons who purchase the article for consumption, and also to the circumstances ordinarily attending their purchase. In determining whether packages are so dressed up as to deceive purchasers, we should regard rather the effect on the consumer than the jobber. In such cases the danger of deception rather than the intent governs the court. *N. K. Fairbank Co. v. R. W. Bell Mfg. Co., 77 Fed. Rep. 869 (1897).

328. A decree of a circuit court in one circuit enjoining infringement and unfair competition is not conclusive in a suit by the same party in another circuit against an agent of the principal where such decree is merely interlocutory and still subject to the control or modification of the court. *Walter Baker & Co., Limited, v. Sanders, 80 O. G. 1476, C. D. 1897.

(b) *Particular Cases.*

329. Trade-mark must be confined to the name adopted, with the form and color of the

letters used on the printed label. *Held*, that the title or name "Sapota Tolu" is not infringed by "Elastic Tolu." *Adams v. Heisel, 31 Fed. Rep. 279 (1891).

330. The word "Celluloid" is a lawful trade-mark, and the word "Cellonite" is sufficiently like it to produce the mischief which is in the purview of the law. "Cellonite Manufacturing Company" is an infringement of "Celluloid Manufacturing Company." *Celluloid Mfg. Co. v. Cellonite Mfg. Co., 41 O. G. 693, C. D. 1887.

331. When a trade-mark has been extensively used nearly twenty years prior to date of suit, and there is no evidence of fraud, or even knowledge of complainants' right, on the part of the defendant, he cannot be held liable to account for past sales and damages in view of such laches. *Low v. Fels, 35 Fed. Rep. 361 (1888).

332. The complainant's mark—a star made of tin a little over one-half inch in diameter, having five points and a round hole in the center and attached to the plug by prongs at the back—is not infringed by the defendant's mark, consisting of a round piece of gilded paper over three-fourths of an inch in diameter, having on it a red star, under which the word "Light" is printed, forming by the figure and word the word "Starlight." *The Liggett and Myers Tobacco Co. v. Finzer, 45 O. G. 943, C. D. 1888.

333. The head of an elk and the word "Elk," *held* a valid trade-mark, and infringed by substantially the same symbols. *Lichtenstein v. Goldsmith, 37 Fed. Rep. 359 (1889).

334. Where it is charged that the defendant has imitated the packages of the plaintiff for the purpose of imposing the goods of the former upon the public as those of the latter, not only must the fact of imitation be shown, but it must also appear that the imitation was made with intent to impose upon the public as aforesaid, and such intention may be presumed from the fact of imitation; but the presumption is not conclusive, and may be overcome by facts showing that the imitation was for other and innocent purposes. ‡Hoeb v. Bishop, 49 O. G. 1845, C. D. 1889.

335. Complainant puts up its hair-crimpers in packages, in a red pasteboard box, on the cover of which is a white label with a black border and in the center the head of a woman with hair curled, together with the words "Madam Louie, Common-Sense Hair-Crimper." Defendant dealt in crimpers packed in a similar manner, in red boxes with white labels, and in the center of the label is the head of a female surrounded by the words "The Langtry, Elegantes, One gross No. 1, Black, Hair-Crimpers." Complainant's crimpers were smaller than defendant's and much heavier, and the wrappers were unlike in length and in the words printed thereon. Defendant had the prior right to the use of the white label and the central vignette, and the labels were dissimilar in form, language, type and general appearance. There was no evidence that any one was ever misled by any resemblance between the two. *Held*, that defendant did not infringe complainant's trade-mark. *Philadelphia Novelty Mfg. Co. v. Rouss, 50 O. G. 1594, C. D. 1890.

336. In a suit for infringement, although it seemed to be clear that when the defendants made what are known as "Warren Hose-Supporters" they had the right to designate them as such, *held*, that that did not include the right to represent in any manner that their goods came from others, and that complainants' trade-mark was infringed by the use of the word "Warranted" in place of "Warren," with a cut similar to that of complainants' label, and with numbers and words indicating sizes and quantity in similarity to those on complainants' label. *Frost v. Rindskopf, 51 O. G. 1131, C. D. 1890.

337. Where in an action for infringement the complaint alleged that defendants had appropriated and used on their advertisements, circulars, letter-heads, etc., relating to their publication, the device of an open book which complainants had theretofore been in the habit of using for like purposes; that defendants used the words "Webster's Dictionary" or "Webster's Unabridged Dictionary" placed in the same relation to their publication that complainants placed them, and that the date of defendants' publication on the title-page was given as of the year 1890, when, in fact, the book was a reprint or photolithographic copy of the edition of Webster's Dictionary of 1847, *held* that, as there might be some evidence of a fraudulent intent on defendants' part to get the benefit of the reputation of the edition of Webster's Dictionary published by complainants, and as the public might possibly be deceived and the complainants damaged to some extent in consequence of the facts averred, a demurrer to the complaint should be overruled. *Merriam v. Holloway Publishing Co., 53 O. G. 1409, C. D. 1890.

338. A trade-mark with the words "Brown's

Iron Tonic" upon it does not infringe another bearing the words "Brown's Iron Bitters," when the cartons and bottles in which the two medicines were offered to the public were wholly different in size, color and appearance, and the labels and wrappers were correspondingly different. *Brown Chemical Co. v. Meyer, 55 O. G. 287, C. D. 1891.

339. Plaintiff having failed to establish the existence of a trade-mark in the letters "LL" or that they constitute a material element in its trade-mark, relief cannot be accorded upon the ground of an infringement by defendant of an exclusive right in the plaintiff to use the letters as against all the world. *Lawrence Mfg. Co. v. Tennessee Mfg. Co., 55 O. G. 1528, C. D. 1891.

("LL" indicated class or quality and were used by other manufacturers.)

340. Complainants' trade-mark "G. F." *held* infringed by the use of defendants' trade-mark "G. & F." on a similar class of goods, with the ampersand much smaller than the initials, when as registered and used on other goods the ampersand and initials are of uniform size. *Giron v. Gartner, 57 O. G. 1430, C. D. 1891.

341. "Bromidia," a coined word, *held* a lawful trade-mark, and defendant's use of it *held* an infringement, although in respect to the rest of the title and the appearance of the label there was a considerable dissimilarity. *Battle & Co. v. Finlay, 45 Fed. Rep. 796 (1891).

342. Complainants' and defendants' wrappers and labels for tobacco packages so closely resemble each other as to deceive dealers and purchasers, although the names "Sweet Lotus" and "Peach Blossom," used by the respective parties, are not similar. *Wellman & Dwire Tobacco Co. v. Ware Tobacco Works, 46 Fed. Rep. 289 (1891).

343. The words "Cramp Cure" were described in the statement as used in connection with a pictorial illustration but not as an essential part of the trade-mark. *Held*, that a suit for infringement could not be maintained, the words being descriptive. *L. H. Harris Drug Co. v. Stucky, 46 Fed. Rep. 624 (1891).

344. The complainant's place of business was in Paris, Kentucky, and the defendant's in Boston. Complainant had no knowledge of defendant's label or infringement prior to 1889, and suit was brought in 1890. *Held*, there was no laches. *G. G. White Co. v. Miller, 50 Fed. Rep. 277 (1892).

345. The trade-mark consisting mainly of the picture of a chicken cock standing upright within a circle, surrounded by the words "Old Bourbon Whiskey, Bourbon County, Ky.," *held* infringed by a trade-mark consisting of a cock standing upright in a circle, the whiskies to which such marks were applied being known respectively as "Chicken Cock" and "Game Cock." *Id.

346. The word "Lone" prefixed to Star, *held* not to avoid infringement of complainant's Star trade-mark. *Hutchinson v. Covert, 50 Fed. Rep. 832 (1892).

347. "Epicure" was used by complainant as a trade-mark for canned salmon, and a business built up under it. At a prior date defendants had used the word as a trade-mark for canned tomatoes and canned peaches. *Held*, this did not entitle the defendants to use it on canned goods of every variety, salmon included. *George v. Smith, 52 Fed. Rep. 830 (1892).

348. Hohner's harmonicas are made in Würtemberg and sold in this country under his name. Defendant uses the word "Improved Hohner" with other less prominent advertising matter. *Held*, this constitutes infringement. *Hohner v. Gratz, 52 Fed. Rep. 871 (1892).

349. Complainant's trade-mark — a representation of the sun and rays with a certain legend on the face thereof,—*held* not infringed by a design having an imperfect outline resembling the sun's rays, but having a distinctly-different and prominently-printed legend, and where it does not appear that the alleged infringing device ever worked deception upon a purchaser. *Jaros Hygienic Underwear Co. v. Simons, 58 O. G. 1095, C. D. 1892.

350. Complainant, California Fig Syrup Company, manufactured a syrup from figs and put it up in packages, having as a device thereon a fig-tree, with leaves and fruit, and the words "Syrup of Figs" as a trade-mark. Respondent, Improved Fig Syrup Company, made and put up the same article in a package with the same device and the words "Improved Syrup of Figs" as a trade-mark. Respondent, on remonstrance, changed its device to the figure of a woman holding up a fig, with the words "Fig Syrup" as a trade-mark, all of which occupied the same place and space on the package as complainant's device and was, besides, an imitation of complainant's newspaper advertising device. *Held*, that complainant was entitled to an injunction. *California Fig Syrup Co. v. Improved Fig Syrup Co., 61 O. G. 155, C. D. 1892.

351. A trade-mark consisting of the word

"Star" and the symbol of a star is infringed by marking similar goods with a star and crescent, making the star so prominent that such goods may also be designated as "Star Goods," and purchasers may be readily deceived into the belief that the goods were made by the proprietors of the trade-mark, even though the star so used is not of the color usually employed for the trade-mark, and of a five-pointed star, while that in the trade-mark is uniformly six-pointed. *Hutchinson v. Blumberg, 61 O. G. 1017, C. D. 1892.

(See foot-note under "Alternatives.")

352. "One Night Cure," *held* not infringed by words "Beshore One Night Cough Cure." *Kohler Mfg. Co. v. Beshore, 62 O. G. 592, C. D. 1892.

353. A [illegible] registration *held* conclusive as to description of plaintiff's mark where he sought to enlarge its terms on a suit for infringement. *Id.

354. Defendants infringe the trade-mark rights of the California Fig Syrup Company when they apply to their laxative compound the name "Syrup of Figs" or any colorable imitation of that name, as such a name does not describe defendants' compound, but merely serves to induce the public to believe that the goods made and sold by them are those manufactured by the California Fig Syrup Company. *Improved Fig Syrup Co. v. California Fig Syrup Co., 64 O. G. 158, C. D. 1893.

355. While there may be a difference between defendants' packages of laxative compound and the packages of the California Fig Syrup Company's laxative compound, and such a difference as to probably put the general trade dealer on his guard, yet, defendants having adopted the trade-name of the California Fig Syrup Company, the consumer is likely to be deceived thereby, and it is against the probability of such imposition upon the consuming class of the public that courts will extend their protection. *Id.

356. Two classes of labels are recognized by cigar manufacturers—"factory brands" and "customers' brands." The latter are originated by a customer, and used only on goods manufactured for him. A cigar merchant ordered a lot of cigars, of a certain size and quality, under the name of "Blackstone," which he originated. This order the manufacturer filled; but the cigars were not taken by the merchant, and were sold to other parties. *Held*, that the manufacturer acquired no right to use the word "Blackstone" as a trade-mark. *Levy v. Waitt, 65 O. G. 893, C. D. 1893.

