SECOND EDITION—MAY, 1896.

NEW YORK CABLE ADDRESS:
"RICHPATENT, NEWYORK."

WASHINGTON CABLE ADDRESS:
"RICHARDS, WASHINGTON."

We transact business solely and exclusively with Patent Agents, Solicitors, and Lawyers.

UNITED STATES

PATENTS,

TRADE MARKS, DESIGNS

AND

COPYRIGHTS.

WILLIAM EVARTS RICHARDS. WILLIAM WALLACE WHITE.

RICHARDS & CO.,

PATENT AGENTS AND SOLICITORS,

203 BROADWAY, NEW YORK, N. Y.

1003 F STREET, WASHINGTON, D. C.

United States of America.

Entered according to Act of Congress, in the year 1896, by RICHARDS & Co., in the office of the Librarian of Congress, at Washington.

PRICE, $1.00: 4 SHILLINGS.

YALE LAW LIBRARY

YALE LAW LIBRARY.

T
R3929
1896

SPECIAL NOTICE.

WE desire to call attention to the fact that we devote ourselves exclusively to the transaction of business for Patent Agents and Solicitors, and members of the Legal Profession. We neither solicit nor receive orders directly from inventors.

RICHARDS & CO.

OCT 28 1931

Library
Simeon E. Baldwin
May 1, 1926

PREFACE.

THIS work is especially designed for the use of Patent Agents and Solicitors, and the Legal Profession. It is intended as a working hand-book; a book that may be readily consulted for information upon any subject under the Patents, Trade Mark, and Copyright Laws.

It contains the full text of the laws, reference to the rules of practice thereunder, and a recital of the leading decisions of the Courts, with reference to the cases or authorities under which the full text of the decisions, etc., may be found.

So far as possible, the language used is the language of the law, the rules, or the Courts; it having been our purpose to make the book authoritative, rather than an expression of our own opinions.

Last, but not least, we have provided a comprehensive subject-matter index.

We hope the book will prove as useful to our correspondents as we intend it to be.

RICHARDS & CO.

NEW YORK, May 1, 1896.

INDEX TO CASES CITED.

THE NUMBERS IN THE RIGHT-HAND COLUMN REFER TO PAGES IN THIS BOOK.

	PAGE
Adams *v.* Howard, 19 Fed. Rep. 319; 22 Fed. Rep. 656	60; 79
" & Westlake Mfg. Co. *v.* Rathbone, 26 Fed. Rep. 262	20
Adriance, Platt & Co., 20 O. G. 1820	87
Agawam Co. *v.* Jordan, 7 Wall, 583; 9 O. G. 1011	21
Alden, *ex parte*, 15 O. G. 889	88
Allen *v.* Blunt, 2 Robb, 530	63
" *v.* City of New York, 17 O. G. 1281	20
Allis *v.* Stowell, 18 O. G. 465	65
" " " 23 O. G. 1033	68
" " " 19 O. G. 727	69
Am. Clay Bird Co. *v.* Legowski Clay Pigeon Co., 31 Fed. Rep. 466	56
Am. D. R. B. Co. *v.* Sheldon, 17 Blatch. 208	14
" " " " " 1 Fed. Rep. 870	65
Am. Hide & Leather Splitting & Dressing Mach. Co. *v.* Am. Tool & Mach. Co., 4 Fisher, 284	21
11 Am. Law Reg. N. S. §§ 612, 665	19
Am. Middlings Purifier Co. *v.* Christian, 3 Bann, & A. 42	68
" " " " *v.* Vail, 15 Blatch. 315	69
Am. Nicholson Pavement Co. *v.* City of Elizabeth, 4 Fisher, 189	67
Am. Paper Barrel Co. *v.* Laraway, 37 O. G. 674	22; 68
Am. Sardine Co. (The) 3 O. G. 395	91
Amoskeag Co. (The) *v.* Garner, 6 Abb. Pr. (N. S.) 265	85
Andrews *v.* Hovey, 41 O. G. 1162	20
Appleton, *ex parte*, 1 Dec. Com. 8	38
Armistead *v.* Blackwell, 1 O. G. 608	88
Arnheim *v.* Finster, 34 O. G. 700	52
Ashcroft *v.* Boston & Lowell R. R. Co., 13 O. G. 805	54
" *v.* Walworth, 2 O. G. 546	35
Atterbury, *ex parte*, 2 O. G. 640	20
Attorney General's Opinion, 9 Op. At. Gen. 171	17
" " " 2 " " " 571	17
" " " 8 " " " 269	24
Atwell *v.* Ferrett, 2 Blatch. 39	99; 106
Atwood *v.* Partland Co. 10 Fed. Rep. 288	51
Avery *v.* Wilson, 20 Fed. Rep. 856	57
Backus *v.* Gould, 7 How. Pr. 798	107
Bailey, *ex parte*, 37 O. G. 781	73
Baker, *ex parte*, 36 O. G. 1149	45
" *v.* Selden, 17 O. G. 1029	100
" *v.* Taylor, 2 Blatch. 82	103
Baldwin *v.* Bernard, 2 O. G. 320	67
Ballard *v.* Pittsburgh, 12 Fed. Rep. 783	33
Baltimore (The), 8 Wallace, 392	60
Bank *v.* Snediker, 17 O. G. 508	24
Banks *v.* McDivett, 8 O. G. 860	108
Barker *v.* Stowe, 14 O. G. 559	19
Barney *v.* Kellogg, 17 O. G. 1096	43; 46
Barrett, *ex parte*, 45 O. G. 125	45
" *v.* Hall, 1 Mason, 447; 1 Robb, 207	17
Bartlett *v.* Crittenden, 5 McLean, 32	107
Bate Refrig. Co. *v.* Gillett, 23 O. G. 1205	21; 22
" " " *v.* " 40 O. G. 1029	22; 65
" " " *v.* " 39 O. G. 833	69
" " " *v.* Hammond *et al.* 46 O. G. 689	22

PAGE

Bates, *ex parte*, 16 O. G. 266..... 24
" *v.* Coe, 15 O. G. 337.....59; 62; 65
Batten *v.* Kear, 2 Phila. 301..... 13
Baumgarten *v.* Forschner, 35 O. G. 137..... 20
Beairs, *ex parte*, 16 O. G. 1233..... 25
Beattie, *ex parte*, 16 O. G. 266..... 73
Bedford *v.* Hunt, 1 Mason, 302; 1 Robb, 148..... 17
Beecher Mfg. Co. *v.* Atwater Mfg. Co., 31 O. G. 1306..... 53
Bell *v.* Brooks, 19 O. G. 290..... 44
" *v.* Daniels, 1 Fisher, 377..... 38
" *v.* Gray, 15 O. G. 776.....41; 42; 43
Bennett, *ex parte*, 35 O. G. 1005.....33; 45
Benton, *ex parte*, 23 O. G. 341..... 53
Bicknell *v.* Todd, 5 McLean, 236..... 57
Bigelow *v.* Commissioner, 7 O. G. 603..... 43
Billings *v.* Ames, 32 Mo. 265..... 13
Birdsell *v.* Coolidge, 93 U. S. 64..... 59
" *v.* Shaliol, 112 U. S. 485..... 57
Blackwell *v.* Dibrell, 3 Hughes, 151..... 90
3 Bl. Com. pp. 378, 386, 393..... 63
Blagrove *v.* Ringgold, 2 Cranch, 407..... 60
Blake *v.* Boisselier, 16 O. G. 854..... 68
" *v.* Stafford, 3 Fisher, 294..... 23
" *v.* " 6 Blatch. 195..... 53
Blakeney *v.* Goode, 30 Ohio St. 350..... 12
Blanchard *v.* Sprague, 2 Story, 164.....6; 25
Bland, *ex parte*, 15 O. G. 775..... 24
" " 16 O. G. 47..... 40
Bliss *v.* City of Brooklyn, 4 Fisher, 596.....52; 57
Board of Commissioners *v.* Gorman, 19 Wallace, 633..... 65
Bochm, *ex parte*, 8 O. G. 319..... 84
Bogert *v.* Hinds, 33 O. G. 1268..... 59
Booth *v.* Lyman, 17 O. G. 393..... 41
Boucicault *v.* Fox, 5 Blatch. 87.....107
" *v.* Hart, 13 Blatch. 47. 107
" *v.* Wood, 2 Biss. 34.....107
Bowers, *ex parte*, 16 O. G. 1004..... 10
Boyd *v.* McAlpin, 3 McLean, 427..... 36
Brammer *v.* Jones, 3 Fisher, 340..... 68
Brass Co. *v.* Miller, 5 Fisher, 48..... 24
Brickell *v.* New York, 18 O. G. 463..... 36
Brooks *v.* Bicknell, 3 McLean, 250..... 68
" *v.* Byam, 2 Story, 525..... 36
" *v.* Miller, 28 Fed. Rep. 615..... 67
Brown *v.* Deere, 19 O. G. 1217.....65; 69
" *v.* Duchesne, 19 How. 183..... 56
" *v.* La Dow, 18 O. G. 1049..... 8
" *v.* Piper, 91 U. S. 41..... 66
" *v.* Selby, 2 Bissell, 457..... 25
" *v.* " 4 Fisher, 363..... 51
" *v.* Shannon, 20 Howard, 55.....12; 13; 68
Browne *v.* Ludlow, 2 Dec. Com. 16..... 44
Browne on Trade Marks, § 87-87; § 204-87; § 333-90; 674-691..... 90
Brownlie, *ex parte*, 3 O. G. 212..... 31
Brush Electric Co. *v.* Electric Co. of San Jose, 51 Fed. Rep. 557..... 65
Bryce *v.* Darr, 3 McLean, 582..... 57
Buchanan, *ex parte*, 16 O. G. 1049..... 45
Bucher Mfg. Co. *v.* Atwater Mfg. Co., 31 O. G. 1306..... 53
Buell, *ex parte*, 20 O. G. 437..... 32
Buerk *v.* Imhauser, 10 O. G. 907..... 59
Bullinger *v.* Mackay, 15 Blatch. 550.....100
Bullock Printing Press Co. *v.* Jones, 13 O. G. 124..... 69
Burdell *v.* Comstock, 15 Fed. Rep. 395..... 64
Burdett *v.* Estey, 16 Blatch. 105..... 14
" *v.* " 15 O. G. 877..... 25
Burdon *v.* Corning, 2 Fisher, 477..... 24

PAGE

Burke *v.* Partridge, 58 N. H. 349.....18; 35
Burney *v.* Kellogg, 17 O. G. 1096..... 45
Burns *v.* Morgan, 3 Hun. 703..... 59
Burr *v.* Duryee, 1 Wall. 531..... 25
Burrows *v.* Lehigh Zinc Co., 1 Bann & A. 521..... 17
Burton *v.* Stratton, 13 Fed. Rep. 696..... 90
Bush & Co., (J.) 10 O. G. 164..... 88
Bussard *v.* Catalino, 2 Cranch, 421..... 60
Butler *v.* Shaw, 21 Fed. Rep. 321..... 48
Butterworth *v.* Hill, 31 O. G. 1043..... 48
" *v.* Hoe, 29 O. G. 615..... 48
Byerly *v.* Cleveland Linseed Oil Works, 31 Fed. Rep. 73..... 20
C. A. Yale Cigar Mfg. Co. *v.* Yale, 30 O. G. 1183..... 40
Cammeyer *v.* Newton, 94 U. S. 225; 11 O. G. 287.....18; 36
Campbell *v.* James, 18 O. G. 1111..... 36
" *v.* " 18 O. G. 979.....36; 58
Canan *v.* Pound Mfg. Co., 31 O. G. 119..... 22
Carew *v.* Boston Elastic Fabric Co., 1 O. G. 91..... 50
" *v.* " " " " 1 Holmes, 45..... 50
Carnrick *v.* McKesson, 19 Blatch. 369..... 68
Carroll *v.* Ertheiler, 1 Fed. Rep. 688.....84; 85
" *v.* Morse, 9 O. G. 458..... 51
Carter *v.* Bailey, 64 Me. 285.....101
" *v.* Baker, 4 Fisher, 404..... 59
" *v.* Perry, 8 O. G. 518..... 17
Carty, *ex parte*, 44 O. G. 570..... 88
Carver *v.* Peck, 131 Mass. 291.....35; 79
Cary *v.* Domestic Spring Bed Co., 30 O. G. 1158..... 69
Case *v.* Redfield, 4 McLean, 526..... 86
Cates *v.* Bales, 78 Ind. 285.....101
Celluloid Mfg. Co. *v.* American Zylonite Co., 40 O. G. 1453..... 23
" " " *v.* " " " 34 Fed. Rep. 744..... 63
" " " *v.* Chrolithian Collar & Cuff Co., 24 Fed. Rep. 585..... 60
" " " *v.* Comstock & Cheney Co., 27 Fed. Rep. 358; 36 O. G. 1356.... 18
" " " *v.* Goodyear Dental Vulcanite Co., 10 O. G. 41.....12; 57
Centennial Catalogue Co. *v.* Porter, 2 W. N. 601.....106
Chambers *v.* Duncan, 10 O. G. 787..... 44
Chapman *v.* Ferry, 12 Fed. Rep. 693.....107
Chase, *ex parte*, 15 O. G. 809..... 26
" *v.* Sanborn, 6 O. G. 932.....103
Chatillon, *ex parte*, 2 O. G. 115..... 31
Christman *v.* Rumsay, 17 O. G. 903..... 25
Clark Patent Co. *v.* Copeland, 2 Fish. 221..... 19
Clark *v.* Killian, 103 U. S. 766..... 66
" *v.* Wilson, 36 O. G. 456..... 22
Clarke, *ex parte*, 26 O. G. 824..... 32
Clayton *v.* Stone, 2 Paine, 382.....100
Clemson *v.* Fowler, 37 O. G. 671..... 41
Coats, *ex parte*, 16 O. G. 544..... 88
Cobb, *ex parte*, 16 O. G. 175..... 32
Coburn *v.* Schroeder, 22 O. G. 419.....20; 22
Cohn *v.* U. S. Corset Co., 6 O. G. 259..... 20
Colgate *v.* Int. Ocean Tel. Co., 17 O. G. 194..... 69
Collender *v.* Griffiths, 3 O. G. 91..... 40
" *v.* " 18 O. G. 241..... 73
" *v.* " 3 O. G. 689.....101
Collins Co. (The) *v.* Oliver Ames & Sons' Corp., 20 Blatch. 542..... 85
" " " *v.* Walker, 7 Weekly Reporter, 222..... 91
Commercial Mfg. Co. *v.* Fairbank Canning Co., 36 O. G. 1473..... 22
Commissioner, Opinion, 26 O. G. 637..... 17
Connor *v.* Williams, 15 O. G. 387..... 41
Conover *v.* Roach, 4 Fish, 12..... 19
Consolidated Electric Light Co. *v.* Edison Electric Light Co., 25 Fed. Rep. 719; 33 O. G. 1597..... 18
Consolidated Fruit Jar Co. *v.* Bellaire Stamping Co., 35 O. G. 627..... 21
" " " " *v.* Whitney, 1 Bann & A. 356..... 68

PAGE

Consolidated Fruit Jar Co., 14 O. G. 269 87
Coon *v.* Wilson, 30 O. G. 889 52
Cornelly, *ex parte*, 1 O. G. 573 24
Cornely *v.* Marckwald, 24 O. G. 498 70
Corning *v.* Troy I. & N. Factory, 13 Howard, 451 66
Cornwall, et al. 12 O. G. 138 88
Cottier *v.* Stimson, 10 Sawyer, 213; 20 Fed. Rep. 906 ..... 20; 63
Covert *v.* Sargent, 38 Fed. Rep. 238 60
Cox, *ex parte*, 3 O. G. 2 ..... 24; 51
Cox's Manual of Trade Mark Cases, 580 91
Crandall, *ex parte*, 35 O. G. 625 ..... 26; 32
Cranson *v.* Smith, 37 Mich. 309 6
Croft *v.* Day, 7 Beav. 84 ..... 91; 92
Crowell *v.* Parmenter, 18 O. G. 360 67
Curtis *v.* Branch, 15 O. G. 919 53
Curtis on Patents, §43 19
Cutting *v.* Myers, 4 Wash. 220 ..... 58; 59
Dale Tile Mfg. Co. *v.* Hyatt, 43 O. G. 249 ..... 57; 58
Davis *v.* Gray, 17 Ohio, St. 330 14
Dawes & Fanning, 1 O. G. 27 88
Dawson *v.* Fallen, 2 Wash. 311 19
Dean *v.* Mason, 20 Howard, 198 66
Dedekam *v.* Vose, 3 Blatch. 153 60
Deering *v.* Winona Harvester Works, 32 O. G. 654 59
De Florez *v.* Reynolds, 17 O. G. 503 ..... 16; 21; 22; 69
" *v.* " 16 Blatch. 397 63
Delano *v.* Scott, 1 Robb, 700 23
Del. Coal & Ice Co. *v.* Packer, 24 O. G. 1273 24
Dermody *v.* Pennock, 14 O. G. 202 41
Designolle, *ex parte*, 13 O. G. 227 24
Dick *v.* Struthers, 34 O. G. 131 70
Diffenderfer, *ex parte*, 2 O. G. 57 73
Doane & Wellington Mfg. Co. *v.* Smith, 24 O. G. 302 53
Dobson *v.* Hartford Carpet Co., 31 O. G. 787 73
" *v.* Dorman, 35 O. G. 750 ..... 73; 74
Dod *v.* Cobb, 10 O. G. 826 40
Dodge, *ex parte*, 3 O. G. 179 ..... 32; 46
Donovan, *ex parte*, 44 O. G. 698 32
Donoughe *v.* Hubbard, 35 O. G. 1561 ..... 35; 41
Dorsey Har. Rake Co. *v.* Marsh, 6 Fisher, 387 23
Doten, *ex parte*, 12 O. G. 841 45
Downton *v.* Gaeger Milling Co., 17 O. G. 906 20
Doyle *v.* Spaulding, 27 O. G. 300; 19 Fed. Rep. 744 70
Draper *v.* Hudson, Holmes, 208; 3 O. G. 354 68
Drawbaugh *v.* Blake, 30 O. G. 259 39
Drewry *v.* Ewing, 1 Bond, 540 100
Dryfoos *v.* Friedman, 18 Fed. Rep. 824 ..... 73; 74
DuBois *v.* Kirk, 158 U. S. 67 (1895) 58
Dudley *v.* Mayhew, 3 N. Y. 9 13
Duke *v.* Graham, 19 Fed. Rep. 647 ..... 12; 58
" *v.* Green, 16 O. G. 1094 89
Dunbar *v.* Marden, 13 N. H. 311 19
Dundas Dick & Co., 10 O. G. 981 87
Dunham *v.* Indianapolis & St. Louis R. R. Co., 7 Bissell, 223 35
" *v.* R. R. Co., 1 Bond, 492 64
Dwight *v.* Appleton, 1 N. Y. Leg. Obs. 195 ..... 103; 105
Dysart, *ex parte*, 34 O. G. 1390 46
Eagle Pencil Co., 10 O. G. 981 87
Eagleton Mfg. Co. *v.* W. B. & C. Mfg. Co., 17 O. G. 1504 ..... 10; 32
Eames *v.* Andrews, 39 O. G. 1319 53
Earle *v.* Sawyer, 4 Mason, 1 18
Earth Closet Co. *v.* Fenner, 5 Fish, 15 67
Eccard *v.* Drawbaugh, 24 O. G. 301 43
Eddy *v.* Dennis, 95 U. S. 560 19
Edison, *ex parte*, 7 O. G. 423 33
Edison *v.* Edison, 9 O. G. 403 8

PAGE

Ehret *v.* Pierce, 18 Blatch. 302.....100
" *v.* " 10 Fed. Rep. 553.....100
Elastic Fabric Co. *v.* Smith, 100 U. S. 110..... 14
Electric Gas Lighting Co. *v.* Fuller, 59 Fed. Rep. 1003..... 66
Elgin Wind, Power & Pump Co. *v.* Nichols, 65 Fed. Rep. 207..... 58
Elizabeth *v.* Pavement Co., 97 U. S. 140..... 60
Emerson *v.* Lippert, 42 O. G. 964..... 22
Emigh *v.* Railroad Co., 6 Fed. Rep. 283..... 58
English, *ex parte*, 2 Dec. Com. 142..... 87
Evans *v.* Eaton, 7 Wheat, 356..... 23
" *v.* Jordan, 1 Brock, 248; 9 Cranch, 199..... 6
Ewart, *ex parte*, 17 O. G. 448..... 25
Ex parte, Alden, 15 O. G. 389..... 88
" Appleton, 1 Dec. Com. 8..... 38
" Atterbury, 2 O. G. 640..... 20
" Bailey, 37 O. G. 781..... 78
" Baker, 36 O. G. 1149..... 45
" Barrett, 45 O. G. 125..... 45
" Bates, 16 O. G. 266..... 24
" Beairs, 16 O. G. 1233..... 25
" Beattie, 16 O. G. 266..... 73
" Bennett, 35 O. G. 1003.....32; 45
" Benton, 23 O. G. 341..... 53
" Bland, 15 O. G. 775..... 24
" " 16 O. G. 47..... 40
" Boehm, 8 O. G. 319..... 84
" Bowers, 16 O. G. 1004..... 10
" Brownlie, 3 O. G. 212..... 31
" Buchanan, 16 O. G. 1049..... 45
" Buell, 20 O. G. 437..... 32
" Carty, 44 O. G. 570..... 38
" Chase, 15 O. G. 809..... 26
" Chatillon, 2 O. G. 115..... 31
" Clarke, 26 O. G. 824.....32; 40
" Coats, 16 O. G. 544..... 88
" Cobb, 16 O. G. 175..... 32
" Cornelly, 1 O. G. 573..... 24
" Cox, 3 O. G. 2..... 24; 51
" Crandell, 35 O. G. 625.....26; 32
" Designole, 13 O. G. 227..... 24
" Diffenderfer, 2 O. G. 57..... 73
" Dodge, 3 O. G. 179.....32; 46
" Donovan, 44 O. G. 698..... 32
" Doten, 12 O. G. 891..... 45
" Dysart, 34 O. G. 1390.....46; 47
" Edison, 7 O. G. 423..... 33
" English, 2 Dec. Com. 142..... 87
" Ewart, 17 O. G. 448..... 25
" Fairbanks, 3 O. G. 65.....24; 31
" Farnum & Co., 18 O. G. 413..... 87
" Funck, 14 O. G. 158..... 24
" Gardner, 17 O. G. 623.....25; 43
" Gentry, 44 O. G. 822..... 25
" Gerard, 43 O. G. 1235.....45; 73
" " 43 O. G. 1240..... 73
" Gillette, 44 O. G. 819.....33; 45
" Gordon, 12 O. G. 517..... 88
" Gray, 12 O. G. 396..... 38
" Greeley, 6 Fisher, 575..... 46
" Hahn, 8 O. G. 597..... 24
" Hardy, 12 O. G. 1075..... 84
" Harris, 38 O. G. 104..... 73
" Hathaway, 3 Dec. Com. 284..... 87
" Herr, 41 O. G. 403..... 53
" Heyman, 18 O. G. 922..... 87
" Hill, 16 O. G. 765..... 31

		PAGE
Ex parte,	Holt, 29 O. G. 171	24; 32
"	" 38 O. G. 227	46; 47
"	Hunt, 13 O. G. 771	8
"	Imbs, 10 O. G. 463	88
"	Jenkins, 4 O. G. 251	21
"	Johnson, 40 O. G. 574	32
"	J. G. Johnson, 2 O. G. 315	87
"	Jovè, 17 O. G. 301	27; 30; 45
"	Keith, 9 O. G. 744	45
"	Kerr, 28 O. G. 95	23; 45
"	" 41 O. G. 463	32
"	Kidd, et al. 5 O. G. 337	84
"	Kimball, 11 O. G. 1109	88
"	Kipling, 24 O. G. 899	87
"	Kitson, 20 O. G. 1750	45
"	Knapp, 16 O. G. 318	87
"	Lanfrey, 20 O. G. 892	20
"	Lanstrom, 17 O. G. 744	45
"	Lassell, 28 O. G. 1274	39
"	Lombard, 43 O. G. 1347	33
"	McDougall, 21 O. G. 1783	32
"	McMurray, 8 O. G. 942	25
"	Malenken, 49 O. G. 915	53
"	Marsh, 2 O. G. 197	54
"	Mason, 9 O. G. 1196	39
"	Mill, 40 O. G. 918	31; 32
"	Myall, 4 O. G. 210	24; 25
"	Nagel, 17 O. G. 198	17; 45
"	Oliver, 18 O. G. 925	87
"	Patitz, 25 O. G. 980	73
"	Pearson, 40 O. G. 244	46
"	Pintsch, 11 O. G. 597	32
"	Pope, 25 O. G. 290	73
"	Porter Blanchard's Sons, 3 Dec. Com. 97	87
"	Preston, 17 O. G. 853	32
"	Proudfit, 10 O. G. 585	31; 45
"	Pulvermacher, 10 O. G. 2	53
"	Rader & Co., G. W. 13 O. G. 596	88
"	Ransom, 39 O. G. 119	32
"	Reid, 15 O. G. 882	24
"	Reynolds, 6 O. G. 641	45
"	Rhentan, 5 O. G. 521	24
"	Roberts, 3 Dec. Com. 100	87
"	Rodgers, 16 O. G. 1223	9
"	Rothschild, 7 O. G. 220	87
"	Sanders, 13 O. G. 818	31
"	Sargent, 12 O. G. 475	8
"	Saunders, 23 O. G. 1224	40
"	Schoonmaker, 13 O. G 595	23
"	Schulze-Berge, 42 O. G. 293	45; 72
"	Siemens, 11 O. G. 1107	53
"	Silliman, 34 O. G. 1389	31
"	Skinner, 19 O. G. 662	24
"	Smith, 2 O. G. 117	24
"	" 1 O. G. 403	25
"	" 16 O. G. 679	87; 88
"	Smoot, 11 O. G. 1010	46
"	Stoughton, 43 O. G. 1345	24
"	Thomas, 14 O. G. 821	82
"	Thurmond, 37 O. G. 217	32
"	Tieman, 11 O. G. 1	32
"	Tolle, 2 O. G. 415	88
"	Traitel, 25 O. G. 783	72
"	Underwood, 1 O. G. 549	51
"	Unsworth, 15 O. G. 882	22
"	Upton, 27 O. G. 99	25

PAGE

Ex parte, Van Matteson, 24 O. G. 889 31
" Warren, 10 O. G. 1 53
" Weaver, 10 O. G. 1 88
" Wharton, 40 O. G. 917 82
" Wheat, 16 O. G. 360 25
" Wheeler, 23 O. G. 1031 40
" Williams, 10 O. G. 748 25
" Wilson, 16 O. G. 95 25
" Winchester, 17 O. G. 453 32
" Witty, 29 O. G. 862 26
" Wright, 10 O. G. 587 50
Fairbanks, *ex parte*, 3 O. G. 65 ..... 24; 31
Farnum & Co., *ex parte*, 18 O. G. 413 87
Faure *v.* Bradley, 44 O. G. 945 40
Fay *v.* Fraser, 14 Fed. Rep. 652 53
Ferrett *v.* Atwill, 1 Blatch. 151 106
Fetridge *v.* Wells, 4 Abb. Pr. 144 91
Fetter *v.* Newhall, 17 Fed. Rep. 841; 21 Blatch. 445; 25 O. G. 502 ..... 17; 35
Fisher *v.* Neil, 19 O. G. 603 ..... 58; 59
Florsheim *v.* Schilling, 35 O. G. 1435 20
Flower *v.* Raynor, 5 Fed. Rep. 791 52
Foote *v.* Frost, 14 O. G. 860 8
" *v.* Silsby, 1 Blatch. 445 55
Folsom *v.* Marsh, 2 Story, 100 108
Forbes *v.* Barstow Stove Co., 2 Clifford, 379 52
Forschner *v.* Baumgarten, 35 O. G. 187 20
Foster *v.* Crossin, 23 Fed. Rep. 400 67
" *v.* Lindsay, 8 O. G. 1032 56
Fowle *v.* Spear, 7 Pa. L. J. 176 91
Foxwell *v.* Bostock, 10 L. T. Rep. N. S. 144 25
Foye *v.* Nichols, 22 O. G. 2243 23
Francis & Mallon, 3 Dec. Com. 283 88
Fraser *v.* Gates, 118 Ill. 99 35
Frearson *v.* Lee, L. R. 9 Ch. 48 20
French *v.* Rogers, 1 Fish, 133 21
Fry *v.* Yeaton, 1 Cranch, 550 60
Funck, *ex parte*, 14 O. G. 158 24
" *v.* Doty, 14 O. G. 157 51
Furbush *v.* Bradford, 1 Fisher, 317 68
Gamewell Fire Alarm Tel. Co. *v.* City of Brooklyn, 22 O. G. 1978 57
Gandy *v.* Belting Co., 143 U. S. 592 59
" *v.* Marble, 39 O. G. 1423 48
Gardner, *ex parte*, 17 O. G. 626 ..... 25; 43
Gardiner *v.* How, 2 Cliff. 462 56
Gaylor *v.* Wilder, 10 How. 498 19
Gaylord *v.* Case, 1 C. L. R. 882 14
Gentry, *ex parte*, 44 O. G. 822 25
Gerard, *ex parte*, 43 O. G. 1235 ..... 45; 78
" " 43 O. G. 1240 78
Giant Powder Co. *v.* Cal. Vigoret Pow. Co., 4 Fed. Rep. 720; 18 O. G. 1339 52
" " " *v.* Safety Nitro Powder Co., 27 O. G. 59 ..... 51; 53
Gibson *v.* Woodworth, 8 Paige, 132 18
Gillette, *ex parte*, 44 O. G. 819 ..... 33; 45
Glen Cove Mfg. Co. *v.* Ludeling, 22 Fed. Rep. 823 92
Goff *v.* Stafford, 14 O. G. 748 20
Gold & Silver Ore Co. *v.* U. S. Ore Co., 3 Fish. 489 56
Goodyear *v.* Allyn, 3 Fisher, 374 37
" *v.* Bishop, 2 Fisher, 96 57
" *v.* " 2 Fisher, 154 59
" *v.* Brown, 3 Blatch. 266 69
" *v.* Chaffee, 3 Blatch. 268 69
" *v.* Hills, 3 Fisher, 134 67
" *v.* McBurney, 3 Blatch. 32 57
" *v.* Providence Rubber Co., 2 Clifford, 351 50
" *v.* Railroad, 1 Fisher, 626 25
" *v.* Wait, 5 Blatch. 468 25

PAGE

Goodyear Dental Vulcanite Co. *v.* Van Antwerp, 9 O. G. 497..... 59
Goodyear Rubber Co., 11 O. G. 1062..... 87
Gordon, *ex parte*, 12 O. G. 517..... 88
Gottfried *v.* Miller, 21 O. G. 711..... 85
Gould *v.* Banks, 8 Wood, 562.....101
Graham *v.* Gammon, 3 Bann & A. 7.....18; 20
" *v.* " 7 Bissell, 490..... 18
" *v.* Geneva Lake C. Mfg. Co., 21 O. G. 1536..... 32
" *v.* McCormick, 21 O. G. 1533..... 19
1 Graham & Waterhouse, N. T. Introd. 1–502, 21; 1–50..... 63
Gramme Electrical Co. *v.* Arnoux & Hochhausen Electric Co., 25 O. G. 193..16; 21; 22
Gray, *ex parte*, 12 O. G. 396..... 88
" *v.* James, 1 Robb, 140..... 59
" *v.* Russell, 1 Story, 11.....100
Greeley, *ex parte*, 6 Fisher, 575..... 48
Green *v.* Hall, 37 O. G. 1475..... 43
Grier *v.* Castle, 17 Fed. Rep. 523; 24 O. G. 1176..... 23
Grigsby *v.* Breckinridge, 2 Bush, 480.....108
Guarantee Insurance Trust & Safe Deposit Co. *v.* Sellers, 41 O. G. 1165..... 22
Guidet *v.* Palmer, 6 Fisher, 82.. 68
Gutta Percha & Rubber Mfg. Co. *v.* Goodyear Rubber Co., 2 Bann & A. 212..... 68
Hahn, *ex parte*, 8 O. G. 597..... 24
Hailes *v.* Albany Stove Co., 123 U. S. 582..... 54
" *v.* " " " 42 O. G. 95..... 70
Hall *v.* Wiles, 2 Blatch. 194..... 54
Hallett *v.* Hague, 2 Bann & A. 370..... 20
Hamilton *v.* Rollins, 3 Bann & A. 157..... 57
Hammerschlag *v.* Scammoni, 20 O. G. 1449..... 20
Hammond *v.* Pratt, 16 O. G. 1235..... 43
Hancock Inspirator Co. *v.* Lally, 35 O. G. 1001..... 23
Hardy, *ex parte*, 12 O. G. 1075..... 34
Harris, *ex parte*, 38 O. G. 104..... 73
Hartell *v.* Vinez, 2 W. N. 602..... 88
Haselden *v.* Ogden, 3 Fish, 378..... 56
Hatch *v.* Hall, 30 O. G. 1096..... 96
" *v.* Moffatt, 15 Fed. Rep. 252..... 24; 51
Hathaway, *ex parte*, 3 Com. Dec. 284..... 87
" *v.* Roach, 2 Woodbury & Minot, 75..... 60
Hayden *v.* Suffolk Mfg. Co., 4 Fisher, 86 59
" *v.* Oriental Mills, 24 O. G. 601..... 63
Hayes *v.* Bickelhaupt, 32 O. G. 133..... 55
Hayward *v.* Andrews, 23 O. G. 533..... 57
Head *v.* Porter, 48 Fed. Rep. 481..... 58
Heath *v.* Unwin, 2 Webb, 236..... 23
Hecht *v.* Porter, 9 Pac. Coast L. J. 569..... 85
Heckers *v.* Fowler, 2 Wallace, 123.....63; 64
Hedges *v.* Daniels, 17 O. G. 152..... 43
Henry *v.* Providence Tool Co., 14 O. G. 855..... 22
Herbert *v.* Butler, 97 U. S. 319..... 64
Herr, *ex parte*, 41 O. G. 463..... 53
Heyman, *ex parte*. 18 O. G. 922..... 87
Heysinger *v.* Denison Mfg. Co., 15 Phila. 509..... 68
Hibbard *v.* Richmond, 17 O. G. 1155..... 44
Hicks *v.* Keating, 40 O. G. 843.. ....39; 43
Higgins *et al v.* Keuffel *et al*, 55 O. G. 1139..... 80
Hill, *ex parte*, 16 O. G. 765..... 31
Hobbie *v.* Smith, 27 Fed. Rep. 665..... 57
Hodge *v.* North Missouri R. R. Co., 4 Fisher, 161..... ... 57
Hoe *v.* Knapp, 36 O. G. 1244..... 68
Hogg *v.* Emerson, 11 How. 587..... 59
Hohorst *v.* Howard, 37 Fed. Rep. 97..... 66
Holden *v.* Curtis, 2 N. H. 61..... 36
Holliday Bros., 16 O. G. 500..... 88
Holmes Elect. Protective Co. *v.* Metropolitan Burglar Alarm Co., 32 O. G. 884; 21 Fed. Rep. 458; 28 O. G. 1189... 22
Holt, *ex parte*, 29 O. G. 171.....24; 32

PAGE

Holt, *ex parte*, 38 O. G. 227.....46; 47
Hoosier Drill Co. *v.* Ingels, 15 O. G. 1013..... 10
" " " *v.* " 14 O. G. 785..... 89
Hopkins *v.* Le Roy, 18 O. G. 859 41
Hoskin *v.* Fisher, 43 O. G. 509..... 53
Hostetter *v.* Vowinkle, 1 Dillon, 329..... .....84; 92
Hotchkiss *v.* Greenwood, 4 McLean. 456..... 19
Hovey *v.* Hupeland, 2 O. G. 491..... 44
" *v.* Rubber Tip Pencil Co., 33 N. Y. Sup. 522..... 13
" *v.* Stevens, 2 Robb, 479 68
Howe *v.* Chatham, 64 Tex. 36..... 36
Hubbard *v.* Myers, 16 O. G. 1051..... 21
" *v.* Thompson, 14 Fed. Rep. 689..... 108
Hubbell *v.* De Land, 22 O. G. 1883..... 62
Hull *v.* Commissioner, 7 O. G. 559..... 48
Hunt, *ex parte*, 13 O. G. 771..... 8
" *v.* Hoover, 24 Iowa, 231..... 13
Huntley *v.* Smith, 18 O. G. 795..... 41
Imbs, *ex parte*, 10 O. G. 463..... 88
Independent Bung and Bushing Co., 31 Fed. Rep. 76..... 20
India Rubber Comb Co., 8 O. G. 905..... 88
Ingalls *v.* Tice, 14 Fed. Rep. 352..... .....12; 58
Insurance Co. *v.* Lanier, 95 U. S. 171..... 64
Irwin *v.* Dane, 4 Fisher, 359..... 67
Isaacs *v.* Cooper, 1 Robb, 332..... 68
Ives *v.* Sargent, 38 O. G. 781.....52; 53
Jacobs *v.* Lopez, 28 O. G. 342..... .....84; 88
James *v.* Campbell, 21 O. G. 337.....24; 53
" *v.* " 104 U. S. 356..... 56
Jenkins, *ex parte*, 4 O. G. 351..... 21
" *v.* Barney, 3 O. G. 119..... 45
Johnson, *ex parte*, 40 O. G. 574..... 32
J. G. Johnson & Co., *ex parte*, 2 O. G. 315..... 87
Johnson *v.* Fassman, 2 O. G. 941..... 21
" *v.* Root, 2 Fisher, 291..... 63
Jollie *v.* Jacques, 1 Blatch. 618..... 100
Jones *v.* Barker, 22 O. G. 771. 52
" *v.* McMurray, 13 O. G. 6..... 19
" *v.* Merrill, 8 O. G. 401..... 67
" *v.* Morehead, 1 Wallace, 155..... 66
" *v.* Sewall, 3 O. G. 630..... 18
Jordan *v.* Dobson, 4 Fish, 232..... .....6; 64
Jové, *ex parte*, 17 O. G. 801..... .....27; 30; 45
Judson *v.* Bradford, 16 O. G. 171 18
Kass *v.* Hawlowetz, 33 O. G. 1135..... 37
Kayser *v.* Arnold, 41 Hun. 275..... 58
Keach, in re, 14 R. I. 571..... 79
Keene *v.* Kimball, 82 Mass. 545.....108
" *v.* Wheatley, 4 Phila. 147.....108
Keith, *ex parte*, 9 O. G. 744..... 45
Kelleher *v.* Darling. 14 O. G. 673.....19; 62
Kendall *v.* Winsor, 6 R. I. 453..... 13
Kendrick *v.* Emmons, 9 O. G. 201..... 22
Kerr, *ex parte*, 28 O. G. 95.....23; 45
" " 41 O. G. 463..... 32
Keyes *v.* Pueblo Smelting & Refining Co., 31 Fed. Rep. 560..... 67
Kidd, et al. *ex parte*, 5 O. G. 337..... 84
Kilbourn *v.* Sunderland, 130 U. S. 505..... 67
Kimball, *ex parte*, 11 O. G. 1169... 88
King *v.* Force, 2 Cranch C. C. 208.....105
Kinney *v.* Allen, 1 Hughes, 106..... 88
Kipling, *ex parte*, 24 O. G. 899..... 87
Kirk *v.* Commissioner, 37 O. G. 451..... 48
" *v.* Dubois, 37 O. G. 102..... 65
Kitson, *ex parte*, 20 O. G. 1750..... 45
Kittle *v.* Hall, 39 O. G. 707..... 67

PAGE

Kittle *v.* Hall, 30 Fed. Rep. 239 70
Knapp, *ex parte*, 16 O. G. 318 87
Knox *v.* Quicksilver M. Co. 4 Fed. Rep. 809 24
Koechlin *v.* Marble, 22 O. G. 1365 22
Kraus *v.* Fitzpatrick, 42 O. G. 1292 73
L. & M. Tobacco Co. *v.* Miller, 17 O. G. 798 55
Lander *v.* Crowell, 16 O. G. 405 ..... 17; 42; 43; 44
Lanfrey, *ex parte*, 20 O. G. 892 ..... 20; 39; 44
Lanstrom, *ex parte*, 17 O. G. 744 45
Lassell, *ex parte*, 28 O. G. 1274 39
Lautz Bros. *v.* Schultz, 9 O. G. 791 89
Laverty *v.* Flagg, 16 O. G. 1141 40
Lawrence & Co., 10 O. G. 163 88
" *v.* Dana, 7 O. G. 81 105
Leather Cloth Co. Case, 11 Jur. (N. S.) 513 91
Lee *v.* Blandy, 2 Fish, 89 13
" *v.* Walsh, 15 O. G. 563 53
Leonard *v.* Lovell, 29 Fed. Rep. 310 18
Lindsay *v.* Roraback, 4 Jones Eq. 124 13
" *v.* Stein, 21 O. G. 1613 ..... 33; 62
Livingston *v.* Van Ingen, 9 Johns, 507 ..... 6; 18
Little *v.* Gould, 2 Blatch. 165 ..... 100; 108
" *v.* " 2 Blatch. 362 100
Lockwood *v.* Lockwood, 33 Iowa, 509 85
Lombard, *ex parte*, 43 O. G. 1347 33
Loom Co. *v.* Higgins, 21 O. G. 2031 23
Lowell *v.* Lewis, 1 Mason, 182; 1 Robb, 131 17
Lyell *v.* Miller, 6 McLean, 422 60
Lynch *v.* Dryden, 3 O. G. 407 43
McBurney *v.* Goodyear, 11 Cush. 509 52
McComb *v.* Brodie, 2 O. G. 117 37
McConihay *v.* Wright, 121 U. S. 201 64
McCrea *v.* Holdsworth, 2 O. G. 592 72
McCreary *v.* Penn. Canal Co., 5 Fed. Rep. 367 67
McCormick *v.* Seymour, 2 Blatch. 240 59
McDougall, *ex parte*, 21 O. G. 1783 32
McElwee *v.* Blackwell, 15 O. G. 658 89
McFarland *v.* Spencer, 32 O. G. 893 70
McKnight *v.* Wagenen, 9 O. G. 1161 41
McLean *v.* Fleming, 6 Otto, 245 ..... 87; 92
" *v.* " 13 O. G. 913 91
McMillan *v.* Barclay, 5 Fish, 189 ..... 33; 67
" *v.* Rees, 17 O. G. 1222 ..... 20; 24
McMurray, *ex parte*, 8 O. G. 943 25
" *v.* Mallory, 27 O. G. 915 54
McNamara *v.* Hulse, 2 Web, 128 24
McWilliams Mfg. Co. *v.* Blundell, 22 O. G. 117 52
Machesney *v.* Brown, 38 O. G. 1130 35
Magic Ruffle Co. *v.* Elm City Co., 11 O. G. 501 64
Malin *v.* Harwood, 30 O. G. 657 58
Malenken, *ex parte*, 49 O. G. 915 58
Manning *v.* Cape Ann Isinglass & Glue Co., 4 Bann & A. 612 20
Marks Chair Co. *v.* Wilson, 43 Fed. Rep. 304 60
Marsh, *ex parte*, 2 O. G. 197 54
" *v.* Nichols, 24 O. G. 901 ..... 13; 58
" *v.* Warren, 13 O. G. 7 81
Martinetti *v.* Maguire, 1 Deady, 216 100
Mason, *ex parte*, 9 O. G. 1196 39
Matthews *v.* Iron Clad Mfg. Co., 42 O. G. 827 53
" *v.* Lalance & Grosjean Mfg. Co., 17 O. G. 1284 65
" *v.* Schoeneburger, 18 O. G. 1464 24
" *v.* Skates, 1 Fish, 602 ..... 19; 21
" *v.* Spangenberg, 23 O. G. 92 55
Maurice *v.* Devol, 23 W. Va. 247 36
May *v.* County of Fond du Lac, 27 Fed. Rep. 691 ..... 18; 59
Mayor of New York *v.* Ransom, 23 How. 487 59

PAGE

Medart *v.* Risdon Iron Works, 71 O. G. 751 25
Meissner *v.* De Voe Mfg. Co., 2 O. G. 545 24
Merchant *v.* Lewis, 1 Bond, 172 60
Merrill *v.* Yeamans, 12 O. G. 980 24
Mers *v.* Conover, 11 O. G. 1111 52
Meserole *v.* Union Paper Collar Co., 3 Fisher, 483 58
Meyer *v.* Bailey, 8 O. G. 437 ..... 50; 51
Mill, *ex parte*, 40 O. G. 918 ..... 31; 32
Miller *v.* Bridgeport Brass Co., 21 O. G. 201 52
" *v.* Smith, 18 O. G. 1047 73
" *v.* Young, 33 Ill. 354 72
Miller's Falls Co. *v.* Ives, 14 O. G. 203 ..... 35; 57
Milligan *v.* Lalance & Grosjean Mfg. Co., 29 O. G. 367 35
Millward *v.* Barnes, 11 O. G. 1060 41
Moffitt *v.* Gaar, 1 Blatch. 273 52
Moore *v.* Marsh, 7 Wall, 515 57
Morgan *v.* Seaward, 2 Carp. P. C. 104 54
Morris *v.* Shelbourne, 4 Fisher, 377 67
Morrison *v.* Case, 2 O. G. 544 88
Motte *v.* Bennett, 2 Fisher, 642 67
Mowry *v.* Whitney, 1 O. G. 499 56
Muntz *v.* Foster, 2 Webb, 96 19
Murray *v.* Ager, 20 O. G. 1311 79
Myall, *ex parte*, 4 O. G. 210 ..... 24; 25
Myers *v.* Callaghan, 5 Fed. Rep. 726 105
" *v.* Frame, 4 Fisher, 493 56
Nagel, *ex parte*, 17 O. G. 198 ..... 17; 45
Nathan *v.* N. Y. Elevated R. R. Co., 2 Fed. Rep. 225 68
New Process Ferm. Co. *v.* Koch, 29 O. G. 535 20
New *v.* Warren, 22 O. G. 587 51
Newman *v.* Alford, 51 N. Y. 192 92
New York Grape Sugar Co. *v.* Buffalo Grape Sugar Co., 32 O. G. 1356 67
New York *v.* Ransom, 23 How. 487 ..... 21; 23
Nichols *v.* Newell, 1 Fisher, 647 37
Nicholson *v.* Bennett, 16 O. G. 631 39
Niedringhaus *v.* Commissioner, 8 O. G. 279 72
North American Iron Works *v.* Fiske, 39 O. G. 1086 65
Northrop *v.* Adams, 12 O. G. 430 73
Northwestern Co. *v.* Philadelphia Co., 6 O. G. 34 ..... 20; 34; 50
Oakes *v.* Tousmierre, 4 Woods, 547 ..... 90; 92
Oliver, *ex parte*, 18 O. G. 923 87
Opinion Attorney General, 9 Op. at Gen. 171; 2 Op. at Gen. 571 17
Opinion Commissioner, 26 O. G. 637 17
O'Reilly *v.* Morse, 15 How. 62 54
Osborne *v.* Winkley, 2 Gallison, 51; 1 Robb, 52 17
Pace, Talbott & Co., 16 O. G. 909 88
Pacific Bank *v.* Robinson, 20 O. G. 1314 79
Page *v.* Holmes B. A. Tel. Co., 17 O. G. 737 ..... 8; 17
" *v.* " " " 17 Blatch. 484 17
Paillard *v.* Bruno, 38 O. G. 900 22
Palmer *v.* De Witt, 47 N. Y. 532; 5 Abb. Pr. (N. S.) 130 108
" *v.* Harris, 60 Penn. 156 91
" *v.* U. S. 20 Ct. of Claims, 432 56
Parker *v.* Haworth, 4 McLean, 379 59
" *v.* Hulme, 1 Fish. 44 56
Parkhurst *v.* Kinsman, 1 Blatch. 494 19
" *v.* " 2 Blatch. 76 69
" *v.* " 1 Blatch. 488 35
Parkinson *v.* Laselle, 3 Saw. 331 105
Parks *v.* Booth, 102 U. S. 106 60
Parsons *v.* Barnard, 7 Johns, 144 13
Parton *v.* Prang, 2 O. G. 619 107
Partridge *v.* Menck, 1 How. App. Cases, 553 91
Patitz, *ex parte*, 25 O. G. 980 73
Pearson, *ex parte*, 40 O. G. 244 46
Peck *v.* Collins, 19 O. G. 1137 51

PAGE

Peck *v.* Farrington, 9 Wend, 44 13
Pelham *v.* Edelmeyer, 25 O. G. 292 64
Penna. Salt Mfg. Co. *v.* Thomas, 5 Fisher, 148 51
Pennock *v.* Dialogue, 2 Peters, 1 17
Pentlarge *v.* Beeston, 17 Blatch. 306 66
" *v.* Kirby, 19 Fed. Rep. 501 37
People *v.* Russell, 25 O. G. 504 6
Perry *v.* Starrett, 14 O. G. 549 74
Peterson *v.* Wooden, 3 McLean, 248 59
Pfanschmidt *v.* P. H. Kelly Mercantile Co., 41 O. G. 1501 63
Phillip *v.* Nock, 13 Wall. 185 12
Phillips *v.* Brown, 4 Blatch. 362 33
Pickering *v.* McCullough, 21 O. G. 73 17
Pierce *v.* Wests' Executors, 1 Peters, C. C. Rep. 351 65
Pierson *v.* Colgate, 24 O. G. 203 20
" *v.* Eagle Screw Co., 3 Story, 402 36
Pike *v.* Potter, 3 Fisher, 55 23
Pintsch, *ex parte*, 11 O. G. 597 32
Piper *v.* Brown, 1 Holmes, 198 60
Pitts *v.* Hall, 2 Blatch. 229 18
" *v.* Whitman, 2 Story, 609 59
Planing Machine Co. *v.* Keith, 17 O. G. 1031 21
" " " *v.* " 101 U. S. 492 63
Pontiac Knit Boot Co. *v.* Merino Shoe Co., 31 Fed. Rep. 39 57
Pope, *ex parte*, 25 O. G. 290 73
" Mfg. Co. *v.* Gormully & Jeffrey Mfg. Co., 34 Fed. Rep. 893 35
Popham *v.* Wilcox, 14 Abb. Pr. (N. S.) 206 92
Poppenhusen *v.* New York Gutta Percha Comb Co., 2 Fisher, 62 ..... 57; 59
" *v.* " " " " " " 2 Fisher, 74 67
Porter Blanchard's Sons, *ex parte*, 3 Dec. Com. 97 87
Potter *v.* Braunsdorf, 7 Blatch. 97 50
" *v.* Holland, 4 Blatch. 206 ..... 35; 50; 52
" *v.* " 1 Fisher, 337 55
" *v.* Mack, 3 Fisher, 428 69
" *v.* Schenck, 3 Fisher, 821 67
" *v.* Wilson, 2 Fish. 102 56
Powder Co. *v.* Powder Works, 98 U. S. 126 53
Pratt & Farmer, 10 O. G. 866 87
Prentiss *v.* Ellsworth, 27 O. G. 623 ..... 48; 55
Preston, *ex parte*, 17 O. G. 853 32
Prime *v.* Brandon Mfg. Co. 16 Blatch. 453; 4 Bann & A. 379 79
Procter *v.* Brill, 16 Fed. Rep. 971 14
Proudfit, *ex parte*, 10 O. G. 585 ..... 31; 45
Pryor *v.* Coulter, 1 Bailey, 517 35
Pulvermacher, *ex parte*, 10 O. G. 2 53
Putnam *v.* Tinkham, 4 Fed. Rep. 411 52
Railway Register Mfg. Co. *v.* North Hudson Co. R. R. Co., 33 O. G. 355 32
Ransom, *ex parte*, 39 O. G. 119 32
" *v.* Mayor of New York, 1 Fisher, 252 ..... 17; 91
Rapid Service Store R. R. Co. *v.* Taylor, 42 O. G. 721 24
Read *v.* Miller, 3 Fisher, 310 ..... 62; 68
Reay *v.* Raynor, 26 O. G. 1111 67
Reed *v.* Carusi, Taney, 72 108
" *v.* Cutter, 1 Story, 590 17
" *v.* Street, 34 O. G. 339 49
Reeder & Co., G. W., *ex parte*, 13 O. G. 593 88
Reeves *v.* Keystone Bridge Co., 9 O. G. 885 65
Reid, *ex parte*, 15 O. G. 882 24
Reynolds, *ex parte*, 6 O. G. 641 45
Rhentan *ex parte*, 5 O. G. 521 24
Rice *v.* Burt, 16 O. G. 1050 ..... 18; 34
Richardson *v.* Miller, 12 O. G. 3 100
Robert Ransome's Ex'rs. 2 Dec. Com. 143 34
Roberts, *ex parte*, 3 Dec. Com. 100 87
" *v.* Dickey, 1 O. G. 4 21
" *v.* Meyers, 23 Law Rep. 396 ..... 100; 101; 103

PAGE

Roberts *v.* Schreiber, 18 O. G. 125..... 23
Robinson on Patents §67–17; §331–19; §325–20; §529–24; §§804-805–35; §659–50; §642–54; §947–57; §949–58; §§986-993–63.
Rodgers, *ex parte*, 16 O. G. 1223..... 7
" *v.* Philp, 1 O. G. 29 .....91; 92
Roemer *v.* Bernheim, 133 U. S. 106..... 66
" *v.* Simon, 12 O. G. 796; 5 O. G. 555..... 17
Rogers *v.* Abbott, 4 Wash, 514..... 65
" *v.* Bear, 16 O. G. 903..... 43
" *v.* Jewett, 22 Law Rep. 339.....106
" *v.* Reissner, 41 O. G. 851..... 64
(Wm.) Rogers Mfg. Co. *v.* Rogers & Spurr Mfg. Co., 11 Fed. Rep. 495..... 84
Root *v.* Lake Shore & Mich. Southern R. R. Co., 21 O. G. 1112.....58; 64
" *v.* Railway Co., 105 U. S. 214..... 60
Rosenbach *v.* Dreyfuss, 17 O. G. 1153.....100; 106
Rosenwasser *v.* Berry, 22 Fed. Rep. 841..... 18
Rossiter *v.* Hall, 5 Blatch. 362.....107
Rothschild, *ex parte*, 7 O. G. 220..... 87
Rowe & Post, 9 O. G. 496..... 87
Royer *v.* Coupe, 29 Fed. Rep. 358; 89 O. G. 239..... 17
Rubber Co. *v.* Goodyear, 9 Wallace, 801..... 60
Rumpf *v.* Köhler, 23 O. G. 1831.....20; 44
Runstatter *v.* Atkinson, 23 O. G. 940..... 17
Russell *v.* Dodge, 11 O. G. 151..... 53
Safety Powder Co., 16 O. G. 186..... 88
Sanders, *ex parte*, 13 O. G. 118..... 31
Sanford *v.* Messer, 5 Fisher, 411..... 57
Sargent, *ex parte*, 12 O. G. 475..... 8
Sarony *v.* Burrow G. L. Co., 17 Fed. Rep. 591.....100; 105
Saunders, *ex parte*, 23 O. G. 1224..... 40
Sawyer *v.* Edison, 25 O. G. 597.....18; 39
" *v.* Horn, 4 Hughes, 239..... 87
" *v.* Kellogg, 7 Fed. Rep. 720..... 87
" *v.* Massey, 25 Fed. Rep. 144..... 56
" *v.* Miller, 12 Fed. Red. 725..... 23
Saxe *v.* Hammond, 7 O. G. 781..... 65
Sayles *v.* Hapgood, 3 Fish, 632..... 17
Schillinger *v.* Gunther, 17 Blatch. 66..... 54
" *v.* " 16 O. G. 905..... 55
Schmid *v.* Mfg. Co., 67 Fed. Rep. 348..... 60
Schneider *v.* Hill, 5 Bann & A. 565..... 28
Schoerken *v.* S. & C. & B. Mfg. Co., 19 O. G. 1493.....14; 20
Schoonmaker, *ex parte*, 13 O. G. 595..... 23
Schubert *v.* Shaw, 28 A. L. Reg. 248.....100
Schulze-Berge, *ex parte*, 42 O. G. 293.....45; 72
Searle *v.* Bouton, 22 O. G. 946..... 53
Seixo *v.* Provezende L. R., 1 Ch. 192..... 91
Selden *v.* Stockwell Self-Lighting Gas Burner Co., 9 Fed. Rep. 390–18; 20 O. G. 1877.....33; 50; 53
Sewing Mach. Co. *v.* Frame, 28 O. G. 96..... 53
Seymour *v.* McCormick, 19 How. 96..... 54
" *v.* Osborne, 3 Fish. 555..... 23
" *v.* " 11 Wall, 516..... 25
Sharp *v.* Tifft, 17 O. G. 1282..... 54
Shaw *v.* Colwell Lead Co., 11 Fed. Rep. 711..... 50
" *v.* Cooper, 7 Peters, 292; 1 Robb, 643..... 17
Shaw Stocking Co. *v.* Mack, 12 Fed. Rep. 707..... 87
Shelly *v.* Brannan, 4 Fisher 195..... 67
Shepard *v.* Carrigan, 34 O. G. 1157..... 53
Shickle *v.* St. Louis Foundry Co., 22 Fed. Rep. 105..... 64
Shook *v.* Rankin, 6 Biss. 477.....100
Sickels *v.* Borden, 3 Blatch. 535..... 59
Siebert Cylinder Oil Cup Co. *v.* Beggs, 32 Fed. Rep. 790..... 35
" " " " " *v.* Harper Steam Lub. Co., 4 Fed. Rep. 328..... 52
Siemens, *ex parte*, 11 O. G. 1107..... 53
" *v.* Sellers, 23 O. G. 2234..... 22

PAGE

Siemmer's Appeal, 58 Pa. St. 155..... 17
Silliman, *ex parte*, 34 O. G. 1389..... 31
Silsby *v.* Foote, 14 Howard, 218..... 63
Simpson *v.* Wright, 15 O. G. 248..... 89
Singer R. C. Co. *v.* Tobey F. Co., 23 O. G. 93..... 19
" Sewing Mach. Co. *v.* Union Button Hole & Emb. Co., 4 O. G. 553..... 68
" *v.* Walmsley, 1 Fisher, 558..... 55
Skinner, *ex parte*, 19 O. G. 662..... 24
Smith, *ex parte*, 2 O. G. 117..... 24
" " 1 O. G. 403..... 25
" " 16 O. G. 679..... 88
" *v.* Dowling, 1 Fish. 64..... 23
" *v.* Johnson, 4 Blatch. 252.....108
" *v.* Prior, 2 Sawyer, 461..... 18
" *v.* Reynolds, 3 O. G. 216..... 88
" *v.* " 3 O. G. 213..... 89
" *v.* Winchell, 13 O. G. 1127..... 43
Smoot, *ex parte*, 11 O. G. 1010..... 40
Snow *v.* Judson, 38 Barb. 210..... 13
" *v.* Taylor, 14 O. G. 861..... 19
Sparkman *v.* Higgins, 1 Blatch. 205..... 18
Spill *v.* Celluloid Mfg. Co., 29 O. G. 773..... 63
Sprague *v.* Adriance, 14 O. G. 308..... 21
Spring *v.* Domestic Sew. Mach. Co., 22 O. G. 1445..... 57
" *v.* " " " " 16 O. G. 721..... 67
" *v.* Packard, 7 O. G. 341..... 17
Stachelberg *v.* Ponce, 23 Fed. Rep. 430..... 90
Stanley, *v.* Whipple, 2 McLean, 35..... 58
Starling *v.* St. Paul Plow Works, 41 O. G. 818..... 63
Starr *v.* Farmer, 23 O. G. 2325.....39; 41
Steam Gauge & Lantern Co. *v.* Miller, 11 Fed. Rep. 718.....52; 53
Stearns *v.* Gladding, 17 How. 447..... 65
Stevens *v.* Cady, 2 Curt. 200.....106; 108
" *v.* Pritchard, 10 O. G. 505..... 24
" *v.* Putnam, 18 O. G. 519..... 43
Stewart *v.* Tenk, 41 O. G. 1502..... 17
Stimpson *v.* Rogers, 4 Blatch. 383..... 34
Stitt *v.* Eastern R. R. Co., 22 Fed. Rep. 649..... 19
Story Eq. Pl. §§403–428; §§412–419; §§1506–1516; §§300–310; §§689–691; §§1480–1504.66
" *v.* Halcombe, 4 McLean, 306.....101
Stoughton, *ex parte*, 43 O. G. 1345..... 24
St. Paul Plow Works *v.* Starling, 104 U. S. 197..... 63
Straiton & Storm, 18 O. G. 923..... 88
Strasburger & Co., 20 O. G. 155..... 88
Streit *v.* Lauter, 11 Fed. Rep. 309..... 53
Suydam *v.* Day, 2 Blatch. 20..... 57
Swift *v.* Jenks. 27 O. G. 621..... 24
" *v.* Peters, 11 O. G. 1110..... 84
" *v.* Whisen, 2 Bond, 115..... 23
" *v.* " 3 Fisher, 343..... 53
Taylor *v.* Martin, 16 O. G. 138..... 46
Teese *v.* Phelps, 1 McAl. 48..... 21
Tennants' Case, Dav. P. C. 429; 1 Web, 125; 1 Abb. P. C. 115..... 17
Terry Clock Co. *v.* New Haven Clock Co., 17 O. G. 908..... 24
The Baltimore, 8 Wallace, 392..... 60
Theberath *v.* Rubber & Celluloid H. T. Co., 23 O. G. 1121..... 78
Thomas, *ex parte*, 14 O. G. 821..... 88
" *v.* Recse, 17 O. G. 195.....17; 30
" *v.* Weeks, 2 Paine, 92..... 17
Thompkins *v.* Butterfield, 33 O. G. 758..... 37
Thompson, Derby & Co., 16 O. G. 137..... 88
" *v.* Haight, 1 U. S. L. T. 582..... 18
" *v.* Mendelson, 5 Fisher, 187..... 58
" & Waterhouse, 30 O. G. 177..... 34
Thurmond, *ex parte*, 37 O. G. 217..... 32
Tibbals *v.* Day, 11 Fed. Rep. 903..... 65

PAGE

Tieman, *ex parte*, 11 O. G. 1..... 32
Tilghman *v.* Proctor, 19 O. G. 859..... 25
" *v.* " 125 U. S. 160..... 60
Tobey Furn. Co. *v.* Colby, 35 Fed. Rep. 592..... 68
Tolle, *ex parte*, 2 O. G. 415..... 88
Tomkinson *v.* Willets Mfg. Co., 31 O. G. 918..... 69
Toohey *v.* Harding, 1 Fed. Rep. 174.....14; 24
Torrant *v.* Duluth Lumber Co., 39 O. G. 1425..... 24
Traitel, *ex parte*, 25 O. G. 783..... 72
Tuck *v.* Bramhill, 6 Blatch. 95.....55; 70
Tucker *v.* Kahler, 15 O. G. 966..... 43
Turnbull *v.* Weir Plow Co., 7 O. G. 173..... 36
Turrill *v.* Railroad Company, 1 Wall, 491..... 25
Tyler *v.* Galloway, 22 O. G. 2072..... 25
Underwood, *ex parte*, 1 O. G. 549..... 51
Union Paper Bag Co. *v.* Binney, 5 Fish. 166..... 56
" " " " *v.* Nixon, 4 O. G. 31..... 23
Union Paper Collar Co. *v.* White, 7 O. G. 698; 877..... 54
United States *v.* Bell Telephone Co., 158 U. S. 548 (1895.)..... 58
" " *v.* Marble, 22 O. G. 1365.....7; 9
United States Annunciator & Bell Tel. Mfg. Co. *v.* Sanderson, 3 Blatch. 184..... 67
United States Nickel Co. *v.* Pendleton, 24 O. G. 704..... 25
United States Rifle & Cart. Co. *v.* Whitney Arms Co., 11 O. G. 373..... 62
United States Stamping Co. *v.* Jewett, 17 Fed. Rep. 869; 18 O. G. 1529..... 18
United Telephone Co. *v.* Harrison, Cox-Walker & Co., L. R. 21 Ch. 720..... 20
Unsworth, *ex parte*, 15 O. G. 883..... 22
Upton, *ex parte*, 27 O. G. 99..... 25
Vance *v.* Campbell, 1 Black, 427..... 63
Van Matteson, *ex parte*, 24 O. G. 389..... 31
Vaughn *v.* Cent. Pac. R. R. Co., 4 Sawyer, 280..... 64
Vogeley *v.* Noel, 18 Fed. Rep. 327..... 20
Vogler *v.* Semple, 11 O. G. 923..... 24
Vose *v.* Singer, 4 Allen, 226..... 35
Walker on Patents, §72–19; §§442–472..... 62
" *v.* Reid, 2 C. L. B. 133..... 89
Walton *v.* Crowley, 3 Blatch. C. C. 440..... 91
Ware *v.* Bullock, 7 O. G. 39..... 38; 44
Warren, *ex parte*, 10 O. G. 1..... 53
Washburn, *v.* Gould, 3 Story, 122; 2 Robb, 206..... 18
" & Moen Mfg. Co. *v.* Chicago G. W. F. Co., 109 Ill. 71..... 35
" " " " *v.* Haish, 19 O. G. 173.....51; 52
Waterbury Brass Co. *v.* N. Y. Brass Co., 3 Fish, 43..... 56
Watson *v.* Bladen, 4 Wash. C. C. 580..... 21
Wayne *v.* Holmes, 1 Bond, 27..... 23
Weaver, *ex parte*, 10 O. G. 1..... 88
Webb *v.* Powers, 2 W. & M. 497.....101
" *v.* Quintard, 1 O. G. 525.....18; 19
Weisert Bros., 16 O. G. 680..... 87
Welling *v.* Rubber Coated Harness Trimming Co., 7 O. G. 608..... 68
Wells *v.* Gill, 2 O. G. 590..... 68
" *v.* Jacques, 5 O. G. 364..... 25
West *v.* Barns, 2 Dallas, 401..... 63
Western Electric Mfg. Co. *v.* Odell, 18 Fed. Rep. 321..... 73
Westinghouse Air Brake Co. *v.* Carpenter, 32 Fed. Rep. 545..... 68
Weston *v.* White, 13 Blatch. 364..... 22
Wetherell *v.* N. J. Zinc Co., 5 O. G. 460..... 69
Wharton, *ex parte*, 40 O. G. 917..... 32
Wheat, *ex parte*, 16 O. G. 360..... 25
Wheaton *v.* Peters, 8 Wheat, 591.....100
" *v.* " 8 Peters, 591.....103; 108
Wheeler, *ex parte*, 23 O. G. 1031..... 40
" *v.* McCormick, 4 O. G. 692..... 57
" *v.* Russell, 1 O. G. 183..... 44
Whipple *v.* Miner, 23 O. G. 2236..... 48
White *v.* Allen, 2 Clifford, 224..... 18
" *v.* Gleason Mfg Co., 24 O. G. 265..... 54

PAGE

White *v.* Rankin, 144 U. S. 628 58
Whitely *v.* Fisher, 4 Fisher, 248 50
Whitely *v.* McCormick, 10 O. G. 826 43
Whitney *v.* Emmett, Baldwin, 303; 1 Robb, 567 13
Whittemore *v.* Cutter, 1 Gallison, 478 59
Wilder *v.* Gaylor, 1 Blatch. 511 68
" *v.* McCormick, 2 Blatch. 31 ..... 58; 59
Williams *v.* Bankhead, 19 Wall. 563 64
" *ex parte*, 10 O. G. 748 25
Willimantic Linen Co. *v.* Clark Thread Co., 4 Bann & A. 133 20
Willis *v.* McCollins, 28 O. G. 1017 ..... 12; 57; 58
Wilson, *ex parte*, 16 O. G. 75 25
" *v.* Barnum, 8 How. 258 12
" *v.* " 2 Fisher, 635 67
" *v.* Chickering, 23 O. G. 1730 57
" *v.* Coon, 19 O. G. 482 25
" *v.* Janes, 3 Blatch. 227 68
" *v.* Rousseau, 4 How. 646 18
" *v.* Singer Mfg. Co., 16 O. G. 1091 37
Wilson Packing Co. *v.* Clapp, 13 O. G. 368 58
Winans *v.* N. Y. & Harlem R. R. Co., 4 Fisher, 1 59
" *v.* N. Y. & Erie R. R. Co., 1 Fisher, 218 91
Winchester, *ex parte*, 17 O. G. 453 32
Wintermute *v.* Redington, 1 Fisher, 239 35
Witty, *ex parte*, 29 O. G. 862 26
Wren *v.* Annin, 34 Fed. Rep. 435 58
Wright, *ex parte*, 10 O. G. 587 50
" *v.* Randal, 21 O. G. 493; 19 Blatch. 495 ..... 18; 33; 36
" *v.* Simpson, 15 O. G. 968 89
" *v.* Wilson, 11 Rich. 144 18
Wood *v.* Abbott, 5 Blatch. 325 100
" *v.* Eames, 17 O. G. 512 43
" *v.* Dolbey, 20 O. G. 523 73
Woolsey *v.* Judd, 4 Duer, 379 ..... 107; 108
Wooster *v.* Handy, 23 Fed. Rep. 60 60
Worden *v.* Searls, 39 O. G. 359 53
Yale Cigar Mfg. Co. *v.* Yale, 30 O. G. 1183 39
Yale Lock Co. *v.* Greenleaf, 35 O. G. 386 24
" " " *v.* Sargent, 35 O. G. 497 ..... 53; 54; 55
York & Cumberland R. R. Co. *v.* Myers, 18 Howard, 240 68
Young *v.* Hoad, 2 Com. Dec. 59 21
" *v.* Lippman, 2 O. G. 249 69
Yuengling *v.* Schile, 12 Fed. Rep. 97 100

HISTORY OF THE PATENT SYSTEM OF THE UNITED STATES.

The granting of patents to inventors is authorized by the eighth section of the first article of the Constitution:

"The Congress shall have power * * * * to promote the progress of Science and Useful Arts, by securing, for limited times, to Authors and Inventors the exclusive right to their respective Writings and Discoveries."

Congress has, in pursuance of this authority, made two classes of grants: (1) Special acts, conferring some new or more exclusive privilege to individual inventors; (2) General acts, providing for the issue of letters patent by a department of the government to any person who may be found to be entitled to them. These, the decisions of the courts interpreting them, the rules of practice of the Patent Office, and the decisions of the Commissioner of Patents, constitute the body of the American patent law and practice.

The first general act was passed in 1790. This act charged the Secretary of State, the Secretary of War, and the Attorney-General, or any two of them, with the duty of granting to an inventor, whose invention they considered sufficiently useful and important, a patent securing to him the exclusive benefits of his invention for a period not exceeding fourteen years. It also prescribed the mode of making application; the proceedings to repeal unlawful patents; the penalty for infringement; and fees for the issue of patents. No examination was made as to the novelty of the invention.

The act of 1793 repealed the act of 1790, saving existing rights; confided the duty of issuing patents to the Secretary of State, subject to the approval of the Attorney-General; and provided that the applicant for patent should make oath that he believed himself the true inventor; for the assignment of interest in patents and the recording of same; for proceedings in case of interfering applications; that a patentee of an improvement is not entitled to use the original invention, or *vice versa*; that changes of form or proportions do not amount to an invention; the mode of making application; and that State patents be relinquished by patentees of United States. The term of the patent still remained fourteen years.

The act of 1794 provided for saving suits commenced under the act of 1790 from defeat by the repeal of the act in 1793.

The act of 1800 extended the privileges of the act of 1793 to resident aliens; provided that oath should be made by every applicant that to the best of his knowledge the invention was never before known or used in this or any foreign country; such use to avoid patent if obtained; and that representatives of deceased inventor might obtain patent in trust for the heirs or devisees.

The act of 1819 provided that the circuit courts of the United States should have original cognizance, at law and equity, of actions under patent laws, with writ of error or appeal to the Supreme Court.

The act of 1832, ch. 162, provided for the annual publication of lists of patents issued; for proceedings before Congress for extensions, and for proceedings for the reissue of patents because of defect in original patent.

The act of 1832, ch. 302, extended privilege of alien patentees, and required the actual use of the invention in the United States within one year after the date of the patent.

The act of 1836 reconstructed the entire patent system, adding many new and valuable elements, and established the rights and obligations of inventors and patentees very nearly as they exist now. A sub-department of the State Department was created, known as the Patent Office, to which the powers and duties of the Secretary of State, in reference to patents, were transferred. The office of Commissioner of Patents was established; a seal of Office adopted. It provided for examination as to the novelty of inventions; that applicants should be notified of the result thereof, and for appeals from such findings; for proceedings when an application interfered with an existing patent; for re-issues; that a foreign patent to same applicant should not be a bar to one in the United States within six months after issue of former. It provided that applicant should make oath that he believed himself the first inventor; that invention was not before known or used by others, or in public use or on sale at time of application, and that he did not know of its prior use or knowledge. Also, that patents might be assigned, and for a record of assignments; that representatives of deceased inventors might take out patent in trust for heirs or devisee; also for caveats, and proceedings under same; and established a Patent Office Library.

The act of 1837 provided for the re-issue of several patents should different inventions be embraced in an original patent; that applications for re-issue or for an improvement to an existing patent should be subject to the same examination as original applications; for proceedings in disclaimer; that patent might issue to an assignee at request of, and on application by, inventor; that a patent was not invalid for what was properly claimed, by reason of excessive claim.

The act of 1839 provided that a foreign patent for the same invention within previous six months should not defeat an application, if there had been no public use in the United States; in such cases the United States patent was to run fourteen years from the date of the foreign patent; for bill in equity for a patent when application was refused by the Patent Office; for appeal from Commissioner to Chief Justice of the District Court of the District of Columbia.

The act of 1842 provided for the refund of fees paid by mistake; for the issue of patents for new designs for the term of seven years; for the marking of patented articles with the date of the patent, and prescribed a penalty for falsely marking unpatented articles, and for imitating the mark of a patentee.

The act of 1846 provided for the payment and deposit of funds for Patent Office.

The act of 1848 vested power in the Commissioner to extend patents; fixed fees for recording assignments, and provided for an increase in the clerical force of the office.

The act of 1849, chap. 108, provided for the removal of the Patent Office to the Interior Department, a division of which it has ever since remained.

The act of 1852 provided that appeals, when made to the Chief Justice of District Court of the United States for the District of Columbia, might be also taken to either of the Assistant Judges of the Circuit Court for said district, and fixed the compensation of such Judges.

The act of 1861, chap. 37, provided for writ of error or appeal in patent cases from Circuit Court to the Supreme Court, at the instance of either party.

The act of 1861, chap. 88, provided for proceedings in taking testimony for use in Patent Office; for the appointment of three examiners-in-chief "of legal knowledge and scientific ability," to review and revise decisions of examiners when necessary, etc.; also that, except in interference cases, no appeal to examiners-in-chief allowed until application had been twice rejected by a primary examiner upon the same state of facts; that Commissioner might require illegible applications, etc., to be printed; and that he might refuse to recognize any person as an attorney, subject to the approval of the President; for a revision of the fees payable with respect to applications, etc.; that inventors of new and useful designs might patent the same for three and a half, seven, or fourteen years, as they desired, and fixed the fees; that applications for patents were to be regarded as abandoned when they were not completed and prepared for examination within two years after filing, unless satisfactory cause was shown; fixed time of filing applications for extensions; provided that patented articles should be so marked, otherwise infringer would not be liable to pay damages unless he knew of his infringement; for printing and selling copies of patents; fixed term of new patents at seventeen years, and no extension of such patents.

The act of 1863 provided that every patent should be dated not later than six months after notice of its allowance to patentee or his agent; that if final fees were not paid within the six months, the invention to become public property.

The act of 1865 provided that when the final fee was not paid in due time, a new application might be filed at any time within two years from the date of the allowance of the original application.

The act of 1868 provided that the examiner-in-chief having the longest official experience should act as commissioner in case of the absence or the disability of the latter.

The act of 1870, as amended by act of 1871, chaps. 5 and 132, and the joint resolution of 1871, No. 5, is still in force, and forms part of the Revision of 1874 (Revised Statutes of the United States of America). The foregoing summary does not include acts whose sole purpose was the appointment of officials or the granting of appropriations.

PATENT LAWS OF THE UNITED STATES.

CONSTITUTION.

ART. 1, SEC. 8.

The Congress shall have power * * * * to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

In the exercise of this power Congress is limited to authors and inventors only, see Livingston *v.* Van Ingen, 9, Johns, 507. The power is general to grant to inventors, and it rests in the sound discretion of Congress to say when and for what length of time, and under what circumstances the patent for an invention shall be granted. There is no restriction which limits the power of Congress to cases where the invention has not been known or used by the public. All that is required is that the patentee shall be the inventor. An act which gives a patent for an invention which was in public use and enjoyed by the community at the time of its passage, is not for that reason unconstitutional. Blanchard *v.* Sprague, 2 Story, 164; Evans *v.* Jordan, 1 Brock, 248; 9 Cranch, 199; Jordan *v.* Dobson, 4 Fish, 232. The power of Congress to legislate upon the subject of patents is plenary, by the terms of the constitution, and as there are no restraints on its exercise, there can be no limitation of their right to modify them at their pleasure, so that they do not take away the rights of property in existing patents, see 2 Robb, 105. Any State legislation which undertakes to limit or restrict in any manner the privileges which the letters patent confer is an invasion of national authority, and therefore void, see Cranson *v.* Smith, 37 Mich., 309; People *v.* Russell, 25 O. G. 504.

STATUTES.

ESTABLISHMENT OF THE PATENT OFFICE.

TITLE XI, Rev. Stat., p. 80:

SEC. 475. There shall be in the Department of the Interior an office known as the Patent Office, where all records, books, models, drawings, specifications, and other papers and things pertaining to patents shall be safely kept and preserved.

OFFICERS AND EMPLOYÉS.

SEC. 476. There shall be in the Patent Office a Commissioner of Patents, one Assistant Commissioner, and three examiners-in-chief, who shall be appointed by the President, by and with the advice and consent of the Senate. All other officers, clerks, and employés authorized by law for the Office shall be appointed by the Secretary of the Interior, upon the nomination of the Commissioner of Patents. [See § 169.]

SALARIES.

SEC. 477. The salaries of the officers mentioned in the preceding section shall be as follows:

The Commissioner of Patents, four thousand five hundred dollars a year.

The Assistant Commissioner of Patents, three thousand dollars a year.

Three examiners-in-chief, three thousand dollars a year each.

TITLE XI, Rev. Stat., p. 74:

SEC. 440. There shall also be in the Department of the Interior—

* * * * * * *

In the Patent Office:

One chief clerk, at a salary of two thousand five hundred dollars a year.

One examiner in charge of interferences, at a salary of two thousand five hundred dollars a year.

One examiner in charge of trade-marks, at a salary of two thousand five hundred dollars a year.

Twenty-four principal examiners, at a salary of two thousand five hundred dollars a year each.

Twenty-four first assistant examiners, at a salary of one thousand eight hundred dollars a year each.

Twenty-four second assistant examiners (two of whom may be women), at a salary of one thousand six hundred dollars a year each.

Twenty-four third assistant examiners, at a salary of one thousand four hundred dollars a year each.

One librarian, at a salary of two thousand dollars a year.

One machinist, at a salary of one thousand six hundred dollars a year.

Three skilled draughtsmen, at a salary of one thousand two hundred dollars a year each.

Thirty-five copyists of drawings, at a salary of one thousand dollars a year each.

One messenger and purchasing clerk, at a salary of one thousand dollars a year.

One skilled laborer, at a salary of one thousand two hundred dollars a year.

Eight attendants in the model-room, at a salary of one thousand dollars a year each.

Eight attendants in the model-room, at a salary of nine hundred dollars a year each.

ACT JUNE 19, 1878.

[*One financial clerk, two thousand dollars, who shall give bond in such amount as the Secretary of the Interior may determine.*]

ACT JUNE 7, 1884.

[*One law clerk, two thousand dollars.*]*

DUTIES OF SECRETARY.

SEC. 441. The Secretary of the Interior is charged with the supervision of public business relating to the following subjects:

* * * * * * *

Fifth. Patents for inventions.

An application for a *mandamus* to compel the issue of a patent must be directed against the Secretary of the Interior and not against the Commissioner of Patents, see U. S. *v.* Marble, 22 O. G. 1365. The decisions of the Commissioner of Patents while acting in a judicial capacity are not, however, subject to review by the Secretary of the

---

* For the number of officers and employés of the Patent Office, and respective salaries, at any given time, see the various appropriation acts.

Interior, see Edison *v.* Edison, 9 O. G. 403. If the Commissioner declines to issue a patent because there is no novelty in the claim, no appeal lies to the Secretary of the Interior, see *ex parte* Hunt, 13 O. G. 771. The power to supervise includes the power to direct, and is applicable to executive duties, see Edison *v.* Edison, 9 O. G. 408.

If the Commissioner neglects or refuses to perform any duty required by law to be performed by him, or performs a ministerial or administrative duty improperly, the Secretary of the Interior, by virtue of his supervisory power, may direct him in its performance, see *ex parte* Sargent, 12 O. G. 475.

TITLE XI, Rev. Stat., p. 80.

SEAL.

SEC. 478. The seal heretofore provided for the Patent Office shall be the seal of the office, with which letters patent and papers issued from the Office shall be authenticated.

BONDS OF COMMISSIONER AND CHIEF CLERK.

SEC. 479. The Commissioner of Patents and the chief clerk, before entering upon their duties, shall severally give bond, with sureties, to the Treasurer of the United States, the former in the sum of ten thousand dollars and the latter in the sum of five thousand dollars, conditioned for the faithful discharge of their respective duties, and that they shall render to the proper officers of the Treasury a true account of all money received by virtue of their offices.

RESTRICTIONS UPON OFFICERS AND EMPLOYÉS.

SEC. 480. All officers and employés of the Patent Office shall be incapable, during the period for which they hold their appointments, to acquire or take, directly or indirectly, except by inheritance or bequest, any right or interest in any patent issued by the Office.

If a person makes an invention before he becomes an employé he does not thereby forfeit or dedicate the invention to the public. He is simply prevented from taking a patent while he remains an employé, see Page *v.* Holmes B. S. Tel. Co., 17 O. G. 737. A Commissioner, after his commission ceases, may take out a patent for an invention made by him while he was in office, and in a controversy with others the invention may be referred to the true date, see Foote *v.* Frost, 14 O. G. 860.

DUTIES OF COMMISSIONER.

SEC. 481. The Commissioner of Patents, under the direction of the Secretary of the Interior, shall superintend or perform all duties respecting the granting and issuing of patents directed by law; and he shall have charge of all books, records, papers, models, machines, and other things belonging to the Patent Office.

DUTIES OF EXAMINERS-IN-CHIEF.

SEC. 482. The examiners-in-chief shall be persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the appellant, to revise and determine upon the validity of the adverse decisions of examiners upon applications for patents, and for re-issues of patents, and in interference cases; and, when required by the Commissioner, they shall hear and report upon claims for extensions, and perform such other like duties as he may assign them.

The decision of the examiners-in-chief must be limited to the questions presented to them by the appeal of the party who considers himself aggrieved, see Brown *v.* La Dow, 18 O. G. 1049.

Establishment of Regulations.

Sec. 483. The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

If a rule established by the Patent Office is within the powers of the office it is just as authoritative as an act of Congress itself, see U. S. *v.* Marble, 22 O. G. 1365.

If the rules do not permit the use of affidavits in a particular case the Commissioner may pass a special order allowing them, see *ex parte* Rodgers, 16 O. G. 1223.

Arrangement and Exhibition of Models, Etc.

Sec. 484. The Commissioner of Patents shall cause to be classified and arranged in suitable cases, in the rooms and galleries provided for that purpose, the models, specimens of composition, fabrics, manufactures, works of art, and designs, which have been or shall be deposited in the Patent Office; and the rooms and galleries shall be kept open during suitable hours for public inspection.

Disposals of Models on Rejected Applications.

Sec. 485. The Commissioner of Patents may restore to the respective applicants such of the models belonging to rejected applications as he shall not think necessary to be preserved, or he may sell or otherwise dispose of them after the application has been finally rejected for one year, paying the proceeds into the Treasury, as other patent moneys are directed to be paid.

Library.

Sec. 486. There shall be purchased for the use of the Patent Office a library of such scientific works and periodicals, both foreign and American, as may aid the officers in the discharge of their duties, not exceeding the amount annually appropriated for that purpose.

Patent Agents may be Refused Recognition.

Sec. 487. For gross misconduct the Commissioner of Patents may refuse to recognize any person as a patent agent, either generally or in any particular case; but the reasons for such refusal shall be duly recorded, and be subject to the approval of the Secretary of the Interior.

Rules of Practice, 1892,—7, 17, 18, 19, 20, 21, 22, 23, 152.

Any person of intelligence and good moral character may appear as the agent or the attorney in fact of an applicant, upon filing a proper power of attorney.

Before an attorney, original or associate, will be allowed to inspect papers or take action of any kind, his power of attorney must be filed. But general powers given by a principal to an associate cannot be considered. In each application the written authorization must be filed. A power of attorney purporting to have been given to a firm or copartnership will not be recognized, either in favor of the firm or of any of its members, unless all its members shall be named in such power of attorney.

Substitution or association can be made by an attorney upon the written authorization of his principal; but such authorization will not empower the second agent to appoint a third.

Powers of attorney may be revoked at any stage in the proceedings of a case upon application to and approval by the Commissioner.

A patent agent does not sustain the same relation to the Patent Office as an attorney sustains to a court. An attorney is a permanent officer of the court, retained by parties in particular cases; but a patent agent is not an officer of the Patent Office, he is connected with the Patent Office only by means of the particular cases in which he is employed, see Hoosier Drill Co. *v.* Ingels, 15 O. G. 1013.

The death of the inventor revokes the power of attorney given to an agent, see Eagleton Mfg. Co. *v.* W. B. & C. Mfg. Co., 17 O. G. 1504.

Where an inventor sends a notice to the Patent Office that he has discharged an agent, that is sufficient so far as the Patent Office is concerned, but a discharge of an agent is not effective against a third party until notice thereof is communicated to him, see Hoosier Drill Co. *v.* Ingels, 15 O. G. 1013.

An attorney is allowed to retain possession of the letters patent until his fees are paid, see *ex parte* Bowers, 16 O. G. 1004.

Printing of Papers Filed.

Sec. 488. The Commissioner of Patents may require all papers filed in the Patent Office, if not correctly, legibly, and clearly written, to be printed at the cost of the party filing them.

Printing Copies of Claims, Laws, Decisions, Etc.

Sec. 489. The Commissioner of Patents may print, or cause to be printed, copies of the claims of current issues, and copies of such laws, decisions, regulations, and circulars as may be necessary for the information of the public.

Printing Specifications and Drawings.

Sec. 490. The Commissioner of Patents is authorized to have printed, from time to time, for gratuitous distribution, not to exceed one hundred and fifty copies of the complete specifications and drawings of each patent hereafter issued, together with suitable indexes, one copy to be placed for free public inspection in each capitol of every State and Territory, one for the like purpose in the clerk's office of the district court of each judicial district of the United States, except when such offices are located in State or Territorial capitols, and one in the Library of Congress, which copies shall be certified under the hand of the Commissioner and seal of the Patent Office, and shall not be taken from the depositories for any other purpose than to be used as evidence. [See § 894.]

Additional Specifications and Drawings.

Sec. 491. The Commissioner of Patents is authorized to have printed such additional numbers of copies of specifications and drawings, certified as provided in the preceding section, at a price not to exceed the contract price for such drawings, for sale, as may be warranted by the actual demand for the same; and he is also authorized to furnish a complete set of such specifications and drawings to any public library which will pay for binding the same into volumes to correspond with those in the Patent Office and for the transportation of the same, and which shall also provide for proper custody for the same, with convenient access for the public thereto, under such regulations as the Commissioner shall deem reasonable.

Lithographing and Engraving.

Sec. 492. The lithographing and engraving required by the two preceding sections shall be awarded to the lowest and best bidders for the interests of the Government, due regard being paid to the execution of the work, after due advertising by the Congressional Printer under the direction of the Joint Committee on Printing; but the Joint Committee on Printing may empower the Congressional Printer to make immediate contracts for engraving, whenever, in their opinion, the exigencies of the public service will not justify waiting for advertisement and award; or if, in the judgment of the Joint Committee on Printing, the work can be performed under the direction of the Commissioner of Patents more advantageously than in the manner above prescribed, it shall be so done, under such limitations and conditions as the Joint Committee on Printing may from time to time prescribe.*

Volumes, Etc., to be Furnished Departments.

(Act of March 3, 1875.)

Sec. 12. *That it shall be the duty of the Commissioner of Patents to furnish, free of cost, one copy of the bound volumes of specifications and drawings of patents published by the Patent Office, to each of the Executive Departments of Government, upon the request of the head thereof.*

Price of Copies of Specifications and Drawings.

Sec. 493. The price to be paid for uncertified printed copies of specifications and drawings of patents shall be determined by the Commissioner of Patents, within the limits of ten cents as the minimum and fifty cents as the maximum price.

Annual Report of the Commissioner.

Sec. 494. The Commissioner of Patents shall lay before Congress, in the month of January, annually, a report, giving a detailed statement of all moneys received for patents, for copies of records or drawings, or from any other source whatever; a detailed statement of all expenditures for contingent and miscellaneous expenses; a list of all patents which were granted during the preceding year; designating under proper heads the subjects of such patents; an alphabetical list of all the patentees, with their places of residence; a list of all patents which have been

---

*For the provisions relating to photolithographing, etc., at any given time, see the various appropriation acts.

In the act of February 26, 1889, chap. 279, U. S. Stat., XXV, p. 737, the following language appears:

* * * * * * *

Said photolithographing, or otherwise producing plates and copies referred to in this and the preceding paragraph, to be done under the supervision of the Commissioner of Patents, and in the city of Washington, if it can be there done at reasonable rates; and the Commissioner of Patents, under the direction of the Secretary of the Interior, shall be authorized to make contracts therefor.

extended during the year; and such other information of the condition of the Patent Office as may be useful to Congress or the public. [See §§ 195, 196.]

CUSTODY OF COLLECTIONS OF EXPLORING EXPEDITION.

SEC. 495. The collections of the Exploring Expedition, now in the Patent Office shall be under the care and management of the Commissioner of Patents.

DISBURSEMENTS FOR PATENT OFFICE.

SEC. 496. All disbursements for the Patent Office shall be made by the disbursing clerk of the Interior Department.

JURISDICTION.

SEC. 629. The circuit courts shall have original jurisdiction as follows:

* * * * * * * *

PATENT AND COPYRIGHT SUITS.

Ninth. Of all suits at law or in equity arising under the patent or copyright laws of the United States.

See also notes under Sec. 4919, *post*.

The Federal courts have exclusive jurisdiction over all cases arising under the patent laws, see Willis *v.* McCollin, 38 O. G. 1017, and without regard to the citizenship of the parties, see Duke *v.* Graham, 19 Fed. Rep. 647. The existence and validity of the monopoly, as claimed under the patent, are the only questions arising under the patent laws, see Blakeney *v.* Goode, 30 Ohio St. 350; Celluloid Mfg. Co. *v.* Goodyear Dental Vulcanite Co., 10 O. G. 41. A question of contract concerning a patent-right or a patented invention is not a question under the patent laws, see Ingalls *v.* Tice, 14 Fed. Rep. 352.

APPELLATE JURISDICTION.

SEC. 690. The Supreme Court shall have appellate jurisdiction in the cases hereinafter specially provided for.

See also Section 4919, and notes, *post*.

The right of appeal or error, without regard to value, given by this section, in cases arising under the patent laws, applies to controversies between a patentee and alleged infringer, as well as to those between patentees, see Philip *v.* Nock, 13 Wall, 185; but does not apply to controversies arising upon enforcement of contracts relative to patents, see Brown *v.* Shannon, 20 How. 55. The Supreme Court has no original jurisdiction over questions of fact, such as infringements, etc., see Wilson *v.* Barnum, 8 How. 258.

* * * * * * * *

WRITS OF ERROR AND APPEALS.

SEC. 699. A writ of error may be allowed to review any final judgment at law, and an appeal shall be allowed from any final decree in equity hereinafter mentioned, without regard to the sum or value in dispute.

PATENT AND COPYRIGHT CASES.

First. Any final judgment at law or final decree in equity of any circuit court, or of any district court acting as a circuit court, or of the supreme court of the District of Columbia, or of any Territory, in any case touching patents rights or copyrights

See also Section 4919, and notes, *post.*

The Supreme Court has no appellate jurisdiction of a suit to enforce the specific performance of a contract in relation to a patent unless the value of the matter in controversy exceeds the jurisdictional amount ($2,000); although it may have and exercise jurisdiction when a far less amount is in dispute, if the suit touches the title, validity or infringement of a patent, see Brown *v.* Shannon, 20 How. 55.

Exclusive Jurisdiction of Courts of United States.

Sec. 711. The jurisdiction vested in the courts of the United States in the cases and proceedings hereinafter mentioned, shall be exclusive of the courts of the several States:

* * * * * * *

Patent and Copyright Cases.

Fifth. Of all cases arising under the patent-right or copyright laws of the United States.

See also notes under Section 4919, *post.*

The jurisdiction vested in the circuit courts is exclusive where the action touches the title, validity or infringement of a patent. A State court cannot entertain a bill in equity to enjoin an infringement, see Dudley *v.* Mayhew, 3 N. Y. 9; and has no jurisdiction over an action for an infringement of a patent, see Parsons *v.* Barnard, 7 Johns. 144; nor of an action brought by a patentee to restrain another from issuing circulars warning parties against purchasing a certain article, if the latter claims the right to do so under a patent, see Hovey *v.* Rubber Tip Pencil Co., 33 N. Y. Sup. 522. If two patents have been issued to different parties, the State courts have no jurisdiction to settle their conflicting claims, or to enjoin the subsequent patentee at the instance of the prior patentee, see Gibson *v.* Woodworth, 8 Paige, 132. A State court has no jurisdiction over an action of assumpsit to recover upon a *quantum valebat* for the use of a patented invention, see Batten *v.* Kear, 2 Phila. 301; nor can it entertain a bill for discovery and an injunction against an execution issued upon a judgment for damages rendered in an action for the infringement of a patent, see Kendall *v.* Winsor, 6 R. I. 453. A State court has jurisdiction over an action to recover damages for fraud in the sale of a patent-right, see Hunt *v.* Hoover, 24 Iowa, 231; of an action by a manufacturer against a patentee, for falsely and intentionally advertising that his manufactures were an infringement of a patent, see Snow *v.* Judson, 38 Barb. 210; of an action for the breach of a warranty, see Wright *v.* Wilson, 11 Rich. 144; of an action to rescind a contract for the sale of a patent-right, on account of a fraud, see Lindsay *v.* Roraback, 4 Jones Eq. 124; of an action to recover damages for breach of an agreement, see Billings *v.* Ames, 32 Mo. 265, and in fact all actions based on contracts between the parties.

* * * * * * * *

Title XIII, Rev. Stat., p. 169:

Copies of Records, Etc., of Patent Office.

Sec. 892. Written or printed copies of any records, books, papers, or drawings belonging to the Patent Office, and of letters patent authenticated by the seal and certified by the Commissioner or Acting Commissioner thereof, shall be evidence in all cases wherein the originals could be evidence; and any person making application therefor, and paying the fee required by law shall have certified copies thereof.

An exemplification of the patent and specification is admissable in evidence although the drawing is not exemplified, see Peck *v.* Farrington, 9 Wend. 44.

A certified copy of an assignment is *prima facie* evidence of the genuineness of the original, and is competent evidence, and absolute evidence of the correctness of the copies from the record, see Lee *v.* Blandy, 2 Fish. 89. A transcript of certain documents

on file in the Patent Office is competent evidence, although it does not purport to be a copy of the whole proceeding, see Tookey *v.* Harding, 1 Fed. Rep. 174. The proper evidence of a patent is a copy of the patent itself duly authenticated by the official seal and certificate of the Commissioner, see Davis *v.* Gray, 17 Ohio St. 330. Certified copies of the assignments of a patent are not evidence that there is no other title of record, see Am. D. R. B. Co. *v.* Sheldon, 17 Blatch., 208.

Copies of Foreign Letters Patent.

Sec. 893. Copies of the specifications and drawings of foreign letters patent certified as provided in the preceding section, shall be *prima facie* evidence of the fact of the granting of such letters patent, and of the date and contents thereof.

If a foreign patent is certified by the officer of the foreign patent office that corresponds to the Commissioner of Patents, it is admissable in evidence, see Schoerken *v.* S. & C. & B. Mfg. Co., 19 O. G. 1498.

A certificate of the Commissioner of the correctness of a translation of a foreign patent contained in a volume in the library of the Patent Office is not competent evidence, see Gaylord *v.* Case, 1 C. L. B. 382.

Printed Copies of Specifications and Drawings of Patents.

Sec. 894. The printed copies of specifications and drawings of patents, which the Commissioner of Patents is authorized to print for gratuitous distribution, and to deposit in the capitols of the States and Territories, and in the clerk's offices of the district courts, shall, when certified by him and authenticated by the seal of his office, be received in all courts as evidence of all matters therein contained. [See § 490.]

Costs not Recoverable in Certain Suits for Infringement of Patent Unless Disclaimer Entered, Etc.

Sec. 973. When judgment or decree is rendered for the plaintiff or complainant, in any suit at law or in equity, for the infringement of a part of a patent, in which it appears that the patentee, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor, no costs shall be recovered, unless the proper disclaimer, as provided by the patent laws, has been entered at the Patent Office before the suit was brought.

If the plaintiff on trial abandons one claim, he cannot recover costs, see Procter *v.* Brill, 16 Fed. Rep. 971. If a patentee files a disclaimer as to one division of a re-issue, and the validity of the other division is sustained, he is entitled to recover costs, see Elastic Fabric Co. *v.* Smith, 100 U. S. 110. If a disclaimer is not filed until after the commencement of a suit, he cannot recover costs, see Burdett *v.* Estey, 16 Blatch. 105.

Patented Articles Connected With Marine Engines.

Sec. 1537. No patented article connected with marine engines shall hereafter be purchased or used in connection with any steam vessels of war until the same shall have been submitted to a competent board of naval engineers, and recommended by such board, in writing, for purchase and use.

TITLE XVII, Rev. Stat., p. 292:

NO ROYALTY TO BE PAID BY UNITED STATES TO ITS OFFICERS FOR PATENT MENTIONED IN PRECEDING SECTION.

SEC. 1673. No royalty shall be paid by the United States to any one of its officers or employés for the use of any patent for the system, or any part thereof, mentioned in the preceding section, nor for any such patent in which said officers or employés may be directly or indirectly interested.

PATENTS.

PATENTS, HOW ISSUED, ATTESTED AND RECORDED.

TITLE LX, Rev. Stat., chap. 1, p. 945:

SEC. 4883. All patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Secretary of the Interior and countersigned by the Commissioner of Patents, and they shall be recorded, together with the specifications, in the Patent Office, in books to be kept for that purpose.

ACT FEB. 18, 1888. U. S. STAT., XXV, P. 40.

CHAP. 15.—An act to amend section four thousand eight hundred and eighty-three of the Revised Statutes to enable the Assistant Secretary of the Interior to sign patents.

SIGNING PATENTS. R. S., S. 4883, P. 945, AMENDED.

Be it enacted, etc., That section four thousand eight hundred and eighty-three of the Revised Statutes is hereby amended by inserting after the words "Secretary of the Interior" where they occur therein, the following words: "or under his direction by one of the Assistant Secretaries of the Interior;" so that the said section as amended will read as follows:

ASSISTANT SECRETARIES OF THE INTERIOR MAY SIGN PATENTS.

"*Sec.* 4883. *All patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Secretary of the Interior or under his direction by one of the Assistant Secretaries of the Interior, and countersigned by the Commissioner of Patents, and they shall be recorded, together with the specifications, in the Patent Office, in books to be kept for that purpose.*"

Approved, February 18, 1888.

ACT APRIL 19, 1888. U. S. STAT. XXV., P. 87.

CHAP. 126.—An act to give validity to certain patents for inventions which were irregularly executed.

PATENTS.

SIGNATURE OF ASSISTANT SECRETARY OF THE INTERIOR VALID TO CERTAIN PATENTS.

Be it enacted, etc., That all patents for inventions signed by David L. Hawkins, Second Assistant Secretary of the Interior, or any other Assistant Secretary of the Interior, shall have the same force, effect,

and validity as though the same had been signed by the Secretary of the Interior in person at the date on which they were respectively executed.

Approved, April 19, 1888.

Rules of Practice, 1892.—134, 165, 166, 221, 222, 14, 220.

If a patent is issued without the signature of the Secretary or of an Assistant Secretary of the Interior, it is void, and a subsequent signing will not make it valid as of the date when it was issued, see Marsh *v.* Nichols, 24 O. G. 901.

The records of the Patent Office are open to inspection; persons will not, however, be allowed to make copies or tracings from the files or records of the office. Such copies or tracings will be furnished by the office upon payment of the usual fees therefor.

Contents and Duration.

Sec. 4884. Every patent shall contain a short title or description of the invention or discovery, correctly indicating its nature and design, and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the exclusive right to make, use, and vend the invention or discovery throughout the United States and the Territories thereof, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof.

Rules of Practice, 1892.—168.

A patent takes effect from the date of its grant, and under the present law it cannot be antedated, see Gramme Electrical Co. *v.* Arnoux & Hochhausen Electric Co., 25 O. G. 193. The term of a patent is measured by the statute, not by the language of the grant, however, see De Florez *v.* Reynolds, 17 O. G. 503; and where an invention has been previously patented in a foreign country, its term will be affected by the term of such prior foreign patent, if same should be less than seventeen years (See Rev. Stat. 4887 and notes, *post*), otherwise the term is uniformly fixed at seventeen years. The term of a patent cannot now be extended except by special act of Congress. (See Rev. Stat. secs. 4924–4928, *post*, as to extension of patents granted prior to March 2, 1861.)

Date of Patent.

Sec. 4885. Every patent shall bear date as of a day not later than six months from the time at which it was passed and allowed and notice thereof was sent to the applicant or his agent; and if the final fee is not paid within that period the patent shall be withheld.

Rules of Practice, 1892.—164, 165, 166, 167, 222.

The weekly issue closes on Thursday, and the patents of that issue bear date as of the third Tuesday thereafter, the intervening time being consumed in preparing, printing, signing and sealing the patents, printing the copies, and preparing and printing the Official Gazette. If the final fee in any application is not paid on or before Thursday, the patent will not go to issue until the following week. If a patent is withheld because of failure to pay the final fee, the application for patent may be renewed, provided that such second application be filed within two years after the allowance of the original application. See Rev. Stat., sec. 4897, *post*.

Who May be Patentee: What Inventions are Patentable.

Sec. 4886. Any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement thereof, not known or used by others in this country, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, and not in public use or on sale for more than two years prior to his application, unless the same is proved to have been abandoned, may upon payment of the fees required by law, and other due proceedings had, obtain a patent therefor.

Act of March 3, 1883, c. 143.

The Secretary of the Interior and the Commissioner of Patents are authorized to grant any officer of the Government, except officers and employés of the Patent Office, a patent for any invention of the classes mentioned in section forty-eight hundred and eighty-six of the Revised Statutes when such invention is used or to be used in the public service, without the payment of any fee: Provided, That the applicant in his application shall state that the invention described therein, if patented, may be used by the Government, or any of its officers or employés in prosecution of work for the Government, or by any other person in the United States, without the payment to him of any royalty thereon, which stipulation shall be included in the patent.

Rules of Practice, 1892.—24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 40, 46.

As to Applicant.—True and First Inventor.—The law places no restriction whatever as to citizenship or nationality, age or sex. The applicant must, however, be the original and first inventor, or the executor or administrator of a deceased inventor.

No person who is not at once the first as well as the original inventor by whom the invention has been perfected and put into actual use, is entitled to a patent. A subsequent inventor, although an original inventor, is not entitled to any patent, see Spring *v.* Packard, 7 O. G. 341; Burrows *v.* Lehigh Zinc Co., 1 Bann. & A., 521; Reed *v.* Cutter, 1 Story, 590; Sayles *v.* Hapgood, 3 Fish., 632; Pickering *v.* McCullough, 21 O. G. 73; Roemer *v.* Simon, 12 O. G. 796.

According to the Constitution, Congress has no power to grant a patent to anyone but an inventor, and to him only for his own invention, see Robinson on Patents, § 67. The term "original inventor" is sometimes used by the courts as synonymous with "first inventor," see Osborne *v.* Winkley, 2 Gallison 51; 1 Robb, 52; Thomas *v.* Weeks, 2 Paine, 92. In other cases the judges make a distinction between the "original" and "first" inventor, giving the former title to every true inventor, and the latter only to the foremost among true inventors, see Lowell *v.* Lewis, 1 Mason, 182; 1 Robb, 131; Bedford *v.* Hunt, 1 Mason, 302; 1 Robb, 148; Pennock *v.* Dialogue, 2 Peters, 1; Reed *v.* Cutter, 1 Story, 590; 2 Robb, 81; Roemer *v.* Simm, 5 O. G. 555. In Pennock *v.* Dialogue, 2 Peters 1, Story, J., says: "It gives the right to the first and true inventor, and to him only; if known or used before his supposed discovery, he is not the first, although he may be a true inventor." In Reed *v.* Cutter, 1 Story, 590, Story, J., says: "He is the first inventor in the sense of the Act, and entitled to a patent for his invention, who has first perfected and adapted the same to use; and until the invention is so perfected and adapted to use, it is not patentable."

Any person, except a slave, or a Patent Office employee, may become a patentee. An alien stands on the same footing with a citizen before the Patent Law, see Thomas *v.* Reese, 17 O. G. 195; *ex parte* Nagel, 17 O. G. 198; Lander *v.* Crowell, 16 O. G. 405; Shaw *v.* Cooper, 7 Peters, 292; 1 Robb, 643. A married woman may be the grantee of a patent, the rights of her husband in the patent being regulated by local law, see Fetter *v.* Newhall, 17 Fed. Rep. 841; 21 Blatch. 445; 25 O. G. 502. An infant or ward may also be the owner of a patent, see Fetter *v.* Newhall, 17 Fed. Rep. 841; 21 Blatch. 445; 25 O. G. 502. An invention by a slave can be patented neither by him nor his master, see Opinion Atty. Gen. 9, Op. At. Gen. 171, and an employee of the Patent Office may not obtain a patent during the term of his employment, see Rev. Stat. 1874, § 480; act of 1836, § 2; see also Opinion of Commissioner, 26 O. G. 637; Page *v.* Holmes Burglar Alarm Tel. Co., 17 Blatch. 484; 17 O. G. 737.

As to Joint Inventors.—A joint patent should always be issued for a joint invention, see Thomas *v.* Weeks, 2 Paine, 92; Barrett *v.* Hall, 1 Mason, 447; 1 Robb, 207. Neither one of two joint inventors can claim a patent to himself alone, see Runstatler *v.* Atkinson, 23 O. G. 940. A patent for a joint invention cannot issue to one of the inventors, though the other has assigned all interests to him, see Opinion Atty. Gen., 2 Op. At. Gen. 571. A joint patent for a sole invention is void, see Stewart *v.* Teak, 41 O. G. 1502; Royer *v.* Coupe, 29 Fed. Rep. 358; 39 O. G. 239; Ransom *v.* Mayor of New York, 1 Fisher, 252; and a sole patent for a joint invention is also void, see Carter *v.* Perry, 8 O. G. 518; Tennant's Case, Dav. P. C. 429; 1 Web, 125; 1 Abb. P. C. 115; Siemmer's Appeal, 58 Pa. St. 155.

As to Application by Executor or Administrator.—The right of an inventor to a patent vests in him at the moment he completes his invention. His right descends to his heirs, and a patent will issue to his personal representatives in trust for them, see Wilson *v.* Rousseau, 4 How, 646. If the inventor dies before applying for a patent, his executor or administrator should apply; and if he dies after application, the patent should issue to his executor or administrator, see Rice *v.* Burt, 16 O. G. 1050.

In case of a deceased foreign inventor, ancillary letters of administration must be taken out in the name of a resident of the United States, and the application be made by him.

As to Assignees.—The right of an inventor to obtain a patent is an inchoate right which may be assigned, see U. S. Stamping Co. *v.* Jewett, 7 Fed. Rep. 869; 18 O. G. 1529; Cammeyer *v.* Newton, 94 U. S. 225; 11 O. G. 287; Selden *v.* Stockwell Self-Lighting Gas Burner Co., 9 Fed. Rep., 390. The patent cannot issue to assignee unless the assignment contains a request to that effect, and is duly entered for record, see Wright *v.* Randell, 21 O. G. 493; 19 Blatch. 495. A patent may also issue to the assignee of an assignee, see Consolidated Electric Light Co. *v.* Edison Electric Light Co., 25 Fed. Rep. 719; 33 O. G. 1597. It should be observed, however, that the assignee cannot make an application for patent directly in his own name. In all cases, the application papers must be signed by the inventor, if he be alive; if he be dead, then by his executor or administrator, see Rev. Stat., secs. 4888 to 4892, *post*.

As to Importers.—In Livingston *v.* Van Ingen, 9 Johns, 507, Kent, C. J., said: "It seems to be admitted that Congress are authorized to grant patents only to the inventor of the useful art * * * There cannot, then, be any aid or encouragement, by means of an exclusive right under the law of the United States, to importers from abroad of any useful invention or improvement." So also in Pitts *v.* Hall, 2 Blatch. 229, Nelson, J., said: "A person, to be entitled to the character of an inventor, within the meaning of the Act of Congress, must himself have conceived the idea embraced in his improvement. It must be the product of his own mind and genius, and not of another's." See also Washburn *v.* Gould, 3 Story, 122; 2 Robb, 206; Sparkman *v.* Higgins, 1 Blatch., 205. A patentee must be an inventor, not an importer, see Thompson *v.* Haight, 1 U. S. L. T. 582.

As to Patentability.—An Invention Must Have Been Made.—The application must describe a complete, operative and actual invention. To be patentable, a thing must not only be new and useful, but must amount to an invention or discovery, see May *v.* County of Fond du Lac, 27 Fed. Rep. 691. In Rosenwasser *v.* Berry, 22 Fed. Rep. 841, Colt, J., said: "Not every improvement is invention; but to entitle a thing to protection it must be the product of some exercise of the inventive faculties, and it must involve something more than what is obvious to persons skilled in the art to which it relates." The exercise of inventive as distinguished from mechanical skill is essential to constitute an inventive act, see Leonard *v.* Lovell, 29 Fed. Rep. 310; Celluloid Mfg. Co. *v.* Comstock & Cheney Co., 27 Feb. Rep. 358; 36 O. G. 1356. In Earle *v.* Sawyer, 4 Mason, 1, Story, J., said: "The thing to be patented is not a mere elementary principle or intellectual discovery, but a principle put in practice and applied to some art, machine, manufacture, or composition of matter. It must be *new* and not *known* or *used* before the application; that is, the party must have found out, created, or constructed some art, machine, etc., * * * which had not been previously found out, created, or constructed by any other person. It is of no consequence whether the thing be simple or complicated; whether it be by accident, or by long, laborious thought, or by an instantaneous flash of the mind, that it is first done. The law looks to the fact and not to the process by which it is accomplished. It gives the first inventor or discoverer of the thing, the exclusive right, and asks nothing as to the mode or extent of the application of his genius to conceive or execute it." 1 Robb, 490. An invention is complete when the thought is embodied in some practical and operative form, see Sawyer *v.* Edison, 25 O. G. 597.

As to Patentability.—The Invention Must be Reduced to Practice.—That reduction to practice is essential to the completion of an invention, see Judson *v.* Bradford, 16 O. G. 171; Burke *v.* Partridge, 58 N. H. 349; Graham *v.* Gammon, 7 Bissell, 490; 3 Bann & A. 7; Smith *v.* Prior, 2 Sawyer, 461; Jones *v.* Sewall, 8 O. G. 630; Webb *v.* Quintard, 1 O. G. 525. In White *v.* Allen, 2 Clifford, 224, Clifford, J., said: "While the suggested improvements, however, rest merely in the mind of the originator of the idea, the invention is not completed within the meaning of the patent law, nor are crude and imperfect experiments sufficient to confer a right to a patent; but in order to constitute an invention, in the sense in which that word is employed in the Patent Act, the party alleged to have produced it, must have proceeded so far as to

have reduced his idea to practice, and embodied it in some distinct form." See also Gaylor *v.* Wilder, 10 How, 498; Parkhurst *v.* Kinsman, 1 Blatch. 494; Curtis on Patents, § 43. In 11 Am. Law Reg. N. S. 612, 665, an able writer, after discussing the cases on the subject, says: "Before an invention can be considered as having been so reduced to practice as to give its author, without further effort on his part, an irrefragable title to it, if duly asserted, it must have been embodied in a practical working machine, capable of being operated to perform its intended functions for business purposes. If not capable of such embodiment, it must have been brought to an equivalent state of perfection in some other way. Upon this point there is no conflict in our judicial tribunals."

As to Patentability.—Novelty.—The applicant for patent must be the original inventor, not only in relation to the United States, but to other parts of the world, see Dawson *v.* Follen, 2 Wash. 311, and this is so even although he had no knowledge of the previous use or previous description, see Whitney *v.* Emmett, Baldwin 303; 1 Robb. 567. Formerly the novelty required was absolute both as to time and place. The act of 1790 limited the privilege to inventions "not before known or used;" the act of 1800 expressly excluded every invention previously known and used in this or any foreign country. In the revision of the law and the reconstruction of the patent system in 1836, however, knowledge and use in a foreign country was excluded from among the causes which prevent or defeat a patent. The restriction as to time has been more widely modified. The act of 1793 substituted for the phrase "not before known and used" as it occurred in the act of 1790, the words "not known or used before the application," and in construing the law our courts soon held that "before the application" was to be regarded as synonymous with "before discovery by the patentee," thus recognizing no use or knowledge as anticipating the invention unless it had preceeded the inventive act. This construction was accepted by Congress, and was, in the act of 1836, duly formulated as one of the provisions of that statute. According to our present law, therefore, novelty exists unless the knowledge or use of the invention in this country preceded the conception of the invention by the patentee.

As to Patentability.—Utility.—The law requires that the invention must be new; it must also be useful. However new an invention may be, it cannot be legally patented unless it is also useful; and however useful it may be, it cannot be legally patented unless it is new. If it is either not new or not useful, the patent is void. Matthews *v.* Skates, 1 Fish., 603; Clark Patent Co. *v.* Copeland, 2 Fish, 221; Eddy *v.* Dennis, 95 U. S., 560; Jones *v.* McMurray, 13 O. G. 6; Barker *v.* Stowe, 14 O. G. 559; Snow *v.* Taylor, 14 O. G. 861; Singer R. C. Co. *v.* Tobey F. Co., 23 O. G. 93. The ground on which a patent may be claimed is that something new and useful has been invented—a thing which did not exist before, see Hotchkiss *v.* Greenwood, 4 McLean, 456. The law does not look to the degree of utility. It simply requires that the invention shall be capable of use, and that the use be such as sound morals and policy do not discountenance, see Dunbar *v.* Marden, 13 N. H., 311. The invention must be useful to an appreciable extent, although the measure of that usefulness is not material. Any degree of utility appreciable by a jury is sufficient, see Conover *v.* Roach, 4 Fish, 12.

As to Patentability.—Prior Knowledge or Use.—The prior knowledge or use, to defeat novelty, must be practical and complete; the identical invention must have been in use in this country, or it must have been patented or described in a printed publication at home or abroad before the other was invented. In Stitt *v.* Eastern R. R. Co., 22 Fed. Rep. 649, Colt, J., said: "The primary inquiry is one of identity between two things. If the identity is apparent on inspection, it is not necessary to prove actual use. If there is a reasonable doubt as to identity, want of novelty is not made out, see Walker on Pat., § 72. By the weight of authority and of reason, it would seem that if the prior invention is the same as that described in the patent; if it was complete and capable of producing the same result, and was known in this country, it is sufficient to sustain the defence of want of novelty."

As to Patentability.—Prior Patents.—A prior patent in order to defeat a subsequent application must be (Robinson on Patents § 331): (1) A public document; (2) accessible to the public; (3) issued for the same invention; (4) for the same operative means; and (5) sufficient to place the idea of the inventor fully in the possession of the public. A prior patent defeats a patent for an invention subsequently made, see Kelleher *v.* Darling, 14 O. G. 673; Muntz *v.* Foster, 2 Webb, 96. A prior patent and a prior publication stand on the same ground, see Webb *v.* Quintard, 1 O. G. 525. Description in a prior specification, the patent not having been issued, is no bar, see Graham *v.* McCormick, 21 O. G. 1533, and this is true though the prior specifications were filed by the same inventor, see Graham *v.* McCormick, 21 O. G. 1533.

The word "patented" in Sec. 4886 means "made known," and this is not true of a British patent until the completed specification is filed, see Rumpf *v.* Köhler, 23 O. G. 1831. It has also been held that a provisional specification in England is not a publication until published, and not then unless it completely describes the invention, see Coburn *v.* Schroeder, 22 O. G. 419; that a patent, though issued, is no bar while kept secret, see Schoerken *v.* Swift & Courtney & Beecher Mfg. Co., 19 O. G. 1493; that a foreign patent takes effect as such only from the period of its enrollment, see Willimantic Linen Co. *v.* Clark Thread Co., 4 Bann. & A., 133; that the date of the invention described in the prior patent is the date of the patent, see Rumpf *v.* Köhler, 23 O. G. 1831; *ex parte* Lanfrey, 20 O. G. 892; that unless the date of the reduction to practice of the later invention precedes the date of the publication of the alleged prior patent, such patent will be a bar, see Byerly *v.* Cleveland Linseed Oil Works, 31 Fed. Rep. 73; that a prior patent, issued by the United States, does not defeat a patent the application for which was filed before the filing of the application for such prior patent, see Allen *v.* City of New York, 17 O. G. 1281; that the prior patent must be for the same invention, see Cohn *v.* U. S. Corset Co., 6 O. G 259; that the prior patent must cover the whole of the invention, not merely a part of it, see Frearson *v.* Lee, L. R. 9 Ch. 48 (but see Florsheim *v.* Schilling, 35 O. G. 1435); that a prior patent for a device does not defeat a patent for a combination of which such device forms one element, see McMillan *v.* Rees, 17 O. G. 1222; that a patent suggesting a result is no bar to a patent for the means by which the result is produced, see Graham *v.* Gammon, 3 Bann. & A., 7; that a prior patent for one means of producing a result does not defeat a patent for a different means of producing the same result, see Hallett *v.* Hague, 2 Bann & A., 370; that the invention described in the patent must be complete and practical, see Downton *v.* Gaeger Milling Co., 17 O. G. 906; that the prior patent must contain a full and precise description of the entire invention, see Hammerschag *v.* Scamoni, 20 O. G. 1449; that if a prior foreign patent so far suggests the invention that any skilled workman could make it, the anticipation is established, see United States Bung Mfg. Co. *v.* Independent Bung & Bushing Co., 31 Fed. Rep. 76; and that a prior foreign patent to the same inventor is not a bar unless there has been two years' public use in this country, see Vogeley *v.* Noel, 18 Fed. Rep. 327.

As to Patentability.—Prior Publication.—In order that a prior publication may defeat a subsequent application it must be (see Robinson on Patents § 325): (1) A work of public character, intended for general use; (2) within reach of the public; (3) published before the date of the later invention; (4) a description of the same complete and operative art or instrument; and (5) so precise and particular that any person skilled in the art to which the invention belongs can construct and operate it without experiments and without further exercise of inventive skill. It has been held: that a written but unprinted description is not a publication, see Northwestern Fire Extinguisher Co. *v.* Philadelphia Fire Extinguisher Co., 6 O. G. 34; that a picture or drawing without printed text is not a publication, see New Process Ferm. Co. *v.* Koch, 29 O. G. 535; that business circulars which are sent only to persons engaged or supposed to be engaged in the trade, are not such publications as contemplated by Sec. 4886, see Pierson *v.* Colgate, 24 O. G. 203; *in re* Atterbury, 2 O. G. 640; that a catalogue showing features of the invention is not a publication, see Forschner *v.* Baumgarten, 35 O. G. 137; that a journal devoted to a special science, printed in German, and deposited in the library of the Patent Office, and in the library of the Institute of Civil Engineers—a society of 3,000 members—and there accessible to them, and catalogued under the head of "Journals" only, though proved to have been read by but one person, is a sufficient publication, see United Telephone Co. *v* Harrison, Cox-Walker & Co., L. R. 21 Ch. 720. That a description in an application for a patent, filed in the Patent Office, is not a publication, Northwestern Fire Ex. Co. *v.* Philadelphia Fire Ex. Co., 6 O. G. 34; that a printed English provisional specification is a publication when once published, see Cohn *v.* U. S. Corset Co., 6 O. G. 259; but not unless full and specific, see Goff *v.* Stafford, 14 O. G. 748; that an English specification is not a publication till completed and published, see Coburn *v.* Schroeder, 22 O. G. 419. Something beside printing is required. Publication means put into general circulation or on sale where the work is accessible to the public, see Cottier *v.* Stinson, 10 Sawyer 212, 20 Fed. Rep. 906.

As to Patentability.—Public Use or Sale.—The act permits public use and sale of the invention for two years before the application. Abandonment is conclusively presumed against the inventor from the public use or sale of the invention with his consent for more than two years before his application for a patent, see Andrews *v.* Hovey, 41 O. G. 1162; Adams & Westlake Mfg. Co. *v.* Rathbone, 26 Fed. Rep. 262; Manning *v.* Cape Ann Isinglass & Glue Co., 4 Bann & A., 612. Public use or sale of the invention in a foreign country is no bar to a patent. It is not necessary that the use

should have been a continuous use, extending over more than two years prior to the application, to render a patent void; it is sufficient if it be a public use or sale, see Young *v.* Hoard, 2 Com. Dec. 59; *ex parte* Jenkins, 4 O. G. 351. If the inventor held the article for sale more than two years before the application, he is not entitled to a patent, although he did not make a shipment until after that time, Hubbard *v.* Myers, 16 O. G. 1051.

As to Patentability.—Abandonment.—An invention once abandoned to the public can never be recalled by the inventor, see Consolidated Fruit Jar Co. *v.* Bellaire Stamping Co., 35 O. G. 627; American Hide and Leather Splitting & Dressing Mach. Co. *v.* Am. Tool & Mach. Co., 4 Fisher, 284. The intention to abandon need not be expressed in words, see Planing Machine Co. *v.* Keith, 17 O. G. 1031. Abandonment is a question of fact, not of law, see Sprague *v.* Adriance, 14 O. G. 308; and of intention, see Johnson *v.* Fassman, 2 O. G. 941. A jury has a right to infer an abandonment from the inventor's acquiescence in the use of the invention by others, his neglect to assert his claims by suit or otherwise, his neglect to make efforts to realize any personal advantage, and similar circumstances.

As to Patentability.—Suggestion.—Although the ideas of the invention and hints concerning it came to the inventor from others, still, if the suggestions simply aided him, and he was the first who gave that idea a useful and practical form, his rights are not to be defeated, see Teese *v.* Phelps, 1 McAl., 48; Matthews *v.* Skates, 1 Fish. 602; Roberts *v.* Dickey, 1 O. G. 4. If, however, the whole or any of the essential parts and principles of the machine are invented by another and introduced into the machine upon his suggestion, the whole patent is void, see Watson *v.* Bladen, 4 Wash., C. C. 580; Agawam Co. *v.* Jordan, 7 Wall, 583. Where, however, an employer has conceived the plan of an invention, and is engaged in experiments to perfect it, no suggestions from an employee, not amounting to a new method or arrangement, which is in itself a complete invention, is sufficient to deprive the employer of the exclusive property in the perfected improvement, see Agawam Co. *v.* Jordan, 7 Wall, 583, 9 O. G. 1011.

Patents for Inventions Previously Patented Abroad.

Sec. 4887.—No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented in a foreign country, unless the same has been introduced into public use in the United States for more than two years prior to the application. But every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years.

Rules of Practice, 1892.—29, 46.

The provisions of this section relate to patents which are applied for here after the issue of a foreign patent or patents upon the same invention, see French *v.* Rogers, 1 Fish, 133. An applicant in possession of an invention that is otherwise patentable, who has already patented in a foreign country, may still obtain a perfectly valid patent in the United States, and at any time after the issue of his prior foreign patent or patents, provided: first, that the invention at the date upon which he files his application in this country has not been in public use or on sale in the United States for more than two years; and, second, that no prior foreign patent for the same invention has expired or become forfeited.

Although the application was filed (in the United States) before the filing of the application for the foreign patent, yet if the foreign patent is granted first, the United States patent must be limited so as to expire with the foreign patent, see Bate Refrig. Co. *v.* Gillett, 22 O. G. 1205, and this is so even if the patent is not so limited on its face, for the statute, not the language of the patent, limits its term, see De Florez *v.* Reynolds, 17 O. G. 503.

An American patent must be limited so as to expire at the same time as a prior foreign patent, whether the foreign patent is a secret or a public patent, see Gramme

Elect. Co. *v.* Arnoux & H. Elect. Co., 25 O. G. 193. In no case, however, can the American patent exceed the term of seventeen years, see Weston *v.* White, 13 Blatch. 304; Siemens *v.* Sellers, 23 O. G. 2234.

If a person surreptitiously, without the knowledge or authority of the inventor, takes out letters patent in a foreign country, he cannot thereby deprive the inventor of any of his rights, see Kendrick *v.* Emmon, 9 O. G. 201.

Sec. 4887 does not require that the term of a patent shall be correctly stated in the patent itself, but only limits the term, and the grant of a patent for seventeen years, therefore, does not prevent it from expiring with a prior foreign patent, see Cahan *v.* Pound Mfg. Co., 31 O. G. 119. A domestic patent is valid, though its term is not expressly limited to that of a foreign patent, see American Paper Barrel Co. *v.* Laraway, 37 O. G. 674.

An American patent expires at the same date with the shortest foreign patent that was granted before the grant of the American patent, see Gramme Elect. Co. *v.* Arnoux & H. Elect. Co., 25 O. G. 193; Koechlin *v.* Marble, 22 O. G. 1365; Henry *v.* Providence Tool Co., 14 O. G. 855. The same rule applies when a single American patent covers several inventions separately patented abroad, see *ex parte* Unsworth, 15 O. G. 882; but an American patent is not limited by the term of a foreign patent unless the inventions are identical, see Siemens *v.* Sellers, 23 O. G. 2234; nor unless the foreign patent claims as well as describes the same invention, see Holmes Elect. Protective Co. *v.* Metropolitan Burglar Alarm Co., 32 O. G. 384. The invention covered by a domestic patent will be the same as that covered by a foreign patent when the principle is the same, though it may be improved, and in this case the term of the whole patent is that of the foreign patent, see Guarantee Insurance Trust & Safe Deposit Co. *v.* Sellers, 41 O. G. 1165. It has also been held that a patent that is a mere adaptation of a foreign patent expires at the same time though some improvement be embraced in it, see Clark *v.* Wilson, 36 O. G. 456; and in Commercial Mfg. Co. *v.* Fairbank Canning Co., 36 O. G. 1473, that if the foreign invention would be enjoined as an infringement of the domestic patent it is the same.

The date of a foreign patent when controlling the term of an American patent, is the date of its issue or publication as a patent, see De Florez *v.* Reynolds, 17 O. G. 503; and in this connection it has been held: that an English provisional specification is not a patent, see Emerson *v.* Lippert, 42 O. G. 964; that no English patent is complete until the final specification is enrolled, see Coburn *v.* Schroeder, 22 O. G. 419; that a domestic patent is not limited by an English patent unless the latter is sealed before the former is issued, whatever date the latter may bear, or unless a complete specification having the effect of a patent is filed, see Emerson *v.* Lippert, 42 O. G. 964; and that a Canadian patent takes effect when signed, sealed and registered, and from its date, not its delivery, see Bate Refrig. Co. *v.* Gillett, 22 O. G. 1205, and 40 O. G. 1029. It should be noted that these decisions relative to English patents were as to patents sealed under the 1852 act.

In case of a prior foreign patent granted for a short term but extended by one or more prolongations to its maximum term, if the term of the foreign patent is continuous and uninterrupted, the American patent will continue in force so long as the foreign patent continues to exist, not however to exceed seventeen years, see Bate Refrig. Co. *v.* Hammond, *et al.*, 46 O. G. 689.

Under the French law each patent of addition stands by itself like a new patent, and by its own date fixes the term of an American patent, see De Florez *v.* Reynolds, 17 O. G. 503. The forfeiture of the foreign patent by the non-fulfillment of conditions, such as the payment of annual taxes or the working of the invention, does not affect the duration of the American patent, see Paillard *v.* Bruno, 38 O. G. 900. Under Sec. 4887 the term of a domestic patent is to be equal to the remainder of the term for which the foreign patent was granted, although the latter may be forfeited by failure to pay a tax, or by other subsequent events, see Holmes Electric Protective Co. *v.* Metropolitan Burglar Alarm Co., 21 Fed. Rep. 458; 28 O. G. 1189.

Requisites of Application, Description, Specification and Claim.

Sec. 4888.—Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear,

concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor and attested by two witnesses.

Rules of Practice, 1892.—30 to 49.

As to the Application.—The requirements of this section are prerequisites to the granting of a patent, and unless the prerequisites are complied with, a party sued for the infringement of a patent may show that they have not been complied with, and in that way defeat the patent. They are conditions precedent to the right of the Commissioner to grant a patent, see New York *v.* Ransom, 23 How. 487; Seymour *v.* Osborne, 3 Fish, 555.

As to the Specification.—The specification has two objects: one is to make known the manner of constructing the machine, if the invention is of a machine, so as to enable artisans to make and use it, and thus to give the public the full benefit of the invention after the expiration of the patent; the other is to put the public in possession of what the party claims as his own invention, so as to ascertain if he claims anything that is in common use, or is already known, and to guard against prejudice or injury from the use of an invention which the public may otherwise innocently suppose not to be patented, see Evans *v.* Eaton, 7 Wheat, 356. The specification must be perfect of itself, an imperfect description makes a patent void, see Wayne *v.* Holmes, 1 Bond, 27; it must explain the principle of the invention and state the best known mode of constructing and operating it, see Grier *v.* Castle, 17 Fed. Rep. 523; 24 O. G. 1176; it must distinguish the new from the old, see Sawyer *v.* Miller, 12 Fed. Rep. 725; and describe some practicable method of carrying the invention into effect, see *ex parte* Schoonmaker 13 O. G. 595; it is sufficient if, from it alone, a competent mechanic can construct the invention, see Wayne *v.* Holmes, 1 Bond, 27. If the description is sufficient to enable those skilled in the art to which it pertains, to make and use the invention the requirement of the law is satisfied, see Loom Co. *v.* Higgins, 21 O. G. 2031; Roberts *v.* Schreiber, 18 O. G. 125. "Persons skilled in the art" are those of ordinary and fair information, not of special excellence, see *ex parte* Kerr, 28 O. G. 95. If, on the assumption that certain matters are known to those skilled in the art, the specification is intelligible, it is sufficient, see Hancock Inspirator Co. *v.* Lally, 35 O. G. 1001; and if a description is sufficient at the date of the patent subsequent discoveries cannot make it less so, see Celluloid Mfg. Co. *v.* Am. Zylonite Co., 40 O. G. 1453.

A failure to describe an essential element avoids the patent, see Schneider *v.* Hill, 5 Bann & A., 565. Absolute precision is not required, see Dorsey Har. Rake Co. *v.* Marsh, 6 Fisher, 387; but nothing can be patented unless it can be described, and a patentee cannot have invented what he cannot describe, see Smith *v.* Downing, 1 Fish, 64. Mistakes in naming the invention, or in assigning the invention to its proper class, as by calling it a product when it is a process, do not render the description insufficient, see Foye *v.* Nichols, 22 O. G. 2243.

Modifications and appliances which would suggest themselves to ordinary mechanics need not be mentioned, see Union Paper Bag Co. *v.* Nixon, 4 O. G. 31; nor is it necessary to describe all the uses of the invention, see Pike *v.* Potter, 3 Fisher, 55. Ambiguity in the description is fatal, irrespective of the intent of the inventor, see Blake *v.* Stafford, 3 Fisher, 294; but not unless the description is rendered unintelligible, see Swift *v.* Whisen, 2 Bond, 115.

False suggestion in a material part of the specification avoids the patent, see Delano *v.* Scott, 1 Robb, 700; and concealment by which the patentee obtains an advantage over the public, if wilful, avoids the patent, see Heath *v.* Unwin, 2 Webb, 236. If the invention relates to a machine the specification must clearly describe the exact construction and operation of every part thereof, and of the machine as a whole; if it relates to a process, it should describe the process step by step, as well as the operation as a whole; if it relates to a composition of matter, it must enumerate all the different materials entering into such composition, the proportions of each, the manner of combining them, and the essential qualities of the resulting composition.

As to the Claim.—Its Scope.—The office of the claim is to define the exact limits of the invention; the scope of the patent is governed by the claim, see Yale Lock Co. *v.* Greenleaf, 35 O. G. 386, and the invention patented is the invention set forth in the claim, and that only, see Toohey *v.* Harding, 1 Fed. Rep., 174; McMillin *v.* Rees, 17 O. G. 1222. If the claim does not define the invention the courts can give no relief, see Del. Coal & Ice Co. *v.* Packer, 24 O. G. 1273. A patent must stand or fall by its claims, see Meissner *v.* Devoe Mfg. Co., 2 O. G. 545; and this is so even if the claimed invention be less than the real invention, see Brass Co. *v.* Miller, 5 Fisher, 48. When the terms of a claim in a patent are clear and distinct (as they always should be), the patentee, in a suit brought upon the patent, is bound by it, and cannot show that the invention is broader than the terms of the claim, see Merrill *v.* Yeamans, 12. O. G. 980. The court will not go into the history of the art, see James *v.* Campbell, 21 O. G. 337; nor enlarge the claim by the description, see Yale Lock Co. *v.* Greenleaf, 35 O. G. 386. Failure to claim described matter dedicates it to the public, see Swift *v.* Jenks, 27 O. G. 621.