357. "One Night Cure," used as a trade-mark for a cough remedy and for a corn remedy, is not infringed by the use of the words "Beshore's One Night Cough Cure." (62 O. G. 592, 53 Fed. Rep. 262, affirmed.) *Kohler Mfg. Co. v. Beshore, 67 O. G. 678, C. D. 1894.

358. When the complainants applied a name to a small lot of cigars made to a special order in 1878, and did not again apply the name to cigars until 1884, and then for the purpose of competing with another party who had applied the same name to cigars in 1881, and not again until 1889, and when the defendants, in 1885, without knowledge of what had been done by complainants, and in good faith, applied the name to cigars of their own manufacture, and made continued and extensive sales and advertisements thereof for five years without objection, *held*, that the complainants are not entitled to assert a right to a trade-mark in the name as against the defendants. *Levy v. Waitt, 68 O. G. 1521, C. D. 1894.

359. The use of the word "Cottoleo" on the tierces and tubs containing a compound of cotton-seed oil and the product of beef-fat is an infringement of the trade-mark "Cottolene" previously registered for the sale of the same substance and used in marking tierces and tubs. *N. K. Fairbank Co. v. Central Lard Co., 70 O. G. 635, C. D. 1895.

360. It is no defense to a suit for infringement of the trade-mark "Cottolene" by the use of the word "Cottoleo" that defendant sold under his own name, and made no attempt, other than by the use of the word "Cottoleo," to sell his goods as if manufactured by plaintiff. *Id.

361. Where the defendant had the right to use the words "Waukesha Hygeia Mineral Springs" and the complainant the word "Hygeia" as trade-marks, *held*, that the defendant did not infringe the complainant's mark by making the word "Hygeia" more conspicuous than other words. *Waukesha Hygeia Mineral Springs Co. v. Hygeia Sparkling Distilled Water Co., 70 O. G. 1321, C. D. 1895.

362. The word "Mojava" so nearly resembles "Momaja" as to cause confusion. *American Grocery Co. v. Bennett, Sloan & Co., 71 O. G. 1770, C. D. 1895.

363. The registered trade-mark "S. B.," for cough drops, *held* not infringed by the use of

the trade-mark "B. & S." *Burt v. Smith, 71 Fed. Rep. 101 (1895).

364. M. A. Thedford, being engaged with others, under the firm-name of M. A. Thedford & Co., in the manufacture and sale of "Simmons' Liver Medicine," sold to his partners all his rights therein, and bound himself not to engage in manufacturing the said medicine "under any name or style." Afterward he formed a partnership, under the firm-name of M. A. Thedford Medicine Company, which made and sold a compound called "M. A. Thedford's Liver Invigorator," which they placed upon the market in wrappers and packages and with symbols and literature calculated to induce the belief that it was the "Simmons' Liver Medicine." *Held*, that this was a clear infringement upon the rights of his transferees, and that it was no defense that the latter had discontinued the use of the word "Simmons" and called their medicine "M. A. Thedford & Co.'s Original and Only Genuine Liver Medicine, or Black Draught." (58 Fed. Rep. 347, reversed.) *Chattanooga Medicine Co. v. Thedford, 73 O. G. 2163, C. D. 1895.

365. A trade-mark consisting of a label upon which appears, on a white background, in two colors—red and black—certain words, in the midst of which is displayed, in a large-sized cut, in prominent black colors, an old-fashioned flat-iron, is not infringed by another trade-mark in the form of a label having certain words prominently displayed on a deep-red background, in three colors—white, yellow, and black—having about the middle of this display, on a steel-colored background, a full-length picture of a colored woman holding up prominently in her extended arms a freshly-ironed shirt-bosom, underneath which is a table, upon which appears a diminutive-sized flat-iron. The phraseology, the display, the colors, and the symbols of the two labels are each and all essentially different. *J. C. Hubinger Bros. Co. v. Eddy, 76 O. G. 1120, C. D. 1896.

366. No trader can adopt a trade-mark so resembling that of another trader as that ordinary purchasers, buying with ordinary caution, are likely to be misled. No person of ordinary discernment could be deceived by the presence of this little iron, and any supposed similarity between it and the complainants' widely-displayed large flat-iron, and thus led to believe he was purchasing complainants' article [illegible].

367. "Fairbank's Gold Dust" soap was put up in yellow paper and "Buffalo Soap Powder" was put up in a similar wrapper. *Held*, that a buyer of ordinary prudence would not be imposed upon by the similarity of the yellow packages in view of the printed matter thereon. (Following Novelty Co. v. Blakesley, 40 Fed. Rep. 588; Novelty Co. v. Rouss, id. 585; Munn v. Kirk, id. 589.) *N. K. Fairbank Co. v. R. W. Bell Mfg. Co., 71 Fed. Rep. 295 (1896).

368. "Curative" for soap, *held* an infringement of the coined word "Cuticura." *Potter Drug & Chemical Corporation v. Miller, 75 Fed. Rep. 657 (1896).

369. The words "German Sweet Chocolate" (German being the name of the individual who registered the trade-mark) are proper in a trade-mark, since "German" is not used in a geographical sense, and is infringed by the words "Germania Sweet Chocolate." *Walter Baker & Co., Limited, v. Baker, 78 O. G. 1427, C. D. 1897.

370. *Held*, that the Greek cross has not such individuality as to give the complainants the exclusive right to use it; and *held*, that the Maltese cross, having a red center and dark projections, is not an infringement of it. *Johnson v. Bauer, 79 Fed. Rep. 954 (1896).

371. "No-To-Bac," *held* an arbitrary term, and not infringed by "Baco-Curo," also an arbitrary term. The test is whether one is likely to be taken for the other by persons of ordinary intelligence. *Sterling Remedy Co. v. Eureka Chemical and Mfg. Co., 80 Fed. Rep. 105 (1897).

372. A trade-mark consisting of a red Greek cross, used to designate "Red Cross Plasters," is infringed by a Maltese cross having a red center. *Johnson & Johnson v. Bauer & Black, 82 Fed. Rep. 662 (1897).

XXIV. Injunction.

(See Fraud; Infringement.)

373. The marks, designs, symbols, directions and other *indicia* placed upon the boxes or packages containing the articles upon which the patent had expired may be treated as a kind of trade-mark, and a manifest imitation be enjoined. Greene v. Woodhouse, 38 O. G. 1491, C. D. 1887.

374. Equity will enjoin the fraudulent use of bottles having complainant's name blown in them. It will also enjoin the fraudulent

ner of a bottle having the same general appearance as that employed by complainant. *Sawyer Crystal Blue Co. v. Hubbard, 41 O. G. 580, C. D. 1887.

375. A court of equity will prevent the piracy of a business name, and the fact that the defendant's name is a corporate name is of no moment. *Celluloid Mfg. Co. v. Cellonite Mfg. Co., 41 O. G. 693, C. D. 1887.

376. An injunction declared for the word "Chatter-box" as a trade-mark name for juvenile books, although it had been previously used on other publications, for youthful persons. The defendant's publications were similar to the plaintiff's in external appearance, but their contents were dissimilar. *Estes v. Worthington, 31 Fed. Rep. 151 (1887).

377. Injunction under Trade-mark No. 16,473, registered April 9, 1889, by Moses Lyman, for a game, "Pigs in Clover." *Lyman v. Burns, 47 O. G. 669, C. D. 1889.

378. The word "Valvoline," compounded and used on packages of lubricating-oils by plaintiffs, and registered as a trade-mark, may be used for that purpose, and the use thereof by defendant in the same manner will be enjoined, though defendant uses his own name in connection with the word. *Leonard v. White's Golden Lubricator Co., 48 O. G. 1401, C. D. 1889.

379. In a suit to restrain use of plaintiff's trade-name or trade-mark applied by him to an article for which he had obtained a patent, *held*, no action for violation of right to the name apart from right to the patent could be maintained. ‡Waterman v. Shipman, 49 O. G. 892, C. D. 1889.

380. In such case plaintiff must obtain redress either by a suit for infringement of the patent, if he has a legal title to the patent, of which the federal courts alone have jurisdiction, or by a direct action to compel a re-assignment of the patent, in which the defendants can be made to account for any profits. ‡Id.

381. The manufacture of an uncooked pudding, put up in packages under the trade-mark name of "Puddine," cannot enjoin the maker of a similar preparation from using the word "Pudding" in describing it. *Clotworthy v. Schepp, 52 O. G. 161, C. D. 1890.

382. The use of the word "Rose" in connection with the word "Vanilla" as a trade-mark is no ground for enjoining a rival maker of similar products containing those well-known flavors from using these words in describing his goods. *Id.

383. A manufacturer who falsely represents the composition of his goods by the labels on his packages is in no position to enjoin a rival manufacturer from using similar labels and packages, on the ground that the latter thereby deceives the public. *Id.

384. As it appears that the plaintiff manufactures and sells Hostetter's Bitters" and is the owner of trade-marks, brands, labels, etc., used in connection with such sale; that the defendant makes an article closely resembling such bitters, which it sells in bulk, advising its customers to refill bottles that had originally contained Hostetter's Bitters with the spurious article, and to offer them for sale, it is *held* that the plaintiff is entitled to an injunction restraining the defendant from selling the spurious article, and that the customers using the bottles and labels in the way indicated are guilty of a wrongful act, which a court of equity will enjoin. *Hostetter Co. v. Brueggeman-Reinhart Distilling Co., 56 O. G. 530, C. D. 1891.

385. A manufacturer of cigars whose goods are protected by trade-mark is entitled to an injunction against a manufacturer of cigar-boxes who, although he does not make cigars, furnishes the trade with boxes supplied with labels confessedly counterfeits of the complainant's registered mark. *Cuervo v. Jacob Henkell Co., 60 O. G. 440, C. D. 1892.

386. The fact that plaintiff's trade-mark, "Syrup of Figs," being merely descriptive, was deceptive as a designation of the compound did not affect plaintiff's right to an injunction, the matter in controversy being not the right to the exclusive use of the words, but respondent's simulation of complainant's devices and packages with a view to deceive customers. *California Fig Syrup Co. v. Improved Fig Syrup Co., 61 O. G. 155, C. D. 1892.

387. The facts that the infringer of a trade-mark, on being notified of his infringement, told his customers to erase the trade-marks from their goods and had since gone out of business, are not ground for denying an injunction to the true owner of the trade-mark, where every step of the suit for an injunction and accounting has been contested by the infringer, and he has put the complainants to the expense of proving every fact necessary to establish their right and his infringement. *Hutchinson v. Blumberg, 61 O. G. 1017, C. D. 1892.

388. Query, whether equity will intervene by injunction to protect the use of words claimed

as a trade-mark between owners of quack medicines. *Kohler Mfg. Co. v. Beshore, 67 O. G. 678, C. D. 1891.

389. It seems that an injunction should not be granted to protect the use of words as the trade-mark of a medicinal preparation which assert a manifest falsehood or physiological impossibility. *Id.

390. In such a suit the statement filed to obtain registration and attached to the affidavits on motion for a preliminary injunction may be considered on the final hearing. *Id.

391. The words "Social Register," as applied to a list of persons resident in a certain locality, compiled by its publisher with reference to the personal and social standing of such persons, constitute a valid trade-mark, and their use by the publisher of a competing list will be restrained. *Social Register Association v. Howard, 67 O. G. 1448, C. D. 1894.

392. Plaintiffs have used the name "Carlsbad" on genuine "Carlsbad Sprudel Salts," and defendants used it upon artificial salts having no connection with that name. *Held*, that this was calculated to deceive customers, and injunction granted. *City of Carlsbad v. Kutnow, 68 Fed. Rep. 794 (1895).

393. Complainants sold Hostetter's Bitters. Defendants sold bitters called "Host-Style Bitters" and put them in bottles bearing Hostetter labels. Injunction granted. *Held*, also, that defendant might use "Host-Style," provided he did not simulate any labels of complainant. *Hostetter Co. v. Becker, 73 Fed. Rep. 297 (1896).

394. Where the court had decreed that the defendant company be enjoined from using, selling, or placing upon the market in connection with hooks and eyes the name "De Long" alone or with other words in any manner which might deceive the public as to the identity of the goods sold by the plaintiffs and defendant, respectively, the use by the president of the defendant company of the words "Oscar A. De Long Hook" was a violation of the injunction. ‡De Long v. De Long Hook and Eye Co., 74 O. G. 811, C. D. 1896.

395. Where it is shown that defendant failed to accompany the use of the word "Singer" on the machines made and sold by it with sufficient notice of their source of manufacture to prevent them from being bought as machines made by the Singer Manufacturing Company, and thus operate an injury to private rights and a deceit upon the public, *held*, that he should be enjoined from using the word "Singer" or any equivalent thereto upon sewing machines or upon any plate or device connected therewith or attached thereto without clearly and unmistakably specifying in connection therewith that such machines are the product of the defendant or a manufacturer other than the Singer Manufacturing Company. *Singer Mfg. Co. v. June Mfg. Co., 75 O. G. 1703, C. D. 1896.

396. Complainant is entitled to an injunction *pendente lite* against the further use by defendants of a square-shaped bulging-necked bottle as a package for "Mount Vernon" whisky, when it appears that complainant was the first to use a bottle of this shape as a package for whisky, and when it also appears that said shape has come to be principally, if not exclusively, relied upon by ordinary customers as a means of identifying this bottling of "Mount Vernon" whisky from all other bottlings. *Cook & Bernheimer Co. v. Ross, 76 O. G. 613, C. D. 1896.

397. Where it clearly appeared that the use by defendants of the name "The Tuerk Water-Meter Company" and the practice in respect thereto adopted by the defendants led to confusion arising from its similarity to the name of the motor of the plaintiff, and that the similarity was such as to cause persons dealing in the articles to suppose it to be the same, *held*, that defendants should be restrained from using the name of "The Tuerk Water-Meter Company," or any other substantial imitation of the name "The Tuerk Water-Motor Company," by which the plaintiff is generally known, or from printing, publishing, issuing or circulating any of the cuts, pictures, prints or printed matter used by the plaintiff in catalogues or circulars prior to the formation of the defendants' firm, or any substantial imitation thereof. ‡Tuerk Hydraulic Power Co. v. Tuerk, 76 O. G. 1274, C. D. 1896.

398. Where exceptions were taken during the trial to a referee's admissions and rejections of evidence, *held*, that such exceptions should be disregarded unless the appellant can show that injustice has been done upon the whole case or that the ruling complained of may have affected the result. ‡Id.

399. It does not follow that because the complainant is not exclusively entitled to use the words "Clark's Spool Cotton" that therefore it cannot rightfully enjoin a person who is fraudulently making use of its label. *Clark Thread Co. v. Armitage, 76 O. G. 1419, C. D. 1896.

400. When a trade has been built up for "Johann Hoff's Malt Extract" or "Hoff's Malt Extract," a branch house conducted by Leopold Hoff, manufacturing such extract in competition with another branch or with the original business, may not use the name of "Hoff" without indicating which of the Hoff family is the maker. *Tarrant & Co. v. Hoff, 78 O. G. 1107, C. D. 1897.

401. Equitable relief for infringement of a trade-mark will not be denied by reason of inaccurate statements in the complainant's labels when such statements are immaterial. *Id.

402. The defendants having discontinued the sale of the articles for the complainant and having also discontinued the use of the trade-mark, which had been applied thereto, a preliminary injunction is refused. *Saxlehner v. Graef, 81 O. G. 972, C. D. 1897.

403. The question as to whether laches or inaction has in any way impaired the complainant's right to an injunction and whether the continued use of the word "Hunyadi" after sale of complainant's water was discontinued was or was not proper may appropriately be left for final hearing where it appears that this word is not now being used. *Id.

404. Defendants having been the exclusive importers of the Hunyadi Janos waters and having pasted their own individual mark on each bottle sold by them, in addition to the mark of the complainant, and having discontinued the sale of such waters, *held*, that they cannot be restrained from placing the same individual mark on the water which they thereafter handle on the ground of unfair competition, since the complainant has no title to such individual mark. *Id.

XXV. Interference.

(See Use and Sale as Establishing Title.)

405. The right to registration as between two interfering applicants or between an applicant and a registrant belongs to the one who, if a party to a suit in a court of equity, would be adjudged the owner of the trade-mark. Manitowoc Mfg. Co. v. Dickerman, 57 O. G. 1721, C. D. 1891.

406. Where the subject-matter of application for trade-mark is clearly anticipated by a mark registered under the act of 1870, and the examiner properly refused to declare an interference because of the nullity of such prior registration, and also properly refused registration to the present applicant because the prior registry makes the mark an anticipation, *held*, the proper course for the office in such a case is to give the applicant under the law of 1870 notice that an application is pending with which his registry would interfere if it were under the existing act and allow him sixty days to make a new application. Ex parte American Lead Pencil Co., 61 O. G. 151, C. D. 1892.

407. The dates of adoption as set forth in interfering applications for the registration of a trade-mark are not conclusive as to the question of lawful title to the mark. Stewart v. Einstein, v. Sawhill, 61 O. G. 287, C. D. 1892.

408. The main question to be determined in a trade-mark interference is priority of such adoption and use as will establish ownership, and this will not be determined in advance of the evidence introduced by the parties in the usual way. Id.

409. Trade-mark rule 13, which states that "each applicant and registrant will be held to the date of adoption alleged in the statement filed with his application," *held* to be not inconsistent with law, and therefore has the force of a statute. Stuart Medicine Co. v. Goldaine, 64 O. G. 1005, C. D. 1893.

410. The word "interference" in section 9 of the act establishing the court of appeals of the District of Columbia interpreted and *held* not to mean and include disputes in trade-marks under section 3 of the trade-mark law of 1881, but to be confined to an interference in patent law. *Einstein v. Sawhill, 65 O. G. 1918, C. D. 1893.

411. A trade-mark consisting of the words "Electric Light" alone and another trade-mark consisting of these words accompanied by the representation of the upper part of an electric-light bulb with zigzag rays emanating from it conflict, the words being the "prominent, essential and vital feature" of the marks, and a motion to dissolve the interference denied. Kirby v. McLaughlin & Co., v. Johnston, 72 O. G. 1785, C. D. 1895.

412. The difference in sound between "Capitol" and "Capital" is too small to be noticed by the ordinary purchaser, though the trade-marks themselves are specifically different, and motion to dissolve the interference denied. Lown v. Ohio Coffee and Spice Co., 73 O. G. 1136, C. D. 1895.

413. It is a rule applicable to trade-marks as well as patents that a motion to dissolve should not be transmitted if based on facts brought out in the testimony, instead of on the applica-

tions, or on facts which appeared of record prior to the declaration. The case must take its regular course to final hearing. Oberhaeuser and Landauer v. Pastor Kneipp Med. Co., 63 MS. D., Dec., 1897 (Greeley, Acting Com'r).

414. In interferences in trade-mark cases a broad claim should not be placed under a narrow issue, but the practice in patent cases of making the issue as broad as the broadest claim should be followed. S. Hernsheim, Bros. & Co., Limited, v. J. H. Hargrave & Son, 81 O. G. 503, C. D. 1897.

XXVI. Jurisdiction of Courts.

415. In a suit for infringement of a trade-mark when both parties are citizens of the same state, a United States circuit court can only entertain jurisdiction on the theory that the complainants have a valid trade-mark, registered pursuant to the act of March 3, 1881, and no relief can be granted because of unlawful competition in trade. The question for the court is whether the complainants have an exclusive right to the alleged trade-mark. *Luyties v. Hollender, 40 O. G. 119, C. D. 1887.

416. The jurisdiction of a court of equity to give relief against the violation of a trade-mark rests not upon the ground that the defendant is committing a fraud on the public, but entirely on the ground that the defendant is violating a property right of the complainant. ‡Schneider v. Williams, 44 O. G. 1400, C. D. 1888.

417. Under act of congress of March 3, 1881, relating to registration of trade-marks used in foreign commerce, the circuit court has no jurisdiction of a bill for infringement where both parties reside in the state and it does not appear that the trade-mark is used in foreign commerce. *Gravely v. Gravely, 53 O. G. 1538, C. D. 1890.

418. The decision of the supreme court in Trade-mark Cases (100 U. S. 82) 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 property rights in trade-marks come from the common law and not from the statute. Battle v. Finlay, 59 O. G. 2072, C. D. 1892.

419. The court of appeals of the District of Columbia has no jurisdiction of disputes in trade-marks under section 3 of the law of 1881. *Einstein v. Sawhill, 65 O. G. 1918, C. D. 1893.

XXVII. Mandamus.

420. In an application for *mandamus* to compel the collector of customs to examine into the validity of a certain registered trade-mark which he had declared simulated on certain imported goods which he had declined to admit to entry under the provisions of section 7 of the tariff act of October 1, 1890, *held*, that the circuit court had no jurisdiction to grant a *mandamus*, and that whether the decision of such officer that any particular import is within the statute's prohibition is reviewable in the courts was not before the court in this proceeding. *Vintschger et al., 60 O. G. 441, C. D. 1892.

421. The commissioner, in the present case, having exercised and exhausted his discretion, and having refused to register simply on the ground that he has decided that the act of engaging in foreign trade is *ultra vires* the relator, *held* proper case for peremptory *mandamus*, the relator having complied with the provisions of the trade-mark statute and the lawful regulations of the patent office. *United States ex rel. the State of South Carolina v. Commissioner of Patents, 65 O. G. 1221, C. D. 1893.

(Decision of the supreme court of the District of Columbia.)

422. The duties imposed upon the commissioner of patents by the trade-mark act of March 3, 1881, are not ministerial, but their discharge requires the exercise of judgment and discretion, and his action in refusing to issue a certificate of registration of a trade-mark cannot be controlled by a writ of *mandamus*. *United States ex rel. the State of South Carolina v. Commissioner of Patents, 66 O. G. 1167, C. D. 1894.

(Decision of court of appeals of the District of Columbia. For original decision of commissioner of patents, see 61 O. G. 1305, C. D. 1893.)

423. The authority to make regulations and requiring applicants to comply with them seems to imply that the commissioner is left free to institute the necessary inquiry in his own mind. *Id.

424. *Mandamus* will not lie save in a plain case and where there is no other legal remedy, and under no circumstances can the writ of *mandamus* be made to operate as a writ of error. *Id.

425. The action of the head of a department in construing the law for his guidance is not subject to revision by *mandamus*. *Id.

426. The refusal of the commissioner of patents to register a trade-mark does not involve the right to the trade-mark, but the registration of the mark, and it is the value of the registration and not the value of the trade-mark that determines the sum of money involved. *United States ex rel. the State of South Carolina v. Commissioner of Patents, 67 O. G. 1191, C. D. 1894.