As to the Claim.—Its Form.—A claim must be for an operative means, see *ex parte* Cornelly, 1 O. G. 573; and be for matter so described that anyone skilled in the art can use it, see Vogler *v.* Semple, 11 O. G 923. It must state a concrete invention, not an abstraction, see *ex parte* Designolle, 13 O. G. 227; it must not cover a principle, see *ex parte* Fairbanks, 3 O. G. 65. General truths and forces belong to all men, and cannot be claimed, see opinion Atty. Gen., 8 Op., Att. Gen., 269.

But one invention can be embraced in a single claim, see *ex parte* Bland, 15 O. G. 775. A process and its product cannot be embraced in a single claim, unless the one is absolutely dependent and inseparable from the other; nor can a machine and its product, an art and its apparatus, be covered by one claim if they are capable of use separately, see *ex parte* Bates, 16 O. G. 266.

The claim must precisely define the thing invented, see *ex parte* Mayall, 4 O. G. 210; and distinguish the invention claimed from all known inventions, see *ex parte* Funck, 14 O. G. 158: Terry Clock Co. *v.* New Haven Clock Co., 17 O. G. 908; and must correspond with the specification, see Knox *v.* Quicksilver M. Co., 4 Fed. Rep. 809. Every element claimed must be clearly stated, not merely inferred, see *ex parte* Holt, 29 O. G. 171; and such indefinite expressions as "means," "mechanism," etc., should not be used except to denote appliances that are not essential parts of the invention, see *ex parte* Stoughton, 43 O. G. 1345.

A claim covers all equivalents, see Burdon *v.* Corning, 2 Fisher, 477; even though the inventor never thought of them, see McNamara *v.* Hulse, 2 Web, 128; and equivalents should not be expressly claimed, see *ex parte* Reid, 15 O. G. 882.

A claim for a function is void, see Matthews *v.* Schoneberger, 18 O. G. 1464; and participial claims are improper, see *ex parte* Cox, 3 O. G. 2; nor can the claim be for a mere result or effect. A claim for the "mode of operation" is void, see Hatch *v.* Moffatt, 15 Fed. Rep. 252. The claim should be drawn to cover the construction of a machine or apparatus, not its mode of operation, or the result produced.

Alternative claims are not allowable, see *ex parte* Holt, 29 O. G. 171.

While claims for the same thing may be repeated in different language in order to prevent misunderstanding, see *ex parte* Hahn, 8 O. G. 597, the claims should not be unnecessarily multiplied.

Claims for separate but dependent inventions may be joined in a single application, see *ex parte* Smith, 2 O. G. 117; but separate and distinct inventions, capable of separate use cannot be so claimed. Their design and operation being independent of each other there is no point of view from which they can be considered as one invention; and patents embracing two or more such inventions will not be sustained. The general rule is that every art or instrument complete in itself, and capable of separate use, constitutes a distinct invention, and should form the subject matter of a separate application for patent.

The claim for a combination of elements must embrace specifically all of the essential elements necessary to produce a distinct and operative combination, see *ex parte* Rhentan, 5 O. G. 521; it should not include non-essential elements, see Rapid Service Store R. R. Co. *v.* Taylor, 42 O. G. 721; nor the connecting mechanism unless it is an element in the combination or is essential to the comprehension of what is claimed, see *ex parte* Skinner, 19 O. G. 662 A claim for an inoperative combination is void, see Torrant *v.* Duluth Lumber Co., 39 O. G. 1425. Each of the elements and sub-combinations, if new and patentable, may be separately claimed, as well as the combination as a whole, see Stevens *v.* Pritchard, 10 O. G. 505; Bank *v.* Snediker, 17 O. G. 508.

The claim for an art or process should enumerate each of the acts or steps of the process in the order in which they are employed, and in such manner as to identify them with the acts or steps set forth in the specification (see Robinson on Pats., § 529), and

each step of a process, if a true sub-process may also be separately claimed, see *ex parte* Wilson, 16 O. G. 95. A general claim for a process covers all ways of performing it, see Tilghman *v.* Procter, 19 O. G. 859. It does not, however, necessarily cover the product, see Goodyear *v.* Wait, 5 Blatch., 468; and does not protect the product if the product can be made in any other way, see Goodyear *v.* Railroad, 1 Fisher, 626. Mere mechanical processes are not patentable, see Medart *v.* Risdon Iron Works, 71 O. G. 751.

The claim for a machine must be drawn to cover a specific piece of mechanism or apparatus; it must not be drawn so as to claim a mode of operation, a principle, an idea, a means of producing an effect or an effect produced, see Burr *v.* Duryea, 1 Wall, 531. If the invention does not embrace an entire machine, the parts invented must be distinctly claimed, see Seymour *v.* Osborne, 11 Wall, 516. Each subordinate mechanism may be separately claimed, even though not useful by itself, see Wells *v.* Jacques, 5 O. G. 864. The claim for a composition of matter should set forth its elements, the mode of combination, and the essential qualities of the resulting compound, see *ex parte* Williams, 10 O. G. 748. A composition of matter requires but a single claim, see *ex parte* Wheat, 16 O. G. 360

The claim for a manufacture should set forth the essential qualities and the mode of making it, see U. S. Nickel Co. *v.* Pendleton, 24 O. G. 704. A manufacture must be claimed as a new product and independently of the process of making it, see *ex parte* Mayall, 4 O. G. 210.

The claim for an improvement upon a known art or machine must clearly state the exact improvement made, see *ex parte* McMurray, 8 O. G. 943; and must distinguish the new from the old, see Brown *v.* Selby, 2 Bissell, 457. It is not sufficient that persons skilled in the art can distinguish the improvement from the original invention, the claim itself must show it, see Foxwell *v.* Bostock, 10 L. T. Rep. N. S., 144.

Claims may be either generic or specific. A patent claiming the genus dominates all subsequent patents claiming only the species, see *ex parte* Ewart, 17 O. G. 448. Generic claims do not cover functions, results or effects, see *ex parte* Beairs, 16 O. G. 1233. An inventor of a species before anyone else invents the genus, or any other species, may claim the genus, see *ex parte* Gardner, 17 O. G. 626; but no patent with generic claims can be granted after one with a species, see *ex parte* Upton, 27 O. G. 99.

As to the Claim.—Its Interpretation.—Patents for inventions are treated as a just reward to ingenious men, and as highly beneficial to the public. Specifications are, therefore, clearly entitled to a liberal construction, since they are granted, not as restrictions upon the rights of the community, but "to promote science and useful arts," Blanchard *v.* Sprague, 2 Story, 164. Under the fair application of the rule *ut res magis valeat quam pereat*, patents are, if practicable, to be interpreted so as to uphold and not destroy the right of the inventor, see Turrill *v.* Railroad Company, 1 Wall, 491.

A claim cannot be dissected and accepted or rejected piecemeal, but must stand or fall together, see *ex parte* Smith, 1 O. G. 403. A claim may be valid for what it claims, though it does not claim the full invention, see Wilson *v.* Coon, 19 O. G. 482; but a claim exceeding the limits of the actual invention is void, see Milligan *v.* Lalance & Grosjean Mfg. Co., 20 O. G. 367.

When several claims are present in the specification, the presence of a void claim does not affect those which are good, unless there is an evident intention to mislead the public, or an unreasonable delay in filing a disclaimer, see Tyler *v.* Galloway, 22 O. G. 2072; Christman *v.* Rumsey, 17 O. G. 903; Burdett *v.* Estey, 15 O. G. 877.

As to Execution.—All the documents in connection with an application for patent; the petition, power of attorney (if any), specification, and oath, must be signed by the inventor, if he be alive, or by his executor or administrator, if he be dead. The signature of the inventor to the specification must be attested by two witnesses. All names should be legibly written in full.

The applicant must sign his full name in full. See *ex parte* Gentry, 44 O. G. 822.

In case of a deceased foreign inventor, it is necessary to apply for and take out ancillary letters of administration, appointing a resident of the United States, who must make the application, signing all the documents.

Drawings, when Required.

Sec. 4889. When the nature of the case admits of drawings, the applicant shall furnish one copy signed by the inventor or his attorney

in fact, and attested by two witnesses, which shall be filed in the Patent Office; and a copy of the drawing, to be furnished by the Patent Office, shall be attached to the patent as a part of the specification.

Rules of Practice, 1892.—49 to 56.

A drawing must be furnished, when the case admits, whether it is useful or necessary or not, see *ex parte* Chase, 15 O. G. 809; it must show every feature claimed, see *ex parte* Crandall, 35 O. G. 625; and correspond in all essential particulars with the specifications, see *ex parte*, Witty, 29 O. G. 862. In case of simple inventions the drawings must be sufficient to supply the place of a model, see *ex parte*, Jovè, 17 O. G. 801.

RULES.—The following rules are rigidly enforced, and any departure from them will be certain to cause the rejection of the drawings.

PAPER AND SIZE.—All drawings must be made upon pure white paper of a thickness corresponding to three-sheet Bristol board. The surface of the paper must be calendered and smooth.

The size of the sheets must be exactly 10 inches (25.4 cm.) wide, by 15 inches (38.1 cm.) long (high). As many sheets may be used as may be necessary to show the invention fully, but the number of sheets must never be more than is absolutely necessary. Under the present practice, no drawing will be admitted, even for the purpose of examination, unless the sheet is of the correct size.

MARGINAL LINES AND SPACE FOR HEADING.—A single marginal line must be drawn, all around, exactly one inch (2.55 cm.) from the edge of the sheet. One of the shorter sides of the sheet is regarded as its top, and measuring downwardly from the marginal line, a clear space of not less than 1¼ inches (3.2 cm.) must be left blank for the heading, which is inserted by the Patent Office. Care must be taken that no portion of the drawing trespass within this space. Space for the signatures should be reserved at the bottom of the sheet above the marginal line.

LARGE VIEWS.—When views are larger (broader) than the width of the sheet, the sheet should be turned on its side. In this case space for the heading will be reserved at the right, and for the signatures at the left of the sheet, occupying the same position as in the upright views, and being horizontal when the sheet is held in an upright position, that is to say, these spaces for heading and signature always occupy the same positions on the sheet, whichever way the drawing itself may be placed.

POSITION OF VIEWS.—All views (and reference letters) on the same sheet must stand in the same direction.

INK, CHARACTER AND COLOR OF LINES.—All drawings must be made with the pen only. Every line and letter must be absolutely black. India ink alone must be used, to secure perfectly black and solid lines. All lines must be clean, sharp and solid, and they must not be too fine or crowded. This rule applies to all lines, however fine, to shading, and to lines representing cut surfaces in sectional views.

Drawings should be made with the fewest lines possible consistent with clearness. Surface shading when used, should be open. Sectional shading should be made by oblique parallel lines, which may be about one-twentieth of an inch apart. Shading (except upon sectional views) should be used only on convex and concave surfaces, where it should be used sparingly, and even there may be dispensed with if the drawing is otherwise well executed. Imitations of wood or surface graining should not be attempted.

The light is always supposed to come from the upper left hand corner at an angle of forty-five degrees. Heavy lines on the shade sides of objects should be used, except where they tend to thicken the work and obscure the letters of reference.

The plane upon which a sectional view is taken should be indicated upon the general view by a broken or dotted line.

SCALE OF DRAWING.—The scale upon which the drawing is made need not be indicated upon the drawing. It should be large enough, in all cases, to show the mechanism without crowding.

LETTERS AND FIGURES OF REFERENCE.—The different views should be consecutively numbered. If the same parts of an invention appear in more than one view it must always be represented by the same reference character. The same reference character should never be used to designate different parts, even in different views. Either letters or numerals may be used as reference characters. All letters and figures of reference must be carefully formed. They should measure at least one-eighth of an inch in height, and may be much larger when there is sufficient room. They must be so placed as to clearly indicate to what parts they refer, and at the same time so as never to

interfere with the thorough comprehension of the parts themselves. When necessarily grouped around a certain part, they should be placed at a little distance therefrom, where there is available space, and be connected by short broken lines with the parts to which they refer. They must never appear upon shaded surfaces, and when it is difficult to avoid this. a blank space must be left in the shading where the letter occurs, so that it shall appear perfectly distinct and separate from the work.

LITHOGRAPHS.—Lithographs will never be accepted under any circumstances, and it is useless to send them.

SIGNATURES.—The inventor need not, and preferably should not, sign the drawing, as this can be signed by the attorney under power, but if signed by the inventor, his signature should be placed at the lower right-hand corner of the sheet, and the signatures of two witnesses at the lower left-hand corner, all above and within the marginal line, but in no case should they trespass upon the drawings.

ADVERTISEMENTS NOT PERMITTED.—No advertisement of any nature, or agent's or attorney's stamp, or written address, will be permitted upon the face of the drawing, either within or without the marginal line.

DRAWINGS FOR RE-ISSUE APPLICATIONS.—Drawings for re-issue applications must be made upon the same scale as the original drawings, or upon a larger scale, unless a reduction of scale shall be authorized by the Commissioner.

BLUE PRINTS OR PHOTOGRAPHS.—Applicants are requested in Order No. 986 of the Patent Office, to furnish, with their originals, a blue print or other photographic copy of their drawings. Where this is done, Attorneys may have the originals taken to the Attorney's room for examination, etc.

The office will, upon request, furnish blue prints at a charge of five cents per sheet.

SPECIMENS OF INGREDIENTS, ETC.

SEC. 4890.—When the invention or discovery is of a composition of matter, the applicant, if required by the Commissioner, shall furnish specimens of ingredients and of the composition, sufficient in quantity for the purpose of experiment.

Rules of Practice, 1892.—62. (See also 56, 60 and 61.)

Specimens are seldom required. In cases where the article is not perishable, a specimen of the composition (if so required by the Commissioner) must be furnished, put up in proper form to be preserved by the office.

MODEL, WHEN REQUISITE.

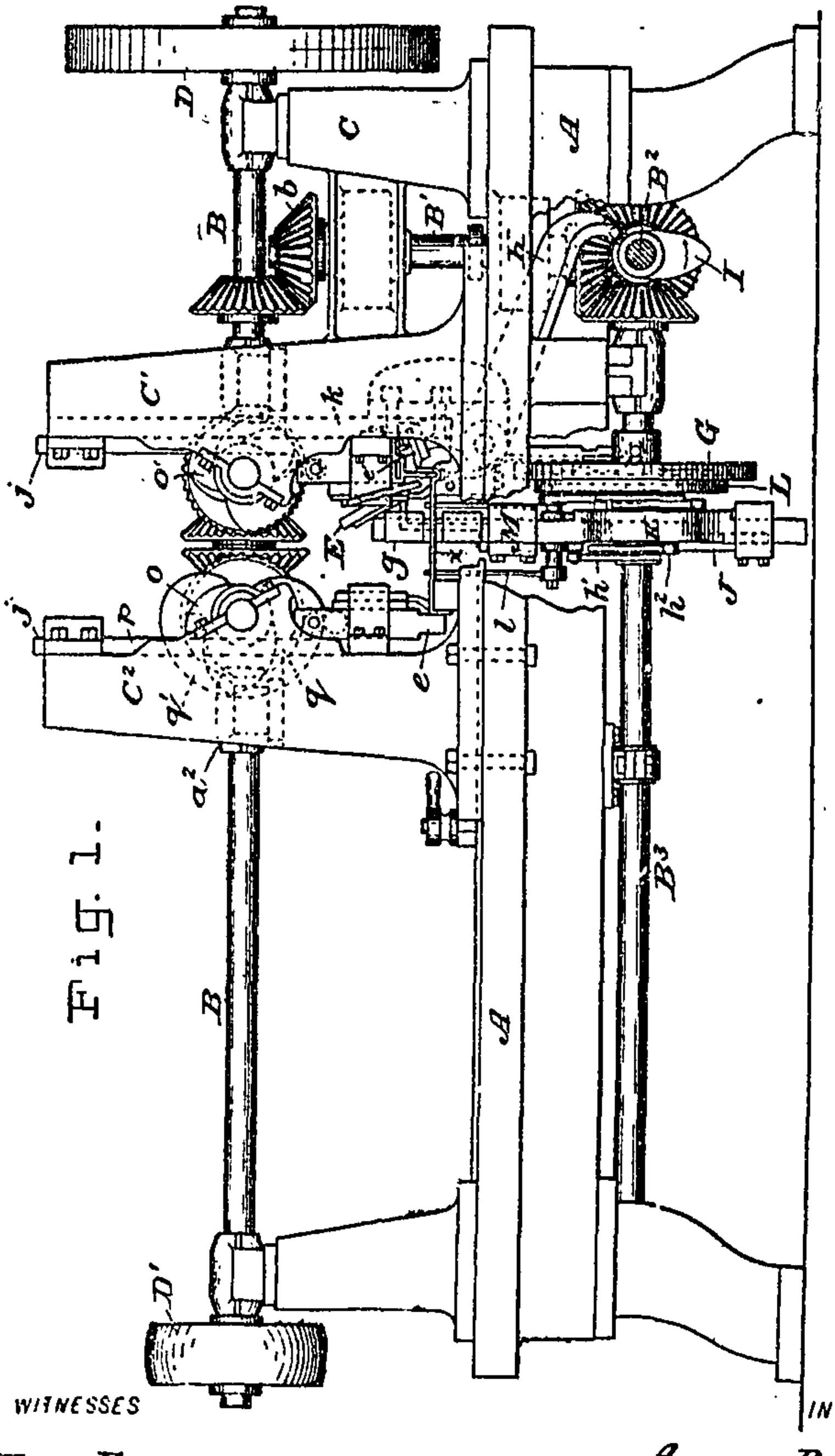
SEC. 4891.—In all cases which admit of representation by model, the applicant, if required by the Commissioner, shall furnish a model of convenient size to exhibit advantageously the several parts of his invention or discovery.

Rules of Practice, 1892.—56 to 62.

A model will not be required unless it is useful as an aid in examining into the state of the art or in the construction of the specification and drawing, see *ex parte* Jovè, 17 O. G. 801. It is usual for the office to require a model whenever the application refers to a device for producing perpetual motion, and when the invention is believed to be inoperative.

Models, when furnished, should be neatly and substantially made of durable material, metal being preferable, but when the material forms an essential feature of the invention it should be constructed of that material. It should clearly show every feature of the invention. It must be not more than 12 inches long, wide or high, except in cases in which the Commissioner shall admit working models of complicated machines of larger dimensions. If made of wood, it must be painted or varnished. Glue must not be used; the parts must be so constructed as to resist the action of heat and moisture. When practicable it should bear the inventor's name, the serial number, and the filing date of the application.

(A clear space of 1¼ inches must be left here for the heading and title that is inserted by the Patent Office.)



NOTE.—The above illustrates a drawing made in accordance with the rules, where the figure, on account of its size, is placed lengthwise of the sheet. It will be observed that all requirements as to size of sheet, margin, space for heading, and space for signatures, are the same as for other drawings, and that the spaces are to be left at the same relative positions upon the sheet.

See note at the bottom of the preceding page.

(A clear space of 1¼ inches must be left here for the heading and title that is inserted by the Patent Office.)

Fig. 2.

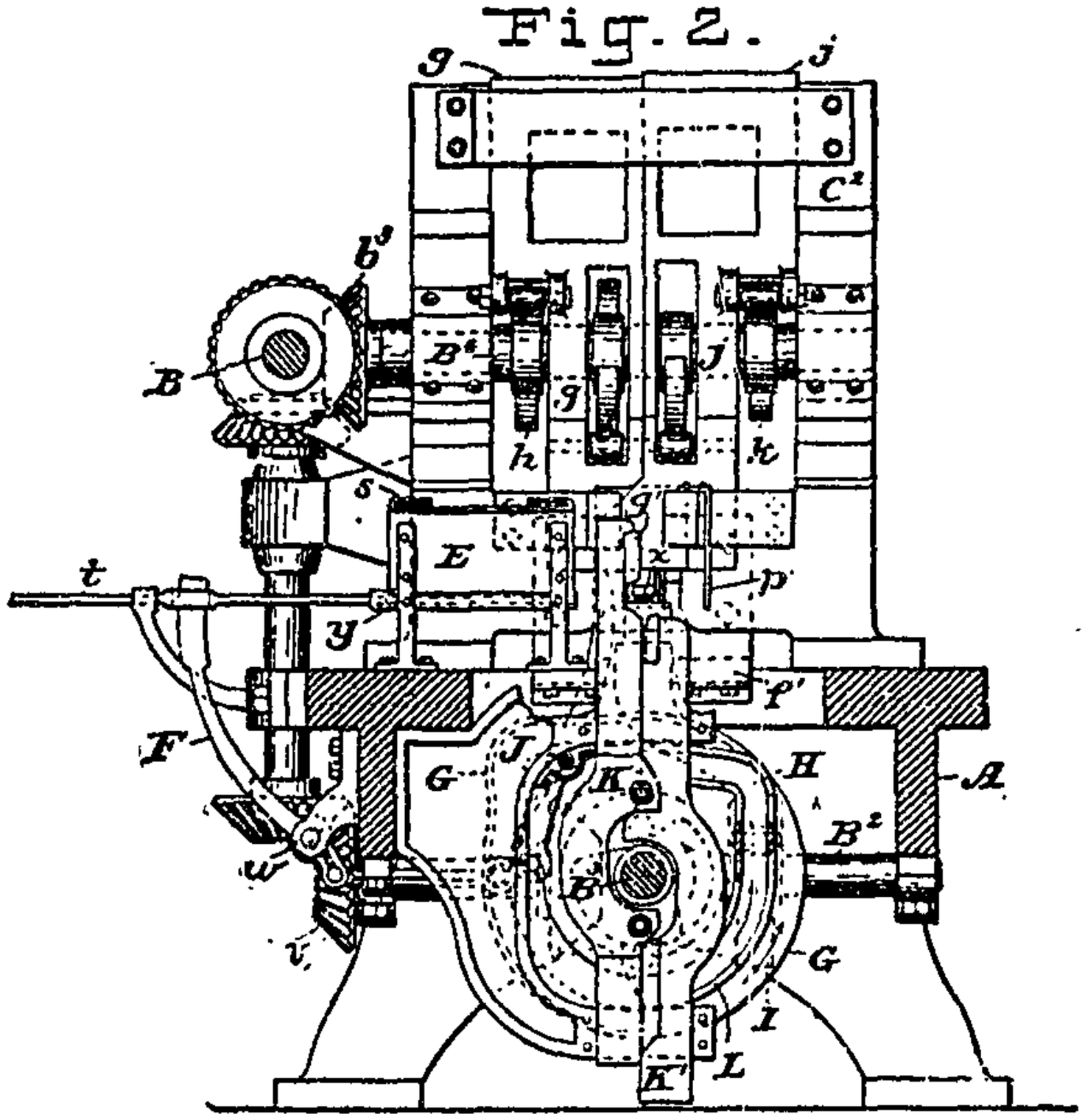


Fig. 3.

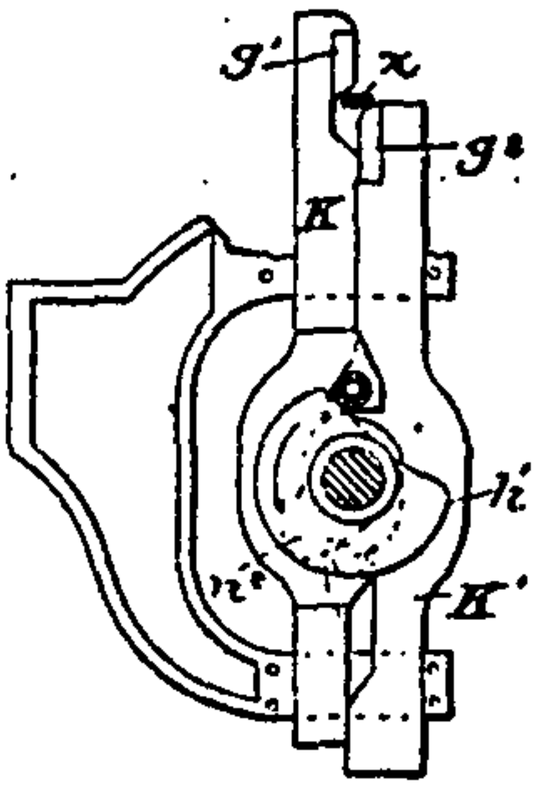


Fig. 4.

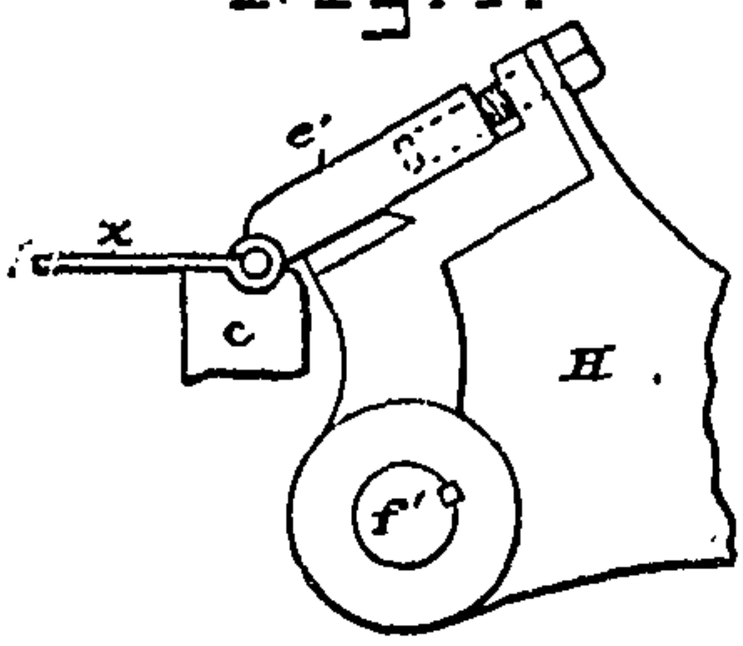
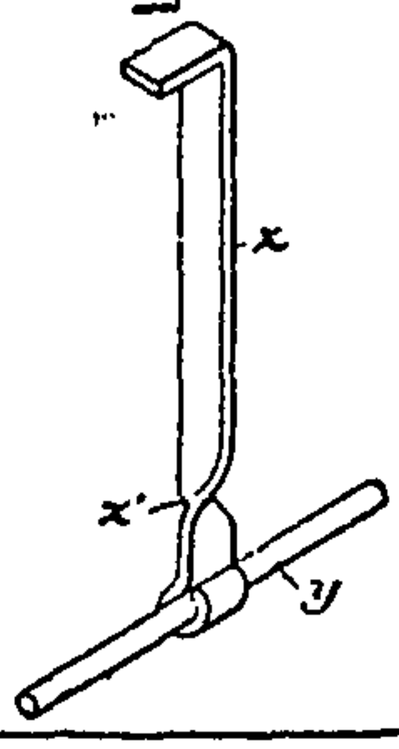


Fig. 5.



WITNESSES

E F.

G H.

INVENTOR

A. B.

BY

C. D.

ATTORNEYS

NOTE.—The above illustrates a drawing made in accordance with the rules. It shows, upon a scale about *one-half* that of the actual drawing, the relative proportions of the sheet, the margin, the blank space required to be left at the top of the sheet below the margin line, the spaces to be left for the signatures, etc.

The Patent Office will no longer knowingly accept informal drawings or lithographs, even for the purpose of examination. All drawings must be hand made, with india ink, upon white, smooth surfaced drawing board equal in thickness to three-sheet bristol board. The sheets must measure exactly ten inches wide by fifteen inches high. The margin line must be drawn exactly one inch from the edge of the sheet.

Oath Required from Applicant.

Sec. 4892.—The applicant shall make oath that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement for which he solicits a patent; that he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or when the applicant resides in a foreign country, before any minister, chargé d'affaires, consul, or commercial agent, holding commission under the Government of the United States, or before any notary public of the foreign country in which the applicant may be.

Rules of Practice, 1892.—46 to 49.

In all applications for letters patent filed subsequent to October 24, 1882, the signature of the applicant is required to the oath.

The oath *must* be attested in all cases by the proper official seal of the officer before whom the oath or affirmation is made. When such officer is not provided with a seal his official character must be established by competent evidence, as by a certificate from a clerk of a court of record, or other proper officer having a seal.

Additional or Supplementary Oaths Required in Certain Cases.—An additional or supplemental oath will be required in certain cases, such as the following:

(1) The Commissioner may require an additional oath if the application has not been filed within a reasonable time after the execution of the original oath.

(2) To cure any defects in the original oath, such as the omission of the declaration as to foreign patents.

(3) If the applicant seeks to introduce, by amendment, any claim not substantially embraced in the statement of invention and claims originally presented, and therefore not covered by the original oath, he will be required to file a supplemental oath to the effect that the subject matter of the proposed amendment was part of his invention, and was invented before he filed his original application.

Inasmuch as in some foreign countries a notary public is not authorized by law to administer oaths it is necessary, in these countries, that the oath be made before a diplomatic or consular officer of the United States. This is the fact as to Austria, Argentine Republic, Belgium, Brazil, Costa Rica, Denmark, Hayti, Honduras, Hungary, Italy, Mexico, Netherlands, Norway, Peru, Portugal, Russia, San Salvador, Servia, Sweden, and Switzerland.

Examination and Issuing Patent.

Sec. 4893.—On the filing of any such application and the payment of the fees required by law, the Commissioner of Patents shall cause an examination to be made of the alleged new invention or discovery; and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the Commissioner shall issue a patent therefor.

Rules of Practice, 1892.—63 to 78. (See also notes under Section 4903 *post.*)

An application is not considered as filed and complete until all its parts have been received. After an application is completed the specification cannot be withdrawn from the office for any purpose whatever. Every part of the application is preserved in secrecy in the Patent Office, and no information is given concerning it to anyone outside of the department without due authority from the inventor, except in interference cases, or when the application has been rejected or abandoned, and in the judgment of the Commissioner its disclosure may be necessary. After an application is completed it is placed on file for examination, receiving a serial number, and thereafter is known to the office by its serial number and filing date.

Classification of Inventions.—Inventions are classified in two hundred and thirteen general classes, which are again subdivided into six thousand three hundred and twenty-two sub-classes. An application will be reached for examination in from

one to six months or more after it has been filed, some examiners being further behind in their work than others. The examination of applications is conducted by thirty-two principal (primary) examiners, each in charge of certain classes of inventions, assisted by thirty-four first, thirty-eight second, forty-three third, and fifty-three fourth assistant examiners, and numerous clerks and copyists.

Upon the receipt of the application at the Patent Office it is first entered of record in the office of the chief clerk. The financial clerk sees that the first government fee of fifteen dollars is paid; the application clerk that all formalities as to signatures and the oath have been properly complied with; the chief draughtsman that the drawing is made in conformity with the rules. If the application is not complete and correct in these particulars the papers are held for correction; if found correct the application receives its filing date and serial number, and is then sent to the examiner in charge of the class of inventions to which it belongs, and a receipt is forwarded to the applicant stating the filing date and the number of the application, and that it "will be taken up for examination in its order."

EXAMINATION AS TO FORM.—The first step in the examination is to determine whether the application is in all respects in proper form. Where there is a vital defect of form, the application cannot be examined on its merits, see *ex parte* Mill, 40 O. G. 918. All the parts of the application are subjected to a rigid scrutiny and all errors or omissions must be cured by amendment. If the technical terms employed are not correct they must be changed. If more than one invention is claimed, a division of the application is demanded, in which the inventor is required to limit his claims to a single invention. The Patent Office requires division not merely for its own sake, but in order that the patent may be valid, see *ex parte* Van Matteson, 24 O. G. 389. The inventor may in such case file separate applications for the matter eliminated, if he wishes to do so. If the drawing is not sufficiently full to clearly show the invention, additional views will be called for. If the specification is faulty, or does not fully describe the invention it must be revised and made complete. If the claims are not properly drawn they must be revised and corrected.

The first letter of the examiner must advise the applicant of all formal requirements, cite all references, and instruct him that action on the merits is postponed until the objections are removed. All formal matters must be settled before any claim is rejected on the merits, see *ex parte* Mill, 40 O. G. 918; *ex parte* Silliman, 34 O. G. 1389. If, however, the objections as to form are not vital, the examiner may proceed to the consideration of the application on its merits, see Rule 64.

EXAMINATION AS TO NOVELTY.—The examiner then proceeds to examine the case as to its merits, *i. e.*, to determine whether the invention is new and useful, and otherwise patentable. These examinations are usually very thoroughly conducted. The drawings of all prior patents in the class to which the invention belongs, and those in other classes, where there is a possibility that there may be any analogy, are carefully compared with those of the pending application. Not only prior United States patents, but the prior patents of all countries, and also the printed publications in the Patent Office Library are examined. The result of the examination is communicated to the applicant through his attorney, and in the great majority of cases consists of a rejection, or partial rejection of the claims presented, with the reasons therefor, and such information, and reference to prior patents or publications as will be useful to the applicant in the further prosecution of the application.

A REJECTION IS NOT A FINAL REFUSAL OF A PATENT.—Such a rejection is not a definite and final refusal to grant a patent. The examination is made with more particular reference to what *is claimed* than what *is shown* in the application, and while the invention itself may be entirely new and novel, and patentable, the examiner may properly reject the claims presented for the reason that they are so worded that they describe old and well-known devices as well as they do the applicant's invention.

An examiner, in rejecting an application, should cite references, not give his own *dictum*, see *ex parte* Fairbanks, 3 O. G. 65. All the examiner's reasons for rejecting the application must be given at once, see *ex parte* Proudfit, 10 O. G. 585. If the examiner denies the prlority of the applicant and cannot cite a reference, he must support his denial by an affidavit, see *ex parte* Hill, 16 O. G. 765. The best references should be cited first, see *ex parte* Sanders, 13 O. G. 818. Pertinent references only should be cited, see *ex parte* Brownlie, 3 O. G. 212; but they need not be identical either in material, shape, or mode of use, see *ex parte* Chatillon, 2 O. G. 115.

AS TO DIVISIONAL APPLICATIONS.—Where separate and independent inventions are embraced in one application, it must be divided, see *ex parte* Mill, 40 O. G. 918; but no division can be ordered where the product or process are inseparable, see *ex parte*

Holt, 29 O. G. 171; and no division will be required unless each invention would be separately patentable, see *ex parte* Pintsch, 11 O. G. 597. Each additional application for the divided inventions must be supported by a new oath and possess the other requisites of an independent application, see *ex parte* Tieman, 11 O. G. 1. All the divided applications bear the date of the original, see Graham *v.* Geneva Lake C. Mfg. Co., 21 O. G. 1536. Where an application is once divided the separated matter can never be reinstated, see *ex parte* Preston, 17 O. G. 853. A divisional application cannot be based on new matter added to the original after filing, see *ex parte* Buell, 20 O. G. 437. All divisional applications should disclaim what they do not claim, with proper references to the applications in which they are claimed, see *ex parte* Clarke, 26 O. G. 824. Whether a division is necessary is a question that the Patent Office alone can determine, see *ex parte* Kerr, 41 O. G. 463.

RIGHT TO AMEND.—The applicant has a right to amend before or after the first rejection or action; and he may amend as often as the examiner presents new references or reasons for rejection. In so amending, the applicant should clearly point out all the patentable novelty which he thinks his invention presents in view of the state of the art disclosed by the references cited, or the objections made.

The object of such amendments is, of course, to correct errors and omissions in the specification and drawings, and to limit the claims to the precise features of novelty contained in the invention. Amendments usually consist in the re-writing of the claims. Oftentimes the change of one or two words in a claim will be sufficient. In other cases a portion of, or the entire specification and the claims must be re-written, and perhaps the drawings amended. Such an amendment having been filed, the examiner again takes up the application for consideration and continues his examination. He may find and cite new references, or objections, and additional amendments are required to overcome them. In this way from one to a dozen or more letters are written by the examiner, and as many amendments filed, before the case is disposed of by an allowance of the patent or a final rejection of the application. A rejection is not final until the examiner has twice rejected the same claim upon the same references or same state of facts.

In considering the question of rejections and amendments the following decisions will be found useful:

Amendments to the application may be offered at any time before final disposition of it has been made, in order to embrace in it everything which was specified at the outset, or to enlarge the claims, see Railway Register Mfg. Co. *v.* North Hudson Co. R. Co., 33 O. G. 355; but not unless a good reason for allowing it appears, see *ex parte* Winchester, 17 O. G. 453; nor can new matter, changing the character of the invention, be introduced by amendment, see *ex parte* Wharton, 40 O. G. 917; and any amendment containing features not found in either the specification, the drawings, or the model, introduces new matter and must be made as a separate application, see *ex parte* Crandall, 35 O. G. 625. Amendments enlarging the scope of the application are not allowable, see Eagleton Mfg. Co. *v.* West, B. & C. Mfg. Co., 17 O. G. 1504.

An applicant cannot change his ground and secure successive examinations for a single fee, see *ex parte* Holt, 29 O. G. 171. Claims struck out because inconsistent with other claims cannot be reinserted by amendment, after such other claims have been defeated, see *ex parte* Cobb, 16 O. G. 175; and a claim once voluntarily erased cannot be restored, but may be made the subject of a new application, see *ex parte* Johnson, 40 O. G. 574. Where an amendment is not permitted a new application may be filed, see *ex parte* Thurmond, 37 O. G. 217.

Any amendment, within the original sworn statement, may be made without a new oath, see Railway Register Mfg. Co. *v.* North Hudson Co. R. Co., 33 O. G. 355; but where claims are enlarged in subject matter by amendment, a supplemental oath is necessary to show that such enlargement is not a departure from the invention as originally described, see *ex parte* Crandall, 35 O. G. 625; and an amendment introducing a part of the invention as originally made but not appearing in the specification as first filed, must be supported by an oath that it belonged to the original invention, see *ex parte* McDougall, 21 O. G. 1783.

Forfeited and abandoned applications will not be cited as references.

An application is open to amendment and addition (except as to new matter), within the limits fixed by the drawings and model until it is finally disposed of, see *ex parte* Dodge, 3 O. G. 179. After a second rejection of the same claim an applicant cannot amend as a matter of course, but must satisfactorily explain why he did not earlier offer the correction, see *ex parte* Donovan, 44 O. G. 698. From the refusal of an examiner to consider an amendment appeal lies to the Commissioner, see *ex parte* Bennett, 35 O. G. 1003. The rejection of claims may be appealed from but the rejected matter cannot be made the subject of a new application, see *ex parte* Ransom, 39 O. G. 119. A rejected

applicant must appeal within a reasonable time or he will not be permitted to stand in the way of other applicants, see *ex parte* Lombard, 43 O. G. 1347. By taking an appeal from the rejection of one claim the applicant forfeits no rights as to the others, see *ex parte* Gillette, 44 O. G. 819.

As to Diligence in Amending.—According to Rule 65, approved February 14, 1895, an applicant will be considered to persist in his claim for a patent without altering his specification in case he fails to act in prosecution of same for six months after the office action thereon, and thereupon the examiner will make a re-examination of the case, according to Rule 68, approved February 14, 1895. In every case pending before the office more than five years, in which the record raises the presumption that there has been intentional delay in prosecution, the examiner may require the applicant to show cause why the case was not more rapidly prosecuted, and at the hearing thereon, or upon failure of the applicant to appear, the examiner will determine, under all the circumstances of the case, whether there have been intentional and unreasonable delays in prosecution, and upon finding the fact to be so, he will reject the case for that reason.

Completion of Applications.

Sec. 4894.—All applications for patents shall be completed and prepared for examination within two years after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same within two years after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable.

Rules of Practice, 1892.—31, 171, 172.

The statute does not interpose an absolute bar to the granting of a patent where the application has not been completed and prepared for examination within two years. The delay may be condoned by proof that it was unavoidable. The decision of the fact is committed to the Commissioner. The sufficiency of the evidence is for him. He is the only judge to be satisfied, and his judgment is conclusive, see McMillan *v.* Barclay, 5 Fish, 189. If the inventor has been incapacitated by mental disorder, the application will not be deemed to be abandoned, see Ballard *v.* Pittsburgh, 12 Fed. Rep. 783. Although a party fails to prosecute his application within two years after he is notified of its rejection, yet he may file a new application for the same invention, for it is not the invention but the application that is decided to be abandoned, Lindsay *v.* Stein, 21 O. G. 1613.

Patents Granted to Assignees.

Sec. 4895.—Patents may be granted and issued or re-issued to the assignee of the inventor or discoverer; but the assignment must first be entered of record in the Patent Office. And in all cases of an application by an assignee for the issue of a patent, the application shall be made and the specification sworn to by the inventor or discoverer; and in all cases of an application for a re-issue of any patent, the application must be made and the corrected specification signed by the inventor or discoverer, if he is living, unless the patent was issued and the assignment made before the eighth day of July, eighteen hundred and seventy.

Rules of Practice, 1892.—26, 215.

The words "the assignee" mean the assignee in any degree and however remote. They are not limited to the immediate assignee of the inventor, but embrace the ultimate assignee, see Selden *v.* Stockwell S. L. G. B. Co., 20 O. G. 1737. No assignment of an unpatented invention is required to be recorded by this section, unless it is an assignment on which a patent is to be issued to "the assignee," and in such case the invention must be so identified in the assignment by a reference to a specification or an application, or otherwise, that there can be no mistake as to what particular invention is intended, see Wright *v.* Randel, 21 O. G. 493. The patent may be issued to the inventor and assignee jointly, see Wright *v.* Randel, 21 O. G. 493.

If assignments have been used, the Commissioner of Patents must be governed by the record in determining to whom a patent shall issue, see *ex parte* Edison, 7 O. G. 423.

When, and on What Oath, Executor or Administrator May Claim Patent.

Sec. 4896.—When any person, having made any new invention or discovery for which a patent might have been granted, dies before a patent is granted, the right of applying for and obtaining the patent shall devolve on his executor or administrator, in trust for the heirs at law of the deceased, in case he shall have died intestate; or if he shall have left a will, disposing of the same, then in trust for his devisees, in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him in his lifetime; and when the application is made by such legal representatives, the oath or affirmation required to be made shall be so varied in form that it can be made by them.

Rules of Practice, 1892.—25, 26.

Patents issued to executors or administrators will be valid, although the trust is not expressed on the face thereof, for the law creates the trust, see Stimpson *v.* Rogers, 4 Blatch., 333. The import of this provision is that while the legal title to the invention is devolved upon the executor or administrator, he must take it and hold it subject to any equities existing as against the inventor in his lifetime. When the inventor parted with the equitable title, the executor or administrator holds it under exactly the same conditions, and subject to the same limitations of his interest in it, see Northwestern Co. *v.* Philadelphia Co., 6 O. G. 34.

If an applicant dies his executor need not file a new application, but may be made a party to the pending application, see Rice *v.* Burt, 16 O. G. 1050.

An administrator with relation to letters patent is substantially a trustee for the heirs of the inventor, but in order to act he must make proof of his representative character. Foreign letters of administration are not good evidence of it, and ancillary letters of administration must be taken out in this country, see Robert Ransome's Ex'rs, 2 Dec. Com. 143. It follows therefore that in case of a deceased foreign inventor, ancillary letters of administration must be taken out in the name of some person resident in the United States, and the application for patent be made by this person as trustee for the heirs or other owners of the invention.

Renewal of Application in Cases of Failure to Pay Final Fee in Season.

Sec. 4897.—Any person who has an interest in an invention or discovery, whether as inventor, discoverer, or assignee, for which a patent was ordered to issue upon the payment of the final fee, but who fails to make payment thereof within six months from the time at which it was passed and allowed, and notice thereof was sent to the applicant or his agent, shall have a right to make an application for a patent for such invention or discovery the same as in the case of an original application. But such second application must be made within two years after the allowance of the original application. But no person shall be held responsible in damages for the manufacture or use of any article or thing for which a patent was ordered to issue under such renewed application prior to the issue of the patent. And upon the hearing of renewed applications preferred under this section, abandonment shall be considered as a question of fact.

Rules of Practice, 1892.—175, 176.

Where a patent has been forfeited for non-payment of the final fee, a renewal application may be filed within two years, but not afterward, see *ex parte* Hardy, 12 O. G. 1075. After two years' delay there can be no renewal application, see Thompson *v.* Waterhouse, 30 O. G. 177. Any person interested in the invention may make the renewal application, using the original petition, oath, specification, drawing, and model, if he pleases, but paying a new fee. This second application is not considered as a

continuation of the former, but will bear date from the time of the renewal, and will be examined and passed upon like an original application. In its examination the novelty will be determined by the state of the art when the original was filed, not in its present state, as in the case of an application wholly new.

Assignments of Patents.

Sec. 4898.—Every patent or any interest therein shall be assignable in law by an instrument in writing; and the patentee or his assigns or legal representatives may, in like manner, grant and convey an exclusive right under his patent to the whole or any specified part of the United States. An assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent Office within three months from the date thereof.

Rules of Practice, 1892.—26, 210, 211, 212, 213, 214, 215, 216, 218, 219.

Any instrument amounting to any assignment, grant, mortgage, lien, incumbrance, or license, or which affects the title of the patent or invention to which it relates, will be received for record. Such instrument should identify the patent by number and date; or, if the invention is unpatented, by the name of the inventor, the serial number, and date of the application.

The assignment may be for either the right to make, to use, or to sell, or for the right to do any or all of these acts, and may be for the whole or any part of the United States, see Howe *v.* Chatham, 64 Tex., 36; Campbell *v.* James, 18 O. G. 1111. Each claim is separately transferable, see Pope Mfg. Co. *v.* Gormully & Jeffrey Mfg. Co., 84 Fed. Rep. 893. Undivided interests may also be assigned. An assignment of an undivided part of a patent, however small the undivided interest conveyed, makes the assignee and the patentee joint owners, see Potter *v.* Holland, 4 Blatch., 206; and the holder of an undivided interest in a patent may make, use and sell, and license others to do so, without regard to its effect on his co-owners, unless there is an agreement between the parties as to profits. Joint owners of a patented invention are tenants in common, see Dunham *v.* Indianapolis & St. Louis R. R. Co., 7 Bissell, 223. A joint interest in a patent does not make the owners partners, see Parkhurst *v.* Kinsman, 1 Blatch., 488. Each co-owner of a patent may use the right without the concurrence of the others, and license at will, see Washburn & Moen Mfg. Co. *v.* Chicago G. W. F. Co., 109 Ill., 71. One joint-owner cannot compel another to account for a share of his profits, see Vose *v.* Singer, 4 Allen, 226; Fraser *v.* Gates, 118 Ill., 99. But it should be observed that neither a joint-owner nor his alienees can lawfully practice an infringing invention, see Miller's Falls Co. *v.* Ives, 14 O. G. 203.

Executors and administrators hold a patent in trust for the devisees; they can assign a patent and give a good title thereto, see Donoughe *v.* Hubbard, 35 O. G. 1561; and it is not necessary that all the executors or administrators should join in the assignment, see Wintermute *v.* Redington, 1 Fisher, 239.

Patented inventions are not subject to execution, nor to any ordinary method of appropriation for the benefit of creditors; a patent privilege cannot be seized and sold on execution, see Carver *v.* Peck, 13 Mass., 291; but the owner of a patented invention may be compelled by a court of equity to assign it for the benefit of creditors. For a full discussion of this subject, see Robinson on Patents, §§ 804, 805.

An infant must assign by guardian, but the guardian is governed by local law; the power of a married woman to assign a patent depends on the provisions of the local law, see Fetter *v.* Newhall, 25 O. G. 502.

No particular form for an assignment is prescribed, see Siebert Cylinder Oil Cup Co. *v.* Beggs, 32 Fed. Rep. 790. It must be made in writing and be signed by the assignors, see Gottfried *v.* Miller, 21 O. G. 711. A parol agreement to assign and to allow the assignee to take out the patent in his own name is valid, see Lockwood *v.* Lockwood, 33 Iowa, 509; and a verbal agreement vests in the assignee an equitable right to grant licenses, and notes given for such licenses are upon sufficient consideration, see Burke *v.* Partridge, 58 N. H., 349; but the legal title to a patent can be transferred only by a written instrument signed by the owner of the patent, see Ashcroft *v.* Walworth, 2 O. G. 546. An assignment executed by an attorney must be signed with name of the *principal and sealed with his seal*, see *Machesney v. Brown, 38 O. G. 1130. An assignment* by an attorney in his own name is invalid, the signature of the owner being essential, see Pryer *v.* Coulter, 1 Bailey, 517. A conveyance by a corporation with its seal,

and by its president with his seal, is good as to both, see Campbell *v.* James, 18 O. G. 979. It is not required that an assignment be under seal, see Gottfried *v.* Miller, 21 O. G. 711; nor need the signature of the assignor be witnessed or acknowledged in order to be effective.

As to Assignment before Issue of Patent.—The right to an invention dates from its discovery, see Wintermute *v.* Redington, 1 Fisher, 239; and an assignment before patent is valid, see Cammeyer *v.* Newton, 11 O. G. 287. A patent cannot issue to the assignee, however, unless the assignment contains a request to that effect and is duly recorded as prescribed by the rules, see Wright *v.* Randell, 21 O. G. 493. Rule 215 requires that such an assignment be presented for record at a date not later than the day upon which the final fee is paid. The invention should be identified in the instrument by the name of the inventor, the serial number, and date of application.

Assignment Should be Recorded.—An unrecorded assignment, grant or conveyance, is valid between the parties thereto, see Horne *v.* Chatham, 64 Tex., 36; Turnbull *v.* Weir Plow Co., 7 O. G. 173; and is good, except against creditors and subsequent *bona fide* purchasers, see Holden *v.* Curtis, 2 N. H., 61; for one who knows of an unrecorded assignment cannot be a *bona fide* purchaser, see Ashcroft *v.* Walworth, 2 O. G. 546; and an assignment though unrecorded is good against all who have actual notice, see Maurice *v.* Devol, 23 W. Va., 247; Ashcroft *v.* Walworth, 2 O. G. 546; but in order that the record may be constructive notice to intending purchasers, the assignment must be recorded within three months from the date of its execution. After three months without record a prior conveyance becomes invalid as against a later transfer, except in cases where the later purchaser had actual notice of the existence of the prior assignment. An assignment is not valid against innocent parties unless recorded, see Boyd *v.* McAlpin, 3 McLean, 427. It should be observed, however, that the record although made after three months have elapsed, affords constructive notice to all persons acquiring interests in the invention subsequently to the date of record, see Brooks *v.* Byam, 2 Story, 525; Case *v.* Redfield, 4 McLean, 526; also that section 4895 does not provide for recording assignments of unpatented inventions, unless the patent is to issue to the assignee, and if recorded, such record is not notice to anyone, see Wright *v.* Randel, 21 O. G. 493; also that the record of an instrument which the law does not require to be recorded is not constructive notice of anything to any person, see Wright *v.* Randel, 21 O. G. 493; and that the law provides for the recording of these instruments only: an assignment before issue, when the patent is to issue to the assignee, either alone or jointly with the inventor; an assignment after patent; a grant of a territorial interest; and a license, see Brooks *v.* Byram, 2 Story, 525. A single assignment may transfer several patents, but to avoid confusion on the records, a separate conveyance for each patent is desirable.

Persons Purchasing of Inventor, Before Application, May Use or Sell the Thing Purchased.

Sec. 4899.—Every person who purchases of the inventor or discoverer, or, with his knowledge and consent, constructs any newly invented or discovered machine, or other patentable article, prior to the application by the inventor or discoverer for a patent, or who sells or uses one so constructed, shall have the right to use, and vend to others to be used, the specific thing so made or purchased, without liability therefor.

The object of this provision is evidently two-fold: 1st, to protect the person who has used the thing patented by having purchased, constructed, or made the machine, etc., to which the invention is applied, from any liability to the patentee or his assignee: 2nd, to protect the rights granted to the patentee against any infringement by any other persons.

The "purchaser" here spoken of is a purchaser not from a mere wrong-doer, but from the first and true inventor before he obtained his patent, see Pierson *v.* Eagle Screw Co., 3 Story, 402. The right of a party who has bought, or constructed a machine before the application for a patent is confined to the specific machines so bought or constructed, see Brickill *v.* New York, 18 O. G. 468.

Patented Articles Must be Marked as Such.

Sec. 4900.—It shall be the duty of all patentees, and their assigns and legal representatives, and of all persons making or vending any

patented article for or under them, to give sufficient notice to the public that the same is patented; either by fixing thereon the words "patented," together with the day and year the patent was granted; or when, from the character of the article, this cannot be done, by fixing to it, or to the package wherein one or more of them is enclosed, a label containing the like notice; and in any suit for infringement, by the party failing so to mark, no damages shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement, and continued, after such notice, to make, use, or vend the article so patented.

The duty of marking patented articles as "patented" devolves upon the manufacturer, see Wilson *v.* Singer Mfg. Co., 16 O. G. 1091. Unless the evidence shows that the statute has been complied with, only nominal damages can be recovered for infringements, see McComb *v.* Brodie, 2 O. G. 117. The failure to stamp prevents recovery of damages, but is no bar to an injunction either preliminary or perpetual, see Goodyear *v.* Allyn, 3 Fisher, 374. However, in McComb *v.* Brodie, 2 O. G. 117, it was held that notice otherwise given is equivalent to a mark on the articles themselves in its effect on the right to substantial damages.

Penalty for Falsely Marking or Labeling Articles as Patented.

Sec. 4901.—Every person who, in any manner, marks upon anything made, used, or sold by him for which he has not obtained a patent, the name or any imitation of the name of any person who has obtained a a patent therefor, without the consent of such patentee, or his assigns or legal representatives; or

Who, in any manner, marks upon or affixes to any such patented article the word "patent" or "patentee," or the words "letters patent," or any word of like import, with intent to imitate or counterfeit the mark or device of the patentee, without having the license or consent of such patentee or his assigns or legal representatives; or

Who, in any manner, marks upon or affixes to any unpatented article the word "patent" or any word importing that the same is patented, for the purpose of deceiving the public, shall be liable, for every such offence, to a penalty of not less than one hundred dollars, with costs; one-half of said penalty to the person who shall sue for the same, and the other to the use of the United States, to be recovered by suit in any district court of the United States within whose jurisdiction such offense may have been committed.

The object of this provision is to prevent fraudulent imposition upon the community at large. The marking is an offense, though no sales result, see Nichols *v.* Newell, 1 Fisher, 647; and however the mark may be put on, *Idem.* The fine may be recovered by any person in a *qui tam* action brought in the name of the informer, not of the United States. The suit can be maintained only in the district in which the stamping was done, and not where the goods were sold, see Pentlarge *v.* Kirby, 19 Fed. Rep. 501. Acts of employees in false stamping are acts of the principal, see Kass *v.* Hawlowetz, 33 O. G. 1135. A corporation may violate this act through its officers, see Thompkins *v.* Butterfield, 33 O. G. 758.

Filing and Effect of Caveats.

Sec. 4902.—Any citizen of the United States who makes any new invention or discovery, and desires further time to mature the same, may, on payment of the fees required by law, file in the Patent Office a caveat setting forth the design thereof, and of its distinguishing characteristics, and praying protection of his right until he shall have matured

his invention. Such caveat shall be filed in the confidential archives of the office and preserved in secrecy, and shall be operative for the term of one year from the filing thereof; and if application is made within the year by any other person for a patent with which such caveat would in any manner interfere, the Commissioner shall deposit the description, specification, drawings, and model of such application in like manner in the confidential archives of the office, and give notice thereof, by mail, to the person by whom the caveat was filed. If such person desires to avail himself of his caveat, he shall file his description, specifications, drawings, and model within three months from the time of placing the notice in the post office in Washington, with the usual time required for transmitting it to the caveator added thereto; which time shall be indorsed on the notice. An alien shall have the privilege herein granted, if he has resided in the United States one year next preceding the filing of his caveat, and has made oath of his intention to become a citizen.

Rules of Practice, 1892.—197 to 209, 15, 154.

The purpose of a caveat is to prevent the grant of a patent for the same invention to another person, without notice to the caveator, in case an application should be filed by another inventor during the existence of the caveat. Thus it simply entitles an inventor to a certain notice. It gives him no advantage over such other applicant, and imposes no obligation upon him either to file an applicatlon for patent after receiving such notice, or to oppose the grant of a patent to the other inventor. It simply affords him the opportunity to do so, and allows him the term of three months for preparing and filing his application. If, during the time which elapses between the filing of the caveat and his application the inventor allows his invention to go into public use, his caveat will not protect him, see Bell *v.* Daniels, 1 Fisher, 377. A caveat cannot be filed for a design, as a design cannot exist at all until it is complete enough to be patented, see *ex parte* Carty, 44 O. G. 570. A caveat for a joint invention may be signed by one of the inventors only, see *ex parte* Gray, 12 O. G. 396. A patent issued on a subsequent application without notice to the caveator is "surreptitiously obtained," see Philips *v.* Brown, 4 Blatch., 362; and gives no advantage to the patentee, but as against the caveator he will still be treated as a rival applicant, see Ware *v.* Bullock, 7 O. G. 89.

A caveat may be renewed from year to year upon payment of the fees.

Notice of Rejection of Claim for Patent to be Given to Applicant.

Sec. 4903.—Whenever, on examination, any claim for a patent is rejected, the Commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejection, together with such information and references as may be useful in judging of the propriety of renewing his application or of altering his specification; and if, after receiving such notice, the applicant persists in his claim for a patent, with or without altering his specifications, the Commissioner shall order a re-examination of the case.

Rules of Practice, 1892.—65, 66, 67, 69 to 78.

For statement as to prosecution of application, rejections, right of applicant to amend, etc., see notes to section 4893, *ante*.

The specification is always open to amendment of its description and claims, until the application is finally disposed of by the granting of the patent or otherwise.

After a first rejection the applicant may insist upon his claim as presented. If the examiner re-affirms his former decision, without supporting it with fresh references, the rejection is final, and there is no remedy but appeal. But if the examiner gives new references, the applicant has a right to reply to them or to amend his specification, see *ex parte* Appleton, 1 Dec. Com. 8. If a reference is a domestic patent, or if it is a foreign patent or a publication, the applicant may avoid the reference by an affidavit showing his completion of the invention before the filing of the application for the

domestic patent, or before the date of the foreign patent, or the publication, and averring that he does not know or believe that the invention has been in public use or on sale in this country for more than two years prior to his application, and that he has never abandoned the invention. Foreign inventors may show that their inventions were known in this country before the dates of their applications, and can go back to the dates of any prior foreign patent granted to them for the same invention, but cannot show use abroad prior to the dates of their patents, see *ex parte* Lamfrey, 20 O. G. 892. In case the prior patent cited is an unexpired domestic patent, an interference arises upon the filing of the affidavit above referred to. (See Section 4904 and notes as to proceedings in interferences.)

INTERFERENCES.

SEC. 4904.—Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than twenty days, as the Commissioner shall prescribe.

Rules of Practice, 1892.—93 to 132, 146, 147.

INTERFERENCES DEFINED.—An interference is a proceeding instituted in the Patent Office for the purpose of determining the priority of the inventive act between two or more parties claiming substantially the same patentable invention. The intent of the law is that a patent shall be granted to the first and original inventor, and in an interference proceeding the sole question is that of the priority of the inventive act, see Hicks *v.* Keating, 40 O. G. 343. Where there are rival claimants for the same invention it becomes the duty of the Patent Office to ascertain which of the claimants is the true and first inventor. To determine this fact a judicial proceeding is instituted, in which each of the claimants is required to prove the date upon which he conceived the invention, each of the parties having the right to be heard by evidence and argument in defense of his own claims and in opposition to the claims of his opponents. When all the testimony has been taken, the examiner of interferences passes upon the evidence and declares which of the claimants appears to be the true and first inventor and is entitled to a patent. This judicial proceeding is called an Interference.

WHEN DECLARED.—Interferences will be declared between two or more pending applications, whether original or for re-issues; or between one or more pending applications (whether original or for re-issues) and any unexpired patent or patents, when all the parties claim substantially the same patentable invention, see Sawyer *v.* Edison, 25 O. G. 597. An interference cannot be declared between an application and an unexpired patent unless the later applicant claims priority under oath, see Thomas *v.* Reese, 17 O. G. 195. An interference cannot be declared against an expired patent, see *ex parte* Mason, 9 O. G. 1196; nor with forfeited or abandoned applications, see Starr *v.* Farmer, 23 O. G. 2325. An interference between two or more patents cannot be adjudicated in the Patent Office, see Nicholson *v.* Bennett, 16 O. G. 631; and it should be observed that a judgment against a patent in an interference proceeding does not annul the patent, but simply awards a patent to the rival, see C. A. Yale Cigar Mfg. Co. *v.* Yale, 30 O. G. 1183. As to interfering patents, see Section 4918 and notes.

Under former rules of the Patent Office an interference was declared where applications might be so amended as to include conflicting claims, although the conflicting matter was not so claimed at the time the interference was instituted. At the present time the rules forbid the declaration of an interference until the conflict appears specifically in the claims.

An application does not conflict with another application, or an unexpired patent, unless the invention covered by each specification is substantially the same, see *ex parte* Lassall, 28 O. G. 1274. Similarity or diversity in name and appearance are of no consequence, and an interference may be declared whenever the inventions conflict, see Drawbaugh *v.* Blake, 30 O. G. 259.

An application for a design patent may interfere with one for a mechanical invention, if both claim the same subject matter, see Collender *v.* Griffith, 3 O. G. 91.

When only part of the invention included in an application is involved in an interference, the applicant may file certified copies of the part or parts of the specification, claims, and drawings which cover the interfering matter, and such copies may be used in the proceeding in place of the original application. The applicant may then withdraw from his application the subject matter adjudged not to interfere, and file a new application therefor, or he may file a divisional application for the subject-matter involved, if the invention can be legitimately divided; no claim, however, can be made in either application broad enough to include matter claimed in the other, see *ex parte* Wheeler, 23 O. G. 1031; *ex parte* Clarke, 26 O. G. 824.

Amendments to an application while in interference can be made only for the purpose of withdrawing its subject-matter, wholly or in part, from the conflict in which it is involved. An applicant who prefers to abandon his claim to the contested matter rather than incur the expense, delay and risks of an interference, may file, before the date fixed for lodging his preliminary statement, a disclaimer in writing over his own signature, and attested by two witnesses, averring that he does not claim to be the inventor of the particular matter at issue. This disclaimer should be accompanied by an amendment removing the contested matter from his application and claims. Where there has been an assignment of any interest, such disclaimer must be accompanied by the written consent of the assignee, see Laverty *v.* Flagg, 16 O. G. 1141.

PROCEDURE IN INTERFERENCES.—Where a primary examiner believes that an interference exists, it becomes his duty, after all preliminary questions are settled, to forward all the papers to the examiner of interferences, who reviews them, and if he finds that the papers are complete and in form, will declare the interference by sending notice of the same to the parties interested.

No interference will be declared until all preliminary questions have been settled by the primary examiner, and the invention decided to be patentable, see *ex parte* Bland, 16 O. G. 47. The primary examiner decides whether the claims interfere, see Faure *v.* Bradley, 44 O. G. 945; *ex parte* Saunders, 23 O. G. 1224; and whenever there is any doubt in his opinion as to the conflict of the inventions it is his duty to notify the applicants, and require them to state their claims in such a manner that the nature and extent of their antagonism will become distinct and unmistakable. Upon receipt of this notice, and within the time therein specified, all the parties must put their claims in such condition that no further change in them will be required to precisely cover their respective rights. The examiner may grant an extension of time if it be found necessary or desirable. Whenever a party fails to put his application in proper condition for an interference within the time specified, the declaration of interference will not be delayed. After final judgment of priority the application of such party will be held for revision and restriction, subject to interferences with other applications.

The notices of interferences define the exact issue involved, and contain a summary of the contested matter, see Dod *v.* Cobb, 10 O. G. 826; and name a time before which the parties interested must file their preliminary statements. The time for filing a preliminary statement may be extended, upon motion duly made and served upon the other parties, if such extension be necessary. (See Rule 104.)

PRELIMINARY STATEMENTS.—The preliminary statement is a concise written recital, under oath, of the date of all the facts upon which the applicant intends to rely to support his claim of priority.

If the invention was made within the United States, the inventor must set forth in his statement:

(1.) The date of his original conception of the invention.
(2.) The date upon which a drawing of the invention was made.
(3.) The date upon which a model of the invention was made.
(4.) The date upon which the invention was first disclosed to others.
(5.) The date of the reduction to practice of the invention.
(6.) A statement showing the extent of use of the invention.

If a drawing or model has not been made, or if the invention has not been reduced to practice, or disclosed to others, or used to any extent, the statement must specifically disclose these facts, see Dermody *v.* Pennock, 14 O. G. 202.

If the invention was made abroad, the inventor must set forth:

(1.) That the applicant made the invention set forth in the declaration of interference.
(2.) Whether or not the invention was ever patented; if so, when and where, giving the date and number of each patent.

(3.) Whether the invention was ever described in a printed publication; if so, when and where, giving the title, place, and date of such publication.
(4.) Whether or not the invention was ever introduced into this country; if so, giving the circumstances, with the dates connected therewith, which are relied upon to establish the fact.

The statements should be carefully prepared, as the parties will be strictly held in their proofs to the dates set up therein. Evidence cannot be introduced contradicting the statement, see Connor *v.* Williams, 15 O. G. 387.

A preliminary statement may be amended upon motion by the permission of the Commissioner in proper cases, see Clemson *v.* Fowler, 37 O. G. 671; and this is so if it contains substantial errors arising from inadvertence or mistake. Clerical errors may be amended at any time, but a motion to amend in material particulars must be made, if possible, before the taking of any testimony, and as soon as practicable after the discovery of the error, see Hopkins *v.* Le Roy, 18 O. G. 859. Upon this motion all parties are entitled to be heard, and reasonable notice of its pendency must be served upon them.

The statements will be open for the inspection of the opposing parties when all have been filed, or the time for such filing (with any extension thereof) shall have expired, and they have been examined by the proper officer and found satisfactory, but any party in default in filing his statement will not have access to his opponent's statement until he has either filed his statement, or waived his rights thereto and agreed to stand upon his record date, see Rule 111.

If a statement is found to be defective, the party will be notified of the defect, and a time assigned within which he must cure the same by an amended statement. In no case will the original or amended statement be returned after it shall have been filed. If a party shall refuse to file an amended statement he will be restricted to his record date, *i. e.*, the date upon which he filed his application, in the further proceedings in the interference, see Rule 112; Booth *v.* Lyman, 17 O. G. 393.