427. Where upon the refusal of the commissioner to register a trade-mark a writ of *mandamus* was unsuccessfully sought against him, upon the ground that upon the facts submitted his duty was ministerial and not discretionary, no objection to the validity of the trade-mark law under which the commissioner acted being made, nor the existence or lawfulness of his authority thereunder being drawn in question, and the only controversy upon the proceedings being as to the construction of the law as to the extent of the commissioner's authority, *held*, that such controversy did not draw into question the validity of an authority exercised under the United States. *Id.

428. Neither the question whether the commissioner rightly decided upon the presumptive lawfulness of the right of the state of South Carolina to the trade-mark sought to be registered, nor the question whether his duty was of such a character that a writ of *mandamus* would lie to compel its performance, involved a question of the validity of the authority exercised by him under the United States. *Id.

(Decision of United States supreme court.)

XXVIII. Parties to Suit.

429. The bill alleged that respondents B. and others were using respondent corporation as a means of infringement, they being themselves substantially the corporation. *Held*, that there was no misjoinder in making them parties defendant. *California Fig Syrup Co. v. Improved Fig Syrup Co., 61 O. G. 155, C. D. 1892.

430. In a bill against a corporation for infringing a trade-mark plaintiff included the directors of the defendant corporation as parties defendant. Upon demurrer, *held* not a misjoinder, and demurrer overruled. *Armstrong & Co. v. Savannah Soap Works, 61 O. G. 1018, C. D. 1892.

431. A trade-mark may be adopted, owned and used by a number of parties engaged in the same business as separate firms, and all of them may join as complainants in a suit to restrain infringement. ‡Gravel Roofers' Exchange v. Turnbull, 64 O. G. 441, C. D. 1893.

XXIX. Partnership.

432. Copartners, upon a dissolution of partnership, will together be entitled to exclusive use of trade-marks of the firm, and perhaps each of them will be entitled to such exclusive use as to all persons except their associates in ownership. *New York and R. Cement Co. v. Coplay Cement Co., 45 Fed. Rep. 212 (1891).

433. Another druggist who had a commercial partnership with the physician up to the time of his death, in the business of dispensing the remedies used by the physician, the two having an extensive trade in them, domestic and foreign, has a right as surviving partner to the trade which had become established, to the good-will connected with it, and to the inchoate trade-mark right which was incident to it, at least to the extent of treating them as assets of the partnership for the purpose of closing out the partnership business. Stewart v. Einstein, v. Sawhill, 64 O. G. 1533, C. D. 1893.

XXX. Practice in Patent Office.

434. A certificate of registration of a trade-mark will not be issued to the assignee of the applicant, even though the assignment may have been previously recorded. Ex parte Bassett, 55 O. G. 997 (1891).

435. In label and trade-mark cases, as in patent cases, matters of form should be settled before the application is finally disposed of upon its merits. Ex parte Vermont Maple Sugar-Makers' Association, 52 MS. D., July, 1893 (Fisher, Ass't Com'r).

436. Where the examiner of interferences refused to recognize a concession of priority of trade-mark adoption executed by an officer of a corporation without the corporate seal, *held*, that a concession of priority is not such an instrument as requires the use of a seal by corporation or individual, and that, it satisfactorily appearing on the record that the officer was empowered to execute the paper, the office will accept it. Jersey City Packing Co. v. Jacob Dold Packing Co., 62 O. G. 317, C. D. 1893.

437. A certificate of correction refused in a trade-mark case to correct an alleged error of statement of essential features, made by applicant in complying with an official requirement. (Rehearing.) Ex parte Wood Drug Co., 53 MS. D., Jan., 1894.

438. The action of the primary examiner of trade-marks is but the report of a partial examination made by a subordinate. *United States ex rel. the State of South Carolina v. Commissioner of Patents, 66 O. G. 1167, C. D. 1894.

439. A certificate of registration will not be issued to an assignee in a trade-mark case. Ex parte Roasted Cereals Co., 57 MS. D., Sept., 1895 (Fisher, Acting Com'r).

440. The words "Black Lion" and figure of a lion for leaf tobacco, having been refused registration on a similar mark registered under the prior law, which had been declared unconstitutional, *held*, the former registrants should be notified an application is pending and sixty days allowed them to make application for new registrations. (Ex parte American Lead Pencil Co., C. D. 1892, 199.) Ex parte Hernsheim Bros. & C., Limited, 60 MS. D., Sept., 1896 (Fisher, Acting Com'r). Similar decision, on same date, in case of application by the same parties for "Black Tiger," for cigars and tobacco.

XXXI. Registration.

(See Anticipation; Class of Goods.)

(a) *In General.*

441. It was not contemplated by the act of congress and is not provided for by the rules that a certificate of registration of a trade-mark should be issued to the applicant and his assignee jointly. Ex parte Spinner, 35 MS. D., July, 1887 (Hall, Com'r).

442. The signature and oath of a firm to a trade-mark application cannot be properly made by one who is not a member of the firm but merely a so-called "director." Ex parte Kirker, Greer & Co. (Limited), 37 MS. D., July, 1888 (Hall, Com'r).

443. The certificate of registration is only *prima facie* evidence of an admission on the part of the government that the applicant for registration is the owner of a valid trade-mark. It is not a grant of any right or privilege, and does not conclude a third party. *United States v. Braun, 39 Fed. Rep. 775 (1889).

444. A trade-mark including, with other arbitrary matter, a representation of an article for which a patent is still in force may be registered. Ex parte Hurlburt Mfg. Co., 41 MS. D., Nov., 1889 (Mitchell, Com'r).

445. The incorporation of a company in the name of an article of commerce, without other specification, will not create any exclusive right to the use of the name. *Goodyear's India Rubber Glove Mfg. Co. v. The Goodyear Rubber Co., 46 O. G. 126, C. D. 1889.

446. A trade-mark adopted for use in dealing in real estate is not proper subject for registration. Ex parte Roy and Nourse, 54 O. G. 1267, C. D. 1891.

447. Where the mark sought to be registered was affixed to bill-heads, letter-heads, cards and circulars which applicants used in their business, *held*, that such a use did not come within the statute. Id.

448. Registration of signs or symbols is provided for only when they are applied to transportable articles of commerce — that is, "goods, wares and merchandise." Id.

449. The mere name of a corporation will not be registered as a trade-mark. Ex parte Creedmoor Cartridge Co., 56 O. G. 1333, C. D. 1891.

450. Whenever in the opinion of the office the thing offered for registry as a trade-mark is so nearly like some prior registered trade-mark as to be likely to lead to mistake or confusion, registration will be denied. Ex parte Coon, 58 O. G. 946, C. D. 1892.

451. An applicant will not be granted independent registration of a trade-mark when it appears that he is one of two or more parties who have a right to use such mark, section 2 of the trade-mark act requiring it to appear that than the applicant "no other person, firm or corporation has the right to such use." Ex parte Langdon, 61 O. G. 286, C. D. 1892.

452. The recital in the statement of the adoption and several transfers of the trade-mark sought to be registered, *held* allowable. Ex parte Bonnell, 52 MS. D., June, 1893 (Fisher, Ass't Com'r).

453. The commissioner must decide whether the applicant has the right to use the trade-mark at all, whether the alleged trade-mark is in itself a lawful trade-mark, or is identical with the trade-mark of another, or a deceptive imitation, or the property of the applicant. *United States ex rel. the State of South Carolina v. Commissioner of Patents, 66 O. G. 1167, C. D. 1894.

454. If the fact of registry confers any benefits, it is only those which are specially provided in the act of congress and not covered by the common-law rule. The trade-mark, when established, is valid and entitled to protection,

whether registered or not. *Waukesha Hygeia Mineral Springs Co. v. Hygeia Distilled Water Co., 70 O. G. 1319, C. D. 1895.

(After a design patent has been granted to one party, registration of the same design as a trade-mark will not be allowed to another party. Ex parte Lee & Shepard, 24 O. G. 1271, C. D. 1883.)

(b) *Particular Cases.*

455. The name of the applicant and his place of business, *held* not registrable. Ex parte Brown, 37 MS. D., July, 1888 (Hall, Com'r).

456. The words "10 cents for each one dollar," *held* not registrable, since they indicate no origin or ownership, but point merely to a source of profit, the object being the sale of the article to which the label is affixed. Ex parte Force Tobacco Co., 41 MS. D., Dec., 1889 (Mitchell, Com'r).

457. Messrs. Holt & Co., New York, N. Y., adjudged to have acquired and to hold the exclusive right to the use of the words "La Favorita," registered by them February 28, 1882, as a trade-mark for flour. *Menendez v. Holt, 46 O. G. 971, C. D. 1889.

458. But one trade-mark can be registered for goods of substantially the same descriptive properties. A trade-mark for drawers and pantaloons prohibits registration of the same mark for overalls. Ex parte Kyle & Co., 57 O. G. 274, C. D. 1891.

459. A fac-simile of the certificate issued by a state board of pharmacy to registered pharmacists is not registrable as a trade-mark. Ex parte Kuppenheimer Brothers, 60 O. G. 439, C. D. 1892.

460. "The arrangement of two panels, one in red and one in blue, each bearing a shield," etc., is proper subject-matter for a trade-mark rather than a label. Ex parte National United States Stamp Delivery Co., 60 O. G. 893, C. D. 1892.

461. A "representation of a band with eyelets therein and cross-lacings connecting the eyelets," *held* not registrable as a trade-mark, since its function is purely decorative in the connection in which it is intended for use. Ex parte Peyser & Co., 62 O. G. 588, C. D. 1893.

462. The state of South Carolina applies to register the trade-mark "Palmetto" in the patent office, to be applied by labels to bottles of intoxicating liquors to be regularly sold by the state outside its own limits in commerce with foreign nations or with Indian tribes. 1. It seems that a state may take upon itself the character of a trading corporation while retaining in other respects the essentials of a sovereign state. 2. While it is not necessary to decide how, if in any manner, a state may enter the domain of commerce, whether by an express authorizing provision in its constitution supplemented by appropriate legislation to carry it into effect, or otherwise, the executive officers of a state may not, in the absence of legislation, embark the state in such trade. 3. The act of the state of South Carolina, approved December 24, 1892, entitled "An act to prohibit the manufacture and sale of intoxicating liquors as a beverage within this state, except as herein provided," is a measure for the suppression of the liquor traffic within the state by private individuals and to substitute therefor its complete control by the state, and is not a law which authorizes a regular trade in liquors by way of sale to foreign purchasers. 4. The state of South Carolina, notwithstanding the acts of its governor and state board of control, has no authorized trade in liquors outside its own limits. It is not the owner of any trade-mark, has not at this time the right to the use of the trade-mark sought to be registered, and therefore, 5, the application is denied. Ex parte State of South Carolina, 64 O. G. 1395, C. D. 1893.

(See MANDAMUS.)

463. A druggist whose only relation with a physician was that he filled the latter's prescriptions occasionally cannot, upon the death of the physician, adopt the *fac-simile* of his signature and picture, or either of them, as a trade-mark without showing to the office in some manner the consent of the physician that this should be done, or acquiring the right to do so from the personal representative of the decedent. Stewart v. Einstein, v. Sawhill, 64 O. G. 1533, C. D. 1893.

464. The person attempting to do this is not the owner of the trade-mark; his use of it in commerce with foreign nations or otherwise is unlawful, and in interference proceedings judgment of priority cannot be rendered in his favor. Id.

465. The registry of a trade-mark, the essential feature of which is described as "the representation of a red anchor in an oval space," is not proof of intention to adopt a trade-mark consisting of the word "Anchor" and the symbol of an anchor, irrespective of color and surroundings. (Richter v. Anchor Remedy Co.

52 Fed. Rep. 455, affirmed.) *Richter v. Reynolds, 67 O. G. 404, C. D. 1894.

466. Registration of "Swan-down," for soap, refused, because the prevailing party to the interference proved no exclusive right. Tetlow v. Bloomingdale and Levy, v. Tappan, 56 MS. D., Jan., 1895 (Fisher, Ass't Com'r).

467. A device which is an entirely subordinate feature in an alleged trade-mark, and constitutes merely a printer's symbol, is public property and not registrable. Ex parte Brunswig, 57 MS. D., Aug., 1895 (Fisher, Acting Com'r).

468. The words "Silver Club" and a representation of a group of four heads, representing four congressmen noted for their advocacy of free silver, refused registration on the ground that the consent of each of the congressmen must be obtained. "Without the group of heads, the words 'Silver Club' would lose their significance." Ex parte Davis & Co., 58 MS. D., Dec., 1895 (Fisher, Ass't Com'r).

469. The difference in appearance, as written or printed, in sound and in meaning are sufficient to differentiate the words "Electric Light" from the word "Electric," and therefore the prior registration of the latter word does not bar the registration of the former words. Kirby v. McLaughlin & Co., v. Johnston, 72 O. G. 1785, C. D. 1895.

470. "League," for base-balls, *held* not registrable in view of lack of proof of exclusive right. Ex parte Spalding & Bros., 60 MS. D., Sept., 1896 (Fisher, Acting Com'r).

XXXII. Right to Use Name of Patented Article.

471. A name which has been applied in a patent to a particular article manufactured under it cannot become a trade-mark after the patent has expired. *Green v. Woodhouse, 38 O. G. 1491, C. D. 1887.

472. A patented printing-press was called by the patentee the "Universal," and the presses were stamped with that name and the names of the manufacturers, who made them for the patentee or his licensees. *Held* that, after the expiration of the patent, the patentee was not entitled to be protected in the use of the word "Universal" as a trade-mark. *Gally v. Colt's Patent Fire Arms Mfg. Co., 41 O. G. 576, C. D. 1887.

473. The term "Weymouth's Patent," used on knives made, patented and sold by the plaintiff, *held* to be free to the public after the expiration of the patent. *Hiram Holt Co. v. Wardsworth, 41 Fed. Rep. 34 (1889).

474. Where it appears in a suit to restrain defendants from using plaintiff's trade-name or trade-mark, applied by him to an article for which he had obtained a patent, that the defendants claimed title to the patent under assignment from plaintiff to secure payment of a note, manufactured under it, and applied the name to the patented article, *held*, that this action for violation of right to the name, apart from the right to the patent, could not be maintained. ‡Waterman v. Shipman, 49 O. G. 892; C. D. 1889.

475. After the expiration of plaintiffs' design patent in 1877 for embossing the ends of sewing-thread spools, the public had the right to use it. *Coats v. Merrick Thread Co., 63 O. G. 1531, C. D. 1893.

476. It is the universal American, English and French doctrine that where, during the life of a monopoly created by a patent, a name, whether it be arbitrary or be that of the inventor, has become, by his consent, either express or tacit, the identifying and generic name of the thing patented, this name passes to the public with the cessation of the monopoly which the patent created. *Singer Mfg. Co. v. June Mfg. Co., 75 O. G. 1703, C. D. 1896.

477. When a patent expires, the public may make the article and use a name for it which originated from or was naturally derived from the patent specification as a descriptive title of the invention. *Air-Brush Mfg. Co. v. Thayer, 79 O. G. 683, C. D. 1897.

478. No one has the right to the exclusive use of the word "Yale" as a trade-mark for locks, as any one who makes a lock disclosed by any one of the expired patents taken out by the Yales has a right to designate such lock as a "Yale lock," and it would be the proper and true name of such lock. Ex parte Yale & Towne Mfg. Co., 81 O. G. 801, C. D. 1897.

479. It is well settled by all the authorities that when an inventor obtains a patent on a device and said patented device is known by a certain name, the name becomes public property at the expiration of the patent. Id.

XXXIII. Right to Use Personal Name.

(See Fraud; Infringement; Injunction.)

480. A person cannot make a trade-mark of his own name, and thus debar another having

the same name from using it in his business honestly and without any intention to wrongfully appropriate the good-will of a business already established. ‡Russia Cement Co. v. Le Page, 44 O. G. 823, C. D. 1888.

481. But although one may honestly use his own name as a trade-mark, although the incidental result may be to injure the business of another, he cannot resort to any artifice, or do any act calculated to mislead the public as to the identity of the business or article, and thus produce injury to such other person beyond that which results from the similarity of name. ‡Id.

482. One may so sell or part with the right to use his own name as a description of a manufactured article as to deprive himself of the right to use it as such, and confer such right upon another, and in such case he will be enjoined from such use of his own name. ‡Id.

483. It is not upon the ground of the invasion of the trade-name adopted by another, but by reason of the contract he has made, that he is deprived of the right himself to use his name as all others of the same name may use theirs. ‡Id.

484. Where one Le Page had used the trade-mark "Le Page's Liquid Glue" to indicate a particular kind of glue manufactured by him, and had thereafter formed a corporation to which he sold his business, with the right to use the trade-marks belonging to or in use by him, which corporation continued to manufacture the same glue under the same name, and he subsequently left the corporation and engaged in the manufacture of glue in the same town, using the name "Le Page's Improved Liquid Glue" to advertise the article produced by him, *held*, that he should be enjoined from so using such name and from describing his business as "Le Page's Liquid Glue Co.," whether with or without any addition, without deciding that he may not use the words "liquid glue" or other appropriate words to describe his product, or state in that connection that he is himself the manufacturer of it. ‡Id.

485. The principles applicable to trade-mark cases involving personal names are doubtless applicable to trade-mark cases involving what may be called "portrait" trade-marks. Richmond v. The Dr. S. A. Richmond Nervine Co., 52 O. G. 307, C. D. 1890.

486. No person can acquire by adoption such an interest in the name of another person as to prevent that person from using his own name in a fair and honest manner in the ordinary course of business. Id.

487. To justify the exclusive use by a person or corporation of any man's name or 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. Id.

488. An ordinary surname cannot be appropriated by any one person as against others of the same name who are using it for a legitimate purpose. *Brown Chemical Co. v. Meyer, 55 O. G. 287, C. D. 1891.

489. Cases are not wanting, however, in which injunctions have been issued to restrain the use of even one's own name where fraud upon another was manifestly intended or where the party had assigned or parted with his right to use it. (Cases cited.) *Id.

490. While the right of no one can be denied to employ his name in connection with his business or with articles of his own production, so as to show the business or product to be his, yet he is not allowed to designate his article by his own name in such way as to cause it to be mistaken for the manufacture or goods of another already on the market under the same or similar name. (Brown Chemical Co. v. Meyer, 55 O. G. 287, 139 U. S. 540; Lawrence Mfg. Co. v. Tennessee Mfg. Co., 55 O. G. 1523, 138 U. S. 537.) *Meyer v. Dr. B. L. Bull Vegetable Medicine Co., 66 O. G. 197, C. D. 1894.

491. The defendant corporation devised, constructed and arranged the names as well as the wrapper of its article for the fraudulent purpose of causing it to be mistaken and sold in the market for complainant's article. Perpetual injunction allowed. *Id.

492. "Although the use of a personal name as a trade-mark will not be protected against its use in good faith by a defendant who has the same name, the reason of the rule ceases and the rule no longer applies where the defendant, as in the case of a corporation, selects its own name, especially where it appears that such name is selected with intention to mislead." (Citing Wm. Rogers Mfg. Co. v. Rogers & Spurr Mfg. Co., 11 Fed. Rep. 485, and distinguishing Wm. Rogers Mfg. Co. v. Simpson, 54 Conn. 527, 9 Atl. Rep. 395.) *William Rogers Mfg. Co. v. R. W. Rogers Co., 73 O. G. 970, C. D. 1895.

493. The name of a corporation is an essential part of its being, and the courts will pro-

tect it independently of statutory provisions. (Cases cited.) *Investor Publishing Co. of Massachusetts v. Dobinson, 72 Fed. Rep. 603 (1896).

494. A man may use his own name, because he cannot truthfully do business under any other, and the law protects that right ordinarily, even though such use may be injurious to another who has established a prior business of the same kind; but the name must not be used in such a way as to mislead the public into purchasing his goods under the belief that they are the manufacture of another. (Higgins Co. v. Higgins Soap Co., 144 N. Y. 462; William Rogers Mfg. Co. v. R. W. Rogers Co., 73 O. G. 970, 66 Fed. Rep. 66.) ‡De Long v. De Long Hook and Eye Co., 74 O. G. 809, C. D. 1896.

495. Where another avails himself of this public dedication to make the machine and use the generic designation, he can do so in all forms, with the fullest liberty, by affixing such name to the machines, by referring to it in advertisements, and by other means, subject, however, to the condition that the name must be so used as not to deprive others of their rights or to deceive the public, and, therefore, that the name must be accompanied with such indications that the thing manufactured is the work of the one making it as will unmistakably inform the public of that fact. *Singer Mfg. Co. v. June Mfg. Co., 75 O. G. 1703, C. D. 1896.

496. A man has a right to the use of his own name so long as he uses it honestly and so as not to injure another having the same name, and to prevent such injury he may be required to use his name in a specific manner, pointed out in an injunction. *Walter Baker & Co., Limited, v. Baker, 78 O. G. 1427, C. D. 1897.

497. One who enters into competition with another person of the same name who has an old and well-established business must differentiate his goods more carefully than is necessary in the case of a competitor of a different name. *Id.

498. The doctrine is well settled that equity will direct how a man shall use his name in his purpose to denote his own individuality. He will not be allowed to so use it as to work an injury to another having the same name, nor to perpetrate a fraud upon the public. *Garrett v. J. H. Garrett & Co., 79 O. G. 1681, C. D. 1897.

499. Where by long use the words "Baker's Chocolate" have come to indicate to purchasers of ordinary intelligence complainant's goods, *held*, that a subsequent manufacturer should not be allowed to use his surname, Baker, whether his given name or initials are prefixed or not, so as to indicate upon labels or advertisements that the goods he sells are "Baker's Chocolate." *Walter Baker & Co., Limited, v. Sanders, 80 O. G. 1476, C. D. 1897.

500. A corporation will not be protected in the use of its name against another corporation adopting and using the same name under such circumstances and in such locality as not to interfere with the former corporation's prior right to the name. *Investor Publishing Co. v. Dobinson, 82 Fed. Rep. 56 (1897).

501. In the use of a trade journal published in Los Angeles, California, under the name of "The Investor," there is no infringement of the right of the journal published in Boston, Massachusetts, under the name of "United States Investor," in view of the absence of proof of financial injury. *Id.

XXXIV. Statute.

502. An indictment under the trade-mark statutes (act of 1876) of the United States cannot be found. Said act fell with the act of 1870, which provided for the registration of trade-marks, and which was declared to be unconstitutional by the supreme court of the United States, and is as much a dead letter as said act of 1870, and was not vivified or given operative force by the act of 1881. *United States v. Koch, 49 O. G. 891, C. D. 1889.