When the statements are properly filed they are examined and compared with the original applications. If it appears that the date of the filing of the earliest application is not overcome by the dates fixed by the other parties in their statements, priority is awarded to the earliest applicant, see Booth *v.* Lyman, 17 O. G. 393; Huntley *v.* Smith, 18 O. G. 795. Where the preliminary statement of a later applicant fails to carry the date of his inventive act behind the date when earlier applications were filed, judgment is entered against him, see Huntley *v.* Smith, 18 O. G. 795. Only in cases where the date claimed in the statement of one party anticipates the filing of an earlier application by some other party does the interference proceed further, since in these cases alone is the *prima facie* presumption of priority of invention arising from the dates of filing of the respective applications rebutted, and additional evidence rendered necessary to determine which of the parties was the true and first inventor. The first applicant is regarded as the first inventor till the contrary appears, see Starr *v.* Farmer, 23 O. G. 2325.

TAKING TESTIMONY.—The time for the taking of testimony by the various parties is fixed by the examiner. The time for taking testimony may be extended in favor of either party upon a motion, disclosing under oath the reasons for his inability to obtain his evidence within the period prescribed, the names of the witnesses whose testimony he desires, the facts which he expects to prove by them, and the efforts he has made already to secure their earlier attendance. A failure to complete his testimony within the period assigned to any party is not permitted to delay the final hearing.

The same rules as to evidence apply in interference cases as in the courts of the United States, see Millward *v.* Barnes, 11 O. G. 1060. Reasonable notice must be given by parties of the time when, and place where, the testimony will be taken, and full opportunity must be afforded for the opponent to be present and cross-examine the witnesses, either in person or by attorney, see Bell *v.* Gray, 15 O. G. 776.

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, and the burden of proof will rest upon the party who seeks to establish a different state of facts, see McKnight *v.* Wagenen, 9 O. G. 1101. The claimant against a patent has the burden of proof, see Donoughe *v.* Hubbard, 35 O. G. 1561. The latest applicant therefore must first complete his evidence in chief; this is followed by the adverse party, who takes his testimony in reply, and finally the later applicant takes his rebutting evidence. Where there are more than two contestants their times for taking testimony are so arranged that each shall have an opportunity to prove his own case against prior applicants, and to rebut their evidence when offered in reply, and also to answer that of later applicants.

The testimony will be taken in answers to interrogations before a notary public or other officer empowered by law to administer an oath, with the questions and answers

committed to writing in their regular order, by the officer, or, in his presence, by some person not interested in the case.

Each witness before testifying must be duly sworn. The deposition, after same shall be taken, shall be carefully read over by the witnesses, or by the officer to him, and must then be subscribed by the witness in the presence of the officer.

The officer must annex to the deposition his certificate, showing—

(1.) The due administration of the oath by the officer to the witness, before the commencement of his testimony.
(2.) The name of the person by whom the testimony was written out, and the fact that, if not written by the officer, it was written in his presence.
(3.) The presence or absence of the adverse party.
(4.) The place, day, and hour of commencing and taking the deposition.
(5.) The reading by, or to, each witness, of his deposition, before he signs the same; and
(6.) The fact that the officer was not connected by blood or marriage with either of the parties, nor interested, directly or indirectly, in the matter in controversy.

The officer must sign the certificate and affix thereto his seal of office. He must then, without delay, securely seal up all the evidence, notices, and paper exhibits, inscribe upon the envelope a certificate, giving the title of the case, the name of each witness, and the date of sealing, address the package, and forward the same to the Commissioner of Patents.

TESTIMONY IN FOREIGN COUNTRIES.—By leave of the Commissioner first obtained upon motion, testimony may be taken in foreign countries, see Lauder *v.* Crowell, 16 O. G. 405.

The motion must designate a place at which an officer duly qualified to take testimony under the laws of the United States in a foreign country shall reside, where the witnesses shall be examined; it must be accompanied by a statement under oath that the motion is made in good faith, and not for the purpose of delay, or of vexing or harassing any party to the case; it must also set forth the names of the witnesses; the particular facts to which it is expected each will testify, and the grounds upon which is based the belief that each will so testify. It must appear that the testimony is material and competent, and that it cannot be taken in this country at all, or without hardship or injury to the moving party greatly exceeding that to which the opposite party will be exposed by the taking of such testimony abroad.

Upon the granting of such motion, a time will be set within which the moving party shall file in duplicate the interrogatories to be propounded to each witness, and serve a copy of the same upon each adverse party, who may, within a designated time, file, in duplicate, cross-interrogatories. Objections to any of the interrogatories or cross-interrogatories may be filed at any time before the depositions are taken, and such objections will be considered and determined upon the hearing of the case.

As soon as the interrogatories are in proper form the Commissioner will cause them to be forwarded to the officer (usually a United States Consul), with the request that, upon payment of, or satisfactory security for, his official fees, he notify the witnesses to appear and make answer thereto under oath; and that he reduce their answer to writing, and transmit the same under his official seal and signature to the Commissioner of Patents, with the certificate provided for in the preceding section.

By stipulation between the parties the testimony may be taken upon oral interrogatories by the parties or their agents.

MOTIONS.—NOTICES TO OPPONENTS.—During the interference proceedings any proper motions may be made by either party, after proper and reasonable notice thereof to all the adverse claimants. The practice follows the ordinary course of equity practice in the courts of the United States, see Bell *v.* Gray, 15 O. G. 776. Proof of the service of notice of all motions, and copies of motions, papers and affidavits, must be made before the motion will be entertained by the Patent Office. Notices may be given to the opposing party in either of the following ways:

(1), By delivering a copy of the notice to the adverse party or his attorney; (2), by leaving same at the usual place of business of the adverse party or his attorney with some one in his employment; (3), when such party has no usual place of business, by leaving such copy at his residence with a member of his family, over fourteen years of age, and of discretion; (4), transmission by registered letter: (5), by express. Such notice shall, with sworn proof of the fact, time, and mode of service thereof, be attached to the deposition or depositions.

TESTIMONY REQUIRED TO BE PRINTED.—The testimony is required to be printed, and six or more printed copies must be furnished for the use of the Patent Office and the opposing parties.

HEARING.—When the evidence is all in, a day is fixed by the examiner of interferences for the hearing, when oral arguments may be made by the parties or their attorneys.

After the arguments have been completed, no further hearing will be accorded to either party unless at the request of the tribunal having jurisdiction of the case.

JUDGMENT OF PRIORITY.—An interference once declared cannot be determined without a formal dissolution, or a judgment on the issue of priority, see Hicks *v.* Keating, 40 O. G. 343.

This judgment may be made upon the testimony, or upon the written concession of the parties, or upon the written declaration of either of the parties that he has abandoned his application, see Tucker *v.* Kahler, 15 O. G. 966; Hammond *v.* Pratt, 16 O. G. 1235. In rendering a judgment on the testimony the examiner follows the same rules which are recognized as binding in the courts.

Where all the parties are American inventors judgment must be awarded to the claimant who establishes the real priority of his inventive act. Where one invention was made within the United States, and the other was made in a foreign country, the American inventor is entitled to priority unless the foreign invention was known or used in the United States, or patented or published, before the conception of the invention by the American inventor. If one of two foreign inventors has obtained a foreign patent, he must prevail over his opponent, even though the other was in fact the first inventor. If both foreign inventors have obtained patents the earliest patentee is entitled to a patent; if neither has a foreign patent the one that first introduced the invention into the United States must prevail, see Lauder *v.* Crowell, 16 O. G. 405. A foreign patentee stands like any other applicant until a contest begins, and must then prove his priority, *idem.* If neither party seems to be the original and first inventor, judgment should run against both of them, see Wood *v.* Eames, 17 O. G. 512.

Where the decision in favor of one applicant against another is not appealed from, or is sustained upon appeal, it is equivalent to a rejection of the defeated application, and a patent is awarded to the victorious applicant alone, for the matter in controversy, see *ex parte* Gardner, 17 O. G. 626. Where an applicant establishes priority against a patent, the result is the issue of another patent to the applicant.

Unless a judgment is appealed from it is conclusive upon all the parties, see Whitely *v.* McCormick, 10 O. G. 826.

An appeal may be taken from the examiner of interferences to the examiners-in-chief; from their decision to the Commissioner of Patents, and from his adverse decision to the Court of Appeals of the District of Columbia. (See Appeals.)

DISSOLUTION, SUSPENSION AND CONSOLIDATION OF INTERFERENCES.—An interference may be dissolved if the invention should be found unpatentable, see Green *v.* Hall, 87 O. G. 1475; if there is no real conflict between the claims of the applicants, see Smith *v.* Winchell, 13 O. G. 1127; if either party fails to show that he is a true inventor of the invention claimed, see Taylor *v.* Martin, 16 O. G. 138; or, if there was such irregularity in the institution of the interference as must render any judgment therein void, see Barney *v.* Kellogg, 17 O. G. 1096.

An interference may be suspended when the patentability of the invention is in doubt, see Lynch *v.* Dryden, 3 O. G. 407; when the invention is claimed to be abandoned by public use, see Hedges *v.* Daniels, 17 O. G. 152; or if it appears that the interference was irregularly declared, see Bigelow *v.* Commissioner, 7 O. G. 603; and the case will be remanded to the primary examiner for his consideration of such matters.

When several applications interfere with one another upon the same subject-matter, presenting but a single issue, the various reciprocal interferences may be consolidated and disposed of upon one proceeding, see Bell *v.* Gray, 15 O. G. 776.

NEW TRIALS.—New trials are granted in the Patent Office upon the same grounds, and with the same restrictions as in the courts, see Stevens *v.* Putnam, 18 O. G. 519. The principal grounds for a new trial are the discovery of new and important evidence, fraud, or mistake, in the former trial as to the real points at issue, see Hibbard *v.* Richmond, 17 O. G. 1155; Stevens *v.* Putnam, 18 O. G. 519; but no new trial will be granted for new evidence unless due diligence has been used, see Rogers *v.* Bear, 16 O. G. 908; or unless the new evidence will fix the date conclusively, see Eccard *v.* Drawbaugh, 24 O. G. 301.

ASSIGNEES.—When an inventor is unable or refuses to prosecute or defend his own claims to priority, or whenever the ends of justice would be otherwise defeated, an

assignee may be permitted to protect his rights in the invention as a party to the interference, upon motion duly made to the Commissioner, and satisfactory evidence that the necessity for such permission actually exists.

DECISIONS.—The following decisions will be found useful in interpreting this section of the Act :

Priority of conception, coupled with due diligence in reducing to practice, constitutes priority of invention, see Wheeler *v.* Russell, 1 O. G. 183. As between two rival inventors, he who first perfects the invention is entitled to the patent, and it cannot avail the other to refer back to crude experiments, Browne *v.* Ludlow, 2 Dec. Com., 16. A foreign inventor cannot on an interference with an American inventor have a commission issued to prove that his invention was made in a foreign country prior to the time when it was patented or published, see Rumpff *v.* Kohler, 23 O. G. 1831. A printed specification of a foreign patent is not competent evidence to prove the date of the invention or that the patentee was the inventor in his favor, see Lander *v.* Crowell, 16 O. G. 405. A foreign inventor cannot prove that he made or used his invention in a foreign country before the date of his patent for any purpose, see *ex parte* Lanfrey, 20 O. G. 892. If an American citizen makes an invention in a foreign country and there has it patented, the earliest date that can be given to his invention as against a rival inventor in this country, is the date of the foreign patent, see Bell *v.* Brooks, 19 O. G. 290. A foreign inventor may show that he made the invention known in this country prior to the date of any prior foreign patent cited against him, see *ex parte* Lanfrey, 20 O. G. 892 ; and in interferences the date of a foreign patented invention is the date of such patent as against an invention made in the United States, see Chambers *v.* Duncan, 10 O. G. 787. The date of a foreign invention may be shown by the date upon which knowledge of the invention was introduced into the United States by samples or otherwise, see Hovey *v.* Hupeland, 2 O. G. 493. Mere descriptions and destroyed drawings are not of much weight to show priority, see Ware *v.* Bullock, 7 O. G. 39.

AFFIDAVITS AND DEPOSITIONS.

SEC. 4905.—The Commissioner of Patents may establish rules for taking affidavits and depositions required in cases pending in the Patent Office, and such affidavits and depositions may be taken before any officer authorized by law to take depositions to be used in the courts of the United States or of the State where the officer resides.

The Commissioner has established the following rules under this section :—
Rules 66, 76, 87, 93, 110, 154, 155, 156, 158, 159, 160 and 162.

SUBPŒNA TO WITNESSES.

SEC. 4906.—The clerk of any court of the United States, for any district or Territory wherein testimony is to be taken for use in any contested case pending in the Patent Office, shall, upon the application of any party thereto, or of his agent or attorney, issue a subpœna for any witness residing or being within such district or Territory, commanding him to appear and testify before any officer in such district or Territory authorized to take depositions and affidavits, at any time and place in the subpœna stated. But no witness shall be required to attend at any place more than forty miles from the place where the subpœna is served upon him.

Rules of Practice, 1892.—160.

WITNESS FEES.

SEC. 4907.—Every witness duly subpœnaed and in attendance shall be allowed the same fees as are allowed to witnesses attending the courts of the United States.

PENALTY FOR FAILING TO ATTEND OR REFUSING TO TESTIFY.

SEC. 4908.—Whenever any witness, after being duly served with such subpœna, neglects or refuses to appear, or after appearing refuses to testify, the judge of the court whose clerk issued the subpœna may, on proof of such neglect or refusal, enforce obedience to the process, or punish the disobedience, as in other like cases. But no witness shall be deemed guilty of contempt for disobeying such subpœna, unless his fees and traveling expenses in going to, returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpœna; nor for refusing to disclose any secret invention or discovery made or owned by himself.

APPEALS FROM PRIMARY EXAMINERS TO EXAMINERS-IN-CHIEF.

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

Rules of Practice, 1892.—133 to 140, 141, 143, 146 and 147.

INTERLOCUTORY AND OTHER APPEALS DEFINED.—Appeals may be based either upon the decisions of the examiner as to matters of form, in which case they are taken to the Commissioner in person, and are called "interlocutory appeals," or from his decision as to some matter of substance, in which case the appeal lies to the board of examiners-in-chief. The question of joinder is a question of form, see *ex parte* Gillette, 44 O. G. 891; whether a claim is intelligible is a question of form, see *ex parte* Doten, 12 O. G. 841; whether a claim is functional is a question of form, see *ex parte* Barrett, 45 O. G. 125; matters of office practice are appealable only to the Commissioner, see *ex parte* Proudfit, 10 O. G. 585. Such questions may be decided upon interlocutory appeals to the Commissioner without fee. (See Rule 145.)

Questions as to the patentability of inventions, see Burney *v.* Kellogg, 17 O. G. 1096; whether an invention is a true combination, see *ex parte* Gillette, 44 O. G. 819; whether an invention is operative, see *ex parte* Kitson, 20 O. G. 1750; whether an invention is new, see *ex parte* Nagel, 17 O. G. 198; whether a cited reference is pertinent, see *ex parte* Kerr, 28 O. G. 95; whether an invention is useful, see *ex parte* Buchanan, 16 O. G. 1049; whether an invention has been abandoned, see Jenkins *v.* Barney, 3 O. G. 119; whether the drawings are sufficient, see *ex parte* Kitson, 20 O. G. 1750; whether the claim distinguishes the new from the old, see *ex parte* Reynolds, 6 O. G. 641; objections to the insertion of distinct claims for non-separable parts, see *ex parte* Gerard, 43 O. G. 1235; whether an invention is a design or a mechanical invention, see *ex parte* Schulze-Berge, 42 O. G. 293; whether an amendment departs from the original by inserting new matter, see *ex parte* Lanstrom, 17 O. G. 744; whether a re-issue application covers new matter, see *ex parte* Keith, 9 O. G. 744; are all questions of substance and appealable only to the examiners-in-chief. Appeals on matters of substance must be taken to the examiners-in-chief, see *ex parte* Baker, 36 O. G. 1149. The right of appeal from a second rejection is absolute, whatever be the cause of rejection, see *ex parte* Bennett, 35 O. G. 1003.

INTERLOCUTORY APPEALS.—An interlocutory appeal to the Commissioner must be in writing and set forth the decision complained of and the reasons for the appeal. The examiner is then required, within fifteen days before the day of hearing, to file an answer disclosing the grounds of his decision, see *ex parte* Jovè, 17 O. G. 801, (a copy of his answer must be furnished the applicant), and upon hearing had, either orally or otherwise, the Commissioner decides the question, affirming, reversing or modifying the action of the examiner. This decision is final, and can only be reviewed or reconsidered by the Commissioner himself.

APPEALS TO THE EXAMINERS-IN-CHIEF.—Before an appeal can be entertained, the claim or claims as originally filed, or if amended the amended claims, must have been twice rejected by the examiner, and all questions of form must have been conclusively settled. (See Rule 134.)

The appeal must be in writing, and set forth the points of the decision upon which it is taken. (See Rule 133.) Upon the filing of the appeal it is submitted to the examiner who, if he finds it to be regular in form, must within fifteen days from the filing thereof, furnish the examiners-in-chief with a written statement of the grounds of his decision on all the points involved in the appeal, with copies of the rejected claims, and the references applicable thereto. The examiner must also furnish the applicant with a copy of his statement. If the appeal is not regular in form, the applicant may amend it, or take an interlocutory appeal from the finding of the examiner to the Commissioner. (See Rule 135.)

The appellant must, before the day of hearing, file a brief of the authorities and arguments on which he will rely to maintain his appeal; and if he desires to be heard orally before the examiners-in-chief, he will so indicate when he files his appeal; a day of hearing will then be fixed, and due notice of the same given him; otherwise the appeal will be considered and decided by the examiners-in-chief upon the record and brief presented. (See Rules 136 and 137.) In contested cases the appellant has the right to make the opening and closing arguments unless otherwise ordered. (See Rule 138.)

The examiners-in-chief in their decision will affirm or reverse the decision of the primary examiner only on the points on which appeal shall have been taken. (See Rule 139*a*.) They must suggest anything they deem important either to the office or the applicant, see *ex parte* Dodge, 3 O. G. 179; but can make no recommendations as to points not within their jurisdiction, see *ex parte* Gillette, 44 O. G. 819. If they are of opinion that a different form of claim from that rejected should be allowed they should annex to their decision a statement to that effect, with such recommendation as they think best, but the examiner is not bound by such recommendation, see *ex parte* Dysart, 34 O. G. 1390. They are not required however to absolutely determine any form of claim to be passed on by the examiner, see *ex parte* Dysart, 34 O. G. 1390; primary examiners may refuse to act on the recommendation of the examiners-in-chief, but an appeal lies from such refusal, see *ex parte* Pearson, 40 O. G. 244. Where the examiners-in-chief make a "recommendation," the party may proffer the recommended matter to the primary examiner, and if he refuses, the Commissioner may order it, or the party may, after acceptance of the matter and a new rejection, appeal, see *ex parte* Holt, 38 O. G. 227. If new references are cited by an examiner, after an appeal to the examiners-in-chief, the applicant may again appeal without a new fee, unless the new references are based on his amendment, see *ex parte* Dysart, 34 O. G. 1390.

Diligence in Filing Appeal.—In appealable cases in which no limit of appeal is fixed, no appeal will be entertained by any tribunal in the office unless taken within six months from the action which puts the case in condition for appeal, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable. (See Rule 134.)

Appeals in Interference Cases.—In interference cases parties have the same remedy by appeal to the examiners-in-chief as in *ex parte* cases. Appeals in interference cases must be accompanied by brief statements of the reasons therefor; and parties will be required to file printed briefs of their arguments before the day of hearing.

From Examiners-in-chief to Commissioner.

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

Rules of Practice.—139 (*c*) (*d*), 140.

This appeal, like the former, is taken by a written petition setting forth the decision complained of and the reasons of appeal, and the procedure is practically the same.

If the Commissioner, in reviewing the decision of the examiners-in-chief, discovers any apparent grounds for granting or refusing letters patent not involved in the appeal, he will, before or after final judgment, and whenever in his opinion substantial justice shall require it, give reasonable notice to the parties; and if any amendment or action thereon be proposed, he will remand the case to the primary examiner for consideration, see *ex parte* Smoot, 11 O. G. 1010. The primary examiner may refuse to act on the recommendation of the Commissioner, and an appeal will lie from such refusal as in other cases, see *ex parte* Pearson, 40 O. G. 244.

Diligence in Filing Appeal.—The same rule applies as in case of appeal to the examiners-in-chief. The appeal should be filed within six months from the action which puts the case in condition for appeal. (See Rule 134.)

APPEALS IN INTERFERENCE CASES.—Parties in interference may appeal from an adverse decision of the examiners-in-chief to the Commissioner of Patents, the procedure being the same as in other cases. Printed briefs should be filed before the day of hearing.
See Act February 9, 1893, under Sec. 4914, *post*.

FROM THE COMMISSIONER TO THE SUPREME COURT, D. C.*

SEC. 4911.—If such party, except a party to an interference, is dissatisfied with the decision of the Commissioner, he may appeal to the Supreme Court of the District of Columbia, sitting in banc.*

NOTICE OF SUCH APPEAL.

SEC. 4912.—When an appeal is taken to the Supreme Court of the District of Columbia,* the appellant shall give notice thereof to the Commissioner, and file in the Patent Office within such time as the Commissioner shall appoint, his reasons of appeal, specifically set forth in writing.

PROCEEDINGS ON APPEAL TO SUPREME COURT.*

SEC. 4913.—The court shall, before hearing such appeal, give notice to the Commissioner of the time and place of the hearing, and on receiving such notice the Commissioner shall give notice of such time and place in such manner as the court may prescribe, to all parties who appear to be interested therein. The party appealing shall lay before the court certified copies of all the original papers and evidence in the case, and the Commissioner shall furnish the court with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal. And at the request of any party interested, or of the court, the Commissioner and the examiners may be examined under oath, in explanation of the principles of the thing for which a patent is demanded.

DETERMINATION OF SUCH APPEAL AND ITS EFFECT.

SEC. 4914.—The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the Commissioner, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

ACT OF FEBRUARY 9, 1893.

AN ACT TO ESTABLISH A COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA, AND FOR OTHER PURPOSES.

SEC. 9. That the determination of appeals from the decision of the Commissioner of Patents, now vested in the general term of the Supreme Court of the District of Columbia, in pursuance of the provisions of section seven hundred and eighty of the Revised Statutes of the United

---

* Now Court of Appeals of the District of Columbia, see Act of February 9, 1893, under Sec. 4914, p. 48, *post*.

States, relating to the District of Columbia, shall hereafter be and the same is hereby vested in the court of appeals created by this act; and in addition, any party aggrieved by the decision of the Commissioner of Patents in any interference case may appeal therefrom to said court of appeals.

Sec. 17. *That all acts and parts of acts inconsistent herewith are hereby repealed.*

See Rules of Practice, 1892.—148 to 150.

This appeal is taken by a written petition, duly signed and filed with the clerk of the court, accompanied by certified copies from the Patent Office of all the original papers and evidence in the case.

The petition should be filed and the docket-fee paid at least ten days before the commencement of the term of court at which the appeal is to be heard. *Pro forma* proceedings will not be had in the Patent Office for the purpose of securing to applicants an appeal to the Court of Appeals of the District of Columbia.

The hearing of appeals are subject to the usual rules of the court. .

Patents Obtainable by Bill in Equity.

Sec. 4915.—Whenever a patent on application is refused, either by the Commissioner of Patents or by the *Supreme Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the Commissioner; and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not. (See § 629, ¶ 9.)

An applicant in an *ex parte* case is not entitled to a bill in equity until he has exhausted his remedies by appeal, see Kirk *v.* Commissioner, 37 O. G. 451. Mandamus will lie where a patent is allowed by the office, but the Commissioner, without denying the right of the applicant, refuses to issue it, see Butterworth *v.* Hoe, 29 O. G. 615. Where the Patent Office rejects an application, and the remedies by appeal are exhausted, the remedy is by bill in equity, see Hull *v.* Commissioner, 7 O. G 559. The power of the Circuit Court to grant a patent is independent of the powers of the Patent Office, see Whipple *v.* Miner, 23 O. G. 2236. It has been decided by the Supreme Court of the United States in Butterworth *v.* Hill, 31 O. G. 1043, that the Commissioner's official residence is at Washington, that he can be sued only in the District of Columbia, and that he cannot waive the question of jurisdiction by appearance, consent or default Further, that a bill to obtain a patent must be brought in the Circuit Court for the District of Columbia, the courts of other districts having no power to enforce decrees against the Commissioner, see Prentiss *v.* Ellsworth, 27 O. G. 623. For the form of a bill to obtain a patent after rejection by the Patent Office, and other proceedings, see *ex parte* Greeley, 6 Fisher, 575.

A bill in equity may be heard on any issues and with any evidence, see Butler *v.* Shaw, 21 Fed. Rep. 321.

Delay in suing in equity for a patent is delay in prosecuting an application, and a petitioner, after a delay of more than two years since the last action, must allege and prove that the delay was unavoidable, see Gandy *v.* Marble, 39 O. G. 1423.

---

* Now Court of Appeals of the District of Columbia.

Appeals from Commissioner of Patents.

Sec. 780.—The Supreme Court, sitting in banc, shall have jurisdiction of and shall hear and determine all appeals from the decisions of the Commissioner of Patents, in accordance with the provisions of section forty-nine hundred and eleven to section forty-nine hundred and fifteen, inclusive, of chapter one, Title LX, of the Revised Statutes, "Patents. Trademarks, and Copyrights." (See R. S. U. S., p. 958. See R. S. U. S., Sec. 699.)

These appeals are now heard by the Court of Appeals for the District of Columbia, see amending act of February 9, 1893, creating Court of Appeals for the District of Columbia, under Sec. 4914, *ante*.

See Rules of Practice, 1892.—148 to 150.

Re-issue of Defective Patents.

Sec. 4916.—Whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the Commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued to the patentee, or, in the case of his death or of an assignment of the whole or any undivided part of the original patent, then to his executors, administrators, or assigns, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the amended patent. The Commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a re-issue for each of such re-issued letters patent. The specifications and claim in every such case shall be subject to revision and restriction in the same manner as original applications are. Every patent so re-issued, together with the corrected specifications, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; but no new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the Commissioner that such new matter or amendment was part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid.

Rules of Practice, 1892.—53, 63, 85 to 92, 94, 170.

Amendment of a patent by way of re-issue was introduced into the patent law as early as 1832; the act of 1836 introduced some slight changes but no substantial modification in the spirit or meaning of the law; the act of 1870 and the Revised Statutes of 1874 introduced other changes in the phrascology of the provisions of the law, but the conditions and procedure are substantially identical with those of the earlier acts.

Re-issues Defined.—Defects in existing patents which may be cured by amendment fall into three classes: (1) Clerical errors. These may be corrected, without surrender and re-issue, by the action of the Patent Office, see Reed *v.* Street, 34 O. G. 339; Rule 170. (2) Errors consisting of an excess of claim. These may also be cured

without surrender and re-issue of the patent, by way of disclaimer, see Section 4917 and notes, *post*. (3) Errors relating to the substance of the grant, whether excess, deficiency or misstatement. Errors of the latter kind can be removed only by re-issue.

The doctrines of the law with reference to re-issues may be resolved into the following propositions: (1) The sole object of a re-issue is to so amend an imperfect existing patent that it may disclose and protect the invention which it was the purpose of that patent to secure to its inventor. (2) It being an amendment of an existing patent, not the grant of a new patent, it must be confined to the invention which the patentee attempted to describe and claim in his original patent. (3) This amendment cannot be allowed unless the imperfections in the original patent arose without fraud, and from inadvertence, accident or mistake. (4) When the amendment is allowable it can be made in any form, and to any extent that may be necessary to render the patent effective for the protection of the original invention. (5) If the re-issue is allowed the original patent must be surrendered and cancelled, and an amended patent will be issued in place thereof, see Robinson on Patents, § 659. See also Rule 85.

"Inadvertence," signifies want of attention; "mistake," want of knowledge; "accident," circumstances against which the inventor cannot guard.

Matter shown and described in an unexpired patent, and which might have been lawfully claimed therein, but which was not so claimed by reason of a defect or insufficiency in the specification, arising from inadvertence, accident or mistake, and without fraud or deceptive intent, cannot be subsequently claimed by the patentee in a separate patent, but only in a re-issue of the original patent. (See Rule 92.)

A re-issued patent supersedes the original; it is a new contract between the United States and the party who obtains it, see Goodyear *v.* Providence Rubber Co., 2 Clifford, 351; it is not a new patent however, it is a continuation of the original patent, see Shaw *v.* Colwell Lead Co., 11 Fed. Rep. 711.

Applicants for Re-issue, Who May Be.—The application for a re-issue must be made by the inventor if he be alive, see Section 4895, Rule 85; on his own behalf if he is still the owner of the entire patent, and on behalf of the real owners if he has assigned the whole or any part of the patent, and in the latter case the application must be accompanied by the written assent of such assignee, see *ex parte* Wright, 10 O. G. 587; Rule 85. If the inventor be dead, the application may be made by the executor, see Carew *v.* Boston Elastic Fabric Co., 1 O. G. 91; the administrator, see Northwestern Fire Extinguisher Co. *v.* Phila. Fire Ex. Co., 6 O. G. 34; or by an assignee of any degree, however remote from the original inventor, see Selden *v.* Self-Lighting Gas Burner Co., 20 O. G. 1377. A re-issue may, if the inventor be dead, be obtained in his own name by the assignee of the executor or administrator of the patentee, see Carew *v.* Boston Elastic Fabric Co., 1 Holmes, 45. A patentee cannot affect the interest of his assignee by any surrender for re-issue, see Burns *v.* Morgan, 3 Hun., 703, as the surrender of an assigned patent is not valid unless made by the assignee, or with his consent, see *ex parte* Wright, 10 O. G. 587. No re-issue can affect the rights of non-assenting owners or other third parties, see Potter *v.* Braunsdorf, 7 Blatch., 97. A re-issue obtained by an inventor without the assent of the assignees is valid or invalid as they may elect. They may ratify it and enjoy the advantages arising from it, though issued only in his name, or they may repudiate it, and compel him to obtain another, or they may insist upon their privileges under the original patent, see Potter *v.* Holland, 4 Blatch., 206. A re-issue to the patentee is, however, a bar to a re-issue to an unrecorded assignee, see Whitely *v.* Fisher, 4 Fisher, 248. It should also be noted that third parties ratify the re-issue by using or selling goods under it, see Meyer *v.* Bailey, 8 O. G. 437.

The Application.—A complete application for the re-issue of a patent comprises: (1) A petition, with power of attorney, if an attorney is appointed. (2) A specification, signed by the applicant and two witnesses. (3) A drawing, if the invention can be illustrated, made upon the same or a larger scale than the original drawing, unless a reduction of scale is authorized by the Commissioner, see Rule 53. (4) An oath which must fulfill all the requirements prescribed for oaths in case of original applications, and in addition it must also aver:

(*a.*) That applicant verily believes the original patent to be inoperative or invalid, and the reason why.

(*b.*) When it is claimed that such patent is so inoperative or invalid "by reason of a defective or insufficient specification," particularly specifying such defects or insufficiencies.

(*c.*) When it is claimed that such patent is inoperative or invalid "by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new," distinctly specifying the part or parts so alleged to have been improperly claimed as new.

(*d.*) Particularly specifying the errors which it is claimed constitute the inadvertence, accident, or mistake relied upon, and how they arose or occurred.

(*e.*) That said errors arose "without any fraudulent or deceptive intention" on the part of the applicant.

(5) A certified copy of the abstract of title, giving the names of all assignees owning any individual interest in the patent. (6) The original patent, or, if this has been lost, an affidavit to that effect, and a certified copy of the patent. (7) The assent of the assignees, if there be any. (8) If the applicant be an executor or administrator, a duly certified copy of the letters testamentary, or of administration, must be annexed to the other papers, or, if the applicant is an assignee, proof of title.

THE SPECIFICATION.—The amended specification must correspond with the original specification unless there is some sufficient reason for a change. In *ex parte* Underwood, 1 O. G. 549, Leggett, Com., said: "In applications for patents the examiner should interfere as little as possible with the language chosen by the applicant in describing his invention. The largest latitude should be allowed, but in applications for re-issues a different rule does and should prevail. The applicant should be held rigidly to the language adopted in his patent, except that a good reason appears for departing from such language. In objecting to the use of new terms, new descriptive matter, etc., the examiner is not bound to give reasons. It is enough that such terms and descriptive matter is new; and it devolves upon the applicant to show good reason for their introduction, or they must be stricken out. A different rule would open a wide door to fraud. A patentee if allowed to interpolate new uses, new descriptive matter, new names, etc., might, by frequent re-issues, keep full pace with the advancement in the art to which his invention pertains, and might thus appropriate to his own use the improvements and inventions made by others. The rule should be: *Liberality with original applications; strict construction with applications for re-issues.*" See also Hatch *v.* Moffitt, 15 Fed. Rep. 252 The specification of the re-issue may be made more full and precise than the original, in order to cover the real invention, see Washburn & Moen Mfg. Co. *v.* Haish, 19 O. G. 173; or may be changed to cure defects or insufficiencies, but should otherwise agree with the original specification in all particulars.

PROCEDURE IN RE-ISSUE CASES.—The procedure in re-issue cases is practically the same as in case of original applications. An examination is made both as to form and substance, and the entire application will be revised and restricted as in other cases (see Rule 90). Even if the validity of the original patent has been sustained by the courts, the Patent Office will conduct the usual examination as to novelty, utility, abandonment and the priority of the applicant's inventive act (see *ex parte* Cox, 3 O. G. 2). The novelty of the invention is determined according to the state of the art at the date of the original application, not at that of the re-issue, see Carroll *v.* Morse, 9 O. G. 453. Its utility is measured by the usual standards. Abandonment is questioned: if there had been two years' public use of the invention before the original application was filed, it will be fatal, see Funck *v.* Doty, 14 O. G. 157.

The practice in regard to objections, references, amendments, arguments, rejections, appeals, and interferences, is similar to that in cases of original applications.

Division may be required, and single original patents may be re-issued in several divisions, see Giant Powder Co. *v.* Safety Nitro-Powder Co., 27 O. G. 59: New *v.* Warren, 22 O. G. 587; and in this case each division constitutes the subject of a separate specification descriptive of the part or parts of the invention claimed in such division, and the drawings may represent only such parts. A separate fee is required for each divisional application as well as the original application for the re-issue. Unless otherwise ordered by the Commissioner, all of the divisions of a re-issue will issue simultaneously; if there be any controversy as to one division, the others will be withheld from issue until the controversy is ended, unless the Commissioner shall otherwise order, see Rule 89. Where an original patent is thus divided, each division is treated as a separate claim under one patent, see Penna. Salt Mfg. Co. *v.* Thomas, 5 Fisher, 148; each division stands by itself as for a separate invention, see Brown *v.* Selby, 4 Fisher, 383, and one division may be valid though the others are void, see Atwood *v.* Portland Co., 16 Fed. Rep. 283.

SURRENDER OF ORIGINAL PATENT.—ITS EFFECTS.—The original patent is required to be surrendered with the application for the re-issue, see Rule 91, but the surrender, as a matter of law and of fact, only takes effect from the date of the re-issue, see Peck *v.* Collins, 19 O. G. 1137. The surrender must be made with the concurrence of all the owners of the original patent, see Meyer *v.* Bailey, 8 O. G. 437. Grantees and licensees are not, however, so interested that their concurrence is necessary to the validity of the surrender and

re-issue. Local or individual rights acquired under the former patent remain unaffected by its surrender until the parties in whom such rights are vested voluntarily relinquish them and accept new rights under the re-issue. The original patent may thus be in force as to grantees and licensees in some portions of the United States, although as to the owners of the patent, and in other sections of the country, the re-issued patent alone is in force, see Potter *v.* Holland, 4 Blatch., 206 ; Meyer *v.* Bailey, 8 O. G. 437.

All rights of action under the original patent expire with its surrender and re-issue, see Jones *v.* Barker, 22 O. G. 771. The surrender is, however, not an acknowledgment that the surrendered patent was entirely void, and a surrender cannot affect rights previously acquired, see Potter *v.* Holland, 4 Blatch., 206, and, therefore, while no suit can be maintained under the original patent, nor any infringement of it be made the ground of a recovery, all closed transactions under it remain undisturbed, see McBurney *v.* Goodyear, 11 Cush. 509. Judgments obtained upon it are not vacated, see Mers *v.* Conover, 11 O. G. 1111. Moneys paid under it cannot be recovered, see Moffitt *v.* Gaar, 1 Blatch., 273. An infringement commenced before the surrender is not sanctioned by the surrender, and if it continues after the re-issue, an action may be instituted on the latter patent, and damages accruing from the date of the re-issue be obtained, see McWilliams Mfg. Co. *v.* Blundell, 22 O. G. 117 ; Bliss *v.* Brooklyn, 4 Fisher, 596.

Withdrawal of Re-issue Applications.—The filing of an application for the re-issue of a patent does not preclude the applicant from abandoning such application, and from resuming his rights under the original patent. As we have just seen, the surrender of the original patent does not take effect until the date of the re-issue. Therefore the applicant may, at any time before the re-issue has been granted, withdraw his application, revoke his surrender, and be restored to his original position, see Forbes *v.* Barstow Stove Co., 2 Clifford, 379.

Date and Term of Re-issued Patent.—A re-issued patent bears the date of the original patent for all purposes, except as the foundation of an action for infringement. It lives during the remainder of the unexpired term of the original patent. All rights of action under the original patent are extinguished with the surrender of the original patent. Rights of action under the re-issued patent commence from the date of the re-issue. The terms of the original and re-issued patents are continuous and uninterrupted, the grant being for seventeen years, unless limited by a prior foreign patent.

Limits of Re-issue, Diligence, Decisions.—The United States Supreme Court in 1882 rendered a decision (Miller *v.* Bridgeport Brass Co., 21 O. G. 201) of great importance, which practically changed the entire practice with respect to re-issues. Prior to this decision it was accepted law that a patentee could, at any time during the life of his patent, re-issue it, and could not only correct any mistakes in the drawings and specifications, but also so broaden his claims as to cover anything which was shown or described in the original patent, or in the model accompanying the application. This was true, even though he had not indicated in his original patent that the matter claimed in his re-issue was his invention ; so long as it was either shown in the drawings or model, or described in the specification, it was sufficient. At the same time it was well settled that a re-issue could not claim a different invention from what was described in the original patent, see Siebert Cyl. Oil Cup Co. *v.* Harper Steam Lub. Co., 4 Fed. Rep. 328 ; Putnam *v.* Tinkham, 4 Fed. Rep. 411 ; Giant Powder Co. *v.* Cal. Vigoret Pow. Co., 4 Fed. Rep. 720 ; Flower *v.* Raynor, 5 Fed. Rep. 791. The position taken by the Supreme Court in the case of Miller *v.* Bridgeport Brass Co. is in substance as follows : A patentee cannot broaden his claims by re-issue, unless the application for re-issue is made with diligence, and with no unreasonable delay after the issue of the original patent, and before other parties are in the field with modifications or improvements which the re-issue would cover ; that if a patentee omits or neglects to claim that part of the invention that he shows or describes, he must make separate application for such part, otherwise he dedicates to the public all that he has not claimed ; and that after the lapse of years a patentee may not change the ground of his invention by re-issue, even though he technically and literally narrows his claim.

The Supreme Court has not specifically said, nor can it say, how long a patentee shall be allowed to wait before filing his application for a re-issue for the purpose of broadening his claims ; what constitutes unreasonable delay in any particular case will depend upon the facts of that case ; and a time that would be reasonable and permissible under one set of facts will be unreasonable and unpermissible under a different set of circumstances. In Ives *v.* Sargent, 38 O. G. 781, it was held that an excuse for a delay longer than two years must be clearly shown ; in Arnheim *v.* Finster, 34 O. G. 700, that where the error, if any, is apparent, and the articles claimed in the re-issue have gone into the market, twenty-two months is too long a delay ; and in Coon *v.* Wilson, 30 O. G.

889, that a delay of three months is unreasonable where the defects are clear and other claimants intervene, if the only object is to enlarge the claims.

The invention claimed in the re-issue must be the identical invention shown and described, and that the inventor attempted to claim in the original patent; that and nothing more. In Powder Co. *v.* Powder Works, 98 U. S. 126, Bradley, J., said: "The specification may be amended so as to make it more clear and distinct; the claim may be modified so as to make it more conformable to the exact rights of the patentee; but the invention must remain the same." A re-issue cannot be expanded so as to claim matters which the patentee did not see fit to claim in the original, see Fay *v.* Fraser, 14 Fed. Rep. 652. Claims in a re-issue which expressly enlarge the invention claimed in the original are void, see Curtis *v.* Branch, 15 O. G. 919. The office of a re-issue is to correct a claim, not to enlarge it, see Russell *v.* Dodge, 11 O. G. 151.

A re-issue cannot claim either another invention or a broader invention than the one attempted to be described and claimed in the original patent, see Worden *v.* Searls, 39 O. G. 359; *ex parte* Herr, 41 O. G. 463. A re-issue is intended to cover the invention which the inventor actually made and attempted to protect in the original, see Eames *v.* Andrews, 39 O. G. 1319, and if no attempt was made to secure the invention in the original patent, it cannot be embraced in a re-issue, see Hoskin *v.* Fisher, 43 O. G. 509. A re-issue is intended to cure the inevitable defects of statement, see Blake *v.* Stafford, 6 Blatch., 195, and may correct but cannot alter, see Doane & Wellington Mfg. Co. *v.* Smith, 24 O. G. 302.

A void patent cannot be re-issued, see Marsh *v.* Nichols, 24 O. G. 901. A joint patent for a sole invention being invalid, no re-issue of it can be granted, see *ex parte* Benton, 23 O. G. 341. An expired patent cannot be re-issued, see *ex parte* Siemens, 11 O. G. 1107.

Where an original patent is valid and operative to the extent of its claims, there is no reason for the re-issue and the re-issue is void, see Giant Powder Co. *v.* Cal. Vigorit Powder Co., 18 O. G. 1339. Where the description is not full and clear a re-issue is needed, see Sewing Mach. Co. *v.* Frame, 28 O. G. 96. Where the original patent covers but one form of the invention it cannot re-issue to cover other forms, see Steam Gauge & Lantern Co. *v.* Miller, 11 Fed. Rep. 718. A re-issue cannot cover new matter, see Ives *v.* Sargent, 38 O. G. 781. To cover a new invention by suppressing parts of the old is not allowable, see Matthews *v.* Iron Clad Mfg. Co., 42 O. G. 827. An error in judgment as to what the patent shall cover, or in conclusions of facts, is no ground for re-issue, see *ex parte* Malcuken, 49 O. G. 915. Where an American patent claimed several devices covered by separate foreign patents, of which some were expired, the devices covered by the expired patents can be excluded from the American patent by re-issue, and the patent be valid for the rest, see *ex parte* Pulvermacher, 10 O. G. 2.

A re-issue cannot claim matters for which the original has expired by reason of its limitation by a foreign patent, see *ex parte* Siemens, 11 O. G. 1107.

A re-issue cannot claim matters inconsistent with the specification, drawings, and model of the original, even though the same matters were claimed in the original patent, see *ex parte* Warren, 10 O. G. 1.

When the original patent does not describe the real invention, the remedy is by a new application and patent, not by re-issue, see James *v.* Campbell, 21 O. G. 337. The fact that a device is not mentioned in the original is evidence that a re-issue which claims it is for a different invention, see Campbell *v.* James, 18 O. G. 979.

Fraud, actual or constructive, renders a re-issue void, see Swift *v.* Whisen, 3 Fisher, 348.

The statements of an inventor in his original patent, as to the nature and scope of his invention, are binding upon him, see James *v.* Campbell, 21 O. G. 337; matters disclaimed in the original cannot be claimed in the re-issue, see Bucher Mfg. Co. *v.* Atwater Mfg. Co., 31 O. G. 1306; the omission from the re-issue of the limitations inserted in the original, renders the re-issue void, see Searle *v.* Bouton, 22 O. G. 946.

The original claims may be reproduced in a re-issue without reference to delay, see Yale Lock Co. *v.* Sargent, 35 O. G. 497, but a re-issue cannot include claims abandoned in the first application, see Streit *v.* Lauter, 11 Fed. Rep. 309; nor claims which were withdrawn from the original in order to secure its issue, see Shepard *v.* Carrigan, 34 O. G. 1157, nor where such claim was withdrawn to escape an interference, see Lee *v.* Walsh, 15 O. G. 563. The greater the discrepancy the shorter should be the delay in applying for re issue, see Mahn *v.* Harwood, 30 O. G. 657.

Successive re issues may be allowed, until the actual invention receives the desired protection, see Selden *v.* Stockwell Self-Lighting Gas Burner Co., 20 O. G. 1377. If a re-issue is void, the original may be re-issued in its exact language and be valid, see Giant Powder Co. *v.* Safety Nitro-Powder Co., 27 O. G. 99. The original patent cannot

be revived by merely disclaiming all changes made by the re-issue, but a new re-issue must be obtained, see McMurray *v.* Mallory, 27 O. G. 915. Where there are several re-issues of the same patent the law always presumes that each was necessary to cure defects, see Union Paper Collar Co. *v.* White, 7 O. G. 698, 877.

Disclaimer.

Sec. 4917. Whenever, through inadvertence, accident or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it.

Rules of Practice, 1892.—195, 196.

A disclaimer is necessary when too much has been claimed, see Seymour *v.* McCormick, 19 How. 96. The filing of a disclaimer is a simple, expeditious and inexpensive method of curing a defect that, in its nature, is fatal to a patent. If an inventor knowingly inserts a claim in his patent covering more than is of his invention, it is a fraud which will invalidate the grant; if he knowingly persists in the claim after he has discovered that it is without foundation, it is a fraud which forfeits all his rights to the protection of any part of the invention covered by the patent, see Robinson on Patents, § 642.

A claim is excessive when it claims any material act or thing beyond the scope of the real invention, or more than what the inventor has shown and described in his specification, drawings and model. In O'Reilly *v.* Morse, 15 How. 62, Taney, C. J., said: "Whether, therefore, the patent is illegal in part because he claims more than he has sufficiently described, or more than he invented, he must in either case disclaim, in order to save the portion to which he is entitled." A disclaimer is necessary, however, only when the thing claimed is a material and substantial part of the art or machine invented, see Hall *v.* Wiles, 2 Blatch , 194. It should also be observed that an excessive claim is amendable only when the defect arose through mistake and without fraud, see Schillinger *v.* Gunther, 17 Blatch., 66; also, that where a foreign patent contains a disclaimer of certain features, the American patent should be limited in the same way, see Ashroft *v.* Boston & Lowell R. R. Co., 13 O. G. 865; that a device actually discarded in practice ought to be disclaimed, see *ex parte* Marsh, 2 O. G. 197; that a disclaimer is a nullity unless the original claim is actually excessive, see Sharp *v.* Tifft, 17 O. G. 1282; that a disclaimer only affects the excess which it eliminates from the claim, neither affecting such other claims of the patent as by themselves are valid, nor the force of what is not disclaimed, see O'Reilly *v.* Morse, 15 How. 62; White *v.* Gleason Mfg. Co., 24 O. G. 265; that it is not a method by which a defective description may be amended, see Hailes *v.* Albany Stove Co., 123 U. S. 582; that a disclaimer may be filed after a patent has been adjudged invalid, see Morgan *v.* Seaward, 2 Carp. P. C. 104; but cannot be filed after the patent has expired, see Yale Lock Mfg. Co. *v.* Sargent, 35 O. G. 497.

Disclaimer. By Whom Made.—A disclaimer may be filed by any party owning the entire patent, or the entire interest in any specified territory, the effect of the disclaimer being commensurate with the interest in the patent owned by the party filing same. The original patentee cannot disclaim after he has parted with his entire title to the

patent, see Myers *v.* Frame, 4 Fisher, 493. An owner of an undivided interest cannot disclaim, and thus change the form of the patent, without the co-operation of the other owners of the same interest in the patent.

If the owner of a territorial or sectional interest files a disclaimer, it will limit and define his rights within the territory owned by him, while at the same time, the owners of other sectional interests may hold under the patent in its original form, see Potter *v.* Holland, 1 Fisher, 327. Thus the same patent may be operative, in terms at least, to different extents in different sections of the United States, and may be valid as to diligent disclaimants, though void as to other owners who have unreasonably neglected to disclaim, see *idem*.

DISCLAIMER.—HOW MADE.—A disclaimer must be in writing, signed by the party making it, attested by one or more witnesses, and recorded in the Patent Office. It must state the precise interest of the disclaimant in the patent, see Foote *v.* Silsby, 1 Blatch. 445; clearly and exactly set out the excess to be disclaimed, and aver that such excess was included in the patent through inadvertence, accident or mistake, see Schillinger *v.* Gunther, 16 O. G. 905.

DILIGENCE.—Disclaimers must be filed without unreasonable delay. "Unreasonable delay" avoids the good effects of a disclaimer, see Tuck *v.* Bramhill, 6 Blatch. 95. In Singer *v.* Walmsley, 1 Fisher, 558, Giles, J., said: "'What is unreasonable delay' is a question to be settled by the court and not for the jury. * * * The court will find that the time, in reference to the question of delay, commences where the knowledge was brought home to the party that he was not the first inventor, or when it is decided by a court, of competent jurisdiction to settle the question, that he was not the first inventor; then it is that the time commences to run, and not till then," and in Yale Lock Mfg. Co. *v.* Sargent, it was held: that the allowance of claims by the Patent Office is such evidence of that validity that the patentee may rely upon it until the courts have decided to the contrary, unless of course, the knowledge is brought home to him in some other way.

EFFECT OF DISCLAIMER UPON PENDING SUITS.—No disclaimer can affect any action pending at the time of filing the same, except as to the question of unreasonable delay in filing it. This provision of the act should not be understood to mean that the claim of the patent must be construed, for the purpose of such action, as if no disclaimer had been filed. In Tuck *v.* Bramhill, 3 Fisher, 400, Blatchford, J., said: "I understand that provision to mean that a suit pending when a disclaimer is filed is not to be affected by such filing, so as to prevent the plaintiff from recovering in it, unless it appears that the plaintiff neglected or delayed to file the disclaimer. * * * It follows that if a disclaimer is made after suit brought, the plaintiff may still recover, but without costs." An excessive claim inserted by mistake, may be disclaimed pending suit, and the suit saved, though without costs, see Matthews *v.* Spangenberg, 23 O. G. 92; a disclaimer being filed during suit, the plaintiff can recover no costs, see Hayes *v.* Bickelhaupt, 32 O. G. 133.

SUITS TOUCHING INTERFERING PATENTS.

SEC. 4918. Whenever there are interfering patents, any person interested in any one of them, or in the working of the invention claimed under either of them, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either of the patents void in whole or in part, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the right of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment.

The proceeding contemplated by this section is an ordinary proceeding in chancery. It is not a summary proceeding, it is an adversary proceeding, in which the party must file the usual bill in chancery and issue the subpœna required by chancery practice, see L. & M. Tobacco Co. *v.* Miller, 17 O. G. 798. A bill to annul a patent must be brought in the district in which the defendant resides or is found, see Prentiss *v.* Ellsworth, 27 O. G. 623. In such a suit the defendant is not compelled to file a cross-bill in order to

obtain affirmative relief, and if he does so it may be dismissed without costs, see Am. Clay Bird Co. *v.* Legowski Clay Pigeon Co., 31 Fed. Rep. 466. Upon such a suit the question of priority of invention is the only point in controversy, and judgment is awarded to the party which establishes the fact that he is the first inventor, or to the party who derives his title from the first inventor, see Sawyer *v.* Massey, 25 Fed. Rep. 144, and the court may declare either of the patents void, in whole or in part, or inoperative or invalid, and as to any particular portion of the United States, according to the interests of the parties in the patent, or the invention patented, see Foster *v.* Lindsay, 8 O. G. 1032. In such cases, the defendant's patent may be defeated, although the plaintiff's patent is void, being anticipated by his own prior patents, see American Clay Bird Co. *v.* Legowski Clay Pigeon Co., 31 Fed. Rep. 466. The judgment binds only the parties to the suit and their subsequent assignees, see Mowry *v.* Whitney, 1 O. G. 499. Two patents interfere within the meaning of this section when they claim the same invention in whole or in part, see Gold & Silver Ore Co. *v.* U. S. Ore Co., 3 Fish, 489.

Suits for Infringement; Damages.

Sec. 4919. Damages for the infringement of any patent may be recovered by action on the case, in the name of the party interested either as patentee, assignee, or grantee. And whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment thereon for any sum above the amount found by the verdict as the actual damages sustained, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs.

See Rev. Stat., Secs. 629, 690, 699, 711 and notes, *ante*.

Infringement Defined.—The statute confers upon the patentee and his assigns the exclusive right to make, to use, or to sell to others to be used, the patented article. An infringement is a copy made after and agreeing substantially and in principle with the article described in the letters patent. It is therefore an infringement to make or manufacture a patented article, though it is never used by the maker. It is likewise an infringement to sell to others the article when it is manufactured by another. The law vests the exclusive right to do all these three things in the patentee, and hence for another to do any one or all of them is an infringement, see Haselden *v.* Ogden, 3 Fish, 378. It is not necessary that the defendant's machine should be an exact copy of the patentee's machine. All that is required is that the defendant's machine should be substantially like the patentee's machine, see Waterbury Brass Co. *v.* N. Y. Brass Co., 3 Fish, 43; so long as the patentee's ideas are found in the construction and arrangement, no matter what may be its form, or shape, or appearance, the party using it is appropriating his invention, and must be held to be an infringer, see Potter *v.* Wilson, 2 Fish, 102. The question of infringement is one irrespective of motive. The defendant may have infringed without intending, or even knowing it, but he is not, on that account, the less an infringer, see Parker *v.* Hulme, 1 Fish, 44. An imperfect infringement, because the machine is imperfect, is still an infringement, Union Paper Bag Co. *v.* Binney, 5 Fish, 166.

The statute does not, and was not intended to operate beyond the limits of the United States. The patentee's right of property and exclusive use cannot extend beyond the limits of the law itself. The use of the invention beyond the limits of the United States is not an infringement of his rights. His rights do not extend to a foreign vessel entering one of our ports, and the use of the invention in the construction, fitting out, or equipment of such vessel while she is coming into or going out of a port of the United States, is not an infringement of the rights of an American patentee, provided it was placed upon her in a foreign port, and authorized by the laws of the country to which she belongs, see Brown *v.* Duchesne, 19 How. 183. The jurisdiction of the United States extends to the decks of American vessels on the high seas, however, as much as it does to all the territory of the country, and the use of a thing patented on such vessels is an infringement, see Gardiner *v.* How, 2 Cliff. 462.

Parties. Infringers.—Any person, whether natural or artificial, may infringe a patent. Even the government of the United States cannot employ an invention, or grant to others the right to practice it without the permission of the patentee, see James *v.* Campbell, 104 U. S. 356; Palmer *v.* U. S., 20 Ct. of Claims, 432. A municipal corporation or other public body is responsible for acts of infringement performed by its officers

and agents for its benefit, see Bliss *v.* City of Brooklyn, 4 Fisher, 596. A private corporation infringes by any act of its agents or employees, authorized or ratified by it, which wrongfully appropriates a patented invention, see Poppenhusen *v.* New York Gutta-Percha Comb Co., 2 Fisher, 62. How far the officers, stockholders, and employees of a private corporation participate in its infringing acts and share its liability is still an open question. A joint-owner of a patent may be an infringer if he employs an infringing device, see Millers Falls Co. *v.* Ives, 14 O. G. 203. An assignor or grantor who has parted with all his right to use an invention within a specified territory, becomes an infringer if he employs the invention within that territory, as does a grantee or licensee who practices the invention outside of the territory owned by him, and, as does either of the above parties who makes, uses or sells an infringing device. All private individuals who voluntarily engage in the unauthorized manufacture, use, or sale of a patented invention, whether by itself, or as part of some more comprehensive instrument or art, are guilty of an infringement. A voluntary maker is an infringer though he is employed by another to do so, see Bryce *v.* Dorr, 3 McLean, 582; a lunatic may infringe and be liable for profits and costs, see Avery *v.* Wilson, 20 Fed. Rep. 856; infants and married women are also liable for damages for infringement, see Robinson on Patents, § 947.

Parties. Who May Bring Suit.—The plaintiff must be the person or persons in whom the legal title to the patent vested at the time of the infringement, see Gamewell Fire Alarm Tel. Co. *v.* City of Brooklyn, 22 O. G. 1978, except where the right of action was assigned together with the title to the patent; in this case the present owner of the monopoly may bring suit for an infringement committed during the ownership of his assignor, as well as for infringements during his own ownership. It follows, therefore, that the patentee, his assignee, his grantee, or his personal representatives only are able to maintain an action for infringement in a court of law; neither licensees, see Birdsell *v.* Shaliol, 112 U. S. 485, nor those who, under contract with the legal owners, have acquired an equitable title to the patent, see Sanford *v.* Messer, 5 Fisher, 411, can maintain a suit for infringement of a patent in their own names; the patentee may sue in behalf of the licensee, see Goodyear *v.* McBurney, 3 Blatch. 32, or the licensee can sue in the name of his licensor, see Birdsell *v.* Shaliol, 30 O. G. 261, but in the latter case only for such infringements as affect his own rights under the patent, see Hayward *v.* Andrews, 23 O. G. 533. A stipulation by the licensor to sue infringers does not compel the licensees to look to him on his covenants, but they may institute suits in his name against infringers, see Goodyear *v.* Bishop, 2 Fisher, 96. If the owner of a patent will not sue or cannot be found, the licensee may use his name in a suit at law, and probably in equity also, see Wilson *v.* Chickering, 23 O. G. 1730. A patentee is not obliged to sue after an assignment of his rights, see Bicknell *v.* Todd, 5 McLean, 236.

Equitable owners of patents or of interests therein, can only obtain relief in a court of equity.

No legal title exists in any one until the patent issues, see Pontiac Knit Boot Co. *v.* Merino Shoe Co., 31 Fed. Rep. 89.

Until a patentee assigns his patent, or until it is vested in his executor or administrator at his death, all suits at law upon it must be brought in his name, see Wheeler *v.* McCormick, 4 O. G. 692. After he has transferred it he may still sue for infringements committed during his ownership, see Moore *v.* Marsh, 7 Wall, 515, and if his assignment covers only an undivided interest he must join with his assignee in suits arising out of subsequent infringements. In case of a joint patent, and in all cases of joint ownership, whatever be the exact relationship of the parties, all the patentees or co-owners must be made plaintiffs, see Moore *v.* Marsh, 7 Wall, 515; and this is so, even if one of two joint owners has assigned his interest since the infringement was committed, see Spring *v.* Domestic Sew. Mach. Co., 22 O. G. 1445.

An assignee of the entire interest must sue alone for any infringement committed during his ownership, see Suydam *v.* Day, 2 Blatch. 20. The grantee of an exclusive territorial interest must sue alone for any infringement committed within his territory during his ownership, see Hobbie *v.* Smith, 27 Fed. Rep. 665; the personal representatives of a deceased inventor must be the plaintiffs in an action for an infringement committed during their own ownership or that of their decedent, see Hodge *v.* North Missouri R. R. Co., 4 Fisher, 161. The right to damages for past infringements is assignable, and the assignee may sue and recover damages, see Hamilton *v.* Rollins, 3 Bann. & A. 157.

Jurisdiction.—The Federal Courts, *i. e.*, the Circuit Courts, District and Territorial Courts having Circuit Court powers, and the Supreme Court of the District of Columbia, have original and exclusive jurisdiction over all cases touching the validity, title, and infringement of patents, see Rev. Stat., Section 629; Willis *v.* McCollins, 33 O. G. 1017; Celluloid Mfg. Co. *v.* Goodyear Dental Vulcanite Co., 10 O. G. 41; Dale

Tile Mfg. Co. *v.* Hyatt, 43 O. G. 249; Duke *v.* Graham, 19 Fed. Rep. 647; Kayser *v.* Arnold, 41 Hun. 275; see also White *v.* Rankin, 144 U. S. 628; Elgin Wind, Power & Pump Co. *v.* Nichols, 65 Fed. Rep. 207. An appeal from an interlocutory decree, which grants, continues, refuses, dissolves or refuses to dissolve an injunction, may be taken to the Circuit Court of Appeals, for the circuit in which such decree was rendered, at any time within thirty days from the entry of the decree, see 28 Statutes at Large, chap. 96, p. 666. An appeal lies to the Circuit Court of Appeals from any final decree or decision of a United States Circuit Court, provided it is taken within six months after the entry of the decree, see 26 Statutes at Large, Sections 6 and 11, unless the decree is only for costs, see Du Bois *v.* Kirk, 158 U. S. 67, 1895. No appeal lies from any Circuit Court of Appeals to the United States Supreme Court, except actions brought by the United States to repeal patents, see United States *v.* Bell Telephone Co., 158 U. S. 548, 1895. Any Circuit Court of Appeals, may, however, certify to the Supreme Court any question of law upon which it desires the instruction of that court for its information; and the Supreme Court may send a certiorari to any Circuit Court of Appeals requiring any action in equity for infringement of a patent to be sent to the Supreme Court for review and determination, see 26 Statutes at Large, Chap. 517, Sec. 6.

An appeal lies to the Court of Appeals of the District of Columbia from any final decree of the Supreme Court of the District of Columbia, see 27 Statutes at Large, Chap. 74, Sec. 7, p. 435; and an appeal may also be demanded from the final judgment of that Court of Appeals to the Supreme Court of the United States in any case wherein the validity of a patent is involved, see 27 Statutes at Large, Chap. 74, Sec. 8, p. 436.

The State Courts have jurisdiction, the citizenship being the same, over all actions based on contracts between the parties, whether to compel their performance, to rescind them, or to award damages for their violation, see Wren *v.* Annin, 34 Fed. Rep. 435. Actions for breach of warranty, for fraud, for royalties or purchase money, and for the non-fulfillment of other collateral contracts, are also within their exclusive jurisdiction, see Willis *v.* McCollin, 38 O. G. 1017; Ingalls *v.* Tice, 14 Fed. Rep. 352. The Federal Courts have jurisdiction over these actions also if there is a difference in the citizenship of the opposing litigants, see Wren *v.* Annin, 34 Fed. Rep. 435; Meserole *v.* Union Paper Collar Co., 3 Fisher, 483. Every action in the Federal Courts should be instituted in that one of the Circuit Courts, or in one of these equivalent tribunals, whose local jurisdiction embraces the parties to the suit.

An action at law may be brought in any district where the defendant can lawfully be served with process, see Thompson *v.* Mendelson, 5 Fisher, 187; an action in equity praying for an injunction can be brought only in the district where the defendant resides or does business, or where the infringement takes place, see Wilson Packing Co. *v.* Clapp, 13 O. G. 368. Actions against the government of the United States for compensation, under licenses, real or implied, should be brought in the Court of Claims. Where the government uses the invention without the consent of the owner of the patent, suit should be brought against those agents of the government who personally committed the infringement, see Head *v.* Porter, 48 Fed. Rep. 481. Such suits are now almost always brought to the equity side of the court, for the reason that the plaintiff can in an equity action recover the defendant's profits as well as damages, see Emigh *v.* Railroad Co., 6 Fed. Rep. 283, while in an action at law damages only are recoverable; also for the further reason that the complainant is not compelled to go into the question of damages until the court has settled the question of the validity of the patent, and of its infringement. It should be observed, however, that legal rights must be enforced in a court of law, and that equity cannot interfere where there is an adequate remedy at law, see Root *v.* Lake Shore & Mich. Southern R. R. Co., 21 O. G. 1112.

PROCESS.—The process in an action at law for infringement does not differ from that employed in other actions. The declaration must contain all the averments necessary to set up the plaintiff's right and its violation, and be as broad as is needed to establish the plaintiff's right to recover, see Stanley *v.* Whipple, 2 McLean, 35. Of these essential averments there are five: (1) The invention of the patentable subject-matter by the plaintiff or his assignor; (2) The grant of letters-patent covering the invention; (3) The legal title of the plaintiff; (4) The infringement of the defendant; (5) The resulting damage to the plaintiff, see Robinson on Patents, § 949 and *post*.

The plaintiff must allege the performance of an inventive act, tendering an issue upon every point essential to the patentability of the invention, see Wilder *v.* McCormick, 2 Blatch. 31; but need not aver the date when the invention was made, except that it was made before the application for the patent was filed, nor allege the taking of the required preliminary steps, all these being presumed from the grant of the patent, see Cutting *v.* Myers, 4 Wash. 220; citizenship is not in issue though alleged, see Fischer

v. Neil, 19 O. G. 603. He must aver that the invention was not in public use or on sale in this country for more than two years before his application for the patent, see Gaudy *v.* Belting Co., 143 U. S. 592.

Under the second averment, the plaintiff must allege and describe the application of the inventor for a patent, its allowance by the Patent Office, and the issue of letters-patent thereon, specifying the nature of the invention which it purports to protect, and making profert of the patent, see Peterson *v.* Wooden, 3 McLean, 248; Cutting *v.* Myers, 4 Wash. 220; Pitts *v.* Whitman, 2 Story, 609; Wilder *v.* McCormick, 2 Blatch. 31; Bogart *v.* Hinds, 33 O. G. 1268.

Under the third averment, the exact title of the plaintiff must be set forth, as it appears, or can be made to appear upon the records of the Patent Office, see Gray *v.* James, 1 Robb, 140.

Under the fourth averment, he must allege the infringement of the patent by the defendant, by making, using or selling the invention therein described, withoutauthority from the owner of the patent. The breach of the patent must be stated as broadly as the right claimed in the patent, in order that it may appear that the acts of the defendant related to the precise invention thereby protected, see Cutting *v.* Myers, 4 Wash. 220; Parker *v.* Haworth, 4 McLean, 379; Wilder *v.* McCormick, 2 Blatch. 31.

Under the fifth averment, the damages sustained by the plaintiff should be set forth. No special statement of the methods in which the infringement has damaged the plaintiff need be averred, see Wilder *v.* McCormick, 2 Blatch. 31. Nominal damages are implied from the violation of the patent, see Poppenhusen *v.* N. Y. Gutta-Percha Comb Co., 2 Fisher, 62; actual damages must be proved, see Mayor of New York *v.* Ransom, 23 How. 487. In fixing the amount the jury cannot exceed the sum named in the declaration, see Winans *v.* N. Y. & Harlem R. R. Co., 4 Fisher, 1.

The language of the declaration is not severely scrutinized by the court, nor are objections to its modes of statement favored if it accomplishes the object for which it was intended. It must put the defendant in possession of all the facts upon which the plaintiff's case is based, and leave open to the defendant every legal defence within his right.

JOINDER OF PATENTS AND SUITS.—More than one patent may be included in the same suit, see Bates *v.* Coe, 15 O. G. 337, and separate suits between the same parties on separate patents, all infringed by the same machine, may be consolidated upon motion, see Deering *v.* Winona Harvester Works, 32 O. G. 654.