503. The commerce clause of the statute merely gives jurisdiction to the patent office, and to the United States courts in trade-mark causes arising between citizens of the same state. The common-law owner of a trade-mark is entitled to registration whenever he shall show use "in commerce with foreign nations or with the Indian tribes," and he cannot be deprived of his right to such registration by reason of the use of the mark in foreign trade by another person, even though the mark has been registered by such other person. Manitowoc Mfg. Co. v. Dickerman, 57 O. G. 1721, C. D. 1891.

504. The purpose of section 3449 of the Revised Statutes of the United States, prohibiting the shipment of spirituous liquors, etc., under any other than their proper name or brand as known to the trade, is solely to facilitate the

enforcement of the revenue laws, and the fact that the statute may sometimes operate for the incidental protection of a trade-mark does not affect its constitutionality within the meaning of the Trade-mark Cases (100 U. S. 82). *United States v. Loeb, 59 O. G. 1766, C. D. 1892.

(The act of July 8, 1870, was the first enacted by congress in reference to trade-mark registration. See sections 76 to 84 inclusive. This part of the act was declared unconstitutional, null and void by the supreme court of the United States at its October term of 1879. (16 O. G. 999, C. D. 1879, 619, 100 U. S. 82.) Congress passed a penal statute in 1876 which fell with the original act of 1870. A new and remedial act was passed by congress and approved March 3, 1881; but the act of 1876 was not included in it. This act of 1881, supplemented by a single amendment, dated August 5, 1882, is the one under which all registrations have since been effected. It provides for no appeal to any tribunal outside the patent office. (*Einstein v. Sawhill, 65 O. G. 1918, C. D. 1893.)

Section 7 of the act of October 1, 1890 (see circular of treasury department, dated October 31, division of customs), prescribes that no article of imported merchandise shall be allowed entry at United States ports which copies or simulates domestic trade-marks, and owners of the latter may file *fac-similes* of the same for transmission to collectors of customs.)

XXXV. Treaty.

505. The name "Vichy" is a commercial name, and, as such, is protected under the industrial property treaty of March 20, 1883, without obligation of deposit (art. 6 of the treaty), whether it does or does not form part of a trade or commercial mark. *La Republique Francaise v. Schultz, 57 Fed. Rep. 37 (1893).

506. Our word "trade-mark" comprehends both the *marque de fabrique* and *marque de commerce* de France. (Browne, Trade-marks, sec. 85.) *Id.

507. Although a German citizen cannot register the word "Goliath" in Germany, as a trade-mark for certain tools, under the convention (1872) between that country and the United States, registration will be allowed here. (Ex parte Manske & Co., 64 O. G. 858.) Ex parte Schmidt, 53 MS. D., July, 1893 (Fisher, Acting Com'r).

(Trade-mark treaties between United States and Germany, and Germany and Austria, referred to in *J. M. P. Baltz Brewing Co. v. Kaiser Brauerei, Beck & Co., 74 Fed. Rep. 222, 1896.)

508. A trade-mark consisting of the word "Germania" may be registered in the United States by a German citizen, under the provisions of article XVII of the convention of December 11, 1871, although the German statutes make no provisions for the registration of mere words as trade-marks. Ex parte Portland-Cement-Fabrik "Germania" H. Manske & Co., 64 O. G. 858, C. D. 1893.

509. The treaty of 1871, between the United States and Germany (art. 17, 17 Stat., 931), which provides that, with regard to the marks of labels of goods or of their packages, the citizens of Germany shall enjoy in the United States the same protection as native citizens, does not give to a citizen of Germany who has acquired the right to a trade-mark in that country a similar right to the trade-mark in the United States. *Richter v. Reynolds, 67 O. G. 404, C. D. 1894.

510. Citizens of Canada who are engaged in the manufacture of trade-marked articles and who have a place of business in the state of New York, where they make and ship such articles for sale in the United States, are within the international convention of March 20, 1883, for the protection of industrial property, and they may sue in the United States courts for the infringement of their trade-marks by its citizens. *Kerry v. Toupin, 67 O. G. 931, C. D. 1894.

511. The international union has not the force nor effect of law in this country. (Citing opinion of Att'y-Gen. Miller, 47 O. G. 398, C. D. 1889.) Ex parte Zwack & Co., 76 O. G. 1855, C. D. 1896.

(See "International Convention.")

XXXVI. Use and Sale as Establishing Title.

512. An application for registration of a trade-mark allowed in absence of evidence that the reference has been used. Ex parte Jones, 34 MS. D., July, 1887 (Hall, Com'r).

513. Registration does not create a trade-mark. It can only be acquired by the actual application of a proper symbol to goods, wares or merchandise of a certain class. *United States v. Braun, 39 Fed. Rep. 775 (1889).

514. The exclusive right to use as a trade-mark a word coined and given currency by a manufacturer is not affected by a subsequent use of the word by the public in a descriptive sense. Selchow v. Baker (93 N. Y. 59) approved. *Celluloid Mfg. Co. v. Cellonite Mfg. Co., 41 O. G. 693, C. D. 1887.

515. Mere adoption of a mark, and a public declaration that the mark so adopted will be used to distinguish goods to be put on the market at a future time, create no right. No title arises until the thing is actually on the market marked with the particular mark.

‡Schneider v. Williams, 44 O. G. 1400, C. D. 1888.

516. Three things are requisite to the acquisition of a title to a trade-mark: First, the person desiring to acquire title must adopt some mark not in use to distinguish goods of the same class or kind already on the market belonging to another trader; second, he must apply his mark to some article of traffic; and third, he must put his article marked with his mark on the market. ‡Id.

517. It appearing that the mode in which the complainants packed their cigars, the kind of boxes used by them, the number of cigars in each bunch, the particular color of ribbon or tape around each bunch, and the size and shape of the cigars were all old in the trade, and that the name "La Normanda" had been used for cigars resembling the "La Normandi" cigars in size and shape, etc., in different parts of the country several years prior to the adoption of the words "La Normandi" by the complainants or their assignor, the adoption of these words as a trade-mark and their registration could not take away the right previously acquired by the public in the use of the words "La Normanda" as indicating a particular kind of cigars. *Stachelberg v. Ponce, 46 O. G. 337, C. D. 1889.

518. Where it appeared that as against the applicant a certain corporation and its successors in business, down to and including the registrant, were and are clothed with the exclusive right to make, sell and use a certain medical compound to which the portrait of the applicant had been applied as a trade-mark, *held*, that as against the registrant the applicant could not register said portrait for use in connection with the same medical compound; and *held*, also, that the use by the applicant of such portrait as a trade-mark for a limited period before the actual incorporation of the registrant, but at a time when the exclusive right to manufacture and sell the article was in the successors of the original company, created no right in the applicant. Richmond v. The Dr. S. A. Richmond Nervine Co., 52 O. G. 307, C. D. 1890.

519. When a party has rejected a trade-mark for an article and announced his intention to use it upon a similar article, it is incumbent upon an applicant who wishes to register a trade-mark for such similar article to show that the registrant has not used it thereupon. Ex parte Kyle & Co., 57 O. G. 274, C. D. 1891.

520. Whoever is the first to adopt and use a mark in either domestic or foreign trade is the owner of such trade-mark. Manitowoc Mfg. Co. v. Dickerman, 57 O. G. 1721, C. D. 1891.

521. It is the party who first *uses* a trade-mark, and not the one who first thought of using it, that is entitled to protection. *George v. Smith, 52 Fed. Rep. 830 (1892).

522. Intermittent use of a trade-mark, coupled with registration, cannot prevail over a continuous use begun at a later period. *Brower v. Boulton, 53 Fed. Rep. 389 (1892).

523. The filing of an application for registration is not conclusive that the mark has been adopted and used at the time of filing said application. Stewart v. Einstein, v. Sawhill, 61 O. G. 287, C. D. 1892.

524. A mere adoption of a mark carries no rights unless there concur a continuous use of it and public familiarity with it. To establish a proprietary right in such a mark, it is necessary that the public understanding respecting the purpose of its use shall be fully proved. *Kohler Mfg. Co. v. Beshore, 62 O. G. 592, C. D. 1893.

525. That which is prior in time is first in right. ‡Whitfield v. Loveless, 64 O. G. 442, C. D. 1893.

526. Sales of medical preparations in this country by a foreign manufacturer, to a limited extent, upon special orders, to supply particular customers, do not amount to use in such circumstances as to publicity and to length of use as show an intention to adopt a symbol placed upon such preparations as a trade-mark. (Kohler Mfg. Co. v. Beshore, 67 O. G. 592, 59 Fed. Rep. 572, followed; Richter v. Anchor Remedy Co., 52 Fed. Rep. 455, affirmed.) *Richter v. Reynolds, 67 O. G. 404, C. D. 1894.

527. Sales of a few dozen bottles of a medicinal preparation, with written labels affixed, bearing a name different from that previously used for such preparation, do not amount to use in such circumstances as to publicity and to such length of use as to show an intention to adopt the written words as a trade-mark. (62 O. G. 592, 53 Fed. Rep. 262, affirmed.) *Kohler Mfg. Co. v. Beshore, 67 O. G. 678, C. D. 1894.

528. A trade-mark used for a time by a party, then discontinued for a series of years, cannot be lawfully resumed as against another, who, meanwhile, has begun its use and continued the same persistently. *Royal Baking Powder Co. v. Raymond, 70 Fed. Rep. 376 (1895).

529. It is immaterial who suggested the word "Triumph" for dress-stays; priority must be awarded the one who first adopts and uses

a mark. Trisdorfer & Co. v. Estate of Eassett, 60 MS. D., Sept., 1896 (Fisher, Acting Com'r).

530. "Cat-al-gine," for a medical compound, held not anticipated by "Katalgen," in view of lack of proof of use of the latter. Ex parte Hartmiller Bros., 60 MS. D., Dec., 1896 (Fisher, Ass't Com'r).

531. A merely casual, interrupted or temporary use will not support a title to a trade-mark. *J. M. P. Baltz Brewing Co. v. Kaiser Brauerei, Beck & Co., 74 Fed. Rep. 222 (1896).

532. Defendants have the right to use the name "Eli Pettijohn" and to make as pronounced as possible upon their labels the personality of this man when it appears that he was for many years engaged in another section of the country in the manufacture of the product to which the labels applied, and when it also appears that complainants had previously joined with him in the manufacture of the same product in such other section. *American Cereal Co. v. Eli Pettijohn Cereal Co., 76 O. G. 610, C. D. 1896.

533. Ephemeral and experimental use of a mark does not amount to adoption, establishing a reputation for the goods in the market. Jenkins v. Burke, 61 MS. D., May, 1897 (Fisher, Ass't Com'r).

XXXVII. What Constitutes.

(See Registration.)

534. In all the legislation of congress upon this subject there is contained a requirement that a trade-mark offered for registration in the patent office shall be lawful, not calculated to deceive the public. "The commissioner of patents shall decide the presumptive lawfulness or claim to the alleged trade-mark." Ex parte M. Bloch & Co., 40 O. G. 443, C. D. 1887.

535. There is no legislation defining what constitutes a lawful trade-mark, and to determine this resort must be had to the common law as disclosed in commercial usages and shown by the commentators and the decisions of courts. Id.