DAMAGES.—When the suit is at law, the rule is that the verdict of the jury must be for the actual damages sustained by the plaintiff, subject to the right of the court to enter judgment thereon for any sum above the verdict, not exceeding three times that amount, together with costs, see Birdsall *v.* Coolidge, 93 U. S. 64.

In equity suits the gains and profits are the proper measure of damage, except in cases where the injury sustained by the infringement is plainly greater than the aggregate made by the respondent, in which event the provision is that the complainant shall be entitled to recover, in addition to the profits to be accounted for by the respondent, the damages he has sustained thereby. The plaintiff in an equity proceeding is entitled to pray in one action for the relief both in regard to profits and damages, see Goodyear Dental Vulcanite Co. *v.* Van Antwerp, 9 O. G. 497. Nominal damages will be awarded when the amount of damages is not proven; if the plaintiff intends to claim more than nominal damages he must satisfy the jury what his actual damages are, see Poppenhusen *v.* N. Y. Gutta-Percha Co., 2 Fisher, 62. The character and financial condition of the parties are not to be considered in estimating damages, see Hayden *v.* Suffolk Mfg. Co., 4 Fisher, 86; nor does the good faith of the defendant excuse him, see Hogg *v.* Emerson, 11 How. 587. Only direct and immediate damages can be recovered, see Buerk *v.* Imhauser, 10 O. G. 907; remote consequential damages cannot be recovered, see Carter *v.* Baker, 4 Fisher, 404. Vindictive damages are not permitted, power being conferred upon the court to increase the amount fixed by the jury in case of malicious or persistent injury, see Whittemore *v.* Cutter, 1 Gallison, 478; Goodyear *v.* Bishop, 2 Fisher, 154.

INTEREST.—The interest allowable upon the items which compose the damages is computed from the time of the reception of the benefit or profits by the defendant, see Sickels *v.* Borden, 3 Blatch. 535; when, however, the amount of damages is based upon the injury directly inflicted on the plaintiff's own enjoyment of the invention, the date of the suit is the period at which the damages are complete and the interest begins, see May *v.* County of Fond du Lac, 27 Fed. Rep. 691. Whenever commencing, interest continues to the date of judgment and should be included in the amount awarded to the plaintiff, see McCormick *v.* Seymour, 2 Blatch. 240.

COSTS.—Costs are recoverable by all plaintiffs who secure judgments for infringement of patents, see Merchant *v.* Lewis, 1 Bond, 172, except: (1) when it appears on the trial that one or more of the claims of the patent are void for lack of being the subject of a patent, or for want of invention, or for want of novelty, and it appears that a proper disclaimer was not filed in the Patent Office before the commencement of the suit, see Rev. Stat., Secs. 973, 4917 and 4922; (2) where part of the patents sued upon are not recovered upon, see Adams *v.* Howard, 19 Fed. Rep. 319; Schmid *v.* Mfg. Co., 37 Fed. Rep. 348; (3) and where only a small part of the infringement alleged by the plaintiff is found by the verdict, see Marks Chair Co. *v.* Wilson, 43 Fed. Rep. 304. All items of cost are specified in the United States statutes, see Rev. Stat. 823, 983; The Baltimore, 8 Wallace, 392; Lyell *v.* Miller, 6 McLean, 422; Wooster *v.* Handy, 23 Fed. Rep. 60. No expenses, other than taxable costs, can be lawfully inserted in any cost bill, see Parks *v.* Booth, 102 U. S. 106. One attorney's docket fee is taxable in each case, see Dedekam *v.* Vose, 3 Blatch. 153; there is no warrant for taxing a separate docket fee for each of the plaintiff's attorneys, if there be more than one, nor with a separate docket fee for each term during which a case has been pending in court, nor for taxing any docket fee in favor of any attorney of the defeated party. The fees of the clerk of the court are in general taxable against the defeated party, but copies of the record ordered by a party for his own use, copies of pleadings, depositions or other papers which form parts of the records of cases are not so taxable. The fees of a commissioner or other magistrate for taking depositions are taxable if such depositions are offered in evidence and are admitted, see Fry *v.* Yeaton, 1 Cranch, 550; Hathaway *v.* Roach, 2 Woodbury & Minot, 75; Rev. Stat. Sec. 824. Witness fees are generally taxable, but are not so when the testimony is taken by deposition, and the latter is not offered, or if offered not admitted in evidence, see Rev. Stat. Sec. 848; Hathaway *v.* Roach, 2 Woodbury & Minot, 63; nor will the fees of more than three witnesses to one fact be taxable unless the court is satisfied by affidavit that the additional witnesses were really necessary, see Bussard *v.* Catalino, 2 Cranch, 421.

The costs are taxed by the clerks of the Circuit Court under the direction of the judges. If the defeated party is dissatisfied with the result the court will hear his motion for a retaxation, and if he shows ground for a claim of error the court will order the clerk to retax the costs, the mover giving the opposite party due notice of the time and place thereof, and paying the costs occasioned thereby. If either party is then dissatisfied with the result he may appeal to the court. All these proceedings must take place at the term in which the judgment is entered, see Blagrove *v.* Ringgold, 2 Cranch, 407.

PROFITS.—The profits made by the infringement of a patent may be recovered by suit in equity. The profits thus recoverable are the profits actually made by the defendant from that infringement, see Rubber Co. *v.* Goodyear, 9 Wallace, 801; and those which resulted directly, not indirectly from the infringement, see Piper *v.* Brown, 1 Holmes, 198. Where several defendants were joint infringers, but the profits were received by only part of them, the decree for profits will be rendered against those only of the defendants who realized them, see Elizabeth *v.* Pavement Co., 97 U. S. 140; and against each defendant for his own share of the profits only, see Covert *v.* Sargent, 38 Fed. Rep. 238. The generic rule for ascertaining the amount of the profits recoverable, is that of treating the infringer as though he were a trustee for the owner of the patent in respect of the profits realized by reason of the infringement, see Root *v.* Railway Co., 105 U. S. 214. In a suit in equity the court may by an interlocutory decree direct a master commissioner of the court to take and report an account of the defendant's profits, or appoint a master *pro hac vice* for that purpose. The complainant must then introduce evidence before such master to prove the amount of those profits. In the course of such accounting the master has full authority to do all acts and direct all proceedings which he may deem necessary and proper. His fees must be paid by the defendant when they accrue and be borne by him in the final taxation of costs, if he is finally defeated, but must be borne by the complainant if the bill is finally dismissed. Interest on infringer's profits is allowed from the date of the master's report, which ascertains the amount of those profits, see Tilghman *v.* Proctor, 125 U. S. 160.

PLEADING AND PROOF IN ACTIONS FOR INFRINGEMENT.

SEC. 4920. In any action for infringement the defendant may plead the general issue, and having given notice in writing to the plaintiff or his attorney, thirty days before, may prove, on trial, any one or more of the following special matters:

First. That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect; or

Second. That he had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; or

Third. That it had been patented or described in some printed publication prior to his supposed invention or discovery thereof; or

Fourth. That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; or

Fifth. That it had been in public use or on sale in this country for more than two years before his application for a patent, or had been abandoned to the public.

And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented, or to have had the prior knowledge of the thing patented, and where and by whom it had been used; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defenses may be pleaded in any suit in equity for relief against an alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect.

ACTIONS AT LAW.—In an action for infringement a defendant may plead either in abatement, by demurrer, or in bar. A plea in abatement should be filed whenever the defendant desires to object to the mode in which the proceedings have been instituted, if either the process or its service be faulty, or there be incapacity, misdescription, misjoinder or non-joinder of parties, or other actions pending between the same parties. The defendant may demur to the declaration either on account of formal defects or on the ground that it sets forth no cause of action.

DEFENSES. PLEADING.—The defenses which are pleadable in bar to an action are very numerous. Where the facts appear to warrant so doing, a defendant may plead:—

1st. That the matter covered by the letters patent was not a statutory subject of a patent:

2nd. That it was not an invention:

3rd. That the patented art or instrument did not result from the inventive act of its alleged inventor:

4th. That the alleged inventor was not the first inventor of the patented art or instrument:

5th. That it was not novel at the time of its alleged invention:

6th. That it was not useful at that time:

7th. That the inventor actually abandoned the invention:

8th. That he constructively abandoned it, by not applying for a patent on it, till more than two years after it was in public use or on sale in this country:

9th. That the alleged letters patent were in fact never granted:

10th. That the letters patent were not issued in conformity with the law:

11th. That the invention covered by the patent was not legally patentable:

12th. That the invention claimed in the original patent is substantially different from any indicated, suggested, or described in the original application therefor:

13th. That the patentee surreptitiously or unjustly obtained the patent for that which was in fact the invention of another, who was using reasonable diligence in adapting and perfecting the same:

14th. That the invention was made by another jointly with the sole applicant:

15th. That it was made by one only of two or more joint applicants:

16th. That for the purpose of deceiving the public, the description and specification filed in the Patent Office was made to cover less than the whole truth relevant to the invention, or was made to cover more than was necessary to produce the desired effect:

17th. That the description of the invention in the specification is not in such full, clear and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same:

18th. That the claims of the patent are not distinct:

19th. That the patentee unreasonably neglected to enter a needed disclaimer:

20th. That the original patent was surrendered and re-issued in the absence of every statutory foundation therefor:

21st. That the claims of the re-issue patent in suit are broader than those of the original, and that the re-issue was not applied for till a long time had elapsed after the original was granted:

22nd. That the re-issue patent in suit covers a different invention from any which the original patent shows was intended to be secured thereby:

23rd. That the invention claimed in the original patent is substantially identical with an invention claimed in a prior patent granted on the application of the same inventor:

24th. That the patent was repealed:

25th. That the patent legally expired before the alleged infringement began or before it ended:

26th. That the patentee made or sold specimens of the invention covered by his patent, without marking them "patented," and without notifying the defendant of his infringement:

27th. That the plaintiff has no title to the patent, or no such title as can enable him to maintain the action:

28th. That the defendant is a co-owner, or has a license, which authorized part or all of the doings which constitute the alleged infringement:

29th. That the defendant has a release discharging him from liability on account of part or all of the alleged infringement:

30th. That the defendant is not guilty of any infringement of the patent upon which he is sued:

31st. That the plaintiff is estopped from enforcing any right of action against the defendant:

32nd. That the cause of action sued upon is partly or wholly barred by some statute of limitation.

The defendant may avail himself of any or all of such of these defenses as are justified by the facts, unless he himself is estopped from urging them by his former act, or conduct, see Lindsay *v.* Stein, 21 O. G. 613; U. S. Rifle & Cart. Co. *v.* Whitney Arms Co., 11 O. G. 373. Where several patents constitute the basis of a single suit, each may be separately attacked by any of the methods of defense herein set forth, see Bates *v.* Coe, 15 O. G. 337; and in the same manner some claims of a patent may be infringed and not others, and each may be defended against, like a separate patent, see Kelleher *v.* Darling, 14 O. G. 673. As to the form in which these various defenses should be pleaded, the authorities appear irreconcilable, some holding that the greater number should be urged under the general issue, others requiring a notice or a special plea for nearly all of them. The general issue is a sufficient plea for all defenses which deny the existence of a cause of action in the plaintiff. Every defense which, admitting the former existence of a cause of action, claims that it has been extinguished by release, by estoppel or by a former judgment, belongs in the same class. The remaining defense which recognizes an existing cause of action, but avers that by reason of laches the plaintiff has lost his right to legal remedy, requires a special plea. But while the general issue may be permitted in the foregoing cases it is not necessary that the defendant should employ it. He may plead specially any or all of his defenses, except that which denies his performance of the infringing act, and this is always his proper course when he desires to tender a specific issue to be simply traversed by the plaintiff. (For a discussion of the relation of special pleas to the general issue, see Hubbell *v.* DeLand, 22 O. G. 1883; Robinson on Patents, §§ 986 to 993; Walker on Patents, 3rd ed., §§ 442 to 472.) The same matter cannot be presented both in a special plea and by a notice under the general issue, see Read *v.* Miller, 3 Fisher, 310.

When the defendant pleads the general issue, the plaintiff closes the pleadings with a *similiter*. If the defendant pleads specially, the plaintiff may either demur or traverse, or reply with new matter, as in other common-law actions, and thence the pleadings may

proceed until an issue of law or fact is reached. See Celluloid Mfg. Co. *v.* Am. Zylonite Co., 34 Fed. Rep. 744; Hayden *v.* Oriental Mills, 24 O. G. 601; Read *v.* Miller, 3 Fisher, 310.

NOTICES.—Notices of special matter must be in writing, and must be served on the plaintiff or his attorney at least thirty days before the trial of the case, see Cottier *v.* Stinson, 20 Fed. Rep. 906. It is not the purpose to oblige defendant to give notice of anticipating matter so that the plaintiff may tamper with the witnesses, but only to give him time to secure evidence in case the testimony of defendant is untrue.

Such notices must be sufficiently full as to facts, dates, and particulars, to relieve the plaintiff from unnecessary labor in searching for and finding prior patents or printed publications, when these are relied upon, and in case of prior knowledge or use, should state the names and residences of the persons alleged to have known or used the patented invention, see Silsby *v.* Foote, 14 Howard, 218. The names of witnesses, as such, need not be mentioned, see Planing Mach. Co. *v.* Keith, 101 U. S. 492. In equity the notice is given in the answer, and by amendment, under permission of the court the stringency of the rule as to service is sometimes avoided, see Carnrick *v.* McKesson, 19 Blatch. 369.

TRIALS IN ACTIONS AT LAW.—The trial of an action at law for infringement may be by a jury, by a judge, or by a referee. The first is the only proper one except where the parties agree to substitute one of the others. By a stipulation in writing, waiving a jury, filed by the parties with the clerk of the court, a case may be tried by a judge, see Rev. Stat. Sec. 649; and with the consent of both parties, a referee may be appointed by the court to try the case, see Heckers *v.* Fowler, 2 Wallace, 123. The rules of evidence which are used in the trial of patent causes are the ordinary rules of the common law, as modified by the statutes of the particular States in which such trials occur, see Vance *v.* Campbell, 1 Black, 427, and as adapted to the circumstances of patent litigation by the decisions of the United States Courts.

Trials by a judge without a jury require that the issues of law and the issues of fact are kept entirely distinct; his decisions on the former are reviewable by the Circuit Court of Appeals, while his finding of fact has the same operation as the verdict of a jury, see Rev. Stat. 649; St. Paul Plow Works *v.* Starling, 104 U. S. 197.

Trial by a referee requires that the referee hears and determines all the issues, decide the controversy, and report to the court. Such report may be special, setting forth the details of the evidence; or general, giving only the conclusions reached. Either party may except in writing, and upon the hearing of the objections, the court may adopt or reject the report and enter judgment accordingly, or recommit the report to the referee with further directions, see Heckers *v.* Fowler, 2 Wallace, 132.

JUDGMENTS IN ACTIONS AT LAW.—The verdicts of juries, findings of judges, or reports of referees are followed by a judgment in favor of the successful party; unless the first are set aside, the second reconsidered or modified, or the last rejected or recommitted. Judgments are entered by the clerk of the court under special or general authority of the judge, and when so entered are binding as the act of the court, see Heeker *v.* Fowler, 2 Wallace, 132.

NEW TRIALS IN ACTIONS AT LAW.—The Federal Courts have authority to grant new trials for the reasons recognized by other courts as sufficient to warrant such proceedings. For the grounds of new trial in general, see 1 Graham & Waterhouse, N. T. Introd. 1–502; 2, 1–50; 3 Bl. Com. pp. 378, 386–393. The reasons consist principally of error committed by either the court or jury during the former trial, such as the admission of improper evidence, or the rejection of proper evidence; departure from the law in instructing the jury, see Allen *v.* Blunt, 2 Robb, 530; a verdict against the evidence, see Wilson *v.* Janes, 3 Blatch. 227; misconduct on the part of the jury, or departure from the law or evidence in rendering the verdict, see Johnson *v.* Root, 2 Fisher, 291; or the discovery of new evidence that would probably change the result, see Starling *v.* St. Paul Plow Works, 41 O. G. 818; Spill *v.* Celluloid Mfg. Co., 29 O. G. 773. Mistakes and negligence of parties and counsel are not ground for new trial, see De Florez *v.* Raynolds, 16 Blatch. 397, and errors known to the party during trial are waived, unless excepted to, see Allen *v.* Blunt, 2 Robb, 530; nor will a new trial be granted in order to introduce immaterial evidence, see Spill *v.* Celluloid Mfg. Co., 29 O. G. 773; or new cumulative evidence, see Pfanschmidt *v.* P. H. Kelly Mercantile Co., 41 O. G. 1501.

WRIT OF ERROR IN ACTIONS AT LAW.—A writ of error from the judgment of a Circuit Court, whether the trial has been conducted with or without a jury, will carry any action at law, for an infringement of a patent, to the Circuit Court of Appeals for review, regardless of the amount involved, see West *v.* Barns, 2 Dallas, 401; Rev. Stat. Sec. 699; York & Cumberland R. R. Co. *v.* Myers, 18 Howard, 246, but no writ of

error can carry any question of fact to that court, see Heckers *v.* Fowler, 2 Wallace, 123. The sole office of this writ is to secure a review of the questions of law involved in the case, by that tribunal. Such an action at law decided in the Supreme Court of the District of Columbia may be taken by a writ of error to the Court of Appeals for the District of Columbia, see 27 Statutes at Large, Chap. 74, Sec. 7, p. 435; and if the validity of the patent is involved, the case may be taken from that court to the Supreme Court of the United States, see 27 Statutes at Large, Chap. 74, Sec. 8, p. 436. But actions at law for the infringement of patents cannot be taken from any Circuit Court of Appeals to the Supreme Court upon a writ of error; though any such Circuit Court of Appeals may certify to the Supreme Court any questions of law upon which it desires the instructions of that court for its proper decision; and the Supreme Court may send a certiorari to any Circuit Court of Appeals, requiring any case for infringement of a patent to be sent to the Supreme Court for its review and determination, see 26 Statutes at Large, Chap. 517, Sec. 6.

Bills of Exception in Actions at Law.—Bills of exception, properly allowed, signed, or sealed by the judge, constitute the only method by which the questions of law arising during the trial of a case, can be prepared for transmission to the Supreme Court in pursuance of a writ of error, see Insurance Co. *v.* Lanier, 95 U. S. 171. But a paper, incorporated in the record, having all the substantial characteristics of a bill of exceptions, will be treated as such, see Herbert *v.* Butler, 97 U. S. 319.

Actions in Equity.—Under preceding sections actions in equity have been considered side by side with actions at law, and their points of difference indicated. Some of the most important of these are now to be considered more at length. As we have already seen, see Root *v.* Lake Shore & Mich. Southern R. R. Co., 21 O. G. 1112, the distinction between law and equity is guaranteed by the Constitution; legal rights must be enforced in courts of law, and equity cannot interfere where there is an adequate remedy at law. A further principle has been established; if equity obtains jurisdiction for one purpose, it will exercise it as to all, see Burdell *v.* Comstock, 15 Fed. Rep. 395. As a result of these two principles, it follows that where equitable interference is necessary for the complete protection of the plaintiff, equity has jurisdiction for all purposes, and can hear and determine all the issues in the cause, see Magic Ruffle Co. *v.* Elm City Co., 11 O. G. 501. The test of equity jurisdiction is whether adequate remedy can be had at law, see McConihay *v.* Wright, 121 U. S. 201. The only function of actions at law in patent cases is to give damages for past infringements. The principal function of actions in equity is to restrain future infringements by means of the writ of injunction, and having acquired jurisdiction over the parties, and the subject matter of the controversy, equity will afford such further relief as the plaintiff may require, see Burdell *v.* Comstock, 15 Fed. Rep. 395. Equity has no jurisdiction over breach of contract, see Magic Ruffle Co. *v.* Elm City Co., 11 O. G. 501.

Parties in Equity.—In an action at law only a legal owner of a patent can bring suit; only the owner of an equitable title can resort to equity for relief, see Rogers *v.* Reissner, 41 O. G. 351. The parties to a suit in equity comprise all persons, natural or artificial, that can be affected by the decree, see Williams *v.* Bankhead, 19 Wall, 563. All legal owners of the patent, and all equitable owners who have been or would be injured by the infringement should be joined as plaintiffs, and if they refuse to sue as plaintiffs should be made defendants, see Jordan *v.* Dobson, 4 Fisher, 232, and they must sue in their own names. All parties participating in the infringement, whether natural or artificial, may be joined as defendants, their relation to each other being shown, see Shickle *v.* St. Louis Foundry Co., 22 Fed. Rep. 105.

Process in Equity.—The process in an action in equity does not differ materially from that employed in an action at law. The bill must disclose all that is necessary to set forth the plaintiff's rights and their violation by the defendant. The averments should cover every material fact, the court having no authority to consider what is proved and not alleged, or what is alleged and not supported by the evidence, see Pelham *v.* Edelmeyer, 25 O. G. 292. The five essential averments specified under Sec. 4919 as necessary in actions at law are no less necessary in actions in equity. The averment as to damages may be in general terms; that of profits must set forth such facts as to the mode in which the defendant has practiced the invention, and the benefits he has derived, as in connection with the other averments will show that there have been profits for which the plaintiff is entitled to an account, see Vaughn *v.* Cent. Pac. R. R. Co., 4 Sawyer, 280. The bill must close with a prayer for the relief desired, and the latter must be, in part at least, of such a character that equity alone can grant, see Dunham *v.* R. R. Co., 1 Bond, 492. The bill must be signed by counsel, and by a solicitor of the court in which it is filed,

see Equity Rule 24. An oath of the truth of the bill must be appended to such a document, if it prays for an injunction, see Rogers *v.* Abbott, 4 Wash. 514. The bill may be amended at any time before replication, upon motion, without notice, by order from any judge of the court, and at or after the hearing, at the discretion of the court.

DEFENSES. PLEADINGS IN EQUITY.—Defenses may be made to a bill by demurrer, by plea or by answer. The defenses which may be made to actions at law may all be made to actions in equity, and in addition the defendant may employ two other defenses: non-jurisdiction in equity and laches.

REPLICATIONS IN EQUITY.—A replication is required to be filed by the complainant, in order to put in issue those points wherein the answer disagrees with the bill. It must be filed on or before the rule day which next succeeds that upon which the answer is due and is filed, see Equity Rules, 45, 46. It may, if offered after that time, be allowed by the court to be filed *nunc pro tunc* as of the day upon which it was due, see Pierce *v.* West's Executors, 1 Peters' C. C. Rep. 351.

HEARING IN EQUITY.—The hearing of an action in equity for infringement of a patent, may take place before one of the judges of the court sitting alone, or before several judges sitting together, or before a judge and a jury, or before a master in chancery.

DECREES IN EQUITY.—An interlocutory decree is a decree in favor of the plaintiff upon the issues created by the bill and answer, and referring the cause to a master in chancery for account of profits and award of damages. Where the validity of the patent and the fact of infringement are admitted or proved, the plaintiff is entitled to a decree and account as a matter of course, see North Am. Iron Works *v.* Fiske, 89 O. G. 1086. Where one of several patents, or one or more claims of the same patent are found to be valid and to have been infringed a decree must be granted and an account ordered, see Tibbals *v.* Day, 11 Fed. Rep. 903; Matthews *v.* Lalance & Grosjean Mfg. Co., 17 O. G. 1284. Under a prayer for general relief the court may decree an account of profits, see Stearns *v.* Gladding, 17 How. 447. Profits and damages may be decreed though the right to an injunction be lost, see Kirk *v.* DuBois, 87 O. G. 102.

A final decree is one which terminates the litigation, awarding the plaintiff the profits, damages, and other relief to which he is entitled, or deciding the case upon its merits in favor of the defendant. A final decree cannot be granted until the cause has been decided upon its merits and, where an account is necessary, it has been taken by the master and reported to and accepted by the court, see Reeves *v.* Keystone Bridge Co., 9 O. G. 885. The defendant has a right to this decree if he proves any one of his special defenses, see Bates *v.* Coe, 15 O. G. 387. If no infringement is found the court will not pass upon the question of novelty and validity, see Saxe *v.* Hammond, 7 O. G. 781.

REHEARINGS IN EQUITY.—A rehearing may be ordered at any time between the interlocutory and final decree for the purpose of admitting new evidence or additional defenses, or on other sufficient ground, see Allis *v.* Stowell, 18 O. G. 465. It is wholly within the discretion of the court to allow a rehearing, see Am. Diamond Rock Boring Co. *v.* Sheldon, 1 Fed. Rep. 870, and the court will not allow it unless the matters presented would change the decree, see Brown *v.* Deere, 19 O. G. 1217, and unless the motion to re-open the decree is made with due diligence, see Bate Refrig. Co. *v.* Gillett, 40 O. G. 1029. After a final decree an application for a rehearing must, under Equity Rule 88, be made at the same term as the final decree is entered and recorded, if the case can be appealed to the Supreme Court, otherwise it may be permitted during the next succeeding term. When the time for a rehearing has expired, a final decree can only be set aside by an appeal or a bill of review, see Brown *v.* Deere, 19 O. G. 1217.

APPEALS IN EQUITY CASES.—Errors of fact or law committed by any Circuit Court may be corrected by appeal to the Circuit Court of Appeals. Such appeal should be taken within six months from the entry of the decree appealed from, see 26 Statutes at Large, Sections 6 and 11; when the appeal is to operate as a supersedeas, and thus stay execution, it should be taken within sixty days, and indeed an execution may be issued, if the appeal be not taken within ten days after the rendition of the decree, see Revised Statutes, Sections 1012 and 1007, but in such cases a supersedeas afterwards obtained will stay further proceedings under the execution, although it will not interfere with what has already been done, see Board of Commissioners *v.* Gorman, 19 Wallace, 663.

A final decision of a United States Court, of a collateral question, may also be appealed to the Circuit Court of Appeals, even while other questions are still pending and undecided in the Circuit Court, see Brush Electric Co. *v.* Electric Co. of San Jose, 51 Fed. Rep. 557.

On the hearing of an appeal the decree may be attacked and supported by the appellant and appellee respectively, upon any ground in the record, whether the Circuit

Court based its decision upon that ground or not, see Electric Gas Lighting Co. *v.* Fuller, 59 Fed. Rep. 1003; but the decree cannot be attacked on the ground that the Court made or refused to make any decision within the judicial discretion of the court to make or not, see Dean *v.* Mason, 20 Howard, 198; Jones *v.* Morehead, 1 Wallace 155; Roemer *v.* Bernheim, 132 U. S. 106.

Where either party desires the alteration of a decree, he must appeal whether the other party appeals or not, see Corning *v.* Troy I. & N. Factory, 13 Howard, 451. No decree can be attacked by the appellee on the appellant's appeal. Where both parties appeal, both appeals are heard together. A decree may also be attacked upon several grounds which were not considered in the lower court; non-jurisdiction of equity is one of them; want of invention is another, when that want results from facts of which the court can take judicial notice, see Brown *v.* Piper, 91 U. S. 41.

Bills of Review in Equity.—A final decree if unappealed from, or affirmed upon appeal, is conclusive as to all matters covered by it, unless it is reversed by a bill of review. Such a bill may be filed by leave of the court, for errors of law apparent on the record, and without such leave for errors in fact disclosed by the discovery of new evidence. As to the nature and object of a bill of review, see Story Eq. Pl. §§ 403–428. A bill of review based on errors of law follows the rules governing writs of error, see Clark *v.* Killian, 103 U. S. 766; and when based on errors of fact is governed by the same rules as a petition for a new trial, see Story Eq. Pl. §§ 412-419. A decree by consent cannot be set aside by a bill of review, unless the consent was obtained by fraud, see Pentlarge *v.* Beeston, 17 Blatch. 306.

Bill of Review in Equity.—Where the defendant dies pending suit, a bill of review may be filed against his representatives, see Hohorst *v.* Howard, 37 Fed. Rep. 97.

Bill to Perpetuate Testimony in Equity.—Where it is clear that certain evidence will be important on a future action which the proper plaintiff refused to commence, or which he cannot yet begin, and that, though now available, this evidence may at that time be beyond the reach of the petitioner, a bill to perpetuate testimony is required. The court, being satisfied that the allegations of the bill are true, will cause the testimony to be taken in some suitable manner, and preserved among the records of the court until needed at the trial. For discussion of the nature and object of this bill, and form of and proceedings thereunder, see Story Eq. Pl., §§ 1506–1516, 300–310.

Bill of Discovery in Equity.—This is a bill praying for the compulsory disclosure of certain facts within the knowledge of the respondent, or the production of certain documents or articles within his custody or control. See Story Eq. Pl., §§ 689–691, 1480–1504.

Power of Courts to Grant Injunctions and Estimate Damages.

Sec. 4921. The several courts vested with jurisdiction of cases arising under the patent laws shall have power to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for an infringement, the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby; and the courts shall assess the same or cause the same to be assessed under its direction. And the court shall have the same power to increase such damages, in its discretion, as is given to increase the damages found by verdicts in actions in the nature of actions of trespass upon the case.

In Patent Cases, Circuit Courts May Submit Questions of Fact to Jury.

Act of Feb. 16, 1875, *Sup. to R. S. vol.* 1, *p.* 136.

Sec. 2. That said courts [*U. S. circuit courts*], *when sitting in equity for the trial of patent causes, may impanel a jury of not less than five and not more than twelve persons, subject to such general rules in the premises as may, from time to time, be made by the Supreme Court, and*

submit to them such questions of fact arising in such cause as such circuit court shall deem expedient.

And the verdict of such jury shall be treated and proceeded upon in the same manner and with the same effect as in the case of issues sent from chancery to a court of law and returned with such findings.

The purpose of an injunction is to prevent prospective injury where no other adequate remedy exists; also to prevent a multiplicity of suits, see Brooks *v.* Miller, 28 Fed. Rep. 615. An injunction is the strong arm of the court; it is never to be used unless the court is convinced of its real necessity, see Potter *v.* Schenck, 3 Fisher, 821, but will issue whenever it is needed to protect rights, see Wilson *v.* Barnum, 2 Fisher, 635. The issue or refusal of a preliminary injunction is wholly within the discretion of the court, and from its decision there is no appeal, see Irwin *v.* Dane, 4 Fisher, 859. There can be no injunctions at law, see Motte *v.* Bennett, 2 Fisher, 642; only equity can prevent an invasion of rights, see McMillan *v.* Barclay, 5 Fisher, 189. Injunctions may be either preliminary, to compel a defendant to desist from his alleged infringing acts while the necessary investigations are being carried on in the courts, or perpetual, permanently prohibiting the defendant from the performance of acts which have been proven and adjudged to be in violation of the patent. On a motion for an injunction the only question is whether the plaintiff presents an undebatable case, see Goodyear *v.* Hills, 3 Fisher 134. Courts will not, as a rule, grant a preliminary injunction unless there has been some previous adjudication on, and sustaining the patent, where the same points of validity and infringement were in issue, or unless there has been a long and undisputed enjoyment of the monopoly under the patent, and the plaintiff is able to make it appear that the defendant's device and his own are substantially identical. A preliminary injunction ought never to be issued unless the right of the patentee is an established or an admitted one, and unless the alleged invasion of the right is proven beyond reasonable doubt, see Am. Nicholson Pavement Co. *v.* City of Elizabeth, 4 Fisher, 189; see also Shelly *v.* Brannan, 4 Fisher, 195.

Where a provisional injunction would operate unjustly upon the defendant, or when it would cause him irreparable injury, while the plaintiff could have ample satisfaction in money damages, the provisional injunction will be refused, see Earth Closet Co. *v.* Fenner, 5 Fish, 15.

A preliminary injunction will also be refused when the defendant will take a license, and this is the plaintiff's usual mode of profit, see Baldwin *v.* Bernard, 2 O. G. 320.

Acquiescence in an infringement may forfeit the right to relief in equity, see Kittle *v.* Hall, 39 O. G. 707. No injunction will issue where the plaintiff has been negligent in asserting his rights, see Keyes *v.* Pueblo Smelting and Refining Co., 31 Fed. Rep. 560, but a patentee is not guilty of laches while ignorant of the infringement, see Kilbourn *v.* Sunderland, 130 U. S. 505.

Plaintiffs are, however, chargeable with the laches of former owners of the patent, see Spring *v.* Domestic Sewing Mach. Co., 16 O. G. 721, and an assignee of claims for past infringements is bound by the laches of his assignor, see New York Grape Sugar Co. *v.* Buffalo Grape Sugar Co., 32 O. G. 1356.

If the defendant was misled by the silence or laches of the plaintiff, and embarked in enterprises which would be destroyed by an injunction, the court will recognize the estoppel and refuse an injunction, see Reay *v.* Raynor, 26 O. G. 1111. An effectual estoppel also exists where the plaintiff has violated his equitable obligations to the defendant, whether created by an express or implied contract, and has thereby placed the defendant in a position where his self-preservation compelled him to infringe, see Crowell *v.* Parmenter, 18 O. G. 860. Where, however, the validity of the patent, the title of the plaintiff, and the intention of the defendant to infringe are fully proved, and where there are no circumstances which render the grant of an injunction inequitable, the court will issue it without reluctance or evasion, see Poppenhusen *v.* N. Y. Gutta-Percha Comb Co., 2 Fisher, 74; Foster *v.* Crossin, 23 Fed. Rep. 400. A preliminary injunction will be denied, and the court may order that the defendant furnish a bond and a continuing account, when the validity of the patent is in dispute, and has never been adjudged, see Morris *v.* Shelbourne, 4 Fisher, 377; where the plaintiff has been negligent in enforcing his rights, see Jones *v.* Merrill, 8 O. G. 401; where the defendant's device is essential to his business, and is made under a later patent, though the plaintiff's patent is not disputed, if the defendant has acted in good faith, see U. S. Annunciator & Bell Tel. Mfg. Co. *v.* Sanderson, 3 Blatch. 184; where the injunction would injure the defendant more than it would benefit the plaintiff, see McCreary *v.* Penn. Canal Co., 5 Fed. Rep. 367; where the patentee has never used his invention or

permitted others to do so, see Hoe *v.* Knapp, 36 O. G. 1244; where the plaintiff grants licenses, or is guilty of laches misleading the defendant, see Westinghouse Air Brake Co. *v.* Carpenter, 32 Fed. Rep. 545; where the defendant is responsible and intends to defend the suit, see Am. Middlings Purifier Co. *v.* Christian, 3 Bann. & A. 42; where novelty is doubtful, see Heysinger *v.* Dennison Mfg. Co., 15 Phila. 509, or for any other cause that seems good and sufficient to the court.

The bond in such case should be sufficient to cover all probable losses to the plaintiff, and the account must so describe the articles sold or used by the defendant that any person acquainted with the business can fix their value and compute their profits, see Brown *v.* Shannon, 20 Howard 55; Wilder *v.* Gayler, 1 Blatch. 511.

An injunction may issue against any person, natural or artificial, an individual, firm, public or private corporation, prohibiting them from committing or promoting the infringement of a patent. Past injuries, however, are not a ground for injunction, and an injunction will not be issued against a defendant who, at the time of filing the bill, has parted with his interest in the infringing device, see Brammer *v.* Jones, 3 Fisher, 340, nor against the personal representatives of a deceased infringer, unless they manifest an intention to infringe, see Draper *v.* Hudson, Holmes 208, 3 O. G. 354.

An application for a preliminary injunction pending suit in equity may either be incorporated into the original bill or constitute a separate proceeding, see Allis *v.* Stowell, 23 O. G. 1033. An injunction in aid of a suit at law must be applied for in an independent motion, as if it were the only equitable remedy required. In any case the application must clearly set forth the plaintiff's right; its intended violation by the defendant, and pray for the immediate interference of the court. The facts should be set out in substantially the same manner as in an original bill for the recovery of damages or profits. The application must be supported by the oath of the plaintiff. The averments should show any former judgments sustaining the patent, or public acquiescence, or equivalent acts, see Gutta-Percha & Rubber Mfg. Co. *v.* Goodyear Rubber Co., 2 Bann. & A. 212. Due notice of a motion for a preliminary injunction must be served on the party sought to be enjoined before that motion will be heard, see Rules of Practice, U. S. Supreme Court, Rule 55.

The answer to an application for an injunction is subject to the same general rules as an answer to an original bill. If the defendant does not appear, the hearing will proceed *ex parte* on the application and the evidence presented.

The evidence on the hearing is presented by affidavits, see Brooks *v.* Bicknell, 3 McLean, 250.

Each party is allowed a reasonable time to inspect the affidavits of the other, and to prepare his own, and evidence not thus submitted to inspection cannot be regarded by the court. Affidavits filed after the stipulated date cannot be considered, see Am. Paper Barrel Co. *v.* Laraway, 37 O. G. 674.

If the defendant does not appear and answer, and the plaintiff has shown the issue of the patent and a judgment in his favor, or an acquiescence by the public, and a probable infringement by the defendant, an injunction will issue even though the court may have some doubt as to the validity of the patent, see Wells *v.* Gill, 2 O. G. 590, but an injunction will be denied if the patent is defective on its face, see Isaacs *v.* Cooper, 1 Robb. 332, or the title of the plaintiff is uncertain, or doubt whether there has been sufficient public acquiescence to raise a presumption in favor of the patent, see Guidet *v.* Palmer, 6 Fisher, 82.

Where an application is heard upon opposing evidence it will be decided upon broad views of the equitable rights of the parties. The plaintiff's affidavits must make a *prima facie* case for an injunction · the defendant, to overcome the presumption thus raised, must present testimony proving the existence of circumstances rendering the allowance of an injunction inexpedient, see Hovey *v.* Stevens, 2 Robb, 479.

The court has a wide latitude in granting preliminary injunctions, and may grant these unconditionally, or upon such other terms as it may seem fit to impose upon the parties, see Furbush *v.* Bradford, 1 Fisher, 317. The plaintiff may be required to give a bond of indemnity to secure the defendant against unwarranted inquiry, see Blake *v.* Boisselier 16 O. G. 854; or to secure him against loss in case the plaintiff's suit fails, or the injunction proves to be improper, see Consolidated Fruit Jar Co. *v.* Whitney, 1 Bann. & A. 356; and if the defendant prevails he can sue on the bond, see Tobey Furn. Co. *v.* Colby, 35 Fed. Rep. 592.

An injunction takes effect according to its terms, and is restricted in its effect to the persons and things named therein, see Welling *v.* Rubber Coated Harness Trimming Co., 7 O. G. 608; and remains in force so long as it may be needed, see Singer Sew. Machine Co. *v.* Union Button-Hole and Emb. Co., 4 O. G. 553; but limited to the life of the patent, see Nathan *v.* N. Y. Elevated R. R. Co., 2 Fed. Rep. 225, unless previously

recalled by the court, or superseded by some other judgment in the suit. It has no authority beyond the limits of the local jurisdiction of the court, see Goodyear *v.* Chaffee, 3 Blatch. 268, except when the defendant resides within the district so that he can be held accountable there for infringements wherever they may be committed, see Hatch *v.* Hall, 30 O. G. 1096.

The terms of the injunction may be modified from time to time, upon application to the court, as the interests of the parties may require, see DeFlorez *v.* Reynolds, 17 O. G. 503; and will be dissolved when it appears from the facts that such dissolution is warranted, see Young *v.* Lippman, 2 O. G. 249; Goodyear *v.* Bourn, 3 Blatch. 266; Cary *v.* Domestic Spring Bed Co., 30 O. G. 1158.

The remedy of the plaintiff for a violation of an injunction is by an application to the court for an order of attachment against the defendant, upon which, if found guilty, he may be subjected to fine or imprisonment, see Wetherell *v.* N. J. Zinc Co., 5 O. G. 460. The affidavits accompanying a motion for attachment must state the specific acts or omissions which constitute the contempt, and the interrogatories addressed to the defendant must be confined to these specific offences, but the defendant need not answer to matters charged on information and belief, and if he demurs to improper interrogations, he can recover his costs, see Parkhurst *v.* Kinsman, 2 Blatch. 76.

A clear case must be made out in proceedings for contempt, or an attachment will be granted, see Bate Refrig. Co. *v.* Gillett, 39 O. G. 833; Allis *v.* Stowell, 19 O. G. 727; Celluloid Mfg. Co. *v.* Chrolithian Collar & Cuff Co., 24 Fed. Rep. 585.

PERPETUAL INJUNCTIONS.—At the conclusion of a suit in equity, if a decree finds an infringement, a perpetual injunction will be ordered, see Potter *v.* Mack, 3 Fisher, 428, even though the infringement has been stopped, see Bullock Printing Press Co. *v.* Jones, 13 O. G. 124. The right to an injunction is independent of the right to profits or damages, see Colgate *v.* Int. Ocean Tel. Co., 17 O. G. 194.

A perpetual injunction is operative only during the life of the patent, except as to the use of articles constructed while the patent was in force, and capable of use after its expiry, see Nathan *v.* El. R. R. Co., 2 Fed. Rep. 225. Its suspension after final decree rests entirely within the discretion of the court which granted it, see Brown *v.* Deere, 19 O. G. 1287. A final injunction may issue upon a decree by consent of the parties, see Tomkinson *v.* Willett's Mfg. Co., 31 O. G. 918, but in such case no question upon the merits will be decided, see Am. Middlings Purifier Co. *v.* Vail, 15 Blatch. 315.

In case of a violation of the injunction the plaintiff may obtain redress in the mode already stated under preliminary injunctions.

APPEALS.—An appeal from an interlocutory decree which grants, continues, refuses, dissolves, or refuses to dissolve an injunction, may be taken to the Circuit Court of Appeals, for the circuit in which that decree was rendered, at any time within thirty days from the entry of such decree, see 28 Statutes at Large, Chap. 96, p. 666. Such an appeal will secure a review of that part of the decree which refers to an injunction; and the questions of validity and infringement, and whatever other questions may be involved touching the justice of the injunction, will be reviewed in this hearing.

SUIT FOR INFRINGEMENT WHERE SPECIFICATION IS TOO BROAD.

SEC. 4922. Whenever, through inadvertence, accident, or mistake, and without any willful default or intent to defraud or mislead the public, a patentee has, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof, which was bona fide his own, if it is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right, notwithstanding the specifications may embrace more than that of which the patentee was the first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff, no costs shall be recovered unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit. But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer.

This section is intended to provide a remedy for a defective patent, when a patentee has claimed more than he in fact invented. It provides a method whereby a plaintiff, in a suit for infringement, may avoid the defense that his patent claimed more than he invented, and enable him, in spite of such defect, to recover proper damages for any injury sustained by him by the infringement of his invention. Disclaimers under Secs. 4917 and 4922 rest on the same grounds, though used for different purposes, see Hailes *v.* Albany Stove Co., 42 O. G. 95. The first section contemplates disclaimers as proper whenever a patentee has claimed more than that of which he was the first inventor, while the last provides for disclaimer only in cases wherein the excess is a material and substantial part of the invention, and prescribes a penalty for a neglect to enter a disclaimer within a reasonable time. Unreasonable delay avoids the good effect of a disclaimer, see Tuck *v.* Bramhill, 6 Blatch. 95. The disclaimer should be filed as soon as its need is known. Delay in disclaiming cannot exist until its need is brought to the attention of the patentee, see Kittle *v.* Hall, 30 Fed. Rep. 230. See Sec. 4917 and notes, *ante*, as to disclaimers generally.

Patent Not Void on Account of Previous Use in Foreign Country.

Sec. 4923. Whenever it appears that a patentee, at the time of making his application for the patent, believed himself to be the original and first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country, before his invention or discovery thereof, if it had not been patented or described in a printed publication.

In Doyle *v.* Spaulding, 27 O. G. 300; 19 Fed. Rep. 744, Nixon, J., said: "After a careful consideration of the provisions of the three sections of the Patent Act which bear upon the subject (Secs. 4886, 4920, 4923), we are of the opinion that the use or a knowledge of the use of an invention in a foreign country by persons residing in this country will not defeat a patent which has been granted to a *bona fide* patentee who, at the time, was ignorant of the existence of the invention or its use abroad."

That foreign use is not prior use, see McFarland *v.* Spencer, 32 O. G. 893; Cornely *v.* Marckwald, 24 O. G. 498; but if the person claiming a patent derived his knowledge of the invention from such prior use, his claim must be denied on the ground that it is not his invention.

Extension of Patents Granted Prior to March 2, 1861.

Sec. 4924. Where the patentee of any invention or discovery, the patent for which was granted prior to the second day of March, eighteen hundred and sixty-one, shall desire an extension of this patent beyond the original term of its limitation, he shall make application therefor, in writing, to the Commissioner of Patents, setting forth the reasons why such extension should be granted; and he shall also furnish a written statement, under oath, of the ascertained value of the invention or discovery, and of his receipts and expenditures on account thereof, sufficiently in detail to exhibit a true and faithful account of the loss and profit in any manner accruing to him by reason of the invention or discovery. Such application shall be filed not more than six months nor less than ninety days before the expiration of the original term of the patent; and no extension shall be granted after the expiration of the original term.

Rules of Practice, 1892.—172 to 186.

The five sections of the Revised Statutes relating to extensions, viz.: §§ 4924 to 4928 inclusive, relate exclusively to the extension of such patents as were issued prior to March 2d, 1861. The Commissioner cannot, under the existing law, entertain an application to extend a patent, issued subsequent to that date, and all extensions heretofore granted have expired. Congress alone can now grant extensions of patents, and such extensions will be by way of a special legislative enactment. The Congress may condition such a grant upon the results of an inquiry to be made before the Commissioner. Rules of Practice Nos. 172-186 prescribe the manner of conducting such an inquiry.

What Notice of Application for Extension Must be Given.

Sec. 4925. Upon the receipt of such application, and the payment of the fees required by law, the Commissioner shall cause to be published in one newspaper in the city of Washington, and in such other papers published in the section of the country most interested adversely to the extension of the patent, as he may deem proper, for at least sixty days prior to the day set for hearing the case, a notice of such application, and of the time and place when and where the same will be considered, that any person may appear and show cause why the extension should not be granted.

See Note to Sec. 4924, *ante*.

Applications for Extension, to Whom to be Referred.

Sec. 4926. Upon the publication of the notice of an application for an extension, the Commissioner shall refer the case to the principal examiner having charge of the class of inventions to which it belongs, who shall make the Commissioner a full report of the case, stating particularly whether the invention or discovery was new and patentable when the original patent was granted.

See note to Sec. 4924, *ante*.

Commissioner to Hear and Decide the Question of Extension.

Sec. 4927. The Commissioner shall, at the time and place designated in the published notice, hear and decide upon the evidence produced both for and against the extension; and if it shall appear to the satisfaction of the Commissioner that the patentee, without neglect or fault on his part, has failed to obtain from the use and sale of his invention or discovery a reasonable remuneration for the time, ingenuity, and expense bestowed upon it, and the introduction of it into use, and that it is just and proper, having due regard to the public interest, that the term of the patent should be extended, the Commissioner shall make a certificate thereon, renewing and extending the patent for the term of seven years from the expiration of the first term. Such certificate shall be recorded in the Patent Office; and thereupon such patent shall have the same effect in law as though it had been originally granted for twenty-one years.

See note to Sec. 4924, *ante*.

Operation of Extensions.

Sec. 4928. The benefit of the extension of a patent shall extend to the assignees and grantees of the right to use the thing patented, to the extent of their interest therein.

See note to Sec. 4924, *ante*.

DESIGN PATENTS.

Patents for Designs Authorized.

Sec. 4929. Any person who, by his own industry, genius, efforts, and expense, has invented and produced any new and original design for a manufacture, bust, statue, alto-relievo, or bas-relief; any new and original design for the printing of woolen, silk, cotton, or other fabrics; any new and original impression, ornament, patent, [pattern] print, or picture to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication, may, upon payment of the fee prescribed, and other due proceedings had the same as in cases of inventions or discoveries, obtain a patent therefor.

Rules of Practice, 1892.—24, 79 to 84.

Designs Defined.—Two classes of patents are issued; mechanical patents, which cover the mechanical construction of a machine, instrument or device, or the steps of an art or process; and design patents, which protect the shape or surface configuration given to articles. A design is an appearance imparted to an object.

In *ex parte* Traitel, 25 O. G. 783, Butterworth, Com., said: "A design is merely a delineation of form or figure, either plane or solid—a shape or configuration. The construction of an article in accordance with that delineation is the materialization of the conception or design. The conception of a building of some particular shape, form, or configuration, and which is delineated on paper, is a design. The various shapes and figures which appear in colors on the surface of prints and carpets, are the expression of so many designs. The material out of which the building is constructed, whether of stone, wood, brick, or glass, forms no part of the design. The character of the material, whether velvet, cloth, cotton, or wool, upon which the designs find expression, forms no part of the design itself. The colors in which they find expression are of no possible importance in describing the design itself. A combination of red and blue and green may be beautiful, and the effect very desirable, but it forms no part of the design, but is the medium through which a design, which relates solely to form and configuration, finds expression or materializes." A design then, as the word is used in the statute, relates solely to the form, shape, or surface configuration which is given to some article or thing.

Requisites as to Patentability.—A design must be new and original, but need not be useful, see Miller *v.* Young, 33 Ill. 354. "Utility" in a design is the power to create agreeable sensations through the eye, see *ex parte* Schulze-Berge, 42 O. G. 293. "Novelty" is required in designs as in other inventions; to be patentable the design must not have been known or used by others before the applicants' invention or production thereof, or patented or described in any printed publication, see Northrop *v.* Adams, 12 O. G. 430; Niedringhaus *v.* Commissioner, 8 O. G. 279. As to identity of designs, Strong, J., in McCrea *v.* Holdsworth, 2 O. G. 592, said: "We hold, therefore, that if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same; if the resemblance is such as to deceive such an observer, inducing him to purchase one, supposing it to be the other, the first patent is infringed by the other." In the same case it was held: A design is an entirety, and any

substantial change, by addition, substitution, or re-arrangement, makes a new design. Thus though details may differ yet, if the impression produced upon the eye is the same, it is the same design, see Wood *v.* Dolbey, 20 O. G. 523. A design is not complete until reduced to practice. A new design may consist of a combination of old designs, see Kraus *v.* Fitzpatrick, 42 O. G. 1292, but a mere aggregation of old designs is not a new design, see Northup *v.* Adams, 12 O. G. 430. Where a new design is created by the exercise of the inventive faculties, and not otherwise, it is a patentable invention, see Western Electric Mfg. Co. *v.* Odell, 18 Fed. Rep. 321.

THE APPLICATION.—A complete application consists of :

(1) A petition, with power of attorney, if an attorney is appointed, signed by the applicant.

(2) A specification, signed by the applicant and two witnesses.

(3) A drawing, when the device can be represented in a drawing, which must be made in accordance with the rules relating to drawings for mechanical patents. In case the nature of the design is such that it cannot properly be represented by such a drawing, upon the recommendation of the examiner a photograph may be employed ; in this case the photograph must be mounted on bristol board ten by fifteen inches in size, having a single marginal line one inch from its edges. The applicant must also furnish twenty-five unmounted extra copies of such photograph.

(4) Oath, signed by applicant before a notary public, or a diplomatic or consular officer of the United States. The requirements as to execution are the same as for other applications.

(5) The fee required by law.

The specification must point out distinctly the characteristic features of the design, and carefully distinguish between what is old and what is believed to be new. The claims also, when the design admits of it, should be as distinct and specific as in the case of other applications ; if not, it may be an omnibus claim, claiming the design as shown and described, see Rule 81.

PROCEDURE.—The procedure in the patent office after the filing of the application, as to rejections, amendments, references, appeals, interferences, etc., is the same as in case of mechanical patents, see Rev. Stat, Sec. 4933, *post*. Rules of Practice, 1892.—81.

DECISIONS.—A prior patent for a design is not a bar to a patent for the same thing as a manufacture, unless it discloses the same complete and operative means, see Collender *v.* Griffith, 18 O. G. 241. The public use of an article with a design upon it is an abandonment of the design, see Theberath *v.* Rubber & Celluloid H. T. Co., 23 O. G. 1121. The doctrine of double use applies to designs, see Western Electric Co. *v.* Odell, 18 Fed. Rep. 321. The claims of a design patent should contain the phrase "as shown and described" so as to limit the patent to the exact design, see *ex parte* Gerard, 43 O. G. 1234. A claim for a design must not cover a mere function, see *ex parte* Diffenderfer, 2 O. G. 57. A claim for "the configuration of the design hereunto annexed when applied to carpeting" is proper, see Dobson *v.* Dornan, 35 O. G. 750. There can be no joinder of designs, see *ex parte* Gerard, 43 O. G. 1240. Two independent designs cannot be joined, see *ex parte* Beattie, 16 O. G. 266. The capability of being associated does not make two designs dependent, see *ex parte* Patitz, 25 O. G. 980. A design patent can cover but one design and such modifications of it as do not affect its identity, see *ex parte* Gerard, 43 O. G. 1240. The joinder of a combination design and its elemental designs is proper in the courts if the Patent Office will permit it, see Dobson *v.* Hartford Carpet Co., 31 O. G. 787. In the Patent Office the elements of a design cannot be joined with the design, see *ex parte* Gerard, 48 O. G. 1235. In an application for a design a claim for a separable part of it, which is not a complete design cannot be inserted, see *ex parte* Pope, 25 O. G. 290. The relation of genus and species does not exist in designs, see *ex parte* Gerard, 43 O. G. 1240.

Where a design patent is applied for when a mechanical patent alone is proper, the examiner, if the case is clear, should hold the application and notify the applicant ; but if the case, being doubtful, is examined and rejected, a new application must be filed and a new fee paid, see *ex parte* Bailey, 37 O. G. 781.

An application for a design patent should be rejected if the examiner considers that the subject matter is not a design, and from such rejection an appeal lies to the Board of Examiners, see *ex parte* Harris, 38 O. G. 104.

If in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same * * * the first one patented is infringed by the other, see Miller *v.* Smith, 18 O. G. 1047. A patent for a design is infringed by copying a part thereof, if that part is covered by the patent, see Dryfoos *v.* Friedman,

18 Fed. Rep. 824. A design may be infringed though a different name be given it, see Perry *v.* Starrett, 14 O. G. 699. A decree in an action for the infringement of a design patent may order an account of the profits and damages resulting from making and selling the article containing the design, see Dobson *v.* Dornan, 35 O. G. 750.

Models of Designs.

SEC. 4930. The Commissioner may dispense with models of designs when the design can be sufficiently represented by drawings or photographs.

Rules of Practice, 1892.—82.

Duration of Patents for Designs.

SEC. 4931. Patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant may, in his application, elect.

Rules of Practice, 1892.—80.

As there is no way in which the term of design patents may be extended, applicants should be careful to elect in their application the full term for which they desire protection.

Extension of Patents for Designs.

SEC. 4932. Patentees of designs issued prior to the second day of March, eighteen hundred and sixty-one, shall be entitled to extension of their respective patents for the term of seven years, in the same manner and under the same restrictions as are provided for the extension of patents for inventions or discoveries issued prior to the second day of March, eighteen hundred and sixty-one.

See Rev. Stat. Secs. 4924 to 4927, *ante*, for law relating to extension of mechanical patents.

See Rules of Practice, 1892.—172 to 186, for rules prescribing manner of conducting inquiry in Patent Office as to losses and profits.

No patents issued since March 2d, 1861, can be extended except by special act of Congress, consequently these sections of the law now have no force.

Patents for Designs Subject to General Rules of Patent Law.

SEC. 4933. All the regulations and provisions which apply to obtaining or protecting patents for inventions or discoveries not inconsistent with the provisions of this Title, shall apply to patents for designs.

Rules of Practice, 1892.—79 to 86.

Act Feb. 4, 1887, *U. S. Stat.*, *XXIV*, *pp.* 387, 388.

Unauthorized Use of Patented Design Unlawful.

CHAP. 105.—An act to amend the law relating to patents, trade-marks, and copyrights.

Be it enacted, etc., That hereafter, during the term of letters patent for a design, it shall be unlawful for any person other than the owner of said letters patent, without the license of such owner, to apply the design

secured by such letters patent, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or to sell or expose for sale any article of manufacture to which such design or colorable imitation shall, without the license of the owner, have been applied, knowing that the same has been so applied. Any person violating the provisions, or either of them, of this section, shall be liable in the amount of two hundred and fifty dollars; and in case the total profit made by him from the manufacture or sale, as aforesaid, of the article or articles to which the design, or colorable imitation thereof, has been applied, exceeds the sum of two hundred and fifty dollars, he shall be further liable for the excess of such profit over and above the sum of two hundred and fifty dollars; and the full amount of such liability may be recovered by the owner of the letters patent, to his own use, in any circuit court of the United States having jurisdiction of the parties, either by action at law or upon a bill in equity for an injunction to restrain such infringement.

See Rev. Stat. Secs. 629, 690, 699, 711, 978, 4919, 4920, 4921, and 4922, *ante*, and notes thereunder.

Remedy by Existing Law Not Impaired.

Sec. 2. That nothing in this act contained shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any owner of letters patent for a design, aggrieved by the infringement of the same, might have had if this act had not been passed; but such owner shall not twice recover the profit made from the infringement.

Approved, February 4, 1887.

See note to preceding section.

FEES.

Fees in Obtaining Patents, etc.

Sec. 4934. The following shall be the rates for patent fees:

On filing each original application for a patent, except in design cases, fifteen dollars.

On issuing each original patent, except in design cases, twenty dollars.

In design cases: For three years and six months, ten dollars; for seven years, fifteen dollars; for fourteen years, thirty dollars.

On filing each caveat, ten dollars.

On every application for the re-issue of a patent, thirty dollars.

On filing each disclaimer, ten dollars.

On every application for the extension of a patent, fifty dollars.

On the granting of every extension of a patent, fifty dollars.

On an appeal for the first time from the primary examiners to the examiners-in-chief, ten dollars.

On every appeal from the examiners-in-chief to the Commissioner, twenty dollars.

For certified copies of patents and other papers, including certified printed copies, ten cents per hundred words.

For recording every assignment, agreement, power of attorney, or other paper, of three hundred words or under, one dollar; of over three hundred and under one thousand words, two dollars; of over one thousand words, three dollars.

For copies of drawings, the reasonable cost of making them.

Rules of Practice, 1892.—217 to 218.

Mode of Payment.

Sec. 4935. Patent fees may be paid to the Commissioner of Patents, or to the Treasurer, or any of the assistant treasurers of the United States, or to any of the designated depositaries, national banks, or receivers of public money, designated by the Secretary of the Treasury for that purpose; and such officer shall give the depositor a receipt or certificate of deposit therefor. All money received at the Patent Office, for any purpose, or from any source whatever, shall be paid into the Treasury as received, without any deduction whatever.

Rules of Practice, 1892.—217 to 224.

Nearly all the fees payable to the Patent Office are positively required by law to be paid in advance—that is, upon making application for any action by the office for which a fee is payable. Rule 217 requires that all fees are payable in advance.

Refunding.

Sec. 4936. The Treasurer of the United States is authorized to pay back any sum or sums of money to any person who has through mistake paid the same into the Treasury, or to any receiver or depositary, to the credit of the Treasury, as for fees accruing at the Patent Office, upon a certificate thereof being made to the Treasurer by the Commissioner of Patents.

Rules of Practice, 1892.—224.

Money paid to the Commissioner of Patents by actual mistake, such as a payment in excess, or when not required by law, or by neglect or misinformation on the part of the office, will be refunded.

If an inventor files an incomplete application, paying the filing fee thereon, and does not complete the same within the term of two years prescribed by law, he may withdraw both application and fees. Such withdrawal may usually be made at any time after such filing, although a mere change of purpose on the part of the applicant, after the payment of money, as when a party desires to withdraw a complete application or an appeal, will not entitle a party to demand such a return as of right.

REPEAL PROVISIONS.

What Revised Statutes Embrace.

Title LXXIV, Rev. Stat., p. 1085:

Sec. 5595. The foregoing seventy-three titles embrace the statutes of the United States general and permanent in their nature, in force on the first day of December, one thousand eight hundred and seventy-

three, as revised and consolidated by commissioners appointed under act of Congress, and the same shall be designated and cited as The Revised Statutes of the United States.

Repeal of Acts Embraced in Revision.

Sec. 5596. All acts of Congress passed prior to said first day of December, one thousand eight hundred and seventy-three, any portion of which is embraced in any section of said revision, are hereby repealed, and the section applicable thereto shall be in force in lieu thereof; all parts of such acts not contained in such revisions having been repealed or superseded by subsequent acts, or not being general and permanent in their nature: *Provided*, That the incorporation into said revision of any general and permanent provision, taken from an act making appropriations, or from an act containing other provisions of a private, local or temporary character, shall not repeal, or in any way affect any appropriation, or any provision of a private, local or temporary character, contained in any of said acts, but the same shall remain in force; and all acts of Congress passed prior to said last-named day, no part of which are embraced in said provision, shall not be affected or changed by its enactment.

Accrued Rights Reserved.

Sec. 5597. The repeal of the several acts embraced in said revision shall not affect any act done, or any right accruing or accrued, or any suit or proceeding had or commenced in any civil cause before the said repeal, but all rights and liabilities under said acts shall continue, and may be enforced in the same manner, as if said repeal had not been made; nor shall said repeal in any manner affect the right to any office, or change the term or tenure thereof.

Prosecutions and Punishments.

Sec. 5598. All offenses committed, and all penalties or forfeitures incurred under any statute embraced in said revision prior to said repeal, may be prosecuted and punished in the same manner and with the same effect as if said repeal had not been made.

Acts of Limitation.

Sec. 5599. All acts of limitation, whether applicable to civil causes and proceedings, or to the prosecution of offenses, or for the recovery of penalties or forfeitures, embraced in said revision and covered by said repeal, shall not be affected thereby, but all suits, proceedings, or prosecutions, whether civil or criminal, for causes arising or acts done or committed prior to said repeal, may be commenced and prosecuted within the same time as if said repeal had not been made.

Arrangement and Classification of Sections.

Sec. 5600. The arrangement and classification of the several sections of the revision have been made for the purpose of a more convenient

and orderly arrangement of the same, and therefore no inference or presumption of a legislative construction is to be drawn by reason of the Title under which any particular section is placed.

Acts Passed since Dec. 1, 1873, Not Affected.

Sec. 5601. The enactment of the said revision is not to affect or repeal any act of Congress passed since the first day of December, one thousand eight hundred and seventy-three, and all acts passed since that date are to have full effect as if passed after the enactment of this revision, and so far as such acts vary from, or conflict with, any provision contained in said revision, they are to have effect as subsequent statutes, and as repealing any portion of the revision inconsistent therewith.

Approved June 22, 1874.

BINDING FOR PATENT OFFICE LIBRARY.

Restrictions as to Binding Not to Apply to Library of Patent Office.

Act Feb. 26, 1879. *Sup. to R. S. vol.* 1, *p.* 420. *R. S. ss.* 3785, 3790.

Be it enacted, etc., That the act entitled "An act making appropriations for sundry civil expenses of the Government for the fiscal year ending June thirtieth, eighteen hundred and seventy-nine, and for other purposes," approved June twentieth, eighteen hundred and seventy-eight, be, and the same is hereby, amended by adding to the clause of said act relating to the binding of books for the Departments of the Government, after the words "Congressional Library," the following words: "nor to the Library of the Patent Office," nor to the Library of the Department of State.

ABRIDGMENT OF PATENTS.

Classified Abridgment of Letters Patent.

Act of March 3, 1881. *Sup. to R. S., vol.* 1, *p.* 613.

Be it enacted, etc. [Section 1], That the sum of ten thousand dollars be, and the same hereby is, appropriated, out of any moneys belonging to the patent fund in the Treasury not otherwise appropriated, to be expended under the direction of the Commissioner of Patents in the preparation of classified abridgments of all letters patent of the United States.

How Printed and Distributed.

Sec. 2. That the said abridgments shall be printed, and one copy of each shall be furnished to each Senator, Representative, and Delegate in Congress; one copy to each of eight public libraries to be designated

by each Senator, Representative, and Delegate; and two copies to the Library of Congress; and also copies to such foreign Governments, libraries, and learned societies as the Commissioner of Patents may designate:

TO BE SOLD AT COST.

Provided, That copies shall be sold at the cost of printing, and all sums received from such sale shall, on or before the first day of each month, be paid into the Treasury.

PATENT RIGHTS VEST IN ASSIGNEE IN BANKRUPTCY.

WHAT PROPERTY VESTS IN ASSIGNEE.

SEC. 5046. All property conveyed by the bankrupt in fraud of his creditors; all rights in equity, choses in action, patent-rights, and copyrights; all debts due him, or any person for his use, and all liens and securities therefor; and all his rights of action for property or estate, real or personal, and for any cause of action which he had against any person arising from contract or from the unlawful taking or detention, or injury to the property of the bankrupt; and all his rights of redeeming such property or estate; together with the like right, title, power, and authority to sell, manage, dispose of, sue for, and recover or defend the same, as the bankrupt might have had if no assignment had been made, shall, in virtue of the adjudication of bankruptcy and the appointment of his assignee, but subject to the exceptions stated in the preceding section, be at once vested is [in] such assignee.

An assignment can be made only by the owner of the patented invention. Either a bankrupt court, or a court of equity, however, may have the power to compel the owner to transfer the ownership by an assignment to the receiver or trustee, and a court of equity, on his refusal, may treat the equitable rights as vested in the creditors, and appoint a trustee for the owner to convey the legal title, in his name and behalf, to the officer in charge of his bankrupt estate, but the title in all such cases is still derived from him on whom it was originally conferred, see *in re.* Keach, 14, R. I. 571; Pacific Bank *v.* Robinson, 20 O. G. 1314; Murray *v.* Ager, 20 O. G. 1311. That if an insolvent refuses to convey when ordered by the court, it may appoint a trustee to make the assignment, see Murray *v.* Ager, 20 O. G. 1311.

A patent cannot be seized and sold on execution, nor set off to a judgment creditor, see Carver *v.* Peck, 131 Mass. 291; nor does a patent vest 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, though he may convey the equitable title, see Adams *v.* Howard, 23 Fed. Rep. 656. Under this section of the statutes it has been decided that a right to the patents of the bankrupt vested in the trustee by virtue of his appointment, see Carver *v.* Peck, 131 Mass. 291, and that the rights of the trustee were superior to those of an assignee of record whose assignment was made by the bankrupt after the bankruptcy, see Prime *v.* Brandon Mfg. Co., 16 Blatch. 453; 4 Bann. & A. 379.

LABELS AND PRINTS.

Sections 3, 4, and 5 of the act of Congress, relating to patents, trade-marks, and copyrights, approved June 18, 1874 (18 Statutes at Large, p. 78), are as follows :

SEC. 3. That in the construction of this act the words "engraving, cut, and print" shall be applied only to pictorial illustrations or works connected with the fine arts, and no prints or labels designed to be used for any other articles of manufacture shall be entered under the copyright law, but may be registered in the Patent Office. And the Commissioner of Patents is hereby charged with the supervision and control of the entry or registry of such prints or labels, in conformity with the regulations provided by law as to copyrights and prints, except that there shall be paid for recording the title of any print or label, not a trade-mark, six dollars, which shall cover the expense of furnishing a copy of the record, under the seal of the Commissioner of Patents, to the party entering the same.

SEC. 4. That all laws and parts of laws inconsistent with the foregoing provisions be and the same are hereby repealed.

SEC. 5. That this act shall take effect on and after the first day of August, eighteen hundred and seventy-four.

Rev. Stat. Sec. 4952 A.

LABELS AND PRINTS DEFINED.—The words "prints" and "labels" as used in this act, so far as it relates to registration in the Patent Office, are construed as synonymous, and are defined as any device, picture, word or words, figure or figures (not a trade-mark) impressed or stamped directly upon the articles of manufacture, or upon a slip or piece of paper, or other material, to be attached in any manner to manufactured articles, or to bottles, boxes, and packages containing them, to indicate the contents of the package, the name of the manufacturer or the place of manufacture, the quality of goods, directions for use, etc.

By the words "articles of manufacture" (to which such print or label is applicable by this act) is meant all vendible commodities produced by hand, machinery, or art.

But no such print or label can be registered unless it properly belongs to an article of commerce, and be as above defined; nor can the same be registered as such print or label when it amounts to a lawful trade-mark, or when its use in connection with the article to which it is applied is arbitrary or fanciful. See Rules of Practice, Trade-marks and Labels, p. 21.

RESTRICTIONS ON REGISTRATION.—The registration of prints and labels is effected under the provisions of the copyright laws. Until recently, all forms of prints and labels, even when consisting solely of the name of the manufacturer or the place of manufacture, the quality or quantity of goods, or directions for use, have been registered by the Patent Office; but the Supreme Court has recently decided, see Higgins *et al*, *v.* Keuffel *et al*, 55 O. G. 1139, that to be entitled to copyright the print or label must have by itself some value as a composition or writing, 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.

The clause of the Constitution under which Congress is authorized to legislate for the protection of authors and inventors is contained in the eighth section of article one, which declares that—

"The Congress shall have power to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

The copyright act, and the act of June 18, 1874, under which labels are registered, are based upon this provision. The Supreme Court has therefore held in effect, that this provision has reference only to such writings and discoveries as are the result of intellectual labor, and that 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, are not proper subjects for registration.

Thus a label upon a box of fruit giving its name as "grapes" even with the addition of adjectives characterizing their quality as "black" or "sweet" would not be registerable. Should, however, the label contain an essay upon the culture of grapes, or any other matter relating to science or the useful arts, clearly the product and result of intellectual labor, the label would be entitled to copyright protection.

The registration of labels and prints has, in view of this decision, practically ceased.

APPLICANT, WHO MAY BE.—The benefits of the act seem to have been originally confined to citizens or residents of the United States, but have been extended by existing treaties to British, German, Italian and Belgian subjects, see Rules of Practice, Trade-Marks and Labels, p. 22.

NOVELTY REQUIRED.—In order to secure copyright protection for a label or print, it is necessary that the application for its registration be filed in the Patent Office on or before the date of the first publication of such label or print in this or any foreign country. A label or print that has been published cannot be copyrighted upon an application filed subsequent to the date of such publication, see Marsh *v.* Warren, 13 O. G. 7.

THE APPLICATION.—A complete application for the registration of a label or print consists of the following parts:

(1) An application addressed to the Commissioner of Patents, containing a reference to the label or print presented for registration; claiming its ownership; stating its title; containing a description thereof; and a request that the same be registered in the Patent Office.

(2) At least five copies of the label or print.

The application must be signed by the applicant. In case of a firm, the usual signature of the firm will be sufficient. If the applicant is a corporation, it should be signed in the name of such corporation by one of the principal officers thereof, who must add his own signature and title of office. His signature should be attested by the corporate seal of the company, see Rules of Practice, Trade-Marks and Labels, pp. 21, 22.

NOTICE OF COPYRIGHT REQUIRED.—The law requires that when the copyright of a label or print has been obtained, that due notice of such copyright shall be given to the public. All copyrighted labels or prints should therefore contain the following notification: "Copyrighted 1892, by A. B.," or as the case may be, stating the year the copyright was entered, and the name of the party by whom it was taken out, see Rev. Stat., Sec. 4962.

TERM OF REGISTRATION.—The term of protection is twenty-eight years, see Rev. Stat., Sec. 4953.

ASSIGNMENTS.—It is held that a registered label is, like a copyright, assignable by an instrument in writing. No particular form of assignment is prescribed, but the assignment should be presented for record within sixty days of its execution, otherwise it is liable to be held void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, see Rules of Practice, Trade-Marks and Labels, p. 22.

HISTORY OF THE TRADE-MARK LEGISLATION OF THE UNITED STATES.

While the right to the exclusive use of, and property in trade-marks, has always been recognized under the common law in the chancery courts, and by the statutes of some of the States, and the owners of trade-marks have been protected and upheld in such rights, the entire legislation of Congress in regard to trade-marks is of very recent origin, and it was not until July 8, 1870, that an attempt was made to recognize, regulate, and control this class of property, by legislative enactment of Congress.

The act of July 8, 1870, provided for the registration of any device in the nature of a trade-mark, to which any person had by usage established an exclusive right, or which the person so registering intended to appropriate by that act to his exclusive use; and they made the wrongful use of a trade-mark, so registered, by any other person without the owner's permission, a cause of action in a civil suit. The framers of this act however blundered in not confining its provisions to the kind of commerce over which Congress has control, viz.: that with foreign nations, among the several States, and with the Indian tribes, and the Supreme Court of the United States in deciding the cases United States *v.* Steffens; same *v.* Wittemann; same *v.* Johnson, held the act to be unconstitutional, see 10 Otto, 82–99.

In 1871, an act was passed to prevent the importation of watches, or parts of watches, bearing the counterfeit marks of manufacturers in this country.

In 1876 an act was passed to punish the counterfeiting of trade-mark goods, and the sale or dealing in counterfeit trade-mark goods.

On March 3, 1881, the present registration act was passed.

The act of August 5, 1882, is an amending act, but does not materially modify or affect the act of 1881 in any essential particular.

The act of 1871 was amended in 1883 so as to include all articles of manufacture within its prohibitory effects.

The act of October 1, 1890, provided for the marking of imported goods with the name of the country of origin.

The acts now in force are therefore the penal act of 1871; the registration act of 1881, the acts of 1876 and 1883 prohibiting the importation of goods bearing counterfeit marks, and the act of 1890, requiring goods to be marked with the name of the country of origin.

The full text of these acts, so far as they relate to trade-marks, will be found below:

CONSTITUTION.

The power of Congress to legislate on the subject of trade-marks, is found in the Constitution, the source of all the powers that Congress can lawfully exercise.

The third clause of Section 8, Article 1 of the Constitution provides:

"That the Congress shall have power to regulate commerce with foreign nations, and among the several States, and with the Indian tribes."

All the trade-mark legislation of the United States is founded upon this provision.

STATUTES.

AN ACT TO AUTHORIZE THE REGISTRATION OF TRADE-MARKS AND PROTECT THE SAME.

ACT OF MARCH 3, 1881.

Be it enacted by the Senate and House of Representatives of the United States in Congress assembled, That owners of trade-marks used in commerce with foreign nations or with the Indian tribes, provided such owners shall be domiciled in the United States or located in any foreign country or tribes, which, by treaty, convention, or law, affords similar privileges to citizens of the United States, may obtain registration of such trade-marks by complying with the following requirements:

First. By causing to be recorded in the Patent Office a statement specifying name, domicile, location, and citizenship of the party applying; the class of merchandise, and the particular description of goods comprised in such class to which the particular trade-mark has been appropriated; a description of the trade-mark itself, with fac-similes thereof, and a statement of the mode in which the same is applied and affixed to goods, and the length of time during which the trade-mark has been used.

Second. By paying into the Treasury of the United States the sum of twenty-five dollars, and complying with such regulations as may be prescribed by the Commissioner of Patents.

Rev. Stat. 4937.

For a definition of trade-marks see notes under Sec. 3.

APPLICANTS.—The applicant for registration may be a person, firm, or corporation. The United States has concluded arrangements for the reciprocal protection of trade-marks with the following countries, and upon the following dates:—Austria-Hungary, June 1, 1872; Belgium, July 30, 1869, and July 9, 1884; Brazil, Sept. 24, 1878; Denmark, October 12, 1892; France, April 16, 1869; German Empire, June 1, 1872; Great Britain

(including British Colonies so far as they grant reciprocal protection to citizens of the United States), July 17, 1878; Italy, March 19, 1884; Netherlands, Feb. 16, 1883; Russia, June 27, 1868; Servia, Dec. 27, 1882; Spain, April 19, 1883; Switzerland, May 16, 1883.

The United States is also a member of the International Convention, and residents, and persons having business establishments in countries belonging to this Union may obtain registration. The applicant must be the owner of the trade-mark, by reason of being the first to actually adopt and use the mark, or by reason of being the successor in right of the first person to so adopt and use the mark in commerce, see Swift *v.* Peters, 11 O. G. 1110.

The right to use a trade-mark depends upon its use, see Wm. Rogers' Mfg. Co. *v.* Rogers & Spurr Mfg. Co., 11 Fed. Rep. 495. Where a person has appropriated a particular trade-mark to distinguish his goods from other similar goods, he has a right of property in it which entitles him to its exclusive use, which equity will protect, see Hostetter *v.* Vowinkle, 1 Dillon 329; and this right exists independently of the registration of the trade-mark, see Sec. 10 and notes, *post*.

It should be noted, in this connection, that if an individual permanently ceases to use a trade-mark, and consents to its use and adoption by another, he relinquishes his right to it, see *ex parte* Kidd *et al*, 5 O. G. 337, and although a party shows that he once used a trade-mark, yet he must show a continuous use in order to establish a present right to it, see Jacobs *v.* Lopez, 23 O. G. 342.

THE APPLICATION.—A complete application consists of the following parts: (1) Letter of advice, with power of attorney, if an attorney is appointed, signed by the applicant; (2) Statement, signed by the applicant and attested by two witnesses. The statement should set forth (*a*) the name, domicile, and place of business, or location of the firm, or corporation, desiring the protection of the trade-mark, and the residence and citizenship of individual applicants; (*b*) the class of merchandise, and the particular description of goods comprised in such class, to which the trade-mark has been appropriated; (*c*) a description of the trade-mark itself, and the mode in which it has been applied, particularly pointing out the essential features of the mark; (*d*) the length of time during which the trade-mark has been used by the applicant on the class of goods described. This may be and usually is done by stating exactly or approximately the date upon which the mark was adopted. (3) A drawing of the trade-mark. This drawing must be furnished in every case which admits of it, and must conform to the rules for drawings of mechanical patents (see Rev. Stat. Sec. 4889, and notes). If, for any reason, such drawing does not constitute a satisfactory fac-simile of the trade-mark, two copies of the trade-mark, as actually used, must be deposited in addition to the required drawing, see Trade-Mark Rules of Practice, Rule 9. (4) A declaration (see following Section and notes).

EXAMINATION OF APPLICATIONS.—PROCEDURE IN PATENT OFFICE.—All applications for registration are examined in the first instance by the trade-mark examiner. A thorough examination is made to ascertain whether the trade-mark is identical with, or so closely resembles the trade-mark of any prior registrant as to be likely to cause confusion in the mind of the public, or to deceive purchasers. If the trade-mark is found to be novel, and it appears that it is used by the applicant in commerce between the United States and some foreign nation or Indian tribe, the examiner causes a letter of allowance to be sent to the applicant, and the certificate of registration follows in due course of business—about three weeks. If it appears that the identical trade-mark, or some mark closely resembling it has been registered to another, the applicant will be so advised. The applicant may amend the statement to correct informalities, or to avoid objections made by the office, or for other reasons arising in the course of the examination; but no amendments will be admitted unless warranted by something in the statement, or fac-simile, or drawing, as originally filed. In respect to amendments, the established rules in regard to applications for patents, will be observed (see Rev. Stat., Secs. 4888 and 4893, and notes, *ante*).

The declaration cannot be amended. If that filed with the application is faulty or defective, a substitute declaration may be filed.

APPEALS.—The applicant may appeal to the Commissioner in person, from an adverse decision of the examiner of trade-marks, who will review the case upon petition, sustaining or reversing the decision of the examiner, see Trade-Mark Rules of Practice, Rules 10 and 13.

REGISTRATION LIMITED TO A SINGLE CLASS.—The first adopter of a mark only acquires the exclusive right to its use, in connection with the specific class of goods to which he has applied it, see *ex parte* Bochm & Co., 8 O. G. 319; Carroll *v.* Ertheiler,

1 Fed. Rep. 628; Hecht *v.* Porter, 9 Pac. Coast L. J. 569. Having adopted and registered the mark for a specific class, he is entitled to its exclusive use upon the different articles belonging to that class, which he may manufacture or sell, see The Collins Co. *v.* Oliver Ames & Sons' Corp., 20 Blatch. 542; The Amoskeag Co. *v.* Garner, 6 Abb. Pr. (N. S.) 265. A registrant should enumerate in his statement all the articles to which he applies his mark, and must file a separate application for each separate class for which he desires to register the mark.

It is not uncommon for the same mark to be registered in different classes by a number of different owners, thus the word "Star" has been used for iron, shirts, lead pencils, oil, soap, agricultural implements, cutlery and dry goods.

Classification of Registered Trade-Marks.

1. Agricultural implements. (See Title 41, 73.)
2. Baking powder and yeast.
3. Beverages. (See Title 42.)
4. Blacking and leather dressing. (See Title 12.)
5. Boots, shoes and lasts. (See Title 57.)
6. Brooms and brushes.
7. Buttons. (See Title 22.)
8. Canned goods. (See Title 16, 26.)
9. Carpets, &c.
10. Cement, plaster, and bricks.
11. Cigars and cigarettes. (See Title 71.)
12. Cleaning and polishing preparations. (See Title 4.)
13. Coffee and tea.
14. Confectionery.
15. Corsets. (See Title 75.)
16. Cured meats. (See Title 8, 26, 37.)
17. Cutlery and edge tools. (See Title 73, 68.)
18. Dairy products.
19. Dentistry.
20. Drugs and chemicals. (See Title 44, 53, 72.)
21. Dry goods. (See Title 22, 69.)
22. Fancy goods. (See Title 7, 21, 30, 47.)
23. Fertilizers.
24. Fire arms, ammunition and explosives.
25. Flour.
26. Food and relishes. (See Title 8, 16.)
27. Fuel.
28. Games and toys. (See Title 46.)
29. Glassware. (See Title 32, 55.)
30. Gloves. (See Title 22.)
31. Headwear.
32. Household articles. (See Title, 29, 35, 55.)
33. Inks. (See Title 65.)
34. Iron, steel, and manufactures. (See Title 41, 73.)
35. Jewelry and plated wear. (See Title 32, 70.)
36. Lamps, lanterns, &c. (See Title 29.)
37. Lard and tallow. (See Title 16.)
38. Laundry articles. (See Title 61, 64.)
39. Leather and saddlery.
40. Locks and hardware. (See Title, 72, 73.)
41. Machines. (See Title 1, 34, 73.)
42. Malt Liquors. (See Title 3.)
43. Matches.
44. Medical compounds. (See Title 20, 53, 72.)
45. Miscellaneous.
46. Musical instruments. (See Title 28.)
47. Needles and pins. (See Title 22.)
48. Oils and lubricants. (See Title 51.)
49. Optics and measuring instruments. (See Title 73.)
50. Packing. (Machinery.)
51. Paints and painters' supplies. (See Title 48.)
52. Paper and envelopes. (See Title 65.)
53. Poisons for animals. (See Title 20, 44.)
54. Publications.
55. Receptacles. (See Title 29, 32.)
56. Rope, cord, and twine. (See Title 59.)
57. Rubber goods. (See Title 5, 69.)
58. Sewing machines and attachments. (See Title 41, 73.)
59. Sewing silk, cotton and thread. (See Title 56.)
60. Shirts, collars and cuffs. (See Title 75.)
61. Soap. (See Title 38, 72.)
62. Spices, mustard and salt. (See Title 26.)
63. Spirituous liquors. (See Title 42, 77.)
64. Starch, corn-starch, and products. (See Title 26, 38.)
65. Stationery miscellany. (See Title 33, 52.)
66. Stoves and heaters.
67. Sugar, syrup and molasses.
68. Surgical instruments and appliances. (See Title 17.)
69. Tailoring and clothing. (See Title 21, 57.)
70. Time-keeping instruments. (See Title 35.)
71. Tobacco and snuff. (See Title 11.)
72. Toilet articles and preparations. (See Title 20, 61.)
73. Tools and devices.
74. Umbrellas, parasols, and canes.
75. Underwear and furnishing. (See Title 15, 60.)
76. Vehicles.
77. Wines. (See Title 3, 42, 63.)

Fees.—No portion of the fee is returnable if the application for registration is finally rejected. There are no taxes or subsequent payments required after the fee of twenty-five dollars paid upon the filing of the application, except upon the renewal of the registration at the expiration of the first term of thirty years. Money paid by

actual mistake, such as a payment in excess, or when not required by law, or by neglect, or mis-information on the part of the office, will be refunded; but a mere change of purpose after the payment of money, as when a party desires to withdraw his application for the registration of a trade-mark, will not entitle a party to demand such a return.

See Appendix, Trade-Mark Rules of Practice, Rule 215.

SEC. 2. That the application prescribed in the foregoing section must, in order to create any right whatever in favor of the party filing it, be accompanied by a written declaration verified by the person, or by a member of a firm, or by an officer of a corporation applying, to the effect that such party has at the time a right to the use of the trade-mark sought to be registered, and that no other person, firm, or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that such trade-mark is used in commerce with foreign nations or Indian tribes, as above indicated; and that the description and fac-similes presented for registry truly represent the trade-mark sought to be registered.

The declaration called for by this section must be signed and sworn to by the applicant in his own name, if the applicant be an individual; by a member of the firm, if the owner of the trade-mark be a firm; by one of the principal officers of the corporation, if the owner be a corporation. The oath may be taken within the United States before a notary public, justice of the peace, or the judge or clerk of any court of record, and must be attested by the official seal of the officer administering the oath; if he has no seal the officer's official character must be established by competent evidence, as by a certificate from a clerk of a court of record, or other proper officer having a seal. In any foreign country it may be taken before a diplomatic or consular officer of the United States, a notary public (see however note to Sec. 4896, Patents, *ante*, as to countries in which notaries public may not administer oaths), or before any person duly qualified by the laws of the country to administer oaths, whose official character shall be certified by a representative of the United States, having an official seal, see Trade-Mark Rules of Practice, Rules 7, 8 and 47. The officer administering the oath should, in all cases, affix his official seal.

SEC. 3. That the time of the receipt of any such application shall be noted and recorded. But no alleged trade-mark shall be registered unless the same appear to be lawfully used as such by the applicant in foreign commerce or commerce with Indian tribes, as above mentioned, or is within the provision of a treaty, convention, or declaration with a foreign power; nor which is merely the name of the applicant; nor which is identical with a registered or known trade-mark owned by another, and appropriate to the same class of merchandise, or which so nearly resembles some other person's lawful trade-mark as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers. In an application for registration the Commissioner of Patents shall decide the presumptive lawfulness of claim to the alleged trade-mark; and in any dispute between an applicant and a previous registrant, or between applicants, he shall follow, so far as the same may be applicable, the practice of courts of equity of the United States in analogous cases.

TRADE-MARKS DEFINED.—The statute does not define the word "trade-mark" or say of what a trade-mark shall consist. The term is used as though its signification were already well known in the law.

It will be observed that the statute only requires four things:

(1) That the trade-mark is lawfully used as such by the applicant in commerce with foreign nations or Indian tribes; or be within the provisions of a treaty, convention, or declaration with a foreign power;

(2) That the trade-mark shall not be merely the name of the applicant;
(3) Nor identical with a registered or known trade-mark owned by another, and appropriated to the same class of merchandise; and
(4) And that it must not so nearly resemble some other person's lawful trade-mark as to be likely to cause confusion or mistake in the mind of the public, or deceive purchasers. Within these limits then, the law and the decisions of the courts, furnish the guide as to what may, and what may not constitute a lawful trade-mark.

The right to registration is founded on the adoption of a proper trade-mark, not the property of another party, and the declared intention to use it, see *ex parte* Rothschild, 7 O. G. 220; it is no bar to the registry of a trade-mark that it has already been used as such on articles of a different character, see *ex parte* English, 3 Dec. Com. 142; it is only necessary that the trade-mark shall be so far original as that when known in the market the goods of one merchant or manufacturer may be distinguished from those of another, see *ex parte* Porter Blanchard's Sons, 3 Dec. Com. 97; *ex parte* Roberts, 3 Dec. Com. 100.

In general it may be said that anything which can serve to distinguish one person's goods from those of another, such as tokens, letters, figures, signs, seals, names, ciphers, monograms or pictures, may be used for a trade-mark, see Shaw Stocking Co. *v.* Mack, 12 Fed. Rep. 707.

It may be a symbol or emblem, unmeaning in itself, such as a cross or a star, a bird, castle, quadruped or sun, or a combination of various objects, as pictures, letters and figures, words and monograms, copied from nature, art or fancy. It may be adhesive or non-adhesive; put inside or on the outside of the article. It may be written, printed, stamped, embossed, stencilled, branded, painted, or otherwise, and on the article itself, or on its case, covering, envelope or wrapper. Browne on Trade-Marks, § 87.

Where a manufacturer uses a particular stamp or brand, or puts up his goods in a peculiar manner so that they are known to purchasers chiefly by the appearance of the package, he will be protected in the use of such stamp or brand, see McLean *v.* Fleming, 6 Otto, 245; in the shape, color, and label of packages, see Sawyer *v.* Horn, 4 Hughes, 239; and in the color, shape, and print of a wrapper, see Sawyer *v.* Kellogg, 7 Fed. Rep. 720.

There are restrictions, however, that should be noted. This section provides that the mere name of the applicant cannot be registered. His autograph may be, however, see Browne on Trade-Marks, § 204; so, too, a fac-simile of an autograph, or the name written, printed, branded or stamped, in a mode peculiar to itself, may constitute a legal trade-mark. Browne on Trade-Marks, § 87.

Generic names, and words descriptive of quality are common property, and no one can have a right to an exclusive use of them, see *ex parte* Hathaway, 3 Com. Dec. 284.

Initial letters and dates add nothing to a phrase which is not a lawful trade-mark without them, see *ex parte* J. G. Johnson & Co., 3 O. G. 315.

The registration of the mere name of a person, firm, corporation, place, or article, or a word or words indicating kind or quality, will be refused, see Rowe & Post, 9 O. G. 496; Eagle Pencil Co., 10 O. G. 981; Dundas Dick & Co., 10 O. G. 981. The name of a person cannot be registered as a trade-mark, although it is accompanied by a mark sufficient to distinguish it from the same name when used by others, see Adriance Platt & Co., 20 O. G. 1830. If the name of a patentee has become a generic name to describe the thing patented, the owner of the patent cannot have the name registered as a trade-mark, see Consolidated Fruit Jar Co., 14 O. G. 269.

A geographical name can not be registered as a trade-mark, see *ex parte* Farnum & Co. 18 O. G. 418, and this is so even though it is joined with something else, see *idem*. The word "London" cannot be registered as a trade-mark if its application is either descriptive or deceptive, see *ex parte* Knapp, 16 O. G. 318. The word "Raleigh" cannot be registered as a trade-mark for manufactured tobacco, see *ex parte* Oliver, 18 O. G. 923.

If a trade-mark so nearly resembles a prior, registered trade-mark as to be calculated to deceive the public, it cannot be registered, see Weisert Bros. 16 O. G. 680. A person has no right to employ a sign or symbol which, from the nature of the fact it is used to signify, others may employ with equal truth, and therefore with equal right, see Pratt & Farmer, 10 O. G. 866.

A trade-mark that is descriptive or deceptive cannot be registered, see *ex parte* Smith 16 O. G. 679; nor can a word which is descriptive of the quality of the article, be used as a trade-mark, see Goodyear Rubber Co. 11 O. G. 1062, although a word which is merely inferentially or remotely descriptive, may sometimes be registered, see *ex parte* Heyman, 18 O. G. 922. So the word "crystalline" cannot be registered as a trade-mark for artificial stones, see *ex parte* Kipling 24 O. G. 899, nor can a barrel constructed of light and dark staves alternately, be registered as a trade-mark for packages of flour, see *ex parte*

Holliday Bros. 16 O. G. 500, because they are, when so used, descriptive of the article. The word "evaporated" is at once generic and descriptive, and cannot be registered, see *ex parte* Alden, 15 O. G. 889. And for the same reason the word "swing" as applied to the socket of a scythe snath, see Thompson, Derby & Co., 16 O. G. 187, and the word "safety" as applicable to powder, fuse lighters and explosive caps, see Safety Powder Co., 16 O. G. 186, cannot be registered.

A device which does not perform the sole office of a trade-mark, but enters into the mechanical structure of the articles, cannot be registered as a trade-mark, see *ex parte* Gordon, 12 O. G. 517; nor can a simple outline figure surrounding words purely descriptive of the quality of the article, see *ex parte* G. W. Rader & Co., 13 O. G. 596.

The thing of value in the matter of registration is the trade-mark itself. No protection is afforded for the use of scrolls, fanciful figures, or other words which are not an essential part of the mark, and a full description of them will not be allowed, see *ex parte* Kimball, 11 O. G. 1109.

No person is entitled to a trade-mark in a numeral, which only indicates but does not express the quality of the goods, but if a person uses a numeral of a certain form, size, color and style, he may be entitled to use that as a trade mark, see Kinney v. Allen, 1 Hughes, 106.

A word which has been registered by another cannot be registered as an essential element in a trade-mark, see Strasburger & Co., 20 O. G. 155, nor can the minor non-essentials of a composite symbol of trade be registered, see *ex parte* Coats, 16 O. G. 544.

A combination of two symbols cannot be registered if each has been previously registered separately, see *ex parte* Smith, 16 O. G. 679, but a combination of two symbols may be registered, although another has previously registered one of them as a trade-mark for the same article, see Cornwall *et al*, 12 O. G. 138.

The symbols and emblems of secret and other organizations may be registered as a trade-mark, see *ex parte* Thomas, 14 O. G. 821.

If the use of a name is entirely fanciful and arbitrary, the same may be registered as a trade-mark, see Pace, Talbott & Co., 16 O. G. 909.

A waved band of ribbon attached to a cigar box may be registered, see Straiton & Storm, 18 O. G. 923.

A newly coined word may be registered as a trade-mark, though it is suggestive of the material from which the article stamped with it is made, see Francis & Mallon, 3 Dec. Com. 283.

It is no objection to a trade-mark that the several parts of which it is composed have been used separately, provided it is so distinct as not to deceive or mislead the public, see *ex parte* Imbs, 10 O. G. 463.

It is sufficient if a trade-mark has an original and a distinctive signification as appertaining to the article, see India Rubber Comb Co., 8 O. G. 905.

If an arbitrary mark or device has been so long used in connection with an article of manufacture that it has become well-known to the trade as designating a particular person's goods, it constitutes a lawful trade-mark, see Morrison v. Case, 2 O. G. 544. A simple illustration of a crown in connection with an article, to designate its origin and ownership, is a lawful trade-mark, see Smith v. Reynolds, 3 O. G. 216.

An arbitrary combination of numerals, having no other meaning than to distinguish the applicant's goods in the market and indicate to purchasers that all goods having this mark have one and the same origin, may be used as a trade-mark, see Dawes & Fanning, 1 O. G. 27.

The designation "lion" whether used pictorially, or written or printed, is a lawful trade-mark for a medicine for a particular disease, see *ex parte* Weaver, 10 O. G. 1.

Every emblem or device that cannot be divested of its ordinary signification, and would be either descriptive or deceptive, is unlawful as a trade-mark, see *ex parte* Tolle, 2 O. G. 415.

A compound trade-mark, one of whose distinguishing features has already been appropriated and registered by another, as applied to the same class of merchandise, cannot be registered, see J. Bush & Co., 10 O. G. 164.

Phrases which are merely descriptive of the quality of the article, or its destined use, cannot be registered as a trade-mark, see Lawrence & Co., 10 O. G. 163.

The name of a town joined to the name of an article is not a legal trade-mark, nor can it be made so by adding the name and place of business of the manufacturer, see Armistead v. Blackwell, 1 O. G. 608.

The word "centennial" as applied to medals generally, is not a good trade-mark, see Hartell v. Vinez, 2 W. N. 602.

RIVAL APPLICANTS. INTERFERENCES.—In the absence of evidence the party who files the first application is entitled to a trade-mark, see Jacobs v. Lopez, 23 O. G. 342.

If two or more applicants claim the same trade-mark, the matter may be referred to the examiner of interferences, see Duke *v.* Green, 16 O. G. 1094. An interference in trade-mark cases can properly be declared in accordance with the usual practice governing interference cases between applicants for patents, see Lautz Bros. *v.* Schultz, 9 O. G. 791, and in such interference proceeding the inquiry may extend to the ownership of the trade-mark as well as the priority of adoption, see Hoosier Drill Co. *v.* Ingels, 14 O. G. 785.

If it appears that each party to an interference is entitled to an undivided half of a trade-mark, the applicant cannot obtain registration, for the law grants registration only to those entitled to the exclusive use of a trade-mark, see McElwee *v.* Blackwell, 15 O. G. 658.

If one partner, after the dissolution of a firm, alone continues to use it upon the same articles, he is entitled to have it registered, see Simpson *v.* Wright, 15 O. G. 248. If a firm which has acquired a trade-mark is dissolved, each becomes a tenant in common thereof, although one possesses the secret of manufacturing the article, and neither is entitled to a registration, see Wright *v.* Simpson, 15 O. G. 968. See also notes to Sec. 5, *post*.

In case of conflicting applications for registration, or in any dispute as to the right to use which may arise between an applicant and a prior registrant, the office will declare an interference, in order that the parties may have an opportunity to prove priority of adoption or right; and the proceedings on such interference will follow, as nearly as practicable, the practice in interferences upon applications for patents (see Rev. Stat., Sec. 4904, and notes, *ante*); but each applicant and registrant will be held to the date of adoption alleged in the statement filed with his application. On the petition of any party dissatisfied with the decision of the examiner of interferences, the case will be reviewed by the commissioner (see Trade-Mark Rules of Practice, Rule 13). An appeal may also be taken from an adverse decision of the Commissioner of Patents, to the Court of Appeals of the District of Columbia, (see Rev. Stat., Sec. 4911, Act of Feb. 9, 1893, and notes, *ante*.

SEC. 4. That certificates of registry of trade-marks shall be issued in the name of the United States of America, under the seal of the Department of the Interior, and shall be signed by the Commissioner of Patents, and a record thereof, together with printed copies of the specifications, shall be kept in books for that purpose. Copies of trade-marks and of statements and declarations filed therewith, and certificates of registry so signed and sealed shall be evidence in any suit in which such trade-marks shall be brought in controversy.

Trade-Mark Rules of Practice, Rules 14 and 19.

When the requirements have been complied with, and the office has adjudged the trade-mark lawfully registerable, a certificate will be issued by the Commissioner, under seal of the Interior Department, to the effect that the applicant has complied with the law, and that he is entitled to the protection of his trade-mark in such case made and provided. Attached to the certificate will be a fac-simile of the trade-mark, and a printed copy of the statement and declaration, see Rule 14.

A certified copy is evidence only that what is shown by it to have been filed was filed. It is not evidence that anything required by the statute to be filed, and not shown by the certificate, or by the statement annexed to it to have been filed, was filed. A general certificate of the Commissioner cannot be taken as evidence that the requirements of the law have been met, see Smith *v.* Reynolds, 3 O. G. 213.

The statement required by the statute is a separate and distinct thing from the declaration, and when the statute speaks of certified copies of the statement, it does not thereby include the declaration, see Walker *v.* Reid, 2 C. L. B. 133. A certificate which gives a copy of the statement, and shows that a declaration was filed, is sufficient, see Walker *v.* Reid, 2 C. L. B. 133.

Printed copies of the statement and declaration in each case, with a duplicate of the trade-mark, can be obtained from the office upon payment of the usual fee.

The Official Gazette of the Patent Office, published weekly, contains a weekly list of all trade-marks registered, with the name and address of the registrant, a brief statement of the essential features of the trade-mark, and the particular description of goods to which it is applied.

See Rule 19.

SEC. 5. That a certificate of registry shall remain in force for thirty years from its date, except in cases where the trade-mark is claimed for and applied to articles not manufactured in this country, and in which it receives protection under the laws of a foreign country for a shorter period, in which case it shall cease to have any force in this country by virtue of this act at the time that such trade-mark ceases to be exclusive property elsewhere. At any time during the six months prior to the expiration of the term of thirty years such registration may be renewed on the same terms and for a like period.

Trade-Mark Rules of Practice, Rule 15.

This section does not affect the vitality of the trade-mark, for it is beyond the power of the national legislature to create or destroy an arbitrary symbol of manufacture or commerce termed a trade-mark, Browne on Trade-Marks § 388. It affects only what the act creates, the certificate of registry. The common law right in a trade-mark exists so long as the owner continues to use and employ it in his business, and his right may be assigned to his successors, who may continue in their enjoyment of the exclusive right to use the trade-mark, see Burton *v.* Stratton, 12 Fed. Rep. 696; and a person may not only assign his trade-mark, but even the right to use his own name in connection with a particular business, and the assignee will thereby become entitled to the exclusive use of the trade-mark, even as against the assignor, *Ibid.*; Oakes *v.* Tousmierre, 4 Woods, 547. The assignee should indicate, in the use of the trade-mark, that he is such assignee or purchaser, see Stachelberg *v.* Ponce, 28 Fed. Rep. 430.

The right to use a trade-mark may be lost by a non-user, and in Blackwell *v.* Dibrell, 3 Hughes, 151, it was held that a non-user for eight or nine years, lost the right to use the trade-mark, and that when lost, it could not be resumed if, in the mean time, another person has acquired the right to its use; but in all such cases the intent of the owner to abandon should be taken into consideration, for a mere non-use of a mark for any length of time, is not conclusive upon the point of abandonment, see Brown on Trade-Marks, §§ 674 to 691.

SEC. 6. That applicants for registration under this act shall be credited for any fee or part of a fee heretofore paid into the Treasury of the United States with intent to procure protection for the same trade-mark.

Trade-Mark Rules of Practice, Rules 17 and 18.

This section of the statute applied to trade-marks registered, or applications filed under the act of July 8, 1870, which act was declared unconstitutional by the Supreme Court of the United States. Owners of trade-marks registered, or applicants for registration under that act, were allowed registration of their trade-marks under the present act upon compliance with its requirements, the fee paid under the former act applying on account of the fee required for the new application; with each application of this character a specific reference to the date and number of the former certificate, or application, is required.

SEC. 7. That registration of a trade-mark shall be *prima facie* evidence of ownership. Any person who shall reproduce, counterfeit, copy, or colorably imitate any trade-mark registered under this act and affix the same to merchandise of substantially the same descriptive properties as those described in the registration shall be liable to an action on the case for damages for the wrongful use of said trade-mark at the suit of the owner thereof; and the party aggrieved shall also have his remedy according to the course of equity to enjoin the wrongful use of such trade-mark used in foreign commerce or commerce with Indian tribes, as aforesaid, and to recover compensation therefor in any court having jurisdiction over the person guilty of such wrongful act; and courts of the United States shall have original and appellate jurisdiction in such cases without regard to the amount in controversy.

The registration of a trade-mark is *prima facie* evidence of title, as in the case of patents, see Winans *v.* N. G. & Erie R. R. Co., 1 Fisher, 213; Ransom *v.* Mayor, *Ibid.* 252, and, as in the case of patents, the Federal Courts have jurisdiction over actions at law and in equity, to restrain the piracy of trade-marks, and to assess damages for the wrongful use of such property.

It should not be overlooked that a person may maintain an action in the State courts for the infringement of a trade-mark, although it has not been recorded at the Patent Office, for a trade-mark is property under the common law independently of the statute, see Rodgers *v.* Philp, 1 O. G. 29. Where a trade-mark has been registered in the Patent Office, the action may be brought against an infringer in the United States Courts. Actions in trade-mark cases are subject to the usual rules of the courts in other cases.

To constitute infringement it is not necessary that the marks should be identical, it is sufficient if they bear such resemblance as is calculated to deceive the public, see Walton *v.* Crowley, 3 Blatch., C. C. 440; nor is it necessary that there be fraudulent intention, see The Collins Co. *v.* Walker, 7 Weekly Reporter, 222; Clement *v.* Maddick, 1 Giffard, 98. Imposition on the public is the test, and probability of deception is necessary to constitute infringement, see Walton *v.* Crowley, 3 Blatch., C. C. 440; Seixo *v.* Provezende, L. R., 1 Ch. 192. For a very full and complete statement of the law and practice regarding infringements, see McLean *v.* Fleming, 13 O. G. 913; Cox's Manual of Trade-Mark Cases, 580.

SEC. 8.—That no action or suit shall be maintained under the provisions of this act in any case when the trade-mark is used in any unlawful business or upon any article injurious in itself, or which mark has been used with the design of deceiving the public in the purchase of merchandise, or under any certificate of registry fraudulently obtained.

It is a broad principle of law that all transactions in violation of morality, or *contra bonos mores*, are void. Thus, if it can be shown that a trade-mark is used to stamp obscene publications or articles used only in the commission of acts of vice, the registrant could not recover damages should the mark be counterfeited and a suit be instituted by him. Any business which violates the rules of public policy is unlawful, as well as any business carried on in violation of a statute, and it should also be observed that any business, the object of which is the violation of the laws of another nation, is properly treated as unlawful.

The words "any article injurious in itself" undoubtedly refer to any article designed for an evil purpose. Poisons, explosives, weapons used in warfare, intoxicating liquors, and similar articles may be perverted from lawful purposes, but are not *per se* unlawful. Adulterated foods, quack medicines, and other similar substances and articles are, however, included within the provisions of this section.

A person whose business is imposition, cannot invoke the aid of equity against a piracy of his trade-mark, see Fowle *v.* Spear, 7 Pa. L. J. 176. A false indication of origin, see Palmer *v.* Harris, 60 Penn. 156; the false representation of an article as patented, see the Leather Cloth Co. case, 11 Jur. (N. S.) 513; a mark calculated or likely to mislead the public, see The Am. Sardine Co., 3 Off. Gaz. 395; or the use of one's own name to induce the public to accept goods as those of another person of the same name, see Croft *v* Day, 7 Beav. 84, are methods of deceiving the public that the law will not tolerate, and it is no answer to the charge that the deceit was really for the benefit of the public, see Partridge *v.* Menck, 1 How. App. Cases, 558. Nor can a person take advantage of any certificate of registry fraudulently obtained. As to the meaning of the phraseology of the words "fraudulently obtained," see Fetridge *v.* Wells, 4 Abb. Pr. 144.

SEC. 9.—That any person who shall procure the registry of a trade-mark, or of himself as the owner of a trade-mark, or an entry respecting a trade-mark, in the office of the Commissioner of Patents, by a false or fraudulent representation or declaration, orally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence thereof to the injured party, to be recovered in an action on the case.

SEC. 10.—That nothing in this act shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trade-mark might have had if the provisions of this act had not been passed.

RIGHTS UNDER THE COMMON LAW NOT AFFECTED BY REGISTRATION.—The right of property in a trade-mark is distinctly recognized in the common law. An owner of a trade-mark has the exclusive right to the use of his mark, and may maintain and enforce this right under the common law of the United States, irrespective of the registration of the trade-mark and his rights under the statute.

A person may maintain an action for infringement of a trade-mark, although it has not been recorded at the Patent Office, for a trade-mark is property independently of the statute. The act is not obligatory. It offers to manufacturers an opportunity to have their trade-marks recorded, but imposes no penalty or forfeiture of right for neglect to so record them, see Rodgers *v.* Philp, 1 O. G. 29; and it should be observed that the recording of a trade-mark does not convey any higher rights than the owner had independently of the statute, see Popham *v.* Wilcox, 14 Abb. Pr. (N. S.) 206.

Chancery protects trade-marks upon the ground that a party shall not be permitted to sell his own goods as the goods of another; and therefore he will not be allowed to use the names, marks, letters, or other *indicia* of another, by which he may pass off his own goods to purchasers as the manufacture of another, see Croft *v.* Day, 7 Beav. 84; Newman *v.* Alford, 51 N. Y. 192. Trade-marks are protected on the ground of property and not exclusively on the ground of fraud, and damages will be allowed for an unauthorized, though unintentional, use of a trade-mark, see Oakes *v.* Tousmierre, 4 Woods, 547. Where a person has appropriated a particular trade-mark to distinguish his goods from other similar goods, he has a right of property in it which entitles him to its exclusive use, which equity will protect, see Hostetter *v.* Vowinkle, 1 Dillon, 329.

In suits against the infringer of a trade-mark, the question is not whether the complainant was the original inventor or proprietor of the article made by him, and on which he has put his trade-mark, nor whether the article made by the respondent is equal to his own, in value or quantity, but the court proceeds on the ground that the complainant has a valuable interest in the good will of his trade or business, and that, having adopted a particular label, sign, or trade-mark, indicating to his customers that the article bearing it is made or sold by him, or by his authority, or that he carries on business at a particular place, he is entitled to protection against one who attempts to deprive him of his trade or customers by using such labels, sign, or trade-mark, without his knowledge or consent, see McLean *v.* Fleming, 6 Otto, 245.

A trade-mark is not granted by the government. The registration or the non-registration of the trade-mark does not affect the right of the owner to his exclusive use of the mark, for this exists under the common law from the time the mark is adopted and used. Nor does the statute create the right to judicial remedies generally, for that right has always existed. The registration of a trade-mark is *prima facie* evidence of ownership; such registration creates a presumption in favor of the registrant; that he was the first to adopt the mark in question, and that such mark is a proper and lawful trade-mark. The certificate of registry, duly signed and sealed; copies of trade-marks, and of statements and declarations filed therewith, are evidence in any suit in which such trade-marks shall be brought in controversy, but neither the vitality of the trade-mark, its ownership, nor the remedies for the wrongful use of the trade-mark, are in anywise affected by the act of registration, or the provisions of the statute itself.

SEC. 11.—That nothing in this act shall be construed as unfavorably affecting a claim to a trade-mark after the term of registration shall have expired; nor to give cognizance to any court of the United States in an action or suit between citizens of the same State, unless the trade-mark in controversy is used on goods intended to be transported to a foreign country, or in lawful commercial intercourse with an Indian tribe.

After the term for which registration can be effected has elapsed, the owner of the trade-mark is relegated to his common law rights. As registration cannot create or grant a trade-mark, so the owner thereof cannot be deprived of his property therein or his rights as such owner by the mere expiration of the registration.

In Glen Cove Mfg. Co. *v.* Ludeling, 22 Fed. Rep. 823, Wallace, J., said: "Unless the complainant's trade-mark is used on goods intended to be transported to a foreign country, by the terms of the act of Congress the court can take no cognizance of the wrong in a suit between citizens of the same State. If it is so used the court will not be concluded by the results of an inquiry whether it is used with an intent to mislead purchasers in the country where the goods are to be ultimately sold; because the goods may be sold here, or be in some country other than the one where they are to be ultimately sold, and the act of Congress contemplates a complete protection to the right which it creates."

SEC. 12.—That the Commissioner of Patents is authorized to make rules and regulations and prescribe forms for the transfer of the right to use trade-marks and for recording such transfers in his office.

Trade-Mark Rules of Practice, Rule 16.

The right to the use of any trade-mark is assignable by an instrument in writing, and such assignment of a registered trade-mark must be recorded in the Patent Office within sixty days after its execution, in default of which it may be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice. No particular form of assignment or conveyance is prescribed, but the trade-mark must be identified by the certificate number.

SEC. 13.—That citizens and residents of this country wishing the protection of trade-marks in any foreign country the laws of which require registration here as a condition precedent to getting such protection there may register their trade-marks for that purpose as is above allowed to foreigners, and have certificate thereof from the Patent Office.

Approved March 3, 1881.

The precise meaning of this section has yet to be discovered. It does not seem possible that the owner of a trade-mark would desire to secure registration in a foreign country unless he was engaged in commerce with that country, and in this case he may proceed under Sec. 1, and obtain registration and his certificate therefor. If it has any other purpose than to grant registration for the trade-marks of such citizens and residents of the United States as are engaged in commerce with foreign nations, it is clearly unconstitutional, in view of the decision of the Supreme Court upon the Act of July 8, 1870.

AN ACT RELATING TO THE REGISTRATION OF TRADE-MARKS.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That nothing contained in the law entitled "An act to authorize the registration of trade-marks and protect the same," approved March third, eighteen hundred and eighty-one, shall prevent the registry of any lawful trade-mark rightfully used by the applicant in foreign commerce or commerce with Indian tribes at the time of the passage of said act.

Approved August 5, 1882.

It is difficult to find any reason or excuse for the passage of this act. By the act of March 3, 1881, to which this is virtually an amendment, every possible species of lawful trade-mark is entitled to registration. This act neither adds to nor subtracts from the practice as established by that act.

PENAL ACT.*

AN ACT TO PUNISH THE COUNTERFEITING OF TRADE-MARK GOODS AND THE SALE OR DEALING IN OF COUNTERFEIT TRADE-MARK GOODS.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That every person who shall, with intent to defraud, deal in or sell, or keep or offer for sale, or cause or procure the sale of, any goods of substantially the same descriptive properties as those referred to in the registration of any trade-mark, pursuant to the statutes of the United States, to which, or to the package

---

*This act and the act of March 3, 1881, providing for the registration of trade-marks, are in effect one, and should be construed together. Registration under the act of March 3, 1881, is an indispensable prerequisite to a criminal prosecution under the act next following.

in which the same are put up, is fraudulently affixed said trade-mark, or any colorable imitation thereof, calculated to deceive the public, knowing the same to be counterfeit or not the genuine goods referred to in said registration, shall, on conviction thereof, be punished by fine not exceeding one thousand dollars, or imprisonment not more than two years, or both such fine and imprisonment.

SEC. 2.—That every person who fraudulently affixes, or causes or procures to be fraudulently affixed, any trade-mark registered pursuant to the statutes of the United States, or any colorable imitation thereof, calculated to deceive the public, to any goods, of substantially the same descriptive properties as those referred to in said registration, or to the package in which they are put up, knowing the same to be counterfeit, or not the genuine goods referred to in said registration, shall, on conviction thereof, be punished as prescribed in the first section of this act.

SEC. 3.—That every person who fraudulently fills, or causes or procures to be fraudulently filled, any package to which is affixed any trade-mark, registered pursuant to the statutes of the United States, or any colorable imitation thereof, calculated to deceive the public, with any goods of substantially the same descriptive properties as those referred to in said registration, knowing the same to be counterfeit, or not the genuine goods referred to in said registration, shall, on conviction thereof, be punished as prescribed in the first section of this act.

SEC. 4.—That any person or persons who shall, with intent to defraud any person or persons, knowingly and willfully cast, engrave, or manufacture, or have in his, her, or their possession, or buy, sell, or offer for sale, or deal in, any die or dies, plate or plates, brand or brands, engraving or engravings, on wood, stone, metal, or other substance, moulds, or any false representation, likeness, copy, or colorable imitation of any die, plate, brand, engraving, or mould of any private label, brand, stamp, wrapper, engraving on paper or other substance, or trade-mark, registered pursuant to the statutes of the United States, shall, upon conviction thereof, be punished as prescribed in the first section of this act.

SEC. 5.—That any person or persons who shall, with intent to defraud any person or persons, knowingly and willfully, make, forge, or counterfeit, or have in his, her, or their possession, or buy, sell, offer for sale, or deal in, any representation, likeness, similitude, copy, or colorable imitation of any private label, brand, stamp, wrapper, engraving, mould, or trade-mark, registered pursuant to the statutes of the United States, shall, upon conviction thereof, be punished as prescribed in the first section of this act.

SEC. 6.—That any person who shall, with intent to injure or defraud the owner of any trade-mark, or any other person lawfully entitled to use or protect the same, buy, sell, offer for sale, deal in or have in his possession any used or empty box, envelope, wrapper, case, bottle, or other package, to which is affixed, so that the same may be obliterated without substantial injury to such box or other thing aforesaid, any trade-mark, registered pursuant to the statutes of the United States, not so defaced, erased, obliterated, and destroyed so as to prevent its fraudulent use, shall, on conviction thereof, be punished as prescribed in the first section of this act.

SEC. 7.—That if the owner of any trade-mark, registered pursuant to

the statutes of the United States, or his agent, make oath, in writing, that he has reason to believe, and does believe, that any counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance; or moulds of his said registered trade-mark, are in the possession of any person, with intent to use the same for the purpose of deception and fraud, or makes such oaths that any counterfeits or colorable imitations of his said trade-mark, label, brand, stamp, wrapper, engraving on paper or other substance, or empty box, envelope, wrapper, case, bottle, or other package, to which is affixed said registered trade-mark not so defaced, erased, obliterated, and destroyed as to prevent its fraudulent use, are in the possession of any person, with intent to use the same for the purpose of deception and fraud, then the several judges of the circuit and district courts of the United States and the commissioners of the circuit courts may, within their respective jurisdictions, proceed under the law relating to search-warrants, and may issue a search-warrant authorizing and directing the marshal of the United States for the proper district to search for and seize all said counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance, moulds, and said counterfeit trade-marks, colorable imitations thereof, labels, brands, stamps, wrappers, engravings on paper, or other substances, and said empty boxes, envelopes, wrappers, cases, bottles, or other packages that can be found; and upon satisfactory proof being made that said counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance, moulds, counterfeit trade-marks, colorable imitations thereof, labels, brands, stamps, wrappers, engravings on paper or other substance, empty boxes, envelopes, wrappers, cases, bottles, or other packages, are to be used by the holder or owner for the purposes of deception and fraud, that any of said judges shall have full power to order all said counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance, moulds, counterfeit trade-marks, colorable imitations thereof, labels, brands, stamps, wrappers, engravings on paper or other substance, empty boxes, envelopes, wrappers, cases, bottles, or other packages, to be publicly destroyed.

SEC. 8.—That any person who shall, with intent to defraud any person or persons, knowingly and willfully aid or abet in the violation of any of the provisions of this act, shall, upon conviction thereof, be punished by a fine not exceeding five hundred dollars, or imprisonment not more than one year, or both such fine and imprisonment.

Approved August 14, 1876.

PROHIBITION OF ENTRY OF WATCHES AND OTHER GOODS OF FOREIGN MANUFACTURE, BEARING FALSIFIED MARKS, AT CUSTOMS HOUSES.

"SEC. 2496.—No watches, watch cases, watch-movements, or parts of watch-movements, *or any other articles* of foreign manufacture, which shall copy or simulate the name or trade-mark of any domestic manufacture, [manufacturer,] shall be admitted to entry at the custom house of the United States, unless such domestic manufacturer is the importer of the same. And in order to aid the officers of the customs in enforcing this prohibition, any domestic manufacturer who has adopted trade-marks may require his name and residence and a description of his trade-marks, to be recorded in books which shall be kept for that purpose in the Department of the Treasury, under such regulations as the Secretary of the

Treasury shall prescribe, and may furnish to the Department *fac-similes* of such trade-marks; and thereupon the Secretary of the Treasury shall cause one or more copies of the same to be transmitted to each collector or other proper officer of the customs."

The Treasury Department, by circular of May 15, 1883, called the attention of customs officers to this section of the Revised Statutes, and instructed them to exercise care to prevent the entry at custom houses of any article of foreign manufacture copying or simulating any such mark, not imported by the owner of such name and trade-mark.

Applications for the recording of names or trade-marks in the Treasury Department should mention the name and residence of the domestic manufacturer, and furnish a description of the mark. No such name will be received unless the trade-mark is registered in the Patent Office; and the fact must be shown by the production of a copy of the mark, certified by the Commissioner of Patents, under the seal of the Patent Office, in the manner provided by law, and also of the necessary fac-similes, under the seal of the Patent Office, to be forwarded to collectors of customs.

On the receipt by a customs officer of any such fac-similes, with information from the Department that they have been recorded therein, he will properly record and file them.

Imported Goods to be Marked with Name of the Country of Origin.

Act of October 1, 1890.

Sec. 6.—That on and after the 1st day of March, 1891, all articles of foreign manufacture, such as are usually or ordinarily marked, stamped, branded, or labeled, and all packages containing such or other imported articles, shall, respectively, be plainly marked, stamped, branded, or labeled in legible English words, so as to indicate the country of their origin, and unless so marked, stamped, branded, or labeled, they shall not be admitted to entry.

Sec. 7.—That on and after March 1, 1891, no article of imported merchandise which shall copy or simulate the name or trade-mark of any domestic manufacture or manufacturer, shall be admitted to entry at any custom house of the United States. And in order to aid the officers of the customs in enforcing this prohibition, any domestic manufacturer who has adopted trade-marks may require his name and residence and a description of his trade-marks to be recorded in books which shall be kept for that purpose in the Department of the Treasury under such regulations as the Secretary of the Treasury shall prescribe, and may furnish to the Department fac-similes of such trade-marks; and thereupon the Secretary of the Treasury shall cause one or more copies of the same to be transmitted to each collector or other proper officer of the customs.

It will be noted that under this act the registration of a trade-mark in the Patent Office is not a pre-requisite to the recording of the trade-mark, with the owner's name and address, in the Treasury Department. We can recommend this system of recording to domestic owners of trade-marks, even in advance of the registration of their marks in the Patent Office, as affording convenient and positive evidence as to their adoption of their trade-marks, and their rights under the common law. At the same time such recording may prevent the piracy of their trade-marks, or at least the importation of goods from abroad bearing trade-marks, or names, the same or similar to the mark or name of such owner.

The procedure in recording trade-marks in the Treasury Department is very simple. It is necessary to file an application requesting the recording of the mark, and to accompany such application with a statement of the full name, and residence of the owner, a detailed description of the trade-mark, and the fac-similes required for registration, and state the names of the ports to which the fac-similes should be sent. See Circular No. 112 of the Treasury Department, dated October 31, 1890.

HISTORY OF THE COPYRIGHT SYSTEM OF THE UNITED STATES.

Previous to the adoption in 1787 of the Constitution, the nation had no power to grant copyright protection to authors. The State of Connecticut in January, 1783, and Massachusetts in March, 1783, passed acts granting copyright protection for twenty-one years to their own citizens, and in May, 1783, Congress recommended the States generally to legislate upon the subject.

The State of Virginia in 1785, New York and New Jersey in 1786, also passed acts providing for copyrights, and other States were considering them, when the Statute of 1790, passed by the Congress, rendered further State legislation unnecessary.

The act of 1790 followed the provisions of the English act of 1710 closely, giving to authors who were citizens or residents, their heirs and assigns, copyright in books, maps and charts, for fourteen years, with privilege of renewal at the end of this term, if the author was then living, for a further term of fourteen years. It required the printed title to be deposited, before the publication of the work, in the clerk's office of the local United States District Court; it required notice of the copyright to be inserted four times in a newspaper within two months after publication, and that a copy of the work be deposited with the Secretary of State of the United States within six months after publication. The act prescribed a remedy against unauthorized publication of manuscripts, and, as a penalty for piracy, forfeiture and a fine of fifty cents for each sheet found, one-half to go to the United States, and one-half to the owner of the copyright.

The act of 1802 required notice of copyright to be printed on the title page, or the page next thereto, and included designs, engravings and etchings, as subject-matters for protection.

The act of 1819 gave original jurisdiction in copyright cases to the United States Circuit Courts.

The act of 1831 (a consolidation of previous acts) extended the term of copyright to twenty-eight years, with privilege of renewal for a further term of fourteen years; included musical compositions; required a copy of the work to be left with the district clerk, within three months from the date of publication, for transmission to the Secretary of State, and cancelled the requirement for advertising in a newspaper, except for renewals.

The act of 1834 required assignments to be recorded in the court of the original entry.

The act of 1846 establishing the Smithsonian Institution, required one copy of the work to be delivered to that Institution, and one copy to the Library of Congress.

The act of 1856 secured the right of performance to dramatists.

The act of 1859 repealed the provisions of 1846, as to the deposit of copies, and placed the Interior Department in charge of copyright matters, instead of the State Department.

The act of 1861 provided for appeal to the Supreme Court in all copyright cases.

The act of 1865 again required the deposit of a copy in the Library of Congress, and provided that such deposit be made within one month from the date of publication; another act including photographs and negatives among the subject matters for protection.

The act of 1867 established a penalty of $25 for failure to deposit the copy required to be left in the Library of Congress.

The act of 1870 was a general act taking the place of the various acts before mentioned; it did away with the system of registry with the local District Court, and made the Librarian of Congress the copyright officer; it extended the protection afforded by the law to "paintings, drawings, chromos, statues, statuary, and models or designs intended to be perfected as works of the fine art"; it required that a printed title of the work should be filed with the Librarian of Congress before the publication, and two copies of the work within ten days after the publication thereof.

In 1873-74 the copyright act was included in the Revised Statutes of the United States, as Sections 4948 to 4971 (see also §§ 629 and 699).

These sections of the revised statutes as amended and augmented by the amending acts of June 18, 1874, August 1, 1882, March 3, 1891, and March 2, 1895, as interpreted by the decisions of the courts, form the body of the present law of copyright now in force. The full text of the law is found below.

CONSTITUTION.

The clause of the Constitution of the United States, which authorizes the grant of copyright, is found in Article 1, Section 8:

The Congress shall have power * * * to promote the progress of science and the useful arts by securing, for limited times, to authors and inventors, the exclusive rights to their respective writings and discoveries * * * also to make all laws which shall be necessary and proper for carrying into execution the foregoing powers.

YALE LAW LIBRARY

THE LAW OF COPYRIGHT IN THE UNITED STATES.

IN FORCE JULY 1, 1895.

From the Revised Statutes of the United States, in force December 1, 1873, *as amended by Act of June* 18, 1874; *August* 1, 1882; *March* 3, 1891, *and March* 2, 1895.

SECTION 4948. All records and other things relating to copyrights and required by law to be preserved, shall be under the control of the Librarian of Congress, and kept and preserved in the Library of Congress; and the Librarian of Congress shall have the immediate care and supervision thereof, and, under the supervision of the Joint Committee of Congress on the Library, shall perform all acts and duties required by law touching copyrights.

SEC. 4949. The seal provided for the office of the Librarian of Congress shall be the seal thereof, and by it all records and papers issued from the office, and to be used in evidence shall be authenticated.

A copy of any record, or a duplicate certificate of any copyright record will be furnished under seal of the office, the legal fee for same being fifty cents, see Rule 2.

SEC. 4950. The Librarian of Congress shall give a bond, with sureties, to the Treasurer of the United States, in the sum of five thousand dollars, with the condition that he will render to the proper officers of the Treasury a true account of all moneys received by virtue of his office.

SEC. 4951. The Librarian of Congress shall make an annual report to Congress of the number and description of copyright publications for which entries have been made during the year.

SEC. 4952. The author, inventor, designer, or proprietor of any book, map, chart, dramatic or musical composition, engraving, cut, print, or photograph or negative thereof, or of a painting, drawing, chromo, statuary, and of models or designs intended to be perfected as works of the fine arts, and the executors, administrators, or assigns of any such person, shall, upon complying with the provisions of this chapter, have the sole liberty of printing, reprinting, publishing, completing, copying, executing, finishing, and vending the same; and, in the case of a dramatic composition, of publicly performing or representing it, or causing it to be performed or represented by others. And authors or their assigns shall have exclusive right to dramatize or translate any of their works, for which copyright shall have been obtained under the laws of the United States.

PARTIES.—To constitute an "author," the person must by his own intellectual labor, applied to the materials of his composition, produce an arrangement or compilation new in itself, see Atwell *v.* Ferrett, 2 Blatch., 39. The word "proprietor" has been used in the copyright laws in the limited and restricted sense of a person who has lawfully

acquired the exclusive rights of some artist or author, see Yuengling *v.* Schile, 12 Fed. Rep. 97. A proprietor cannot claim a copyright for a work invented by another unless he shows an exclusive right lawfully received from the inventor, *idem.*

A party who first brings together materials drawn from different sources is entitled to a copyright for a compilation, see Gray *v.* Russell, 1 Story, 11.

A reporter of judicial decisions is entitled to copyright of his work to the extent of his authorship of the composition contained therein, see Little *v.* Gould, 2 Blatch., 165.

A person who translates a dramatic composition with the consent of the author is entitled to a copyright, see Shook *v.* Rankin, 6 Biss. 477.

The legal assignee of an author is competent to take out a copyright, although he takes it in trust for others, see Little *v.* Gould, 2 Blatch., 362.

SUBJECTS OF COPYRIGHT.—A "book" need not be a book in the common and ordinary acceptation of the word, viz., a volume made up of several sheets bound together. It may be printed only on one sheet, see Clayton *v.* Stone, 2 Paine, 382. The term "book" does not carry with it the requirement that it shall be printed; a book may exist without printing, and such book when made or composed, is entitled to copyright, see Roberts *v.* Meyers, 23 Law Rep. 396.

The word "chart" as used in this section refers to a form of map, see Ehret *v.* Pierce, 18 Blatch., 302.

The word "print" is used in connection with "engraving, cut, and photograph." It means apparently a picture; something complete in itself, similar in kind to an engraving, cut, or photograph. It clearly does not mean something printed on paper that is not intended for use as a picture, but is itself to be cut up and embroidered, and then made into an entirely different article, see Rosenbach *v.* Dreyfuss, 17 O. G. 1153.

The word "print" embraces lithographs, see Yuengling *v.* Schile, 12 Fed. Rep. 97, but a photograph is not a print, cut, or engraving, see Wood *v.* Abbott, 5 Blatch., 325.

The provisions of this section in relation to photographs are constitutional, see Sarony *v.* Burrow G. L. Co., 17 Fed. Rep. 591.

An advertising card used to display the different colors of paints is not a subject of copyright, see Ehret *v.* Pierce, 10 Fed. Rep. 553. The statute was passed for the encouragement of learning, and was not intended for the encouragement of mere industry, unconnected with learning or science, see Clayton *v.* Stone, 2 Paine, 382.

Blank account books are not the subject of copyright, see Baker *v.* Selden, 17 O. G. 1029; but a compilation of information that is useful in a counting room is a proper subject, see Bullinger *v.* Mackey, 15 Blatch., 550.

A new arrangement of an old piece of music is a valid subject of copyright, see Schuberth *v.* Shaw, 28 A. L. Reg. 248.

If a chromo is clearly a work of artistic merit it is the subject of a copyright, although the person claiming the copyright expects to obtain his reward indirectly through an increase of profits in his business, to be obtained through its gratuitous distribution, see Yuengling *v.* Schile, 12 Fed. Rep. 97.

Immoral, pernicious or indecent works are not entitled to copyright, see Richardson *v.* Miller, 12 O. G. 3; but in order to exclude such works from protection it must appear that there is something immoral, pernicious or indecent in the thing *per se*, or that it is incapable of use except in connection with some illegal or immoral act, *idem.* That this applies to dramatic composition, see Martinette *v.* Maguire, 1 Deady, 216.

No reporter can have any copyright in judicial decisions, see Wheaton *v.* Peters, 8 Wheat, 591.

A daily or weekly publication of the state of the market is not the subject of a copyright, see Clayton *v.* Stone, 2 Paine, 382.

The preliminary steps required by law cannot be reasonably applied to a work of so ephemeral a character as a newspaper, see Clayton *v.* Stone, 2 Paine, 282.

A chart which contains a series of diagrams interspersed with printed instructions as to the mode of using them in taking measurements for and cutting garments, is the subject of copyright, see Drewry *v.* Ewing, 1 Bond, 540.

Playing cards may be a proper subject of copyright, see Richardson *v.* Miller, 12 O. G. 3.

A spectacular piece consisting almost wholly of scenic effects or representations, and in which the dialogue is very scant and meaningless is not a dramatic composition, see Martinelli *v.* Maguire, 1 Deady, 216.

The musical composition contemplated by the statutes must be substantially a new and original work, and not a copy of a piece already produced, with additions and variations which a writer of music with skill and experience might readily make, see Jollie *v.* Jacques, 1 Blatch., 618.

If an engraving does not involve invention it is not a subject of copyright, see Collender *v.* Griffiths, 3 O. G. 689.

Works on law, whether elementary or otherwise, are proper subjects of abridgment, see Story *v.* Halcombe, 4 McLean, 306.

There is a clear distinction between a compilation and an abridgement. To abridge requires an exercise of the mind, and that is not copying. To compile is to copy from various authors into one work, see Story *v.* Halcombe, 4 McLean, 306.

COPYRIGHT FOR PROJECTED WORKS.—A copyright may be secured for a projected as well as for a completed work, but the law provides for no *caveat*, or notice of interference—only for actual entry of title, see Rule 7.

SEC. 4953. Copyrights shall be granted for the term of twenty-eight years from the time of recording the title thereof, in the manner hereinafter directed.

SEC. 4954. The author, inventor, or designer, if he be still living, or his widow or children, if he be dead, shall have the same exclusive right continued for the further term of fourteen years, upon recording the title of the work or description of the article so secured a second time, and complying with all other regulations in regard to original copyrights, within six months before the expiration of the first term. And such person shall, within two months from the date of said renewal, cause a copy of the record thereof to be published in one or more newspapers, printed in the United States, for the space of four weeks.

Applications for renewal must be accompanied by a printed title and the fee; and by explicit statement of ownership in the case of an author, or of relationship in the case of his heirs, and must definitely state the date and place of entry of the original copyright.

The time of the publication required by this section is not limited by law or regulation, but the courts have held that it should take place "within a reasonable time," see Rules 6 and 7.

SEC. 4955. Copyrights shall be assignable in law by any instrument of writing, and such assignment shall be recorded in the office of the Librarian of Congress within sixty days after its execution; in default of which it shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice.

See Rules 8 and 9.

The statute does not say what interest may be assigned, but there is no sufficient reason for preventing an author from conveying any distinct portion of his right. Divisability as well as assignability enhances the value of his property, for he may find a purchaser able and willing to pay for a part, but not for the whole of his copyright, see Roberts *v.* Myers, 23 Law Rep. 896.

A parol promise for a good consideration, to transfer an interest in a copyright is binding, for the making of the assignment merely concerns the manner of the performance of the promise, see Gould *v.* Banks, 8 Wood, 562.

The exclusive right to act and represent a drama is distinct from that of printing and publishing, and may be assigned for certain territory and a limited time, see Roberts *v.* Myers, 23 Law Rep. 896.

An assignee may maintain an action, although his assignment may never have been recorded, for it is valid between the parties, see Webb *v.* Powers, 2 W. & M. 497.

Although an instrument has never been copyrighted yet a transfer thereof is a sufficient consideration for a promissory note, see Cates *v.* Bales, 78 Ind., 285.

With regard to co-owners, the statute confers upon all the owners full power, without exacting any obligation in return, to print, publish and sell. Each can exercise his own right alone. When one owner at his own expense publishes and sells the book, he is not liable to account to the co-owners for the profits, see Carter *v.* Bailey, 64 Me. 458.