536. No rule can be adopted by which to determine what is or is not a lawful trade-mark. In many cases the misrepresentation may not appear upon the face of the trade-mark and accompanying application, and the office may not be in possession of the facts which would enable it to guard against the registry of a false trade-mark; but whenever it clearly and distinctly appears that the proposed trade-mark constitutes a misrepresentation of such a character that it would not be protected in a court of equity, it is the duty of the office to refuse its registration. Probably doubtful cases should be resolved favorably to applicants, leaving all parties affected to their remedies in the courts. Id.

537. The office of a trade-mark is to point out distinctively, either by itself or by association, the origin or ownership of the article to which it is affixed, or, in other words, to give notice who was the producer. While this may be done in many cases by a name, a mark or a device well known, but not previously applied to the same article, it is not necessary that the word or device should be a new creation never before known or used. (Canal Co. v. Clark, 13 Wall. 322.) Id.

538. The name which is given to a patented device to distinguish it as a patented article from other articles of the same character is not, properly speaking, a trade-mark. *Adee v. Peck Bros. & Co., 48 O. G. 823, C. D. 1889.

539. It designates nothing except that the structure has a definite character as the structure that was patented, and indicates nothing in regard to the character of the workmanship or the person by whom it was manufactured. *Id.

540. A trade-mark is something different from the article itself, which the mark designates, and is a name, mark or device attached to the article to indicate its origin. *Id.

541. A label which does not indicate with any degree of certainty by what particular person or firm the articles to which it may be affixed were manufactured, or serve to distinguish the goods of one manufacturer from the goods of another, and in which complainant appears to have no vendible interest, but merely a right to use it on articles of his own make, so long and only so long as he remains a member of a certain union, is not a valid trade-mark. *Carson v. Ury, 49 O. G. 411, C. D. 1889.

542. A small metallic frame containing a portrait fastened to a pin, so as to be used as a personal ornament, does not constitute a valid trade-mark when so attached to and sold with a cigar as to be readily detached and used separately in the manner indicated. ‡Hoeb v. Bishop, 49 O. G. 1845, C. D. 1889.

543. An article having a distinct commercial value of its own cannot be made a trade-mark for another article by being attached to and sold with it. ‡Id.

544. A trade-mark may, in form, serve as a

label, but it differs from a mere label in that it is not confined to a designation of the article to which it is attached, but is a symbol or device which, affixed to a product of one's manufacture, distinguishes it from articles of the same general nature manufactured or sold by others, thus securing to the producer the benefits of any increased sale by reason of any peculiar excellence he may have given to it. A mere label is not intended to accomplish any such purpose, but only to indicate the article contained in the bottle, package or box to which it is affixed. *Higgins v. Keuffel, 55 O. G. 1139, C. D. 1891.

545. The primary function of a trade-mark is to denote the origin of the article which bears it. A "representation" which upon its face appears clearly to have another purpose, such as decoration, and which by reason of that decorative character creates no suspicion that it is intended as a trade-mark, is not registrable as such. Ex parte Peyser & Co., 62 O. G. 588, C. D. 1893.

546. Complainants manufactured a medicinal compound under the name of "Syrup of Red Spruce Gum," and for some twenty years or more that name was placed conspicuously on the package in which the compound was sold, and in connection therewith appeared a cut of an Indian against a background of spruce-trees and a water-fall. *Held*, that the adoption and continuous use of this distinctive name and device entitle complainants to claim it as a trade-mark and to be protected against its infringement by persons making similar goods. *Kerry v. Toupin, 67 O. G. 931, C. D. 1894.

547. Where a firm has for many years used the name of its predecessors in connection with its goods and has built up an extensive trade thereunder, such name, even if it could not be used as a trade-mark, is to be treated as a descriptive term, to the benefit of which they are entitled. *Garrett v. T. H. Garrett & Co., 79 O. G. 1681, C. D. 1897.

("Form is necessary to make color an essential element of a trade-mark." Browne on Trade-marks, sec. 229, 2d ed.)

XXXVIII. WITNESSES.

548. Witnesses hired by the manufacturer of a proprietary medicine to secure evidence against suspected infringers are not disinterested and their testimony should be scrutinized with unusual caution. *Hostetter Co. v. Bower, 76 O. G. 1856, C. D. 1896.

TREATIES.

(See INTERNATIONAL CONVENTION; TRADE-MARKS, TREATY.)

The treaty of April 16, 1869, between the United States and France is impliedly repealed by the treaty of March 20, 1883. (Cases cited.) *La Republique Francaise v. Schultz, 57 Fed. Rep. 37 (1893).

TRUSTS.

(See CONTRACTS, ILLEGAL; CORPORATIONS.)

USE, DOUBLE.

(See PATENTABILITY.)

USE OF NAME OF PATENT OR PATENTED ARTICLE BY THE PUBLIC.

(See RIGHT OF PUBLIC TO USE NAME OF, ETC.)

USE OF PATENTED ARTICLE BY UNITED STATES GOVERNMENT.

(See RIGHT OF SAME TO USE.)

UTILITY.

(See PATENTABILITY.)

VOID PATENTS.

(See PATENTS, DEFECTIVE OR VOID.)

WITHDRAWAL FROM ISSUE.

(See AMENDMENT AFTER FINAL REJECTION; CLAIMS, REINSTATEMENT OF.)

1. An applicant who has had his day in the office, and whose application has received full consideration and has been passed to issue, ought not to be permitted to withdraw his case from issue and submit amendments which should have been earlier proposed, and thus put the office to the trouble of making a reexamination. Unless a showing of *irreparable injury* is made to appear, such petition will be denied and applicant required to file a new ap-

plication covering the subject of his proposed amendment, or he may abandon his original application, pay a new fee, and file another application in the form desired. Ex parte Page and Krausse, 43 O. G. 1455, C. D. 1888.

2. 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. Ex parte Myers, 49 O. G. 131, C. D. 1889.

3. Where the claims sought to be introduced by amendment were so specially pertinent to the subject-matter of the application, and were so inseparable in their nature from the particular invention sought to be patented, that if they were to be allowed in another application there would be grave doubt whether the patent therefor would be a valid patent, amendment after allowance was permitted. Id.

4. Before a claim deliberately erased can be reinstated some good showing must be made of especial hardship to the inventor, or of inadvertence, accident or mistake in erasing such claim. Ex parte Potter, 53 O. G. 760, C. D. 1890.

5. An application confined to the apparatus cannot be withdrawn from issue for the purpose of inserting a claim for the process, although the process claim might have been included in the original application. Ex parte Adams, 47 MS. D. (3 G. W. D.), June, 1891 (Frothingham, Ass't Com'r).

6. Where it appeared that the petitioner had erased a certain claim from his application for a specific purpose and had specifically abandoned it, so far as said application was concerned, in order to obtain an allowance, and subsequently desired to withdraw the case from issue for the purpose of reinstating said claim, *held*, that the petition should be denied. Ex parte Potter, 53 O. G. 760, C. D. 1890.

7. There is no warrant in rule 165 for withdrawing an application which has been passed to issue and allowed to enable a party to preserve rights to patents in foreign countries when it appears that the six months within which the final fee must be paid under the statute would necessarily elapse before the expiration of the time during which the case would be withdrawn from issue. Ex parte Simonson, 53 O. G. 1571, C. D. 1890.

8. Rule 165 only provides for a new notice of allowance when applications are "withdrawn for further action on the part of the office," and no provision exists in the rule for a new notice where the effect of the petition to withdraw the application from issue, if granted, is intended to be and would be to permit the final fee to be paid more than six months after that allowance of the application which resulted from proceedings in the office. Id.

9. A petition to be allowed to withdraw an application for an apparatus from the issue, and to amend it by incorporating therein the claims of an application for a process which has been permitted to become forfeited for non-payment of the final fee within six months from notice of allowance, must be denied. Such action would in effect revive the forfeited claims without the payment of the fee required by law. Ex parte Hopkinson, 54 O. G. 264, C. D. 1891.

10. Where an application has been passed to issue, permitted to become forfeited by failure to pay the final fee, thereafter renewed and again allowed, a petition to withdraw such application from the issue to add amended claims, unaccompanied by any showing of "hardship or irreparable injury," was denied. Ex parte Meyer, 54 O. G. 265, C. D. 1891.

(Ex parte Gaboury, 37 O. G. 217, C. D. 1886.)

11. The necessity of advancing the work of the office compels conformity to the rule laid down in Ex parte Myers (49 O. G. 131). Id.

12. Amendments not affecting the merits of the application, but intended to correct formal matters, may be admitted under rule 78, without withdrawing case from issue. Ex parte Cornelius, 56 O. G. 929, C. D. 1891.

13. When amendments made after issue affect the merits, they cannot be made without withdrawing the case from issue. Such withdrawal will be made only upon a proper showing. Id.

14. Under rule 165 an application will not be withdrawn from issue to permit applicant to reinsert therein a claim originally presented but voluntarily erased. Ex parte Wood, 58 O. G. 273, C. D. 1892.

15. 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. Ex parte Brand, 56 O. G. 1062, C. D. 1891.

16. The rule that an application will not be withdrawn from issue for the purpose of allowing an applicant to amend his claims is subject

to exception only in cases where its enforcement would work irremediable injury. Ex parte Gold, 59 O. G. 2067, C. D. 1892.

17. An application will not be withdrawn from issue for the purpose of adding claims to a feature described and reserved but not claimed in a prior patent to the same inventor, because of the fact that more than two years have elapsed since said prior patent was issued, when it appears that a new application can be filed in such a manner that the two applications may be considered continuous. Ex parte Nash, 60 O. G. 159, C. D. 1892.

18. An application will not not be withdrawn from issue because of more than two years' public use of the invention when it appears that a second application for the same invention may be filed as a continuation of the first application, such first application having been filed before the expiration of the two years. Ex parte Schilling, 60 O. G. 160, C. D. 1892.

19. An application will not be withdrawn from issue for the insertion of a claim in the absence of any showing of great hardship or irremediable injury. Ex parte Blakeslee, 63 O. G. 1201, C. D. 1893.

20. The withdrawal of an application from issue for the purpose of inserting a claim previously presented and voluntarily canceled will not be permitted. Id.

21. Withdrawal of an application from issue will not be allowed for admission of an amendment that would require re-examination of the case. Ex parte Dean, 62 MS. D., July, 1897 (Greeley, Ass't Com'r).

WITHHOLDING FROM ISSUE.

(See APPLICATION, SUSPENSION OF ACTION ON; WITHDRAWAL FROM ISSUE.)

1. The filing of a bill in equity in the circuit court of the United States by the defeated party to an interference will not operate to stay the issue of patent to the successful contestant, nor will it justify the commissioner of patents in delaying or withholding it until such proceeding in equity is terminated. Wells v. Boyle, 43 O. G. 753, C. D. 1888.

2. There is no reason for withholding from issue an allowable application for process until an interference between a companion application for apparatus and other applications for apparatus which show but do not claim the process is disposed of. Ex parte Atwood, 44 O. G. 341, C. D. 1888.

3. An applicant who has completed his invention and diligently and successfully prosecuted his application for patent ought not to be delayed in the issuance of his patent by a caveator who is under no obligation to be diligent or to file his application for patent. Ex parte Ward, 46 O. G. 1573, C. D. 1889.