SEC. 4956. No person shall be entitled to a copyright unless he shall, on or before the day of publication, in this or any foreign country, deliver at the office of the Librarian of Congress, or deposit in the mail

within the United States, addressed to the Librarian of Congress, at Washington, District of Columbia, a printed copy of the title of the book, map, chart, dramatic or musical composition, engraving, cut, print, photograph, or chromo, or a description of the painting, drawing, statue, statuary, or a model or design, for a work of the fine arts, for which he desires a copyright; nor unless he shall also, not later than the day of the publication thereof, in this or any foreign country, deliver at the office of the Librarian of Congress, at Washington, District of Columbia, or deposit in the mail, within the United States, addressed to the Librarian of Congress, at Washington, District of Columbia, two copies of such copyright book, map, chart, dramatic or musical composition, engraving, chromo, cut, print, or photograph, or in case of a painting, drawing, statue, statuary, model, or design for a work of the fine arts, a photograph of the same: *Provided*, That in the case of a book, photograph, chromo, or lithograph, the two copies of the same required to be delivered or deposited as above, shall be printed from type set within the limits of the United States, or from plates made therefrom, or from negatives, or drawings on stone made within the limits of the United States, or from transfers made therefrom. During the existence of such copyright the importation into the United States of any book, chromo, lithograph, or photograph, so copyrighted, or any edition or editions thereof, or any plates of the same not made from type set, negatives, or drawings on stone made within the limits of the United States, shall be, and it is hereby prohibited, except in the cases specified in paragraphs 512 to 516, inclusive, in section two of the act entitled, an act to reduce the revenue and equalize the duties on imports and for other purposes, approved October 1, 1890; *and except in the case of persons purchasing for use and not for sale, who import subject to the duty thereon, not more than two copies of such book at any one time; and, except in the case of newspapers and magazines, not containing in whole or in part matter copyrighted under the provisions of this act, unauthorized by the author, which are hereby exempted from prohibition of importation:

Provided, nevertheless, That in the case of books in foreign languages, of which only translations in English are copyrighted, the prohibition of importation shall apply only to the translation of the same, and the importation of the books in the original language shall be permitted.

The following regulations (Department order 102, July 8, 1891) have been issued by the Treasury Department to customs officers under this section:

1. Copyrighted books and articles, the importation of which is prohibited by Section 4956 of the Revised Statutes, as amended by Section 3 of said act, shall not be admitted to entry. Such books and articles, if imported *with* the previous consent of the proprietor of the copyright, shall be seized by the Collector of Customs, who will take the proper steps for the forfeiture of the goods to the United States under Section 3082, Revised Statutes.

2. Copyrighted books and articles imported contrary to said prohibition, and *without* the previous consent of the proprietor of the copyright, being primarily subject to forfeiture to the proprietor of the copyright, shall be detained by the Collector, who shall forthwith notify such proprietor, in order to ascertain whether or not he shall institute proceedings for the enforcement of his right to the forfeiture.

---

* NOTE.—These paragraphs of the Tariff act permit free importation of books, etc., more than twenty years old, books in foreign languages, publications imported by the Government, or for societies, colleges, etc., and libraries which have been in use one or more years, brought from abroad by persons or families and not for sale.

If the proprietor institutes such proceedings and obtains a decree of forfeiture, the goods shall be delivered to him upon payment of the expenses incurred in the detention and storage, and the duties accrued thereon. If such proprietor shall fail to institute such proceedings within sixty days from date of notice, or shall declare in writing that he abandons his right to the forfeiture, then the Collector shall proceed as in the case of articles imported *with* the previous consent of such proprietor.

3. Copyrighted articles the importation of which is not prohibited, but which, by virtue of Section 4965 of the Revised Statutes, as amended by Section 8 of said act, are forfeited to the proprietor of the copyright when imported without his previous consent, and are moreover subject to the forfeiture of $1 or $10 per copy, as the case may be, one-half thereof to the said proprietor and the other half to the use of the United States, shall be taken possession of by the Collector, who shall take the necessary steps for securing to the United States half of the sum so forfeited, and shall keep the goods in his possession until a decree of forfeiture is obtained, and the half of the sum so forfeited, as well as the duties and charges accrued, are paid; whereupon he shall deliver the goods to the proprietor of the copyright.

In case of failure to obtain a decree of forfeiture, the goods shall be admitted to entry.

See Rules 1, 8, 11 and 14.

The printed copy of the title required by this section may be a copy of the title page of such publications as have title pages. In other cases the title must be printed expressly for copyright entry, with name of claimant of copyright. The style of type is immaterial, and the print of a typewriter will be accepted. A separate title is required for each entry; in case of periodicals, each number of the periodical requires a separate entry of copyright, and the title must include the date and number.

The description required in case of paintings, drawings, etc., should be full and explicit, enumerating all important and essential facts and particulars, and naming a definite title. A mounted photograph, as large as cabinet size, should accompany the description.

Every applicant for a copyright should distinctly state the full name and residence of the claimant; name the article for which a copyright is desired, and state whether the claimant is the author, designer, or proprietor. No affidavit or witness to the application is required.

The printed title, description, and application must be delivered to the Librarian of Congress, or deposited in the mails within the United States prepaid and addressed to the Librarian of Congress, Washington, D. C., on or before the day of publication in this or any foreign country. The two printed copies of the complete work, or in case of paintings, drawings, etc., the photograph, must be delivered or mailed to the Librarian of Congress, in the same way, not later than the day of publication, under the penalty imposed by Sec. 4960, *post*, and the avoidance of the copyright. The copies required may be sent through the mails within the United States free, without limit of weight, by using printed penalty labels, which are furnished by the Librarian of Congress upon application.

Congress by the statute created the right, and no protection can be claimed unless its provisions have been complied with, see Wheaton *v.* Peters, 8 Peters, 591.

If the publication is made before a deposit of a printed copy of the title, the person is not entitled to a copyright, see Baker *v.* Taylor, 2 Blatch., 82. The right accrues from the time a copy of the title of the book is deposited in the Librarian's office, see Wheaton *v.* Peters, 8 Peters, 591; but no copyright is valid unless two copies of the book are delivered to the Librarian of Congress within the prescribed time, see Chase *v.* Sanborn, 6 O. G. 932. In Dwight *v.* Appleton, 1 N. Y. Leg. Obs. 195, it was held that if the work consists of several volumes, the delivery of the copies of the first volumes within the prescribed time, and of the copies of the other volumes before any piracy is committed, or any action is brought therefor, is sufficient.

If there has been no publication of the book no copies of the book need be deposited with the Librarian, see Roberts *v.* Myers, 23 Law Rep. 396.

SEC. 4957. The Librarian of Congress shall record the name of such copyright book, or other article, forthwith in a book to be kept for that purpose, in the words following: "Library of Congress, to wit: Be it remembered that on the day of A. B., of hath deposited in this office the title of a book, (map, chart, or otherwise, as the case may be, or description of the article,) the title or description of which is in the following words, to wit: (here insert the title or

description,) the right whereof he claims as author, (originator, or proprietor, as the case may be,) in conformity with the laws of the United States respecting copyrights. C. D., Librarian of Congress." And he shall give a copy of the title or description under the seal of the Librarian of Congress, to the proprietor, whenever he shall require it.

See Rule 9.

A copy of the record, or an original or a duplicate certificate of any copyright entry can be obtained upon application therefor, and payment of the legal fee of fifty cents each.

SEC. 4958, The Librarian of Congress shall receive from the persons to whom the services designated are rendered, the following fees: 1. For recording the title or description of any copyright book or other article, fifty cents. 2. For every copy under seal of such record actually given to the person claiming the copyright, or his assigns, fifty cents. 3. For recording and certifying any instrument of writing for the assignment of a copyright, one dollar. 4. For every copy of an assignment, one dollar. All fees so received shall be paid into the treasury of the United States: *Provided*, That the charge for recording the title or description of any article entered for copyright, the production of a person not a citizen or resident of the United States, shall be one dollar, to be paid as above into the treasury of the United States, to defray the expenses of lists of copyrighted articles as hereinafter provided for.

See Rule 2.

And it is hereby made the duty of the Librarian of Congress to furnish to the Secretary of the Treasury copies of the entries of titles of all books and other articles wherein the copyright has been completed by the deposit of two copies of such book printed from type set within the limits of the United States, in accordance with the provisions of this act, and by the deposit of two copies of such other article made or produced in the United States; and the Secretary of the Treasury is hereby directed to prepare and print, at intervals of not more than a week, catalogues of such title-entries for distribution to the collectors of customs of the United States and to the postmasters of all post offices receiving foreign mails, and such weekly lists, as they are issued, shall be furnished to all parties desiring them, at a sum not exceeding five dollars per annum; and the Secretary and the Postmaster General are hereby empowered and required to make and enforce such rules and regulations as shall prevent the importation into the United States, except upon the conditions above specified, of all articles prohibited by this act.

See regulations of Treasury Department under Sec. 4956, *ante*.

SEC. 4959. The proprietor of every copyright book or other article shall deliver at the office of the Librarian of Congress, or deposit in the mail, addressed to the Librarian of Congress, at Washington, District of Columbia, a copy of every subsequent edition wherein any substantial changes shall be made: *Provided, however*, That the alterations, revisions, and additions made to books by foreign authors, heretofore published, of which new editions shall appear subsequently to the taking effect of this act, shall be held and deemed capable of being copyrighted as above provided for in this act, unless they form a part of the series in course of publication at the time this act shall take effect.

See Rule 8. Also see Sec. 4956 and notes *ante*, as to method and requirements for depositing copies.

SEC. 4960. For every failure on the part of the proprietor of any copyright to deliver, or deposit in the mail, either of the published copies, or description, or photograph, required by sections 4956 and 4959, the proprietor of the copyright shall be liable to a penalty of twenty-five dollars, to be recovered by the Librarian of Congress, in the name of the United States, in an action in the nature of an action of debt, in any district court of the United States within the jurisdiction of which the delinquent may reside or be found.

SEC. 4961. The postmaster to whom such copyright book, title, or other article is delivered, shall, if requested, give a receipt therefor; and when so delivered he shall mail it to its destination.

SEC. 4962. No person shall maintain an action for the infringement of his copyright unless he shall give notice thereof by inserting in the several copies of every edition published, on the title-page, or the page immediately following, if it be a book; or if a map, chart, musical composition, print, cut, engraving, photograph, painting, drawing, chromo, statue, statuary, or model or design intended to be perfected and completed as a work of the fine arts, by inscribing upon some visible portion thereof, or of the substance on which the same shall be mounted, the following words, viz: "Entered according to act of Congress, in the year ———, by A. B., in the office of the Librarian of Congress, at Washington;" or, at his option, the word "Copyright," together with the year the copyright was entered, and the name of the party by whom it was taken out, thus: "Copyright, 18—, by A. B."

This section imposes an additional duty upon the person obtaining the copyright, as a pre-requisite to its maintenance. He must first acquire a copyright under the provisions of the act, and then in order to enforce his rights against infringers he must also give notice of his right by the means prescribed by this section, see Parkinson *v.* Lasalle, 8 Saw, 331.

If an entire work, embracing a complete system, is composed of several volumes, it is sufficient if the entry is made on the first volume, see Dwight *v.* Appleton, 1 N. Y. Leg. Obs., 195.

The omission to cause the date of the entry of a map to be engraved on some visible portion thereof will prevent a recovery, see King *v.* Force, 2 Cranch C. C. 208.

A notice is valid although the initial of the owner is used instead of the full Christian name, see Sarony *v.* Burrow G. L. Co. 17 Fed. Rep. 591.

Notice that copyright is secured is full protection for the original edition throughout its term, but is no protection to a second edition with notes, nor to any succeeding edition with improvements, see Lawrence *v.* Dana, 7 O. G. 81.

Subsequent editions, without alterations or additions, should give the same notice that the copyright is secured as the original edition, see Lawrence *v.* Dana, 7 O. G. 81.

Successive editions with additions or alterations, need not specify the date of the original copyright, see Lawrence *v.* Dana, 7 O. G. 81. A copyright of a second edition will not cure material defects in the copyright of the original edition, see Lawrence *v.* Dana, 7 O. G. 81.

A mere mistake as to the year in which the book was entered will not deprive the author of the benefit of the statute, see Myers *v.* Callaghan, 5 Fed. Rep. 726.

SEC. 4963. Every person who shall insert or impress such notice, or words of the same purport, in or upon any book, map, chart, dramatic or musical composition, print, cut, engraving, or photograph, or other article, for which he has not obtained a copyright, shall be liable to a penalty of one hundred dollars, recoverable one-half for the person who shall sue for such penalty, and one-half to the use of the United States.

See Rule 4.

The right of action is restricted by the plain language and sense of the statute to a single person. If the plaintiff brings several actions, and the defendant files a demurrer in each, the court will not, on the motion of the plaintiff, order an argument of the demurrer in one of the cases and stay all proceedings in the meantime in the other cases, to abide the event of the one to be argued, see Ferrett *v.* Atwill, 1 Blatch., 151.

The penalty imposed by this section is imposed only in case of articles that are subject to copyright, see Rosenbach *v.* Dreyfuss, 17 O. G. 1153.

As the penalty accrues one-half to the proprietor and one-half to the United States, it is a proper subject of a "*qui tam*" action, see Stevens *v.* Cady, 2 Curt. 200.

SEC. 4964. Every person who, after the recording of the title of any book and the depositing of two copies of such book as provided by this act, shall, contrary to the provisions of this act, within the term limited, and without the consent of the proprietor of the copyright first obtained in writing, signed in presence of two or more witnesses, print, publish, dramatize, translate, or import, or knowing the same to be so printed, published, dramatized, translated, or imported, shall sell or expose to sale any copy of such book, shall forfeit every copy thereof to such proprietor, and shall also forfeit and pay such damages as may be recovered in a civil action by such proprietor in any court of competent jurisdiction.

See Rule 5.

No notice or record is required to secure to authors and their assigns the exclusive right to translate or to dramatize any of their works.

The mere recording of the title does not entitle the party to protection for a book not yet made, for the act says a book, but not an intended book, see Centennial Catalogue Co. *v.* Porter, 2 W. N. 601.

An action on the case is the proper remedy, see Atwill *v.* Ferrett, 2 Blatch., 39.

The words "copy of a book" naturally import a transcript or copy of the entire book. They do not include cases of copying parts of a book, but only the reproduction of the article, see Rogers *v.* Jewett, 22 Law Rep. 339.

The Circuit Courts of the United States have original jurisdiction of all suits at law or in equity arising under the copyright laws, and Sections 629, 690, 699 and 711 of the Revised Statutes apply with equal force to Patent and Copyright cases. For the text of these Sections, see under Patents, *ante*. The practice in copyright actions is substantially the same as in Patent cases. We do not, therefore, give full notes to this and the next six sections, but refer the reader to the corresponding sections under Patents, *ante*.

SEC. 4965. If any person, after the recording of the title of any map, chart, dramatic or musical composition, print, cut, engraving, or photograph, or chromo, or of the description of any painting, drawing, statue, statuary, or model or design intended to be perfected and executed as a work of the fine arts as provided by this act, shall, within the term limited, contrary to the provisions of this act, and without the consent of the proprietor of the copyright first obtained in writing, signed in presence of two or more witnesses, engrave, etch, work, copy, print, publish, dramatize, translate, or import, either in whole or in part, or by varying the main design, with intent to evade the law, or knowing the same to be so printed, published, dramatized, translated, or imported, shall sell or expose to sale any copy of such map or other article, as aforesaid, he shall forfeit to the proprietor all the plates on which the same shall be copied, and every sheet thereof, either copied or printed, and shall further forfeit one dollar for every sheet of the same found in his possession, either printing, printed, copied, published, imported or exposed for sale; and in case of a painting, statue, or statuary, he shall forfeit ten dollars for every copy of the same in his possession, or by him sold or exposed for sale; one-half thereof to the proprietor and the

other half to the use of the United States. *Provided, however*, That in case of any such infringement of the copyright of a photograph made from any object not a work of fine arts, the sum to be recovered in any action brought under the provisions of this section shall be not less than one hundred dollars, nor more than five thousand dollars, and: *Provided, further*, That in case of any such infringement of the copyright of a painting, drawing, statue, engraving, etching, print, or model or design for a work of the fine arts or of a photograph of a work of the fine arts, the sum to be recovered in any action brought through the provisions of this section shall be not less than two hundred and fifty dollars, and not more than ten thousand dollars. One-half of all the foregoing penalties shall go to the proprietors of the copyright and the other half to the use of the United States.

As the penalty accrues one-half to the proprietor and one-half to the United States, it is a proper subject only of a "*qui tam*" action, see Stevens *v.* Cady, 2 Curt. 200.

A photograph is an infringement of a copyrighted engraving. The word "copy" is a general term added to the more specific terms before used for the very purpose of covering methods of reproduction not included in the words engrave, etch or work, see Rossiter *v.* Hall, 5 Blatch., 362.

The penalty of one dollar for every sheet, whether printed, or being printed or published, or exposed for sale, is limited to sheets in the possession of the defendant, see Backus *v.* Gould, 7 How. Pr. 798.

A person who has infringed a copyright cannot be compelled to discover the number of copies he has sold or has on hand, for this would subject him to a penalty, see Chapman *v.* Ferry, 12 Fed. Rep. 693.

SEC. 4966. Any person publicly performing or representing any dramatic composition for which a copyright has been obtained, without the consent of the proprietor thereof, or his heirs or assigns, shall be liable for damages therefor; such damages in all cases to be assessed at such sum, not less than one hundred dollars for the first, and fifty dollars for every subsequent performance, as to the court shall appear to be just.

The object of this section is to secure to the author of a copyrighted play the sole right to its performance after it is printed, while it is in manuscript he needs no such protection, see Boucicault *v.* Fox, 5 Blatch., 87.

A publication of a dramatic composition after the filing of the title is a violation of this section, see Boucicault *v.* Hart, 13 Blatch., 47. The exclusive right to perform a dramatic composition under the statute depends upon a copyright. There is no such right if there is no copyright, *idem*.

An action may be maintained for a representation after recording the title but before the publication, as well as after publication, see Boucicault *v.* Wood, 2 Biss. 34.

If an author after depositing the title of a play with the Librarian of Congress, consents to its publication in a foreign country prior to the publication here, any manager has the right to import the play and use it on the stage, for this is an abandonment of his rights under our laws, see Boucicault *v.* Wood, 2 Biss. 34.

SEC. 4967. Every person who shall print or publish any manuscript whatever, without the consent of the author or proprietor first obtained, shall be liable to the author or proprietor for all damages occasioned by such injury.

The right of an author in his manuscript at common law has not been taken away or abridged by the statute relating to copyrights, see Woolsey *v.* Judd, 4 Duer, 379.

The word "manuscript" does not include a picture, see Parton *v.* Prang, 2 O. G. 619.

A surreptitious publication of a substantial part of a manuscript is within the principle of the statute, see Bartlett *v.* Crittenden, 5 McLean, 32.

An author at common law has a property in a manuscript, and may obtain redress against any one who deprives him of it, or by improperly obtaining a copy endeavors to

realize a profit by its publication, see Wheaton *v.* Peters, 8 Peters, 591. This exclusive right is the right of property in the words, thoughts and sentiments, which in their connection form the written composition, see Woolsey *v.* Judd, 4 Duer, 379. This right is absolute and unlimited. As owner he has an absolute right to suppress as well as to publish. *Idem.*

Publication is circulation before the public eye by printing or multiplied copies in writing, see Grigsby *v.* Breckenridge, 2 Bush, 480.

An author retains his right in his manuscript until he relinquishes it by contract or some unequivocal act indicating an intent to dedicate it to the public, see Palmer *v.* DeWitt, 47 N. Y. 532.

After publication an author's exclusive right to his manuscript ceases at common law, see Palmer *v.* DeWitt, 5 Abb. Pr. (N. S.) 130.

A manuscript of a dramatic composition is equally under the protection of the law with any other work, see Keene *v.* Kimball, 82 Mass. 545. The rights of an author of a drama are two-fold. He is entitled to the profit arising from its performance, and also from the sale of the manuscript or the printing and publishing it, see Palmer *v.* DeWitt, 47 N. Y. 532.

A performance of a play at a theatre is a general publication, see Keene *v.* Wheatley, 4 Phila. 157, but if a general publication of a play does not enable others to represent it through a retention of the words in their memory, the author's proprietorship continues. *Idem.* If a spectator retains it by memory alone and publishes it, the exclusive right is gone, see Palmer *v.* DeWitt, 5 Abb. Pr. (N. S.) 130.

The author of any letter, whether it is a literary composition, or a familiar letter, or a letter of business, possesses the sole and exclusive copyright therein, see Folsom *v.* Marsh, 2 Story, 100. By sending a letter the author parts with his right to the possession, control or reclamation thereof without the consent of the receiver, and gives the latter the exclusive right to read and keep it, see Grigsby *v.* Breckenridge, 2 Bush, 480. The author has the right to publish the letter if he keeps or can procure a copy; the recipient has the right to keep it, or destroy it, or dispose of it in any other way than by publication, *Idem*; he may read the letter to a friend, or deposit it for safe keeping, without violating the author's right of publication, *Idem.* A person to whom a letter is addressed has no right to publish it, except to protect or vindicate himself, see Folsom *v.* Marsh, 2 Story, 100.

SEC. 4968. No action shall be maintained in any case of forfeiture or penalty under the copyright laws, unless the same is commenced within two years after the cause of action has arisen.

Every printing for sale is a new infraction of the right, and if such printing was within two years before the suit was brought, the defendant is liable, see Reed *v.* Carusi, Taney, 72.

SEC. 4969. In all actions arising under the laws respecting copyrights the defendant may plead the general issue, and give the special matter in evidence.

SEC. 4970. The circuit courts, and districts courts having the jurisdiction of circuit courts, shall have power, upon bill in equity, filed by any party aggrieved, to grant injunctions to prevent the violation of any right secured by the laws respecting copyrights, according to the course and principles of courts of equity, on such terms as the court may deem reasonable.

A motion for a preliminary injunction will be disposed of on the affidavits of the parties, and will not be referred to a master, see Smith *v.* Johnson, 4 Blatch., 252 Such injunction may be granted although the questions involved have never been settled by any prior adjudication, see Little *v.* Gould, 2 Blatch., 165.

Where an infringement is palpable, and a provisional injunction will not be attended with serious injury, it is not ordinarily refused as to so much of the work as is a plain infringement of the prior publication, see Banks *v.* McDivett, 8 O. G. 860. If there are doubts in regard to the infringement of a copyright the defendant may be allowed to give bond instead of awarding a preliminary injunction, see Hubbard *v.* Thompson, 14 Fed. Rep. 689.

See notes under Sec. 4921 (Patents) *ante.*

SEC. —. [Approved June 18, 1874, to take effect August 1, 1874.]

In the construction of this act the words "engraving," "cut," and "print," shall be applied only to pictorial illustrations or works connected with the fine arts, and no prints or labels designed to be used for any other articles of manufacture shall be entered under the copyright law, but may be registered in the Patent Office. And the Commissioner of Patents is hereby charged with the supervision and control of the entry or registry of such prints or labels, in conformity with the regulations provided by law as to copyright of prints, except that there shall be paid for recording the title of any print or label, not a trade-mark, six dollars, which shall cover the expense of furnishing a copy of the record, under the seal of the Commissioner of Patents, to the party entering the same.

See Labels and Prints *ante*.

SEC. —. [Approved Aug. 1, 1882.] That manufacturers of designs for molded decorative articles, tiles, plaques, or articles of pottery or metal subject to copyright may put the copyright mark prescribed by section forty-nine hundred and sixty-two of the Revised Statutes, and acts additional thereto, upon the back or bottom of such articles, or in such other place upon them as it has heretofore been usual for manufacturers of such articles to employ for the placing of manufacturers, merchants, and trade-marks thereon.

SEC. 11. [Approved March 3, 1891, to take effect July 1, 1891.] That for the purpose of this act each volume of a book in two or more volumes, when such volumes are published separately, and the first one shall not have been issued before this act shall take effect, and each number of a periodical shall be considered an independent publication, subject to the form of copyrighting as above.

See Rule 10.

In the case of books published in more than one volume, or of periodicals published in numbers, or of engravings, photographs, or other articles published with variations, a copyright must be entered for each volume or part of a book, or number of a periodical, or variety, as to style, title, or inscription, of any other article. To complete the copyright on a book published serially in a periodical, two copies of each serial part as well as of the complete work (if published separately), should be deposited.

SEC. 12. That this act shall go into effect on the first day of July, anno Domini eighteen hundred and ninety-one.

SEC. 13. [Approved March 3, 1891, to take effect July 1, 1891.] That this act shall only apply to a citizen or subject of a foreign state or nation when such foreign state or nation permits to citizens of the United States of America the benefit of copyright on substantially the same basis as its own citizens; or when such foreign state or nation is a party to an international agreement which provides for reciprocity in the granting of copyright, by the terms of which agreement the United States of America may at its pleasure become a party to such agreement. The existence of either of the conditions aforesaid shall be determined by the President of the United States, by proclamation made from time to time as the purposes of this act may require.

International copyright arrangements have now (January 1, 1896) been concluded between the United States and Great Britain and her Colonies, France, Belgium, Switzerland, Germany, Italy, Denmark, Spain, and Portugal, and citizens or subjects of these countries may now obtain copyright protection of their works in the United States.

PATENTS.

FORMS FOR APPLICATION BY A SOLE INVENTOR.

Petition with Power of Attorney.

To the Commissioner of Patents:

Your Pet'tioner, (*insert full names of inventor*), a citizen, (*or subject, and state of what country applicant is a citizen or subject, as, for instance, "a citizen of the Republic of France," or "a subject of the Queen of Great Britain and Ireland,"*) residing at (*insert residence of applicant*), prays that Letters Patent may be granted to him for the (*insert title of invention*), set forth in the annexed specification; and he hereby appoints William E. Richards and William W. White, doing business under the name and style of Richards & Co., of the city, county and State of New York, and of Washington, D. C., his attorneys, with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to receive the Patent, and to transact all business in the Patent Office connected therewith.

(*Signature.*)

Specification.

To all whom it may concern:

Be it known that I, (*insert full name of inventor*), a citizen, (*or subject, and state of what country applicant is a citizen or subject*), and resident of (*insert residence*), have invented a certain new and useful (*insert title of invention, and if the invention has already been patented in any other country, insert here the words* for which I have obtained a patent (*or patents*) in, *and state in what countries patents have been obtained, giving the numbers and dates of the patents, as:* "*Great Britain No.* 1428, *bearing date June* 24, 1890," *etc.,*) of which the following is a specification:

The objects of my invention are (*here insert a brief description of the objects of the invention*).

Referring to the drawings which form a part of this specification, Figure 1 is (*here insert a brief description of each figure of the drawings, after which insert the specification or description of the invention, inserting before the claims the words*);

Having now described my invention, what I claim as new and desire to secure by Letters Patent is: (*Insert claims.*)

In witness whereof I have hereunto set my hand in presence of two witnesses.

(*Inventor signs here.*)

Witnesses:

(*Two witnesses must sign here.*)

Oath.

(*Insert place of execution.*).....
(*Insert name of country.*)..... } *ss.*

(*Insert name of inventor*), the above-named petitioner, a citizen (*or subject, and state of what country he is a citizen or subject, as for instance, "a citizen of the Republic of Switzerland," or "a subject of the King of Prussia"*), and resident of (*insert residence*), being duly sworn, deposes and says that he verily believes himself to be the original, first, and sole inventor of the (*insert title of invention*) described and claimed in the foregoing specification; that the same has not been patented to himself or to others with his knowledge or consent. (*If the invention has not been patented in any other country, add the words* "in any country." *If prior patents exist, add the words* "except in," *and proceed to state the name or names of the country or countries in which it has been patented, and the official number and date of such prior patents, as for example:* "*Great Britain, No.* 4120, *Dated January* 1, 1890," *etc.,*); that the same has not to his knowledge been in public use or on sale in the United States for more than two years prior to this application, and he does not know and does not believe that the same was ever known or used prior to his invention thereof.

(*Signature.*)

Sworn to and subscribed before me this (*insert date*).
(*Seal of officer administering oath.*)

(*Signature of official administering the oath.*)

FORMS FOR APPLICATION BY JOINT INVENTORS.

Petition with Power of Attorney.

To the Commissioner of Patents:

Your petitioners, (*insert name of one inventor*), a citizen (*or subject, and state of what country he is a citizen or subject*), residing at (*insert residence of first inventor*), and (*insert name of second joint inventor*), a citizen (*or subject, and state of what country he is a citizen or subject*), residing at (*insert residence of second inventor*), pray that Letters Patent may be granted to them for the (*insert title of invention*) set forth in the annexed specification: and they hereby appoint William E. Richards and William W. White, doing business under the name and style of Richards & Co., of the city, county and State of New York, and of Washington, D. C., their attorneys, with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to receive the Patent, and to transact all business in the Patent Office connected therewith.

(*Signature of first inventor.*)
(*Signature of second inventor.*)

Specification.

To all whom it may concern:

Be it known that we, (*insert name of one inventor*), a citizen (*or subject, and state of what country he is a citizen or subject*), residing at (*insert his residence*), and (*insert name of second inventor*), a citizen (*or subject, and state of what country he is a citizen or subject*), residing at (*insert his residence*), have invented a certain new and useful (*insert title of invention. If the invention has already been patented in any other country insert here the words* for which we have obtained a patent (*or patents*) in, *and state in what countries patents have been obtained, giving the number and date of each patent, as for instance,* "*Great Britain, No.* 1736, *bearing date September* 22, 1890; *France, No.* 214,976, *bearing date January* 1, 1890," *etc.,*) of which the following is a specification:

The objects of the invention are (*here briefly describe the objects of the invention*).

Referring to the drawings which form a part of this specification, Figure 1 is (*here give a brief description of each figure of the drawings, and follow with the specification or description of the invention, inserting before the claims the words*):

Having now described our invention, what we claim as new and desire to secure by Letters Patent is: (*Insert claims.*)

In witness whereof we have hereunto set our hands in presence of two witnesses.

(*First inventor signs here.*)

Witnesses. (*Second inventor signs here.*)

(*Two witnesses must sign here.*)

OATH.

(*Insert place of execution.*).....
(*Insert name of country.*)..... } ss.

(*Insert name of one inventor*), a citizen (*or subject, and state of what country he is a citizen or subject*), and resident of (*insert place of residence*), and (*insert name of other inventor*), a citizen (*or subject, and state of what country he is a citizen or subject*), and resident of (*insert place of residence*), the above-named petitioners, being duly sworn, depose and say that they verily believe themselves to be the original, first and joint inventors of the (*insert title of invention*) described and claimed in the foregoing specification; that the same has not been Patented to themselves or to others with their knowledge or consent (*if the invention has not been patented in any other country, add the words* "in any country." *If prior patents exist, add the words*, "except in" *and proceed to state the name or names of the country or countries in which it has been patented, and the official number and date of such prior patents, as for example:* "*Great Britain, No. 4120, dated January 1, 1890,*" *etc.*); that the same has not to their knowledge been in public use or on sale in the United States for more then two years prior to this application, and they do not know and do not believe that the same was ever known or used prior to their invention thereof.

(*First inventor signs here.*)

(*Second inventor signs here.*)

Sworn to and subscribed before me this day of.....(*insert date*).

(*Signature of official administering oath.*)

(*Official seal of officer administering oath.*)

FORMS FOR AN APPLICATION BY AN ADMINISTRATOR.

NOTE.—An application by an administrator must be accompanied by a duly certified copy of the letters of administration.

In case of a deceased foreign inventor it is necessary to apply for and obtain ancillary letters of administration in the name of a resident of the United States, and make the application in his name.

PETITION WITH POWER OF ATTORNEY.

To the Commissioner of Patents:

Your petitioner, (*insert full name*), a citizen (*or subject, and state of what country applicant is a citizen or subject,*) residing at (*insert residence*), administrator of the estate of (*insert full name and last residence of inventor*), late a citizen (*or subject, and state of what country he was a citizen or subject*), deceased, as by reference to the duly certified copy of letters of administration hereto annexed will more fully appear, prays that Letters Patent may be granted to him for the invention of the said (*insert name of inventor*), for (*insert title of invention*), set forth in the annexed specification; and he hereby appoints William E. Richards and William W. White, doing business under the name and style of Richards & Co., of the city, county and State of New York, and of Washington, D. C., his attorneys, with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to receive the Patent, and to transact all business in the Patent Office connected therewith.

(*Signature.*)

SPECIFICATION.

To whom it may concern:

Be it known that (*insert name of inventor*), late a citizen of (*or subject of, and proceed to state of what country he was a citizen or subject*), and a resident of (*insert last place of residence*), but now deceased, did invent a certain new and useful (*insert title of invention, and if any foreign patents have been obtained add the words*, for which patents have been obtained in, *and proceed to specify the countries in which patents have been obtained and the number and date of each patent*), of which the following is a full, clear, and exact specification.

The invention has for its object. (*Here proceed with the specification and claims as in other cases.*)

(*Signature of administrator*),
Administrator of the estate of (*insert name of deceased inventor*) deceased.

Witnesses:
(*Signatures of two witnesses.*)

OATH.

(*Insert place of execution.*).....
(*Insert name of country.*)..... } ss.

(*Insert name of administrator*), the above-named petitioner, a citizen (*or subject, and state of what country he is a citizen or subject*), and resident of (*insert residence*), being duly sworn, deposes and says that he is the administrator of the estate of (*insert name of inventor*), late a citizen (*or subject, and state of what country he was a citizen or subject*), and resident of (*insert last place of residence*), deceased; that he verily believes that the said (*insert name of inventor*) was the original, first and sole inventor of the improvement in (*insert title of invention*), described and claimed in the foregoing specification; that the same has not been patented to himself, or to others with his knowledge or consent (*if the invention has not been patented in any country add the words* "in any country." *If prior patents exist, add the words*, "except in the following countries," *and proceed to state the name or names of the country or countries in which the same has been patented, as for example:* "*Great Britain, No. 4125, dated January 1, 1890: France, No. 192,478, dated January 2, 1890,*" *as the case may be*); that the same has not to his knowledge been in public use or on sale in the United States for more than two years prior to this application, and he does not know and does not believe that the same was ever known or used prior to the said (*insert inventor's name*) invention thereof.

(*Signature.*)

Sworn to and subscribed before me this.....day of.....189....

(*Signature of official administering the oath.*)

(*Official seal of officer administering oath.*)

FORMS FOR AN APPLICATION BY AN EXECUTOR.

NOTE.—An application by an executor must be accompanied by a duly certified copy of the letters testamentary.

In case of a deceased foreign inventor it is necessary to apply for and obtain ancillary letters of administration in the name of a resident of the United States, and make the application for patent in his name.

PETITION WITH POWER OF ATTORNEY.

To the Commissioner of Patents:

Your petitioner, (*insert name and residence of executor*), a citizen (*or subject, and state of what country the executor is a citizen or subject*), executor of the last will and testament of (*insert name and last residence of inventor*), late a citizen (*or subject, and state of what country the inventor was a citizen or subject*), deceased, as by reference to the duly certified copy of letters testamentary, hereto annexed, will more fully appear, prays that Letters Patent may be granted to him for the invention of the said (*insert name of inventor*), for a (*insert title of invention*), set forth in the annexed specification; and he hereby appoints William E. Richards, and William W. White, doing business under the name and style of Richards & Co., of the city, county and State of New York, and of Washington, D. C., his attorneys, with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to receive the Patent, and to transact all business in the Patent Office connected therewith. (*Signature.*)

SPECIFICATION.

To all whom it may concern:

Be it known that (*insert name of inventor*), who was a citizen of (*or subject of, and state of what country he was a citizen or subject*), and a resident of (*insert last residence*), but is now deceased, did invent a certain new and useful (*insert title of invention and if any foreign patents have been obtained add the words* for which patents have been obtained in, *and proceed to specify the countries in which such patents have been obtained, stating the number and date of each*), of which the following is a full, clear and exact specification:

(*Here proceed with the specification and claims as in other cases.*)

(*Signature of Executor.*)

Witnesses:

(*Signatures of two witnesses.*)

Executor of the estate of (*insert name of deceased inventor*) deceased.

NOTE.—All the executors, if there be more than one, should join in the application and in executing the documents.

OATH.

The form is precisely the same as for an administrator, except that he "*deposes and says he is the executor of the last will and testament of*" instead of "administrator of the estate of," in the first few lines of the document.

REVOCATION OF POWER OF ATTORNEY, AND APPOINTMENT OF NEW ATTORNEY.

To the Commissioner of Patents:

The undersigned, having on or about the (*insert date*) appointed (*insert name and address of attorney whose power is to be revoked*), his attorney to prosecute an application for Letters Patent for (*insert title of invention*), which application was filed in the Patent Office on or about (*insert filing date*), serial number (*insert serial number*), hereby revokes the power of attorney then given, and appoints William E. Richards and William W. White, doing business under the name and style of Richards & Co., of the city, county and State of New York, and Washington, D. C., his attorneys, with full power of substitution and revocation, to prosecute said application, to make alterations and amendments therein, to receive the Patent, and to transact all business in the Patent Office connected therewith. (*Signature.*)

FORM FOR SUPPLEMENTAL OATH AS TO FOREIGN PATENTS.

SUPPLEMENTAL OATH AS TO FOREIGN PATENTS.

(*Insert place of execution.*).....
(*Insert name of country.*)..... } ss.

(*Insert name of inventor*), whose application for Letters Patent for an improvement in (*insert title of invention*) was filed in the United States Patent Office on or about the (*insert date of filing*), being duly sworn, deposes and says that he is the applicant named in the application above described; that he verily believes himself to be the original, first and sole inventor of the said improvements, and that the same have not been patented to him, or to others with his knowledge or consent, except in the following countries: (*here insert the numbers and dates of all existing foreign patents, as for example:* "Great Britain, No. 4715, dated June 4, 1880; France, No. 104,615, dated May 12, 1881," etc., *as the case may be.*) (*Signature.*)

Sworn to and subscribed before me this (*insert date*).

(*Signature of official administering oath.*)

(*Official Seal.*)

FORM OF SUPPLEMENTAL OATH TO ACCOMPANY A NEW OR AN ENLARGED CLAIM.

OATH.

(*Insert place of execution.*).....
(*Insert name of country.*)..... } ss.

(*Insert name of inventor*), whose application for Letters Patent for an improvement in (*insert title of invention*), serial number (*insert serial number*), was filed in the United States Patent Office on or about the (*insert date of filing*), being duly sworn, deposes and says that he verily believes himself to be the original, first and sole inventor of the improvement as described and claimed as follows: (*here insert the claim or claims in question*), in addition to that which was embraced in the claim originally made, and that he does not know and does not believe that the same was ever before known or used, and that the matter sought to be inserted formed a part of his original invention at the date of filing said application, and was invented by him before he filed the same. (*Signature.*)

Sworn to and subscribed before me this (*insert date*).

(*Signature of official administering the oath.*)

[*Official Seal.*]

RE-ISSUES.

FORMS FOR APPLICATION FOR A RE-ISSUE. BY AN INVENTOR.

Petition with Power of Attorney.

To the Commissioner of Patents:

Your petitioner, (*insert name of inventor*), a citizen (*or subject, and state of what country the applicant is a citizen or subject*), residing at (*insert residence*), prays that he may be allowed to surrender the Letters Patent for an improvement in (*insert title of invention*), granted to him, (*insert date of patent*), whereof he is now sole owner (*or, if the patent has been assigned, whereof (insert name of assignee) on whose behalf and with whose assent this application is made, is now sole owner, by assignment,*) and that letters patent may be re-issued to him (*or to the said [insert name of assignee]*) for the same invention, upon the annexed amended specification. With this petition is filed an abstract of title, duly certified, as required in such cases. And your petitioner hereby appoints William E. Richards and William W. White, doing business under the name and style of Richards & Co., of the city, county and State of New York, and of Washington, D. C., his attorneys, with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to receive the Patent, and to transact all business in the Patent Office connected therewith.

(*Signature.*)

Note.—If the patent has been assigned, the assent of the assignee must be procured in the following form:

The undersigned, assignee of the entire (*or if of an interest, here define it*) interest in the above-mentioned letters patent, hereby assents to the accompanying application.

(*Signature of assignee.*)

Oath.

(*Insert place of execution*) .....
(*Insert name of country*) ..... } ss.

(*Insert name of inventor*), the above-named petitioner, being duly sworn, deposes and says that he does verily believe himself to be the original and first inventor of the improvement set forth and claimed in the foregoing specification, and for which improvement he solicits a patent; that deponent does not know and does not believe that said improvement was ever before known or used; that deponent is a citizen (*or subject, and state of what country he is a citizen or subject*), and resides at (*insert residence*); that deponent verily believes that the letters patent referred to in the foregoing petition and specification, and herewith surrendered, are inoperative (*or invalid*) for the reason that the specification thereof is defective (*or insufficient*), and that such defect (*or insufficiency*) consists particularly (*here insert a statement particularly specifying such defects or insufficiencies*); and deponent further says that the errors which render such patent so inoperative (*or invalid*) arose from inadvertence (*or accident, or mistake*), and without any fraudulent or deceptive intention on the part of deponent; that the following is a true specification of the errors which it is claimed constitute such inadvertence (*or accident, or mistake*), relied upon: (*here recite the facts*); that such errors so particularly specified arose (*or occurred*) as follows: (*state here how the errors arose or occurred*).

(*Signature of Inventor.*)

Subscribed and sworn to before me this (*insert date*).

(*Signature of official administering oath.*)

[*Official Seal.*]

FORMS FOR APPLICATION FOR RE-ISSUE. BY THE ASSIGNEES.

(*To be used only when the inventor is dead.*)

Petition with Power of Attorney for a Re-issue.

To the Commissioner of Patents:

Your petitioners, (*insert name of one assignee*), a citizen (*or subject, and state of what country he is a citizen or subject*) residing at (*insert place of residence*), and (*insert name of other assignee*), a citizen (*or subject, and state of what country he is a citizen or subject*), residing at (*insert place of residence*), pray that they may be allowed to surrender the Letters Patent for an improvement in (*insert title of invention*), granted (*insert date of patent*), to (*insert name of patentee*), now deceased, whereof they are now owners by assignment of the entire interest, and that the Letters Patent may be re-issued to them for the same invention, upon the annexed amended specification. With this petition is filed an abstract of title duly certified, as required in such cases. Your petitioners hereby appoint William E. Richards and William W. White, doing business under the name and style of Richards & Co., of the city, county and State of New York, and of Washington, D. C., their attorneys, with full powers of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to receive the Patent, and to transact all business in the Patent Office connected therewith.

(*Signatures.*)

Oath.

(*Insert place of execution*) .....
(*Insert name of country*) ..... } ss.

(*Insert names, addresses, and citizenship of assignees,*) the above-named petitioners, being duly sworn, depose and say that they verily believe that the aforesaid letters patent granted to (*insert name of patentee*) are (*here follow allegations as in oath for re-issue by inventor, the necessary changes being made to make them apply to the assignees, after which and before the signatures) the following must be added*): that the entire title to said letters patent is vested in them, and that they verily believe the said (*insert name of patentee*) to be the first and original inventor of the invention set forth and claimed in the foregoing amended specification, and that the said (*insert name of patentee*) is now deceased.

(*Signatures of assignees.*)

Sworn to and subscribed before me this (*insert date*).

(*Signature of official administering oath.*)

[*Official Seal.*]

DISCLAIMER.

FORM FOR DISCLAIMER AFTER ISSUE OF PATENT.

DISCLAIMER.

To the Commissioner of Patents:

Your petitioner, (*insert name of disclaimant*), a citizen (*or subject, and state of what country he is a citizen or subject*), residing at (*insert residence*), represents that in the matter of a certain improvement in (*insert title of invention*), for which letters patent of the United States No. (*insert number of patent*) were granted to (*insert name of patentee*) on the (*insert date of patent*), he is the (*here set forth the exact facts as to the interests in said patent owned by the disclaimant; if he is the assignee, state the liber and page where assignment is recorded*), and that he has reason to believe that through inadvertence (*or accident or mistake*) the specification and claim of said letters patent are too broad, including that of which the patentee was not the first inventor. Your petitioner, therefore, hereby enters his disclaimer to that part of the claim in said specification which is in the following words, to wit; (*here recite the part disclaimed.*)

(*Signature.*)

Witness:
(*Signature of Witness.*)

INTERFERENCE.

FORM FOR DOMESTIC INVENTOR.

STATEMENT IN INTERFERENCE.

(*Preliminary Statement of Domestic Inventor.*)

(*Insert name of Inventor.*) *vs.* (*Insert name of Opponent.*)	Interference in United States Patent Office. No. (*Insert number.*) Preliminary Statement of (*Insert name of Inventor.*)

(*Insert name of inventor*), of (*insert residence of inventor*), being duly sworn, doth depose and say that he is a party to the interference declared by the Commissioner of Patents, (*insert date of declaration of interference*), between his application for letters patent, filed (*insert date of filing application*), serial number (*insert serial number*), and the (*state whether application or patent*) of (*insert name of opponent*), No. (*insert number*), for (*insert title of invention*); that he conceived the invention set forth in the declaration of interference on or about the (*state date of conception*); that on or about the (*insert date*) he made drawings of the invention (*if he has not made a drawing, then he should say that no drawing of the invention in issue has been made*); that on or about the (*insert date*) he first explained the invention to others, and that he made a model showing such invention on or about the (*insert date*), (*if he has not made a model, then he should allege that no model of the invention in issue has been made*); that he embodied his invention in a full-sized machine, which was completed about the (*insert date*), and that on the (*insert date*) the said machine was successfully operated at his shop in (*insert name of town or city, county and State*), and that he has since continued to use the same, and that he has manufactured others for use and sale. (*If he has not embodied the invention in a full-sized machine, he should so state, and if he has embodied it, but has not used it, he should so state.*)

(*Inventor signs here.*)

Subscribed and sworn to before me this (*insert date*).

[*Official Seal.*]

(*Signature of official administering oath.*)

FORM OF PRELIMINARY STATEMENT IN INTERFERENCE FOR A FOREIGN INVENTOR.

STATEMENT IN INTERFERENCE.

(*Preliminary Statement of Foreign Inventor.*)

(*Insert name of Inventor.*) *vs.* (*Insert name of Opponent.*)	Interference in United States Patent Office. No. (*Insert number.*) Preliminary Statement of (*Insert name of Inventor.*)

(*Insert name and residence of inventor*), being duly sworn, doth depose and say that he is a party to the interference declared by the Commissioner of Patents (*insert date of the declaration of interference*), between his application for patent filed (*insert date of filing*), serial number (*insert serial number*), and the (*state whether application or patent*) of (*insert name of opponent*), No. (*insert number*), for (*insert title of invention*); that he made the invention set forth in the declaration of interference, being at that time in (*insert name of place*); that patents for such invention were applied for and obtained as follows: (*here insert the dates of all applications for foreign patents that have been made, together with the numbers and dates of each patent, as for instance: "Application filed in Great Britain, December 4th, 1888, patent numbered 24,076 of 1888, and dated December 4th, 1888," etc., etc. If a patent has not been obtained in any country it should be so stated.*)

That such invention was fully described in: (*Here set forth any publications of the invention, giving the dates, and stating where such publications appeared, and when and where such publications were introduced into the United States, if at all. If the invention was never described in a publication it should be so stated.*)

That knowledge of such invention was introduced into the United States under the following circumstances: On (*insert date*), the said (*name of inventor*) wrote a letter to (*insert name*) residing at (*insert residence*), describing such invention, and soliciting his services in procuring a patent therefor in the United States. (*Here proceed to recite the facts, showing to whom in the United States knowledge of the invention was disclosed for the purpose of making application for patent therefor; the earliest date upon which such knowledge of the invention was introduced into the United States, etc.*

If the invention has been manufactured in the United States, state when, and to whom the applicant first wrote to secure such manufacture, and also whether the invention has been described in trade circulars in the United States, the date, etc., and any other information that will show when and where the invention was first introduced into or disclosed in the United States. If the invention has not been introduced into the United States otherwise than by the application papers, it should be so stated.)

(*Signature.*)

Subscribed and sworn to before me this (*insert date*).

[*Official Seal.*]

(*Signature of official administering oath.*)

NOTE.—This statement must be subscribed and sworn (or affirmed) to before a Notary Public, or a Diplomatic or Consular Officer of the United States, who must in all cases affix his official seal.

ASSIGNMENTS.

FORM OF ASSIGNMENT TO ACCOMPANY AN APPLICATION FOR PATENT WHEN IT IS DESIRED THAT THE PATENT SHALL ISSUE TO AN ASSIGNEE.

ASSIGNMENT.

Whereas I, (*insert name of inventor*), of (*insert residence of inventor*), have invented a certain new and useful (*insert title of invention*), for which I am about to make application for letters patent of the United States therefor.

And whereas, (*insert name of assignee*), of (*insert residence of assignee*), is desirous of acquiring an interest in said invention, and in the letters patent to be obtained therefor.

Now, therefore, to all whom it may concern, be it known that for and in consideration of the sum of (*insert consideration*), to me in hand paid, the receipt of which is hereby acknowledged, I, the said (*insert name of assignor*), have sold, assigned, and transferred, and by these presents do sell, assign, and transfer unto the said (*insert name of assignee*), all my right, title and interest in and to the said invention, as fully set forth and described in the specification prepared and executed by me on the (*insert date of execution of application*), preparatory to obtaining letters patent of the United States therefor; and I do hereby authorize and request the Commissioner of Patents to issue the said letters patent when granted to the said (*insert name of assignee*).

In testimony whereof I have hereunto set my hand and affixed my seal this (*insert date*).

In presence of (*Signature of inventor.*) [SEAL.]
(*Signatures of two witnesses.*)

FORM OF ASSIGNMENT OF PARTIAL INTEREST, WHERE APPLICATION HAS BEEN FILED, WITH REQUEST TO ISSUE PATENT TO INVENTOR AND ASSIGNEE JOINTLY.

ASSIGNMENT.

Whereas I, (*insert name of inventor*), of (*insert residence of inventor*), have invented a certain new and useful (*insert title of invention*), for which I have made application for letters patent of the United States therefor, said application having been filed in the United States Patent Office on or about (*insert date upon which application was filed*), serial number (*insert serial number of application*).

And Whereas, (*insert name of assignee*), of (*insert residence of assignee*), is desirous of acquiring an interest in said invention, and in the letters patent to be obtained therefor:

Now, therefore, to all whom it may concern, be it known, that for and in consideration of the sum of (*insert consideration*). to me in hand paid, the receipt of which is hereby acknowledged, I, the said (*insert name of inventor*), have sold, assigned, and transferred, and by these presents do sell, assign, and transfer unto the said (*insert name of assignee*), an undivided one-half part of the whole right, title and interest in and to the said invention, and in and to the letters patent to be obtained therefor, and I do hereby authorize and request the Commissioner of Patents to issue the said letters patent when granted to me and to the said (*insert name of assignee*), jointly.

In testimony whereof I have hereunto set my hand and affixed my seal this (*insert date*), at (*insert place of execution*).

In presence of (*Signature.*) [SEAL.]
(*Signatures of two witnesses.*)

FORM OF ASSIGNMENT. AFTER ISSUE OF PATENT.

ASSIGNMENT.

Whereas I, (*insert name and address of patentee,*) did obtain letters patent of the United States of America, for an invention entitled (*insert title of invention*), which letters patent are numbered (*insert number of patent*), and bear date the (*insert date of patent*).

And whereas, (*insert name and address of assignee*), is desirous of acquiring an interest in the same:

Now, therefore, to all whom it may concern, be it known that for and in consideration of the sum of (*insert consideration*), to me in hand paid, the receipt of which is hereby acknowledged, I, the said (*insert name of assignor*), have sold, assigned, and transferred, and by these presents do sell, assign and transfer unto the said (*insert name of assignee*), all my right, title and interest (*or an undivided one-half interest, or whatever interest may be assigned, as the case may be*), in and to the said invention, and in and to the letters patent therefor aforesaid: the same to be held and enjoyed by the said (*insert name of assignee*), for his own use and behoof, and for the use and behoof of his legal representatives and assigns, to the full end of the term for which said letters patent are or may be granted, as fully and entirely as the same would have been held and enjoyed by me had this assignment and sale not been made.

In testimony whereof I have hereunto set my hand and affixed my seal at (*insert place of execution*), this (*insert date*).

In presence of (*Signature.*) [SEAL.]
(*Signatures of two witnesses.*)

CAVEATS.

NOTE.—Only citizens of the United States, or aliens who have resided in the United States for one year next preceding the filing of the caveat, and who have declared their intention to become citizens of the United States, are entitled to file caveats.

FORM OF PETITION WITH POWER OF ATTORNEY.

To the Commissioner of Patents:

The petition of (*insert name of petitioner*), a citizen of the United States (*or if a resident alien recite the facts in accordance with the above note*), residing at (*insert residence*), represents:

That he has made certain improvements in (*insert title of invention*), and that he is now engaged in making experiments for the purpose of perfecting the same, preparatory to applying

for letters patent therefor. He therefore prays that the subjoined description of his invention may be filed as a caveat in the confidential archives of the Patent Office.

And he hereby appoints William E. Richards and William W. White, doing business under the name and style of Richards & Co., of the city, county and State of New York, and of Washington, D. C., his attorneys, with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, and to transact all business in the Patent Office connected therewith.

(*Signature.*)

SPECIFICATION.

To the Commissioner of Patents:

Be it known that I, (*insert name of caveator*), a citizen of the United States (*or if a resident alien recite the facts in accordance with the above note*), and residing at (*insert residence*), having invented (*insert title of invention*), and desiring further to mature the same, file this my caveat therefor, and pray protection of my right until I shall have matured my invention.

The following is a description of my invention, which is as full, clear, and exact as I am able at this time to give, reference being had to the drawing hereto annexed.

(*Here insert a description of the invention. It is not necessary to append claims to a caveat.*)

Witnesses:

(*Signature of Caveator.*)

(*Signatures of two witnesses.*)

OATH.

(*Insert place of execution.*).....} ss.
(*Insert name of country.*).....}

(*Insert name of caveator*), the above-named petitioner, a citizen of the United States (*or if a resident alien recite the facts in accordance with above note*), and resident of (*insert residence*), being duly sworn, deposes and says that he verily believes himself to be the original and first inventor of the (*insert title of invention*), described in the foregoing specification.

(*Signature of Caveator.*)

Sworn to and subscribed before me this (*insert date*).

[*Official Seal.*]

(*Signature of official administering oath.*)

DESIGN PATENTS.

DOCUMENTS REQUIRED.

NOTE.—The documents required are the same as for other Patents. The forms for Specifications and Oaths are the same as for other Patents, except that in reciting the title of the invention the words "a new and original design for" are to precede the title. The petition must state the term for which protection is asked, as follows:

FORM OF PETITION FOR DESIGN PATENT.

To the Commissioner of Patents:

Your petitioner, (*insert name of inventor*), a citizen of (*or subject of, and state of what country he is a citizen or subject*), residing at (*insert residence*), prays that letters patent may be granted to him for the term of (*here insert the term asked for, whether three and one-half, seven, or fourteen years*), for the new and original design for (*insert title of invention*), set forth in the annexed specification, and he hereby appoints William E. Richards and William W. White, doing business under the name and style of Richards & Co., of the city, county, and State of New York, and of Washington, D. C., his attorneys, with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to sign the drawings, to receive the patent, and to transact all business in the Patent Office connected therewith.

(*Signature of Inventor.*)

TRADE MARKS.

FORMS FOR APPLICATION. BY AN INDIVIDUAL.

APPLICATION FOR THE REGISTRATION OF A TRADE MARK.

LETTER OF ADVICE WITH POWER OF ATTORNEY.

To the Commissioner of Patents:

The undersigned presents herewith a fac-simile of his lawful trade mark and requests that the same, together with the accompanying statement and declaration, may be registered in the United States Patent Office, in accordance with the law in such cases made and provided; and he hereby appoints William E. Richards and William W. White, doing business under the name and style of Richards & Co., of the city, county, and State of New York, and of Washington, D. C., his attorneys, with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to receive the Certificate of Registration, and to transact all business in the Patent Office connected therewith.

(*Signature.*)

STATEMENT.

To all whom it may concern:

Be it known that I, (*insert name of applicant*), a citizen of (*or subject of, and state of what country he is a citizen or subject*), residing at (*insert residence*), and doing business at (*insert business address, naming street and number*), have adopted for my use a trade-mark for (*insert name of goods upon which trade mark is used*), of which the following is a full, clear and exact specification.

My trade mark consists of (*state of what the trade mark consists*). This has generally been arranged, as shown in the accompanying fac-simile, which represents (*here insert a complete description of the trade mark, describing in detail all of its parts and features*).

The essential feature of my trade mark is (*here name the essential features of the trade mark claimed*). This trade mark I have used continuously in my business since (*insert date since when*

the trade mark has been continuously used). The class of merchandise to which this trade mark is appropriated is (*here name such class*), and the particular description of goods comprised in said class upon which I use it is (*here name the particular goods or commodities upon which it is used*). It is my practice to apply my trade mark by (*here state the manner in which the trade mark is applied*).

In witness whereof I have hereunto set my hand in presence of two witnesses.

(*Signature*).

Witnesses:
(*Signatures of two witnesses.*)

DECLARATION.

(*Insert place of execution.*).....
(*Insert name of country*).....} ss.

(*Insert name of applicant*), being duly sworn, deposes and says that he is the applicant named in the foregoing statement; that he verily believes that the foregoing statement is true; that he has at this time a right to the use of the trade mark therein described; that no other person, firm or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that it is used by him in commerce between the United States and foreign nations or Indian tribes, and particularly with (*here name one or more foreign countries or Indian tribes, or both, between which and the United States it is used in commerce*); and that the description and fac-similes presented for record truly represent the trade mark sought to be registered.

(*Signature*).

Sworn and subscribed before me, (*insert title of officer before whom the declaration is made*), this (*insert the date*).

(*Signature of official administering oath.*)

[*Official Seal.*]

FORMS FOR APPLICATION. BY A FIRM.

APPLICATION FOR THE REGISTRATION OF A TRADE MARK.

LETTER OF ADVICE WITH POWER OF ATTORNEY.

To the Commissioner of Patents:

The undersigned present herewith a fac-simile of their lawful trade mark and request that the same, together with the accompanying statement and declaration, may be registered in the United States Patent Office, in accordance with the law in such cases made and provided; and they hereby appoint William E. Richards and William W. White, doing business under the name and style of Richards & Co., of the city, county and State of New York, and of Washington, D. C., their attorneys, with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to receive the Certificate of Registration, and to transact all business in the Patent Office connected therewith.

(*Signature of firm.*)

STATEMENT.

To all whom it may concern:

Be it known that we, (*insert name of firm*), a firm domiciled in (*state place of domicile*), and doing business at (*insert business address, naming street and number*), have adopted for our use a trade mark for (*here insert name of goods upon which the trade mark is used*), of which the following is a full, clear and exact specification:

Our trade mark consists of (*state of what the trade mark consists*). This has generally been arranged as shown in the accompanying fac-simile, which represents (*here insert a complete description of the trade mark, describing in detail all of its parts and features*).

The essential feature of our trade mark is (*here name the essential feature claimed*).

This trade mark has been used continuously in business by us and those from whom we derive our title since (*insert date since when the trade mark has been continuously used*). The class of merchandise to which this trade mark is appropriated is (*here name such class*), and the particular description of goods comprised in such class on which it is used by us is (*here name the particular goods or commodities upon which it is used*). It has been our practice to apply our trade mark by *there state the manner in which the trade mark is applied*).

In witness whereof we have hereunto set our hands in presence of two witnesses.

(*Signature of firm.*)

Witnesses:
(*Signatures of two witnesses.*)

DECLARATION.

(*Insert place of execution.*).....
(*Insert name of country.*).....} ss.

(*Insert the name of the member of the firm who makes the declaration*), being duly sworn, deposes and says that he is a member of the firm, the applicant named in the foregoing statement; that he verily believes that the foregoing statement is true; that the said firm has at this time a right to the use of the trade mark therein described; that no other person, firm or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that the trade mark is used by the said firm in commerce between the United States and foreign nations or Indian tribes, and particularly with (*here name one or more foreign nations or Indian tribes, or both, between which and the United States it is used in commerce*), and that the description and fac-similes presented for record truly represent the trade mark sought to be registered.

(*Signature of the member of the firm who makes the declaration.*)

Sworn and subscribed before me, a (*state official title of officer administering oath.*) this (*insert date.*)

[*Official Seal.*]

(*Signature of official administering oath.*)

FORM OF APPLICATION. BY A CORPORATION.

APPLICATION FOR THE REGISTRATION OF A TRADE MARK.

LETTER OF ADVICE WITH POWER OF ATTORNEY.

To the Commissioner of Patents:

The undersigned presents herewith a fac-simile of its lawful trade mark and requests that the same, together with the accompanying statement and declaration, may be registered in the United States Patent Office, in accordance with the law in such cases made and provided; and it hereby appoints William E. Richards and William W. White, doing business under the name and style of Richards & Co., of the city, county and State of New York, and of Washington, D. C., its attorneys, with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to receive the Certificate of Registration, and to transact all business in the Patent Office connected therewith.

(*Signature of corporation.*)

STATEMENT.

To all whom it may concern:

Be it known that the (*insert name of corporation*), a corporation organized under the laws of (*state under what laws the corporation is organized*), and located in (*state where located*), and doing business in (*state business address of corporation, giving street and number*), has adopted for its use a trade mark for (*state goods upon which trade mark is used*), of which the following is a full, clear and exact specification:

The trade mark of said company consists of (*state of what the trade mark consists*). This has generally been arranged as shown in the accompanying fac-simile, in which (*here insert a complete description of the trade mark, describing in detail all of its parts and features*).

The essential features of the said trade mark are (*here name the essential features claimed*).

This trade mark has been continuously used by said corporation since (*state date since when the trade mark has been continuously used*). The class of merchandise to which this trade mark is applied is (*state class*), and the particular description of goods comprised in such class on which it is used by the said company is (*here name the goods or commodities upon which it is used*). It is usually (*here state how the trade mark is applied or affixed*).

(*Signature of corporation.*)
By (*Signature of official signing name.*)
(*Title of official who signed.*)

Witnesses:
(*Signatures of two witnesses.*)
(*Seal of corporation.*)

DECLARATION.

(*Insert place of execution*).....
(*Insert name of country.*).....} *ss.*

(*Insert name of the officer of the corporation who makes the declaration,*) being duly sworn, deposes and says that he is (*state his title of office*) of the corporation, the applicant named in the foregoing statement; that he verily believes that the foregoing statement is true; that the said corporation has at this time a right to the use of the trade mark therein described; that no other person, firm or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that the trade mark is used by said corporation in commerce between the United States and foreign nations or Indian tribes, and particularly with (*here name one or more foreign nations or Indian tribes, or both, between which and the United States the trade mark is used in commerce*), and that the description and fac-similes presented for record truly represent the trade mark sought to be registered.

(*Signature of the officer of the corporation who makes the declaration.*)

[*Seal of corporation.*]

Sworn and subscribed before me, a (*state official title of the person administering the oath*).....
.....this (*insert date*).....} (*Signature of official administering oath.*)

[*Official Seal.*]

LABELS AND PRINTS.

FORM OF APPLICATION. BY AN INDIVIDUAL.

To the Commissioner of Patents:

The undersigned, (*insert name of applicant*), of (*insert residence*), and a citizen of (*or subject of, and state of what country he is a citizen or subject*), hereby furnishes five copies of a label (*or print, as the case may be*), to be used for (*state use of label or print*), of which he is the sole proprietor. The title of said label (*or print*) is (*insert title*), and the said label (*or print*) consists of the words and figures as follows, to wit: (*here insert a full description of the label or print*).

And he hereby requests that the said label (*or print*) be registered in the Patent Office, in accordance with the Act of Congress to that effect, approved June 18, 1874.

And he hereby appoints William E. Richards and William W. White, doing business under the name and style of Richards & Co., of the city, county and State of New York, and of Washington, D. C., his attorneys, with full powers of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to receive the Certificate of Registration, and to transact all business in the Patent Office connected therewith.

(*Insert place and date of execution.*)

(*Signature.*)
Proprietor.

FORM OF APPLICATION. BY A FIRM.

To the Commissioner of Patents:

The undersigned, (*insert name of firm*), a firm domiciled in (*insert domicile*), and doing business at (*insert business address, giving street and number*), hereby furnishes five copies of a label (*or print, as the case may be*), to be used for (*state use of label or print*), of which they are the sole proprietors. The title of said label (*or print*) is (*insert title*), and the said label (*or print*) consists of the words and figures as follows, to wit:—(*here insert a full description of the label or print*).

And they hereby request that the said label (*or print*) be registered in the Patent Office, in accordance with the Act of Congress to that effect, approved June 18, 1874.

And they hereby appoint (*insert power of attorney in the same form as given above, in form of application by an individual*).

(*Place and date of execution.*)

(*Signature of firm.*)
Proprietors.

FORM OF APPLICATION. BY A CORPORATION.

To the Commissioner of Patents:

The applicant, a corporation created by authority of the laws of (*state under what law corporation was organized*), and doing business at (*insert business address, giving street and number, city and country*), hereby furnishes five copies of a label (*or print, as the case may be*), to be used for (*state use of label or print*), of which it is the sole proprietor. The title of said label (*or print*) is (*insert title*), and the said label (*or print*) consists of the words and figures as follows, to wit: (*here insert description of label or print*).

And it is hereby requested that the said label (*or print*) be registered in the Patent Office, in accordance with the Act of Congress to that effect, approved June 18, 1874.

And it hereby appoints (*insert power of attorney in the same form as given above, in form of application by an individual.*)

(*Signature of corporation.*)

(*Place and date of execution.*)

By (*signature of official signing same.*)
(*Title of official signing.*)

(*Seal of corporation.*)

COPYRIGHTS.

FORM OF APPLICATION.

To the Librarian of Congress, Washington, D. C.:

The undersigned, (*insert name of applicant*), a citizen of (*or subject of, and state of what country he is a citizen or subject*), and resident of (*insert residence*) presents herewith a printed copy of the title of a (*state whether a book, map, chart, dramatic or musical composition, or whatever the work may be*), for which he desires copyright protection in accordance with the law in such cases made and provided.

He claims the right to such copyright protection as the (*state whether he claims as author, designer, or proprietor*) of the work, the printed title of which is presented herewith, and he hereby appoints William E. Richards and William W. White, doing business under the name and style of Richards & Co., of the city, county and State of New York, and of Washington, D. C., his attorneys, with full powers of substitution and revocation, to prosecute this application, to pay all fees required by law, to receive the Certificate of Registration, and to transact all business relating thereto.

(*Signature.*)

(*Place and date of execution.*)

SCHEDULE OF GOVERNMENT FEES.

All fees payable are required to be paid in advance—that is, upon making any application for any action for which a fee is payable.

PATENTS AND DESIGN PATENTS.

The following is the schedule of fees and of prices of publication, etc., of the Patent Office:

On filing each original application for a design patent for three years and six months	$10 00
On filing each original application for a design patent for seven years	15 00
On filing each original application for a design patent for fourteen years	30 00
On allowance of an application for a design patent, no further charge.	
On filing each caveat	10 00
On filing each original application for a patent	15 00
On allowance of an original application for a patent, except in design cases	20 00
On filing disclaimer	10 00
On filing every application for the re-issue of a patent	30 00
On filing each application for a division of a re-issue	30 00
On allowance of an application for the re-issue of a patent, no further charge.	
On filing every application for an extension of a patent	50 00
On the granting of every extension of a patent	50 00
On filing an appeal for the first time from a primary examiner or the examiner of interferences to the examiners-in-chief	10 00
On filing every appeal from the examiners-in-chief to the Commissioner	20 00
For manuscript copies of records in the English language, for every one hundred words or fraction thereof	10
If certified, for the certificate, additional	25
For copies of drawings not in print, the reasonable cost of making them.	
For uncertified copies of the specifications and accompanying drawings of all patents which are printed, per copy	10
For twenty coupon orders, each coupon good until used for one copy of a printed specification and drawing	2 00
For certified copies of printed patents:	
For specification and drawing per copy	10
For the certificate	25
For the grant	50
For the specification, if not in print, for every one hundred words or fraction thereof	10
For the drawings, if in print	10
For the drawings, if not in print, the reasonable cost of making them.	
For certifying to a duplicate of a model	50
For abstracts of title to patents or inventions:	
For the certificate of search	1 00
For each brief from the digest of assignments	20
For copies of matter in any foreign language, for every one hundred words or a fraction thereof	20
For translation, for every one hundred words or fraction thereof	50
For recording every assignment, agreement, power of attorney, or other paper of three hundred words or under	1 00

For recording every assignment, agreement, power of attorney, or other paper of over three hundred words and under one thousand words	$2 00
For recording every assignment, agreement, power of attorney, or other paper of over one thousand words	3 00
For assistance to attorneys and others in the examination of records, one hour or less	50
For each additional hour or fraction thereof	50
For assistance to attorneys in the examination of patents or other matter in the scientific library, one hour or less	1 00
Each additional hour or fraction thereof	1 00
For subscription to the Official Gazette, published every Tuesday, all subscriptions to commence with the beginning of a volume, none being taken for a less period than three months, and there being no club rates or discount to newsdealers, as follows: To all subscribers within the United States and Canada, one year	5 00
To foreign subscribers, except in Canada	7 00
Single numbers	10
For bound volumes of the Official Gazette:	
Semi-annual volumes, from January 1, 1872, to June 30, 1883, full sheep binding, per volume	4 00
Semi-annual volumes, from January 1, 1872, to June 30, 1883, half sheep binding, per volume	3 50
Quarterly volumes subsequent to July 1, 1883, full sheep binding, per volume	2 75
For the annual index—lists of patentees and inventions, alphabetically arranged, with date of patent, number, etc., from January, 1872—one volume each year, full law binding, per volume	2 00
In paper covers, per volume	1 00
For the general index—a list of inventions patented from 1790 to 1873, with the name of inventor, residence, date of patent, number, etc.—three volumes, full law binding, per set	10 00
For the index from 1790 to 1836—a list of inventions patented from 1790 to 1836, photolithographed from Patent Office Reports—one volume, full law binding	5 00
For the monthly volumes, containing the specifications and photolithographed copies of the drawings of all patents issued during the month, certified, bound full sheep, per volume	12 00
For the monthly volumes, containing the specifications and photolithographed copies of the drawings of all patents issued during the month, certified, bound half sheep, per volume	10 00
For the index to patents relating to electricity, granted by the United States prior to June 30, 1882, one volume, two hundred and fifty pages, bound	5 00
In paper covers	3 00
Annual appendixes for each fiscal year subsequent to June 30, 1882, paper covers	1 50
For Commissioners' Decisions:	
For 1869-'70-'71, bound in one volume, full law binding	2 00
For 1872-'73-'74, bound in one volume, full law binding	2 00
For 1875-'76, bound in one volume, with decisions of United States courts in patent cases, full law binding	2 00
For 1875-'76, bound in paper covers	1 00
For 1877-'78-'79-'80-'81-'82-'83, one volume *each year*, with decisions of United States courts, full law binding, per volume	2 00
For 1877-'78-'79-'80-'81-'82-'83, bound in paper covers	1 00
Pamphlet of the Rules of Practice	Free

TRADE MARKS AND LABELS.

On filing an application for registration of a trade mark	$25 00
On filing an application for registration of a label	6 00
For assignments, copies of records, etc., the same as for patents	

COPYRIGHTS.

For recording each copyright for citizens or residents of the United States	$0 50
For recording each copyright for an alien	1 00
For certificate of copyright	50
For recording an assignment	1 00
For a certified copy of any record of assignment	1 00
For a copy of the record of any copyright entry	1 00

SUBJECT MATTER INDEX.

REFERENCES ARE TO PAGES.

PAGE

ABANDONMENT, defined, as bar to patentability....16, 21
considered in renewed applications.... 34
of claim in interference.... 40
considered in re-issue applications....49, 51
of application for re-issue.... 52
ACCIDENT, defined....49, 50
ACTION AT LAW, in suits for infringement....56, 57, 58, 59, 60, 61, 62, 63, 64
parties in....56, 57
damages in....56, 57, 58
may be brought, where.... 58
process in....58, 59
joinder of patents and suits in.... 59
interest allowable in.... 59
costs in.... 60
pleadings in....61, 62
trials in.... 63
judgments in.... 63
new trials in.... 63
writ of error in.... 63
bills of exception in.... 63
ACTION IN EQUITY, to declare interfering patent void....55, 56
in suits for infringement....56, 57, 58, 59, 60, 61, 62, 63, 64
may be brought, where.... 58
defendants' profits recovered in....58, 60
rule for ascertaining.... 60
parties in.... 64
process in.... 64
replications in.... 65
hearings in.... 65
decrees in.... 65
re-hearings in.... 65
appeals in.... 65
bills of review in.... 66
bill to perpetuate testimony in.... 66
bill of discovery in.... 66
forfeiture of right to relief in, by acquiescence.... 67
ADMINISTRATION, ancillary letters of....18, 25, 34
foreign letters of, not good evidence.... 34
ADMINISTRATOR, application by....18, 25, 34
form of....111
of deceased foreign inventor....18, 25, 34
may assign patent and give good title.... 35
application by, and re-issue of patent to....49, 50, 51
may maintain suit for infringement....57, 69
of author, etc., may obtain copyright.... 99
ADVERTISEMENTS, not permitted in drawings.... 27
AFFIDAVITS, by examiner if he cannot cite references.... 31
applicant may avoid references by filing, when....38, 39
Commissioner to establish rules for.... 44
officers before whom may be taken.... 44
evidence on application for injunction, presented by.... 68
time allowed for preparation and inspection.... 68
filed after stipulated date, not considered.... 68
accompanying motion for attachment, requirements of.... 69
AGGREGATION, mere, not true combination, and unpatentable....24, 25
of old designs not a new design.... 73
AGREEMENT, to assign, is valid and binding.... 35

PAGE

ALIEN, may obtain patent..... 17
file caveat if resident of U. S. for one year..... 38
protection of print or label by..... 81
trade-mark by.....83, 84
rights of under copyright laws.....109
ALLOWANCE of application, patent to issue within six months of..... 16
if final fee not paid within six months after, patent withheld..... 16
renewed applications to be filed within two years after.....16, 34
after examination..... 32
ALTERNATIVE CLAIMS, not allowable..... 24
AMENDMENT, introducing new matter requires supplemental oath..... 30
of applications.....31, 32, 33
may be made before or after rejection..... 32
restrictions upon introduction of new matter by..... 32
remedy if examiner refuses to admit..... 32
during interference..... 40
of appeal, to cure defect in form..... 46
of patent, by re-issue.....49, 50, 51, 52, 53
by disclaimer.....49, 50, 54, 55, 69, 70
of design application..... 73
of trade mark application..... 84
ANNUAL REPORTS, of Commissioner of Patents..... 11
of Librarian of Congress..... 99
APPEAL, none to Secretary, if Commissioner refuses to issue patent..... 8
to Commissioner, if examiner refuses to admit amendment..... 32
must be filed within reasonable time.....33, 46
in interference cases.....43, 45
to examiners-in-chief, upon questions of substance.....45, 46
interlocutory, upon questions of form, to Commissioner..... 45
right of applicant to amend..... 46
from examiners-in-chief to Commissioner.....46, 47
from Commissioner to Court of Appeals.....47, 48, 49
determination of appeal and its effect..... 47
in applications for re-issue..... 51
to Circuit Court of Appeals from interlocutory decree..... 58, 69
from final decree..... 58
in actions in equity..... 65
in applications for design patents..... 73
in trade-mark applications..... 84
fees payable on.....75, 119
APPLICANT, for patent, who may, who may not be..... 17
must be original, first and true inventor..... 17
or executor or administrator.....17, 18
as to assignees..... 18
must make and sign oath as to invention..... 30
forms for application of.....110
execution of documents by..... 25
rights of, to amend application.....32, 33
must complete application within two years..... 33
must prosecute application within two years after any action thereon... 33
may file new application for subject of abandoned application..... 33
delay of, may be excused..... 38
may renew forfeited application.....34, 35
may insist upon claim after first rejection,..... 38
may overcome reference by filing affidavit, when.....38, 39
may abandon claim in interference..... 40
may withdraw matter not in conflict in interference..... 40
first, regarded as first inventor until contrary appears..... 41
may appeal if claims twice rejected.....45, 46, 47, 48
from examiner of interferences..... 45
can amend appeal not regular in form..... 46
diligence of in filing appeals..... 46
for re-issue of patent, who may be.....49, 50, 51
may abandon application and resume patent..... 52
must be diligent in filing application.....52, 53
for caveat, who may be..... 38

PAGE

APPLICANT, for design patent, who may be..... 72
for registration of label or print..... 81
of trade mark.....83, 84
of copyright..... 99
for extension of term of copyright.....101
APPLICATION, renewal of, after forfeiture.....16, 34
by executor or administrator.....18, 25, 34
joint inventors..... 17
assignees..... 17
requisites of..... 22
form for, sole inventor.....110
joint inventors.....110, 111
administrator.....111
executor.....112
execution of..... 25
oath must accompany..... 30
examination of.....30, 31, 32, 33, 38
amendment of, during examination.....31, 32, 33, 38
when considered filed and complete..... 30
preserved in secrecy in Patent Office..... 30
receipt of serial number and filing date..... 30
examination as to form..... 31
as to novelty..... 31
division of, when required..... 31
new, for matter eliminated by division..... 31
divisional, bears date of original..... 32
once divided cannot be again united..... 32
should disclaim what it does not claim..... 32
must be completed within two years..... 33
regarded as abandoned, when..... 33
new, for subject of abandoned application..... 33
if applicant dies, executor may be made party to..... 34
renewal of, can be none after two years delay..... 34
original documents may be used for..... 34
second application dates from renewal..... 35
examination of, in..... 35
interferences, when and how declared..... 39
division of, during interference..... 40
amendment of, during interference..... 40
if refused, patent may be obtained by bill in equity..... 48
for re-issue of patent.....49, 50, 51, 52, 53
requirements of.....50, 51
to be made by inventor, if alive.....49, 50
by executor, administrator, or assignee.....49, 50
forms for application for.....113, 114
examination of..... 49
amendment of.....49, 50, 51, 52, 53
for extension of patent granted prior to March 2, 1861.....70, 71
for design patent, requisites and execution of..... 73
form for application for.....116
examination, rejection and amendment of..... 73
subject to general rules of patent law..... 74
for registration of label or print..... 81
form for application for.....118, 119
of trade-mark.....83, 84
forms for application for.....117, 118
of copyright.....99, 101, 102
form for application for.....119
fees for..... 75, 119, 120
for extension of term of copyright.....101
ARTICLES, patented, no royalty to officers or employees of U. S.....14, 15
purchased of inventor before application..... 36
must be marked as such 36, 37
duty of marking devolves upon manufacturer..... 37
penalty for falsely marking as patented..... 37
of pottery or metal, copyright mark upon 109

PAGE

ASSIGNEE, application by inventor on behalf of..... 18
patent may be issued or re-issued to..... 33
to inventor and assignee jointly..... 33
may renew application if forfeited..... 34
rights of, in interferences.....43, 44
assent of, to re-issue.....49, 50, 51
may apply for re-issue, when.....50, 51
interest of, not affected by re-issue without consent..... 50
may maintain action for infringement.....57, 69, 70
disclaimer by.....54, 55
in bankruptcy, property vests in..... 79
of author, etc., may register copyright.....99, 100
ASSIGNMENT, invention may be assigned before application.....18, 83, 86
must be entered of record.....33, 36
invention or patent to be clearly identified in.....33, 35, 36
of patent or interest therein..... 35
to be recorded within three months..... 35
any instrument affecting title may be recorded..... 35
executors and administrators may make..... 35
by owner of patent for benefit of creditors.....35, 79
by infant, to be through guardian..... 35
by married woman..... 35
must be in writing and signed..... 35
before issue of patent, forms for.....115
after issue of patent, form for.....115
parol agreement to make is valid..... 35
executed by attorney, must be signed with name of principal..... 35
by attorney in his own name is invalid..... 35
before issue of patent, is valid..... 36
must contain request if patent is to issue to assignee..... 36
unrecorded, valid between the parties thereto..... 36
good except against creditors and subsequent purchasers.. 36
single, may transfer several patents..... 36
can be made by owner only..... 79
courts have power to compel owner to make..... 79
fees for recording.....119, 120
of label or print..... 81
of trade-mark..... 93
of copyrights.....101
to be recorded.....101

ATTORNEYS, see PATENT AGENTS.
AUTHOR, when entitled to register copyright..... 99
has exclusive right to translate or dramatize..... 99
may apply for extension of copyright, how.....101
BANKRUPT, property of vests in assignee..... 79
compelled to assign patent for benefit of creditors..... 79
BILL OF DISCOVERY, in action in equity..... 66
BILL IN EQUITY, remedy by, if patent refused..... 48
BILL OF EXCEPTION, in action at law..... 64
BILL TO PERPETUATE TESTIMONY, in action in equity..... 66
BILL OF REVIEW, in action in equity..... 66
BLUE PRINTS of drawings..... 27
BOND, by defendant in equity.....67, 68
by plaintiff in equity..... 68
BONDS of Commissioner and Chief Clerk..... 8
of Librarian of Congress..... 99
BOOK, copyright for..... 99
defined.....100
BOUND VOLUMES, see COPIES.
BURDEN OF PROOF, in interference cases..... 41
CASES CITED, Index to.....i-xvi
CAVEATS, filing and effect of.....37, 38
applicant, who may file..... 38
cannot be filed for design..... 38
for joint invention, one inventor only may sign..... 38
form for application.....115, 116

PAGE

CAVEATS, renewal of..... 38
fees for.....75, 119
CERTIFICATE, trade-mark..... 89
as evidence in suits..... 89
CHART, copyright for..... 99
defined.....100
CHIEF CLERK of Patent Office, bond of..... 8
CHILDREN, of deceased author may extend copyright.....101
CHROMO, copyright for.....99, 100
CIRCUIT COURTS, jurisdiction of.....12, 13, 57, 58
power of to grant patent..... 48
writ of error from judgment of..... 68
power of to grant injunctions and estimate damages....66, 67, 68, 69
may submit questions of fact to jury.....66, 67
jurisdiction of, in trade mark matters..... 91
in copyright matters.....106
CIRCUIT COURT OF APPEALS, appeal to from interlocutory decree..... 58, 69
from final decree of Circuit Court..... 58
no appeal from, ordinarily, to Supreme Court..... 58
may certify question of law to Supreme Court..... 58
Supreme Court may send certiorari to..... 58
jurisdiction of, in trade mark matters..... 91
in copyright matters.....106
CLAIMS, requisites of..... 22
must define invention..... 23
be signed by inventor and witnesses..... 23
as to scope of.....24, 32
as to form of..... 24
must be for operative means..... 24
can embrace but one invention..... 24
cannot include process and product unless dependent..... 24
must correspond with specification..... 24
covers all equivalents..... 24
functional, are void..... 24
should be drawn to cover construction..... 24
alternative, not allowable..... 24
for dependent inventions, may be joined..... 24
for process..... 24
for inoperative combination, void..... 23
for sub-combinations and sub-processes.....24, 25
generic and specific.....24, 25
for machines..... 25
composition of matter..... 25
manufacture..... 25
improvement..... 25
interpretation of..... 25
void claim does not void patent if valid claim present..... 25
examination and amendment of.....31, 32, 33
cannot be enlarged by amendment 32
voluntarily erased cannot be reinstated..... 32
if enlarged require supplemental oath..... 32
if rejected, applicant to receive notice..... 38
may insist upon..... 38
in interference may be abandoned..... 40
if twice rejected appeal may be entered.....32, 45
questions of form of appealable to Commissioner..... 45
substance appealable to examiners-in-chief..... 45
amendment of, by re-issue.....49, 50, 51, 52, 53
cannot be broadened in re-issue.....52, 53
original may be reproduced in re-issue..... 53
withdrawn or abandoned, cannot be introduced in re-issue..... 53
excessive, amendment of by disclaimer.....54, 55
in design applications..... 73
CLASSIFICATION, of inventions..... 30
of trade marks..... 85
CLERICAL ERRORS, in patent, how corrected..... 49

PAGE

COLLECTOR OF CUSTOMS, to prevent entry of goods bearing false marks.....95, 96
not properly marked..... 96
of copyrighted articles.....102, 103
to seize same, when.....102
COMBINATION, claim for.....24, 25
must specifically embrace essential elements..... 24
inoperative combination, void..... 24
sub-combinations..... 24
COMMISSIONER OF PATENTS, powers and duties of.....8, 9, 10, 11, 12, 13, 14, 15, 17, 30, 33, 38, 39, 44, 46, 47, 48, 49, 70, 71, 74, 76, 78, 79, 80, 83, 84, 86, 89, 93.
bonds of..... 8
Secretary of Interior has authority over.....7, 8
but cannot revise his judicial judgments...7, 8
to make rules for Patent Office..... 9
of evidence.....9, 44
may refuse to recognize agent or attorney..... 9
subject to approval of Secretary.... 9
may require papers to be printed..... 9
annual report of..... 11
to examine applications before issuing patents..... 30
to issue patents..... 30
appeal to if amendment refused consideration..... 32
may excuse delay of applicant..... 33
governed by record in issuing patent..... 33
to deposit caveats in confidential archives..... 38
to notify applicant of rejection of claims..... 38
to declare interference in certain cases..... 39
evidence in interference cases to be sent to..... 42
interlocutory appeals to..... 45
appeal to, if examiner refuses to act on recommendations of examiners-in-chief..... 46
appeal to, from examiners-in-chief.....46, 47
appeal from, to Court of Appeals.....47, 48, 49
suable only in District of Columbia..... 48
bill in equity to compel issue of patent by..... 48
to re-issue patent, when..... 49
may cause several patents to issue..... 49
extension of patents granted prior to March 2, 1861, by..70, 71
has charge of registration of labels and prints.....80, 109
of trade marks..... 83
to sign certificate of registry..... 89
to decide lawfulness of claim..... 86
authorized to make rules..... 93
appeals to, from examiners of trade-marks..... 84
from (trade-marks) to Court of Appeals..... 89
COMMON LAW rights of owner of trade-mark.....90, 91, 92
not affected by statutory provisions.....91, 92
COMPILER, entitled to copyright.....100
COMPOSITION OF MATTER, claim for..... 25
requires but a single claim..... 25
CONGRESS, power of, in patent matters, unrestricted..... 6
But to grant patents to inventors only.....6, 17
annual report of Commissioner to..... 11
of Librarian of Congress to..... 99
CONSTITUTION, authorizes grant of patents to inventors.....3, 6, 17
registration of trade marks..... 83
of copyrights..... 98
CONTEMPT, penalty for, for violation of injunction..... 60
CONTENTS AND DURATION of patents..... 16
COPIES, of papers filed, may be required to be printed..... 10
of claims, laws, decisions, etc., printed..... 10
of specifications and drawings, printed..... 10
price of.....11, 119, 120
of bound volumes of printed specifications, etc..... 11
of records, etc., when admissable in evidence..... 13

PAGE

COPIES, certified, of records, etc., obtainable..... 13
fees for.....119, 120
of foreign letters patent, as evidence..... 14
printed, of specifications and drawings, as evidence..... 14
of records, furnished by Patent Office.....13, 16
certified, used in place of originals in interference..... 40
of certificates of registry of trade-marks, as evidence..... 89
of copyrighted work to be delivered to Librarian.....102, 103
importation of, prohibited.....102, 103
of entries of copyrights furnished to Secretary of Treasury.....104
postmasters to give receipt for.....105
of title to be deposited to secure copyright.....101, 102, 103
of subsequent editions, to be deposited.....104
penalty for failure to deposit.....105
of records, furnished by Librarian..... 99
COPYRIGHTS, jurisdiction of Federal Courts in.....12, 13
State Courts over questions of contract..... 13
history of legislation regarding..... 97
constitutional provisions for..... 98
under charge of Librarian of Congress..... 99
seal provided for office..... 99
Librarian required to give bond..... 99
to make annual report to Congress..... 99
registration of, who entitled to..... 99
application for registration.....103
form for 119
subjects, what may be registered.....99, 100, 101
for projected works.....101
term of protection for.....101
extension of.....101
who may apply for.....101
publication of application for.....101
assignable.....101
assignment to be recorded.....101
within what time.....101
rights of co-owners of.....101
title must be deposited before publication.....101, 102, 103
copies of work to be deposited on publication.....101, 102, 103
importation prohibited during copyright.....102, 103
regulations regarding importation.....102, 103
requirements as to printed copy of title. 103
novelty required.....101, 102, 103
Librarian to keep record.....103
and furnish copy to proprietor.....104
fees for registry.....104, 120
Librarian to furnish copies of entry to Secretary of Treasury.....104
Secretary of Treasury to furnish catalogue of entries to collectors and postmasters.....104
Secretary of Treasury to sell copies of catalogue to public.....104
copies of subsequent editions to be deposited.....104
as to new editions of works of foreign authors.....104
penalty for failure to deposit copies.....105
postmaster to give receipt for copies.....105
notice of copyright to be given by marking.....105
penalty for false marking.....105, 106
who may sue for penalty.....105, 106
penalty for infringing.....106, 107
infringements, jurisdiction of Circuit Courts.....106
infringing goods may be seized.....106
damages recoverable.....106, 107
in manuscripts.....107, 108
of dramatic compositions.....99, 100, 102, 106, 107, 108
limitation of time for commencing suit.....108
pleadings in actions for infringement.....108
power of courts to grant injunctions.....108
registration of prints and labels.....109

PAGE

COPYRIGHTS, marking articles of pottery and metal....109
each volume or number a separate publication....109
rights of foreigners....109
right to translate and dramatize exclusive.... 99
compiler entitled to copyright....100
translator, when entitled to....100
requirements as to printing....102
CORPORATION, conveyance by, with seal, is good....35, 36
as an infringer.... 57
COSTS, effect of disclaimer on.... 14
not recoverable if plaintiff abandons claim.... 14
unless disclaimer entered.... 14
if disclaimer entered during suit....55, 69, 70
in suit for infringement.... 60
COUNTERFEITING, of trade-marks, penal act concerning....93, 94, 95
COUNTERFEITS, (trade-marks), may be seized and destroyed....94, 95
COURTS, power of, to grant injunctions and estimate damages....66, 67, 68, 69, 108
COURT OF APPEALS, of the District of Columbia, appeals to....47, 48, 49
act establishing court....47, 48
appeal to from final decree, Supreme Court of District.... 58
from Commissioner (trade-marks).... 89
from, to the Supreme Court.... 58
COURT OF CLAIMS, jurisdiction of, in actions against government.... 58
CUT, copyright for.... 99
DAMAGES, in case of patent after renewed application.... 34
none for use of thing purchased of inventor before application.... 36
in suits for infringements....56, 59
how recovered.... 56
in whose name.... 56
right to is assignable.... 57
power of courts to determine and grant injunctions....66, 67, 68, 69
to increase damages found in verdicts....56, 66
recoverable for infringement of copyright....106, 107
DATE of patent.... 16
patent cannot be antedated.... 16
of re-issued patent.... 52
DECEASED INVENTOR, see EXECUTOR, ADMINISTRATOR.
DECISIONS, printed, see COPIES.
DECLARATIONS, in application for registration of trade-mark.... 86
liability for making false.... 91
cannot be amended.... 84
if faulty a substitute must be filed.... 84
DECREES, in actions in equity.... 65
DEFENDANTS, in suits for infringement, who may be....56, 57, 64
defenses, pleadable by....61, 62, 65
to give notices of special matter.... 63
defenses in action in equity.... 65
DEFENSES in suits for infringement....61, 62. 65
in equity.... 65
DEPOSIT of title, to secure copyright....101, 102
of copies of work, to complete copyright....102
DEPOSITIONS, Commissioner to establish rules for taking.... 44
officers before whom may be taken.... 44
DESCRIPTION of invention, requisites of.... 22
when to be filed.... 22
amendment of during application....31, 32, 33
by re-issue....49, 50, 51, 52, 53
DESIGN, of work of fine art, copyright for.... 99
DESIGN PATENT, caveat cannot be filed.... 38
interference with mechanical invention 40
provided for.... 72
definition of design.... 72
applicant for, who may be.... 72
requisites as to patentability.... 72
application for.... 73
form for....116

PAGE

DESIGN PATENT, procedure, examination, amendments, appeals, interferences..... 73
decisions regarding 78, 74
models..... 74
duration of..... 74
extension of. 74
subject to general rules of patent law..... 74
identity of designs..... 72
design not complete until reduced to practice..... 73
fees for applications.....75, 119
DESIGNER, entitled to copyright..... 99
may apply for extension.....101
DEVISEES, application by executor or administrator as trustee for..... 34
DILIGENCE, in prosecuting application..... 33
in filing appeals..... 46
in applying for re-issue.....52, 53
in filing disclaimer..... 55
DISCLAIMER, effect of, on costs.....14, 69, 70
in divisional applications..... 53
during interference..... 40
assignee (if any) should consent to..... 40
to correct excess of claim.....49, 50
when necessary..... 54
requisites of..... 54
form for.....114
does not affect pending action..... 54
by whom made..... 54
how made..... 55
diligence necessary.....55, 69, 70
effect of upon interests of owners..... 55
patent 54, 55
pending suits..... 55
fee payable on.....75, 119
DISCOVERY, when patentable..... 16
(See also INVENTION.)
DIVISION OF APPLICATION, if more than one invention..... ... 31
separate applications for matter eliminated..... 31
none required if process and product inseparable..... 31
unless each invention separately patentable 32
each divisional application requires oath, etc..... 32
bears date of original..... 32
should contain proper disclaimer..... 32
application once divided cannot be again united..... 32
during interference..... 40
re-issue.....49, 51
DOCKET FEE, on appeal to Court of Appeals..... 48
DOCUMENTS, execution of, patents..... 25
drawings..... 27
assignments 35
testimony in interferences..... 42
applications for re-issue..... 50
disclaimers..... 55
application for design patent..... 73
registration of label or print..... 81
of trade-mark..... 84
of copyrights.....103
forms of.....110, 111, 112, 113, 114, 115, 116, 117, 118, 119
DRAMATIC COMPOSITIONS, copyright for.....99, 100, 102, 106, 107, 108
DRAWING, copyright for..... 99
DRAWINGS, printed copies of, see COPIES.
when required.....25, 26
signed by attorney.....25, 27
witnesses.....26, 27
must be furnished whenever possible..... 26
must show every feature claimed..... 26
must correspond with specification..... 26

PAGE

DRAWINGS, rules for.....20, 27
illustration of.....28, 29
advertisements in, not permitted..... 27
for re-issue applications.....27, 49, 50
blue prints or photographs of..... 27
additional views, when required..... 31
errors in may be corrected..... 33
original, may be used in renewed application..... 34
for design application..... 73
trade-mark application..... 84
DURATION of Patent, see TERM.
EMPLOYEES of Patent Office, see OFFICERS AND EMPLOYEES.
ENGRAVING, copyright for.....99, 101
EQUIVALENTS, all, covered by claim..... 24
EVIDENCE, copies of records, when admissable as..... 13
of foreign letters patent, when admissable as..... 14
printed copies of specifications and drawings as..... 14
contradicting preliminary statement in interference..... 41
in interference cases.....41, 42
extension of time for..... 41
how taken.....41, 42
forwarded to Commissioner..... 42
rules for taking in foreign countries..... 42
on motion for injunction, by affidavits..... 68
certificate of registry of trade-mark, as..... 89
EXAMINATION, of application.....30, 31, 32, 33
order of..... 30
as to form..... 31
novelty..... 31
division of application during.....31, 32
procedure during.....32, 33
renewed applications subject to..... 34
of applications for re-issue.....49, 51, 53
for design patents..... 73
for registration of trade-mark..... 84
EXAMINERS, actions of, during examination.....31, 32, 33
duties of, in interferences..... 40
appeals from, to examiners-in-chief.....45, 46
of trade-marks, appeal from..... 84
EXAMINERS-IN-CHIEF, duties of..... 8
appeal to, from primary examiner.....45, 46
appeal from, to Commissioner.....46, 47
EXAMINER OF INTERFERENCES, duties and actions of.....40, 41, 42, 43
appeal from decision of..... 45
EXECUTION OF DOCUMENTS, see DOCUMENTS.
EXECUTOR, application by.....18, 25, 34
form for.....112
oath by..... 34
may be made party to application if inventor dies..... 34
patent issued to valid though trust not expressed..... 34
may assign patent and give good title..... 35
application by, and re-issue of patent to.....49, 50, 51
may maintain suit for infringment even if specification too broad.....69, 70
but should file disclaimer before entering suit.....69, 70
of author, may register copyright..... 99
EXPENSES, of bill in equity to be paid by applicant..... 48
(Also see COSTS.)
EXPLORING EXPEDITION, custody of collections of..... 12
EXTENSION, of term of patent..... 16
of patent granted prior to March 2, 1861.....70, 71
operation of..... 71
of design patent..... 71
fee payable on.....25, 119
of term of copyright.....101
who may apply for.....101
application for to be published.....101

PAGE

EXTENSION, of term of registration of trade-mark..... 90
EXTENSION OF TIME, for preparing claims for interference..... 40
for filing preliminary statements..... 40
for taking testimony..... 41
FEDERAL COURTS, jurisdiction of.....12, 13, 57, 58
authority of to grant new trials..... 63
power to grant injunctions and estimate damages.....66, 67, 68, 69
jurisdiction of, in trade-marks.....90, 91
in copyrights.....12, 13, 108
FEES, payment of.....16, 30, 76, 85, 86, 104, 119
new, required for renewed application..... 34
allowed to witnesses..... 44
upon filing appeal..... 45
application for re-issue..... 49
divisional applications.....49, 51
schedule of.....75, 119, 120
mode of payment of..... 76
refunding of..... 76
for labels and prints..... 80
for registration of trade-marks.....85, 86
applicant credited with those previously paid..... 90
for registration of copyrights.....104
FINAL FEE if not duly paid patent withheld..... 16
renewed application may be filed..... 34
amount of.....75, 119
FOREIGN AUTHORS, new editions of works of, copyright for.....104
when entitled to copyright.....109
FOREIGN COUNTRY, restrictions as to Notaries in..... 30
rules for taking testimony in..... 42
patent not void because of prior use in..... 70
FOREIGN GOODS, bearing falsified marks, entry prohibited.....95, 96
marking with name of country of origin..... 96
FOREIGN INVENTOR, date of inventive act of.....39, 44
FOREIGN LETTERS OF ADMINISTRATION, not good evidence..... 34
FOREIGN LETTERS PATENT, copies, when admissable as evidence..... 14
prior, effect on term of U. S. patent.....16, 21
no bar to patent here unless expired..... 21
to have limiting effect must be identical..... 22
date of when controlling U. S. patent..... 22
taken without knowledge of actual inventor..... 22
as determining date of invention made abroad.....39, 44
FOREIGN VESSEL, use of invention upon..... 56
FORFEITED APPLICATIONS, renewal of.....34, 35
FORFEITURE, of imported copies of copyrighted works.....102, 103
FORM, examination of as to..... 31
defects in, must be cured..... 31
interlocutory appeals as to questions of..... 45
questions of, defined..... 45
FORMS, *Patents*, application by sole inventor.....110
joint inventors.....110, 111
administrator.....111
executor.....112
revocation of power of attorney and appointment of new attorney..112
supplemental oath as to foreign patents.....112
to accompany new or enlarged claim.....112
application for re-issue, by inventor.....113
by assignees.....113
disclaimer, after issue of patent.....114
interference, preliminary statement, domestic inventor.....114
foreign inventor.....114
assignment, before issue, patent to issue to assignee.....115
of partial interest, patent to issue to inventor and assignee.115
after issue of patent.....115
Caveats, application.....115, 116
Design Patent, application.....116
Trade-Mark, application by an individual.....116, 117

PAGE

FORMS, *Trade-Mark*, application by a firm....117
by a corporation....118
Labels and Prints, application by an individual....118
by a firm....118
by a corporation....119
Copyrights, application....119
FRAUD, actual or constructive renders re-issue void....53
FUNCTION, claim for is void....24
whether claim is functional a question of form....45
GENERIC CLAIMS, scope of....25
do not cover functions, results or effects....25
GOODS, imported, must be marked....96
bearing falsified marks, importation prohibited....95, 96
HEARING, in appeals....46, 47
in interference....43
in actions in equity....65
on motion for injunction....68
HEIRS AT LAW, application by executor or administrator on behalf of....34
executor or administrator act as trustees for....34
HISTORY of Patent System....3, 4, 5
of trade-mark legislation....82
of copyright legislation....97
IDENTITY, how determined....22
of designs....72
of trade-marks....84, 86, 87
IMPORTATION, of goods bearing falsified marks, prohibited....95, 96
of copies of copyrighted work, prohibited....102
goods imported must be marked....96
IMPORTER, mere, cannot obtain patent....18
IMPROVEMENT, patentable....16
claim for....25
INADVERTENCE, defined....49, 50
INDEX TO CASES CITED....i-xvi
INFANT, may obtain patent....17
must assign through guardian....35
may be an infringer....57
INFRINGERS, who are....56, 57
INFRINGEMENT, suits for....56, 57, 58, 59, 60, 61, 62, 63, 64, 65, 66
damage for....56, 59
defined....56
parties, infringers....56, 57
who may bring suit....57
jurisdiction, in suits for....57, 58
of Federal Courts....57, 58
of Appellate Courts....57, 58
of State Courts....58
service of process....58
process in action at law....58, 59
joinder of patents and suits....59
interest....59
costs....60
profits....60
pleadings and proof in actions for....60, 61
at law....61, 62
pleading....61, 62
defenses....61, 62
notices....63
trials in actions at law....63
judgments in actions at law....63
new trials in actions at law....63
writ of error in actions at law....63
bills of exception in actions at law....64
equity, actions in....63, 64, 65, 66
parties in....64
process in....64
pleadings and defenses in....65

PAGE

INFRINGEMENT, equity, replications in 65
hearings in 65
decrees in 65
rehearings in 65
appeals in 65
bills of review in 66
bill to perpetuate testimony in 66
bill of recovery in 66
acquiescence in many forfeit right to relief 67
patentee not guilty of laches while ignorant of 67
suit for, when specification is too broad 69, 70
effect of disclaimer upon costs 69, 70
in case of design patents 73, 74
trade-marks, action at law for damages 90, 91
action in equity 90, 91
injunction to restrain unlawful use of 90
jurisdiction of United States Courts 91
no suit if mark used unlawfully 91
copyrights, penalty for 106, 107
jurisdiction of Circuit Courts 106
infringing goods may be seized 106
damages for 106, 107
limitation of time for commencing suit 108
pleading in actions for 108
power of courts to grant injunctions 108
INGREDIENTS, specimens of 27
INJUNCTIONS, power of courts to grant 66, 67, 68, 69
purpose of 66, 67
preliminary 67, 68
perpetual 67, 68, 69
preliminary, application for, how made 68
notice of motion for, must be served 68
answer to application for 68
hearing of application for 68
plaintiff or defendant may be required to give bonds 67, 68
takes effect according to their terms 68
duration of 68, 69
no effect beyond jurisdiction of court 69
terms may be modified 69
when dissolved 69
remedy for violation of 69
perpetual, when ordered 69
duration of 69
suspension of 69
final, may issue by consent of parties 69
appeals from interlocutory decree 69
INOPERATIVENESS, defined 49, 50
INVENTION, what may be patented, ... 16, 18, 19, 20, 21
distinguished from mechanical skill 18
must be complete and operative 18
reduced to practice 18
novel 19
useful 19
as affected by prior knowledge or use 19
patents 19
publication 20
public use or sale 20
abandonment 21
suggestions of others 21
specification of 23, 24
claim for 24, 25
not broader than claim 24
failure to claim dedicates to public 24
but one may be claimed in single application 24
models of, when required 27
examination of, in Patent Office 30, 31, 32, 33

PAGE

INTENTION, division, if more than one in application.....31, 32
scope of cannot be enlarged by amendment..... 32
unpatented, may be assigned.....34, 35
right to, dates from discovery and may be assigned..... 36
should be clearly identified in assignment..... 36
as to date of when made abroad..... 39
design may interfere with mechanical..... 40
priority of, how determined..... 44
identity of, in re-issue.....49, 50
previous use of in foreign country, no bar to patent..... 70
defined, in case of design..... 72
INVENTIONS, classification of..... 30
INVENTOR only, entitled to patent.....6, 17
death of, revokes power given to agent..... 10
who may apply for patent.....16, 17, 18
must be true and first.....17, 44
subsequent inventor not entitled to patent..... 17
may assign right to obtain patent..... 18
mere importer not an inventor..... 18
must sign application if alive..... 25
form for application by.....110
rights of to amend application..... 32
cannot enlarge claims by amendment..... 32
rights of appeal.....32, 33, 38, 43, 45, 46, 47, 48, 49
must complete application within two years after filing..... 33
prosecute application within two years after any action thereon..... 33
delay of may be excused by Commissioner..... 33
and assignee, patent may issue to..... 33
deceased, application by executor or administrator.....18, 25, 34
may make renewed application..... 34
foreign, date of inventive act of.....39, 44
first, entitled to patent.....39, 44
must make application for re-issue if alive.....49, 50
form for application for.....113
cannot affect interests of non-assenting assignee by re-issue..... 50
statements of, in original patent are binding..... 53
of new and original design, may obtain patent..... 72
when entitled to register copyright..... 99
form of application for.....119
may apply for extension of copyright.....101
ISSUE, of patent..... 15
weekly, closing of..... ... 16
of patent to assign..... 18
INTEREST, in suits for infringement..... 59
INTERFERENCES, when and how declared..... 39
Commissioner to give notice of..... 39
to issue patent to prior inventor..... 39
defined..... 39
cannot be declared against expired patent..... 39
with forfeited or abandoned applications..... 39
declared only when conflict appears specifically in claims..... 39
division of application, during..... 40
disclaimer, during..... 40
applicant may abandon claim in..... 40
procedure in..... .....40, 41
none declared until all preliminary questions settled..... 40
unless invention patentable..... 40
notice of must define exact issue involved..... 40
name time for filing preliminary statements..... 40
preliminary statements in, requirements of..... .....40, 41
forms for..... 114
extensions of time for filing..... 40
amendment of..... 41
when open for inspection..... 41
judgment upon..... 41
taking testimony in.....41, 42

PAGE

INTERFERENCES, taking testimony in foreign countries..... 42
motions in..... 42
notices to opponents..... 42
testimony required to be printed..... 43
hearing of, after evidence is taken..... 43
judgment of priority in..... 43
dissolution, suspension, and consolidation of..... 43
new trials in..... 43
as to rights of assignees in..... 43
appeals in.....43, 45, 46, 47
printed briefs of arguments to be filed.....46, 47
between patent, suit in equity to declare interfering patent void..55, 56
in case of design patents or applications..... 73
in case of trade-mark applications.....88, 89
JOINDER, question of, a question of fact..... 45
of patents and suits..... 59
can be none of designs..... 73
JOINT INFRINGERS, decree against, for profits..... 60
JOINT INVENTION, joint patent issued for..... 17
sole patent for is void..... 17
caveat for..... 38
JOINT INVENTORS, may obtain joint patent..... 17
form for application by.....110, 111
neither of may obtain patent alone..... 17
one of, only, may sign caveat..... 38
JOINT OWNERS of patent are tenants in common..... 35
not partners unless so agreed..... 35
not bound to account for profits..... 35
may not practice infringing invention..... 35
assent of, to application for re-issue.....50, 51
may be infringers..... 57
of copyrights, rights of.....101
JOINT PATENT for sole invention is void..... 17
being invalid cannot be re-issued..... 53
JUDGMENT, in suits for infringement..... 56
may be for sum not exceeding three times amount of verdict..... 58
in actions at law..... 63
JUDGMENT OF PRIORITY, in interference cases..... 43
JURISDICTION, of Circuit Courts.....12, 57, 58, 108
of Supreme Court.....12, 13, 57, 58, 108
of Federal Courts.....12, 13, 57, 58, 108
of Court of Appeals of the District of Columbia.....47, 48, 49
Commissioner cannot waive question of..... 48
of Circuit Court of Appeals.....57, 58, 108
of State Courts..... 58
of District and Territorial Courts..... 57
of United States extends to decks of vessels on high seas..... 56
of Court of Claims..... 58
Courts vested with, have power to grant injunctions and estimate damages.....66, 67, 68, 69
JURY, Circuit Courts may submit questions of fact to.....66, 67
LABELS AND PRINTS, registration provided for.....80, 109
defined..... 80
restrictions upon registration.....80, 81
applicant, who may be..... 81
forms of application for.....118, 119
novelty necessary..... 81
application..... 81
term of registration..... 81
assignment of..... 81
fees for.....80, 120
LACHES, may forfeit rights to relief..... 67
none, if patentee ignorant of infringement..... 67
LEGAL REPRESENTATIONS, see EXECUTOR, ADMINISTRATOR.
LETTERS OF ADMINISTRATION, foreign, not good evidence..... 34
ancillary.....18, 25, 34

PAGE
LETTERS PATENT, classified abridgment of..... 78
how printed and distributed 78
to be sold at cost..... 79
(see also PATENT.)
LIBRARIAN OF CONGRESS, has charge of copyrights..... 99
seal for office of..... 99
required to give bond..... 99
to make annual report to Congress..... 99
to record entry of copyright.....103
and furnish copy under seal to proprietor..104
to furnish copies of entries to Secretary of Treasury.....104
LIBRARY of Patent Office, establishment and regulations of..... 9
binding for..... 78
LICENSE, should be recorded within three months of date..... 35
in writing..... 35
identify patent by number and date..... 35
LICENSEE, may be an infringer..... 57
patentee may sue in behalf of..... 57
may sue in name of licensor..... 57
LIMITATION OF TERM, by prior foreign patent.....16, 21, 22
LITHOGRAPHS, never accepted as drawings..... 27
may be copyrighted.....100
LITHOGRAPHING and Engraving..... 11
LUNATIC, may be an infringer..... 57
MACHINE, specification of..... 23
and product cannot be claimed together unless dependent..... 24
MANDAMUS, to compel Commissioner to issue patent.....7, 8, 48
must be directed against Secretary of Interior.. 7
MANUFACTURE, claim for..... 25
must be claimed as new product..... 25
design for article of, patentable..... 72
MANUSCRIPT, copyright in..... ....107, 108
MAP, copyright for..... 99
MARINE ENGINE, patented articles connected with..... 14
no royalty to U. S. officers and employees for.... 15
MARRIED WOMEN, may obtain patent..... 17
power of, to assign patent..... 35
are liable for infringements..... 57
MARKING COPYRIGHTED ARTICLES, requirements.....105
articles of pottery or metal.....109
penalty for falsely marking articles "copyrighted".....105, 106
who may sue for penalty.....105, 106
MARKING FOREIGN GOODS, with name of country of origin..... 96
MARKING PATENTED ARTICLES, requirements.....36, 37
duty devolves upon manufacturer..... 37
penalty for falsely marking articles "patented".. 37
who may sue for penalty..... 37
"MEANS" restriction upon use of word in claims..... 24
"MECHANISM" restriction upon use of word in claims..... 24
subordinate, may be separately claimed..... 25
MECHANICAL SKILL, not invention..... 18
METAL ARTICLES, copyright mark upon.....109
MISTAKE, defined.....49, 50
MODE OF OPERATION, claim for is void..... 24
MODELS arrangement and exhibition of, etc..... 9
disposal of..... 9
when required..... 27
required when invention deemed inoperative..... 27
relates to perpetual motion..... 27
requirements as to construction of..... 27
of design..... 74
MODEL of work of the fine arts, copyright in..... 99
MOTIONS, in interference proceedings.....40, 41, 42
notice of, to be served on opponents.....40, 41, 42, 63, 68
for injunction..... 68

PAGE

MUNICIPAL CORPORATION, as an infringer....56, 57
MUSICAL COMPOSITION, copyright for....99, 100
NEW MATTER, cannot be introduced into application.... 32
into re-issue....49, 51, 52, 53
NEW TRIALS, in interferences.... 48
in actions at law.... 63
NOTARIES PUBLIC, countries in which may not administer oaths.... 30
must affix official seal.... 30
may take testimony in interferences....41, 42
rules for.... 42
NOTICE, to opponent, upon making motion....40, 41, 42
of time and place for taking testimony.... 41
of special matter in pleading.... 63
of motion for injunction.... 68
NOVELTY, a prerequisite to patentability.... 16, 19
examination as to.... 31
applicant to point out all patentable.... 32
examination as to, renewed applications....34, 35
how determined in renewed applications.... 35
examination as to, application for re-issue....49, 51, 53
a prerequisite to patentability in case of design.... 72
labels and prints.... 81
copyrights....101, 102, 103
OATH, by inventor, required.... 30
forms for....110, 111, 112, 113
execution of.... 25
averments necessary.... 30
officials before whom it may be taken.... 30
countries in which Notaries Public may not administer.... 30
must be signed by inventor.... 30
attested by official seal of officer administering.... 30
supplemental, when required....30, 32
forms for....112
divisional applications require separate oaths, etc.... 32
by administrator.... 34
form for....111
original may be used for renewed application.... 34
to accompany caveat, form for....116
in re-issue application....50, 51
form for....113
in design application.... 73
OBJECTIONS, see REJECTIONS.
OFFICIALS, before whom oath may be taken.... 30
must affix official seal to oath.... 30
OFFICERS AND EMPLOYEES, of Patent Office....6, 7, 31
how appointed.... 6
salaries of....6, 7
restrictions upon....8, 17
of U. S., no royalties to for use of inventions 15
may obtain patent, when.... 17
"OPERATIVE MEANS," claim to be for.... 24
PAINTING, copyright for.... 99
PARTICIPIAL CLAIMS, are improper.... 24
PARTIES, in infringements in actions at law....56, 57
in actions in equity.... 64
PATENT, to whom issued....6, 17, 36
granted to inventors only....6, 17
restrictions upon officers and employees of U. S. acquiring....6, 17
constitution authorizes grant of....3, 6, 17
attorney may retain until fees paid.... 10
how issued, attested and recorded.... 15
who may sign.... 15
invalid if issued without proper signatures.... 16
contents and duration of.... 16
cannot be antedated.... 16
term limited by prior foreign patent....16, 21, 22

PAGE

PATENT, extended by special act of Congress only..... 16
jurisdiction of Federal Courts.....12, 13
takes effect from date of issue..... 16
term measured by statute not language of grant.....16, 21, 22
date of..... 16
withheld if final fee not paid in due time..... 16
who may obtain.....16, 17
forms for applications for.....110, 111, 112, 113
to joint inventors..... 17
to executor or administrator..... 18
may issue to assignee.....18, 36
for inventions previously patented abroad..... 21
identity with foreign patent..... 22
date of foreign patent when controlling term of U. S. patent..... 22
when term not affected by forfeiture prior foreign patent..... 22
scope of determined by claim..... 24
cannot be broader than claims..... 24
cannot embrace more than one invention..... 24
entitled to liberal construction..... 25
with generic claim dominates patent claiming species 25
examination of application and issue of patent.....30, 31, 32, 33
issue, conditional upon utility and importance of invention..... 30
rejection of claims not final refusal of patent..... 31
application for, must be completed within two years..... 33
issued or re-issued to assignee if assignment recorded.....33, 36
may issue to inventor and assignee jointly.....33, 35, 36
when and on what oath may issue to executor or administrator..... 34
assignable by instrument in writing..... 35
assignment of, should be recorded within three months..... 35
any part of, or interest in, may be assigned..... 35
assignment should identify by number and date..... 35
executors and administrators may assign..... 35
assignment of, by infant..... 38
by married woman..... 35
cannot be seized and sold on execution.....35, 79
owner may be compelled to assign.....35, 79
no particular form of assignment prescribed..... 35
obtainable by bill in equity..... 48
defects in, how cured..... 49
if inoperative or defective, may be re-issued.....49, 50, 51, 52, 53, 54
re-issued patent, applicant for, who may be..... 49
original patent surrendered..... 49
assent of co-owners to..... 50
effect of.....49, 50
division of inventions in..... 49
does not affect closed transactions..... 52
issued for unexpired term of original..... 49
does not affect rights of non-assenting owners..... 50
application for, requirements of.....50, 51
procedure in.....51, 52
withdrawal of..... 52
date and term of..... 52
decisions regarding.....52, 53
void and expired patents cannot be re-issued..... 53
amendment of, by disclaimer.....54, 55
effect of disclaimer upon.....54, 55
interfering patents, suits touching.....55, 56
not void because of previous use in foreign country..... 70
granted prior to March 2, 1861, extension of.....70, 71
design patent, provided for..... 72
who may apply for..... 72
duration of..... 74
extension of..... 74
subject to general rules of patent law..... 74
fees for obtaining, schedule of.....75, 119, 120
rights vest in assignees in bankruptcy..... 79

PAGE

PATENTABLE INVENTION, essential attributes of....16, 18, 19
must be reduced to practice.... 18
novelty required.... 19
utility required.... 19
effect of prior knowledge or use.... 19
prior patents.... 19
publication.... 20
public use or sale.... 20
abandonment.... 21
what are, in case of designs....72, 73
PATENT ACTS, history of....3, 4, 5
PATENT AGENTS, who may be.... 9
may be refused recognition, when.... 9
must file power before taking any action.... 9
requirement of power to firm.... 9
substitution or association, when allowed.... 9
power in favor of, may be revoked.... 9
not an officer of Patent Office.... 10
death of inventor revokes power given to.... 10
refusal of Commissioner to recognize, subject to approval of Secretary.... 9
PATENT OFFICE, establishment of.... 6
officers and employees of....6, 7, 31
salaries of....6, 7
how appointed....6, 7
records, models, etc., preserved in.... 6
Secretary of Interior has supervision of.... 7
seal of.... 8
Patent Agent or attorney not officer of.... 10
disbursements for.... 11
applications preserved in secrecy in.... 30
assignments recorded in.... 35
PATENT PRIVILEGE, constitutional power of government over.... 6
under Federal grant not subject to State laws.... 6
granted to inventors only....6, 17
for their own inventions....6, 17
not subject to seizure or execution....35, 79
does not operate beyond limits of United States.... 56
PATENT SYSTEM of the United States. History of....3, 4, 5
PATENTED ARTICLES, must be marked as such....36, 37
duty of marking devolves upon manufacturer.... 37
penalty for falsely marking articles "patented".... 37
PATENTEE, who may be....16, 17
bound by his claims....24, 25
may assign patent or interest therein.... 35
re-issue of patent to....49, 50, 51, 52, 53
extent of his rights under patent.... 56
may be plaintiff in action at law for himself or for assignee.... 57
not obliged to sue after assignment of his rights.... 57
may maintain suit even if specifications too broad....69, 70
(See also INVENTOR.)
PENALTY for falsely marking articles as "patented".... 37
if witness fails to attend or refuses to testify.... 45
for counterfeiting trade-mark....93, 94, 95
for falsely marking articles "copyrighted"....105, 106
for failure to deliver copies of copyrighted work....105
for infringing copyright....106, 107
PENAL ACT concerning counterfeiting of trade-marks....93, 94, 95
PENDING SUITS, effect of disclaimer upon.... 55
PETITION, execution of.... 25
forms for....110, 111, 112, 113
original may be used for renewed application.... 34
for design application.... 73
form for....116
re-issues....113
PHOTOGRAPHS, of drawings.... 27

PAGE

PHOTOGRAPHS, entitled to copyright.....99, 100
negatives of, entitled to copyright..... 99
PLAINTIFF, in actions at law, judgments for..... 56
who may be..... 57
in equity, who may be.....57, 64
if negligent in asserting his rights, no injunction will issue..... 67
is chargeable with laches of former owners..... 67
estoppel exists if defendant misled by..... 67
cannot recover costs in certain cases.....69, 70
PLEADING, in actions for infringement.....60, 61, 62, 63
in actions in equity..... 65
in actions for infringement of copyright.. 108
POSTMASTERS, to receive catalogue of title entries..... 104
to give receipt for copies.....105
POTTERY, articles of, copyright mark upon.....109
POWER OF ATTORNEY, must be filed before attorney can take action..... 9
when given to firm must name members..... 9
may be revoked, when..... 9
separate, required for every separate application..... 9
death of inventor revokes..... 10
execution of..... 25
forms for.....110, 111, 112, 113
revocation of power, and appointment of new attorney..112
PRACTICE, questions of, are questions of form..... 45
PRELIMINARY STATEMENT, in interference, requirements of..... 40
forms for.....114, 115
must be filed within time fixed..... 40
extension of time for filing..... 40
must be under oath..... 40
contain all the facts upon which applicant relies... 40
evidence contradicting cannot be introduced..... 41
amendment of..... 41
when open for inspection..... 41
never returned after filing..... 41
party refusing to file restricted to record date..... 41
judgment of priority upon..... 41
PREVIOUS USE, in foreign country, patent not void on account of..... 70
PRINCIPLE, best method of applying must be explained..... 23
cannot be claimed.....24, 25
PRINTED BRIEFS, required in interferences.....46, 47
PRINTED PUBLICATIONS, prior, as affecting patentability.....16, 20
comparison with invention during examination..... 31
as affecting patentability of design..... 72
PRINT, copyright for..... 99
defined.....100
(See also LABELS and PRINTS.)
PRINTING, of papers filed, Commissioner may require..... 10
copies of claims, law, decisions, etc..... 10
specifications and drawings..... 10
of testimony in interference cases..... 43
briefs in interferences.....46, 47
of copyright works, requirements.....102
PRIORITY, judgment of in interferences..... 43
of invention, how determined..... 44
what constitutes..... 44
PRIOR KNOWLEDGE, as affecting patentability.....16, 19
in case of a design..... 72
PRIOR PATENT, as affecting patentability.....16, 19
as limiting term of patent..... .....16, 21
not a bar to patent. 21
must be identical to have limiting effect..... 22
date of, when controlling term of domestic patent..... 22
forfeiture of, when not affecting term of domestic patent..... 22
taken without knowledge of actual inventor..... 22
reference to by examiner during examination..... 31
as affecting patentability of a design..... 72

PAGE

PROCESS, claim for.....24, 25
and product, unless inseparable cannot be claimed together..... 24
claim for should enumerate steps..... 24
sub-processes may be separately claimed..... 25
mechanical processes unpatentable..... 25
no division required if product inseparable from..... 31
in actions at law.....58, 59
in equity..... 64
PRODUCT, claim for.....24, 25
cannot be claimed with process or machine if separable..... 24
no division required if process inseparable from..... 31
PROJECTED WORKS, copyright for.....101
PROPRIETOR, may obtain copyright..... 99
copy of entry to be furnished to.....104
meaning of word.....99, 100
PUBLIC USE, as affecting patentability.....16, 19, 20
in case of design..... 72
PURCHASER, before application may use or sell the thing purchased..... 36
RECEIVER, patent does not vest in..... 79
may convey equitable title..... 79
RECORDS, kept and preserved in Patent Office.....6, 8
open to inspection..... 16
copies furnished by Patent Office.....13, 16
fees for.....119, 120
certified copies of, may be obtained..... 13
when admissable in evidence..... 13
Commissioner governed by in issuing patent..... 33
REDUCTION TO PRACTICE, necessary..... 18
REFERENCES, examiner should cite prior patents or publications as.....31, 38
the best should be cited first..... 31
should be pertinent though and not be identical..... 31
forfeited and abandoned applications not cited as..... 32
may be avoided by applicant filing affidavit, when.....38, 39
in applications for re-issue..... 51
in applications for design patent..... 73
REGULATIONS, how established..... 9
when within powers of office are authoritative..... 9
REHEARINGS, in actions in equity..... 65
RE-ISSUES, drawings for..... 27
applicant for, may appeal to examiner-in-chief..... 45
amendment of patent by way of..... 49
defined..... 49
applicants for, who may be..... 50
application for, requisites of.....50, 51
forms for..... 113
procedure in..... 51
surrender of original patents, its effects..... 51
withdrawal of application therefor..... 52
take and term of patent..... 52
limits and facts of re-issue.....49, 52, 53
diligence in applying for..... 52
decisions of courts, regarding..... 52
several patents may be issued for the separate and distinct parts of thing patented..... 49
application examined as to novelty, utility, abandonment and priority, 49, 51
no new matter can be introduced.....49, 50, 51, 52, 53
parts of application, how corrected..... 49
doctrines of law with regard to..... 50
re-issue cannot affect rights of non-assenting parties..... 50
division may be required..... 51
separate fee required for each divisional application..... 51
all divisions of re-issue to issue simultaneously..... 51
each division treated as a separate invention..... 51
restrictions upon broadening of claims in.....52, 53
void patents and expired patents cannot be re-issued..... 53
fraud, actual or constructive renders re-issue void..... 53

PAGE
RE-ISSUES, statements of inventor in original patent are binding..... 53
successive re-issues allowed until all defects are cured..... 53
original patent cannot be revived by disclaiming change made by re-issue 53
fees for.....75, 119
REJECTIONS, examination made with reference to matter claimed..... 31
a rejection not a final refusal of patent..... 31
references must be cited by examiner in..... 31
best references should be cited first..... 31
references should be pertinent though they need not be identical..... 31
if examiner cannot cite references must furnish affidavit..... 31
all examiner's reasons for rejecting must be given at once..... 31
applicant may amend before or after the first..... 32
so long as examiner presents new reasons for.... 32
not final until examiner has twice rejected the same claim..... 32
after second, applicant cannot amend no matter of course..... 32
rejection of claims may be appealed from..... 32
applicant must be diligent in making answer to..... 33
to receive notice if his claim is rejected..... 38
is final when examiner re-affirms his decision without citing new references..... 38
if claim twice rejected applicant may appeal to examiners-in-chief.... 45
in re-issue applications..... 51
in applications for design patent..... 73
RENEWAL OF APPLICATIONS, provided for.....16, 34
who may make application for..... 34
time limit for filing..... 34
a re-examination made..... 34
original documents may be used..... 34
a new fee required..... 34
REPLICATIONS, in actions in equity..... 65
REPEAL PROVISIONS.....76, 77, 78
repeal of acts embraced in revision..... 77
accrued rights reserved..... 77
prosecution and punishments..... 77
acts of limitation..... 77
arrangement and classification of sections..... 77
acts passed since Dec. 1, 1873, not affected..... 78
REVISED STATUTES, what are embraced in.....76, 77
RULES OF PRACTICE, see REGULATIONS.
SALARIES, of officers and employees.....6, 7
SALE, prior to application, as affecting patentability.....16, 20
SEAL, of Patent Office..... 8
of Librarian of Congress..... 99
SECRETARY OF INTERIOR, authority of.....7, 8
charged with supervision over Patent Office..... 7
duties of..... 7
cannot review judicial decisions of Commissioner..... 7
refusal of Commissioner to recognize attorney subject to approval of..... 9
SECRETARY OF TREASURY, regulations of concerning trade-marks..... 96
copyrights.....102, 103
Librarian of Congress to furnish copies of copyright entries to.....104
to print catalogues of title entries for collectors and postmasters.....104
SEIZURE, of counterfeit trade-marks, etc..... 95
of articles and things infringing copyrights.....106
SERIAL NUMBER, given to application when complete..... 30
SLAVE, invention of, unpatentable..... 17
may not apply for patent..... 17
SPECIES, claim for..... 25
SPECIFIC CLAIM, dominated by generic claim..... 25
SPECIFICATION, requisites of..... 22
forms for.....110, 111, 112, 113
must be full, clear and exact.....22, 23
signed by inventor and two witnesses..... 23

PAGE

SPECIFICATION must distinguish from other inventions and the new one from the old 23
be perfect or patent void 23
failure to describe essential element in avoids patent 23
ambiguity or false suggestion in is fatal 23
execution of 25
and drawings must agree in all essential particulars 26
cannot be withdrawn after application completed 30
if faulty must be amended 31, 32, 33
amendment of, how made 32
original, may be used for renewed application 34
may be amended at any time until application finally disposed of 32, 38
defective or insufficient cured by re-issue 49
in re-issue application, subject to same examination as in original applications 49
no new matter can be introduced in 49
amendment of 49
new patent in accordance with corrected specification to be issued 49
in suit for infringement, where specification is too broad 69, 70
of a design, requisites of 73
SPECIFICATIONS, printed, see COPIES.
SPECIMENS, of ingredients, etc., when required 27
STATE COURTS, jurisdiction of, defined 13, 58
in trade-mark cases, under common law 91
STATES, have no power to limit or restrict patent privileges 6
STATUARY, copyright for 99
SUBPŒNA, to witnesses 44
SUBSTANCE, questions of, appealable to examiners-in-chief 45
what are questions of 45
errors relating to, cured by re-issue 50
SUGGESTIONS OF OTHERS, do not defeat rights of true inventor 21
SUITS, pending, effect of disclaimer upon 55, 69, 70
touching interfering patents 55, 56
in equity, to declare interfering patent void 55, 56
for infringement, where specification is too broad 69, 70
SUPREME COURT, appellate jurisdiction of 12, 58, 91
has no original jurisdiction over questions of fact 12
jurisdiction to enforce contracts, when 13
no appeal to, ordinarlly, from Circuit Court of Appeals 58
actions brought by United States to repeal patents may be appealed to 58
Circuit Court of Appeals may certify questions of law to 58
may send certiorari to Circuit Court of Appeals 58
appeal to from Court of Appeals of the District of Columbia 58
SUPREME COURT OF THE DISTRICT OF COLUMBIA, appeal from to Court of Appeals 58
(*See also* COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.)
SURRENDER of patent, in re-issue 49, 50, 51, 52
takes effect, when 49, 51, 52
TERM, of patent 16
when limited by term of prior foreign patent 16, 21, 22
extended only by special Act of Congress 16
measured by statute not by language of grant 16, 21, 22
date of foreign patent when limiting term of domestic patent 22
when not limited by expiry of foreign patent 22
of re-issued patent 49, 52
of design patent 74
of registration of label or print 81
of trade-mark 90
limited by term of protection abroad 90
extension of 90
of copyright 101
extension of 101
who may apply for 101
publication of application for 101
TESTIMONY, rules for taking, in interferences 41, 42
in foreign countries, rules for taking 42

PAGE

TESTIMONY, to be printed..... 43
copies to be furnished..... 43
TITLE legal, not vested in anyone until patent issues..... 57
deposit of copies of, to secure copyright.....101, 102
requirements as to printing and delivery of.....103
catalogues of, printed and for sale.....104
delivered to collectors and postmasters.....104
TRADE-MARKS, history of the legislation, report..... 82
constitutional provisions regarding..... 83
registration provided for..... 83
applicants for..... 83
application for..... 84
forms for.....116, 117, 118
examination of..... 84
appeals from decision of examiner of trade-marks..... 84
limited to a single class.....84, 85
fees payable for.....83, 85, 86, 120
fees not returnable..... 85
classification of..... 85
registration, declaration, requisites of..... 86
restrictions on..... 86
defined.....86, 87
what may and what may not be registered.....86, 87, 88
rival applicants, interferences.....88, 89
appeals from Commissioner to Court of Appeals..... 89
certificates of registry, issue of..... 89
as evidence in suits..... 89
term of..... 90
term of protection..... 90
limited by protection abroad..... 90
common law right in.....90, 91, 92
right to use may be lost by non-user..... 90
applicant credited with fees previously paid..... 90
registration of *prima facie* evidence of ownership..... 90
infringement, action at law for damages.....90, 91
action in equity.....90, 91
injunctions to restrain wrongful use of..... 90
United States courts have original and appellate jurisdiction.....90, 91
suits in State courts under common law..... 91
to constitute not necessary that marks be identical..... 91
no suit can be maintained when mark used in unlawful business..... 91
liability of persons making false declaration or representation..... 91
rights under common law not affected by statutory provisions....91, 92
Commissioner authorized to make rules and regulations..... 93
registration by persons wishing to protect trade-marks abroad..... 93
penal act, regarding counterfeiting of.....93, 94, 95
counterfeiting of, punished criminally.....93, 94, 95
counterfeits may be seized and destroyed.....94, 95
prohibition of entry of foreign goods bearing falsified marks....95, 96
imported goods to be marked with name of country of origin..... 96
registry of trade-marks in Treasury Department.....95, 96
right to use depends upon use..... 84
continuous use necessary..... 84
declaration cannot be amended..... 84
if faulty a substitute must be filed..... 84
list of published weekly in Official Gazette..... 80
assignment of..... 93
TRANSLATOR, when entitled to copyright.....100
TREASURY DEPARTMENT, registry of trade-marks in.....95, 96
(See also SECRETARY OF TREASURY.)
TRIALS, in actions at law..... 63
TRUSTEE, rights to patents of bankrupt vest in..... 79
when rights of are superior to assignee of record..... 79
USE, unauthorized, of patented design, unlawful.....74, 75

PAGE

USE of trade-mark, right to, may be lost by non-user 90
UTILITY, a prerequisite to patentability 16, 19, 30
"not a prerequisite in case of a design 72
VERDICT, in suits for infringement, entry of judgment thereon 56
in actions at law to be for actual damages 56
in equity may be for profits as well as damages 58
courts have power to increase damages found by 56, 66
of jury how treated and proceeded upon 67
WARD, may obtain patent 17
WIDOW, of deceased author, may secure extension of copyright 101
WITHDRAWAL, of re-issue applications 52
WITNESSES, in interference cases, taking testimony of 42
subpœna to 44
fees allowed to 44
not required to attend at place more than forty miles distant 44
penalty for failing to attend, or refusing to testify 45
obedience of to process may be enforced 45
when not deemed guilty of contempt 45
WRITS OF ERROR, and appeals, provided for 12
in actions at law 63

YALE LAW LIBRARY