4. Where petitioners prayed that patents to be issued upon certain applications of the inventor should not be issued to the assignee of record, and requested that time be given them to determine in the courts their rights in the premises before the patents were issued, and that the examiner in charge of such applications be required to suspend action thereon until the legal owners of the right thereto should have been determined; or, in the event of the refusal of this request, that the patents be issued to the inventor, and it appeared that whatever title petitioners had was one which could only be established in a court of equity, and that the legal title to the invention was in the assignee, *held*, that the petition must be denied. Shedlock v. Hannay, 50 O. G. 166, C. D. 1890.

5. A claim by the government to an interest in an invention, either as licensee or assignee, will not stay the issue of a patent to an inventor, since that is a question for the courts and not the patent office to determine. Riley v. Barnard, 59 O. G. 1919, C. D. 1892.

6. An application having been withheld from issue four months, and it being probable from the manner in which the case is being prosecuted it will be several months more before an interference can be declared, it should be passed to issue. (Abel & Dewar v. Maxim, v. Nobel, 56 O. G. 139; Ex parte Lombard, 43 O. G. 1347.) Ex parte Holt, 63 MS. D., Dec., 1897 (Greeley, Acting Com'r).

WITNESSES.

(See TESTIMONY.)

I. TO APPLICATIONS.
II. COMPELLING ATTENDANCE OF.
III. COMPULSORY TESTIMONY OF.
IV. CROSS-EXAMINATION OF.
V. HUSBAND AND WIFE.

I. To Applications.

1. While the grammatical construction of section 4889, Revised Statutes, seems to indicate that the drawing or the document signed by

the applicant and not his signature is the thing which is to be attested by two witnesses, the uniform practice of the office has been to regard the attestation as referring to the signature, and accordingly to require two competent witnesses for each signature. *Held*, therefore, that a member of the firm of applicant's attorneys who signs the firm name to the drawing is not also a competent witness to the signature of the firm. Ex parte Kyle, 57 O. G. 1621, C. D. 1887.

2. The attestation by *two* witnesses of the inventor's signature to the specification forming part of his application for patent is made imperative by section 4888, Revised Statutes, and rule 40. Ex parte Ackroyd, 63 O. G. 466, C. D. 1893.

II. Compelling Attendance of.

3. The manner of taking depositions and the whole conduct of such proceedings rest with the federal courts, and parties taking testimony should apply to the district judge for an order to compel the attendance of witnesses. Before a deposition should be suppressed when a witness fails to present himself for cross-examination, the court will look into the character of the deposition, and from that determine whether the aggrieved party ought not to have applied to the district court for an order compelling attendance, instead of resorting to a motion to suppress, which motion, while noticed at the time the deposition was taken, was not urged until the hearing of the case upon the question of priority before the patent office. Wright v. Daggett, 44 O. G. 948, C. D. 1888.

4. The commissioner of patents has no control over witnesses. Their production, attendance and conduct are under the control of the United States courts. If a witness fails to attend or refuses to answer questions without the fault or interference of the adverse party, application should be made to the federal court for such orders as the circumstances demand. (Wright v. Daggett, 44 O. G. 943.) Osgood v. Badger, v. Bennett, 44 O. G. 1065, C. D. 1888.

5. It should be an extreme case which would justify the commissioner of patents in suppressing a deposition on motion of a party who omits to take the proper steps to secure such orders from the courts as would protect him in taking the depositions. Id.

6. The statute points to the federal courts as the tribunals having power to govern the conduct of witnesses in interference cases, rather than to the patent office. Brungger v. Smith, 57 O. G. 273, C. D. 1891.

7. The proper form of application to enforce obedience to a subpœna issued under section 4906, Revised Statutes, is a petition for an attachment for contempt. *Brungger v. Smith, 58 O. G. 388, C. D. 1892.

8. Section 4906, Revised Statutes, providing that, on the application of any party to a contested case pending in the patent office, the clerk of any federal court shall issue a subpœna for a witness commanding him "to appear and testify," does not include an authority to issue a subpœna *duces tecum*. *Ex parte Moses, 62 O. G. 1826, C. D. 1893.

9. The commissioner of patents has no judicial power over the production and conduct of witnesses in interference proceedings, but this whole matter is left in the hands of the federal courts of the district in which the testimony is being taken. (Wright v. Daggett, 44 O. G. 943; Osgood v. Badger, v. Bennett, 44 O. G. 1065.) Kelly v. Park, 81 O. G. 1931, C. D. 1897.

10. Where a party fails to avail himself of his right to apply to the court for the control of a refractory witness, the commissioner will not interfere, except in an unusual case, but will, in passing upon the question of priority, give to the testimony of such witness only such weight as is justified by the circumstances. Id.

11. The fact that the witness is a volunteer witness does not relieve him from the jurisdiction of the federal court, and the remedy from his refusal to answer proper questions is by application to the judge of such court. Id.

12. Where the taking of testimony has been closed, the printed record filed, and the day set for final hearing has passed, application for leave to apply to the court comes too late. Id.

III. Compulsory Testimony of.

13. The defendant may be compelled to state whether or not he, subsequent to the date of the patent and prior to the commencement of the suit, had in his possession the machine which is alleged to be an infringement of plaintiff's patent, though the plaintiff had not previously made out a *prima facie* case of infringement. *Delamater v. Reinhardt, 53 O. G. 434, C. D. 1890.

14. 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 will not protect a wit-

ness from answering a question when the effect of his answer would be to make such disclosure. *Dornan v. Keefer, 58 O. G. 1093, C. D. 1892.

15. The vendor of an infringing device, who is not a party to the suit, may be compelled to testify to the purchase and use thereof by the defendaut without violating the constitutional provision that no witness shall be compelled to testify against himself in any criminal case, for Revised Statutes, sections 4919, 4921, do not subject an infringer to penalties or forfeitures, but merely authorize the court in its discretion and "according to the circumstances of the case" to impose additional damages. *Masseth v. Johnston, 67 O. G. 143, C. D. 1894.

IV. Cross-examination.

16. "Where a witness is called to give his deposition, is examined in chief in relation to a subject properly involved in the controversy, and upon cross-examination refuses to answer a proper, pertinent and material question, his testimony will not be considered" at the hearing. *Milligan v. Niedringhaus, 38 O. G. 103, C. D. 1887.

17. Ordinarily, objections which may be obviated by issuing a new commission and reexamining the witness, as well as formal objections to the interrogatories and answers, should be raised by motion to suppress. *Id.

18. Such motion to suppress should be made without unreasonable delay, so that the omissions may be corrected by a further examination. *Id.

19. The better and safer practice in a case like the present, where the witness declined to answer a proper, pertinent and material cross-interrogatory, is to move for the suppression of the deposition in advance of the hearing and as soon as reasonably possible after such deposition be taken. *Id.

20. It is well settled that when a party has had an opportunity to cross-examine a witness and has neglected to do so, the case is the same in effect as if he had cross-examined, otherwise the admissibility of the evidence would be made to depend upon his pleasure whether he would cross-examine or not, which would be a most uncertain and unjust rule. Wright v. Daggett, 44 O. G. 943, C. D. 1888.

21. A party who omits to cross-examine, relying upon his motion before the commissioner to suppress the depositions, elected what course to pursue and is bound thereby. A court of law or equity might relieve him from the consequences of his election and by process compel the witness to appear for cross-examination, or the commissioner of patents could order the witness to be produced for cross-examination, under penalty of suppressing his deposition. Osgood v. Badger, v. Bennett, 44 O. G. 1065, C. D. 1888.

22. 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 such application to court. Rueter v. Frist, 58 O. G. 386, C. D. 1892.

V. Husband and Wife.

23. The question as to whether husband and wife are competent and compellable to testify for or against each other must be determined by the law in force in the jurisdiction in which the patent office is located, whether that jurisdiction may be said to be the entire United States or the District of Columbia. The question of competency must be determined in accordance with either the common law, the statute law, or both. Marsh v. Rein, v. Ruppel, 43 O. G. 1453, C. D. 1888 (Hall, Com'r).

24. Inasmuch as it seems to be well settled that the common-law provision as to husband and wife is in force in the District of Columbia, it follows that husband and wife are not competent witnesses for or against each other in the tribunals and for the purposes mentioned in sections 876 and 877 of the Revised Statutes of the District of Columbia. Id.

25. 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, 58 O. G. 804, C. D. 1892 (Simonds, Com'r).

26. A wife is non-competent as a witness in proceedings before the patent office where her husband is a real party in interest and her testimony is offered on his behalf. (Affirming Dobeck v. Novotny, 58 O. G. 804.) Crawford v. Lichtenstein, 61 O. G. 1480, C. D. 1892 (Simonds, Com'r).

(The wife is a competent witness for her husband in an interference proceeding in the patent office to which he is a party. Koen v. Quint, 23 O. G. 1329, C. D. 1883, Marble, Com'r.)

APPENDIX.

THE INTERNATIONAL UNION FOR THE PROTECTION OF INDUSTRIAL PROPERTY.

This Union was established by the convention concluded at Paris, March 20, 1883, and conferences have been held from time to time, at which the United States has been represented. The last conference was at Brussels, December, 1897. The United States has been a member of the Union since 1887, but no statute has been enacted to carry out the treaty, and its force and validity are more or less in doubt. (See opinion of the Attorney-General of the United States — vol. 47, O. G. 398, Com'rs Dec., A. D. 1889, 253, and the decision of the United States Circuit Court (Coxe, J.) in Electrical Accumulators Co. v. Julien Electric Co. et al., vol. 64, O. G. 559, Com'rs Dec., A. D. 1893, 437.)

The following are the most important articles of the convention:

"ART. II. The subjects or citizens of each of the contracting states shall enjoy, in all the other states of the Union, so far as concerns patents for inventions, trade or commercial marks, and the commercial name, the advantages that the respective laws thereof at present accord, or shall afterward accord, to subjects or citizens. In consequence, they shall have the same protection as these latter, and the same legal recourse against all infringements of their rights, under reserve of complying with the formalities and conditions imposed upon subjects or citizens by the domestic legislation of each state.

"ART. IV. Any one who shall have regularly deposited an application for a patent of invention, of an industrial model, or design, of a trade or commercial mark, in one of the contracting states, shall enjoy, for the purpose of making the deposit in the other states, and under reserve of the rights of third parties, a right of priority during the periods hereinafter determined.

"In consequence, the deposit subsequently made in one of the other states of the Union, before the expiration of these periods, cannot be invalidated by acts performed in the interval, especially by another deposit, by the publication of the invention or its workings by a third party, by the sale of copies of the design or model, by the employment of the mark.

"The periods of priority above mentioned shall be six months for patents of invention and three months for designs or industrial models, as well as for trade or commercial marks. They shall be augmented by one month for countries beyond the sea.

"ART. VI. Every trade or commercial mark regularly deposited in the country of origin shall be admitted to deposit and so protected in all the other countries of the Union.

"Shall be considered as country of origin, the country where the depositor has his principal establishment.

"If this principal establishment is not situated in one of the countries of the Union, shall be considered as country of origin that to which the depositor belongs.

"The deposit may be refused if the object for which it is asked is considered contrary to morals and to public order.

"ART. VIII. The commercial name shall be protected in all the countries of the Union without obligation of deposit, whether it forms part or not of a trade or commercial mark."

An international union for regulating international registration of trade-marks was initiated in 1890, and established April 14, 1891.

The United States has not become a member of it.

(The international office for the protection of industrial property is located at Berne, Switzerland, M. Morel, director.)

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